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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,480	11/03/2010	7484382	002783.0120	3579

26171 7590 03/02/2012
FISH & RICHARDSON P.C. (DC)
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/02/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Inter Partes Whirlpool Corporation
v.
LG Electronics Inc.

Reexamination Control No. 95/001,480
Patent No. 7,484,382
Technology Center 3900

DECISION ON PETITION

This is a decision on the requester's "Respondent Request for Waiver of Page Limit in an *Inter Partes* Reexamination (37 C.F.R. § 41.68)" of February 21, 2012 ("present petition"). Petitioner requests waiver of 37 C.F.R. § 1.943(c) to permit entry and consideration of the requester's respondent brief filed on January 13, 2012, which is stated to be not more than 19 pages or 8,000 words. The petition fee of $400 pursuant to 37 C.F.R. §1.17(f) was charged to petitioner's deposit account on February 22, 2012.

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

FINDINGS

1. U.S. Patent No. 7,484,382 issued on February 3, 2009.

2. A request for *inter partes* reexamination of the '382 patent was filed by third party requester on November 3, 2010, and was assigned Control No. 95/001,480.

3. On November 30, 2010, reexamination was ordered and a non-final Office action was mailed.

4. Prosecution was conducted and on September 14, 2011, a Right of Appeal Notice (RAN) was mailed.

5. Patent owner filed a Notice of Appeal on October 14, 2011, and an appellant brief on December 14, 2011.

6. Requester filed a respondent brief on January 13, 2012.

7. The present petition was filed on February 21, 2012.

RELEVANT AUTHORITY

37 C.F.R. § 1.183 states:

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

37 C.F.R. § 1.943(c) states:

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

MPEP § 2667 I.A.2 (Response filed by Patent Owner that is too long) states:

> With respect to the length of the papers, the following additional information is to be noted. Similar to the Federal Rules of Appellate Procedure, the provisions of 37 CFR 1.943(c) are waived to the extent that the table of contents pages, the table of case law pages, and the pages of the claims (but not claim charts applying the art to the claims) are excluded from the thirty (30) page limit required by 37 CFR 1.943(c).
>
> Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

MPEP § 2667 I.B.2 (Response filed by Third Party Requester that is too long) states:

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

37 C.F.R. § 41.66(b) states:

> Once an appellant's brief has been properly filed, any brief must be filed by respondent within one month from the date of service of the appellant's brief. The time for filing a respondent's brief or an amended respondent's brief may not be extended.

ANALYSIS

A review of the record reveals that patent owner filed an appellant brief on December 14, 2011, including a certificate of word count of 13,963 words. Requester filed a respondent brief on January 13, 2012, and included a certificate stating that the brief is 19 pages and 7,724 words. Patent owner's appellant brief is stated to be 13,963 words, which would be within the limit of 30 pages and 14,000 words. However, patent owner's appellant brief also contains several declarations which count toward the page limit per MPEP § 2667 I.A.2. This causes appellant's brief to exceed substantially the 30 page limit pursuant to 37 C.F.R. § 1.943(c). Similarly, requester's respondent brief contains two declarations which count toward the page limit. Therefore, respondent's brief not only exceeds the page and word limits by the amounts indicated in the petition, but the numerous pages of declarations cause respondent's brief to far exceed the 15 page limit pursuant to 37 C.F.R. § 1.943(c).

The present petition is actually a petition pursuant to 37 C.F.R. §1.183, and was filed on February 21, 2012, *i.e.*, more than 2 months from

appellant brief of December 14, 2011. Per MPEP 1002, the 2-month time period in 37 CFR § 1.181(f) applies to a petition under any section (*e.g.*, 37 C.F.R. § 1.182 and 37 C.F.R. § 1.183) that does not specify the time period within which a petition must be filed. The 2-month period is not extendible under 37 C.F.R. § 1.136(a) since the time is within the discretion of the Director of the USPTO. The present petition is **dismissed** as not being timely filed.

The USPTO has the discretion to waive the applicable rules under 37 C.F.R. § 1.183 in an extraordinary situation when justice requires waiver. Even if the present petition had been timely filed, petitioner's stated reasons for requesting waiver of the page/word limits for requester's respondent brief, e.g., to respond to the 80 new claims added by the appellant, to address a lengthy disputed functional limitation in the context of the structural disclosures in the prior art, and to use figures and illustrations from the prior art in order to make such explanations easier and clearer, are not persuasive. Petitioner has provided no showing of an extraordinary situation where justice requires waiver of 37 C.F.R. § 1.943(c).

The patent owner's appellant brief of December 14, 2011, is not entered for exceeding the page limit pursuant to 37 C.F.R. § 1.943(c) for the reasons explained *supra*. Because the appellant brief is not entered, the respondent brief of January 13, 2012, does not have an entry right pursuant to 37 C.F.R. § 41.66(b). However, even if it did have an entry right, the respondent brief would not be entered for exceeding the page and word limits pursuant to 37 C.F.R. § 1.943(c) for the reasons explained *supra*. Accordingly, the present petition also is **dismissed** in view of the non-compliant appellant brief.

CONCLUSION

The present petition is DISMISSED.

If a compliant appellant brief is timely filed, then requester will have one opportunity to file a corrected respondent brief in compliance with 37 C.F.R. § 1.943(c), within a non-extendable time period of one month from the certificate of service date of the corrected appellant brief pursuant to 37 C.F.R. § 41.66(b). If a compliant respondent brief is not timely received, the appeal will proceed without consideration of a respondent brief.

With respect to whether there comes to be a compliant appellant brief, patent owner, who also is being mailed a copy of this decision, hereby is given one opportunity to file a corrected appellant brief in compliance with 37 C.F.R. § 1.943(c), within a non-extendable time period of 1 month from the mailing date of this decision. If a corrected appellant brief is not timely submitted, the patent owner's appeal will be dismissed.

James Donald Smith
Chief Administrative Patent Judge

Control No. 95/001,480
Patent No. 7,484,382

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MAILED
FEB 16 2011
CENTRAL REEXAMINATION UNIT

In re Puente Baliarda *et al.*
Inter Partes Reexamination
Control No. 95/001,482
Filed: October 1, 2010
For: U.S. Patent No. 7,397,431

: DECISION
: DISMISSING
: PETITION

This is a decision on patent owner's January 21, 2011 petition entitled "PATENT OWNER PETITION UNDER 37 C.F.R. § 1.182 TO TEMPORARILY SUSPEND REEXAMINATION PROCEEDINGS PENDING DECISION ON MERGER."

The petition is before the Office of Patent Legal Administration (OPLA) for decision.

The petition is dismissed for the reasons set forth below.

REVIEW OF FACTS

1. On July 8, 2008 the Office issued U.S. Patent No. 7,397,431 (the '431 patent) to Puente Baliarda *et al.*

2. On November 11, 2010, a first request for *inter partes* reexamination of claims 1, 4-5, 7-8, 12-14 17, 21-22, 24-27 and 29-31 of the '431 patent, assigned control No. 95/001,482 ("the '1482 proceeding"), was filed by a third party requester on behalf of real party in interest Samsung Electronics Co., Ltd. ("the '1482 requester").

3. On December 3, 2010, a second request for *inter partes* reexamination of claims 1, 4-5, 7-8, 12-14 17, 21-22, 24-27 and 29-31 of the '431 patent, assigned control No. 95/001,497 ("the '1497 proceeding"), was filed by a third party requester on behalf of real party in interest HTC Corp. and HTC America, Inc. ("the '1497 requester").

4. On December 13, 2010, a third request for *inter partes* reexamination of claims 1, 4-5, 7-8, 12-14 17, 22, 27, 29, and 31 of the '431 patent, assigned control No. 95/000,586 ("the '586 proceeding"), was filed by a third party requester on behalf of real party in interest Kyocera Communications, Inc. ("the '586 requester").

5. On December 14, 2010, *inter partes* reexamination was ordered on claims 1, 4-5, 7-8, 12-14 17, 21-22, 24-27 and 29-31 of the '431 patent in the '1482 proceeding based upon an

examiner's determination with regard to the substantial new questions of patentability alleged by requester in the November 11, 2010 request for reexamination. An Office action was not concurrently issued. The order indicated that an Office action would issue in due course.

6. On January 20, 2011, *inter partes* reexamination was ordered on claims 1, 4-5, 7-8, 12-14 17, 22, 27, 29, and 31 of the '431 patent in the '586 and on claims 1, 4-5, 7-8, 12-14 17, 21-22, 24-27 and 29-31 of the '431 patent in the '1497 proceedings based upon an examiner's determination with regard to the substantial new questions of patentability alleged by requesters in the December 13, 2010 and December 3, 2010 requests for reexamination respectively. An Office action was not concurrently issued in either proceeding. The orders indicated that Office actions would issue in due course.

7. On January 21, 2011, patent owner filed the present petition requesting suspension of reexamination until a merger decision has issued regarding the '1482 proceeding and the '586 and '1497 proceedings.

8. To date, no Office action has issued in the three *inter partes* reexamination proceeding ordered for the '431 patent.

DECISION

Patent owner's January 21, 2011 petition is dismissed. Initially, it is to be noted that, once all proceedings are ordered, the proceedings are ripe for consideration of whether or not to merge proceedings, and the Office's decision on whether or not to merge is within the sole discretion of the Office. [1] In this instance, as all of the reexamination proceedings have been ordered, a determination will be made in due course as to whether or not the Office will exercise its sole discretion to merge for the present situation.[2] In addition, should a decision be made to merge, procedures are in place to accommodate the merging of proceedings where an outstanding Office action exists.[3] Accordingly, there is no basis to suspend proceedings in this instance.

CONCLUSION

1. Patent owner's January 21, 2011 petition is dismissed.

2. Any questions concerning this communication should be directed to Joseph F. Weiss in the Office of Patent Legal Administration, at (571) 272-7759.

Kenneth M. Schor

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

[1] MPEP 2686.01 I
[2] MPEP 2686.01 III
[3] MPEP 2686.01 III

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MAY 04 2011

CENTRAL REEXAMINATION UNIT

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Inter Partes Reexamination Proceeding
Control No. 95/000,586
Filed: December 13, 2010
For: U.S. Patent No. 7,397,431

Inter Partes Reexamination Proceeding
Control No. 95/001,482
Filed: November 11, 2010
For: U.S. Patent No. 7,397,431

Inter Partes Reexamination Proceeding
Control No. 95/001,497
Filed: December 3, 2010
For: U.S. Patent No. 7,397,431

DECISION, *SUA SPONTE*, MERGING *INTER PARTES* PROCEEDINGS

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration as to action to be taken under 37 C.F.R. § 1.989 at this time.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,397,431 (the '431 patent) issued to Carles Puente Baliarda *et al.* on April 10, 2007.

2. The 95/001,482 *inter partes* proceeding.
   On November 11, 2010, a request for *inter partes* reexamination of claims 1, 4, 5, 7, 8, 12-14, 17, 21, 22, 24-27, and 29-31 of the '431 patent was deposited by third party requester; the request was assigned control number 95/001,482 (the '1482 *inter partes* proceeding). Samsung Electronics is identified as the real party in interest.

   Reexamination was ordered on December 13, 2010.

3. The 95/000,586 *inter partes* proceeding.
   On November 12, 2010, a request for *inter partes* reexamination of claims 1, 4, 5, 7, 8, 12-14, 17, 22, 27, 29, and 31 of the '431 patent was deposited by third party requester; the request was assigned control number 95/000,586 (the '586 *inter partes* proceeding), and a filing date of December 13, 2010, the date at which the filing requirements of 37 C.F.R. § 1.915 were met. Kyocera Communications is identified as the real party in interest.

   Reexamination was ordered on February 4, 2011.

4. The 95/001,497 *inter partes* proceeding.
   On December 3, 2010, a request for *inter partes* reexamination of claims 1, 4, 5, 7, 8, 12-14, 17, 21, 22, 24-27, and 29-31 of the '431 patent was deposited by third party requester; the request was assigned control number 95/001,497 (the '1497 *inter partes* proceeding). HTC and HTC America are identified as the real parties in interest.

   Reexamination was ordered on January 20, 2011.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 C.F.R. § 1.989(a):

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

As evidenced by the above review of facts, the '1482, '586, and '1497 reexamination proceedings are currently pending. Orders granting reexamination of claims 1, 4, 5, 7, 8, 12-14, 17, 21, 22, 24-27, and 29-31 of the '431 patent have been mailed in both the '1482 and '1497 reexamination proceedings, and an order granting reexamination of claims 1, 4, 5, 7, 8, 12-14, 17, 22, 27, 29, and 31 of the '431 patent was mailed in the '586 reexamination proceeding, and a decision under 37 C.F.R. § 1.989(a) is timely. The '1482, '586, and '1497 reexamination proceedings are at the same stage, in which no Office action on the merits has been issued.

The general policy of the Office is that multiple reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into each proceeding on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in each of the proceedings, and (3) to expedite the prosecution of each proceeding. In the present instance, merger of the '1482, '586, and '1497 reexamination proceedings would address these considerations. Thus, pursuant to 37 C.F.R. § 1.989(a), the '1482, '586, and '1497 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an inter partes reexamination proceeding with two other inter partes reexamination proceedings. Pursuant to 37 C.F.R. § 1.989(b), the merged proceeding is governed by 37 C.F.R. §§ 1.902 through 1.997.

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2).[1] First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is limited to issues raised in either the Office action or the patent owner's

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

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

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

2. Appeal Rights:

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

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

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

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

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

It is to be noted that, because the '586 *inter partes* third party requester does not propose any rejections of claims 21, 24-26, and 30 in the request for reexamination, the '586 requester has no appeal rights as to those claims as they appear in the '431 patent.

C. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office, or filed by the patent owner, and the third party requesters will contain the identifying data for both proceedings and will be entered in each reexamination file. All papers filed by the patent owner and the third

party requesters must consist of a single paper, **filed in triplicate**, each bearing a signature and identifying data for all proceedings, for entry into the file for each proceeding.

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

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

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

By Mail to: Mail Stop "*Inter Partes* Reexam"
Attn: Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

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

By hand (or delivery service) to:

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

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

D. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 C.F.R. § 1.530 and the guidelines of MPEP § 2666. 37 C.F.R. § 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via

markings pursuant to 37 C.F.R. § 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

E. Fees:

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

F. Citation of Patents and Printed Publications:

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

G. Appeal Procedure Reminders for *Inter Partes* Reexamination

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,482, *inter partes* Reexamination Control No.95/001,487, and *inter partes* Reexamination Control No. 95/000,586 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Any questions concerning this communication should be directed to the Office of Patent Legal Administration, to Michael Cygan, at (571) 272-7700, or in his absence, to the undersigned at (571) 272-7726.

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

May 3, 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.
95/001,482 • 95/001497 • 95/000586	11/11/2010	7,397,431	3008.006REX0	6101

26111 7590 10/28/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/28/2011

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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HOUSTON, TX 77002

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

REEXAMINATION CONTROL NUMBER 95/001,482. + 95/001497, + 95/000586

PATENT NUMBER 7,397,431.

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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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CENTRAL REEXAMINATION U

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Inter Partes Reexamination Proceeding
Control No. 95/001,482
Filed: November 11, 2010
For: U.S. Patent No. 7,397,431

Inter Partes Reexamination Proceeding
Control No. 95/001,497
Filed: December 3, 2010
For: U.S. Patent No. 7,397,431

Inter Partes Reexamination Proceeding
Control No. 95/000,586
Filed: December 13, 2010
For: U.S. Patent No. 7,397,431

DECISION GRANTING PETITIONS

This is a decision on the following petitions:

1. Patent owner paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on August 15, 2011.

2. The '1482 requester paper entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)[*sic*]," filed on September 14, 2011.

Both petitions are before the Office of Patent Legal Administration for consideration.

Both petitions under 37 CFR 1.183 are granted for the reasons set forth herein.

BACKGROUND

1. On July 8, 2008, United States Patent No. 7,397,431 (the '431 patent) issued to Baliarda et al.

2. On November 11, 2010, a first request for *inter partes* reexamination of the '431 patent was filed by a third party requester (the '1482 requester), which request was assigned Reexamination Control No. 95/001,483 (the '1482 proceeding).

3. On December 3, 2010, a second request for *inter partes* reexamination of the '431 patent, assigned Reexamination Control No. 95/000,586 (the '0586 proceeding), was initially deposited by a third party requester (the '586 requester), and a corrected request was filed on December 13, 2010.

4. Also on December 3, 2010, a third request for *inter partes* reexamination of the '431 patent was filed by a third party requester (the '1497 requester), which request was assigned Reexamination Control No. 95/001,500 (the '1497 proceeding).

5. On December 13, 2010, the Office ordered reexamination in the '1482 proceeding.

6. On January 20, 2011, the Office ordered reexamination in the '1497 proceeding.

7. On February 4, 2011, the Office ordered reexamination in the '586 proceeding.

8. On May 4, 2011, the Office issued a decision merging, *sua sponte*, the '1482, '1497 and '586 proceedings ("the merged proceeding").

9. On May 13, 2011, the Office issued a non-final action in the merged proceeding.

10. On August 15, 2011, the patent owner filed a response in the merged proceeding, concurrently with the instant petition entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION" (patent owner petition under 37 CFR 1.183).

11. On September 14, 2011, the '1482 requester filed comments, concurrently with the instant petition entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)[*sic*]" ('1482 requester petition under 37 CFR 1.183).

DECISION

I. 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(b) provides:

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

II. Petitions Under 37 CFR 1.183

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological** facts, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide

a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count

A. Patent Owner Petition Under 37 CFR 1.183

On August 15, 2011, patent owner filed the instant petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its August 15, 2011 response submission. In support of its request for waiver of the rule, patent owner "asserts that justice would be served by granting waiver of the 50-page limit, because the full length of the Response is needed to fully and adequately respond to the Office Action."[1] Further, patent owner asserts:

> This reexamination proceeding represents the merger of three *Inter Partes* reexaminations. Thus, the Office Action is based on the combination of three *Inter Partes* reexamination requests and grants. Specifically, the Office Action includes 22 separate grounds of rejection over 13 separate references. . . . While the pending Office action constitutes only 16 pages, it incorporates by reference over 850 pages of argument and detailed claim charts set forth by the three third party requesters in their requests for reexamination. It would be unjust to hold the Patent Owner to only 50 pages to respond to what is essentially three Office Actions, particularly given the size and complexity of the three *Inter Partes* reexamination requests upon which they are based."[2]

In addition to stating that the response satisfies the formatting requirements for a grantable petition under 37 CFR 1.183, patent owner asserts that it has "made a good faith effort to comply with the 50-page limit, making efforts to economize, avoid extraneous material and information already of record, and present arguments efficiently . . . . Despite these efforts, the argument portion of the Response exceeds the 50-page limit."[3]

Patent owner's August 15, 2011 response submission includes: (1) a 175-page remarks section; (2) a 10-page declaration entitled "Declaration of Dr. Carles Puente Under 37 C.F.R. § 1.132"; (3) a 15-page declaration entitled "Declaration of Dr. Carles Puente Under 37 C.F.R. § 1.132 Relating to Fractal and Multilevel Antennas"; (4) a 9-page declaration entitled "Declaration of Drs. Carles Puente, Carmen Borja, Jaume Anguera, and Jordi Soler Under 37 C.F.R. § 1.132"; (5) a 9-page declaration entitled "Declaration of Ruben Bonet Under 37 C.F.R. § 1.132"; (6) a 41-page declaration entitled "Declaration of Dr. Raj Mittra Under 37 C.F.R. § 1.132" (The "Mittra Declaration"); and (7) a 20-page declaration entitled "Declaration of Dr. Raj Mittra Under 37 C.F.R. § 1.132 Relating to Single Band, Resonant and Multilevel Antennas". In view of the guidance set forth herein, portions of the 41-page "Mittra Declaration" are deemed to include an extension of arguments of counsel. Thus, the Mittra declaration is subject to the 50-

[1] *See* patent owner petition at page 2.
[2] *See id.* at pages 2-3.
[3] *See id.*

page length requirement, in addition to 175-page remarks section[4] such that patent owner's August 15, 2011 response submission exceeds the regulatory page limit by up to 166 pages.

Based on the individual facts and circumstances of this case such as, for example, the size of the May 13, 2011 Office action, including the incorporation by reference of pages from multiple requests for reexamination in the merged proceeding,[5] it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that patent owner's response submission exceeds 50 pages. Accordingly, patent owner's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's August 15, 2011 response submission to exceed the regulatory page limit by up to 166 pages. This waiver makes patent owner's August 15, 2011 response submission page-length compliant.

B. The '1482 Requester's Petition Under 37 CFR 1.183

On September 14, 2011, the '1482 requester filed the instant petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its September 14, 2011 comments submission. The '1482 requester asserts that the September 14, 2011 comments submission includes "99 pages of double spaced 12 pt font arguments and a 20-page declaration from Dr. Balanis under 37 C.F.R. § 1.132."[6] The '1482 requester asserts, however, that "[i]f the Office agrees with [patent owner's] interpretation of MPEP § 2667(I)(A)(2), then Samsung's Comments are only 99 pages as Dr. Balanis' declaration discusses how one of ordinary skill in the art would understand the disclosure of the prior art at issue".[7]

In support of its request for waiver of the rule, the '1482 requester asserts:

> Samsung has attempted to respond in as little a number of pages as possible but was unable to do so within the 50 page limit. The additional pages requested in

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[4] The cover page is excluded from the page count, as is the listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count.

[5] *See* May 13, 2011 Office action which, on its face, spans only 16 pages in length but relies heavily on incorporation by reference of more than 850 pages from multiple requests for *inter partes* reexamination in the merged proceeding.

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

[7] *Id.* at page 3. The '1482 requester is cautioned that statements submitted in opposition to patent owner's petition under 37 CFR 1.183 are improper and may result in the requester's petition paper being returned and not considered, as set forth in 37 CFR 1.939(a). For example, on page 3 of the third party requester petition under 37 CFR 1.183, the '1482 requester presents arguments against patent owner's position set forth in patent owner's petition under 37 CFR 1.183. Pursuant to MPEP 2667(I)(B)(4), a requester does not have a statutory right to challenge this discretionary procedural process (*i.e.*, waiver of the regulatory page limit) in the reexamination proceeding. Pursuant to 35 U.S.C. § 314(b)(2), the third party requester in an ordered *inter partes* reexamination proceeding has a statutory right to once file written comments to a patent owner's response to an Office action on the merits. Patent owner's petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) for patent owner's response submission, however, is not a "response" to an Office action on the merits. Thus, in this instance, 35 U.S.C. § 314(b)(2) does not provide any right for the third party requester to file comments on a patent owner's petition under 37 CFR 1.183 for suspension of the rules. Accordingly, any future petition that contains such arguments will be treated as an improper opposition paper and, as such, will be returned by marking the paper "closed" and "not public" in the IFW for the proceeding and will not be considered. Thus, any reply that exceeds the regulatory page limit which accompanies such petition would be found not page-length compliant.

> this petition are necessary to provide a reply the all of the issues raised by the Patent Owner's 279-page response.
>
> Importantly, this waiver would not go beyond the 1:1 ratio proscribed [sic] for Patent Owner and Requester responses to Office Actions recited in 37 C.F.R. § 1.943(b). In fact, the Requester is asking for significantly fewer total pages that the Patent Owner has submitted (279 total pages for the Patent Owner while Requester is only asking for a total of 99 pages). Therefore in the interest of justice, the Office should grant this petition so that the Requester is able to provide the Office with a rebuttal of all the arguments raised by the Patent Owner.[8]

The '1482 requester's September 14, 2011 comments submission includes: (1) a 99-page remarks section; (2) an 11-page declaration entitled "DECLARATION OF DR. CONSTANTINE A. BALANIS" captioned for this merged proceeding (the merged proceeding Balanis declaration); (3) an 8-page declaration entitled "DECLARATION OF DR. CONSTANTINE A. BALANIS" captioned for *inter partes* proceeding 95/001390 (the '1390 proceeding Balanis declaration); and (4) additional reference documents. In view of the guidance set forth herein, portions of the 11-page Balanis declaration for the merged proceeding and the 8-page Balanis declaration for the '1390 proceeding are deemed to include an extension of arguments of counsel. Thus, the 19 pages of the Balanis declarations are subject to the 50-page length requirement, in addition to 99-page remarks section[9] such that the '1482 requester's September 14, 2011 comments submission exceeds the regulatory page limit by up to 68 pages.

Based on the specific facts set forth in the '1482 requester's petition under 37 CFR 1.183, the '1482 requester's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a comments submission in compliance with the 50-page limit and submitting the resulting comments submission (which is in excess of 50 pages), and the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that the '1482 requester's September 14, 2011 comments submission exceeds 50 pages. Accordingly, '1482 requester's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting '1482 requester's comments submission to exceed the page limit by up to 68 pages. This waiver makes the '1482 requester's September 14, 2011 comments submission page-length compliant.

III. Time Period for Submission of the '1497 and '586 Requesters' Comments

The '1497 and '586 requesters have **30 days from the mailing date of this decision**, granting patent owner's petition under 37 CFR 1.183 and making patent owner's August 15, 2011 response submission page-length compliant, **to file a comments paper pursuant to 37 CFR 1.947**. It is noted that any petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) deemed necessary should accompany the comments submission. Further, to obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a requester comments submission that:

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[8] *Id.* at page 2. It is noted, however, as set forth in section I(A) above, patent owner's August 15, 2011 response submission has been determined to include up to 216 pages that count toward the regulatory page limit.

[9] The cover page is excluded from the page count, as is the table of contents pages.

1) is one-and-a-half or double-spaced;[10]
2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);
3) has a font size no smaller than 12-point;
4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and
5) has sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.

See, generally, 37 CFR 1.943(a) and 37 CFR 1.52. Adherence to such formatting guidelines enables the Office to more accurately and uniformly determine the number of pages of a requester comments submission that the Office must review, analyze, and address to the extent needed. Attached reference materials, such as prior art references, are not subject to these formatting guidelines, as such papers are expressly excluded from the regulatory page limit count under 37 CFR 1.943(b).

CONCLUSION

1. Patent owner's August 15, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's response submission to exceed the regulatory page limit by up to 166 pages. This waiver makes patent owner's August 15, 2011 response submission page-length compliant.

2. The '1482 requester's September 14, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting the '1482 requester's comments submission to exceed the regulatory page limit by up to 68 pages. This waiver makes '1482 requester's September 14, 2011 comments submission page-length compliant.

3. The '1497 and '586 requesters have 30 days from the mailing date of this decision, granting patent owner's petition under 37 CFR 1.183 and making patent owner's August 15, 2011 response submission page-length compliant, to file a comments paper pursuant to 37 CFR 1.947.

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

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

[10] Claim charts applying the art to the claims are permitted to be single-spaced so long as the charts have sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.

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Inter Partes Reexamination Proceeding
Control No. 95/000,586
Filed: December 13, 2010
For: U.S. Patent No.: 7,397,431

Inter Partes Reexamination Proceeding
Control No. 95/001,497
Filed: December 03, 2010
For: U.S. Patent No. 7,397,431

Inter Partes Reexamination Proceeding
Control No: 95/001,482
Filed: November 11, 2010
For: U.S. Patent No. 7,397,431

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

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

Patent owner's petition to terminate filed on September 16, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/001,497, filed on September 16, 2011, is **granted**.

Inter partes reexamination proceeding control number 95/001,497 is hereby **severed** from the merged proceeding of *inter partes* reexamination control numbers 95/001,497, 95/000,586 and 95/001,482.

Inter partes reexamination proceeding 95/001,497, filed on September 16, 2011, is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,586 and 95/001,482 **will continue** in the manner set forth in this decision.[1]

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/001,497 (the '1497 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

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

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

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

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,397,431 (the '431 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd.et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner submits a copy of a consent judgment, entered by the district court on September 15, 2011, in which the district court stated that ". . . HTC [the defendant/requester of the '1497 proceeding] has not sustained its burden of proving the invalidity of any of the above listed claims of the Patents-in-Suit" and that "[t]his Consent Judgment constitutes, for purposes of 35 U.S.C.

[1] This petition does not address the petition under 37 CFR 1.182 to terminate the '586 proceeding or the petition to expunge information submitted under MPEP § 724.02, both of which were filed on September 30, 2011. These petitions will be addressed by a separate decision.

§ 317(b), a final decision entered against HTC in a civil action arising in whole or in part under section 1338 of title 28". The "above listed claims" of one of the patents in suit, the '431 patent, which is the patent under reexamination in the '1497 proceeding, are listed in the consent judgment as claims 1, 4, 5, 7, 8, 12-14, 17, 21, 22, 24-27, and 29-31, which are identical to the claims that were requested to be reexamined by HTC in the '1497 proceeding, and that are under reexamination in the merged proceeding. The court also stated, in the September 15, 2011 consent judgment, that "[a]ll of Fractus' claims against HTC are dismissed with prejudice. All of HTC's defenses, claims, and counterclaims of invalidity and unenforceability of each and every claim of the Patents-in-Suit [including the '431 patent] are dismissed with prejudice", and that "[t]he parties expressly waive their rights to appeal". Thus, the patent owner has provided sufficient evidence that (1) the requester HTC was a party to the litigation, (2) the district court's decision was final, and (3) the court determined that the requester/defendant HTC had not sustained its burden of proving the invalidity of the claims in suit, which are identical to the claims requested to be reexamined by requester HTC, and which are under reexamination in the merged proceeding. For these reasons, the above-described elements 1-3 have been shown to be satisfied.

Regarding element 4, the court also stated, in the September 15, 2011 consent judgment, that "[t]he prior art raised by [defendant/requester] HTC, Samsung, and Kyocera in the Reexaminations [listed by the court, and including the '1497 *inter partes* reexamination proceeding] was raised by HTC, or could have been raised by HTC, in this suit". Thus, element 4 has been shown to be satisfied.

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

Inter partes reexamination proceeding control no. 95/001,497 (the '1497 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/001,497, 95/000,586 and 95/001,482.

Inter partes reexamination proceeding control no. 95/001,497 (the '1497 proceeding) is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,586 and 95/001,482 **will continue**.[2] Any rejection proposed by HTC (the requester of the '1497 proceeding) which has been adopted and applied by the examiner in an Office action in the merged proceeding, will remain in the merged proceeding. An examiner "adopts" a proposed rejection as his own. Any rejection proposed by the requester HTC, which was adopted by the examiner, will remain in the merged proceeding as a rejection raised by the examiner, unless the examiner, during the course of the reexamination, makes a determination based on the merits that the rejection should be withdrawn. The examiner's determination, in the merged proceeding, not to adopt any rejection that was proposed solely by the requester HTC, may not be appealed or otherwise addressed by the remaining requesters of the merged proceeding. The examiner's determination, in the merged proceeding, not to adopt any rejection proposed by HTC that was

[2] As pointed out above, this decision does not address the September 30, 2011 petition to terminate the '586 proceeding which is presently pending. This petition will be addressed by a separate decision.

also *properly* proposed by one or both of the remaining requesters, may be appealed in the merged proceeding only by the requester who *properly* proposed the rejection.[3] As noted in the May 4, 2011 decision entitled "Decision, *Sua Sponte*, Merging *Inter Partes* Proceedings" (the May 4, 2011 merger decision), because the requester of the '586 proceeding did not propose any rejections of claims 21, 24-26, and 30 in its request for reexamination, the requester of the '586 proceeding has no appeal rights as to those claims as they appear in the '431 patent.

All papers filed by the patent owner and by the remaining requesters of the merged proceeding must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for *inter partes* reexamination proceeding control nos. 95/000,586 and 95/001,482, for entry into the file of each proceeding. The conduct of the merged proceeding of 95/000,586 and 95/001,482 will otherwise remain, in general, as outlined by the May 4, 2011 merger decision.

The '1497 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for conclusion of that proceeding. The CRU will mail the present decision, and process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The file will be assigned an 822 status. A copy of the PALM "Application Number Information" screen and the "Contents" screen will be printed, the printed copy will be annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy will then be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

CONCLUSION

- Patent owner's September 16, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/001,497 is **granted**.
- *Inter partes* reexamination proceeding control no. 95/001,497 (the '1497 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/001,497, 95/000,586 and 95/001,482.
- The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,586 and 95/001,482 **will continue** in the manner set forth in this decision.
- The prosecution of the '1497 *inter partes* reexamination proceeding is hereby **terminated** and will be concluded.
- The '1497 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for further processing to conclude the '1497 proceeding, as set forth in this decision.

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

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

Kenneth M. Schor

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

Kenpet9

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,482	11/11/2010	7,397,431	3008.006REX0	6101

26111 7590 12/12/2011

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

ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

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.
95/000,586	12/13/2010	7397431	3008.006REX1	5626

26111 7590 12/12/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

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HOUSTON, TX 77002

Date: MAILED
DEC 12 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001482
PATENT NO. : 7397431
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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San Diego, CA 92130-2040

Date: **MAILED**

DEC 12 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000586
PATENT NO. : 7397431
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)
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MAILED

DEC 12 2011

Novak, Druce & Quigg, LLP (For *Inter Partes* '1482 Requester)
(NDQ Reexamination Group)
1000 Louisiana Street
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Houston, TX 77002

CENTRAL REEXAMINATION U

Inter Partes Reexamination Proceeding
Control No. 95/000,586
Filed: December 13, 2010
For: U.S. Patent No.: 7,397,431

Inter Partes Reexamination Proceeding
Control No. 95/001,482
Filed: November 11, 2010
For: U.S. Patent No. 7,397,431

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

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

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

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

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

[1] In a companion decision, patent owner's September 16, 2011 petition entitled "Petition to Terminate Inter Partes Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/001,497, was granted. *Inter partes* reexamination proceeding 95/001,497 was severed from the merger of *inter partes* reexamination proceedings 95/001,497, 95/000,586 and 95/001,482, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,586 and 95/001,482.

SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,586, filed on September 30, 2011, is **dismissed**.

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

DECISION

The September 30, 2011 Petition to Terminate

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,586 (the '586 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

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

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

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

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,397,431 (the '431 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd.et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner states that "[o]n September 22, 2011 the district court . . . entered a Final Consent Judgment against Kyocera [the requester of the '586 *inter partes* reexamination proceeding] finding that Kyocera had not sustained its burden to prove the invalidity of the '431 patent's claims 1, 4, 5, 7, 8, 12-14, 17, 21, 22, 24-27 and 29-31, all of which were in-suit [*sic*]". The patent owner refers to a "Final Consent Judgment, attached as Exhibit A".

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

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

In the present petition to terminate, however, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. For example, the patent owner states that the consent judgment "constitutes a final decision under 35 U.S.C. § 317(b), requiring that the Office terminate this reexamination as to claims 1, 4, 5, 7, 8, 12, 13, 14, 17, 22, 27, 29 and 31 of the '431 patent". The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled "Factual Background" and "Legal Argument".

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

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

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

The patent owner has thus requested conflicting forms of relief. The patent owner requests the Office to base its determination whether to terminate the '586 proceeding on a consent judgment by the district court, which must be entered into the record in order to be considered, and which must be held open to inspection by the general public. The patent owner also requests the Office to expunge from the official record the only information on which the determination can be based. For this reason, no determination on the presently filed petition to terminate the '586 proceeding can be made, unless the patent owner chooses to submit the consent judgment for entry into the official record, which will be held open to the public.

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

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

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

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

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

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

The September 30, 2011 Petition to Expunge

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

The patent owner states that on September 22, 2011, the district court, in the civil action *Fractus, S.A. v. Samsung Electronics, Co., Ltd.et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.), " . . . entered a Final Consent Judgment against Kyocera [the requester of the '586 *inter partes* reexamination proceeding]", and that the "Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public" (emphasis in original). The patent owner states that the consent judgment "is being filed in support of the concurrently filed [September 30, 2011 petition to terminate]". The patent owner requests, in its petition to expunge, that the consent judgment be expunged from the record and returned to the patent owner after the Office decides the concurrently-filed petition to terminate.

However, while the patent owner states that the consent judgment was filed (presumably by the patent owner) with the district court under seal, the patent owner has not provided any evidence showing whether the consent judgment is under a protective order by the court, and if so, whether Office personnel are permitted to review the protected information under the terms of the court's protective order. Nor has the patent owner provided evidence that Kyocera, the requester of the '586 proceeding, has consented to a waiver of any protective order by the court,

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

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

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

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

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

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

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

CONCLUSION

- Patent owner's September 30, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,586 is **dismissed**.
- Patent owner's September 30, 2011 petition under 37 CFR 1.59 and 1.182 to expunge information submitted under MPEP 724.02 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day time period, the documents submitted with the September 30, 2011 petition to expunge, including the document(s) under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

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

Brian E. Hanlon
Director
Office of Patent Legal Administration

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,482	11/11/2010	7,397,431	3008.006REX0	6101

26111 7590 02/27/2012

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

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Date:

FEB 27 2012

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001482 + 95000586
PATENT NO. : 7397431
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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Inter Partes Reexamination Proceeding
Control No. 95/000,586
Filed: December 13, 2010
For: U.S. Patent No.: 7,397,431

Inter Partes Reexamination Proceeding
Control No. 95/001,482
Filed: November 11, 2010
For: U.S. Patent No. 7,397,431

DECISION DISMISSING PETITION TO TERMINATE *INTER PARTES* REEXAMINATION PROCEEDING

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

This decision also addresses the January 26, 2012 opposition paper, entitled "Third Party Requester's Opposition to Patent Owner's Petition to Terminate Pursuant to 37 C.F.R. § 1.182 &, If Necessary, § 1.183", filed by the third party requester of *inter partes* reexamination proceeding control number 95/001,482 (the '1482 requester's January 26, 2012 opposition).

Patent owner's January 11, 2012 petition to terminate, the '1482 requester's January 26, 2012 opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

[1] On December 12, 2011, the Office issued a decision granting patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/001,497. *Inter partes* reexamination proceeding 95/001,497 was severed from the merger of *inter partes* reexamination proceedings 95/001,497, 95/000,586 and 95/001,482, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,586 and 95/001,482.

SUMMARY

Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,586 is **dismissed**.

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,586 (the '586 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

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

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

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

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,397,431 (the '431 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd.et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner also informs the Office that on September 22, 2011, the district court entered a final consent judgment against Kyocera, the requester of the '586 *inter partes* reexamination proceeding. A copy of the court's September 22, 2011 consent judgment, designated as "Exhibit A", is attached to the present petition (the September 22, 2011 consent judgment).

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

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

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

For this reason, no determination on the presently filed petition to terminate the '586 proceeding can be made. Furthermore, since no determination on the presently filed petition can be made, this decision will not address patent owner's arguments, and requester's opposing arguments, regarding whether any rejections adopted and applied by the examiner in the merged proceeding will be maintained, in the event that the '586 *inter partes* reexamination proceeding is terminated.

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

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

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

CONCLUSION

- Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,586 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day

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

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

- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.

/Cynthia L. Nessler/
Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,483	11/11/2010	7,394,432	3008.007REX0	6128

26111 7590 02/16/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

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HOUSTON, TX 77002

Date:

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FEB 16 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001483
PATENT NO. : 7394432
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. (For patent owner)
1100 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

MAILED

FEB 16 2011

CENTRAL REEXAMINATION UNIT

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

In re Puente Baliarda *et al.*
Inter Partes Reexamination
Control No. 95/001,483
Filed: October 1, 2010
For: U.S. Patent No. 7,394,432

: DECISION
: DISMISSING
: PETITION

This is a decision on patent owner's January 12, 2011 petition entitled "PATENT OWNER PETITION UNDER 37 C.F.R. § 1.182 TO TEMPORARILY SUSPEND REEXAMINATION PROCEEDINGS PENDING DECISION ON MERGER."

The petition is before the Office of Patent Legal Administration (OPLA) for decision.

The petition is dismissed for the reasons set forth below.

REVIEW OF FACTS

1. On July 1, 2008, the Office issued U.S. Patent No. 7,394,432 (the '432 patent) to Puente Baliarda *et al.*

2. On November 11, 2010, a first request for *inter partes* reexamination of claims 1-3 and 6 of the '432 patent, assigned control No. 95/001,483 ("the '1483 proceeding"), was filed by a third party requester on behalf of real party in interest Samsung Electronics Co., Ltd. ("the '1483 requester").

3. On November 12, 2010, a second request for *inter partes* reexamination of claims 1-3 and 6 of the '432 patent, assigned control No. 95/000,588 ("the '588 proceeding"), was filed by a third party requester on behalf of real party in interest Kyocera Communications, Inc. ("the '588 requester").

4. On December 3, 2010, a third request for *inter partes* reexamination of claims 1-3 and 6 of the '432 patent, assigned control No. 95/001,500 ("the '1500 proceeding"), was filed by a third party requester on behalf of real party in interest HTC Corp. and HTC America, Inc. ("the '1500 requester").

5. On December 14, 2010, *inter partes* reexamination was ordered on claims 1-3 and 6 of the '432 patent in the '1483 proceeding. An Office action was not concurrently issued. The order indicated that an Office action would issue in due course.

6. On January 20, 2011, two orders for *inter partes* reexamination of claims 1-3 and 6 of the '432 patent were issued, for the '588 and '1500 proceedings, respectively. An Office action was not concurrently issued in either proceeding. The orders stated that Office actions would issue in due course.

7. On January 21, 2011, patent owner filed the present petition requesting suspension of reexamination until a merger decision has issued regarding the '1483 proceeding and the '588 and 1500 proceedings.

8. To date, no Office action has issued in the three *inter partes* reexamination proceeding ordered for the '432 patent.

DECISION

Patent owner's January 21, 2011 petition is dismissed. Initially, it is to be noted that, once all proceedings are ordered, the proceedings are ripe for consideration of whether or not to merge proceedings, and the Office's decision on whether or not to merge is within the sole discretion of the Office. [1] In this instance, as all of the reexamination proceedings have been ordered, a determination will be made in due course as to whether or not the Office will exercise its sole discretion to merge for the present situation.[2] In addition, should a decision be made to merge, procedures are in place to accommodate the merging of proceedings where an outstanding Office action exists.[3] Accordingly, there is no basis to suspend proceedings in this instance.

CONCLUSION

1. Patent owner's January 21, 2011 petition is dismissed.

2. Any questions concerning this communication should be directed to Joseph F. Weiss in the Office of Patent Legal Administration, at (571) 272-7759.

Kenneth M. Schor

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

Kenpet8/stay_supend... 2-15-11

[1] MPEP 2686.01 I
[2] MPEP 2686.01 III
[3] Id.

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,483	11/11/2010	7,394,432	3008.007REX0	6128

26111 7590 03/17/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/17/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

MAR 17 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001483
PATENT NO. : 7394432
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

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,588	12/13/2010	7394432	3008.007REX1	3628

26111 7590 03/17/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/17/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MORRISSON & FOESTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2050

Date:

MAILED

MAR 17 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000588
PATENT NO. : 7394432
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.
95/001,500	12/03/2010	7394432	3008.007REX2	7084

26111 7590 03/17/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/17/2011

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

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Commissioner for Patents
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P.O.Box 1450
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BAKER BOTTS L.L.P.
PATENT DEPARTMENT
98 SAN JACINTO BLVD., SUITE 1500
AUSTIN, TX 78701-4039

Date:

MAILED

MAR 17 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001500
PATENT NO. : 7394432
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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MAR 17 2011

CENTRAL REEXAMINATION UNIT

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

NOVAK DRUCE & QUIGG, LLP (For first *Inter Partes* Requester)
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

MORRISON & FOERSTER LLP (For second *Inter Partes* Requester)
1253 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

BAKER BOTTS L.L.P. (For third *Inter Partes* Requester)
PATENT DEPARTMENT
98 SAN JACINTO BLVD., SUITE 1500
AUSTIN, TX 78701-4039

Inter Partes Reexamination Proceeding Control No. 95/001,483 Filed: November 11, 2010 For: U.S. Patent No. 7,394,432	
Inter Partes Reexamination Proceeding Control No. 95/000,588 Filed: December 13, 2010 For: U.S. Patent No. 7,394,432	**DECISION,** ***SUA SPONTE,*** **TO MERGE** **REEXAMINATION** **PROCEEDINGS**
Inter Partes Reexamination Proceeding Control No. 95/001,500 Filed: December 3, 2010 For: U.S. Patent No. 7,394,432	

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

REVIEW OF RELEVANT FACTS

1. On July 1, 2008, the Office issued U.S. Patent No. 7,394,432 (the '432 patent) to Carlos Puente Baliarda *et al.* with 6 claims.

2. On November 11, 2010, a first request for *inter partes* reexamination of claims 1-3 and 6 of the '432 patent, assigned control No. 95/001,483 ("the '1483 proceeding"), was filed by a third party requester on behalf of real party in interest Samsung Electronics Co., Ltd. ("the '1483 requester").

3. On November 12, 2010, a second request for *inter partes* reexamination of claims 1-3 and 6 of the '432 patent, assigned control No. 95/000,588 ("the '588 proceeding"), was initially deposited by a third party requester real party in interest Kyocera Communications, Inc. ("the '588 requester"), and a corrected request was filed on December 13, 2010.

4. On December 3, 2010, a third request for *inter partes* reexamination of claims 1-3 and 6 of the '432 patent, assigned control No. 95/001,500 ("the '1500 proceeding"), was filed by a third party requester on behalf of real party in interest HTC Corp. and HTC America, Inc. ("the ' 1500 requester").

5. On December 14, 2010, *inter partes* reexamination was ordered on claims 1-3 and 6 of the '432 patent in the '1483 proceeding.

6. On January 20, 2011, two orders for *inter partes* reexamination of claims 1-3 and 6 of the '432 patent were issued, for the '588 and '1500 proceedings, respectively.

7. To date, no Office action has issued in any of the three *inter partes* reexamination proceedings ordered for the '432 patent.

DECISION

I. MERGER OF PROCEEDINGS

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

The 95/000,588, 95/001,483 and 95/001,500 *inter partes* proceedings <u>are merged</u>. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

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

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2).[1] First, an *inter partes* requester's right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requester's right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requesters' comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

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

2. Appeal Rights:

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

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

---

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

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

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

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

C. Papers mailed/filed:

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

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

by Mail to: Attn: Mail Stop "*Inter Partes* Reexam"
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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

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

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

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

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

D. Amendments:

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

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

E. Fees:

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

F. Citation of Patents and Printed Publications:

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

G. Appeal Procedure Reminders for *Inter Partes* Reexamination

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

rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 CFR 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 CFR 41.67(c)(1)(vi))

CONCLUSION

1. *Inter partes* Reexamination Control Nos. 95/000,588, 95/001,483 and 95/001,500 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above in Part III of this decision.

2. Any questions concerning this communication should be directed to Susy Tsang-Foster, Legal Advisor, at 571-272-7711.

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

March 17, 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.
95/001,483	11/11/2010	7,394,432	3008.007REX0	6128

26111 7590 05/11/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/11/2011

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
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:
MAILED
MAY 1 1 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001483
PATENT NO. : 7394432
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

Decision on Petition for Extension of Time in Reexamination	Control No.: 95/000,588 & 95/001,483 & 95/001,500

MAILED

MAY 1 1 2011

CENTRAL REEXAMINATION UNIT

1. THIS IS A DECISION ON THE PETITION FILED 04 May 2011.

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

   The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS

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

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

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

5. CONCLUSION

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

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

In support of a factual accounting of reasonably diligent behavior of what action the patent owner has taken to date to provide a response.

In consideration of providing the patent owner with a fair opportunity to present an argument against any attack on the patent as balanced with the statutory mandate of conducting reexamination proceedings with special dispatch. This is the first request for extension of time in this proceeding. While the petition speaks to the considerations of the length and complexity of the Office action and speed at which Office action was prepared. The petitioner also noted other proceedings for which reexamination was granted It is agreed that patent owner needs to be given opportunity to complete all aspects of investigation prior to responding to the first Office action on the merits in a reexamination proceeding. This is why, absent litigation stayed for reexamination all patent owners are given a response period of two months for preparation of a response. Yet it is Patent owner who must exercise diligence in responding to an outstanding office action. The requirement for reasonably diligent behavior by patent owner includes a reasonable expectation of resource management. Resource management takes into consideration other proceedings before the Office. The petition identifying other concurrent proceedings is noted but is not germane to the issues under consideration as to "sufficient cause" for granting an extension of time. Additionally, the speed at which the Office action was prepared is required to meet the requirements of "special dispatch." All of that said, the length and complexity of the Office action does warrant consideration.

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

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

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

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SEP 20 2011

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding :
Control No. 95/001,483 :
Filed: November 11, 2010 :
For: U.S. Patent No. 7,394,432 :
:
Inter Partes Reexamination Proceeding : **DECISION**
Control No. 95/001,500 : **GRANTING**
Filed: December 3, 2010 : **PETITIONS**
For: U.S. Patent No. 7,394,432 :
:
Inter Partes Reexamination Proceeding :
Control No. 95/000,588 :
Filed: December 13, 2010 :
For: U.S. Patent No. 7,394,432 :

This is a decision on the following petitions:

1. Patent owner paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on July 7, 2011.

2. The '1483 requester paper entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)," filed on August 8, 2011.

Both petitions are before the Office of Patent Legal Administration for consideration.

Both petitions under 37 CFR 1.183 are granted for the reasons set forth herein.

BACKGROUND

1. On July 1, 2008, United States Patent No. 7,394,432 (the '432 patent) issued to Baliarda et al.

2. On November 11, 2010, a first request for *inter partes* reexamination of the '432 patent was filed by a third party requester (the '1483 requester), which request was assigned Reexamination Control No. 95/001,483 (the '1483 proceeding).

3. On November 12, 2010, a second request for *inter partes* reexamination of the '432 patent, assigned Reexamination Control No. 95/000,588 (the '0588 proceeding), was initially deposited by a third party requester (the '0588 requester), and a corrected request was filed on December 13, 2010.

4. On December 3, 2010, a third request for *inter partes* reexamination of the '432 patent was filed by a third party requester (the '1500 requester), which request was assigned Reexamination Control No. 95/001,500 (the '1500 proceeding).

5. On December 14, 2010, the Office ordered reexamination in the '1483 proceeding.

6. On January 20, 2011, the Office ordered reexamination in the '0588 and '1500 proceedings.

7. On March 17, 2011, the Office issued a decision merging, *sua sponte*, the '1483, '1500 and '0588 proceedings (the merged proceeding).

8. On April 7, 2011, the Office issued a non-final action in the merged proceeding.

9. On July 7, 2011, the patent owner filed a response in the merged proceeding, concurrently with the instant petition entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION" (patent owner petition under 37 CFR 1.183).[1]

10. On August 8, 2011, the '1483 requester filed comments, concurrently with the instant petition entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)" ('1483 requestor petition under 37 CFR 1.183).

[1] On May 11, 2011, the Office mailed a decision granting patent owner's May 4, 2011 request for extension of time, extending the time period for patent owner's response by 1 month to July 7, 2011.

DECISION

I. 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(b) provides:

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

II. Petitions Under 37 CFR 1.183

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological** facts, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide

a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count

A. Patent Owner Petition Under 37 CFR 1.183

On July 7, 2011, patent owner filed the instant petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its July 7, 2011 response submission. In support of its request for waiver of the rule, patent owner "asserts that justice would be served by granting waiver of the 50-page limit, because the full length of the Response is needed to fully and adequately respond to the Office Action."[2] Further, patent owner asserts:

> This reexamination proceeding represents the merger of three *Inter Partes* reexaminations. Thus, the Office Action is based on the combination of three *Inter Partes* reexamination requests and grants. Specifically, the Office Action includes 20 separate grounds of rejection over 13 separate references. . . . While the pending Office action constitutes only 13 pages, it incorporates by reference over 500 pages of argument and detailed claim charts set forth by the three third party requesters in their requests for reexamination. It would be unjust to hold the Patent Owner to only 50 pages to respond to what is essentially three Office Actions, particularly given the size and complexity of the three *Inter Partes* reexamination requests upon which they are based."[3]

In addition to stating that the response satisfies the formatting requirements for a grantable petition under 37 CFR 1.183, patent owner asserts that it has "made a good faith effort to comply with the 50-page limit, making efforts to economize, avoid extraneous material and information already of record, and present arguments efficiently . . . . Despite these efforts, the argument portion of the Response exceeds the 50-page limit."[4]

Patent owner's July 7, 2011 response submission includes: (1) a remarks portion, (2) an 11-page declaration entitled "Declaration of Dr. Carles Puente Under 37 C.F.R. § 1.132", (3) a 15-page declaration entitled "Declaration of Dr. Carles Puente Under 37 C.F.R. § 1.132 Relating to Fractal and Multilevel Antennas", (4) a 9-page declaration entitled "Declaration of Drs. Carles Puente, Carmen Borja, Jaume Anguera, and Jordi Soler Under 37 C.F.R. § 1.132", (5) a 9-page declaration entitled "Declaration of Ruben Bonet Under 37 C.F.R. § 1.132", and (6) a 36-page declaration entitled "Declaration of Dr. Raj Mittra Under 37 C.F.R. § 1.132" (the Mittra declaration). In view of the guidance set forth herein, portions of the 36-page Mittra declaration are deemed to include an extension of arguments of counsel. Thus, the Mittra declaration is subject to the 50-page length requirement, in addition to 96 pages of the remarks portion[5] such

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[2] *See* patent owner petition at page 2.
[3] *See id.* at pages 2-3.
[4] *See id.*
[5] The cover page is excluded from the page count, as is the listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count.

that patent owner's July 7, 2011 response submission exceeds the regulatory page limit by up to 82 pages.

Based on the individual facts and circumstances of this case such as, for example, the size of the April 7, 2011 Office action, including the incorporation by reference of pages from multiple requests for reexamination in the merged proceeding,[6] it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that patent owner's response submission exceeds 50 pages. Accordingly, patent owner's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's July 7, 2011 response submission to exceed the regulatory page limit by up to 82 pages. This waiver makes patent owner's July 7, 2011 response submission page-length compliant.

B. The '1483 Requester's Petition Under 37 CFR 1.183

On August 8, 2011, the '1483 requester filed the instant petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its August 8, 2011 comments submission. The '1483 requester asserts that the August 8, 2011 comments submission includes "70 pages of double spaced 12 pt font arguments and a 11 page declaration from Dr. Balanis under 37 C.F.R. § 1.132."[7] The '1483 requester asserts, however, that "[i]f the Office agrees with [patent owner's] interpretation of MPEP § 2667(I)(A)(2), then Samsung's Comments are only 70 pages as Dr. Balanis's declaration discusses how one of ordinary skill in the art would understand the disclosure of the prior art at issue" such that no waiver would be needed.[8]

In support of its request for waiver of the rule, the '1483 requester asserts:

> Samsung has attempted to respond in as little a number of pages as possible but was unable to do so within the 50 page limit. The additional pages requested in this petition are necessary to provide a reply the all of the issues raised by the Patent Owner's 176 page response.
>
> Importantly, this waiver would not go beyond the 1:1 ratio proscribed [sic] for Patent Owner and Requester responses to Office Actions recited in 37 C.F.R. §

[6] *See* April 7, 2011 Office action which, on its face, spans only 11 pages in length but relies heavily on incorporation by reference of more than 500 pages from multiple requests for *inter partes* reexamination in the merged proceeding.

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

[8] *Id.* at page 4. The '1483 requester is cautioned that statements submitted in opposition to patent owner's petition under 37 CFR 1.183 are improper and may result in the requester's petition paper being returned and not considered, as set forth in 37 CFR 1.939(a). For example, on page 3 of the third party requester petition under 37 CFR 1.183, the '1483 requester presents arguments against patent owner's position set forth in patent owner's petition under 37 CFR 1.183. Pursuant to MPEP 2667(I)(B)(4), a requester does not have a statutory right to challenge this discretionary procedural process (*i.e.*, waiver of the regulatory page limit) in the reexamination proceeding. Pursuant to 35 U.S.C. § 314(b)(2), the third party requester in an ordered *inter partes* reexamination proceeding has a statutory right to once file written comments to a patent owner's response to an Office action on the merits. Patent owner's petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) for patent owner's response submission, however, is not a "response" to an Office action on the merits. Thus, in this instance, 35 U.S.C. § 314(b)(2) does not provide any right for the third party requester to file comments on a patent owner's petition under 37 CFR 1.183 for suspension of the rules. Accordingly, any future petition that contains such arguments will be treated as an improper opposition paper and, as such, will be returned by marking the paper "closed" and "not public" in the IFW for the proceeding and will not be considered. Thus, any reply that exceeds the regulatory page limit which accompanies such petition would be found not page-length compliant.

> 1.943(b). In fact, the Requester is asking for significantly fewer total pages that the Patent Owner has submitted (176 total pages for the Patent Owner while Requester is only asking for a total of 81 pages). Therefore in the interest of justice, the Office should grant this petition so that the Requester is able to provide the Office with a rebuttal of all the arguments raised by the Patent Owner.[9]

The '1483 requester's August 8, 2011 comments submission includes: (1) a remarks portion and (2) an 11-page declaration entitled "DECLARATION OF DR. CONSTANTINE A. BALANIS" (the Balanis declaration), and (3) additional reference materials. In view of the guidance set forth herein, portions of the 11-page Balanis declaration are deemed to include an extension of arguments of counsel. Thus, the 11-page Balanis declaration is subject to the 50-page length requirement, in addition to 70 pages of the remarks portion[10] such that the '1483 requester's August 8, 2011 comments submission exceeds the regulatory page limit by up to 31 pages.

Based on the specific facts set forth in the '1483 requester's petition under 37 CFR 1.183, the '1483 requester's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a comments submission in compliance with the 50-page limit and submitting the resulting comments submission (which is in excess of 50 pages), and the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that the '1483 requester's August 8, 2011 comments submission exceeds 50 pages. Accordingly, '1483 requestor's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting '1483 requester's comments submission to exceed the page limit by 31 pages. This waiver makes the '1483 requester's August 8, 2011 comments submission page-length compliant.

III. Time Period for Submission of the '1500 and '0588 Requesters' Comments

The '1500 and '0588 requesters have **30 days from the mailing date of this decision**, granting patent owner's petition under 37 CFR 1.183 and making patent owner's July 7, 2011 response submission page-length compliant, **to file a comments paper pursuant to 37 CFR 1.947**. It is noted that any petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) deemed necessary should accompany the comments submission. Further, to obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a requester comments submission that:

1) is one-and-a-half or double-spaced;[11]
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

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[9] *Id.* at page 2. It is noted, however, as set forth in section I(A) above, patent owner's July 7, 2011 response submission has been determined to include up to 132 pages that count toward the regulatory page limit.
[10] The cover page is excluded from the page count, as is the table of contents pages.
[11] Claim charts applying the art to the claims are permitted to be single-spaced so long as the charts have sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.

5) has sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.

See, generally, 37 CFR 1.943(a) and 37 CFR 1.52. Adherence to such formatting guidelines enables the Office to more accurately and uniformly determine the number of pages of a requester comments submission that the Office must review, analyze, and address to the extent needed. Attached reference materials, such as prior art references, are not subject to these formatting guidelines, as such papers are expressly excluded from the regulatory page limit count under 37 CFR 1.943(b).

CONCLUSION

1. Patent owner's July 7, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's response submission to exceed the regulatory page limit by up to 82 pages. This waiver makes patent owner's July 7, 2011 response submission page-length compliant.

2. The '1483 requester's August 8, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting the '1483 requester's comments submission to exceed the regulatory page limit by up to 31 pages. This waiver makes '1483 requester's August 8, 2011 comments submission page-length compliant.

3. The '1500 and '0588 requesters have 30 days from the mailing date of this decision, granting patent owner's petition under 37 CFR 1.183 and making patent owner's July 7, 2011 response submission page-length compliant, to file a comments paper pursuant to 37 CFR 1.947.

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

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

09-19-2011

United States Patent and Trademark Office

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Inter Partes Reexamination Proceeding
Control No. 95/000,588
Filed: December 13, 2010
For: U.S. Patent No.: 7,394,432

Inter Partes Reexamination Proceeding
Control No. 95/001,500
Filed: December 03, 2010
For: U.S. Patent No. 7,394,432

Inter Partes Reexamination Proceeding
Control No: 95/001,483
Filed: November 11, 2010
For: U.S. Patent No. 7,394,432

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

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

Patent owner's petition to terminate filed on September 16, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/001,500, filed on September 16, 2011, is **granted**.

Inter partes reexamination proceeding control number 95/001,500 is hereby **severed** from the merged proceeding of *inter partes* reexamination control numbers 95/001,500, 95/001,483 and 95/000,588.

Inter partes reexamination proceeding 95/001,500, filed on September 16, 2011, is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/001,483 and 95/000,588 **will continue** in the manner set forth in this decision.[1]

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/001,500 (the '1500 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

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

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

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

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,394,432 (the '432 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd.et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner submits a copy of a consent judgment, entered by the district court on September 15, 2011, in which the district court stated that ". . . HTC [the defendant/requester of the '1500 proceeding] has not sustained its burden of proving the invalidity of any of the above listed claims of the Patents-in-Suit" and that "[t]his Consent Judgment constitutes, for purposes of 35 U.S.C.

[1] This petition does not address the petition under 37 CFR 1.182 to terminate the '588 proceeding or the petition to expunge information submitted under MPEP § 724.02, both of which were filed on September 30, 2011. These petitions will be addressed by a separate decision.

§ 317(b), a final decision entered against HTC in a civil action arising in whole or in part under section 1338 of title 28". The "above listed claims" of one of the patents in suit, the '432 patent, which is the patent under reexamination in the '1500 proceeding, are listed in the consent judgment as claims 1-3 and 6, which are identical to the claims that were requested to be reexamined by HTC in the '1500 proceeding, and that are under reexamination in the merged proceeding. The court also stated, in the September 15, 2011 consent judgment, that "[a]ll of Fractus' claims against HTC are dismissed with prejudice. All of HTC's defenses, claims, and counterclaims of invalidity and unenforceability of each and every claim of the Patents-in-Suit [including the '432 patent] are dismissed with prejudice", and that "[t]he parties expressly waive their rights to appeal". Thus, the patent owner has provided sufficient evidence that (1) the requester HTC was a party to the litigation, (2) the district court's decision was final, and (3) the court determined that the requester/defendant HTC had not sustained its burden of proving the invalidity of the claims in suit, which are identical to the claims requested to be reexamined by requester HTC, and which are under reexamination in the merged proceeding. For these reasons, the above-described elements 1-3 have been shown to be satisfied.

Regarding element 4, the court also stated, in the September 15, 2011 consent judgment, that "[t]he prior art raised by [defendant/requester] HTC, Samsung, and Kyocera in the Reexaminations [listed by the court, and including the '1500 *inter partes* reexamination proceeding] was raised by HTC, or could have been raised by HTC, in this suit". Thus, element 4 has been shown to be satisfied.

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

Inter partes reexamination proceeding control no. 95/001,500 (the '1500 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/001,500 , 95/001,483 and 95/000,588.

Inter partes reexamination proceeding control no. 95/001,500 (the '1500 proceeding) is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/001,483 and 95/000,588 **will continue**.[2] Any rejection proposed by HTC (the requester of the '1500 proceeding) which has been adopted and applied by the examiner in an Office action in the merged proceeding, will remain in the merged proceeding. An examiner "adopts" a proposed rejection as his own. Any rejection proposed by the requester HTC, which was adopted by the examiner, will remain in the merged proceeding as a rejection raised by the examiner, unless the examiner, during the course of the reexamination, makes a determination based on the merits that the rejection should be withdrawn. The examiner's determination, in the merged proceeding, not to adopt any rejection that was proposed solely by the requester HTC, may not be appealed or otherwise addressed by the remaining requesters of the merged proceeding. The examiner's determination, in the merged proceeding, not to adopt any rejection proposed by HTC that was

[2] As pointed out above, this decision does not address the September 30, 2011 petition to terminate the '588 proceeding which is presently pending. This petition will be addressed by a separate decision.

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

All papers filed by the patent owner and by the remaining requesters of the merged proceeding must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for *inter partes* reexamination proceeding control nos. 95/001,483 and 95/000,588, for entry into the file of each proceeding. The conduct of the merged proceeding of 95/001,483 and 95/000,588 will otherwise remain, in general, as outlined by the decision, mailed on March 17, 2011, entitled "Decision, *Sua Sponte*, Merging *Inter Partes* Proceedings".

The '1500 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for conclusion of that proceeding. The CRU will mail the present decision, and process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The file will be assigned an 822 status. A copy of the PALM "Application Number Information" screen and the "Contents" screen will be printed, the printed copy will be annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy will then be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

CONCLUSION

- Patent owner's September 16, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/001,500 is **granted**.
- *Inter partes* reexamination proceeding control no. 95/001,500 (the '1500 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/001,500, 95/001,483 and 95/000,588.
- The merged proceeding of *inter partes* reexamination proceeding control numbers 95/001,483 and 95/000,588 **will continue** in the manner set forth in this decision.
- The prosecution of the '1500 *inter partes* reexamination proceeding is hereby **terminated** and will be concluded.
- The '1500 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for further processing to conclude the '1500 proceeding, as set forth in this decision.

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

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

Kenneth M. Schor

Kenneth M. Schor
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,483	11/11/2010	7,394,432	3008.007REX0	6128

26111 7590 12/12/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/12/2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,588	12/13/2010	7394432	3008.007REX1	3628

26111 7590 12/12/2011

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Date: DEC 12 2011

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000588
PATENT NO. : 7394432
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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Date: MAILED

DEC 12 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001483
PATENT NO. : 7394432
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

DEC 12 2011

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(For *Inter Partes* '1483 Requester)

Inter Partes Reexamination Proceeding
Control No. 95/000,588
Filed: December 13, 2010
For: U.S. Patent No.: 7,394,432

Inter Partes Reexamination Proceeding
Control No. 95/001,483
Filed: November 11, 2010
For: U.S. Patent No. 7,394,432

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

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

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

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

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

[1] In a companion decision, patent owner's September 16, 2011 petition entitled "Petition to Terminate Inter Partes Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/001,500, was granted. *Inter partes* reexamination proceeding 95/001,500 was severed from the merger of *inter partes* reexamination proceedings 95/001,500, 95/000,588 and 95/001,483, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,588 and 95/001,483.

SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,588, filed on September 30, 2011, is **dismissed**.

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

DECISION

The September 30, 2011 Petition to Terminate

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,588 (the '588 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

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

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

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

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,394,432 (the '432 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd.et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner states that "[o]n September 22, 2011 the district court . . . entered a Final Consent Judgment against Kyocera [the requester of the '588 *inter partes* reexamination proceeding] finding that Kyocera had not sustained its burden to prove the invalidity of the '432 patent's claims 1, 2, 3 and 6, all of which were in-suit [*sic*]". The patent owner refers to a "Final Consent Judgment, attached as Exhibit A".

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

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

In the present petition to terminate, however, the consent judgment is the sole basis on which the patent owner relies to show that the provisions of 35 U.S.C. 317(b) have been met. For example, the patent owner states that the consent judgment "constitutes a final decision under 35 U.S.C. § 317(b), requiring that the Office terminate this reexamination as to [the above-listed claims] of the '432 patent". The patent owner further relies on the consent judgment throughout the present petition by either quoting or making reference to the consent judgment. See, for example, the sections entitled "Factual Background" and "Legal Argument".

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

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

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

The patent owner has thus requested conflicting forms of relief. The patent owner requests the Office to base its determination whether to terminate the '588 proceeding on a consent judgment by the district court, which must be entered into the record in order to be considered, and which must be held open to inspection by the general public. The patent owner also requests the Office to expunge from the official record the only information on which the determination can be based. For this reason, no determination on the presently filed petition to terminate the '588 proceeding can be made, unless the patent owner chooses to submit the consent judgment for entry into the official record, which will be held open to the public.

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

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

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

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

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

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

The September 30, 2011 Petition to Expunge

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

The patent owner states that on September 22, 2011, the district court, in the civil action *Fractus, S.A. v. Samsung Electronics, Co., Ltd.et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.), " . . . entered a Final Consent Judgment against Kyocera [the requester of the '588 *inter partes* reexamination proceeding]", and that the "Final Consent Judgment was filed with the district court . . . UNDER SEAL, and therefore has not been made public" (emphasis in original). The patent owner states that the consent judgment "is being filed in support of the concurrently filed [September 30, 2011 petition to terminate]". The patent owner requests, in its petition to expunge, that the consent judgment be expunged from the record and returned to the patent owner after the Office decides the concurrently-filed petition to terminate.

However, while the patent owner states that the consent judgment was filed (presumably by the patent owner) with the district court under seal, the patent owner has not provided any evidence showing whether the consent judgment is under a protective order by the court, and if so, whether Office personnel are permitted to review the protected information under the terms of the court's protective order. Nor has the patent owner provided evidence that Kyocera, the requester of the '588 proceeding, has consented to a waiver of any protective order by the court,

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

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

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

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

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

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

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

CONCLUSION

- Patent owner's September 30, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,588 is **dismissed**.

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

- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day time period, the documents submitted with the September 30, 2011 petition to expunge, including the document(s) under seal and the document entitled "Transmittal Letter to Accompany Information Submitted Under MPEP § 724.02", will be discarded unless the patent owner makes arrangements within the thirty-day period to retrieve them.

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

Brian E. Hanlon

Brian E. Hanlon
Director
Office of Patent Legal Administration

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,483	11/11/2010	7,394,432	3008.007REX0	6128

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FEB 27
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001483 + 95000588
PATENT NO. : 7394432
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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Inter Partes Reexamination Proceeding
Control No. 95/000,588
Filed: December 13, 2010
For: U.S. Patent No.: 7,394,432

Inter Partes Reexamination Proceeding
Control No. 95/001,483
Filed: November 11, 2010
For: U.S. Patent No. 7,394,432

DECISION DISMISSING PETITION TO TERMINATE *INTER PARTES* REEXAMINATION PROCEEDING

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

This decision also addresses the January 26, 2012 opposition paper, entitled "Third Party Requester's Opposition to Patent Owner's Petition to Terminate Pursuant to 37 C.F.R. § 1.182 &, If Necessary, § 1.183", filed by the third party requester of *inter partes* reexamination proceeding control number 95/001,483 (the '1483 requester's January 26, 2012 opposition).

Patent owner's January 11, 2012 petition to terminate, the '1483 requester's January 26, 2012 opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

[1] On December 12, 2011, the Office issued a decision granting patent owner's September 16, 2011 petition entitled "Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317(b) and 37 CFR §§ 1.907(b) & 1.182", requesting termination of *inter partes* reexamination proceeding 95/001,500. *Inter partes* reexamination proceeding 95/001,500 was severed from the merger of *inter partes* reexamination proceedings 95/001,500, 95/000,588 and 95/001,483, which resulted in the present merged proceeding of *inter partes* reexamination control numbers 95/000,588 and 95/001,483.

SUMMARY

Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/000,588 is **dismissed**.

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,588 (the '588 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

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

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

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

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,394,432 (the '432 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd.et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner also informs the Office that on September 22, 2011, the district court entered a final consent judgment against Kyocera, the requester of the '588 *inter partes* reexamination proceeding. A copy of the court's September 22, 2011 consent judgment, designated as "Exhibit A", is attached to the present petition (the September 22, 2011 consent judgment).

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

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

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

For this reason, no determination on the presently filed petition to terminate the '588 proceeding can be made. Furthermore, since no determination on the presently filed petition can be made, this decision will not address patent owner's arguments, and requester's opposing arguments, regarding whether any rejections adopted and applied by the examiner in the merged proceeding will be maintained, in the event that the '588 *inter partes* reexamination proceeding is terminated.

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

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

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

CONCLUSION

- Patent owner's January 11, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,588 is **dismissed**.
- Any response to this decision must be filed **within thirty (30) days** of the mail date of this decision. If a timely response to this decision is not received within the thirty-day

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

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

- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.

/Cynthia L. Nessler/
Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

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26111 7590 03/05/2012

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/05/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date: MAILED
MAR 05 2012
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001483 + 95000588
PATENT NO. : 7394432
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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MAR 05 2012

CENTRAL REEXAMINATION UNIT

Robert Greene Sterne STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVE., NW WASHINGTON, DC 20005	:	(For Patent Owner)
MORRISON & FOERSTER, LLP 12531 HIGH BLUFF DRIVE SUITE 100 SAN DIEGO, CA 92130	:	(For '588 Third Party Requester)
NOVAK DRUCE & QUIGG, LLP (NDQ REEXAMINATION GROUP) 1000 LOUISIANA STREET 53RD FLOOR HOUSTON, TX 77002	:	(For '1483 Third Party Requester)
In re: Puente Baliarda *et al.* *Inter Partes* Reexamination Proceeding Control No.: 95/000,588 Deposited: December 13, 2010 For: U.S. Patent No.: 7,394,432	:	DECISION ON PETITION UNDER 37 CFR § 1.181
In re: Puente Baliarda *et al.* *Inter Partes* Reexamination Proceeding Control No.: 95/001,483 Deposited: November 11, 2010 For: U.S. Patent No.: 7,394,432	:	

This is a decision on a petition filed by the patent owner on January 4, 2012 entitled "Petition Under 37 C.F.R. § 1.181 for Reopening of Prosecution" [hereinafter "petition"] and is a request that the Action Closing Prosecution be withdrawn and that the Office issue a new non-final action.

The petition is before the Director of the Central Reexamination Unit. Also before the Director is the opposition filed February 3, 2012.

The petition is granted.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,394,432 issued on July 1, 2008.
- Three requests for *inter partes* reexamination were filed and assigned control numbers 95/000,588, 95/001,483 and 95/001,500.
- Reexamination was ordered in each proceeding and the three were merged in a decision mailed March 17, 2011.
- Prosecution progressed until an Action Closing Prosecution was mailed November 4, 2011.
- On December 12, 2011, the Office issued a decision terminating 95/001,500 and severing it from the merged proceeding. 95/000,588 and 95/001,483 remain merged.
- On January 4, 2012, the patent owner filed the instant petition with a response to the ACP.
- On February 3, 2012, the third party filed an opposition to the petition.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.949 Examiner's Office action closing prosecution in *inter partes* reexamination

Upon consideration of the issues a second or subsequent time, or upon a determination of patentability of all claims, the examiner shall issue an Office action treating all claims present in the *inter partes* reexamination, which may be an action closing prosecution. The Office action shall set forth all rejections and determinations not to make a proposed rejection, and the grounds therefor. An Office action will not usually close prosecution if it includes a new ground of rejection which was not previously addressed by the patent owner, unless the new ground was necessitated by an amendment.

DECISION

Patent owner claims that the Action Closing Prosecution was improper because it included new grounds of rejection that were not necessitated by amendment. In the first Office action mailed April 7, 2011, the examiner rejected claim 1 as anticipated by Serizawa, but did not reject claims 2, 3 and 6 under that ground. The patent owner, in response, did not amend the claims. In the ACP, the examiner again rejected claim 1 as anticipated by Serizawa, but additionally rejected claims 2, 3 and 6 under that ground. This rejection of claims 2, 3 and 6 as anticipated by Serizawa was a new ground of rejection that was not necessitated by amendment. Accordingly, the action should not have been an ACP and the petition is granted. The ACP is withdrawn and replaced as discussed further herein.

Relief Granted
A new ACP is issued concurrently with this decision, removing the rejection of claims 2, 3 and 6 as anticipated by Serizawa.

Patent owner urges that the ACP should be replaced with a non-final Office action, or that the ACP be reissued and patent owner's previous response should be expunged from the record. The third party in the opposition argued that, if the new rejections were withdrawn, the Office may issue a Right of Appeal Notice. The Director disagrees with both parties.

Patent owner's argument that a new non-final action issue was apparently premised on the examiner maintaining the new rejections. As those rejections are not maintained, the argument is unpersuasive. The prior action otherwise contained no defect that would prevent an ACP, therefore there is no reason to issue a new non-final action.

The argument that the prior response be expunged is not persuasive. The Director is mindful that a patent owner may not wish to have a detailed prosecution history for tactical litigation purposes, but frankly this is incidental to the examination process and is not the Office's concern. Rejections are applied during prosecution and later withdrawn for various reasons. Rarely, if ever, does the Office fully expunge from the record an Office action and a patent owner's/applicant's response, and there is no reason for the Office to depart from this longstanding practice in this case. This is particularly so where the patent owner points merely to some hypothetical, as yet unrealized, prejudice and not any actual prejudice that occurred. The Office trusts that the courts can manage any such potential prejudice should the issue become important in litigation. In any event, the use of prosecution history during litigation has the general purpose of informing the proper meaning of the claims. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed. Cir. 2005) (en banc). It is not used as some sort of "gotcha" moment intended to trick the patent owner or catch it in a trap. A patent owner's discussion of a

reference or the invention remains relevant prosecution history, even if a rejection later is withdrawn (or, even if it never should have been applied in the first place).

While it is not expunged from the record, the amendment to the claims filed January 4, 2012 is not currently entered. Given that the concurrently issued ACP will be different than the previous ACP, patent owner may wish to respond in a different way. Patent owner should have a clean slate to change its claim amendments, if it desires, in response to the new action. Accordingly, claims 1-3 remain in this proceeding for the purpose of the new ACP.

Moving on to the third party requester's arguments, the third party is incorrect that a RAN is appropriate. A RAN is not permissible until after an ACP. 37 CFR § 1.953(a). As the ACP has been withdrawn, the proceeding is not ripe for a RAN. Furthermore, while the withdrawal of this one rejection might seem relatively minor, it could potentially change the manner in which patent owner chooses to respond to the action. As described herein an ACP is appropriate, and patent owner should have the opportunity to respond under the post-ACP constraints, rather than under the post-RAN constraints, which are much more limiting. *See* 37 CFR § 1.116(b)-(f)

Accordingly, the petition is granted. The ACP issued November 4, 2011 is withdrawn, and a new ACP is issued concurrently with this decision.

CONCLUSION

1. The petition filed January 4, 2012 is granted. The Action Closing Prosecution of November 4, 2011 is withdrawn.

2. A new ACP is issued concurrently.

2. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.

Irem Yücel
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,483	11/11/2010	7,394,432	3008.007REX0	6128

26111 7590 03/23/2012

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HOUSTON, TX 77002

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001483 + 95000588
PATENT NO. : 7394432
TECHNOLOGY CENTER : 3999
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HOUSTON, TX 77002

Inter Partes Reexamination Proceeding
Control No. 95/000,588
Filed: December 13, 2010
For: U.S. Patent No. 7,394,432

Inter Partes Reexamination Proceeding
Control No. 95/001,483
Filed: November 11, 2010
For: U.S. Patent No. 7,394,432

DECISION DISMISSING PETITION UNDER 37 CFR 1.183 AS MOOT

This is a decision on patent owner's January 4, 2012 petition entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO ACTION CLOSING PROSECUTION IN REEXAMINATION" (the petition under 37 CFR 1.183), requesting waiver of the regulatory page limit for its concurrently-filed "Patent Owner's Response to the Action Closing Prosecution of November 4, 2011." The petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

In light of the decision issued by the Central Reexamination Unit (CRU) on March 5, 2012, granting patent owner's January 4, 2012 petition under 37 CFR 1.181 and withdrawing the Action Closing Prosecution issued on November 4, 2011, the instant petition under 37 CFR 1.183 is dismissed as moot. Any questions concerning this communication should be directed to Nicole D. Haines, Legal Advisor, at 571-272-7717.

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

03-21-2012

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,485	11/12/2010	7043543	57058.0148	8636

26582 7590 04/01/2011

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DENVER, CO 80201

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Edmund J. Walsh
WOLF GREENFIELD & SACKS, P.C.
600 Atlantic Avenue
Boston, MA 02210-2206

Date:

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APR 0 1 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001485
PATENT NO. : 7043543
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

Decision on Petition for Extension of Time in Reexamination	Control No.: 95/001,485

1. THIS IS A DECISION ON THE PETITION FILED March 31, 2011.

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

   The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS
   Patent owner requests that the period for responding to the Office action mailed on January 15, 2011 which sets a 2 month period for filing a response thereto, and extended by 1 month to April 15, 2011 via petition grant on February 24, 2011, be extended by an additional month or 45 days as the petition requests both.

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

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

5. CONCLUSION

   Telephone inquiries with regard to this decision should be directed to J. Harrison at 571-272-4449. In his/her absence, calls may be directed to M. Reinhart at 571-272-1611 in the Central Reexamination Unit.

/J. Harrison/	SPE AU 3992
[*Signature*]	(Title)

This is the second request for extension of time to respond to the outstanding Office action of January 15, 2011. In the petition patent owner's representative requests a additional forty-five day extension of time on page one of the petition and an additional one-month extension of time on page three of the petition in order to (i)fully investigate and consider a large volume of documents produced in concurrent litigation; (ii) await a determination of a Motion to Use Confidential Document in Reexam from the court. A one-month extension is under consideration.

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 only outlined diligent review and investigation of documents produced by the concurrent litigation as patent owner is mindful of duty of disclosure requirements in the present reexamination.

With respect to point i) the Office notes the activities described by patent owner as requiring additional time to ensure reasonable inquiry and fully investigate documents produced in concurrent litigation indeed have a bearing upon and requires mindfulness of patent owners duty of disclosure; however it is not clear from the petition how or why this large volume of documents has bearing upon the rejections faced by patent owner. The submission of documents to meet patent owners duty of disclosure are not constrained by a response period. Rather, the patent owners response to the outstanding office action is under a response period. While it is noted that patent owner is investigating whether or not prior art utilized in the adopted rejection(s) constitute prior art in fact, the petition further submits patent owner has recently learned through deposition information about the content of the switch as opposed to whether or not the reference is prior art or a printed publication. What appears at issue in the reexamination proceeding would be whether or not the reference is prior art and what the reference discloses and/or suggested to one of ordinary skill in the art at the time of the invention as opposed to what may have been utilized in practice. It is agreed that patent owner need be given opportunity to complete all aspects of investigation prior to responding to the first Office action on the merits. This is why, absent litigation stayed for reexamination, all patent owners are given a response period of two months. Here, patent owner has been granted and additional month for essentially the same reasons as are requested in the instant petition. The need for patent owner to have opportunity to respond to an office action is balanced against the statutory requirement for special dispatch in the conduct of *inter partes* reexamination proceedings. Here, the question seems to lie in the issue of resource management in preparation of the response – an issue that all patent owner's face – and not be a question of demonstrated cause which mandates the grant of additional time. Additionally it is noted that should additional information and/or evidence be uncovered and/or received at a point in time after response, the timing and manner of receipt would support a demonstration of good and sufficient reasons why the information was not earlier presented in the window of opportunity for presentation of argument/amendment/evidence between an action closing prosecution (ACP) and a right of appeal notice (RAN) in an *inter partes* proceeding.

As to points ii), a similar logic is presented. Patent owner advances he needs additional time to await court determination of the presentation of documents under protective order. Respectfully, in this limited proceeding to answer the proposed substantial new question of patentability before the USPTO, patent owner will still have opportunity to meet his duty of disclosure requirements in the future should the court rule favorably. However, only third party requester may propose new prior art/new rejections in an *inter partes* proceeding, and only then can those proposals be entered on a very limited basis. See MPEP 2665. The petition fail to demonstrate any link as to why the information subject to the protective order would have any direct bearing or impact upon patent owners ability to respond to the outstanding rejections he faces.

On balance, it does not appear patent owners reasoning as to why additional time is needed has been demonstrated. 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 <u>dismissed</u>.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,485	11/12/2010	7043543	57058.0148	8636

26582 7590 06/14/2011

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Boston, MA 02210-2206

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001485
PATENT NO. : 7043543
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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JUN 14 2011

CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

EDMUND J. WALSH
WOLF, GREENFIELD & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON, MA 02210-2206

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,485
Filed: November 12, 2010
For: U.S. Patent No. 7,043,543

DECISION DISMISSING PETITION

This is a decision on the May 10, 2011 third party requester petition paper entitled "REQUESTER'S PETITION UNDER 37 C.F.R § 1.183 FOR SUSPENSION OR WAIVER OF PAGE LIMIT REQUIREMENT."

The petition is before the Office of Patent Legal Administration for decision.

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

DECISION

In the instant petition, third party requester requests waiver of the page limit requirement of 37 CFR 1.943(b) for its comments submission filed on May 16, 2011.

On June 3, 2011, the Office mailed a "NOTICE RE DEFECTIVE PAPER IN INTER PARTES REEXAMINATION' (the notice of non-compliance), stating that patent owner's April 15, 2011 response submission, as supplemented on May 10, 2011, and on May 12, 2011, is defective and setting a time period of 15 days for patent owner to file a corrected response submission. The notice of non-compliance also states that since a proper response from the patent owner has not been made, the third party requester will have the opportunity to file new comments within 30 days of service of a corrected patent owner response submission. Pursuant to MPEP § 2667(I)(A)(2), "Any previously submitted third party comments in response to [the] 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." Accordingly, requester's May 10, 2011 petition requesting waiver of 37 CFR 1.943(b) for its May 16, 2011 comments submission is moot, and requester's May 10, 2011 petition is dismissed as moot.

CONCLUSION

1. Third party requester's May 10, 2011 petition paper entitled "REQUESTER'S PETITION UNDER 37 C.F.R § 1.183 FOR SUSPENSION OR WAIVER OF PAGE LIMIT REQUIREMENT" is dismissed as moot.

2. Telephone inquiries with regard 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

06-13-2011
Kenpet8

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95/001,485	11/12/2010	7043543	57058.0148	8636

26582 7590 07/18/2011

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In re Ewing et al	:	
Inter partes Reexamination Proceeding	:	**DECISION**
Control No: 95/001,485	:	**DISMISSING**
Filing Date: November 12, 2010	:	**PETITION**
For: U.S. Patent No.: 7,043,543	:	

This is a decision on the May 9, 2011 patent owner petition, entitled "Petition under 37 CFR § 1.182 to Suspend *Inter Partes* Reexamination Proceeding" (the May 9, 2011 patent owner petition).

This decision also addresses the opposition paper filed by the requester on May 23, 2011, entitled "Requester's Opposition to Patent Owner's Petition under 37 C.F.R. § 1.182 to Suspend *Inter Partes* Reexamination Proceeding" (the May 23 2011 requester opposition).

The May 9, 2011 patent owner petition, the May 23, 2011 requester opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The May 9, 2011 patent owner petition is **dismissed**.

DECISION

The patent owner requests the Office to suspend the present *inter partes* reexamination proceeding.

MPEP 2686.04 provides, in pertinent part (emphasis added):

> [35 U.S.C. 314(c)][1] thus authorizes the Director of the USPTO **to suspend (stay) reexamination proceedings, where there is good cause to do so**, pending the conclusion of litigation based on a potential for termination of a reexamination prosecution under 35 U.S.C. 317(b). Thus, a District Court decision that is pending appeal on the validity of the same claims considered in an *inter partes* reexamination proceeding may provide the requisite statutory "good cause" for suspension, due to the real possibility that the 35 U.S.C. 317(b) estoppel may attach in the near future to bar/terminate the reexamination proceeding.

Factors to be considered in determining whether it is appropriate to suspend action in the reexamination are:

A. Whether the third party requester is a party to the litigation;

B. Whether the claims in suit are identical to the claims under reexamination;

C. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the litigation;

D. Whether the litigation has advanced to a late enough stage that there is a sufficient probability that a final decision will be adverse to the requester; and

E. Whether there is a concurrent *ex parte* reexamination proceeding for the patent.

The patent owner, in the present petition, does not specifically address any of the above factors. This decision addresses patent owner's arguments, where possible, in light of the above-identified factors.

The patent owner, Server Technology, Inc. (STI) essentially argues that good cause exists to suspend the present proceeding because the requester, American Power Conversion Corporation (APC), is a defendant in copending litigation. While the patent owner does not, in the present petition, specifically identify the copending litigation, the requester has attached a copy of a court document which, the patent owner asserts, was filed in the copending litigation. The copending litigation, as designated in the court document, is *Server Technology, Inc. v. American Power Conversion Corporation,* Civil Action No. 3:06-CV-698-LRH-VPC, pending in the U.S. District Court for the District of Nevada (the litigation). Upon brief review of this court document, the Office confirms that the requester, APC, is a defendant in the litigation. This satisfies item A.[2]

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[1] 35 U.S.C. 314(c) provides, in pertinent part (emphasis added):

> **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.

[2] The patent owner is reminded that the patent owner has the burden of providing a sufficient showing as to the above-listed factors, including whether the requester is a defendant to the litigation. Merely stating that the requester is a defendant in the litigation is insufficient. In the present case, the Office was able to verify patent owner's

The patent owner, in the present petition, is silent with respect to element B, while the requester, in its May 23, 2011 opposition paper, asserts that not all of the claims under reexamination are the subject of the litigation. The Office confirms that claims 1-23 of U.S. Patent 7,043,543 (the '543 patent) are under reexamination in the present proceeding. The present petition, however, includes no argument with supporting evidence, such as a court document, that the claims in suit are identical to those under reexamination. Requester's opposition paper states that only claims 1, 2, 3, 6, 15, 16, and 17 of the '543 patent are the subject of the litigation, but the paper fails to include evidence to support its statement. Furthermore, after a brief review of the record of this proceeding, the Office is unable to determine which claims of the '543 patent are the subject of the litigation.

"Good cause" for suspension pending the conclusion of litigation is based on a potential for the imminent termination of reexamination prosecution under 35 U.S.C. 317(b). See MPEP 2686.04, quoted above. If a claim under reexamination is not the subject of the litigation, then the estoppel provisions of 35 U.S.C. 317(b) would not apply to the final outcome of the litigation *as to that patent claim*, because there would be no "final decision that the party has not sustained its burden of proving the invalidity" of that patent claim. Thus, there is no "potential for termination" of this reexamination proceeding as to the non-litigated claims. A suspension of the reexamination proceeding would unfairly deprive the requester of its statutory right to have the patentability issue of any claims in the reexamination proceeding that are not the subject of the litigation, and thus not potentially subject to the estoppel provisions of 35 U.S.C. 317, resolved *with special dispatch* pursuant to 35 U.S.C. 314(c), by ultimately appealing any claims found patentable and obtaining a decision on such an appeal.

For the reasons given above, the patent owner has not sufficiently shown that the claims in suit are identical to the claims under reexamination, i.e., claims 1-23 of the '543 patent. Thus, item B has not been shown to have been satisfied.[3]

Regarding element C, the patent owner presents the bald statement that the issues in the litigation "are precisely the same issues presented in this reexamination".[4] The patent owner appears to argue that "the same issues presented in this reexamination" are, broadly, the issue of whether a *prima facie* case of obviousness "exists", i.e., whether a *prima facie* case of obviousness of the claims of the '543 patent may be established. The patent owner has not provided any argument and supporting evidence, such as a court document, to show, for example, that the prior art applied in the present reexamination proceeding, as well as any other issues raised in the present reexamination proceeding, were raised or could have been raised in the litigation. Thus, element C has not been shown to have been satisfied.

Regarding element D, the patent owner argues that the proceedings in the district court have reached an advanced stage, and points to a copy of the court's scheduling order, attached to the

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assertion after brief review. However, if more than a brief review is required to determine the above factors, then the showing of the patent owner will not be sufficient.

[3] If a renewed petition is filed, the patent owner must address all of the above-identified factors, and must provide evidence, as an attachment to its petition, to support its position. See also footnote 2.

[4] Furthermore, no mention of element C is made in requester's opposition paper.

present petition as exhibit A, to support its argument. The patent owner, however, admits that trial has not yet begun, and has provided evidence which shows that trial has not begun. For this reason, the patent owner has not shown that the litigation has advanced to a late enough stage that there is a sufficient probability that a final decision will be adverse to the requester. Further, there is no district court decision adverse to requester on which to base a finding that there is a sufficient probability that the litigation will end in a manner adverse to requester. Thus, element D has not been shown to have been satisfied.

Regarding element E, the patent owner, in the present petition, is silent. In any event, however, Office records do not reveal the existence of any co-pending *ex parte* reexamination proceeding for the '543 patent. Thus, item E is satisfied.

The patent owner also admits that the litigation "is not postured the same as others such as *Sony*", i.e., *Sony Computer Entertainment America, Inc. v. Dudas*, 85 USPQ2d 1594 (E.D. Va. 2006), where the court upheld the Office's determination of "good cause" to suspend two related *inter partes* reexamination proceedings. In fact, the facts of the present case are clearly distinguishable from *Sony*. Reexamination in *Sony* was limited to the claims that were being litigated. In the present case, however, the patent owner has not presented arguments with supporting evidence to show that the claims in suit are identical to the claims under reexamination, and the requester has argued that the claims in suit are not identical. In *Sony*, the request for *inter partes* reexamination was not filed until after a final judgment in the district court was rendered. In the present case, however, the request for *inter partes* reexamination was filed well before the trial stage. Furthermore, unlike *Sony*, the Office has already issued a non-final Office action, while in *Sony*, an action on the merits had not yet issued. Also, in *Sony*, an appeal had been filed and had been fully briefed. Thus, a final decision in *Sony* was on the horizon.[5] In the present case, however, trial has not begun. In other words, the patent owner has not shown that a final decision as to *all claims under reexamination* is expected in the near future. And, without a final decision adverse to requester as to *all* claims under reexamination, no estoppel can attach as to *all* claims to mandate termination of the presently ordered reexamination proceeding. Thus, the fact that estoppel could possibly attach as to some of the claims at some uncertain point in the future, does not provide the requisite showing of good cause for suspension.

The patent owner extensively argues that good cause exists for suspension because the patent owner is prevented, by the district court's protective order, from submitting certain information in the present reexamination proceeding. The patent owner states that the information "has been elicited through deposition testimony from [witnesses for the requester in the litigation] as well as interrogatories and document production requests". In other words, the information is that of the requester.[6] The patent owner argues that the materials under protective order provide evidence of the scope and content of the prior art. Specifically, the patent owner argues that the protected materials include "testimony suggesting" that references cited as prior art before the examiner in the present reexamination proceeding were, allegedly not publicly available at the

[5] A decision is "final" after all appeals, including any appeal to the Federal Circuit, have been exhausted.
[6] The requester, in its opposition, states that the district court has denied patent owner's request, filed on an emergency basis, that the court modify its protective order to allow material from the litigation to be submitted to the Office.

time of the filing of the application which became the '543 patent. The patent owner asserts that for this reason, "the District Court is in the best position" to resolve these fact issues". The patent owner, however, may present arguments and/or other evidence in response to the first Office action regarding whether the art at issue was publicly available, i.e., evidence that is not subject to the protective order, such as, for example, evidence originating from the patent owner, not the requester. The patent owner further argues that the materials under protective order also provide evidence of the level of ordinary skill in the art, evidence of the commercial success of the alleged infringing product, and evidence of copying on the part of the requester. However, in order to rebut a *prima facie* case of obviousness of the claims of the '543 patent, the patent owner may timely submit its own secondary indicia of nonobviousness in the reexamination proceeding. For example, the patent owner may timely submit alleged evidence of the commercial success *of its own product.* Evidence of commercial success must be *directly derived from the claimed invention*, and must show that the evidence is *directly derived from the claimed features*, not the unclaimed features. Merely showing that there was commercial success of an article which embodied the invention is not sufficient. See *Ex parte Remark*, 15 USPQ2d 1498, 1502-02 (Bd. Pat. App. & Inter. 1990).[7] Alleged evidence of the commercial success of the product of an alleged infringer is, at best, of limited relevance to the issue of the commercial success of the product claimed in the patent under reexamination. A patent owner's evidence of its own commercial success is more likely to be directed to the entire scope of the patent claims at issue, and opposed to such evidence of another party which <u>might</u> be relevant only as to one product within the claim scope. The patent owner may, and has, timely filed alleged evidence of commercial success of its own product in response to the first Office action. In addition, the patent owner may, and has, timely submitted alleged evidence of copying in response to the first Office action. Thus, the patent owner has not been prevented, in the present reexamination proceeding, from filing arguments and/or alleged evidence (that is not subject to the court's protective order) regarding whether the prior art was publicly available at the time of filing the application which became the '543 patent, or regarding its opinion of the level of ordinary skill, or regarding secondary indicia of nonobviousness.

Pursuant to 35 U.S.C. § 317(b), *inter partes* reexamination of a patent and litigation as to that patent may continue side-by-side until "a final decision has been entered against a party in a civil action ... that the party has not sustained its burden of proving the invalidity of any patent claim in suit" or until "a final decision in an *inter partes* reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent." Petitioner's proposal, however, would provide for a pre-emptive termination of the *inter partes* reexamination in anticipation of the possibility that some information generated by a party in the litigation might have an impact on the patentability of claims. While the statute may allow for suspending a proceeding for "good cause," it does not permit the Office to effectively terminate any reexamination proceeding on the basis of a possibility of information generated by a party in the litigation having an impact. If an *inter partes* reexamination of a patent were to be suspended any time there was litigation as to that patent (effectively terminating the proceeding until the resolution of the litigation), Congress would have simply said so in the statute. It clearly did not.

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[7] See, generally, MPEP 716.03 *et seq.*

The standards of proof and of claim interpretation used by the Office differ from those used by the courts. See *Ethicon v. Quigg,* 849 F.2d 1422, 1428 (Fed. Cir. 1988). As pointed out in *Ethicon,* "the suspension of PTO proceedings ... precludes access to the forum where there is no presumption of validity." *Ethicon,* 849 F.2d at 1427. The logical extension of patent owner's argument, that the district court is in a better position to resolve the factual issues because of its access to protected materials, is for the Office to set aside all *inter partes* reexaminations of a patent involved in litigation, where the requester is party to the litigation, the question of obviousness has been raised, and materials have been placed under protective order by the court. This would deprive the requester of its statutory "access to the forum where there is no presumption of validity." It would eviscerate the statutory scheme of *inter partes* reexamination by refraining from carrying out the reexamination in deference to the possibility of a resolution of court proceedings favorable to one of the parties.

In summary, the patent owner has not provided a showing of good cause to suspend prosecution of the present reexamination proceeding.

Accordingly, the March 22, 2011 patent owner petition is **dismissed**. Pursuant to MPEP 2686.04, the present *inter partes* reexamination proceeding **will continue**, and **will not be suspended**.

If a renewed petition to suspend the present *inter partes* reexamination proceeding is later contemplated, the factors explained in this decision must be addressed.

The Official Correspondence Address of the Patent Owner

The address for the patent owner in a reexamination proceeding is the official correspondence address of the patent owner *in the patent file.* In the present case, the official correspondence address for the patent owner, that is of record in the patent file, application no. 12/489,174, is shown in the caption of this decision. See MPEP 2622 and 37 CFR 1.33(c).

A courtesy copy of this decision will be mailed to the practitioner who filed the present petition, Joshua Randall of Holland & Hart, LLP. **Absent the filing of a proper change of correspondence address in the patent file, which is application no. 12/489,174, however, all future correspondence will be mailed to the current address of record for the patent owner, as shown in the caption of this decision.**

CONCLUSION

- The May 9, 2011 patent owner petition is **dismissed**.
- The present *inter partes* reexamination proceeding will continue, and **will not be suspended**.
- Absent the filing of a proper change of correspondence address in the patent file, application no. 12/489,174, all future correspondence will be mailed to the current address of record for the patent owner, as shown in the caption of this decision.

- Telephone inquiries related to this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, at (571) 272-7724.

Kenneth M. Schor

Kenneth M. Schor
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Office of Patent Legal Administration

7-14-11
Kenpet8/IP/suspend

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,485	11/12/2010	7043543	57058.0148	8636

26582 7590 09/14/2011
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/14/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Date: 9-14-11

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001485
PATENT NO. : 7043543
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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CENTRAL REEXAMINATION UNIT

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Inter Partes Reexamination Proceeding
Control No. 95/001,485
Filed: November 12, 2010
For: U.S. Patent No. 7,043,543

: **DECISION**
: **GRANTING-IN-PART**
: **PETITION**
: **AND**
: **EXPUNGING**
: **IMPROPER PAPERS**

This is a decision on the third party requester's petition entitled "REQUESTER'S RENEWED PETITION UNDER 37 C.F.R. § 1.183 FOR SUSPENSION OR WAIVER OF PAGE LIMIT REQUIREMENT," filed on July 8, 2011. The petition requests waiver of the requirement of 37 CFR 1.943(b) that the written comments by third party requester not exceed fifty (50) pages in length. Subsequently, on July 20, 2011, third party requester timely filed comments under 37 CFR 1.947.

This decision also addresses the patent owner's opposition paper entitled "PATENT OWNER'S OPPOSITION TO REQUESTOR'S RENEWED PETITION UNDER 37 C.F.R. § 1.183 FOR SUSPENSION OR WAIVER OF PAGE LIMIT REQUIREMENT," filed on July 15, 2011.

The proceeding, the third party requester's petition and the patent owner's opposition paper are before the Office of Patent Legal Administration.

The third party requester's petition under 37 CFR 1.183 is dismissed to the extent of the amount of pages requested for the comments, but is granted-in-part for the reasons set forth below.

The third party requester's July 20, 2011 comments submission and the patent owner's opposition paper are improper papers and are expunged for the reasons set forth below.

DECISION

I. 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(b) provides:

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

MPEP § 2667(I), (TYPES OF PAPERS RETURNED WITH CENTRAL REEXAMINATION UNIT DIRECTOR OR REEXAMINATION LEGAL ADVISOR APPROVAL REQUIRED), provides in pertinent part:

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Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

II. Third Party Requester's July 8, 2011 Petition under 37 CFR 1.183

The instant third party requester petition requests waiver of the requirement of 37 CFR 1.943(b) that the written comments by third party requester not exceed fifty (50) pages in length. In support of its request for waiver of the rule, third party requester's principal argument is that additional pages are needed for its new claim charts, which provide detailed explanation of the grounds of rejection proposed for the 26 newly added claims that would satisfy the requirements of MPEP § 2617.[1]

[1] Petition at page 2. In the petition at page 3, requester incorrectly stated that patent owner's June 20, 2011 revised response adds 26 claims. Patent owner's revised response actually adds 27 new claims (claims 24-50).

A. Analysis and Findings

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which a requester petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a requester comments submission in compliance with the 50-page limit, and submission of a comments paper that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted comments paper. Such comments paper can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response or comments, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts,** or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see*, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

Third party requester's July 20, 2011 comments are found to consist of a 49-page comments section, 4 declarations under 37 CFR 1.132, and 9 exhibits (E1-E3, V-Z, and AA).

Exhibits E1-E3 are product information web pages that are free of legal argument and thus do not count toward the page limit.

Exhibit V is a reference and does not count toward the page limit.

Exhibits W-Z, and AA are a 149-page set of five claims charts that count toward the page limit.

The §1.132 declaration by Patrick Johnson and the §1.132 declaration by Alex North are free of legal argument and thus do not count toward the page limit.

The §1.132 declaration by Dr. Mark Horenstein is found to contain legal argumentation/conclusion, see *inter alia* the legal argument/conclusion made on page 12, paragraphs 39-40; on pages 13-14, paragraph 45; on page 14, paragraph 48; and on pages 14-15, paragraph 49. Therefore, 4 pages of the Horenstein declaration are considered part of third party requester's substantive response.

The §1.132 declaration by Douglas Bors is found to contain legal argumentation/conclusion, see *inter alia* the legal argument/conclusion made on page 8, paragraph 23, and on page 22, paragraph 68. Therefore, 2 pages of the Bors declaration are considered part of requester's substantive response.

Accordingly, the length of third party requester's substantive response, and the extent of the waiver being requested, is 204 pages.[2]

Upon review of the submitted comments for economizing, extraneous material, and arrangement, without repetition of information already of record, it is found that the 154 pages of arguments in excess of 50 required to complete the third party requester's comments are not reasonable in this instance, in view of the present facts and circumstances. Specifically, the January 15, 2011 non-final Office action is 41 pages on its face, it does not incorporate any pages from the request, and it adopts a majority of the rejections proposed in the request. Requester's July 20, 2011 comments submission pursuant to 37 CFR 1.947 responds to the patent owner's June 20, 2011 revised response made pursuant to 37 CFR 1.945(a) that does not exceed the regulatory 50 page limit.[3] Requester has not demonstrated nor asserted that a prose styled response did not substantially reduce the number of pages as compared to the chart styled response that requester opted to submit.

Based on the particular circumstances of this case, it is not equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance, to the extent requested. The total number of pages of third party requester's July 20, 2011 comments submission that counts toward the page limit is 204 pages. The granting of a waiver for 154 additional pages based upon patent owner's inclusion of 27 new claims that span only 4 pages and effectively add 6 new limitations is <u>not</u> commensurate with the requirements of justice in this situation.[4]

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[2] The sum of requester's 49-page comments section plus 4 pages of the Horenstein declaration, 2 pages of the Bors declaration and the 149 pages of claim charts.

[3] The examiner was consulted regarding patent owner's June 20, 2011 revised response, and the examiner has determined that the patent owner's June 20, 2011 revised response is within the regulatory 50-page limit.

[4] Patent owner's June 20, 2011 revised response adds new claims 24-50. The limitations added by a majority of the new claims are identical or substantially identical to the limitations in the original claims. For example, the limitation added by new claim 26 is a limitation present in original claim 2. The following lists the new claims that add limitations that correspond to those in the original claims (shown in parentheses). 26(2), 27(3), 28(5), 29(2), 31(4), 32(4), 33(8), 37(11), 38(11), 42(2), 43(2), 44(5), 45(5), 46(18), 47(18), 48(22), 49(23), and 50(22). Claims 24, 25, 30, and 34-36, 39, 40, and 41 add limitations not in the original claims. However, claims 34-36 add the same limitations and claims 40 and 41 add the same limitations. Therefore, new claims 24-50 effectively add 6 limitations that are not present in the original claims.

Thus, requester's petition under 37 CFR 1.183 is dismissed.

The page limit requirement of 37 CFR 1.943(b) is, however, waived to the extent that justice requires in this circumstance and permits third party requester's comments submission to exceed the page limit requirements by 54 pages, for a total of 104 pages. This waiver does not make third party requester's July 20, 2011 comments submission page-length compliant. Therefore, third party requester's July 20, 2011 comments submission is an improper paper and it will not be considered. The comments submission is being expunged by being closed in the present proceeding's Image File Wrapper (IFW) and marking it "not-public." The July 20, 2011 comments submission will not constitute part of the record of the present reexamination proceeding. Requester is advised that the present waiver is conditioned on the comments being at least 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.

B. Guidance for Third Party Requester

Requester's July 20, 2011 comments submission is improper and subject to return. See MPEP 2667, Part I.A.2. The copy of the July 20, 2011 comments submission however, was scanned into the electronic Image File Wrapper (IFW) of the present proceeding, before discovery of the impropriety. Thus, the comments submission cannot be physically returned to requester. Therefore, the IFW copy of the 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 July 20, 2011 comments submission by third party requester exceeded the page limit established by 37 CFR 1.943(b) and this decision. 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:

1. Submit re-drafted remarks that do not exceed the 104 page limit established by this decision; or,

2. File a copy of the original remarks with pages redacted to satisfy the 104 page limit established by this decision.

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 comments submission from requester is received within the allotted time, the reexamination proceeding will be forwarded to the examiner for appropriate action, without written comments from requester.

As pointed out above, submissions must 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.

III. Patent Owner's Opposition Paper of July 15, 2011

On July 15, 2011, patent owner filed the instant opposition paper in response to the July 8, 2011 third party requester petition under 37 CFR 1.183, requesting that the requester's page-length waiver petition be denied.

Patent owner's opposition to the third party requester's petition under 37 CFR 1.183 for waiver of the page limit requirements of 37 CFR 1.943(b) is an improper paper in the present proceeding, because it is not provided for in the reexamination statute, regulations or practice. 35 U.S.C. 314(a) governs the conduct of *inter partes* reexamination proceedings and provides that reexamination shall be conducted according to the procedures established for initial examination of the original patent (*i.e.*, under the provisions of 35 U.S.C. 132 and 133), which do not provide a right to contest another party's request for relief in a matter of equity and of the Office's discretion. Thus, patent owner's opposition to the Office's exercise of its discretion with respect to waiver of the regulatory page limit for third party requester's comments submission is an improper paper in the present proceeding. *See* 76 Fed. Reg. 22854, 22858 (April 25, 2011), stating that an opposition to a petition under 37 CFR 1.183 to waive page length requirement or word count is not permitted.

Accordingly, patent owner's July 15, 2011 opposition paper is an improper paper, and it will not be made of record in the file of the present proceeding. Because patent owner's July 15, 2011 opposition paper has been scanned into the electronic Image File Wrapper (IFW), the paper is being expunged by marking it "closed" and "not-public" in the IFW, and will not constitute part of the record of the present proceeding. *See* MPEP 2667. No copy of the July 15, 2011 opposition paper will be maintained of record in the Office. A copy of this decision will be made of record in the IFW of the present proceeding.

CONCLUSION

1. Third party requester's July 8, 2011 petition under 37 CFR 1.183 is dismissed as to the amount of pages for which waiver is requested.

2. Third party requester's request for waiver of the 37 CFR 1.943(b) is granted-in-part to permit 54 additional pages to respond to patent owner's June 20, 2011 revised submission,. Third party requester is given a 15 day non-extendable time period for reply to submit a response that does not exceed 104 pages. The waiver is conditioned on the above-described formatting requirements.

3. Third party requester's July 20, 2011 comments submission is an improper paper and will not be considered. The comments submission is being expunged by being closed in the

present proceeding's Image File Wrapper (IFW) and marking it "not-public." The response will not constitute part of the record of the present reexamination proceeding.

4. Patent owner's July 15, 2011 opposition paper is an improper paper in the present proceeding. Patent owner's July 15, 2011 opposition paper is being expunged from the record by marking it "closed" and "not-public" in the IFW of the present proceeding.

5. A copy of this decision will be made of public record.

6. Any questions concerning this communication should be directed to Susy Tsang-Foster, Legal Advisor, at 571-272-7711.

/Kenneth M. Schor/

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

9-9-11
Kenpet8/...

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,485	11/12/2010	7043543	57058.0148	8636

26582 7590 04/05/2012

HOLLAND & HART, LLP
P.O BOX 8749
DENVER, CO 80201

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/05/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Edmund J. Walsh
WOLF GREENFIELD & SACKS, P.C.
600 Atlantic Avenue
Boston, MA 02210-2206

Date:
MAILED
APR 05 2012
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001485
PATENT NO. : 7043543
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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APR 05 2012

CENTRAL REEXAMINATION UNIT

Gregory W. Osterloth HOLLAND & HART, LLP P.O. Box 8749 Denver, CO. 80201	:	(For Patent Owner)
Edmund J. Walsh WOLF, GREENFIELD & SACKS, P.C. 600 Atlantic Ave. Boston, MA. 02210	:	(For Third Party Requester)
In re: Ewing et al. *Inter Partes* Reexamination Proceeding Control No.: 95/001,485 For: U.S. Patent No.: 7,043,543	:	DECISION ON PETITIONS

This is a decision on two petitions, one filed by the patent owner: a petition dated August 23rd, 2011, entitled "PETITION UNDER 37 C.F.R. 1.181 TO VACATE THE DECISION TO GRANT *INTER PARTES* REEXAMINATION PROCEEDINGS, IN PART, AS *ULTRA VIRES*" [hereinafter "petition 1"], and another petition filed by Third Party Requestor on September 6th, 2011, entitled "REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION UNDER 37 C.F.R 1.181 TO VACATE THE DECISION TO GRANT *INTER PARTES* REEXAMINATION PROCEEDINGS, IN PART, AS *ULTRA VIRES*" [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. 7,043,543 issued on May 9th, 2006.
- A request for *inter partes* reexamination was filed on November 12th, 2010 and assigned control no. 95/001,485.

- *Inter partes* reexamination was ordered on January 15th, 2011.
- A Non-Final Office Action was mailed on January 15th, 2011.
- Patent Owner's Response to the Non-Final Office Action was received on April 15th, 2011.
- The Third Party Requestor's Comments to the Patent Owner Response and the Non-Final Office Action were received on May 16th, 2011.
- A Notice of Defective Paper was mailed on June 3rd, 2011.
- Patent Owner's Response to the Notice of Defective Paper was received on June 20th, 2011.
- The Third Party Requestor's Comments to the Patent Owner Response and the Notice of Defective Paper were received on July 20th, 2011.
- Petition 1 was filed August 23rd, 2011, and Petition 2 was filed September 6th, 2011.
- A Non-Final Office Action was mailed on March 29th, 2012.

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.

(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. (Emphasis added.)

MPEP § 2646 (II) PETITION TO VACATE THE ORDER GRANTING REEXAMINATION

When a petition under 37 CFR § 1.181 is filed to vacate a reexamination order, the third party requester may file a single submission in opposition to the petition.

DECISION

Patent owner ["petitioner"] argues in petition 1 that the Office vacate the proceedings because Office's order dated January 15th, 2011 is *ultra vires* as not based on prior art patents or printed publications. The petitioner further states that the Order failed to make an initial determination as to whether the MSVM User Guide, MSVM Quick Start Manual, MSVM PowerNet Guide references (or any of the other references) was a publicly available printed publication and because the Office's order is based on a reference not shown to be a printed publication. The petition states that the references themselves do not indicate when they became printed publications, and there is no evidence of record to explain how the references would have become printed publications on the dates contained within the references.

The Third Party Requester ["petitioner"] argues in petition 2 that the Patent Owner's August 23rd 2011 Petition (petition 1) is improper under 37 C.F.R. § 1.181(f) as being untimely and furthermore, is improper under MPEP § 2646(II) wherein the examiner's determination is not petitionable. The petitioner further provides evidence to substantiate that MSVM User Guide, MSVM Quick Start Manual, MSVM PowerNet Guide references to be a patent or printed publication.

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. However, the MPEP § 2646(II) "PETITION TO VACATE THE ORDER GRANTING REEXAMINATION" clearly states:

> "Where the examiner determines that a reference is a printed publication (i.e., that the criteria for publication has been satisfied), that determination is also **not** petitionable. These matters cannot be questioned with respect to vacating the order granting reexamination until a final agency decision on the reexamination proceeding has issued. Rather, these matters can be **argued** by the patent owner and **appealed** during the examination phase of the reexamination proceeding."

MPEP § 2642 (II) clearly directs that the determination as to whether a reference is a printed publication is not petitionable for vacating an Order.

Furthermore, 37 C.F.R. § 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. 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.)

It should also be noted that the petition "petition 1", was filed on August 23rd, 2011 more than six months from the mailing date of the order granting the request for reexamination which was mailed on January 15th, 2011. As a consequence, the petition is also untimely.

Therefore, petition 1 to vacate the order granting reexamination under *Ultra Vires* as not being based on a patent or printed publication is **denied** pursuant to MPEP § 2646(II).

Petition 2

The Third Party Requester ["petitioner"] argues in petition 2 that the Patent Owner's August 23rd 2011 Petition (petition 1) is improper under 37 C.F.R. § 1.181(f) as being untimely and furthermore, is improper under MPEP § 2646(II) wherein the examiner's determination is not petitionable. The petitioner further provides evidence to substantiate that MSVM User Guide, MSVM Quick Start Manual, MSVM PowerNet Guide references to be a patent or printed publication.

In light of the Office's decision with regards to Petition 1, decision *supra*, the petition 2 is hereby **dismissed as moot**.

CONCLUSION

1. The patent owner filed petition (petition 1) dated August 23rd, 2011 is hereby **denied.**

2. The requester filed petition (petition 2) dated September 6th, 2011 is **dismissed as moot.**

3. The non-Final Office action dated March 29th, 2012, remains outstanding, the patent owner's response is due as set forth in that action.

4. 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 Yucel
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,486	11/15/2010	6238289	SCEA 3.6-014	9635

98749 7590 07/07/2011

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1000 Jorie Boulevard
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/07/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Andrew T. Zidel
LERNER DAVID LITTENBERG ET AL.
600 South Avenue West
Westfield, NJ 07090

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001486
PATENT NO. : 6238289
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)

Andrew T. Zidel
LERNER, DAVID, LITTENBERG ET AL.
600 South Avenue West
Westfield, NJ 07090

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,486
Filed: November 15, 2010
For: U.S. Patent No. 6,238,289

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

This is a decision on third party requester's petition paper entitled "PETITION UNDER RULE 1.183 TO WAIVE THE PROVISIONS OF RULE 1.943(B) TO PERMIT REQUESTER'S WRITTEN COMMENTS TO EXCEED THE 50-PAGE LIMITATION," filed on April 29, 2011. The petition requests waiver of the requirement of 37 CFR 1.943(b) that the written comments by third party requester not exceed fifty (50) pages in length, and requests that the page limit be extended to 100 pages. Third party requester timely filed comments under 37 CFR 1.947 concurrently with the petition.

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

Third party requester's petition under 37 CFR 1.183 to waive the 37 CFR 1.943(b) limit as to the number of pages permitted in comments by third party requester is granted to the extent that the page limit for comments by third party requester is extended to not exceed 97 pages in length.

DECISION

I. 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.

II. Third Party Requester's Petition

In the instant petition, third party requester requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for third party requester's comments filed on April 29, 2011, and requests that the page limit be extended to 100 pages.[1] In support of its request for waiver of the rule, third party requester argues that additional pages are needed to address the 29 newly presented claims. Third party requester further argues that it must comply with MPEP 2666.05(III), which requires requester to provide a detailed discussion of the grounds of rejection for the proposed claims.[2]

---

[1] Petition at page 3.
[2] *Id.* at pages 2-3.

III. Analysis and Findings

The instant petition under 37 CFR 1.183 has been fully considered. In this instance, petitioner third party requester's April 29, 2011 written comments include 39 pages of remarks, which are subject to the 50 page limit.[3] The third party requester comments are also accompanied by Exhibit 1, and Appendices E-G. A discussion of the counting of pages for the Exhibit and Appendices now follows:

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.

Exhibit 1 is a one page email communication that does not contain any legal arguments. Therefore, Exhibit 1 is not counted toward the page limit.

Appendices E-G are claim charts applying the prior art to the newly added claims. These appendices, totaling 58 pages, count toward the page limit.

Accordingly, the April 29, 2011 third party requester comments submission includes *in toto* 97 pages in length as to pages counting toward the regulatory page limit.

Upon review of the submitted response for economizing, extraneous material, and arrangement, without repetition of information already of record, it is found that the 47 pages of arguments in excess of 50 required to complete the third party requester's comments are not unreasonable in this instance, in view of the present facts and circumstances. This includes the point that patent owner's response added 29 new claims. It is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance.

[3] This decision is limited to the page-limit issue and the propriety of third party requester's written comments will be reviewed by the Central Reexamination Unit (CRU).

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 reexamination proceeding, the instant third party requester petition is deemed to establish that a waiver of 37 CFR 1.943(b) to the extent of permitting third party requester's comments to run 97 pages in length is appropriate in the interest of justice.

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's comments submission to exceed the page limit by up to 47 pages. This waiver makes requester's April 29, 2011 comments submission page-length compliant.

CONCLUSION

1. Third party requester's petition under 37 CFR 1.183 is granted, and the page limit of 37 CFR 1.943(b) is waived to the extent that third party requester's comments filed on April 29, 2011 may exceed the page limit by up to 47 pages. This waiver makes the April 29, 2011 third party requester comments submission page-length compliant.

2. Telephone inquiries related to the present decision should be directed to the Susy Tsang-Foster, Legal Advisor, at 571-272-7711.

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

7/6/11
Kenpet8/

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,486	11/15/2010	6238289	SCEA 3.6-014	9635

98749 7590 09/01/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/01/2011

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600 South Avenue West
Westfield, NJ 07090

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001486
PATENT NO. : 6238289
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)

Andrew T. Zidel
Lerner, David, Littenberg et al.
600 South Avenue West
Westfield, NJ 07090

(For *Inter Partes* Requester)

In re Sobota et al.
Inter partes Reexamination Proceeding
Control No. 95/001,486
Filed: November 15, 2010
For: U.S. Patent No. 6,238,289

: **DECISION**
: **DISMISSING**
: **PETITIONS**

This decision is in response to Patent Owner's petition filed on June 6, 2011 under 37 CFR 1.182, requesting expungement of the comments by the Requester, filed on April 29, 2011, and Requester's petition, filed June 14, 2011, opposing the June 6, 2011 petition by the Patent Owner. Although the petitions cited to 37 CFR 1.182 as authority to file the petitions, the petitions are being treated under 37 CFR 1.181 as requesting supervisory review.

The petition and opposition are before the Director of the Technology Center 1600, who oversees Central Reexamination Unit, for decision.

Patent Owner's petition is **DISMISSED** as premature for the reasons explained below.

Requester's opposition petition is **DISMISSED** as premature for the reasons explained below.

STATEMENT OF RELEVANT FACTS

1. U.S. Patent No. 6,238,289 (the '289 patent) issued on May 29, 2001.

2. A request for reexamination of the '289 patent was filed on November 15, 2010. The request was assigned control No. 95/001,486 (the '1486 reexamination proceeding).

3. On January 31, 2011, the Office ordered that the patent be reexamined, finding that requester had raised a substantial new question of patentability as to claims 1, 2, 3, 4, 6, 10, 11, 12 and 13 of '289 patent. Concurrently, the Office also mailed an Office action, rejecting claims 1, 2, 3, 4, 6, 10, 11, 12 and 13.

4. On March 31, 2011, Patent Owner filed a response to the Office action, which included amendments to the claims. The amendment added proposed new claims 21-45. Concurrently, the Patent Owner filed remarks directed to new Claims 21-45.

5. On April 29, 2011, Requester filed comments after patent owner's response. The comments paper was 40 pages and included 1 additional exhibit and 3 additional appendices. Concurrently, Requester filed a petition titled "PETITION UNDER RULE 1.183 TO WAIVE THE PROVISIONS OF RULE 1.943(B) TO PERMIT REQUESTER'S WRITTEN COMMENTS TO EXCEED THE 50-PAGE LIMITATION."

6. On June 6, 2011, Patent Owner filed the instant petition entitled "PETITION UNDER 37 C.F.R. §1.182 TO EXPUNGE THE REQUESTER'S COMMENTS TO THE PATENT OWNERS' STATEMENT." Patent owner requested that the requester's comments be expunged from the record as being noncompliant with the requirements of 37 CFR 1.947.

7. On June 14, 2011, Requester filed a petition entitled "REQUESTER'S OPPOSITION TO PATENT OWNER'S PETITION TO EXPUNGE REQUESTER'S COMMENTS – PURSUANT TO 37 C.F.R. § 1.182."

8. On July 7, 2011, the Office mailed a decision granting Requester's April 29, 2011 petition under 37 CFR 1.183 and permitting the Requester's comments to exceed the page limit of 37 CFR 1.943(b) by 47 pages.

DECISION

As pointed out, the Patent Owner filed a June 6, 2011 petition, which is being treated as a petition under 37 CFR 1.181 to invoke supervisory authority to not enter the April 29, 2011 comments. On June 14, 2011, Requester filed an opposition to Patent Owner's June 6, 2011 petition. However, there has been no decision by the examiner if the Requester's April 29, 2011 comments are in compliance with Office rules and procedures. Accordingly, it is premature to invoke supervisory authority regarding entry or refusal to enter the April 29, 2011 comments because the examiner has not made his or her decision. Thus, the Patent Owner's June 6, 2011 petition and third party Requester's June 14, 2011 opposition are premature, and they are dismissed.

CONCLUSION

1. The June 6, 2011 Patent Owner petition is dismissed as premature.

2. The June 14, 2011 Requester opposition petition is dismissed as premature.

3. Telephone inquiries related to this decision should be directed Alexander Kalinowski, Supervisory Patent Examiner, at (571) 272-6771.

Irem Yucel, Director
Technology Center 1600

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,486	11/15/2010	6238289	SCEA 3.6-014	9635

7590 03/01/2012
ELEVEN ENGINEERING GAME CONTROL, LLC
65 EAST 55th STREET
23rd FLOOR
NEW YORK, NY 10022

EXAMINER
HOTALING, JOHN M

ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
03/01/2012	PAPER

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,617	05/09/2011	John Sobota	723-2844	9929

7590 03/01/2012
ELEVEN ENGINEERING GAME
CONTROL, LLC.
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NEW YORK, NY 10022

EXAMINER
HOTALING, JOHN M

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MAR 0 1 2012

CENTRAL REEXAMINATION UNIT

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Date:

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD
11th FLOOR
ARLINGTON, VA 22203

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001617
PATENT NO. : 6238289
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

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

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

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

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Andrew T. Zidel
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600 South Avenue West
Westfield, NJ 07090

MAILED

Date: MAR 0 1 2012

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001486
PATENT NO. : 6238289
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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ANDREW T. ZIDEL (For the '1486 Requester)
LERNER, DAVID, LITTENBERG ET AL.
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

MAR 01 2012

CENTRAL REEXAMINATION UNIT

NIXON & VANDERHYE, PC (For the '1617 Requester)
901 NORTH GLEBE ROAD
11TH FLOOR
ARLINGTON, VA 22203

Inter Partes Reexamination Proceeding Control No. 95/001,486 Filed: November 15, 2010 For: U.S. Patent No. 6,238,289	**DECISION** ***SUA SPONTE*** **TO MERGE** **REEXAMINATION** **PROCEEDINGS**
Inter Partes Reexamination Proceeding Control No. 95/001,617 Filed: May 9, 2011 For: U.S. Patent No. 6,238,289	

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

REVIEW OF RELEVANT FACTS

1. On May 29, 2001, U.S. Patent No. 6,238,289 (the '289 patent) issued to Sobota et al. with 20 claims.

2. On November 15, 2010, a first request for *inter partes* reexamination of claims 1-4, 6, and 10-13 of the '289 patent was filed by a third party requester and assigned Reexamination Control No. 95/001,486 ("the '1486 proceeding"). The request identified Sony Computer Entertainment America, LLC ("the 1486 requester") as the real party in interest.

3. On January 31, 2011, *inter partes* reexamination was ordered on claims 1-4, 6, and 10-13 of the '289 patent in the '1486 proceeding. An Office action was concurrently issued in the proceeding, rejecting claims 1-4, 6, and 10-13 of the '289 patent.

4. On March 31, 2011, patent owner timely filed, in the '1486 proceeding, an amendment and response to the January 31, 2011 Office action, adding new claims 21-49. No claims were amended or canceled.

5. On April 29, 2011, third party request timely filed comments.

6. On May 9, 2011, a second request for *inter partes* reexamination of claims 1-20 of the '289 patent was filed by a third party requester and assigned Reexamination Control No. 95/001,617 ("the '1617 proceeding"). The request identified Nintendo of America and Nintendo Co., Ltd. ("the 1617 requester") as the real party in interest.

7. On August 8, 2011, *inter partes* reexamination was ordered on claims 1-20 of the '289 patent in the '1617 proceeding. An Office action was not concurrently issued in the proceeding. The order indicated that an Office action would issue in due course.

8. To date, no Office action has issued in the '1617 *inter partes* proceeding, and no further Office action has issued in the '1486 *inter partes* proceeding.

DECISION

I. MERGER OF PROCEEDINGS

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

MPEP 2686.01 points out:

> Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with "special dispatch."

The 95/001,486 and 95/001,617 *inter partes* proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. New claims 21-49 have been proposed by amendment in the '1486 proceeding, while there is no corresponding amendment in the '1617 proceeding. Thus, the claims are not currently the same in both files. An Office action requiring an amendment placing the claims in identical form is being issued concurrently with this decision. Patent owner must respond to the Office action in accordance with the procedures in 37 CFR 1.111. The third party requesters will then have an opportunity to comment on patent owner's response in accordance with the procedures in 37 CFR 1.947. It is to be noted that if the '1486 requester chooses to file a comments paper after the patent owner response, the filing of such will be treated as comments in substitution for the comments filed on April 29, 2011. In that event, the April 29, 2011 comments paper would not be considered by the examiner. Accordingly, should '1486 requester choose to file a substitute comments paper, then '1486 requester should include any comments from the April 29, 2011 comments that it wishes considered in any such substitute comments paper.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

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

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2).[1] First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requesters' comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

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

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

2. Appeal Rights:

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

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

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

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

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

The '1486 *inter partes* third party requester did not propose any rejections of claims 5, 7-9, and 14-20 in the request for reexamination. Therefore, the '1486 requester <u>does not</u> have an appeal right to claims 5, 7-9, and 14-20 as they appear in the '289 patent.

C. Papers mailed/filed:

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

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

by Mail to: Attn: Mail Stop "Inter Partes Reexam"
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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

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

by EFS: Registered users may submit papers via the electronic filing system EFS-Web, at:
https://efs.uspto.gov/efile/myportal/efs-registered

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

D. Amendments:

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

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

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

E. Fees:

Where a paper is filed that requires payment of a fee (e.g., petition fee, excess claims fee, extension of time fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For

example, only one fee need be paid for any patent owner's appellant brief (or that of an *inter partes* reexamination requester) which may be filed, even though the brief relates to merged multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

F. Citation of Patents and Printed Publications:

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

G. Appeal Procedure Reminders for *Inter Partes* Reexamination

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

CONCLUSION

1. *Inter partes* Reexamination Control Nos. 95/001,466, and 95/001,617 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above in Part III of this decision.

2. Telephone inquiries related to the present 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 7, 2012

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,487	11/15/2010	7519327	AFF.0003B3US	1395

21906 7590 05/25/2011

TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/25/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:
MAILED
MAY 25 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001487
PATENT NO. : 7519327
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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TROP, PRUNER & HU, P.C.
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(For Patent Owner)

NOVAK, DRUCE & QUIGG, LLP
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HOUSTON, TX 77002

(For Third Party Requester)

MAILED

MAY 25 2011

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/001,487
Filed: November 15, 2010
For: U.S. Patent No. 7,519,327

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

This is a decision on the March 18, 2011 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT REQUIREMENT FOR THE PATENT OWNER REPLY UNDER 37 C.F.R. § 1.943(b)."

The petition requests waiver of the requirement of 37 CFR 1.943(b) that the patent owner response not exceed fifty (50) pages in length, and requests that the page limit be extended to 83 pages. Patent owner timely filed its response pursuant to 37 CFR 1.945 concurrently with the petition.

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

Patent owner's petition under 37 CFR 1.183 to waive the 37 CFR 1.943(b) limit as to the number of pages permitted in patent owner's response is dismissed as moot.

DECISION

In the instant petition, patent owner requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for patent owner's response filed on March 18, 2011 to address the January 19, 2011 non-final Office action, and requests that the page limit be extended to 83 pages.[1]

[1] Petition at 1.

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a response in compliance with the 50-page limit, and submission of the resulting response paper that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response submission can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response submission: (1) for justification that more pages are needed to complete the response submission, and (2) to set forth an accurate determination of exactly how many additional pages are needed to complete the response submission.

The instant petition under 37 CFR 1.183 has been fully considered. In this instance, petitioner patent owner's March 18, 2011 response includes 23 pages of remarks, which are subject to the 50 page limit.

The patent owner response also includes Appendix A and a declaration of Russell White under 37 CFR 1.132, which are accompanied by Exhibits A-M.

There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the affidavit or declaration is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

Appendix A is a 2-page claim chart showing alleged support for the new claims, and is counted toward the page limit.

The 10-page declaration of White contains legal arguments on 3 pages. Examples of legal arguments in the White declaration, which are not exhaustive, that count toward the page limit are:

On page 8, in paragraph 23, declarant White states: "I disagree with the rejections, as the prior art, alone and in combination fails to teach or suggest all of the claimed subject matter...one of ordinary skill in the art would not have been motivated to make the combinations... the claims are not obvious."

On page 9, in paragraph 26, declarant White states: "At least because Abecassis fails to teach or suggest the subject matter for which it is relied upon, one of ordinary skill in the art would have no reason to combine its subject matter with any of the primary and the other secondary references."

On page 10, in paragraph 30, declarant White states: "Baughan does not teach or suggest the pause functionality recited in claim 1 and the other independent claims of the '327 Patent. For this reason alone, when combined with other references, the claimed subject matter is not achieved."

Regarding Exhibit E, which accompanies the White declaration, the claim charts presented in this exhibit are not comparing the limitations of the claims under the present reexamination with the teachings of a reference cited against the claims. Rather, the claim charts are comparing the present invention to that of a device which patent owner alleges is infringing the claims of the patent under reexamination, and are provided as alleged evidence of commercial success (see, e.g., page 4 of the White declaration). For this reason, the claim charts of Exhibit E are not included in the page count.

Thus, the March 18, 2011 patent owner response includes 28 pages which are counted toward the page limit.

For the reasons given above, the patent owner's response, filed on March 18, 2011 is deemed to be within the 50-page regulatory limit. Accordingly, the March 18, 2011 patent owner petition is **dismissed as moot**.

CONCLUSION

- Patent owner's March 18, 2011 petition is **dismissed as moot**. Patent owner's response filed on March 18, 2011 is deemed to be **page-length compliant.**
- Any inquiry concerning this communication should be directed to Susy Tsang-Foster, Legal Advisor, at 571-272-7711.

Cynthia L. Nessler

Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

5-24-11
Cindypet/

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,487	11/15/2010	7519327	AFF.0003B3US	1395

82427 7590 02/02/2012
KRAMER LEVIN NAFTALIS & FRANKEL LLP
1177 Avenue of the Americas
New York, NY 10036

EXAMINER
NASSER, ROBERT L

ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
02/02/2012	PAPER

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,487	11/15/2010	7519327	AFF.0003B3US	1395

82427 7590 02/02/2012
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EXAMINER
NASSER, ROBERT L

ART UNIT	PAPER NUMBER
3992	

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02/02/2012	PAPER

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

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CENTRAL REEXAMINATION UNIT

KRAMER LEVIN NAFTALIS & FRANKEL LLP 1177 AVENUE OF THE AMERICAS NEW YORK, NY 10036	: : : :	(For Patent Owner)
KRAMER LEVIN NAFTALIS & FRANKEL LLP 1177 AVENUE OF THE AMERICAS NEW YORK, NY 10036	: : : :	(For Third Party Requester)[1]
In re: White *Inter Partes* Reexamination Proceeding Control No.: 95/001,487 Deposited: November 15, 2010 For: U.S. Patent No.: 7,519,327	: : : : :	DECISION ON PETITIONS UNDER 37 CFR § 1.181

This is a decision on a petition filed by the patent owner on July 18, 2011, entitled: "PETITION UNDER 37 C.F.R. § 1.181 REQUESTING EXPUNGMENT OF THIRD PARTY COMMENTS FILED JUNE 25, 2011" [hereinafter "the petition"].

This is also a decision on the companion petition/opposition filed by the third party requester on July 27, 2011 entitled: "SECOND PETITION UNDER 37 C.F.R.. § 1.181, OR IN THE ALTERNATIVE 37 C.F.R. § 1.182, FOR SUPERVISORY REVIEW OF THE JUNE 30, 2011 ACTION CLOSING PROSECUTION AND THE MAY 25, 2011 DECISION DISMISSING PATENT OWNER'S MARCH 18, 2011 PETITION AND OPPOSITION TO PATENT OWNER'S JULY 18, 2011 PETITION" [hereinafter "the opposition"].

The petition is a request for the Director to exercise his supervisory authority to expunge an allegedly untimely comments submission paper from the record. The opposition opposes that request, and also requests the Director to review the examiner's allegedly improper action of failing to consider that comments submission.

The petition and opposition are before the Director of the Central Reexamination Unit. The petition is granted and the opposition is denied.

[1] Note that per the communication filed November 15, 2011, the third party requester has acquired the '327 patent.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,519,327 issued on April 14, 2009.
- A request for *inter partes* reexamination was filed on November 15, 2010 and assigned control no. 95/001,487.
- *Inter partes* reexamination was ordered on January 18, 2011 and a first Office action was mailed on January 19, 2011.
- On March 18, 2011, patent owner filed a response to the Office action. Patent owner also filed a petition under 37 C.F.R. § 1.183 to waive the page limit requirement.
- On May 25, 2011, the Office of Patent Legal Administration ["OPLA"] issued a decision dismissing the petition, determining that waiver was unnecessary as the response was compliant with the page limit requirement as filed.
- On June 24, 2011, the third party submitted comments in response to the Office action.
- On June 30, 2011, the examiner issued an Action Closing Prosecution. This action did not consider any third party comments submission, and stated that "The Third Party Requester did not respond."
- On July 18, 2011, the patent owner filed the petition requesting expungement of the June 24 comments submission as untimely.
- On July 27, 2011, the third party filed the opposition, opposing the petition and requesting withdrawal and reissuance of the Action Closing Prosecution so that its June 24 comments could be considered.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. § 314 Conduct of inter partes reexamination proceedings (in part)

(b) RESPONSE. —

* * *

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

37 C.F.R. § 1.943 Requirements of responses, written comments, and briefs in *inter partes* reexamination (in part)

(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.

MPEP § 2666.05 Third Party Comments After Patent Owner Response (in part)

I. TIMELINESS

A third party requester may once file written comments on any patent owner response to an Office action, during the examination stage of an *inter partes* reexamination proceeding. The third party requester comments must be filed within a period of 30 days from the **date of service** of the patent owner's response on the third party requester. 37 CFR 1.947. . . .

If the third party requester comments are filed after 30 days from the **date of service** of the patent owner's response on the third party requester, the comments will not be considered. See 37 CFR 1.957(a).

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

the time the 37 CFR 1.183 petition is granted, the patent owner response becomes complete with its content being set in place, and the requester has 30 days from the date of the decision granting the 37 CFR 1.183 petition to file a comment paper pursuant to 37 CFR 1.947.

DECISION

Patent owner argues that the third party requester's comments were untimely and should be expunged from the record. The third party requester argues that its comments to the patent owner's response should have been considered by the examiner. Patent owner's response was filed with a petition to waive the page limit requirement. OPLA determined that the response was already compliant and dismissed the page limit waiver petition. The third party filed comments within 30 days of OPLA's decision, but well after 30 days from the date of service of the response as filed. The examiner issued an Office action without considering the third party's comments.

First, to be clear, this decision addresses only the propriety of the comments submission and the examiner's action of issuing an Office action without considering the comments. This decision does not address whether OPLA's decision was correct. That issue is the subject of the "FIRST" petition filed on the same date as the present petition, and will be addressed in a separate decision. If the "FIRST" petition is granted then that might change the result presented herein, but if that is the case any change will be explained in the decision on that petition. Note also that a "THIRD" petition was also filed by the third party requester on the same date, and that will also be addressed in a separate decision.

In some situations a patent owner may file a response that is not compliant with the page limit requirements, along with a petition to waive said requirements. This non-compliant response is not considered an official response until it is completed by the granting of the page limit waiver petition. Only at that point does the response become a proper and complete response, therefore the date of the response is deemed to be the date that the page limit waiver is granted. Accordingly, the third party will have 30 days from the date the petition is granted to file comments. This procedure is outlined in MPEP § 2666.05, and was further explained in Control No. 95/001,206, Decision Denying Petition Under 37 C.F.R. § 1.181, April 19, 2011 (cited by requester).

Of course, that situation is not the same as the present situation. Here, the patent owner filed a response that included a petition to waive the page limit, but the response was ultimately determined by OPLA to be compliant. The response was therefore a fully complete and

compliant response as of the date it was filed. Because it was a fully complete and compliant response as of its filing date, it was a response within the meaning of the statute as of its filing date. Accordingly, the actual date of service, March 18, 2011, is the controlling event under 35 U.S.C. § 314(b)(2). The third party's comments submission was filed over three months after that date, far exceeding the time permitted by statute. As the comments were filed after the statutory time period, they are improper and should be expunged, and the examiner's act of not considering the comments was not improper. The patent owner's petition is granted. The third party's opposition is denied.

Requester argues that this result is unfair in light of the guidance given in MPEP § 2666.05. It states that it fully intended to file comments in accordance with § 2666.05, within 30 days from the date the page limit waiver petition was granted. It argues that the plain language of § 2666.05 states that the patent owner response is incomplete until the petition waving the page limit is granted, and there is no indication that the Office will retroactively accept the earlier date if it determines that the original response was actually compliant.

Requester's complaint about § 2666.05 is irrelevant because the quoted portion is explicitly drawn to a patent owner response where "the page length of the response exceeds the page length set by 37 CFR 1.943(b)." MPEP § 2666.05. Here, the page length does not exceed the page limit of the rules when the pages are counted properly. In other words, the section presumes a non-compliant response, and does not address the circumstance where the response was compliant but also included a petition for waiver of the page limit. In any case, there is no "retroactive" accepting of the filing date. Because the response was compliant as of its filing date, that date always was its effective date. Only in the case where a response is non-compliant does it not gain a date until it is effectively completed by the granting of a petition.

Requester no doubt believes it is unfair that, on March 18, it did not know whether OPLA would or would not determine that the response was compliant. Of course, nothing prevents the third party from filing its comments submission within 30 days of the original date of service of the response, regardless of whether it might or might not actually be accorded a later date. It is not as if this would have created much potential unnecessary work for requester, as the vast majority of page limit waiver petitions are ultimately granted. Requester essentially played a strategic game in waiting to file its comments, and in this particular situation it lost that game.

Requester further argues that the 95/001,206 Decision, *supra*, supports its view. The entire basis of that decision was that the patent owner's response in that case was not a "response" within the meaning of the statute because it was not compliant. Only when OPLA granted a waiver of the page limit requirements did the response become a "response" under the statute, triggering the 30 day time period. As described herein, OPLA determined that patent owner's March 18 response was a complete and valid response at the time of filing. Thus, it was always a "response" under

the statute, and the date of service was the triggering event under the statute. 95/001,206 is simply a different situation.

It is not up to the parties to determine when a submission is compliant with the Office's rules. A party does not "admit" that a response is non-compliant by filing a petition or even by stating that it believes its response was non-compliant. The statute requires that comments be filed within 30 days of the date of service of the response, and here OPLA has determined that the date of service of the response is March 18, 2011. The comments were not timely under the statute. Accordingly, the petition is granted and the opposition is denied.

CONCLUSION

1. The petition filed July 18, 2011 is granted. The third party comments filed June 24, 2011 are untimely and are expunged from the record.

2. The third party opposition filed July 27, 2011 is denied. The Action Closing Prosecution mailed June 30, 2011 is not withdrawn by this decision.

3. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.

Irem Yucel
Director, Central Reexamination Unit

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NASSER, ROBERT L

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Date: MAILED

FEB 02 2012

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001487
PATENT NO. : 7519327
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

KRAMER LEVIN NAFTALIS & FRANKEL LLP 1177 AVENUE OF THE AMERICAS NEW YORK, NY 10036	: : : :	(For Patent Owner)
KRAMER LEVIN NAFTALIS & FRANKEL LLP 1177 AVENUE OF THE AMERICAS NEW YORK, NY 10036	: : : :	(For Third Party Requester)[1]
In re: White *Inter Partes* Reexamination Proceeding Control No.: 95/001,487 Deposited: November 15, 2010 For: U.S. Patent No.: 7,519,327	: : : : :	DECISION ON PETITION UNDER 37 CFR § 1.181

This is a decision on a petition filed by the third party requester on July 27, 2011 entitled: "THIRD PETITION UNDER 37 C.F.R.. § 1.181, OR IN THE ALTERNATIVE 37 C.F.R. § 1.182, TO VACATE THE JUNE 30, 2011 ACTION CLOSING PROSECUTION" [hereinafter "the petition"].

The petition is a request for the Director to exercise his supervisory authority to vacate and reissue the Action Closing Prosecution [hereinafter "ACP"] because the examiner failed to address all of the pending claims.

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

[1] Note that per the communication filed November 15, 2011, the third party requester has acquired the '327 patent.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,519,327 issued on April 14, 2009.
- A request for *inter partes* reexamination was filed on November 15, 2010 and assigned control no. 95/001,487.
- *Inter partes* reexamination was ordered on January 18, 2011 and a first Office action was mailed on January 19, 2011.
- On March 18, 2011, patent owner filed a response to the Office action. Among other things, the response proposed an amendment adding new claims 43-59.
- On June 30, 2011, the examiner issued an ACP. The ACP did not mention or address claims 43-59.
- On July 27, 2011, the third party filed the instant petition.
- Other petitions have been filed, which will be addressed in separate decisions.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.949 Examiner's Office action closing prosecution in *inter partes* reexamination

Upon consideration of the issues a second or subsequent time, or upon a determination of patentability of all claims, the examiner shall issue an Office action treating all claims present in the *inter partes* reexamination, which may be an action closing prosecution. The Office action shall set forth all rejections and determinations not to make a proposed rejection, and the grounds therefor. An Office action will not usually close prosecution if it includes a new ground of rejection which was not previously addressed by the patent owner, unless the new ground was necessitated by an amendment.

DECISION

The third party requester petitions for review of the ACP because it did not address all of the claims. On March 18, 2011 the patent owner proposed an amendment that added claims 43-59. In the ACP the examiner rejected claims 1-42, but did not reject, deem patentable, or in any way address claims 43-59. The ACP explicitly states on page 2 "This office action addresses claims 1-42 . . . ." and the Director finds no mention of the new claims. Accordingly, the examiner's ACP fails to comply with 37 CFR § 1.949, which requires that "the examiner shall issue an Office action treating all claims present in the *inter partes* reexamination."

The petition is therefore granted. The examiner will issue a new Office action addressing all of the claims present in this proceeding.

CONCLUSION

1. The petition filed July 27, 2011 is granted. The ACP mailed June 30, 2011 is withdrawn and a new action will be issued. The new action may be an ACP or a non-final Office action, as appropriate.

2. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.

Irem Yucel
Director, Central Reexamination Unit

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EXAMINER

ART UNIT	PAPER NUMBER

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CENTRAL REEXAMINATION UNIT

In re White
Inter Partes Reexamination Proceeding
Control No. 95/001,487
Filed: November 15, 2010
For: U.S. Patent No. 7,519,327

: **DECISION**
: **DENYING**
: **PETITION**

This is a decision on requester's July 27, 2011 petition entitled "First Petition under 37 C.F.R. § 1.181, or in the alternative 37 C.F.R. § 1.182, for Supervisory Review of the May 25, 2011 Decision Dismissing Patent Owner's March 18, 2011 Petition" (the July 27, 2011 petition).

The July 27, 2011 petition, and the record as a whole, are before the Office of Patent Legal Administration.

SUMMARY

The July 27, 2011 petition is **granted to the extent that** the May 25, 2011 petition has been reviewed by the Director of the Office of Patent Legal Administration, but is **denied** as to the underlying relief requested. The May 25, 2011 decision is **proper**, and **is being maintained**.

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

DECISION

The requester argues that it has standing to contest the May 25, 2011 decision dismissing as moot patent owner's March 18, 2011 petition requesting waiver of the page length requirements of 37 CFR 1.943(b), and holding patent owner's response to be page-length compliant.[1] By statute, the requester has only one opportunity to file its comments within 30 days of the date of service of patent owner response. See 35 U.S.C. 314(b)(2). In the present case, the requester failed to timely file its comments within 30 days of the date of service of patent owner's compliant response. Instead, the requester filed its comments on June 24, 2011, i.e., within 30 days of the May 25, 2011 decision. Had the Office determined, in its May 25, 2011 decision,

[1] The Office notes that the power of attorney for the patent owner and the statement under 37 CFR .3.73(b), both of which were filed on November 15, 2011, and the power of attorney for the requester Apple, Inc., filed on November 17, 2011, cause the attorney of record, and the correspondence address, for both the patent owner and the requester, to be identical. Requester Apple, Inc. has informed the Office that it has acquired the rights of the patent under reexamination, and is now also the patent owner.

that patent owner's response required a waiver of the page limit, and had the decision granted the requested waiver of the page limit, the requester would have been given 30 days from the May 25, 2011 date of the decision granting the page limit waiver to file its comments, causing requester's June 24, 2011 comments to be considered timely. For this reason, the requester has standing to contest the May 25, 2011 decision.

The requester argues that it "was aware of the . . . guidance provided in MPEP § 2666.05(I)", and that "based on that guidance, Requester believed that its written comments became due within 30 days of May 25, 2011, the date of the . . . Decision . . . Therefore, Requester had filed written comments on June 24, 2011. . .". In essence, the requester argues that it intentionally waited until after the mailing of the May 25, 2011 decision before deciding to file its comments, due to an erroneous interpretation of MPEP 2666.05(I).[2] The guidance set forth in MPEP 2666.05(I), however, only applies in the unique circumstance where the patent owner files a petition for waiver of the regulatory page limit in conjunction with a response to an Office action that exceeds the page length requirements.

In some situations, a patent owner may file a response that is not compliant with the page limit requirements, along with a petition to waive these requirements. This non-compliant response is not considered to be an official response until it is completed by the granting of the page limit waiver petition. Only at that point does the response become a proper and complete response. Therefore, the date of the response is deemed to be the date that the page limit waiver is granted. Accordingly, the requester is given 30 days from the date of the decision granting the petition requesting waiver of the page limit to file its comments.

In the present case, the patent owner filed a response accompanied by a petition to waive the page limit. Patent owner's response, however, was determined to be compliant with the page length requirements. Because it was a proper and complete response as of its March 18, 2011 filing date, the March 18, 2011 response was a "response" within the meaning of 35 U.S.C. 314(b)(2). Requester's comments were filed well after the statutory due date, i.e., more than 30 days after the March 18, 2011 date of service of patent owner's response, and for this reason, were properly considered to be untimely.

In addition, the requester effectively admits that it intentionally waited until after the mailing of the May 25, 2011 decision before deciding to file its comments. Even ignoring the provisions of 35 U.S.C. 314(b)(2), the Office cannot, as a matter of policy, permit a procedural delay caused by requester's deliberate decision to wait until the mailing of the May 25, 2011 decision to draft its comments, due to the Office's mandate for special dispatch. See 35 U.S.C. 314(c).

The requester further argues that the Office's determination, in the May 25, 2011 decision, that patent owner's response complied with the page length requirements was "clearly erroneous". The requester argues that "authority in fact exists that explains the nature of declarations in reexamination proceedings", and points to a July 14, 2004 decision in another reexamination

[2] The requester argues, in footnote 5, that "in an abundance of caution", it placed two telephone calls to two different advisors in the Office of Patent Legal Administration to confirm the due date for requester's written comments.. The only telephone calls that the Office is aware of, however, were placed *after* the June 24, 2011 filing of requester's comments.

proceeding, control no. 95/000,016.[3] See, however, the Office policy set forth in the Manual of Patent Examining Procedure, (MPEP), section 2667, published in July of 2008. MPEP 2667 provides, in pertinent part (emphasis added):

> 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.

The May 25, 2011 decision is entirely consistent with the policy set forth in the MPEP. The Office determined that the 23 pages of remarks, which were submitted with patent owner's response, included arguments that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, and were subject to the page limit. The two-page claim chart, attached as Exhibit A to patent owner's response, alleged support for the newly added claims, and was also determined to be subject to the page limit. The requester does not dispute these findings.

The Office further determined that three of the ten pages of the declaration under 37 CFR 1.132 of Russell White contained legal argument such as, e.g., argument as to how an outstanding rejection is overcome, were subject to the page limit. Finally, the Office determined that while Exhibit E, which accompanied the White declaration, included claim charts, these claim charts were not subject to the page limit, because the claim charts are not comparing the limitations of the claims under the present reexamination with the teachings of a reference cited against the claims. Rather, the claim charts are comparing the present invention to that of a device which patent owner alleges is infringing the claims of the patent under reexamination, and are provided as alleged evidence of commercial success (see, e.g., page 4 of the White declaration). For this reason, the claim charts of Exhibit E were not included in the page count. Thus, the Office determined that the March 18, 2011 patent owner response includes only 28 pages which are

[3] The July 14, 2004 decision dismissed an earlier petition by the patent owner in that proceeding, requesting that the comments of the requester in that proceeding "be returned" under 37 CFR 1.939 as an unauthorized paper.

subject to the page limit, and that the March 18, 2011 patent owner response was page-length compliant. For these reasons, the May 25, 2011 decision dismissed as moot patent owner's March 18, 2011 petition requesting waiver of the page length requirements.

The requester specifically argues that "[t]he conclusions reached . . . regarding the number of pages of legal arguments contained in the White declaration and Exhibit E are clearly erroneous". The requester asserts that pages 2-8 of the White declaration contain legal arguments directed to the issues of copying and commercial success, and that the claim charts of Exhibit E. while constituting alleged evidence of commercial success, contain arguments regarding the commercial success. The requester essentially argues that because these pages contain arguments in general, they should be subject to the page limit.

As stated in the May 25, 2011 decision, however, 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. Such affidavits or declarations do, of course, contain arguments that the facts, arguments or materials proferred with or within the declaration ***are*** evidence that establishes e.g., commercial success, etc. For example, where, as here, the pages of a declaration under 37 CFR 1.132 are limited to the argument that the exhibits attached to the declaration provide evidence of commercial success, such pages are not subject to the page limit because the argument is solely directed to whether the proferred materials are evidence of commercial success, and not whether the materials, regardless of whether they are ultimately determined to be evidence, provide a showing that is sufficient to overcome a rejection of record. The Office permits the filing of ***evidence*** to support requester's arguments. Such evidence may include patents, printed publications, and ***evidence*** of secondary considerations of non-obviousness. When, however, the declaration additionally includes legal arguments, for example, that ***an outstanding rejection is overcome by*** the proferred evidence, then the pages that include these arguments are subject to the page limit and are counted. Arguments that an outstanding rejection is overcome, or that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, are subject to the page limit.

The requester argues that the claim charts in Exhibit E are "actually <u>not</u> evidence". The issue, however, is not whether the declarant is *correct* in alleging that the materials proferred with the declaration are evidence. Rather, the issue is whether the declaration and the attached exhibits are limited to arguments that the materials ***are*** evidence of secondary considerations of nonobviousness, and do not include arguments that any information allegedly established by the materials overcomes a rejection of record, or that the claims are anticipated or rendered obvious by the patent under reexamination.[4]

The requester argues that the patent owner admits that "all 10 pages of the White declaration are 'directed to respond to the Office action', and that the 'Declaration of Russell W. White

[4] As an analogy, a requester may submit references with the request that properly raise a substantial new question of patentability. In the request, the requester may allege that the references establish the unpatentability of the patent claims. When determining whether to grant reexamination, however, the issue is not whether the requester is correct that the references establish the unpatentability of the patent claims, but whether the references raise a substantial new question of patentability, and were not raised in the same manner in the earlier examination of the patent.

references Exhibit E which includes 50 pages of infringement contentions'." The fact that the White declaration responds to the Office action or that Exhibit E includes 50 pages of infringement contentions is not relevant to which pages of the White declaration or of Exhibit E are counted toward the page limit. In the present case, three of the ten pages of the White declaration were properly determined to include legal argument directed to whether an outstanding rejection was overcome, or that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination. The remaining pages of the White declaration, and the pages of Exhibit E, are not found to contain such arguments. Furthermore, the requester has not shown that the remaining pages of the White declaration, or any of the pages of Exhibit E, contained such arguments.

Regarding the July 14, 2004 decision in reexamination proceeding control no. 95/000,016, the requester argues that this decision "provides guidance on the issue of including the pages of a 37 CFR § 1.132 declaration against the page limit of 37 C.F.R. § 1.943(b), and in doing so relies on case law that provides a 'test' for determining whether an affidavit or declaration is to be counted against that page limit". In that decision, however, the Office determined that three pages of a 21-page declaration under 37 CFR 1.132 were subject to the page length requirements of 37 CFR 1.943(b), because these pages contained arguments "that the combination of the teachings of the references would motivate one skilled in the art to prepare the claimed invention", i.e., arguments directed to how an outstanding rejection is overcome. For this reason, these three pages were added to the 36 pages of remarks submitted as part of requester's comments in that proceeding, to obtain a total of only 39 pages. Because the total of 39 pages was less than the 50-page limit set by 37 CFR 1.943(b), requester's comments in that proceeding were determined to be page-length compliant. This outcome is effectively indistinguishable from the outcome of the May 25, 2011 decision.

Also in the July 14, 2004 decision, the Office made the initial general determination that the declaration filed in that proceeding "constitutes extrinsic evidence", and that as such, the declaration may be considered in that reexamination proceeding. The Office supported this determination by stating that "it is well settled that extrinsic evidence may be considered [in a reexamination proceeding] when it is used to explain, but not expand, the meaning of a reference", relying on *In re Baxter Travenol Labs,* 21 USPQ2d 1281, 1284 (Fed. Cir. 1991), *In re Chambers*, 20 USPQ2d 1470, 1474 (Comm'r Pats. 1991), *Scripps Clinic & Research Foundation v. Genentech Inc.,* 18 USPQ2d 1001 (Fed. Cir. 1991), and *Heinl v. Godici*, 143 F. Supp.2d 592, 604 (E.D. Va. 2001). Thus, the Office determined that the case law supports the position that a declaration under 37 CFR 1.132 which is used to explain, but not expand the meaning of a reference, *may be considered in a reexamination proceeding*. Again, this determination is consistent with the Office policy as set forth in MPEP 2667, outlined above. The Office then determined that the content of the (remaining) pages of the declaration under 37 CFR 1.132 filed in that proceeding, which were directed to comments on the scope and teachings of the cited prior art references, would not be subject to the 50-page limit imposed by 37 CFR 1.943(b). This determination, however, is not relevant to the issue in the present case, which involves a declaration directed to alleged evidence of secondary considerations rather than to comments on the scope and teachings of the cited prior art references.

The requester points to language in the July 14, 2004 decision, i.e., that "any affidavit or declaration (or clearly-defined portion thereof) that is not directed to further defining the scope and content of a prior art reference would not be 'reference material such as prior art references' and would count against the 50-page limit *of requester's comments*" (emphasis added). The requester generalizes that this language is a "test" for determining whether papers other than the requester's comments filed in that proceeding are to be subject to the 50-page limit. The declaration at issue in that proceeding, however, did not involve an alleged showing of secondary considerations.[5] Thus, the July 14, 2004 decision was directed to declarations filed by the requester, and did not contemplate the issue of which pages of a patent-owner-filed declaration under 37 CFR 1.132, which is directed to alleged evidence of secondary considerations of nonobviousness, are to be subject to the 50-page limit. As stated in the May 25, 2011 decision, 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. The July 14, 2004 decision stated, in effect, that any affidavit or declaration (or clearly defined portion thereof), which is filed by the requester in that proceeding and which is not directed to further defining the scope and content of a prior art reference would count against the 50-page limit *of requester's comments filed in that proceeding.*

Finally, the requester effectively argues that the *Heinl* decision supports requester's generalized assumption that *all* declarations other those "further defining the scope and content of a prior art reference" in *all inter partes* reexamination proceedings would be subject to the 50-page limit. However, the *Heinl* decision does not provide such support, nor has the requester pointed to any other case law that provides support for such a generalization. The *Heinl* court stated, in a footnote, that "any affidavits or declarations that were submitted to support a breach of candor claim, as opposed to materials submitted to explain the pertinency of the patents and printed publications, must be excluded", i.e., ***from submission in a reexamination proceeding***. In other words, the court stated that the issue of a breach of the duty of candor is not an issue within the scope of reexamination, which is entirely consistent with Office policy, and which is not relevant to the declaration at issue in either the present proceeding or in the '016 proceeding, neither of which involved the issue of a breach of the duty of candor. In *Heinl*, the court stated, in the same footnote, that "[a] different result [i.e., that evidence such as a declaration *may not be considered in a reexamination proceeding*] *might* be obtained if the documents [such as declarations] did not relate to an explanation of the printed publications, but rather to other issues of validity and enforceability [such as a breach of the duty of candor]" (emphasis added). In other words, the court stated that, depending on the facts and circumstances, a declaration that does not relate to an explanation of the printed publications *might* not be permitted to be considered, if it involves an issue that is not within the scope of reexamination. The *Heinl* court did ***not*** hold that, in *inter partes* reexamination proceedings, all declarations other than those directed to further defining the scope and content of the prior art references would be subject to the page length requirements of 37 CFR 1.943(b). In fact, the reexamination proceeding at issue in the *Heinl* court was an *ex parte* reexamination proceeding, not an *inter partes* reexamination proceeding.[6] There are no regulations governing the page length of patent owner's responses to

[5] Nor would it, since the declarations at issue involved declarations filed by the requester, not by the patent owner. The requester is not likely to file a declaration alleging secondary indicia of nonobviousness.

[6] This is also true for any of the other case law cited in the July 14, 2004 decision, i.e., *Baxter Travenol Labs, Chambers, and Scripps Clinic and Research Foundation.*

an Office action in an *ex parte* reexamination proceeding, nor are there any such regulations governing requester's reply to patent owner's statement under 35 U.S.C. 304. The issue of which pages of a declaration *properly* submitted in an *inter partes* reexamination proceeding, i.e., a declaration directed to issues within the scope of reexamination, are subject to the 50-page limit imposed by 37 CFR 1.943(b), was not before the court. Thus, there is simply no support in *Heinl* for the generalization that *all* declarations other than those "further defining the scope and content of a prior art reference" in *all inter partes* reexamination proceedings would be subject to the 50-page limit imposed by 37 CFR 1.943(b).

For the reasons given above, the May 25, 2011 decision dismissing as moot patent owner's March 18, 2011 petition requesting waiver of the page length requirements set forth in 37 CFR 1.943(b) is **proper**. Accordingly, the July 27, 2011 petition, filed by the requester in the present proceeding, is **dismissed**.

In summary, in the present case, the May 25, 2011 decision properly held that March 18, 2011 patent owner's response is compliant with the page length requirements of 37 CFR 1.943(b). The requester was required, pursuant to 35 U.S.C. 314(b)(2), to file any written comments by April 18, 2011, 30 days after the date of service of patent owner's response. Not only did it fail to do so, it intentionally decided to wait until after the mailing of the May 25, 2011 decision to file its comments, which was well past its April 18, 2011 statutory due date. For this reason, requester's June 24, 2011 comments were not timely filed, and will not be considered.

CONCLUSION

- The July 27, 2011 petition is **granted to the extent that** the May 25, 2011 petition has been reviewed by the Director of the Office of Patent Legal Administration, but is **denied** as to the underlying relief requested.
- The May 25, 2011 decision is **proper**, and **is being maintained**.
- This decision is designated as a final agency action under 5 U.S.C. § 704.
- Any inquiry concerning this communication should be directed to Cynthia L. Nessler, Senior Legal Advisor, at 571-272-7724.

Brian E. Hanlon

Brian E. Hanlon
Director
Office of Patent Legal Administration

2 26 2012

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,488	11/15/2010	7062225	AFF.0003B1US	1590

21906 7590 10/28/2011
TROP, PRUNER & HU, P.C.
1616 S. VOSS ROAD, SUITE 750
HOUSTON, TX 77057-2631

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/28/2011

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HOUSTON, TX 77002

Date:

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OCT 28 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001488
PATENT NO. : 7062225
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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HOUSTON, TX 77057-2631

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OCT 28 2011

CENTRAL REEXAMINATION UNIT

(For Requester)

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

In re White	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 95/001,488	:	FOR REOPENING
Filed: November 15, 2010	:	PROSECUTION
For: U.S. Patent No.: 7,062,225	:	UNDER 37 CFR 1.181

This is a decision on a petition filed by the patent owner on July 12, 2011. The petition is entitled "PETITION UNDER 37 C.F.R. § 1.181 FOR WITHDRAWAL OF ACTION CLOSING PROSECUTION AS PREMATURE," and is a request to the Director to exercise her discretion pursuant to 37 CFR 1.181 and order a corrected Office action in place of the Action Closing Prosecution issued on June 13, 2011.

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

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated July 12, 2011 is denied with respect to withdrawing the ACP dated June 13, 2011 in the *Inter Partes* reexamination proceeding 95/001,488.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,062,225 (hereinafter, the '225 patent) issued on June 13, 2006.

2. A request for *inter partes* reexamination, assigned control No. 95/001,488, was filed by a third party requester on November 15, 2010.

3. *Inter partes* reexamination was ordered for the '488 reexamination proceeding on January 28, 2011. On the same day, a non-final Office action was mailed in the '488 reexamination proceeding.

4. On March 28, 2011 the patent owner filed a response. The response included amendments to independent claim 1 and added proposed new claims 9-14.

5. On April 27, 2011, the third party requester filed comments. The comments addressed the new limitations added to independent claim 1 (see, e.g., page 7) and the patentability of proposed new claims 9-14 (see, e.g., pages 21-35).

6. On June 13, 2011, the Office mailed an Action Closing Prosecution (ACP), which addressed the patent owner's response and the third party comments, was mailed. The ACP added the teachings of Abecassis, as proposed by the third party requester, to the previously applied rejections in response to patent owner's amendments and proposed new claims.

7. On July 12, 2011, the patent owner filed the above-mentioned petition under 37 CFR 1.181 to invoke the supervisory authority of the Director and requesting that a corrected Office action be mailed. The patent owner also filed comments in response to the ACP.

DECISION

The patent owner (petitioner) states that the ACP dated June 13, 2011 does not clearly develop the issues of patentability, because the ACP fails to clearly state each ground of rejection. Patent owner points to 37 CFR 1.949 and MPEP 2671.02 as the basis and explicitly identifies the rejections of Issue 2A and Issue 3, as labeled in the ACP, as being deficient. See pages 2-5 of the petition. Patent owner states that the ACP fails to clearly develop the grounds of these rejections in a manner sufficient to determine the basis for the rejections. Because of these grounds, petitioner requests that a corrected Office action should replace the ACP dated June 13, 2011.

Upon review of the record, it is noted that the ACP contains the same rejections in a similar format as presented in the non-final action of January 28, 2011 but added the teachings of Abecassis in response to patent owner's amendments and proposed new claims filed in response to the January 28, 2011 Office action. Compare the rejections identified on page 3 of the

January 28, 2011 Office action to the rejections identified on page 4 of the ACP. Specifically, the ACP incorporated the explanation presented in the request for the application of Hjelt in view of Vock and Root for Issue 2A and Vock in view of Rydbeck for Issue 3. Compare pages 9-11 in the January 28, 2011 Office action to pages 15-16 and 18-19 in the ACP. The ACP added the teachings of Abecassis because of the amendments to claim 1 and altered the rejections to account for proposed new claims 9-14. The ACP cited to specific pages in the third party requester's comments that discussed the teachings of Abecassis and the application of the cited art to proposed new claims 9-14 (see, e.g., pages 16 and 18 of the ACP). For example, the explanation for the rejection of claims 1, 3-8, and 12 based on Hjelt in view of Vock, Root, and Abecassis refers to pages 9-14 and 28-29 of the third party requester's comments. Pages 9-14 of the comments discuss the application of Abecassis to claim 1 as amended in the context of the original rejection based on Hjelt, Vock, and Root. Pages 28-29 of the comments discuss the application of Abecassis to the limitations of proposed new claim 12. In regard to the examiner's comment in the last paragraph on page 23 of the ACP, the examiner explained that certain proposed rejections (e.g., adding the teaching of Abecassis to the previously identified proposed rejections in the request) were adequately explained, but the broad statement made by the requester encompasses other unidentified new proposed rejections. It is these unidentified proposed rejections that lacked a sufficient explanation for the examiner to adequately evaluate. Therefore, upon review of the record, ACP treated all the claims present in the proceeding by setting forth all rejections and only issued new grounds of rejections that were necessitated by an amendment. In other words, the ACP is in compliance with the requirements of 37 CFR 1.949 and the guidelines of MPEP 2671 et seq.

To the extent that the grounds of argument presented in the petition address the merits of the examiner's determinations, these issues are appealable (and not petitionable) issues. See MPEP 1201 and 1002. Specifically, the issue of whether the examiner set forth a proper prima facie showing of obviousness is an appealable issue, and therefore, cannot be addressed by petitions. Therefore, the merits of the examiner's actions will not be addressed in this decision.

In response to petitioner's general arguments for reopening prosecution in this reexamination proceeding, the Director finds there are not good and sufficient reasons to do so. First, 35 U.S.C. 314(c) requires that all *inter partes* reexamination proceedings to be acted upon with "special dispatch." The rules and procedures of the Office were established through notice and comment in order to achieve special dispatch in a reasonable manner. The Office rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing an action closing prosecution (ACP). The record shows that the examiner followed the statutory mandate of "special dispatch" by issuing the ACP because the ACP did not introduce any new grounds of rejection that were not necessitated by the amendment and proposed new claims. Therefore, the record shows that the ACP was not premature. Accordingly, the record shows that the examiner appropriately followed Office rules and procedures in the determination to issue an ACP, and did not categorically deprive the patent owner of its statutory rights to present amendments and arguments in reexamination proceedings.

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

CONCLUSION

1. The July 12, 2011 petition under 37 CFR 1.181 for reconsideration of the Action Closing Prosecution dated June 13, 2011 is **denied**.

2. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, 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.
95/001,489	11/15/2010	7251454	AFF.0003B2US	1636

21906 7590 06/13/2011

TROP, PRUNER & HU, P.C.
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Date:
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JUN 13 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001489
PATENT NO. : 7251454
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,489
Filed: November 15, 2010
For: U.S. Patent No. 7,251,454

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

This is a decision on the March 21, 2011 patent owner petition entitled "PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE PAGE LIMIT REQUIREMENT FOR THE PATENT OWNER REPLY UNDER 37 C.F.R. § 1.943(b)."

The petition requests waiver of the requirement of 37 CFR 1.943(b) that the patent owner response not exceed fifty (50) pages in length, and requests that the page limit be extended to 96 pages. Patent owner timely filed its response pursuant to 37 CFR 1.945 concurrently with the petition.

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

Patent owner's petition under 37 CFR 1.183 to waive the 37 CFR 1.943(b) limit as to the number of pages permitted in patent owner's response is dismissed.

DECISION

In the instant petition, patent owner requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for patent owner's response filed on March 21, 2011 to address the January 21, 2011 non-final Office action, and requests that the page limit be extended to 96 pages.[1]

[1] Petition at 1.

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a response in compliance with the 50-page limit, and submission of the resulting response paper that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response submission can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response submission: (1) for justification that more pages are needed to complete the response submission, and (2) to set forth an accurate determination of exactly how many additional pages are needed to complete the response submission.

The instant petition under 37 CFR 1.183 has been fully considered. In this instance, petitioner patent owner's March 21, 2011 response includes 19 pages of remarks, which are subject to the 50 page limit. Appendix A is a one page claim chart showing alleged support for the new claims, and is counted toward the page limit.

The patent owner response includes an eight-page declaration of Russell White under 37 CFR 1.132. There are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, i.e., evidence of **technological** facts, or whether the affidavit or declaration is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03 -716.06, respectively, will not be included in the page count.

The eight-page declaration of White presents only objective evidence of secondary considerations, specifically evidence of copying and commercial success, is free of legal argument and therefore does not count against the regulatory page limit.

Regarding Exhibit E, which accompanies the White declaration, the claim charts presented in Exhibit E are not comparing the limitations of the claims under the present reexamination with the teachings of a reference cited against the claims. Rather, the claim charts are comparing the present invention to that of a device which patent owner alleges is infringing the claims of the patent under reexamination, in addition to other related patents that are not subject to this reexamination proceeding. For these reasons, the claim charts of Exhibit E are not included in

the page count. Thus, the March 21, 2011 patent owner response includes 20 pages which are counted toward the page limit.

Further, patent owner's March 21, 2011 submissions have been reviewed by the Central Reexamination unit (CRU) and determined to be compliant with the 50-page limit requirement of 37 CFR 1.943(b).

For the reasons given above, waiver of 37 CFR 1.943(b) is not necessary for patent owner's March 21, 2011 submission. Accordingly, the instant petition under 37 CFR 1.183 is dismissed.

CONCLUSION

1. Patent owner's March 21, 2011 petition is dismissed. Patent owner's response filed on March 21, 2011 is page-length compliant.

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

/Kenneth M. Schor/

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.
95/001,489	11/15/2010	7251454	P12615USREX3	1636

82427 7590 02/02/2012

KRAMER LEVIN NAFTALIS & FRANKEL LLP
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Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001489
PATENT NO. : 7251454
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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KRAMER LEVIN NAFTALIS & FRANKEL LLP 1177 AVENUE OF THE AMERICAS NEW YORK, NY 10036	: : : :	(For Third Party Requester)[1]

MAILED
FEB 02 2012
CENTRAL REEXAMINATION UNIT

In re: White *Inter Partes* Reexamination Proceeding Control No.: 95/001,489 Deposited: November 15, 2010 For: U.S. Patent No.: 7,251,454	: : : : :	DECISION ON PETITION UNDER 37 CFR § 1.181

This is a decision on a petition filed by the third party requester on July 13, 2011 entitled: "SECOND PETITION UNDER 37 C.F.R.. § 1.181, OR IN THE ALTERNATIVE 37 C.F.R. § 1.182, FOR SUPERVISORY REVIEW OF THE JUNE 13, 2011 DECISION DISMISSING PATENT OWNER'S MARCH 21, 2011 PETITION" [hereinafter "the petition"].

Despite the title, the petition is actually a request for the Director to exercise his supervisory authority pursuant to 37 CFR § 1.181 to review the examiner's action of allegedly failing to wait an appropriate time before issuing an Office action, thus failing to consider the requester's later filed comments submission. The "FIRST" petition, filed on the same date, is drawn to the propriety of the June 13, 2011 petition decision and will be decided separately.

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

[1] Note that per the communication filed November 15, 2011, the third party requester has acquired the '454 patent.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,251,454 issued on July 31, 2007.
- A request for *inter partes* reexamination was filed on November 15, 2010 and assigned control no. 95/001,489.
- *Inter partes* reexamination was ordered and a first Office action was mailed on January 21, 2011.
- On March 21, 2011, patent owner filed a response to the Office action. Patent owner also filed a petition under 37 C.F.R. § 1.183 to waive the page limit requirement.
- On June 13, 2011, the Office of Patent Legal Administration ["OPLA"] issued a decision dismissing the petition, determining that waiver was unnecessary as the response was compliant with the page limit requirement as filed.
- On June 30, 2011, the examiner issued an Action Closing Prosecution. This action did not consider any third party comments submission, as none had been filed at that time.
- On July 13, 2011, the third party filed comments to the patent owner's response, along with the instant petition.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. § 314 Conduct of inter partes reexamination proceedings (in part)

(b) RESPONSE. —

* * *

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

37 C.F.R. § 1.943 Requirements of responses, written comments, and briefs in *inter partes* reexamination (in part)

(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.

MPEP § 2666.05 Third Party Comments After Patent Owner Response (in part)

I. TIMELINESS

A third party requester may once file written comments on any patent owner response to an Office action, during the examination stage of an *inter partes* reexamination proceeding. The third party requester comments must be filed within a period of 30 days from the **date of service** of the patent owner's response on the third party requester. 37 CFR 1.947. . . .

If the third party requester comments are filed after 30 days from the **date of service** of the patent owner's response on the third party requester, the comments will not be considered. See 37 CFR 1.957(a).

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

DECISION

The third party requester ["petitioner"] argues that it should have had an opportunity to file comments to the patent owner's response. Patent owner's response was filed with a petition to waive the page limit requirement. OPLA determined that the response was already compliant and dismissed the page limit waiver petition. The third party filed comments within 30 days of OPLA's decision, but well after 30 days from the date of service of the response as filed. The examiner issued an Office action without waiting for or considering the third party's comments.

First, to be clear, this decision addresses only the propriety of the examiner's action of issuing an Office action without waiting for or considering the third party's comments submission. This decision does not address whether OPLA's decision was correct. That issue is the subject of the "FIRST" petition filed on the same date as the present petition, and will be addressed in a separate decision. If the "FIRST" petition is granted then that might change the result presented herein, but if that is the case any change will be explained in the decision on that petition.

In some situations a patent owner may file a response that is not compliant with the page limit requirements, along with a petition to waive said requirements. This non-compliant response is not considered an official response until it is completed by the granting of the page limit waiver petition. Only at that point does the response become a proper and complete response, therefore the date of the response is deemed to be the date that the page limit waiver is granted. Accordingly, the third party will have 30 days from the date the petition is granted to file comments. This procedure is outlined in MPEP § 2666.05, and was further explained in Control No. 95/001,206, Decision Denying Petition Under 37 C.F.R. § 1.181, April 19, 2011 (cited by petitioner).

Of course, that situation is not the same as the present situation. Here, the patent owner filed a response that included a petition to waive the page limit, but the response was ultimately determined by OPLA to be compliant. The response was therefore a fully complete and compliant response as of the date it was filed. Because it was a fully complete and compliant response as of its filing date, it was a response within the meaning of the statute as of its filing date. Accordingly, the actual date of service, March 21, 2011, is the controlling event under 35 U.S.C. § 314(b)(2). The third party's comments submission was filed nearly four months after that date, far exceeding the time permitted by statute. As the comments were filed after the statutory time period, the examiner's act of not waiting for or considering the comments was not improper. The petition is denied.

Petitioner argues that this result is unfair in light of the guidance given in MPEP § 2666.05. It states that it fully intended to file comments in accordance with § 2666.05, within 30 days from

the date the page limit waiver petition was granted. It argues that the plain language of § 2666.05 states that the patent owner response is incomplete until the petition waving the page limit is granted, and there is no indication that the Office will retroactively accept the earlier date if it determines that the original response was actually compliant.

Petitioner's complaint about § 2666.05 is irrelevant because the quoted portion is explicitly drawn to a patent owner response where "the page length of the response exceeds the page length set by 37 CFR 1.943(b)." MPEP § 2666.05. Here, the page length does not exceed the page limit of the rules when the pages are counted properly. In other words, the section presumes a non-compliant response, and does not address the circumstance where the response was compliant but also included a petition for waiver of the page limit. In any case, there is no "retroactive" accepting of the filing date. Because the response was compliant as of its filing date, that date always was its effective date. Only in the case where a response is non-compliant does it not gain a date until it is effectively completed by the granting of a petition.

Petitioner no doubt believes it is unfair that, on March 21, it did not know whether OPLA would or would not determine that the response was compliant. Of course, nothing prevents the third party from filing its comments submission within 30 days of the original date of service of the response, regardless of whether it might or might not actually be accorded a later date. It is not as if this would have created much potential unnecessary work for petitioner, as the vast majority of page limit waiver petitions are ultimately granted. Petitioner essentially played a strategic game in waiting to file its comments, and in this particular situation it lost that game.

Petitioner further argues that the 95/001,206 Decision, *supra*, supports its view. The entire basis of that decision was that the patent owner's response in that case was not a "response" within the meaning of the statute because it was not compliant. Only when OPLA granted a waiver of the page limit requirements did the response become a "response" under the statute, triggering the 30 day time period. As described herein, OPLA determined that patent owner's March 21 response was a complete and valid response at the time of filing. Thus, it was always a "response" under the statute, and the date of service was the triggering event under the statute. 95/001,206 is simply a different situation.

It is not up to the parties to determine when a submission is compliant with the Office's rules. A party does not "admit" that a response is non-compliant by filing a petition or even by stating that it believes its response was non-compliant. The statute requires that comments be filed within 30 days of the date of service of the response, and here OPLA has determined that the date of service of the response is March 21, 2011. The comments were not timely under the statute. Accordingly, the petition is <u>denied</u>.

CONCLUSION

1. The petition filed July 13, 2011 is denied. The third party comments filed July 13, 2011 are untimely and are expunged from the record.

2. The Action Closing Prosecution mailed June 30, 2011 is not withdrawn.

3. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.

Irem Yücel
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,489	11/15/2010	7251454	P12615USREX3	1636

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/28/2012

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

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(For Patent Owner and
Third Party Requester)

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CENTRAL REEXAMINATION UNIT

In re White
Inter Partes Reexamination Proceeding
Control No. 95/001,489
Filed: November 15, 2010
For: U.S. Patent No. 7,251,454

: **DECISION**
: **DENYING**
: **PETITION**

This is a decision on requester's July 13, 2011 petition entitled "First Petition under 37 C.F.R. § 1.181, or in the alternative 37 C.F.R. § 1.182, for Supervisory Review of the June 13, 2011 Decision Dismissing Patent Owner's March 21, 2011 Petition" (the July 13, 2011 petition).

The July 13, 2011 petition is before the Office of Patent Legal Administration.

SUMMARY

The July 13, 2011 petition is **granted to the extent that** the June 13, 2011 petition has been reviewed by the Director of the Office of Patent Legal Administration, but is **denied** as to the underlying relief requested. The June 13, 2011 decision is **proper**, and **is being maintained**.

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

DECISION

The requester argues that it has standing to contest the June 13, 2011 decision dismissing as moot patent owner's March 21, 2011 petition requesting waiver of the page length requirements of 37 CFR 1.943(b), and holding patent owner's response to be page-length compliant.[1] By statute, the requester has only one opportunity to file its comments within 30 days of the date of service of patent owner response. See 35 U.S.C. 314(b)(2). In the present case, the requester failed to timely file its comments within 30 days of the date of service of patent owner's compliant response. Instead, the requester filed its comments on July 13, 2011, *i.e.*, within 30 days of the June 13, 2011 decision.. Had the Office determined, in its June 13, 2011 decision, that patent owner's response required a waiver of the page limit, and had the decision granted the requested waiver of the page limit, the requester would have been given 30 days from the June

[1] The Office notes that the power of attorney for both the patent owner and requester Apple Inc., and the statement under 37 CFR .3.73(b), all of which were filed on November 15, 2011, cause the attorney of record, and the correspondence address, for both the patent owner and the requester, to be identical. Requester Apple, Inc. has informed the Office that it has acquired the rights of the patent under reexamination, and is now also the patent owner.

13, 2011 date of the decision granting the page limit waiver to file its comments, causing requester's July 13, 2011 comments to be considered timely. For this reason, the requester has standing to contest the June 13, 2011 decision.

The requester argues that it "was aware of the . . . guidance provided in MPEP § 2666.05(I)", and that "based on that guidance, Requester believed that its written comments became due within 30 days of June 13, 2011, the date of the . . . Decision . . . Therefore, Requester had filed written comments on July 13, 2011. . .". In essence, the requester argues that it intentionally waited until after the mailing of the June 13, 2011 decision before deciding to file its comments, due to an erroneous interpretation of MPEP 2666.05(I). The guidance set forth in MPEP 2666.05(I), however, only applies in the unique circumstance where the patent owner files a petition for waiver of the regulatory page limit in conjunction with a response to an Office action that exceeds the page length requirement.

In some situations, a patent owner may file a response that is not compliant with the page limit requirements, along with a petition to waive these requirements. This non-compliant response is not considered to be an official response until it is completed by the granting of the page limit waiver petition. Only at that point does the response become a proper and complete response. Therefore, the date of the response is deemed to be the date that the page limit waiver is granted. Accordingly, the requester is given 30 days from the date of the decision granting the petition requesting waiver of the page limit to file its comments.

In the present case, the patent owner filed a response accompanied by a petition to waive the page limit. Patent owner's response, however, was determined to be compliant with the page length requirements. Because it was a proper and complete response as of its March 21, 2011 filing date, the March 21, 2011 response was a "response" within the meaning of 35 U.S.C. 314(b)(2). Requester's comments were filed well after the statutory due date, i.e., nearly four months after the March 21, 2011 date of service of patent owner's response, and for this reason, were properly considered to be untimely.

In addition, the requester effectively admits that it intentionally waited until after the mailing of the June 13, 2011 decision before deciding to file its comments. Even ignoring the provisions of 35 U.S.C. 314(b)(2), the Office cannot, as a matter of policy, permit a procedural delay caused by requester's deliberate decision to wait until the mailing of the June 13, 2011 decision to draft its comments, due to the Office's mandate for special dispatch. See 35 U.S.C. 314(c).

The requester further argues that the Office's determination, in the June 13, 2011 decision, that patent owner's response complied with the page length requirements was "clearly erroneous". The requester argues that "authority in fact exists that explains the nature of declarations in reexamination proceedings", and points to a July 14, 2004 decision in another reexamination proceeding, control no. 95/000,016.[2] See, however, the Office policy set forth in the Manual of Patent Examining Procedure, (MPEP), Section 2667, published in July of 2008. MPEP 2667 provides, in pertinent part (emphasis added):

[2] The July 14, 2004 decision dismissed an earlier petition by the patent owner in that proceeding, requesting that the comments of the requester in that proceeding "be returned" under 37 CFR 1.939 as an unauthorized paper.

> 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.

The June 13, 2011 decision is entirely consistent with the policy set forth in the MPEP. The Office determined that the 19 pages of remarks, which were submitted with patent owner's response, included arguments that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, and were subject to the page limit. The one-page claim chart, attached as Appendix A to patent owner's response, alleged support for the newly added claims, and was also determined to be subject to the page limit. The requester does not dispute these findings.

The Office further determined that the declaration under 37 CFR 1.132 of Russell White was limited to factual evidence and free of legal argument, and thus not subject to the regulatory page limit requirement. Finally, the Office determined that while Exhibit E, which accompanied the White declaration, included claim charts, these claim charts were not subject to the regulatory page limit requirement, because the claim charts are not comparing the limitations of the claims under the present reexamination with the teachings of a reference cited against the claims. Rather, the claim charts are comparing the present invention to that of a device which patent owner alleges is infringing the claims of the patent under reexamination, and are provided as alleged evidence of copying (see, e.g., page 4 of the White declaration). For this reason, the claim charts of Exhibit E were not included in the page count. Thus, the Office determined that the March 21, 2011 patent owner response includes only 20 pages which are subject to the page limit and that the March 21, 2011 patent owner response was page-length compliant. For these reasons, the June 13, 2011 decision dismissed as moot patent owner's March 21, 2011 petition requesting waiver of the page length requirements.

The requester specifically argues that the findings by the Office that patent owner's March 21, 2011 response was page length compliant is clearly erroneous regarding the number of pages of legal arguments contained in the response in light of the White declaration and Exhibit E. The requester asserts that pages 2-8 of the White declaration contain legal arguments directed to the

issues of copying and commercial success, and that the claim charts of Exhibit E, cited by the White declaration for factual support regarding the secondary considerations, contains impermissible "infringement contentions." The requester essentially argues that because these pages contain some form of argument in general, they should be subject to the regulatory page limit requirement.

As stated in the June 13, 2011 decision, 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.
Such affidavits or declarations do, of course, contain opinions that the facts or materials proffered with or within the declaration ***are*** evidence that establishes e.g., copying, etc. For example, where, as here, the pages of a declaration under 37 CFR 1.132 are limited to the opinion that the exhibits attached to the declaration provide evidence of copying, such pages are not subject to the page limit because the opinion is solely directed to whether the proffered materials are evidence of copying, and not whether the materials, regardless of whether they are ultimately determined to be evidence, provide a showing that is sufficient to overcome a rejection of record. The Office permits the filing of ***evidence*** to support requester's arguments. Such evidence may include patents, printed publications, and ***evidence*** of secondary considerations of non-obviousness. When, however, the declaration additionally includes legal arguments, for example, that ***an outstanding rejection is overcome by*** the proffered evidence, then the pages that include these arguments are subject to the page limit and are counted. Arguments that an outstanding rejection is overcome, or that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, are subject to the page limit.

The requester argues that the claim charts in Exhibit E do <u>not</u> constitute evidence, but are infringement contentions that should count against the 50-page limit. The requester asserts that the June 13, 2011 decision's conclusion that the White declaration is free of legal argument is in error, because the White declaration opines upon secondary considerations of copying and commercial success and cites to Exhibit E, which includes patent owner's infringement contentions. The issue, however, is not whether the proffered declaration and attached exhibits are free of all argument, but whether the declaration and the attached exhibits are limited to arguments that the materials provide evidence of secondary considerations of nonobviousness and do not include arguments that the evidence submitted <u>overcomes a rejection of record</u>, or that it renders the claims of the patent under reexamination anticipated or obvious.

The requester further argues that the patent owner candidly admits that "all 8 pages of the White declaration are 'directed to respond to the Office action', and that the 'Declaration of Russell W. White references Exhibit E, which includes 69 pages of infringement contentions'." The fact that the White declaration responds to the Office action or that Exhibit E includes 69 pages of infringement contentions is not relevant as to which pages of the White declaration or of Exhibit E are counted toward the page limit. In the present case, the White declaration was properly determined to be free of legal argument directed to whether an outstanding rejection was overcome, or whether the art anticipates or render obvious the claims, or specific claim elements, of the patent under reexamination. The White declaration, and Exhibit E were not found to contain such arguments. The requester has not shown that the White declaration, or Exhibit E contained such arguments.

Regarding the July 14, 2004 decision in reexamination proceeding control no. 95/000,016 (the '016 proceeding), the requester argues that this decision "provides guidance on the issue of including the pages of a 37 CFR § 1.132 declaration against the page limit of 37 C.F.R. § 1.943(b), and in doing so relies on case law that provides a 'test' for determining whether an affidavit or declaration is to be counted against that page limit". In that decision, the Office determined that three pages of a 21-page declaration under 37 CFR 1.132 were subject to the page length requirements of 37 CFR 1.943(b), because these pages contained arguments "that the combination of the teachings of the references would motivate one skilled in the art to prepare the claimed invention", i.e., arguments directed to how an outstanding rejection is overcome. For this reason, those three pages were added to a 36 page remark section submitted as part of requester's comments in the '016 proceeding, to obtain a total of 39 pages subject to the 50-page limit. Because the total of 39 pages was less than the 50-page limit set by 37 CFR 1.943(b), requester's comments in the '016 proceeding were determined to be page-length compliant. The outcome in the '1489 proceeding is effectively indistinguishable from the outcome of the June 13, 2011 decision, except that none of the pages of the declaration at issue in the '1489 proceeding were found to contain relevant legal argument that would result in the declaration, or portions of the declaration, being counted against the 50-page limit.

Also in the July 14, 2004 decision, the Office made the initial general determination that the declaration filed in that proceeding "constitutes extrinsic evidence", and that as such, the declaration may be considered in that reexamination proceeding. The Office supported this determination by stating that "it is well settled that extrinsic evidence may be considered [in a reexamination proceeding] when it is used to explain, but not expand, the meaning of a reference", relying on *In re Baxter Travenol Labs,* 21 USPQ2d 1281, 1284 (Fed. Cir. 1991), *In re Chambers*, 20 USPQ2d 1470, 1474 (Comm'r Pats. 1991), *Scripps Clinic & Research Foundation v. Genentech Inc.,* 18 USPQ2d 1001 (Fed. Cir. 1991), and *Heinl v. Godici*, 143 F. Supp.2d 592, 604 (E.D. Va. 2001). Thus, the Office determined that the case law supports the position that a declaration under 37 CFR 1.132 which is used to explain, but not expand the meaning of a reference, *may be considered in a reexamination proceeding*. Again, this determination is consistent with the Office policy as set forth in MPEP 2667, outlined above. The Office then determined that the content of the (remaining) pages of the declaration under 37 CFR 1.132 filed in that proceeding, which were directed to comments on the scope and teachings of the cited prior art references, would not be subject to the 50-page limit imposed by 37 CFR 1.943(b). This determination, however, is not relevant to the issue in the present case, which involves a declaration directed to alleged evidence of secondary considerations rather than to comments on the scope and teachings of the cited prior art references.

The requester points to language in the July 14, 2004 decision, i.e., that "any affidavit or declaration (or clearly-defined portion thereof) that is not directed to further defining the scope and content of a prior art reference would not be 'reference material such as prior art references' and would count against the 50-page limit *of requester's comments*" (emphasis added). The requester generalizes that this language is a "test" for determining whether papers other than the requester's comments filed in that proceeding are to be subject to the 50-page limit. The declaration at issue in that proceeding, however, did not involve an alleged showing of secondary

considerations.[3] Thus, the July 14, 2004 decision was directed to declarations filed by the requester, and did not contemplate the issue of which pages of a patent-owner-filed declaration under 37 CFR 1.132, which is directed to alleged evidence of secondary considerations of nonobviousness, are to be subject to the 50-page limit. As stated in the June 13, 2011 decision, there are no *per se* rules for determining whether a document, such as an affidavit or declaration, contains a relevant legal argument that will cause the document to be subject to the page count. Each determination is made on a case-by-case basis. The July 14, 2004 decision stated, in effect, that any affidavit or declaration (or clearly defined portion thereof), which is filed by the requester in that proceeding and which is not directed to further defining the scope and content of a prior art reference would count against the 50-page limit *of requester's comments filed in that proceeding.*

Finally, the requester effectively argues that the *Heinl* decision supports requester's generalized assumption that *all* declarations other those "further defining the scope and content of a prior art reference" in *all inter partes* reexamination proceedings would be subject to the 50-page limit. However, the *Heinl* decision does not provide such support, nor has the requester pointed to any other case law that provides support for such a generalization. The *Heinl* court stated, in a footnote, that "any affidavits or declarations that were submitted to support a breach of candor claim, as opposed to materials submitted to explain the pertinence of the patents and printed publications, must be excluded", i.e., ***from submission in a reexamination proceeding***. In other words, the court stated that the issue of a breach of the duty of candor is not an issue within the scope of reexamination, which is entirely consistent with Office policy, and which is not relevant to the declaration at issue in either the present proceeding or in the '016 proceeding, neither of which involved the issue of a breach of the duty of candor. In *Heinl*, the court stated, in the same footnote, that "[a] different result [i.e., that evidence such as a declaration *may not be considered in a reexamination proceeding*] *might* be obtained if the documents [such as declarations] did not relate to an explanation of the printed publications, but rather to other issues of validity and enforceability [such as a breach of the duty of candor]" (emphasis added). In other words, the court stated that, depending on the facts and circumstances, a declaration that does not relate to an explanation of the printed publications *might* not be permitted to be considered, if it involves an issue that is not within the scope of reexamination. The *Heinl* court did ***not*** hold that, in *inter partes* reexamination proceedings, all declarations other than those directed to further defining the scope and content of the prior art references would be subject to the page length requirements of 37 CFR 1.943(b). In fact, the reexamination proceeding at issue in the *Heinl* court was an *ex parte* reexamination proceeding, not an *inter partes* reexamination proceeding.[4] There are no regulations governing the page length of patent owner's responses to an Office action in an *ex parte* reexamination proceeding, nor are there any such regulations governing requester's reply to patent owner's statement under 35 U.S.C. 304. The issue of which pages of a declaration *properly* submitted in an *inter partes* reexamination proceeding, i.e., a declaration directed to issues within the scope of reexamination, are subject to the 50-page limit imposed by 37 CFR 1.943(b), was not before the court. Thus, there is simply no support in *Heinl* for the generalization that *all* declarations other than those "further defining the scope and content of a

[3] Nor would it, since the declarations at issue involved declarations filed by the requester, not by the patent owner. The requester is not likely to file a declaration alleging secondary indicia of nonobviousness.

[4] This is also true for any of the other case law cited in the July 14, 2004 decision, i.e., *Baxter Travenol Labs, Chambers, and Scripps Clinic and Research Foundation.*

prior art reference" in *all inter partes* reexamination proceedings would be subject to the 50-page limit imposed by 37 CFR 1.943(b).

For the reasons given above, the June 13, 2011 decision dismissing as moot patent owner's March 21, 2011 petition requesting waiver of the page length requirements set forth in 37 CFR 1.943(b) is **proper**. Accordingly, the July 13, 2011 petition, filed by the requester in the present proceeding, is **dismissed**.

In summary, in the present case, the June 13, 2011 decision properly held that the March 21, 2011 patent owner's response is compliant with the page length requirements of 37 CFR 1.943(b). The requester was required, pursuant to 35 U.S.C. 314(b)(2), to file any written comments by April 21, 2011, 30 days after the date of service of patent owner's response. Not only did requester fail to do so, requester intentionally decided to wait until after the mailing of the June 13, 2011 decision to file comments, which was well past its April 21, 2011 statutory due date. For this reason, requester's July 13, 2011 comments were not timely filed, and will not be considered.

CONCLUSION

- The July 13, 2011 petition is **granted to the extent that** the June 13, 2011 petition has been reviewed by the Director of the Office of Patent Legal Administration, but is **denied** as to the underlying relief requested.
- The June 13, 2011 decision is **proper**, and **is being maintained**.
- This decision is designated as a final agency action under 5 U.S.C. § 704.
- Any inquiry concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.

Brian E. Hanlon

Brian E. Hanlon
Director
Office of Patent Legal Administration

2 26 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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Hamilton, Brook, Smith & Reynolds, P.C. (For Patent Owner)
530 Virginia Road
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Concord, MA 01742-9133

MAILED
JUN 27 2011
CENTRAL REEXAMINATION UNIT

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1100 New York Avenue, N.W.
Washington, D.C. 20005

Klarquist Sparkman, LLP (Courtesy Copy)
121 S.W. Salmon Street
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Portland, OR 97204

In re Schlecht :
Inter partes Reexamination Proceeding : **DECISION**
Control No: 95/001,491 : **DISMISSING**
Filing Date: November 16, 2010 : **PETITION**
For: U.S. Patent No.: 7,269,034 :

This is a decision on the April 18, 2011 patent owner petition under 37 CFR 1.182, entitled "Petition to Stay *Inter Partes* Reexamination" (the April 18, 2011 patent owner petition under 37 CFR 1.182).

This decision also addresses the powers of attorney, change of correspondence address, and statements under 3.73(b) filed by the patent owner in the present reexamination proceeding on April 18, 2011, and in the 7,269,034 patent file, application no. 11/509,146, on June 20, 2011.

The April 18, 2011 patent owner petition under 37 CFR 1.182, the powers of attorney, change of correspondence address, and statements under 37 CFR 3.73(b), filed by the patent owner in the present proceeding on April 18, 2011, and in the 7,269,034 patent file on June 20, 2011, and the record of the present reexamination proceeding as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

The April 18, 2011 patent owner petition under 37 CFR 1.182 is **dismissed**.

The powers of attorney, change of correspondence address, and statements under 37 CFR 3.73(b), filed by the patent owner in the present proceeding on April 18, 2011 and in the 7,269,034 patent file, application no. 11/509,146, on June 20, 2011, are **ineffective**.

DECISION

The patent owner requests the Office to suspend the present *inter partes* reexamination proceeding.

MPEP 2686.04 provides, in pertinent part (emphasis added):

> [35 U.S.C. 314(c)][1] thus authorizes the Director of the USPTO **to suspend (stay) reexamination proceedings, where there is good cause to do so**, pending the conclusion of litigation based on a potential for termination of a reexamination prosecution under 35 U.S.C. 317(b). Thus, a District Court decision that is pending appeal on the validity of the same claims considered in an *inter partes* reexamination proceeding may provide the requisite statutory "good cause" for suspension, due to the real possibility that the 35 U.S.C. 317(b) estoppel may attach in the near future to bar/terminate the reexamination proceeding.

Factors to be considered in determining whether it is appropriate to suspend action in the reexamination are:

A. Whether the third party requester is a party to the litigation;

B. Whether the claims in suit are identical to the claims under reexamination;

C. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the litigation;

D. Whether the litigation has advanced to a late enough stage that there is a sufficient probability that a final decision will be adverse to the requester; and

E. Whether there is a concurrent *ex parte* reexamination proceeding for the patent.

The patent owner argues that good cause exists to suspend the present proceeding because the requester, Lineage Power Corporation, is a co-defendant in the copending litigation, *SynQor, Inc. v. Artesyn Technologies, Inc. et al.*, Civil Action No. 2:07-CV-497-TJW-CE (E.D. Tex.). Upon brief review of the multitude of court documents filed in the present proceeding, the Office has verified that the requester, Lineage Power Corporation, is a co-defendant in the copending litigation, which satisfies item A.[2]

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[1] 35 U.S.C. 314(c) provides, in pertinent part (emphasis added):

> **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.

[2] The patent owner is reminded that the patent owner has the burden of providing a sufficient showing of the above-listed factors, including whether the requester is a co-defendant to the litigation. Merely stating that the requester is a co-defendant in the litigation is insufficient. In the present case, the Office was able to verify patent owner's statement after brief review. However, if more than a brief review of the voluminous number of court documents is

The patent owner further asserts that the claims at issue in the reexamination are identical to those in the litigation. The patent owner states that prior to trial, the district court instructed the parties to agree on a representative number of claims for trial management purposes, and that the parties agreed to try claim 9 as a representative claim of the '034 patent. The patent owner, however, has not pointed to, and provided as an attachment to the present petition, a copy of any court document that includes, for example, the court's instructions regarding the requirement to select representative claims, such as the court's order to select representative claims, or a court document that includes a statement by the patent owner regarding the court's requirement to select representative claims. Furthermore, the patent owner has not pointed to, and provided as an attachment to the present petition, any court document that sets forth which claims of the '034 patent were the subject of the litigation *prior to* the court's requirement to select representative claims. In other words, the patent owner has not provided evidence showing which group of claims is represented by the representative claim. For this reason, the patent owner has not sufficiently shown that the claims at issue in the litigation are identical to the claims in reexamination, i.e., claims 1-4, 7-16, and 20-28 of the '034 patent. Thus, item B has <u>not</u> been shown to have been satisfied.[3]

The patent owner asserts that the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the litigation. To support its assertion, the patent owner points to exhibit A of the present petition, which is a court document, filed on November 1, 2010 by the co-defendants in the copending litigation, that identifies prior art "that may anticipate or showing [sic] the state of the art" pursuant to 35 U.S.C. 282, and that "reserves the right to modify or supplement this disclosure". As argued by the patent owner, this court document cites each of the five references cited by the requester/co-defendant Lineage Power Corporation in the request for reexamination. The Office further notes

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required to determine the above factors, then the showing of the patent owner will be determined to be insufficient, as discussed *infra*.

[3] Regarding patent owner's footnote no. 3, appearing on page 3 of the present petition, the patent owner is reminded that any evidence filed in support of a petition must either be concurrently filed as an exhibit, or an attachment, to the petition, or, if the evidence has been filed prior to the petition, the evidence must be referenced in the petition such a manner that the evidence may be quickly located in the file of the reexamination proceeding after only a brief review. This is necessary due to the Office's statutory mandate to conduct reexamination proceedings with special dispatch, pursuant to 35 U.S.C. 314(c). In the present case, the patent owner has submitted, under 37 CFR 1.985, hundreds of pages of court documents as a "notice of concurrent proceeding" pursuant to 37 CFR 1.985, and has vaguely "pointed to" the documents cited in the present petition as having "been made of record in the'1491 Re-examination via Notice of Concurrent Proceedings/Court Action" (see footnote 3 of page 3 of the present petition). Due to the volume of petitions that are processed by the Office in reexamination proceedings, the time taken to peruse hundreds of pages of court documents in an effort to locate documents which may be, or which the patent owner asserts is, supportive of its petition is deemed to be overly burdensome, and prevents the Office from complying with its statutory mandate for special dispatch. For this reason, the patent owner must file, as as an attachment to any renewed petition that may be filed, a copy of any evidentiary document that is alleged to be in support of the present petition, and must appropriately reference the attachment in the present petition, so that the supporting passages in the document that are alleged to support the present petition may be located after brief review. **The patent owner is also reminded that the Office, in its sole discretion, may deem the volume of litigation papers filed under 37 CFR 1.985 to be too extensive, and may expunge all or part of the submission entitled "Notice of Concurrent Proceedings".** "In such instance, a party may limit the submission in accordance with what is deemed relevant, and resubmit the papers". See MPEP 2686. For this reason, any additional papers submitted in this proceeding under 37 CFR 1.985 will be viewed with scrutiny.

that the request for reexamination was filed with the Office prior the commencement of the trial in the litigation. For this reason, the patent owner has sufficiently shown that any issues raised in the reexamination proceeding were either raised or could have been raised prior to trial in the litigation. Thus, item C has been satisfied.

The patent owner further argues that the proceedings in the district court have reached an advanced stage. The patent owner states that the district court has entered a judgment on the jury verdict. The patent owner, however, has not pointed to, and provided as an attachment to the present petition, a copy of the court's judgment to support its statement. Furthermore, the patent owner has not provided any evidence[4] that an appeal has been filed with the Federal Circuit or that the time for filing all appeals has expired. For this reason, the patent owner has not shown that litigation has advanced to a late enough stage that there is a sufficient probability that a final decision will be adverse to the requester. Thus, item D has not been shown to have been satisfied.

Finally, Office records do not reveal the existence of a co-pending *ex parte* reexamination proceeding for the '034 patent, which satisfies item E.

See also *Sony Computer Entertainment America, Inc. v. Dudas*, 85 USPQ2d 1594 (E.D. Va. 2006), where the court upheld the Office's determination of "good cause" to suspend two related *inter partes* reexamination proceedings. The facts of the present case are clearly distinguishable from *Sony*. In *Sony*, the request for *inter partes* reexamination was not filed until after a final judgment in the district court was rendered. In the present case, however, the request for *inter partes* reexamination was filed before trial began. Furthermore, unlike *Sony*, the Office has already issued a non-final Office action rejecting all of the patent claims under reexamination, while in *Sony*, an action on the merits had not yet issued. Also, in *Sony*, an appeal had been filed and had been fully briefed. Thus, a final decision in *Sony* was on the horizon.[5] In the present case, however, the patent owner has not shown that an appeal to the Federal Circuit has been filed, or that the time for filing all appeals has expired. The patent owner has not shown that a final decision is expected in the near future. And, without a final decision adverse to requester, no estoppel can attach to bar the filing of an *inter partes* reexamination request or to mandate termination of an ordered reexamination proceeding. Stated another way, the fact that estoppel could possibly attach at some uncertain point in the future, as argued by patent owner, does not provide the requisite showing of good cause for suspension. Finally, reexamination in *Sony* was limited to the claims that were being litigated. In the present case, however, the patent owner has not shown that the claims in suit are identical to the claims under reexamination in the present proceeding - see the above discussion as to this point.

In summary, the patent owner has not provided a showing of good cause to suspend prosecution of the present reexamination proceeding.

Accordingly, the April 18, 2011 patent owner petition under 37 CFR 1.182 is **dismissed**. Pursuant to MPEP 2686.04, the present *inter partes* reexamination proceeding **will continue**, and **will not be suspended**.

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[4] Which must also be filed as an attachment to the present petition.

[5] A decision is "final" after all appeals, including any appeal to the Federal Circuit, have been exhausted.

If a renewed petition to suspend the present *inter partes* reexamination proceeding is later contemplated, **the factors explained in this decision must be addressed.**

The Powers of Attorney, Change of Correspondence Address, and Statements under 37 CFR 3.73(b) of the Patent Owner Are Ineffective

A power of attorney, change of correspondence address, and a statement under 37 CFR 3.73(b) were separately filed by the patent owner in the present proceeding on April 18, 2011, and in the patent file, application no. 11/509,146, on June 20, 2011. The statements under 37 CFR 3.73(b) must satisfy either 37 CFR 3.73(b)(1)(i) or 37 CFR 3.73(b)(1)(ii). The statements fail to satisfy 37 CFR 3.73(b)(1)(ii) because they fail to specify where documentary evidence of chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., by reel and frame number). Regarding 37 CFR 3.73(b)(1)(i), the statements under 37 CFR 3.73(b) are accompanied by a copy of a document purporting[6] to be documentary evidence of a chain to title from the original owner to the assignee. The patent owner, however, did not provide evidence that the alleged documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11 (i.e., the last box on form PTO/SB/96 was not checked), pursuant to 37 CFR 3.73(b)(1)(ii). Furthermore, Office records fail to reveal an assignment of the patent under reexamination *to* SynQor, Inc.[7] For these reasons, the statements under 37 CFR 3.73(b) filed by the patent owner in the present proceeding on April 18, 2011, and in the patent file, application no. 11/509,146, on June 20, 2011, are ineffective to establish ownership of the patent under reexamination by SynQor, Inc. As a result, the powers of attorney and change of correspondence address, each of which were signed by the executive vice president and general counsel of SynQor, Inc., are not acceptable.

For the reasons given above, the powers of attorney, change of correspondence address, and statements under 37 CFR 3.73(b), filed by the patent owner in the present proceeding on April 18, 2011 and in the patent file, application no. 11/509,146, on June 20, 2011, are **ineffective**.

A courtesy copy of this decision will be mailed to the practitioner who submitted the present patent owner petition, Mr. Richard D. McLeod. **Absent the filing of a properly executed power of attorney and change of correspondence address in the patent file, which is application no. 11/509,146, however, the attorneys of record in the present proceeding, and in the patent file, will continue to be those of the law firm of Hamilton, Brook, Smith & Reynolds, P.C., of Concord, MA, and all future correspondence will be mailed to the official correspondence address of record for the patent owner, i.e., the address of Hamilton, Brook, Smith & Reynolds, P.C., as shown in the caption of this decision.**

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[6] The Office does not make any determination as to the propriety of assignment documents. However, the Office wishes to alert the patent owner that the assignment document accompanying each of the statements under 37 CFR 3.73(b) does not appear to be related to the patent under reexamination (the document refers to application no. 11/407,699; however, a benefit claim under 37 CFR 1.20 to this application does not appear to have been filed in the patent file, application no. 11/509,146).

[7] Office records reveal an assignment ***by*** SynQor, Inc. ***to*** Bank of America, N.A.

CONCLUSION

- The April 18, 2011 patent owner petition under 37 CFR 1.182 is **dismissed**.
- The present *inter partes* reexamination proceeding will continue, and **will not be suspended**.
- The powers of attorney, change of correspondence address, and statements under 37 CFR 3.73(b), filed by the patent owner in the present proceeding on April 18, 2011 and in the patent file, application no. 11/509,146, on June 20, 2011, are **ineffective**. Absent the filing of a properly executed power of attorney and change of correspondence address in the patent file, which is application no. 11/509,146, however, the attorneys of record in the present proceeding, and in the patent file, will continue to be those of the law firm of Hamilton, Brook, Smith & Reynolds, P.C., of Concord, MA, and all future correspondence will be mailed to the official correspondence address of record for the patent owner, i.e., the address of Hamilton, Brook, Smith & Reynolds, P.C., as shown in the caption of this decision.
- The petition under 37 CFR 1.183 entitled "Petition to Waive Rules (37 CFR § 1.183)", also filed by the patent owner on April 18, 2011, **will be treated in due course**.
- Telephone inquiries related to this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.

Kenneth M. Schor

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

6-23-11
Kenpet8/IP/suspend

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,491	11/16/2010	7,269,034 B2	2882.001REX0	2397

24197 7590 02/02/2012

KLARQUIST SPARKMAN, LLP
121 SW SALMON STREET
SUITE 1600
PORTLAND, OR 97204

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/02/2012

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
STERNE,KESSLER,GOLDSTEIN AND FOX, PLLC
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

Date: **MAILED**

FEB 0 2 2012

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001491
PATENT NO. : 7269034
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

United States Patent and Trademark Office

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(For Patent Owner)

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CENTRAL REEXAMINATION UNI

Sterne, Kessler, Goldstein, & Fox, P.L.L.C.
1100 New York Avenue, N.W.
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(For *Inter Partes* Requester)

In re Schlecht
Inter Partes Reexamination Proceeding
Control No. 95/001,491
Filed: November 16, 2010
For: U.S. Patent No.: 7,269,034

DECISION

DISMISSING

PETITION

This is a decision on patent owner's April 18, 2011 combined petition entitled "Petition to Waive Rules (37 CFR § 1.183)" (patent owner's April 18, 2011 combined petition).

Patent owner's April 18, 2011 combined petition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's April 18, 2011 combined petition under 37 CFR 1.182 and 1.183 is **dismissed**.

DECISION

The patent owner requests that the Office "waive" the provisions of 37 CFR 41.2 and 41.60 "so that [the patent owner] may compel the production of evidence [under 35 U.S.C. 24] from the relevant parties" and present the evidence to the Office.[1] The patent owner argues that "Congress intended that the Patent Owner would be able to compel the production of evidence from hostile parties (e.g., infringers)", and that "the trial record establishes the existence of substantial evidence [which is under a protective order by the court] that defeats the Requester's allegations of obviousness". Thus, the present combined petition is taken as:

1) a petition under 37 CFR 1.183 to "waive" the provisions of 37 CFR 41.2 and 41.60;
2) a petition under 37 CFR 1.182 to authorize discovery in the present *inter partes* reexamination proceeding; and
3) a petition under 37 CFR 1.182 to permit the entry of the discovered evidence.

37 CFR 41.2 provides, in pertinent part:

> An appeal in an *inter partes* reexamination proceeding is not a contested case.

[1] See the last two lines of page 9 of the present petition.

37 CFR 41.60 provides, in pertinent part:

> An *inter partes* reexamination proceeding is not a contested case subject to part D [which governs interferences].

37 CFR 1.183 permits waiver of "any *requirement* of the regulations . . . which is not a requirement of the statutes . . .". The above-quoted provisions, however, are *definitions*, not requirements. There is no requirement for the Office to waive. Furthermore, the Office cannot selectively "waive" the definition of any one *inter partes* reexamination proceeding, i.e., that it is not a contested case, while preserving the same definition for other *inter partes* reexamination proceedings, because to do so would be arbitrary and capricious. For this reason, patent owner's petition under 37 CFR 1.183 to "waive" the relevant provisions of 37 CFR 41.2 and 41.60 is **dismissed**.

The patent owner also requests the Office, under 37 CFR 1.182, to authorize discovery in the present proceeding. Patent owner's petition is, in essence, a request to review the Office's interpretation that the *inter partes* reexamination statute does not authorize discovery in *inter partes* reexamination proceedings, which includes the interpretation that *inter partes* reexamination proceedings are not "contested cases" within the meaning of 35 U.S.C. 24.

35 U.S.C. 24 provides, in pertinent part (emphasis added):

> The clerk of any United States court for the district wherein testimony is to be taken for use *in any contested case in the Patent and Trademark Office*, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent and Trademark Office....

The *inter partes* reexamination statute, however, does not authorize discovery in *inter partes* reexamination proceedings. 35 U.S.C. 24 is not applicable to *inter partes* reexamination proceedings.

Optional *inter partes* reexamination was enacted in the American Inventors Protection Act of 1999 (the AIPA). See Public Law 106-113, 113 Stat. 1501, 1501A-552 through 1501A-591 (1999), codified at 35 U.S.C. 311–318. 35 U.S.C. 311–318 provide for the filing of a request for *inter partes* reexamination, the Office's decision on such a request, an examination stage including Office actions on the merits, patent owner responses to the Office actions, and third-party requester comments (where patent owner responds) addressing issues raised by the Office action and/or the patent owner's response, an appeal stage, and the issuance of a certificate at the conclusion of the proceedings. The AIPA provided that the patent owner in an *inter partes* reexamination could appeal a decision of the Board of Patent Appeals and Interferences (BPAI) adverse to patent owner to the United States Court of Appeals for the Federal Circuit (Federal Circuit). However, as originally enacted, the AIPA did not permit a third party requester of the *inter partes* reexamination to appeal an adverse decision of the BPAI to the Federal Circuit, and did not provide for third-party-requester participation in an appeal taken by the patent owner to

the Federal Circuit. Subsequently, the *21st Century Department of Justice Appropriations Authorization Act* (*see* Pub. L. 107-273, 116 Stat. 1758, 1899-1906 (2002)) via section 13106, granted the third party requester the rights to (a) appeal an adverse decision of the BPAI to the Federal Circuit (in which appeal the patent owner may participate), and (b) be a party to a patent owner appeal to the Federal Circuit. Such is the extent of third party participation in an *inter partes* reexamination proceeding, as provided by the 1999 and 2002 enactments. An *inter partes* reexamination proceeding is otherwise modeled on *ex parte* proceedings such as initial examination or *ex parte* reexamination, which do not permit discovery. See, e.g., 145 Cong. Rec. H6944 (Aug. 3, 1999) (Statement of Rep. Rohrabacher) (indicating that the AIPA was intended to create a proceeding like *ex parte* reexamination which did "not subject the patent to any greater challenge in scope than currently exists today" but "merely allows a reexam requestor the option to further explain why a particular patent should not have been granted").

35 U.S.C. 314 prescribes the procedure for the conduct of *inter partes* reexamination proceedings. 35 U.S.C. 314(a) provides, in pertinent part (emphasis added):

> 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.

35 U.S.C. 132 and 133, which govern initial examination, do not provide any basis for the authorization of discovery under 35 U.S.C. 24. The initial examination of a patent application is not a "contested case in the Patent and Trademark Office" within the meaning of 35 U.S.C. 24. Moreover, 35 U.S.C. 305, which includes corresponding provisions governing *ex parte* reexamination, similarly specifies that *ex parte* reexamination "will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133." The fact that the same language is used to describe the conduct of *ex parte* reexamination proceedings, which do not provide for discovery, implies that discovery practice is not within the scope of any reexamination proceeding, whether *inter partes* or *ex parte*. *Cf. Rules to Implement Optional Inter Partes Reexamination Proceeding*, 65 Fed. Reg. 76,756, 76,763 (December 7, 2000) (final rule) ("In a very real sense, the intent of reexamination is to start over and reexamine the patent and examine new and amended claims *as they would have been examined in the original application of the patent.*") (emphasis added).

35 U.S.C. 314(b) provides for service of parties and for the submission of written comments by the third party requester after a patent owner response during the examination stage. Third party requester's written comments must be filed within thirty days of the date of service of patent owner's response. There is no authorization for discovery. Furthermore, it would be impracticable, if not impossible, for the parties to conduct discovery, for the court to resolve any discovery disputes, and for the third party requester to prepare and submit its written comments within the thirty-day period set by statute. The fact that Congress required the third party requester to file written comments within a thirty-day period provides evidence that Congress did not intend to authorize discovery practice in *inter partes* reexamination proceedings.

Both 35 U.S.C. § 314(c), which governs *inter partes* reexamination, and 35 U.S.C. § 305, which governs *ex parte* reexamination, provide that reexamination in *inter partes* reexamination and in *ex parte* reexamination proceedings, respectively, will be conducted with "special dispatch"

within the Office. Neither the statute nor the regulations define special dispatch; however, in *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988), the Federal Circuit explained:

> "Special dispatch" is not defined by statute. . . . According to Webster's New World Dictionary, special means distinctive, unique, exceptional or extraordinary, and dispatch means to finish quickly or promptly. Consequently, the ordinary, contemporary and common meaning of special dispatch envisions some type of unique, extraordinary or accelerated movement. In fact, the PTO itself has interpreted special dispatch to require that 'reexamination proceedings will be "special" through their pendency' in the office and provides for an accelerated schedule. MPEP § 2261.
>
> *Ethicon*, 849 F.2d at 1426.

Any provision for discovery would necessarily prolong proceedings before the Office. The time needed to conduct the discovery, the additional, extensive consideration by the Office of that discovery, and the resolution of any issues, would be contrary to the statutory mandate for special dispatch. If Congress had intended for discovery to be permitted in *inter partes* reexamination proceedings, rather than in *ex parte* reexamination proceedings, Congress would have expressly provided for such a practice, and it would have circumscribed the discovery in a manner consistent with the statutory requirement for "special dispatch." Thus, the statutory requirement for special dispatch clearly provides evidence that Congress did not contemplate discovery for *inter partes* reexamination proceedings. Regarding the sole exception to the "special dispatch" requirement in the statute, i.e., a finding of "good cause" by the Director, the Office has not authorized an exception to the "special dispatch" provision for the purposes of permitting discovery, and is not authorized to do so, given the above-discussed provisions of 35 U.S.C. 314(a) and (b)(2).

The above interpretation of the *inter partes* reexamination provisions is consistent with their legislative history. The legislative history makes no mention of discovery, and consistently expresses a concern for providing a low-cost, efficient alternative to litigation, in which a third party requester has the ability to participate by submitting comments, in writing, to the examiner, in response to arguments made by the patentee. See, e.g., H.R. Rep. No. 106-287, 106th Cong., 1st Sess. 31, (1999) (Submitted by Rep. Coble) ("The existing patent reexamination system is an ineffective means for bringing relevant prior art unavailable to examiners during their search to the attention of the PTO due to the ex parte nature of the proceeding.");145 Cong. Rec. S14720, (Nov. 17, 1999) (Statement of Senator Lott) ("Subtitle F is intended to reduce expensive patent litigation in U.S. district courts by giving third-party requesters, in addition to the existing *ex parte* reexamination in Chapter 30 of title 35, the option of *inter partes* reexamination proceedings in the USPTO. Congress enacted legislation to authorize *ex parte* reexamination of patents in the USPTO in 1980, but such reexamination has been used infrequently since a third party who requests reexamination cannot participate at all after initiating the proceedings. Numerous witnesses have suggested that the volume of lawsuits in district courts will be reduced if third parties can be encouraged to use reexamination by giving them an opportunity to argue their case for patent invalidity in the USPTO. Subtitle F provides that opportunity as an option to the existing *ex parte* reexamination proceedings.").

It is clear that the Office's construction of the statute has consistently been that the *inter partes* reexamination provisions do not authorize discovery. In response to a reporting requirement of the AIPA (*see* AIPA, Pub. L. 106-113, 1501A-571, § 4606 (1999)), the Office conducted a "round table meeting" to receive views on the effectiveness and possible improvement of *inter partes* reexamination and then drafted a report to Congress. The report points out that "the lack of such procedural mechanisms as discovery and cross-examination that would be available in litigation has apparently resulted in challengers being unwilling to invoke inter partes reexamination and risk its estoppel effect." *United States Patent And Trademark Office Report To Congress On Inter Partes Reexamination* (2004) (available at http://www.uspto.gov/web/offices/dcom/olia/reports/reexam_report.htm), at 4; *see also* Transcript of February 17, 2004 Roundtable Meeting (available at http://www.uspto.gov/web/offices/pac/dapp/opla/comments/reexamproceed/round_tbl_transcript.pdf) at 20-21 (discussing the lack of discovery in *inter partes* reexamination). The report contrasts *inter partes* reexamination to a proposed "post-grant review process," in which "[c]losely controlled discovery and cross-examination would be available in the review, upon the challenger's presenting sufficient grounds that one or more of the patent claims are unpatentable." Id. at 8. Accordingly, the public and the Office understood that discovery was not available in *inter partes* reexamination, and that additional legislation would be required to provide for such discovery.

In this regard, on September 16, 2011, Congress enacted The America Invents Act (the AIA), which, replaces *inter partes* reexamination with a new proceeding titled *inter partes* review, effective September 16, 2012. The statute expressly provides for discovery in newly enacted 35 U.S.C. § 316 (conduct of *inter partes* review), which instructs the Director to "prescribe regulations . . . setting forth standards and procedures for discovery of relevant evidence, including that such discovery will be limited to (A) the deposition of witnesses submitting affidavits or declarations; and (B) what is necessary in the interests of justice." See Pub. L. No. 112-29, Section 6. The legislative history of the new proceeding confirms that Congress intended to provide discovery where none had previously been available:

> The Act converts inter partes reexamination from an examinational to an adjudicative proceeding, and renames the proceeding ''inter partes review.'' The Act also makes the following improvements to this proceeding:
>
> . . . .
>
> • Discovery. Parties may depose witnesses submitting affidavits or declarations and seek such discovery as the Patent Office determines is otherwise necessary in the interest of justice.
>
> H. Rep. No. 112-98 (Part 1) 112th Cong., 1st Sess., at 46-47 (2011) (available at http://www.gpo.gov/fdsys/pkg/CRPT-112hrpt98/pdf/CRPT-112hrpt98-pt1.pdf).

Congress's characterization of the provision for limited discovery in *inter partes* review as an "improvement" over *inter partes* reexamination settles any dispute concerning the proper interpretation of the *inter partes* reexamination statute. The AIPA does not authorize discovery in *inter partes* reexamination proceedings.

Furthermore, an *inter partes* reexamination proceeding is not a contested case. The Office's interpretation of 35 U.S.C. 314 to exclude authorization for discovery in *inter partes* reexamination proceedings, including the interpretation that *inter partes* reexamination proceedings are not "contested cases" within the meaning of 35 U.S.C. 24, is confirmed by the Office's promulgation of rules specifically governing discovery for interferences, while none were drafted for *inter partes* reexamination proceedings. *See, e.g.,* 37 CFR 41.150(a), which states: "[a] party is not entitled to discovery except as authorized in this subpart". If Congress intended to permit discovery in *inter partes* reexamination proceedings, it would have modeled *inter partes* reexamination proceedings on interferences, which are contested cases, and not on proceedings such as initial examination or *ex parte* reexamination, which are not contested cases, and which do not include discovery.

Finally, in quashing a subpoena served by the patent owner on the requester in merged *inter partes* reexamination proceeding control numbers 95/000,542 and 95/000,552 ("the merged proceeding"), the district court for the Eastern District of Virginia recently determined that an *inter partes* reexamination proceeding is not a contested case, and that discovery is not permitted in *inter partes* reexamination proceedings. See *Abbott Labs. v. Cordis Corp.,* Civil Action No. 1:11-MC-421, Order (E.D. Va. Jan. 20, 2012) (Hilton, J.), aff'g Order (Anderson, Mag. J.) (granting motion to quash); see Hr'g Tr. at 19-20 (E.D. Va. Dec. 9, 2011) (agreeing with the Office's December 7, 2011 final agency action in the merged proceeding when explaining reasons for granting motion to quash). See also the December 7, 2011 final agency action (in the merged proceeding) denying a petition by the patent owner (in that merged proceeding) requesting the Office to authorize the patent owner to compel discovery in that proceeding.

In summary, discovery in an *inter partes* reexamination proceeding is not permitted by the *inter partes* reexamination statute, or by any regulation governing *inter partes* reexamination proceedings. 35 U.S.C. 24 is not applicable to *inter partes* reexamination proceedings. Accordingly, patent owner's petition under 37 CFR 1.182 to authorize discovery in the present *inter partes* reexamination proceeding, is **dismissed**. Given this dismissal, patent owner's petition under 37 CFR 1.182 to permit the entry of the discovered evidence is **dismissed as moot**.

The patent owner states that the evidence which patent owner wishes to obtain by discovery is subject to a June 19, 1999 protective order by the court in *SynQor, Inc. v. Artesyn Technologies, Inc., et al,* Civil Action No. 2-07-CV-497-TJW-CE (E.D. Tex.). Even if the patent owner were to obtain the evidence desired, the Office would not review, permit the entry of, or otherwise consider such evidence, because the Office would not violate the court's protective order. In order for such evidence to be entered and considered by the Office, the patent owner must provide evidence that the requester has consented to a waiver of the court's protective order, and that the court has granted such a waiver. The patent owner must explain, in any response to this decision, why the patent owner believed, at the time of filing the present petition, that it would not be a violation of the court's protective order if the Office were to grant the present petition.

The patent owner has recourse through the court to request the court's permission to submit the necessary materials in this proceeding. Therefore, there are adequate remedies to address this situation.

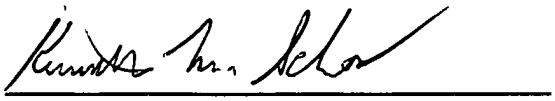
The patent owner further states that documents, which are designated as exhibits D and E and which are attached to the present petition, were subject to the court's protective order, but were made public at trial by the requester. The patent owner also states that additional documents, which were filed on April 18, 2011 in a notice of concurrent proceedings (and, apparently, in a second notice of concurrent proceedings filed on April 19, 2011), were also subject to the court's protective order, but were presented at trial by the requester's expert witness, Dr. Leeb. The patent owner has not, for example, provided *evidence* that these documents were made public by the requester, or that requester has consented to a waiver of the court's protective order with respect to these documents. However, the requester has had nearly ten months to object to the filing of the documents in the notice of concurrent proceedings, and to the filing of the documents attached to the present petition as exhibits D and E, during which time the requester has filed comments, on May 18, 2011, on patent owner's April 18, 2011 response, and an opposition, on October 26, 2011, to patent owner's September 29, 2011 petition requesting entry of a declaration under 37 CFR 1.132 of Brooke Ekins. To date, the requester has not presented any arguments that any of the above-discussed documents are still under the court's protective order. For this reason, these documents will remain in the file, and will not be sealed. However, if any of these documents remain under the court's protective order, the parties are required to inform the Office immediately.

In view of the above, patent owner's April 18, 2011 combined petition under 37 CFR 1.183 to "waive" the relevant provisions of 37 CFR 41.2 and 41.60, and under 37 CFR 1.182 to authorize discovery and to permit entry of the discovered evidence, is **dismissed**.

A decision on patent owner's September 29, 2011 petition entitled "Petition Requesting the Entry of the Declaration of Brooke Ekins (37 CFR 1.182)" and on patent owner's October 6, 2011 petition entitled "Renewed Petition to Stay *Inter Partes* Re-examination (37 CFR § 1.182)" will each be separately mailed in due course.

CONCLUSION

- Patent owner's April 18, 2011 combined petition under 1.182 and 1.183 is **dismissed.**
- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724.



Kenneth M. Schor
Senior Legal Advisor
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,491	11/16/2010	7,269,034 B2	2882.001REX0	2397

24197 7590 02/10/2012

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/10/2012

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 2-10-12

STERNE,KESSLER,GOLDSTEIN AND FOX, PLLC
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001491
PATENT NO. : 7269034
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 10 2012

CENTRAL REEXAMINATION UNIT

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Washington, D.C. 20005

In re Schlecht	:	**DECISION**
Inter Partes Reexamination Proceeding	:	**DISMISSING**
Control No. 95/001,491	:	**AND EXPUNGING**
Filed: November 16, 2010	:	**IMPROPER PETITION**
For: U.S. Patent No.: 7,269,034	:	

This is a decision on patent owner's September 29, 2011 petition entitled "Petition Requesting the Entry of the Declaration of Brooke Ekins (37 CFR 1.182)" (patent owner's September 29, 2011 petition).

This petition also addresses requester's October 26, 2011 opposition paper entitled "Third Party Requester's Petition Opposing Patent Owner's Petition Requesting the Entry of the Declaration of Brooke Ekins (37 CFR 1.182)" (requester's October 26, 2011 opposition paper).

Patent owner's September 29, 2011 petition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's September 29, 2011 petition under 37 CFR 1.182 is **dismissed**.

The September 29, 2011 petition paper, including the attached declaration under 37 CFR 1.132 of Brooke Ekins and its accompanying exhibits, is an **improper paper**. Because the present petition paper has been scanned into the electronic Image File Wrapper (IFW), the petition paper cannot be physically returned to the patent owner. Thus, the present petition paper will be **expunged** from the record by marking the paper "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.

DECISION

The patent owner requests the entry of the September 29, 2011 declaration under 37 CFR 1.132 of Brooke Ekins, a legal assistant to counsel for the patent owner, who states that the documents filed concurrently with the declaration are true and correct copies of documents that were either issued by the court or filed in court by one of the parties, in the litigation styled *SynQor, Inc. v. Artesyn Technologies, Inc., et al,* Civil Action No. 2-07-CV-497-TJW-CE (E.D. Tex.) and in the litigation styled *SynQor, Inc. v. Ericsson, Inc. et al,* Civil Action No. 2-11-CV-54 (E.D. Tex.).

The patent owner asserts that these documents were originally submitted as part of a notice of concurrent proceedings, which was filed on April 18, 2011. The patent owner further states that the present petition is submitted because the patent owner believes that these documents "may not have been entered", and that patent owner's "response" (it is not clear whether the patent owner is referring to its original April 18, 2011 response or its supplemental response, filed on April 27, 2011), "might be deemed as an incomplete response", because the patent owner relied upon certain of these documents in its "response". The patent owner requests entry of these documents pursuant to 37 CFR 1.182 because the "rules do not generally provide for the proactive correction of a defect".

A review of Office records, however, reveals that a notice of concurrent proceedings by the patent owner was received on April 18, 2011, and that patent owner's April 18, 2011 response, April 27, 2011 supplemental response, and April 18, 2011 notice of concurrent proceedings, were entered. Office records fail to reveal that patent owner's April 18, 2011 response, or for that matter, patent owner's April 27, 2011 supplemental response, or April 18, 2011 notice of concurrent proceedings, were determined by the Office to be defective.

37 CFR 1.182 provides, in pertinent part:

> 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 . . .

As presently argued by the patent owner, the declaration under 37 CFR 1.132 of Brooke Ekins (the Ekins declaration) is submitted to provide copies of documents on which the patent owner relied in its response (either its original response or its supplemental response). In other words, the Ekins declaration and its accompanying exhibits is a second, supplemental response by the patent owner, which is specifically governed by the provisions of 37 CFR 1.945(b). Thus, the present petition under 37 CFR 1.182 is improper because the regulations specifically provide for the entry of a supplemental response. Furthermore, to be considered, any supplemental response must be filed as a separate paper as required by 37 CFR 1.4(c), and not as an attachment to a petition, because 1) different matters may be considered by different branches or sections of the Office, and 2) it is not clear whether the attachment, itself, is meant to be the supplemental response, or whether another document, of which the attachment is a duplicate, is meant to be the supplemental response.

For the reasons given above, patent owner's September 29, 2011 petition under 37 CFR 1.182 is **dismissed**. The September 29, 2011 petition paper, including the attached declaration under 37 CFR 1.132 of Brooke Ekins and its accompanying exhibits, is an **improper paper**. Because the present petition paper has been scanned into the electronic Image File Wrapper (IFW), the petition paper cannot be physically returned to the patent owner. Thus, the present petition paper will be **expunged from the record** by marking the paper "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.

Additional Comments

Even if the Ekins declaration and its accompanying exhibits, which is a second, supplemental response by the patent owner, were properly filed as a separate paper, it would not be entitled to entry into the record because the patent owner has not provided a showing of a sufficient cause why the second supplemental response should be entered. 37 CFR 1.945(b) provides:

> Any supplemental response to the Office action will be entered only where the supplemental response is accompanied by a showing of sufficient cause why the supplemental response should be entered. The showing of sufficient cause must include:
>
> (1) An explanation of how the requirements of § 1.111(a)(2)(i) are satisfied;
>
> (2) An explanation of why the supplemental response was not presented together with the original response to the Office action; and
>
> (3) A compelling reason to enter the supplemental response.

Specifically, the patent owner has not provided any explanation of how the requirements of 37 CFR 1.111(a)(2)(i) are satisfied. Furthermore, the Office has not found to be defective either 1) patent owner's April 18, 2011 notice of concurrent proceedings,[1] which, according to the patent owner, includes duplicates of the presently submitted exhibits to the Ekins declaration: 2) patent owner's original April 18, 2011 response; or 3) patent owner's April 27, 2011 supplemental response. Thus, the patent owner has not provided a compelling reason to enter the second supplemental response, i.e., the Ekins declaration and its accompanying exhibits, filed on September 29, 2011.

For these reasons, even if the Ekins declaration and its accompanying exhibits were properly filed as a separate paper, it would not be entitled to entry into the record, and would be expunged from the record pursuant to MPEP 2666, subsection III.

CONCLUSION

- Patent owner's September 29, 2011 petition under 1.182 is **dismissed.**

---

[1] In patent owner's April 18, 2011 combined petition to reopen prosecution, the patent owner stated that certain documents filed as part of patent owner's April 18, 2011 notice of concurrent proceedings (and, apparently, in a second notice of concurrent proceedings filed on April 29, 2011) were also subject to the a protective order by the court, but were made public at trial by requester's expert witness, Dr. Leeb. However, as discussed in the Office's February 2, 2012 decision dismissing the April 18, 2011 combined petition, while the patent owner has not provided evidence that these documents were made public by the requester, or that requester has consented to a waiver of any protective order by the court with respect to these documents, the requester has had nearly ten months to object to the filing of the documents, during which time the requester has filed its October 26, 2011 opposition to patent owner's present petition and has filed comments, on May 18, 2011, on patent owner's April 18, 2011 response. To date, the requester has not presented any arguments that any of these documents are still under the court's protective order. For this reason, these documents will remain in the file, and will not be sealed. However, if any of these documents remain under the court's protective order, the parties are required to inform the Office immediately.

- Patent owner's September 29, 2011 petition paper, including the attached declaration under 37 CFR 1.132 of Brooke Ekins and its accompanying exhibits, is an **improper paper**. It will be **expunged from the record** by marking the paper "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.

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

Brian E. Hanlon

Brian E. Hanlon
Director
Office of Patent Legal Administration

2 7 2012

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,491	11/16/2010	7,269,034 B2	2882.001REX0	2397

24197 7590 02/24/2012
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/24/2012

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Date:

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FEB 24 2012
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001491
PATENT NO. : 7269034
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 24 2
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In re Schlecht	:	
Inter partes Reexamination Proceeding	:	**DECISION**
Control No: 95/001,491	:	**DISMISSING**
Filing Date: November 16, 2010	:	**PETITION**
For: U.S. Patent No.: 7,269,034	:	

This is a decision on patent owner's October 6, 2011 petition, entitled "Renewed Petition to Stay *Inter Partes* Reexamination (37 CFR 1.182)" (patent owner's October 6, 2011 renewed petition).

This decision also addresses requester's October 26, 2011 opposition paper, entitled "Opposition to Renewed Petition to Stay *Inter Partes* Reexamination (37 CFR 1.182)" (requester's October 26, 2011 opposition).

Patent owner's October 6, 2011 renewed petition, requester's October 26, 2011 opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's October 6, 2011 renewed petition is **dismissed**. The present *inter partes* reexamination proceeding **will continue**, and **will not be suspended**.

DECISION

The patent owner requests the Office to suspend the present *inter partes* reexamination proceeding.

MPEP 2686.04 provides, in pertinent part (emphasis added):[1]

> [35 U.S.C. 314(c)][2] thus authorizes the Director of the USPTO **to suspend (stay) reexamination proceedings, where there is good cause to do so**, pending the conclusion of

[1] See particularly, MPEP 2686.04, subsections II(B) and III.

[2] 35 U.S.C. 314(c) provides, in pertinent part (emphasis added):

litigation based on a potential for termination of a reexamination prosecution under 35 U.S.C. 317(b). Thus, a District Court decision that is pending appeal on the validity of the same claims considered in an *inter partes* reexamination proceeding may provide the requisite statutory "good cause" for suspension, due to the real possibility that the 35 U.S.C. 317(b) estoppel may attach in the near future to bar/terminate the reexamination proceeding.

Factors to be considered in determining whether it is appropriate to suspend action in the reexamination are:

A. Whether the third party requester is a party to the litigation;

B. Whether the claims in suit are identical to the claims under reexamination;

C. Whether the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the litigation;

D. Whether the litigation has advanced to a late enough stage that there is a sufficient probability that a final decision will be adverse to the requester; and

E. Whether there is a concurrent *ex parte* reexamination proceeding for the patent.

In the June 27, 2011 decision dismissing patent owner's initial petition to suspend[3] the present reexamination proceeding, the Office determined that elements A and E have been satisfied.

Regarding element B, the patent owner asserts that the claims at issue in the reexamination are identical to those in the copending litigation, *SynQor, Inc. v. Artesyn Technologies, Inc. et al.*, Civil Action No. 2:07-CV-497-TJW-CE (E.D. Tex.). In patent owner's initial petition, the patent owner stated that "[p]rior to trial, the District Court instructed the parties to agree on a representative number of claims for trial management purposes. SynQor [the patent owner] and the Defendants [including the third party requester of the present proceeding] agreed to try claim 9 as the representative claim for the '034 patent [the patent under reexamination]." In the June 27, 2011 decision, the Office determined that element B had not been shown to have been satisfied, because the patent owner did not provide evidence of the court's requirement to select "representative claims", or evidence showing which claims were represented by the representative claims.

With the present petition, the patent owner submits, among other exhibits, 1) Exhibit E, a copy of requester/defendant's December 2, 2009 invalidity contentions, which was apparently submitted in court, and which identifies all of the claims of the '034 patent that are under reexamination as the "asserted claims" of the '034 patent in the litigation; 2) Exhibit F, a copy of the court's March 25, 2010 order granting requester's motion to compel the patent owner "to reduce the

---

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.

[3]Filed on April 18, 2011.

number of claims it asserts"; 3) Exhibit P, a copy of the court's November 29, 2010 order limiting the patent owner to the assertion of ten claims at trial; and 4) Exhibit X, a copy of the court's August 17, 2011 final judgment, in which the court refers to "claim 9 of the '034 patent" as the "asserted" claim of the '034 patent, and states that the jury failed to find that "any of the asserted claims are invalid". Finally, the patent owner states, on page 12 of the present petition, that it "ultimately chose to try the issue of infringement of the '034 Patent [solely] based on representative claim 9".

The patent owner has provided evidence that all of the patent claims under reexamination were originally asserted in the copending litigation (see, e.g. Exhibit F, as outlined above). However, the patent owner has not provided any evidence that the parties agreed, or that the court determined, that claim 9 of the '034 patent, which was the only claim of the '034 patent that was ultimately litigated, is "representative" of the claims that were originally asserted in the copending litigation. No evidence can be found which shows that the court referred to the claim in suit as "the representative claim". Rather, the court appears to have consistently referred to the claim in suit as "the asserted claim". Furthermore, the patent owner has not provided any evidence that the requester/co-defendant agreed that claim 9 would be "representative" of the claims originally asserted by the patent owner in the litigation. The evidence proferred by the patent owner only appears to show that the patent owner was given the opportunity to select which claims were to be litigated, and not that the parties agreed, or that the court determined, that the claims selected by the patent owner were to be "representative" of the claims originally asserted in the litigation. Thus, the patent owner has not provided evidence showing that the claims at issue in the reexamination are identical to those in the copending litigation, as also argued by the requester in its October 26, 2011 opposition. In fact, the evidence of record appear to show that they are not identical.

For the reasons given above, element B has not been shown to have been satisfied.

Regarding element C, the Office determined, in the June 27 2011 decision, that the issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the litigation. Upon reconsideration, however, and in view of the fact that the evidence of record now appears to show that the claims under reexamination are not identical to those litigated in court, the patent owner has not shown that any issues raised in the reexamination proceeding with respect to the non-litigated claims could have been raised by the requester in the copending litigation. The patent owner points to *Katz Interactive Call Processing Patent Litigation v. American Air,* 639 F.3d 1303, 97 USPQ2d 1737 (Fed. Cir. 2011) to show that "the Court's judgment will have a *res judicata* effect against [the requester/co-defendant] on all claims of the '034 Patent even though only claim 9 was presented to the jury". However, the decision in *Katz*, which the court expressly limited to the circumstances before it,[4] is inapplicable here. The district court in *Katz* was seeking to eliminate duplicative claims, and allowed the plaintiff/patent owner the opportunity to select the claims that it wanted to assert. The issue on appeal was whether the district court's approach was fair to the patent owner. The Federal Circuit accepted plaintiff/patent owner's assertion that the district court's judgments could preclude *the plaintiff/patent owner* from litigating the unselected claims in later actions brought against the same or other parties. The Federal Circuit, however, viewed the approach as

[4] 639 F.3d at 1309.

fair because it gave the plaintiff/patent owner the opportunity to select which claims it would assert, and further gave the plaintiff/patent owner the ability to raise additional claims that were not duplicative. *Id.* In the present case, however, the patent owner has not pointed to any part of the *Katz* decision where the Federal Circuit suggested that the approach in *Katz* would likewise limit the *defendant* in *Katz* regarding whether the issue of invalidity of the unasserted claims may be raised in a future litigation. Unlike *Katz,* the issue here is not whether the patent owner had a fair opportunity to raise the unasserted claims in the district court. Instead, the question is whether the requester had a fair opportunity to litigate the validity of the claims that were not asserted against it. The patent owner has not shown that the requester in the present case had a fair opportunity. The patent owner selected which claims would be asserted, not the requester. The patent owner has not shown how the requester could have raised, in the copending litigation, any issues that were raised in the reexamination proceeding with respect to the non-litigated claims.[5]

"Good cause" for suspension pending the conclusion of litigation is based on a potential for the termination of reexamination prosecution under 35 U.S.C. 317(b). See MPEP 2686.04, quoted above. If a claim under reexamination is not the subject of the copending litigation, then the estoppel provisions of 35 U.S.C. 317(b) would not apply to the final outcome of the copending litigation as to that patent claim, because there would be no "final decision that the party has not sustained its burden of proving the invalidity" of the patent claim. Thus, there is no "potential for termination" of this reexamination proceeding as to the non-litigated claims.

Therefore, upon reconsideration, element C has not been shown to have been satisfied.

Regarding element D, the patent owner provides evidence that the proceedings in the district court have concluded, and that the district court has entered a final judgment on the jury verdict. A brief review of the record reveals that the requester appealed the final judgment of the district court to the Federal Circuit on October 28, 2011. The patent owner, however, has not provided evidence that the appeal has been fully briefed. For these reasons, the patent owner has not shown that litigation has advanced to a late enough stage that there is a sufficient probability that a final decision will be adverse to the requester. Thus, item D has not been shown to have been satisfied.

See also *Sony Computer Entertainment America, Inc. v. Dudas*, 85 USPQ2d 1594 (E.D. Va. 2006), where the court upheld the Office's determination of "good cause" to suspend two related *inter partes* reexamination proceedings. The facts of the present case, however, are clearly distinguishable from *Sony*. In *Sony*, the request for *inter partes* reexamination was not filed until after a final judgment in the district court was rendered. In the present case, however, the request for *inter partes* reexamination was filed well before trial began. In addition, reexamination in *Sony* was limited to the claims that were being litigated. In the present case,

---

[5] The patent owner also argues that the requester/defendant, as in *Katz,* requested that the court compel the patent owner to reduce the number of asserted claims. Whether the court required the patent owner to select a reduced number of asserted claims at the request of the requester, however, does not alter the fact that the patent owner has not shown that the court determined, or that the requester agreed, that claim 1 was "representative" of the originally asserted claims, i.e., that the claims under reexamination and the claims in litigation are identical, and has not shown how the requester could have raised, in the copending litigation, any issues raised in the reexamination proceeding with respect to the non-litigated claims.

however, the claims under reexamination differ from those in the copending litigation. Furthermore, unlike *Sony*, the Office has already issued a non-final Office action rejecting all of the patent claims under reexamination, while in *Sony*, an action on the merits had not yet issued. Also, in *Sony*, an appeal to the Federal Circuit had been fully briefed. Thus, a final decision in *Sony* was on the horizon. In the present case, however, the patent owner has not provided any evidence that the appeal has been fully briefed. In other words, the patent owner has not shown that a final decision *as to all claims under reexamination* is expected in the near future. Furthermore, the present proceeding has progressed on the merits. Without a final decision adverse to the requester as to *all* claims under reexamination, no estoppel can attach as to all claims, to mandate termination of the present ordered reexamination proceeding. The fact that estoppel could possibly attach as to some of the claims at some uncertain point in the future, as argued by patent owner, does not provide the requisite showing of good cause for suspension.

Regarding the paper entitled "Joint Notification of Settlement Agreement By Patent Owner and Third Party Requester", filed by the parties on February 21, 2012, and the power of attorney for the requester, filed on even date, the requester makes statements such as 1) "Lineage [the requester] actually raised or could have raised the validity of all claims of the '034 Patent"; 2) "Lineage had the opportunity to challenge the validity of all claims of the '034 Patent on the basis of all prior art in the '1491 Reexam"; 3) "In the '1491 Reexam, Lineage had the opportunity to challenge all claims on the basis of the prior patents and printed publications that were known to it in the Litigation"; 4) "In the Litigation, Lineage failed to sustain its burden of proving the invalidity of any patent claim, regardless of those issues which were ultimately submitted to the jury for resolution"; 5) "SynQor [the patent owner] and Lineage have requested dismissal of Lineage's appeal of the FINAL JUDGMENT with prejudice . . ."; 6) "The estoppel provisions of 35 USC § 317(b) have been triggered by the FINAL DECISION"; etc. 35 USC 317(b), however, is concerned with the final decision of the court, and not a defendant's characterization of the decision. The requester has not, for example, explained how it had the burden of proving the invalidity of the claims that were not asserted against it at trial, or why the district court would have entertained such an issue regarding a non-asserted claim. Furthermore, the evidence provided by the patent owner shows that only claim 9 of the '034 patent was litigated, and fails to show that the court determined that claim 9 is "representative" of all of the other, non-litigated claims which are under reexamination. Thus, the claims under reexamination are not identical to the claims in suit.

The parties are required to promptly inform the Office of any dismissal by the Federal Circuit of requester's appeal.

Accordingly, patent owner's October 6, 2011 renewed petition under 37 CFR 1.182 to suspend the present reexamination proceeding is **dismissed**. Pursuant to MPEP 2686.04, the present *inter partes* reexamination proceeding **will continue**, and **will not be suspended**.

CONCLUSION

- The October 6, 2011 patent owner renewed petition is **dismissed**.
- The present *inter partes* reexamination proceeding **will continue**, and **will not be suspended**.

- Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-7724.

/Cynthia L. Nessler/
Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,493	11/24/2010	6,725,867	DGJ-00201	5267

22827 7590 03/15/2012

DORITY & MANNING, P.A.
POST OFFICE BOX 1449
GREENVILLE, SC 29602-1449

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/15/2012

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
FOLEY HOAG, LLP
PATENT GROUP, WORLD TRADE CENTER WEST
155 SEAPORT BLVD.
BOSTON, MA 02110

Date:

MAILED

MAR 15 2012

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001493
PATENT NO. : 6725867
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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

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

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

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

United States Patent and Trademark Office

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CENTRAL REEXAMINATION UNIT

Dority & Manning, P.A.
Post Office Box 1449
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(For Patent Owner)

Foley Hoag, LLP
Patent Group, World Trade Center West
2001 Ross Avenue
155 Seaport Blvd.
Boston, MA 02110

(For Third Party Requester)

In re Peterson et al	:	
Inter partes Reexamination Proceeding	:	**DECISION DISMISSING**
Control No: 95/001,493	:	**PETITION TO**
Filing Date: November 24, 2010	:	**TERMINATE *INTER PARTES***
For: U.S. Patent No.: 6,725,867	:	**REEXAMINATION PROCEEDING**

This is a decision on patent owner's December 13, 2011 paper entitled "Patent Owner Request to Discontinue and Terminate the Above Inter Partes Reexamination", which is taken as a petition under 37 CFR 1.182 to terminate the present reexamination proceeding (patent owner's December 13, 2011 petition).

This decision also addresses requester's December 20, 2011 paper entitled "Comments by Third-Party Requester to Patent Owner's Request to Discontinue and Terminate *Inter Partes* Reexamination" (requester's December 20, 2011 paper).

Patent owner's December 13, 2011 petition, requester's December 20, 2011 paper, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's December 13, 2011 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **dismissed**.

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/001,493 (the '1493 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

> Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then . . . an inter partes reexamination requested by

> that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

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

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

The patent owner informs the Office that the patent under reexamination, U.S. Patent No. 6,725,867 (the '867 patent), was the subject of a civil action in district court, i.e., *Schweitzer-Mauduit International, Inc. v. Astra Tobacco Corporation et al,* Civil Action No. 2:10-cv-00293-RMG (D. S.C.). The patent owner submits a copy of a stipulated consent judgment, entered by the district court on December 5, 2011, in which the district court stated that "Delfort [Delfourtgroup AG, the requester of the present proceeding] concedes that it has failed to sustain the burden of proving invalidity of any claims of U.S. Patent No. . . 6,725,867 [the patent under reexamination]". The stipulated consent judgment, which states that the civil action is dismissed, appears to be a final decision within the meaning of 35 U.S.C. 317(b). Thus, elements 1 and 2 have been satisfied.

Regarding element 3, Office records reveal that claims 1-46 are subject to reexamination in the present proceeding. It is not clear, however, which claims were at issue in the litigation. The district court's stipulated consent judgment only states that the requester/defendant "concedes that it has failed to sustain the burden of proving invalidity of *any* claims of U.S. Patent No. 6,725,867" (emphasis added). There is no indication of which claims of the '867 patent were in suit. Until the Office receives evidence showing which claims were at issue in the litigation, a determination of whether the court decided that the requester/defendant did not sustain its burden of proving the invalidity of the claims under reexamination, which were at issue in the litigation, cannot be made. For this reason, element 3 has not been satisfied.

Furthermore, until it is clear which claims were at issue in the litigation, a determination cannot be made whether the issues raised in the reexamination proceeding were raised or could have been raised by the requester in the civil action. For example, if certain claims, which are under reexamination, were not at issue in the litigation, then any issues regarding those claims which were raised in the reexamination proceeding could not have been raised by the requester in the litigation. For this reason, element 4 has not been satisfied.

Accordingly, in the absence of evidence showing 1) which claims were at issue in the litigation; and 2) whether all of the issues raised in the reexamination proceeding as to those claims were

either raised, or could have been raised, by the requester in the litigation, prosecution of the present *inter partes* reexamination proceeding cannot be terminated. [1]

Any response to this notice should include evidence, in the form of a document either by the court or submitted to the court, showing 1) which claims were at issue in the litigation; and 2) whether all of the issues raised in the reexamination proceeding as to those claims were either raised, or could have been raised, by the requester in the litigation. This evidence should accompany any such response as an attachment or as an exhibit to the response.

CONCLUSION

- Patent owner's December 13, 2011 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **dismissed**.

- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.

/Cynthia L. Nessler/
Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

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[1] Requester's December 20, 2011 paper, stating that requester agrees with the patent owner that the present proceeding cannot be maintained and should be terminated pursuant to 35 U.S.C. 317(b), is appreciated. However, the agreement of the parties, while appreciated, does not mandate termination. Evidence, which shows that the above-identified four elements have been satisfied, is required.

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CENTRAL REEXAMINATION UNIT

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Morrison & Foerster LLP (For *Inter Partes* '586 Requester)
12531 High Bluff Drive, Suite 100
San Diego, CA 92130

Novak, Druce, & Quigg LLP (For *Inter Partes* '1482 Requester)
(NDQ Reexamination Group)
1000 Louisiana Street, 53rd Floor
Houston, TX 77002

Baker Botts LLP (For *Inter Partes* '1497 Requester)
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Inter Partes Reexamination Proceeding
Control No. 95/000,586
Filed: December 13, 2010
For: U.S. Patent No. 7,397,431

Inter Partes Reexamination Proceeding
Control No. 95/001,482
Filed: November 11, 2010
For: U.S. Patent No. 7,397,431

Inter Partes Reexamination Proceeding
Control No. 95/001,497
Filed: December 3, 2010
For: U.S. Patent No. 7,397,431

DECISION, *SUA SPONTE*, MERGING *INTER PARTES* PROCEEDINGS

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration as to action to be taken under 37 C.F.R. § 1.989 at this time.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,397,431 (the '431 patent) issued to Carles Puente Baliarda *et al.* on April 10, 2007.

2. The 95/001,482 *inter partes* proceeding.
   On November 11, 2010, a request for *inter partes* reexamination of claims 1, 4, 5, 7, 8, 12-14, 17, 21, 22, 24-27, and 29-31 of the '431 patent was deposited by third party requester; the request was assigned control number 95/001,482 (the '1482 *inter partes* proceeding). Samsung Electronics is identified as the real party in interest.

   Reexamination was ordered on December 13, 2010.

3. The 95/000,586 *inter partes* proceeding.
   On November 12, 2010, a request for *inter partes* reexamination of claims 1, 4, 5, 7, 8, 12-14, 17, 22, 27, 29, and 31 of the '431 patent was deposited by third party requester; the request was assigned control number 95/000,586 (the '586 *inter partes* proceeding), and a filing date of December 13, 2010, the date at which the filing requirements of 37 C.F.R. § 1.915 were met. Kyocera Communications is identified as the real party in interest.

   Reexamination was ordered on February 4, 2011.

4. The 95/001,497 *inter partes* proceeding.
   On December 3, 2010, a request for *inter partes* reexamination of claims 1, 4, 5, 7, 8, 12-14, 17, 21, 22, 24-27, and 29-31 of the '431 patent was deposited by third party requester; the request was assigned control number 95/001,497 (the '1497 *inter partes* proceeding). HTC and HTC America are identified as the real parties in interest.

   Reexamination was ordered on January 20, 2011.

DECISION

I. MERGER OF PROCEEDINGS

Under 37 C.F.R. § 1.989(a):

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

As evidenced by the above review of facts, the '1482, '586, and '1497 reexamination proceedings are currently pending. Orders granting reexamination of claims 1, 4, 5, 7, 8, 12-14, 17, 21, 22, 24-27, and 29-31 of the '431 patent have been mailed in both the '1482 and '1497 reexamination proceedings, and an order granting reexamination of claims 1, 4, 5, 7, 8, 12-14, 17, 22, 27, 29, and 31 of the '431 patent was mailed in the '586 reexamination proceeding, and a decision under 37 C.F.R. § 1.989(a) is timely. The '1482, '586, and '1497 reexamination proceedings are at the same stage, in which no Office action on the merits has been issued.

The general policy of the Office is that multiple reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into each proceeding on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in each of the proceedings, and (3) to expedite the prosecution of each proceeding. In the present instance, merger of the '1482, '586, and '1497 reexamination proceedings would address these considerations. Thus, pursuant to 37 C.F.R. § 1.989(a), the '1482, '586, and '1497 reexamination proceedings are hereby merged. The merged proceeding will be conducted in accordance with the guidelines and requirements which follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an inter partes reexamination proceeding with two other inter partes reexamination proceedings. Pursuant to 37 C.F.R. § 1.989(b), the merged proceeding is governed by 37 C.F.R. §§ 1.902 through 1.997.

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2).[1] First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is limited to issues raised in either the Office action or the patent owner's

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

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

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

2. Appeal Rights:

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

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

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

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

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

It is to be noted that, because the '586 *inter partes* third party requester does not propose any rejections of claims 21, 24-26, and 30 in the request for reexamination, the '586 requester has no appeal rights as to those claims as they appear in the '431 patent.

C. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office, or filed by the patent owner, and the third party requesters will contain the identifying data for both proceedings and will be entered in each reexamination file. All papers filed by the patent owner and the third

party requesters must consist of a single paper, **filed in triplicate**, each bearing a signature and identifying data for all proceedings, for entry into the file for each proceeding.

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

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

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

By Mail to: Mail Stop "*Inter Partes* Reexam"
Attn: Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

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

By hand (or delivery service) to:

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

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

D. Amendments:

The filing of any amendments to the specification, claims, and drawings must comply with the provisions of 37 C.F.R. § 1.530 and the guidelines of MPEP § 2666. 37 C.F.R. § 1.121 does not apply to amendments in a reexamination proceeding. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via

markings pursuant to 37 C.F.R. § 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

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

E. Fees:

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

F. Citation of Patents and Printed Publications:

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

G. Appeal Procedure Reminders for *Inter Partes* Reexamination

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,482, *inter partes* Reexamination Control No.95/001,487, and *inter partes* Reexamination Control No. 95/000,586 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. Any questions concerning this communication should be directed to the Office of Patent Legal Administration, to Michael Cygan, at (571) 272-7700, or in his absence, to the undersigned at (571) 272-7726.

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

May 3, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,497 → 95/000586 → 95/001482	12/03/2010	7397431	3008.006REX2	7016

26111 7590 10/28/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/28/2011

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

BAKER BOFFS, LLP PATENT DEPARTMENT

98 SAN JACINTO BLVD.

SUITE 1500

AUSTIN, TX 78701-4039

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

REEXAMINATION CONTROL NUMBER 95/001,497, 95/000586 - 95/001482

PATENT NUMBER 7397431.

TECHNOLOGY CENTER 3999.

ART UNIT 3992.

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

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

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

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Inter Partes Reexamination Proceeding
Control No. 95/001,482
Filed: November 11, 2010
For: U.S. Patent No. 7,397,431

Inter Partes Reexamination Proceeding
Control No. 95/001,497
Filed: December 3, 2010
For: U.S. Patent No. 7,397,431

Inter Partes Reexamination Proceeding
Control No. 95/000,586
Filed: December 13, 2010
For: U.S. Patent No. 7,397,431

DECISION GRANTING PETITIONS

This is a decision on the following petitions:

1. Patent owner paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on August 15, 2011.

2. The '1482 requester paper entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)[*sic*]," filed on September 14, 2011.

Both petitions are before the Office of Patent Legal Administration for consideration.

Both petitions under 37 CFR 1.183 are granted for the reasons set forth herein.

BACKGROUND

1. On July 8, 2008, United States Patent No. 7,397,431 (the '431 patent) issued to Baliarda et al.

2. On November 11, 2010, a first request for *inter partes* reexamination of the '431 patent was filed by a third party requester (the '1482 requester), which request was assigned Reexamination Control No. 95/001,483 (the '1482 proceeding).

3. On December 3, 2010, a second request for *inter partes* reexamination of the '431 patent, assigned Reexamination Control No. 95/000,586 (the '0586 proceeding), was initially deposited by a third party requester (the '586 requester), and a corrected request was filed on December 13, 2010.

4. Also on December 3, 2010, a third request for *inter partes* reexamination of the '431 patent was filed by a third party requester (the '1497 requester), which request was assigned Reexamination Control No. 95/001,500 (the '1497 proceeding).

5. On December 13, 2010, the Office ordered reexamination in the '1482 proceeding.

6. On January 20, 2011, the Office ordered reexamination in the '1497 proceeding.

7. On February 4, 2011, the Office ordered reexamination in the '586 proceeding.

8. On May 4, 2011, the Office issued a decision merging, *sua sponte*, the '1482, '1497 and '586 proceedings ("the merged proceeding").

9. On May 13, 2011, the Office issued a non-final action in the merged proceeding.

10. On August 15, 2011, the patent owner filed a response in the merged proceeding, concurrently with the instant petition entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION" (patent owner petition under 37 CFR 1.183).

11. On September 14, 2011, the '1482 requester filed comments, concurrently with the instant petition entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)[*sic*]" ('1482 requester petition under 37 CFR 1.183).

DECISION

I. 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(b) provides:

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

II. Petitions Under 37 CFR 1.183

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological** facts, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide

a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count

A. Patent Owner Petition Under 37 CFR 1.183

On August 15, 2011, patent owner filed the instant petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its August 15, 2011 response submission. In support of its request for waiver of the rule, patent owner "asserts that justice would be served by granting waiver of the 50-page limit, because the full length of the Response is needed to fully and adequately respond to the Office Action."[1] Further, patent owner asserts:

> This reexamination proceeding represents the merger of three *Inter Partes* reexaminations. Thus, the Office Action is based on the combination of three *Inter Partes* reexamination requests and grants. Specifically, the Office Action includes 22 separate grounds of rejection over 13 separate references. . . . While the pending Office action constitutes only 16 pages, it incorporates by reference over 850 pages of argument and detailed claim charts set forth by the three third party requesters in their requests for reexamination. It would be unjust to hold the Patent Owner to only 50 pages to respond to what is essentially three Office Actions, particularly given the size and complexity of the three *Inter Partes* reexamination requests upon which they are based."[2]

In addition to stating that the response satisfies the formatting requirements for a grantable petition under 37 CFR 1.183, patent owner asserts that it has "made a good faith effort to comply with the 50-page limit, making efforts to economize, avoid extraneous material and information already of record, and present arguments efficiently . . . . Despite these efforts, the argument portion of the Response exceeds the 50-page limit."[3]

Patent owner's August 15, 2011 response submission includes: (1) a 175-page remarks section; (2) a 10-page declaration entitled "Declaration of Dr. Carles Puente Under 37 C.F.R. § 1.132"; (3) a 15-page declaration entitled "Declaration of Dr. Carles Puente Under 37 C.F.R. § 1.132 Relating to Fractal and Multilevel Antennas"; (4) a 9-page declaration entitled "Declaration of Drs. Carles Puente, Carmen Borja, Jaume Anguera, and Jordi Soler Under 37 C.F.R. § 1.132"; (5) a 9-page declaration entitled "Declaration of Ruben Bonet Under 37 C.F.R. § 1.132"; (6) a 41-page declaration entitled "Declaration of Dr. Raj Mittra Under 37 C.F.R. § 1.132" (The "Mittra Declaration"); and (7) a 20-page declaration entitled "Declaration of Dr. Raj Mittra Under 37 C.F.R. § 1.132 Relating to Single Band, Resonant and Multilevel Antennas". In view of the guidance set forth herein, portions of the 41-page "Mittra Declaration" are deemed to include an extension of arguments of counsel. Thus, the Mittra declaration is subject to the 50-

[1] *See* patent owner petition at page 2.
[2] *See id.* at pages 2-3.
[3] *See id.*

page length requirement, in addition to 175-page remarks section[4] such that patent owner's August 15, 2011 response submission exceeds the regulatory page limit by up to 166 pages.

Based on the individual facts and circumstances of this case such as, for example, the size of the May 13, 2011 Office action, including the incorporation by reference of pages from multiple requests for reexamination in the merged proceeding,[5] it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that patent owner's response submission exceeds 50 pages. Accordingly, patent owner's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's August 15, 2011 response submission to exceed the regulatory page limit by up to 166 pages. This waiver makes patent owner's August 15, 2011 response submission page-length compliant.

B. The '1482 Requester's Petition Under 37 CFR 1.183

On September 14, 2011, the '1482 requester filed the instant petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its September 14, 2011 comments submission. The '1482 requester asserts that the September 14, 2011 comments submission includes "99 pages of double spaced 12 pt font arguments and a 20-page declaration from Dr. Balanis under 37 C.F.R. § 1.132."[6] The '1482 requester asserts, however, that "[i]f the Office agrees with [patent owner's] interpretation of MPEP § 2667(I)(A)(2), then Samsung's Comments are only 99 pages as Dr. Balanis' declaration discusses how one of ordinary skill in the art would understand the disclosure of the prior art at issue".[7]

In support of its request for waiver of the rule, the '1482 requester asserts:

> Samsung has attempted to respond in as little a number of pages as possible but was unable to do so within the 50 page limit. The additional pages requested in

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[4] The cover page is excluded from the page count, as is the listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count.

[5] *See* May 13, 2011 Office action which, on its face, spans only 16 pages in length but relies heavily on incorporation by reference of more than 850 pages from multiple requests for *inter partes* reexamination in the merged proceeding.

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

[7] *Id.* at page 3. The '1482 requester is cautioned that statements submitted in opposition to patent owner's petition under 37 CFR 1.183 are improper and may result in the requester's petition paper being returned and not considered, as set forth in 37 CFR 1.939(a). For example, on page 3 of the third party requester petition under 37 CFR 1.183, the '1482 requester presents arguments against patent owner's position set forth in patent owner's petition under 37 CFR 1.183. Pursuant to MPEP 2667(I)(B)(4), a requester does not have a statutory right to challenge this discretionary procedural process (*i.e.*, waiver of the regulatory page limit) in the reexamination proceeding. Pursuant to 35 U.S.C. § 314(b)(2), the third party requester in an ordered *inter partes* reexamination proceeding has a statutory right to once file written comments to a patent owner's response to an Office action on the merits. Patent owner's petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) for patent owner's response submission, however, is not a "response" to an Office action on the merits. Thus, in this instance, 35 U.S.C. § 314(b)(2) does not provide any right for the third party requester to file comments on a patent owner's petition under 37 CFR 1.183 for suspension of the rules. Accordingly, any future petition that contains such arguments will be treated as an improper opposition paper and, as such, will be returned by marking the paper "closed" and "not public" in the IFW for the proceeding and will not be considered. Thus, any reply that exceeds the regulatory page limit which accompanies such petition would be found not page-length compliant.

> this petition are necessary to provide a reply the all of the issues raised by the Patent Owner's 279-page response.
>
> Importantly, this waiver would not go beyond the 1:1 ratio proscribed [sic] for Patent Owner and Requester responses to Office Actions recited in 37 C.F.R. § 1.943(b). In fact, the Requester is asking for significantly fewer total pages that the Patent Owner has submitted (279 total pages for the Patent Owner while Requester is only asking for a total of 99 pages). Therefore in the interest of justice, the Office should grant this petition so that the Requester is able to provide the Office with a rebuttal of all the arguments raised by the Patent Owner.[8]

The '1482 requester's September 14, 2011 comments submission includes: (1) a 99-page remarks section; (2) an 11-page declaration entitled "DECLARATION OF DR. CONSTANTINE A. BALANIS" captioned for this merged proceeding (the merged proceeding Balanis declaration); (3) an 8-page declaration entitled "DECLARATION OF DR. CONSTANTINE A. BALANIS" captioned for *inter partes* proceeding 95/001390 (the '1390 proceeding Balanis declaration); and (4) additional reference documents. In view of the guidance set forth herein, portions of the 11-page Balanis declaration for the merged proceeding and the 8-page Balanis declaration for the '1390 proceeding are deemed to include an extension of arguments of counsel. Thus, the 19 pages of the Balanis declarations are subject to the 50-page length requirement, in addition to 99-page remarks section[9] such that the '1482 requester's September 14, 2011 comments submission exceeds the regulatory page limit by up to 68 pages.

Based on the specific facts set forth in the '1482 requester's petition under 37 CFR 1.183, the '1482 requester's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a comments submission in compliance with the 50-page limit and submitting the resulting comments submission (which is in excess of 50 pages), and the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that the '1482 requester's September 14, 2011 comments submission exceeds 50 pages. Accordingly, '1482 requester's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting '1482 requester's comments submission to exceed the page limit by up to 68 pages. This waiver makes the '1482 requester's September 14, 2011 comments submission page-length compliant.

III. Time Period for Submission of the '1497 and '586 Requesters' Comments

The '1497 and '586 requesters have **30 days from the mailing date of this decision**, granting patent owner's petition under 37 CFR 1.183 and making patent owner's August 15, 2011 response submission page-length compliant, **to file a comments paper pursuant to 37 CFR 1.947**. It is noted that any petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) deemed necessary should accompany the comments submission. Further, to obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a requester comments submission that:

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[8] *Id.* at page 2. It is noted, however, as set forth in section I(A) above, patent owner's August 15, 2011 response submission has been determined to include up to 216 pages that count toward the regulatory page limit.

[9] The cover page is excluded from the page count, as is the table of contents pages.

1) is one-and-a-half or double-spaced;[10]
2) is in a non-script type font (e.g., Arial, Times New Roman, or Courier);
3) has a font size no smaller than 12-point;
4) conforms to the margin requirements of 37 CFR 1.52(a)(1)(ii); and
5) has sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.

See, generally, 37 CFR 1.943(a) and 37 CFR 1.52. Adherence to such formatting guidelines enables the Office to more accurately and uniformly determine the number of pages of a requester comments submission that the Office must review, analyze, and address to the extent needed. Attached reference materials, such as prior art references, are not subject to these formatting guidelines, as such papers are expressly excluded from the regulatory page limit count under 37 CFR 1.943(b).

CONCLUSION

1. Patent owner's August 15, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's response submission to exceed the regulatory page limit by up to 166 pages. This waiver makes patent owner's August 15, 2011 response submission page-length compliant.

2. The '1482 requester's September 14, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting the '1482 requester's comments submission to exceed the regulatory page limit by up to 68 pages. This waiver makes '1482 requester's September 14, 2011 comments submission page-length compliant.

3. The '1497 and '586 requesters have 30 days from the mailing date of this decision, granting patent owner's petition under 37 CFR 1.183 and making patent owner's August 15, 2011 response submission page-length compliant, to file a comments paper pursuant to 37 CFR 1.947.

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

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

[10] Claim charts applying the art to the claims are permitted to be single-spaced so long as the charts have sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.

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Inter Partes Reexamination Proceeding
Control No. 95/000,586
Filed: December 13, 2010
For: U.S. Patent No.: 7,397,431

Inter Partes Reexamination Proceeding
Control No. 95/001,497
Filed: December 03, 2010
For: U.S. Patent No. 7,397,431

Inter Partes Reexamination Proceeding
Control No: 95/001,482
Filed: November 11, 2010
For: U.S. Patent No. 7,397,431

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

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

Patent owner's petition to terminate filed on September 16, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/001,497, filed on September 16, 2011, is **granted**.

Inter partes reexamination proceeding control number 95/001,497 is hereby **severed** from the merged proceeding of *inter partes* reexamination control numbers 95/001,497, 95/000,586 and 95/001,482.

Inter partes reexamination proceeding 95/001,497, filed on September 16, 2011, is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,586 and 95/001,482 **will continue** in the manner set forth in this decision.[1]

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/001,497 (the '1497 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

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

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

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

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,397,431 (the '431 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd.et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner submits a copy of a consent judgment, entered by the district court on September 15, 2011, in which the district court stated that ". . . HTC [the defendant/requester of the '1497 proceeding] has not sustained its burden of proving the invalidity of any of the above listed claims of the Patents-in-Suit" and that "[t]his Consent Judgment constitutes, for purposes of 35 U.S.C.

[1] This petition does not address the petition under 37 CFR 1.182 to terminate the '586 proceeding or the petition to expunge information submitted under MPEP § 724.02, both of which were filed on September 30, 2011. These petitions will be addressed by a separate decision.

§ 317(b), a final decision entered against HTC in a civil action arising in whole or in part under section 1338 of title 28". The "above listed claims" of one of the patents in suit, the '431 patent, which is the patent under reexamination in the '1497 proceeding, are listed in the consent judgment as claims 1, 4, 5, 7, 8, 12-14, 17, 21, 22, 24-27, and 29-31, which are identical to the claims that were requested to be reexamined by HTC in the '1497 proceeding, and that are under reexamination in the merged proceeding. The court also stated, in the September 15, 2011 consent judgment, that "[a]ll of Fractus' claims against HTC are dismissed with prejudice. All of HTC's defenses, claims, and counterclaims of invalidity and unenforceability of each and every claim of the Patents-in-Suit [including the '431 patent] are dismissed with prejudice", and that "[t]he parties expressly waive their rights to appeal". Thus, the patent owner has provided sufficient evidence that (1) the requester HTC was a party to the litigation, (2) the district court's decision was final, and (3) the court determined that the requester/defendant HTC had not sustained its burden of proving the invalidity of the claims in suit, which are identical to the claims requested to be reexamined by requester HTC, and which are under reexamination in the merged proceeding. For these reasons, the above-described elements 1-3 have been shown to be satisfied.

Regarding element 4, the court also stated, in the September 15, 2011 consent judgment, that "[t]he prior art raised by [defendant/requester] HTC, Samsung, and Kyocera in the Reexaminations [listed by the court, and including the '1497 *inter partes* reexamination proceeding] was raised by HTC, or could have been raised by HTC, in this suit". Thus, element 4 has been shown to be satisfied.

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

Inter partes reexamination proceeding control no. 95/001,497 (the '1497 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/001,497, 95/000,586 and 95/001,482.

Inter partes reexamination proceeding control no. 95/001,497 (the '1497 proceeding) is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,586 and 95/001,482 **will continue**.[2] Any rejection proposed by HTC (the requester of the '1497 proceeding) which has been adopted and applied by the examiner in an Office action in the merged proceeding, will remain in the merged proceeding. An examiner "adopts" a proposed rejection as his own. Any rejection proposed by the requester HTC, which was adopted by the examiner, will remain in the merged proceeding as a rejection raised by the examiner, unless the examiner, during the course of the reexamination, makes a determination based on the merits that the rejection should be withdrawn. The examiner's determination, in the merged proceeding, not to adopt any rejection that was proposed solely by the requester HTC, may not be appealed or otherwise addressed by the remaining requesters of the merged proceeding. The examiner's determination, in the merged proceeding, not to adopt any rejection proposed by HTC that was

[2] As pointed out above, this decision does not address the September 30, 2011 petition to terminate the '586 proceeding which is presently pending. This petition will be addressed by a separate decision.

also *properly* proposed by one or both of the remaining requesters, may be appealed in the merged proceeding only by the requester who *properly* proposed the rejection.[3] As noted in the May 4, 2011 decision entitled "Decision, *Sua Sponte*, Merging *Inter Partes* Proceedings" (the May 4, 2011 merger decision), because the requester of the '586 proceeding did not propose any rejections of claims 21, 24-26, and 30 in its request for reexamination, the requester of the '586 proceeding has no appeal rights as to those claims as they appear in the '431 patent.

All papers filed by the patent owner and by the remaining requesters of the merged proceeding must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for *inter partes* reexamination proceeding control nos. 95/000,586 and 95/001,482, for entry into the file of each proceeding. The conduct of the merged proceeding of 95/000,586 and 95/001,482 will otherwise remain, in general, as outlined by the May 4, 2011 merger decision.

The '1497 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for conclusion of that proceeding. The CRU will mail the present decision, and process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The file will be assigned an 822 status. A copy of the PALM "Application Number Information" screen and the "Contents" screen will be printed, the printed copy will be annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy will then be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

CONCLUSION

- Patent owner's September 16, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/001,497 is **granted**.

- *Inter partes* reexamination proceeding control no. 95/001,497 (the '1497 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/001,497, 95/000,586 and 95/001,482.

- The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,586 and 95/001,482 **will continue** in the manner set forth in this decision.

- The prosecution of the '1497 *inter partes* reexamination proceeding is hereby **terminated** and will be concluded.

- The '1497 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for further processing to conclude the '1497 proceeding, as set forth in this decision.

---

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

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

Kenneth M. Schor

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

Kenpet9

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,498	12/03/2010	7015868	3008.001REX2	7027

26111 7590 05/23/2011

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

ART UNIT	PAPER NUMBER

DATE MAILED: 05/23/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BAKER BOTTS, LLP
PATENT DEPARTMENT
98 SAN JACINTO BLVD., SUITE 1500
AUSTIN, TX 78701-4039

Date: MAILED

MAY 23 '011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001498
PATENT NO. : 7015868
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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MAY 23 2011

CENTRAL REEXAMINATION U

Sterne, Kessler, Goldstein & Fox P.L.L.C. (For Patent Owner)
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Baker Botts, LLP (For 95/001,498 Requester)
Patent Department
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Suite 1500
San Antonio, TX 78701-4039

Morrison & Foerster LLP (For 95/000,589 Requester)
12531 High Bluff Drive
Suite 100
San Diego, CA 92130

Novak Druce & Quigg, LLP (For 95/001,390 Requester)
(NDQ Reexamination Group)
1000 Louisiana Street
53rd Floor
Houston, TX 77002

In re Carles Puente Baliarde et al. :
Inter Partes Reexamination Proceeding :
Control No.: 95/001,498 :
Filed: December 3, 2010 :
For: U.S. Patent No. 7,015,868 :
:
In re Carles Puente Baliarde et al. : **DECISION, *SUA SPONTE*,**
Inter Partes Reexamination Proceeding : **TO MERGE**
Control No.: 95/000,589 : **REEXAMINATION**
Filed: November 16, 2010 : **PROCEEDINGS**
For: U.S. Patent No. 7,015,868 :
:
In re Carles Puente Baliarde et al. :
Inter Partes Reexamination Proceeding :
Control No.: 95/001,390 :
Filed: July 2, 2010 :
For: US. Patent No. 7,015,868 :

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.989.

BACKGROUND

1. U.S. Patent No. 7,015,868 ("the '868 patent") issued to Carles Puente Baliarde et al. on March 21, 2006, with 37 claims.

2. A request for *inter partes* reexamination of claims 1, 3, 6, 12, 14, 23, 26, and 32-35 of the '868 patent was filed on July 2, 2010, by a third party requester, and was assigned control number 95/001,390 ("the '1390 *inter partes* proceeding"). The real party in interest is Samsung Electronics Co. Ltd.

3. On August 12, 2010, *inter partes* reexamination was ordered for claims 1, 3, 6, 12, 14, 23, 26, and 32-35 of the '868 patent in the '1390 *inter partes* proceeding based on the examiner's determination that the July 2, 2010 request raised a substantial new question of patentability affecting these claims. The order was followed by a non-final rejection action mailed on August 19, 2010.

4. A second request for *inter partes* reexamination of claims 1, 3, 6, 12, 14, 23, 26, and 32-35 of the '868 patent was filed on November 16, 2010, by a third party requester, and was assigned control number 95/000,589 ("the '589 *inter partes* proceeding"). The real party in interest is Kyocera Communications, Inc.

5. A third request for *inter partes* reexamination of claims 1, 3, 6, 12, 14, 23, 26, and 32-35 of the '868 patent was filed on December 3, 2010, by a third party requester, and was assigned control number 95/001,498 ("the 1498 *inter partes* proceeding"). The real party in interest is HTC Corporation and HTC America, Inc.

6. On January 13, 2011, *inter partes* reexamination was ordered for claims 1, 3, 6, 12, 14, 23, 26, and 32-35 of the '868 patent in the '589 *inter partes* proceeding based on the examiner's determination that the November 16, 2010 request raised a substantial new question of patentability affecting these claims. No Office action on the merits has been issued in the '589 proceeding.

7. On January 25, 2011, *inter partes* reexamination was ordered for claims 1, 3, 6, 12, 14, 23, 26, and 32-35 of the '868 patent in the '1498 *inter partes* proceeding based on the examiner's determination that the December 3, 2010 request raised a substantial new question of patentability affecting these claims. No Office action on the merits has been issued in the '1498 proceeding.

8. On April 11, 2011, patent owner submitted a response to the August 19, 2010 non-final rejection action in the '1390 *inter partes* proceeding.[1] The April 11, 2011 patent owner response did not include any amendment to the specification or claims.

---

[1] Patent owner's April 11, 2011 response in the '1390 *inter partes* proceeding was a corrected response filed in response to a March 25, 2011 Notice Re Defective Paper In Inter Partes Reexamination. The March 25, 2011 Notice stated that patent owner's original November 19, 2010 response to the August 19, 2010 non-final rejection action was defective.

9. On May 2, 2011,the '1390 requester filed comments to patent owner's April 11, 2011 response.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in three proceedings for the same claims of the same patent. All three proceedings are *inter partes* proceedings. All three proceedings are still pending, and have not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989 provides:

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

In accordance with 37 CFR 1.989(a), the 95/001,390, 95/000,589 and 95/001,498 proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL THREE PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges three *inter partes* reexamination proceedings. The merged proceeding is governed by 37 CFR 1.902 through 1.997. Pursuant to 37 CFR 1.989(a), the merged examination will normally result in the issuance and publication of a single reexamination certificate under 37 CFR 1.997.

B. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all three proceedings. All papers issued by the Office, or filed by the patent owner and the third party requester(s), will contain the identifying data for all three proceedings and will be entered in each reexamination file. All papers filed by the patent owner and the third party requester(s) must consist of a single paper, **filed in triplicate**, each bearing a

signature and identifying data for all three proceedings, for entry into each file.

All papers filed by the patent owner and the third party requester(s) should be directed:

by Mail to: Attn: Mail Stop "*Inter Partes* Reexam"
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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

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

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

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

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

C. Amendments:

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

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

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

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

F. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest. The third party requester must identify each rejection *that was previously proposed by* <u>*that*</u> *third party requester* that the third party requester intends to contest, and each rejection made and later withdrawn by the examiner that the third party requester intends to contest. No new ground of rejection (including one proposed by another requester, but not the appellant requester) can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. See 37 CFR 41.67(c)(1)(vi) as to the proposed rejections that each individual requester can challenge in the appellant brief.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,390, *inter partes* Reexamination No. 95/000,589 and *inter partes* Reexamination Control No. 95/001,498 <u>are merged into a single proceeding</u>, to be conducted in accordance with the procedure set forth above.

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

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

/Kenneth M. Schor/

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

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,498	12/03/2010	7015868	3008.001REX2	7027

26111 7590 06/20/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/20/2011

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,498	12/03/2010	7,015,868	079957.0104

EXAMINER
MENEFEE, JAMES

ART UNIT	PAPER
3992	

BAKER BOTTS LLP
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98 SAN JACINTO BLVD.
SUITE 1500
AUSTIN, TX 78701-4039

DATE MAILED:

06/20/11

INTER PARTES REEXAMINATION COMMUNICATION

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

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

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,498	12/03/2010	7,015,868	079957.0104

EXAMINER
MENEFEE, JAMES

ART UNIT	PAPER
3992	

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98 SAN JACINTO BLVD.
SUITE 1500
AUSTIN, TX 78701-4039

DATE MAILED:

INTER PARTES REEXAMINATION COMMUNICATION

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

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CENTRAL REEXAMINATION UNIT

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HOUSTON, TX 77002

Inter Partes Reexamination Proceeding Control No. 95/001,498 Filed: December 3, 2010 For: U.S. Patent No. 7,015,868	
Inter Partes Reexamination Proceeding Control No. 95/000,589 Filed: November 16, 2010 For: U.S. Patent No. 7,015,868	**DECISION ON PETITIONS UNDER 37 CFR 1.183**
Inter Partes Reexamination Proceeding Control No. 95/001,390 Filed: July 2, 2010 For: U.S. Patent No. 7,015,868	

This is a decision on the patent owner petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on April 11, 2011 in reexamination proceeding control no. 95/001,390.

This is also a decision on the third party requester petition paper entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)," filed on May 2, 2011, in reexamination proceeding control no. 95/001,390.

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

The patent owner petition under 37 CFR 1.183 is **dismissed as unnecessary** and the third party requester petition under 37 CFR 1.183 is **granted** to the extent set forth below.

BACKGROUND

1. On March 21, 2006, U.S. patent number 7,015,868 (the '868 patent) issued to Baliarde *et al.*

2. On July 2, 2010, a third party requester filed a request for *inter partes* reexamination of the '868 patent, which request was assigned Reexamination Control No. 95/001,390 (the '1390 proceeding).

3. On August 12, 2010, the Office issued an order granting *inter partes* reexamination in the '1390 proceeding and, on August 19, 2010, the Office issued a non-final Office action.

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

5. On March 7, 2011, third party requester filed corrected comments after the August 19, 2010 Office action and patent owner's November 19, 2010 response.[2]

6. On March 25, 2011, the Office mailed a "NOTICE OF DEFECTIVE PAPER IN *INTER PARTES* REEXAMINATION" (the notice of defective paper), finding patent owner's November 19, 2010 response defective and setting a time period of 15 days from the mailing date of the notice of defective paper for patent owner to file a corrected response submission.

7. On April 11, 2011, patent owner filed the instant "PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION" (patent owner petition under 37 CFR 1.183), concurrently with a corrected response to the August 19, 2010 Office action (patent owner corrected response submission).

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

[1] On October 7, 2010, the Office mailed a decision granting patent owner's September 27, 2010 petition for a one-month extension of time.
[2] On February 24, 2011, the Office mailed a decision granting patent owner's January 31, 2011 petition under 37 CFR 1.181 and expunging the '1390 requester's December 20, 2010 comments submission and giving the '1390 requester 15 days from the mailing date of that decision to file corrected comments.

August 19, 2010 Office action and patent owner's April 11, 2011 corrected response submission (requester comments submission).

9. On May 23, 2011, the Office issued a "DECISION, *SUA SPONTE*, MERGING *INTER PARTES* PROCEEDINGS," merging the '1390 proceeding with *inter partes* reexamination proceeding control no. 95/001,498 (the '1498 proceeding) and with *inter partes* reexamination proceeding control no. 95/000,589 (the '589 proceeding).

DECISION

I. Relevant Statutes, Regulations and Procedures

35 U.S.C. 314(b)(2) provides:

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

37 CFR 1.183 provides:

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

37 CFR 1.943(b) provides:

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

II. Analysis

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a

response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts,** or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see*, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

III. Patent owner petition of April 11, 2011

On April 11, 2011, patent owner filed, in the '1390 proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b), to permit entry of its concurrently-filed corrected response submission. Patent owner asserts that the argument portion of the April 11, 2011 corrected response submission is 39 pages long, thereby complying with the 50-page limit of 37 CFR 1.943(b).[3] Patent owner states that "a number of Rule 132 declarations are filed herewith" but asserts that "these declarations are drawn to fact, not argument, and thus do not count towards the 50-page limit."[4] Nonetheless, patent owner requests waiver of the 50-page limit "for the combination of the Corrected Response and any of the Rule 132 declarations (or portion(s) thereof) considered to include argument as opposed to facts, to the extent such combination exceeds the 50-page limit of 37 C.F.R. § 1.943(b)."[5]

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

[4] Id. (stating that the "Declaration of Dr. Carles Puente Under 37 C.F.R. § 1.132 (10 pages)," the "Declaration of Drs. Carles Puente, Carmen Borja, Jaume Anguere, and Jordi Soler Under 37 C.F.R. § 1.132 (9 pages)," the "Declaration of Rubén Bonet Under 37 C.F.R. § 1.132 (7 pages)," and the "Declaration of Dr. Yahya Rahmat-Samii Under 37 C.F.R. § 1.132 (19 pages)" are filed herewith, and that "Dr. Rahmat-Samii attached to his declaration the Declaration of Dr. Dwight L. Jaggard solely for Dr. Jaggard's reference to what would constitute a person of ordinary skill.")

[5] Id.

In support of its request for waiver of the rule, patent owner asserts that none of the declarations filed with the April 11, 2011 corrected response submission includes argument or opinions that would be counted towards the 50-page limit.[6] Additionally, patent owner asserts that "the full length of the Corrected Response and the Rule 132 declarations are needed to fully and adequately respond to the Office Action," and that although the Office action "constitutes only 7 pages, it incorporates by reference over 150 pages of argument and detailed claim charts set forth by the third party requester in its request for reexamination."[7] Patent owner further asserts that it has attempted to draft a corrected response in compliance with the 50-page limit, as well as in compliance with the formatting requirements set forth in the March 25, 2011 notice of defective paper, by taking measures to "economize, avoid extraneous material and information already of record, and present arguments efficiently."[8] As evidence of the reformatting and further editing made to reduce page length, patent owner submitted with the petition under 37 CFR 1.183 as "Exhibit 1" a redlined document comparing patent owner's November 19, 2010 original response submission to patent owner's April 11, 2011 corrected response submission. The "Exhibit 1" document has been expunged from the record of the '1390 proceeding by marking the paper "closed" and "not public" in the image file wrapper (IFW) as it contains the full content of the paper that was deemed defective by the March 25, 2011 notice of defective paper.

In this instance, patent owner's April 11, 2011 corrected response submission is page-length compliant as the total number of pages that count toward the regulatory page limit does not exceed 50 pages.[9] Thus, no waiver of 37 CFR 1.943(b) is required for entry of patent owner's April 11, 2011 corrected response submission. Accordingly, patent owner's request for waiver of the 50-page limit of 37 CFR 1.943(b) is dismissed as unnecessary.

IV. Third party requester petition of May 2, 2011

On May 2, 2011, the '1390 requester filed, in the '1390 proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) to permit entry of its concurrently-filed comments submission. The '1390 requester asserts that the May 2, 2011 comments submission includes "50 pages of double spaced 12 pt font arguments and an 8 page declaration from Dr.

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[6] Id. at pages 2-4.
[7] Id. at page 5.
[8] Id. at pages 5-6.
[9] 38 pages of the remarks portion of patent owner's April 11, 2011 corrected response submission count toward the page limit (the cover page and certificate of service page are excluded from the page count, as is the 6-page listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count). Further, based on the guidance set forth in section II above, portions of the 19-page "Declaration of Dr. Yahya Rahmat-Samii Under 37 C.F.R. § 1.132" that are subject to the regulatory page limit count do not cause the total number of pages of patent owner's April 11, 2011 corrected response submission to exceed the 50-page limit (*e.g.*, excluded from the page count are portions related to declarant's qualifications, technical background information, technical explanations of terms of art used by a reference, etc.). It is noted that the pages of the "Declaration of Dr. Carles Puente Under 37 C.F.R. § 1.132," the "Declaration of Drs. Carles Puente, Carmen Borja, Jaume Anguere, and Jordi Soler Under 37 C.F.R. § 1.132," and the "Declaration of Rubén Bonet Under 37 C.F.R. § 1.132" do not count toward the regulatory page limit. Additionally, in this instance, the pages of the copies of the court documents that were filed as "Exhibit 2" and "Exhibit 7B" also do not count toward the regulatory page limit.

Balanis under 37 C.F.R. § 1.132."[10] The '1390 requester asserts, however, that "[i]f the Office agrees with [patent owner's] interpretation of MPEP § 2667(I)(A)(2), then Samsung's Comments are only 50 pages as Dr. Balanis's declaration discusses how one of ordinary skill in the art would understand the disclosure of the prior art at issue."[11]

In support of its request for waiver of the rule, the '1390 requester asserts that "[t]he additional pages requested in this petition are necessary to provide a reply [to] all of the issues raised by the Patent Owner's 114 page response."[12] The '1390 requester asserts that it "has attempted to respond in as little a number of pages as possible but was unable to do so within the 50 page limit" and "is asking for significantly fewer total pages than [sic] the Patent Owner has submitted," *i.e.*, requester "is only asking for a total of 58 pages."[13] The '1390 requester also asserts that "in the interest of justice, the Office should grant this petition so that the Requester is able to provide the Office with a rebuttal of all of the arguments raised by the Patent Owner."[14]

Based on the specific facts set forth in the '1390 requester's petition under 37 CFR 1.183, the '1390 requester's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a comments submission in compliance with the 50-page limit and submitting the resulting comments submission (which is in excess of 50 pages),[15] and the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that the '1390 requester's May 2, 2011 comments submission exceeds 50 pages. Accordingly, the '1390 requester's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of the '1390 requester's May 2, 2011 comments submission. This waiver makes the '1390 requester's May 2, 2011 comments submission page-length compliant.

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

[11] Id. at page 4. The '1390 requester is cautioned that statements submitted in opposition to patent owner's petition under 37 CFR 1.183 are improper and may result in the requester's petition paper being returned and not considered, as set forth in 37 CFR 1.939(a). For example, on pages 3-4 of the third party requester petition under 37 CFR 1.183, the '1390 requester presents arguments against patent owner's position set forth in patent owner's petition under 37 CFR 1.183. Pursuant to MPEP 2667(I)(B)(4), a requester does not have a statutory right to challenge this discretionary procedural process (*i.e.*, waiver of the regulatory page limit) in the reexamination proceeding. Pursuant to 35 U.S.C. § 314(b)(2), the third party requester in an ordered *inter partes* reexamination proceeding has a statutory right to once file written comments to a patent owner's response to an Office action on the merits. Patent owner's petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) for patent owner's corrected response submission, however, is not a "response" to an Office action on the merits. Thus, in this instance, 35 U.S.C. § 314(b)(2) does not provide any right for the third party requester to file comments on a patent owner's petition under 37 CFR 1.183 for suspension of the rules. Accordingly, any future petition that contains such arguments will be treated as an improper opposition paper and, as such, will be returned by marking the paper "closed" and "not public" in the IFW for the proceeding and will not be considered. Thus, any reply that exceeds the regulatory page limit which accompanies such petition would be found not page-length compliant.

[12] Id. at page 2.

[13] Id.

[14] Id.

[15] 50 pages of the remarks portion of the '1390 requester's May 2, 2011 comments submission count toward the page limit. Further, based on the guidance set forth in section II above, to the extent portions of the 8-page "Declaration of Dr. Constantine A. Balanis" are subject to the regulatory page limit count, the total number of pages of the May 2, 2011 comments submission exceeds the 50-page limit. In this instance, the pages of the copies of the court documents that were filed as exhibits to the May 2, 2011 comments submission do not count toward the regulatory page limit.

CONCLUSION

1. Patent owner's April 11, 2011 petition under 37 CFR 1.183 is **dismissed as unnecessary**.

2. The '1390 requester's May 2, 2011 petition under 37 CFR 1.183 is **granted** and the 50-page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of the '1390 requester's May 2, 2011 comments submission. This waiver makes the '1390 requester's May 2, 2011 comments submission page-length compliant.

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

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

06-17-2011

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,498	12/03/2010	7015868	3008.001REX2	7027

26111 7590 11/18/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/18/2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,589	11/16/2010	7015868	3008.001REX1	9707

26111 7590 11/18/2011

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,390	07/02/2010	7015868	3008.001REX0	8872

26111 7590 11/18/2011

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

EXAMINER

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SUITE 100
SAN DIEGO, CA 92130-2040

Date:

MAILED

NOV 18 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000589
PATENT NO. : 7015868
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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HOUSTON, TX 77002

Date: MAILED

NOV 18 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001390
PATENT NO. : 7015868
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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BAKER BOTTS, LLP
PATENT DEPARTMENT
98 SAN JACINTO BLVD., SUITE 1500
AUSTIN, TX 78701-4039

Date:

MAILED

NOV 18 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001498
PATENT NO. : 7015868
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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HOUSTON, TX 77002

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98 SAN JACINTO BLVD., SUITE 1500
AUSTIN, TX 78701-4039

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NOV 18 2011

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/000,589
Filed: November 16, 2010
For: U.S. Patent No. 7,015,868

Inter Partes Reexamination Proceeding
Control No. 95/001,390
Filed: July 2, 2010
For: U.S. Patent No. 7,015,868

Inter Partes Reexamination Proceeding
Control No. 95/001,498
Filed: December 3, 2010
For: U.S. Patent No. 7,015,868

DECISION ON PETITION UNDER 37 CFR 1.183

This is a decision on the patent owner petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on October 3, 2011 in reexamination proceeding control nos. 95/000,589, 95/001,390, and 95/001,498.

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

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

RELEVANT BACKGROUND

1. On March 21, 2006, U.S. patent number 7,015,868 (the '868 patent) issued to Puente Baliarda *et al.*

2. Subsequently, three requests for *inter partes* reexamination of the '208 patent, which requests were assigned Reexamination Control Nos. 95/001,390, 95/000,589, and 95/001,498, were instituted by the Office.

3. On May 23, 2011, the Office issued a "DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS," merging the '1390 proceeding with the '589 and '1498 proceedings (the merged proceeding).

4. On July 1, 2011, the Office issued a non-final Office Action in the merged proceeding.

5. On October 3, 2011, patent owner filed a response to the July 1, 2011 Office action in the merged proceeding, concurrently with the instant "PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION" (patent owner petition under 37 CFR 1.183).[1]

DECISION

I. Relevant Statutes, Regulations and Procedures

35 U.S.C. 314(b)(2) provides:

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

37 CFR 1.183 provides:

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

[1] On August 5, 2011, the Office mailed a decision granting a one-month extension of time for patent owner's response to the July 1, 2011 Office action.

37 CFR 1.943(b) provides:

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

II. Analysis

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts,** or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see*, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

III. Patent owner petition of October 3, 2011

On October 3, 2011, patent owner filed, in the merged proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b), to permit entry of its concurrently-filed response submission. Patent owner asserts that the argument portion of the October 3, 2011 response submission is 121 pages long, exceeding the 50-page limit of 37 CFR 1.943(b), and requests waiver of the regulatory page limit as to the response submission.[2] Patent owner states that it concurrently filed "a number of 132 declarations" but asserts that the declarations "include only facts and thus does not count towards the 50-page limit."[3] Nonetheless, patent owner also requests waiver of the 50-page limit for "those portions of the 132 Declarations that the PTO holds count towards the 50 page limit...."[4]

In support of its request for waiver of the rule, patent owner asserts that none of the declarations filed with the October 3, 2011 response submission includes argument or opinions that would be counted towards the 50-page limit.[5] Additionally, patent owner asserts that "the full length of the Response is needed to fully and adequately respond to the Office Action," and that although the Office action "constitutes only 44 pages, it incorporates by reference almost 550 pages of argument and detailed claim charts set forth by the three third party requesters in their requests for reexamination."[6] Patent owner further asserts that it has attempted to draft a response in compliance with the 50-page limit by taking measures to "economize, avoid extraneous material and information already of record, and present arguments efficiently."[7]

Based on the specific facts set forth in patent owner's petition under 37 CFR 1.183, patent owner's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response (which is in excess of 50 pages),[8] and the individual facts and circumstances of this case (such as the length of the July 1, 2011 Office action),[9] it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance.

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

[3] Id. at page 4 (identifying two declaration(s) of Dr. Carles Puente under 37 C.F.R. § 1.132 (10 pages and 15 pages), a declaration of Drs. Carles Puente, Carmen Borja, Jaume Anguera and Jordi Soler under 37 C.F.R. § 1.132 (9 pages), a declaration of Aurora Andujar under 37 C.F.R. § 1.132 (13 pages), a declaration of Ruben Bonet under 37 C.F.R. § 1.132 (13 pages), and two declaration(s) of Dr. Raj Mittra under 37 C.F.R. § 1.132 (each 20 pages)).

[4] Id. at page 2.

[5] Id. at pages 4-7.

[6] Id. at page 2-3.

[7] Id. at page 3.

[8] 122 pages of the remarks portion of patent owner's October 3, 2011 response submission count toward the page limit (the cover page and pages of the table of contents are excluded from the page count, as is the 6-page listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count). Additionally, at least portions of the 20-page declaration of Dr. Raj Mittra under 37 C.F.R. § 1.132 are deemed to be an extension of the arguments of counsel and count toward the page limit. Thus, up to 142 pages of the patent owner's October 3, 2011 response submission count toward the 50-page limit.

[9] On its face, the substantive portion of the July 1, 2011 Office action spans only approximately 44 pages, but it incorporates by reference numerous pages from the '1390, '1498 and '589 requests for *inter partes* reexamination and comments submissions.

Thus, it is deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that patent owner's response to the July 1, 2011 Office action exceeds 50 pages. Accordingly, patent owner's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's October 3, 2011 response submission to exceed the regulatory page limit by up to 92 pages. This waiver makes patent owner's October 3, 2011 response submission page-length compliant.

ADDITIONAL DISCUSSION

The 95/001,390 third party requester, 95/001,498 third party requester and the 95/000,589 third party requester have 30 days from the date of this decision, granting patent owner's October 3, 2011 petition under 37 CFR 1.183 and entering patent owner's October 3, 2011 response submission, to file a comment paper pursuant to 37 CFR 1.947. MPEP 2666.05(I) provides:

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

CONCLUSION

1. Patent owner's October 3, 2011 petition under 37 CFR 1.183 is **granted** and the 50-page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's October 3, 2011 response submission to exceed the regulatory page limit by up to 92 pages. This waiver makes patent owner's October 3, 2011 response submission page-length compliant.

2. The 95/001,390 third party requester, 95/001,498 third party requester and the 95/000,589 third party requester each has 30 days from the mailing date of this decision, granting patent

owner's October 3, 2011 petition under 37 CFR 1.183 and entering patent owner's October 3, 2011 response submission, to file a comment paper pursuant to 37 CFR 1.947.

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

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

11-17-2011

United States Patent and Trademark Office

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DEC 12 2011

CENTRAL REEXAMINATION UNIT

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Washington, D.C. 20005

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12531 High Bluff Drive
Suite 100
San Diego, CA 92130-2040

Baker Botts, LLP (For *Inter Partes*' 1498 Requester)
2001 Ross Avenue
Suite 600
Dallas, TX 75201-2980

Novak, Druce & Quigg, LLP (For *Inter Partes* '1390 Requester)
(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-third Floor
Houston, TX 77002

Inter Partes Reexamination Proceeding
Control No. 95/000,589
Filed: November 16, 2010
For: U.S. Patent No.: 7,015,868

Inter Partes Reexamination Proceeding
Control No. 95/001,498
Filed: December 03, 2010
For: U.S. Patent No. 7,015,868

Inter Partes Reexamination Proceeding
Control No: 95/001,390
Filed: July 02, 2010
For: U.S. Patent No. 7,015,868

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

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

Patent owner's petition to terminate filed on September 16, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/001,498, filed on September 16, 2011, is **granted**.

Inter partes reexamination proceeding control number 95/001,498 is hereby **severed** from the merged proceeding of *inter partes* reexamination control numbers 95/001,498, 95/000,589 and 95/001,390.

Inter partes reexamination proceeding 95/001,498, filed on September 16, 2011, is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,589 and 95/001,390 **will continue** in the manner set forth in this decision.[1]

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/001,498 (the '1498 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

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

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

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

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,015,868 (the '868 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd.et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner submits a copy of a consent judgment, entered by the district court on September 15, 2011, in which the district court stated that ". . . HTC [the defendant/requester of the '1498 proceeding] has not sustained its burden of proving the invalidity of any of the above listed claims of the Patents-in-Suit" and that "[t]his Consent Judgment constitutes, for purposes of 35 U.S.C.

[1] This petition does not address the petition under 37 CFR 1.182 to terminate the '589 proceeding or the petition to expunge information submitted under MPEP § 724.02, both of which were filed on September 30, 2011. These petitions will be addressed by a separate decision.

§ 317(b), a final decision entered against HTC in a civil action arising in whole or in part under section 1338 of title 28". The "above listed claims" of one of the patents in suit, the '868 patent, which is the patent under reexamination in the '1498 proceeding, are listed in the consent judgment as claims 1, 3, 6, 12, 14, 23, 26, and 32-35, which are identical to the claims that were requested to be reexamined by HTC in the '1498 proceeding, and that are under reexamination in the merged proceeding. The court also stated, in the September 15, 2011 consent judgment, that "[a]ll of Fractus' claims against HTC are dismissed with prejudice. All of HTC's defenses, claims, and counterclaims of invalidity and unenforceability of each and every claim of the Patents-in-Suit [including the '868 patent] are dismissed with prejudice", and that "[t]he parties expressly waive their rights to appeal". Thus, the patent owner has provided sufficient evidence that (1) the requester HTC was a party to the litigation, (2) the district court's decision was final, and (3) the court determined that the requester/defendant HTC had not sustained its burden of proving the invalidity of the claims in suit, which are identical to the claims requested to be reexamined by requester HTC, and which are under reexamination in the merged proceeding. For these reasons, the above-described elements 1-3 have been shown to be satisfied.

Regarding element 4, the court also stated, in the September 15, 2011 consent judgment, that "[t]he prior art raised by [defendant/requester] HTC, Samsung, and Kyocera in the Reexaminations [listed by the court, and including the '1498 *inter partes* reexamination proceeding] was raised by HTC, or could have been raised by HTC, in this suit". Thus, element 4 has been shown to be satisfied.

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

Inter partes reexamination proceeding control no. 95/001,498 (the '1498 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/001,498 , 95/000,589 and 95/001,390.

Inter partes reexamination proceeding control no. 95/001,498 (the '1498 proceeding) is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,589 and 95/001,390 **will continue**.[2] Any rejection proposed by HTC (the requester of the '1498 proceeding) which has been adopted and applied by the examiner in an Office action in the merged proceeding, will remain in the merged proceeding. An examiner "adopts" a proposed rejection as his own. Any rejection proposed by the requester HTC, which was adopted by the examiner, will remain in the merged proceeding as a rejection raised by the examiner, unless the examiner, during the course of the reexamination, makes a determination based on the merits that the rejection should be withdrawn. The examiner's determination, in the merged proceeding, not to adopt any rejection that was proposed solely by the requester HTC, may not be appealed or otherwise addressed by the remaining requesters of the merged proceeding. The examiner's determination, in the merged proceeding, not to adopt any rejection proposed by HTC that was

[2] As pointed out above, this decision does not address the September 30, 2011 petition to terminate the '589 proceeding which is presently pending. This petition will be addressed by a separate decision.

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

All papers filed by the patent owner and by the remaining requesters of the merged proceeding must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for *inter partes* reexamination proceeding control nos. 95/000,589 and 95/001,390, for entry into the file of each proceeding. The conduct of the merged proceeding of 95/000,589 and 95/001,390 will otherwise remain, in general, as outlined by the decision, mailed on May 23, 2011, entitled "Decision, *Sua Sponte*, Merging *Inter Partes* Proceedings".

The '1498 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for conclusion of that proceeding. The CRU will mail the present decision, and process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The file will be assigned an 822 status. A copy of the PALM "Application Number Information" screen and the "Contents" screen will be printed, the printed copy will be annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy will then be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

CONCLUSION

- Patent owner's September 16, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/001,498 is **granted**.
- *Inter partes* reexamination proceeding control no. 95/001,498 (the '1498 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/001,498, 95/000,589 and 95/001,390.
- The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,589 and 95/001,390 **will continue** in the manner set forth in this decision.
- The prosecution of the '1498 *inter partes* reexamination proceeding is hereby **terminated** and will be concluded.
- The '1498 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for further processing to conclude the '1498 proceeding, as set forth in this decision.

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

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

Kenneth M. Schor

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

Kenpet9

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,499 +95/001455 +95/000595	12/03/2010	7528782	3008.003REX2	7053

26111 7590 05/24/2011

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

ART UNIT	PAPER NUMBER

DATE MAILED: 05/24/2011

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

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Date: 5-24-11

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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PATENT DEPARTMENT
98 SAN JACINTO BLVD., SUITE 1500
AUSTIN, TX 78701-4039

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001499 → 95/001455 → 95/000595
PATENT NO. : 7528782
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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MAY 24 2011

CENTRAL REEXAMINATION UNIT

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Patent Department
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Austin, TX 78701-4039

Tracy W. Druce (For 95/001,455 Requester)
Novak Druce & Quigg, LLP
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53rd Floor
Houston, TX 77002

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

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.989.

BACKGROUND

1. U.S. Patent No. 7,528,782 ("the '782 patent") issued to Carles Puente Baliarda et al. on May 5, 2009, with 29 claims.

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

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

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

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

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

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

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

---

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

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

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

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in three proceedings for overlapping claims of the same patent. All three proceedings are *inter partes* proceedings. All three proceedings are still pending, and have not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989 provides:

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

In accordance with 37 CFR 1.989(a), the 95/001,455, 95/001,499 and 95/000,595 proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL THREE PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges three *inter partes* reexamination proceedings. The merged proceeding is governed by 37 CFR 1.902 through 1.997. Pursuant to 37 CFR 1.989(a), the merged examination will normally result in the issuance and publication of a single reexamination certificate under 37 CFR 1.997.

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

B. Papers mailed/filed:

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

All papers filed by the patent owner and the third party requester(s) should be directed:

by Mail to: Attn: Mail Stop "*Inter Partes* Reexam"
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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

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

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

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

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

C. Amendments:

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

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

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for

reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

D. Fees:

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

E. Citation of Patents and Printed Publications:

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

F. Appeal Procedure Reminders for *Inter Partes* Reexamination

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

CONCLUSION

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

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

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

/Kenneth M. Schor/

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

May 20, 2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,499 +95/000595 +95/001455	12/03/2010	7528782	3008.003REX2	7053

26111 7590 06/22/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/22/2011

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Date: 6-22-11

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PATENT DEPARTMENT
98 SAN JACINTO BLVD., SUITE 1500
AUSTIN, TX 78701-4039

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001499 + 95/001455 + 95/000595
PATENT NO. : 7528782
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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

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

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

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

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

BACKGROUND

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

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

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

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

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

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

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

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

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

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

DECISION

I. Relevant Statutes, Regulations and Procedures

35 U.S.C. 314(b)(2) provides:

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

37 CFR 1.183 provides:

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

37 CFR 1.943(b) provides:

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

II. Analysis

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set

forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts,** or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see*, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

III. Patent owner petition of April 12, 2011

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

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

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

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

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

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

IV. Third party requester petition of April 28, 2011

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

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

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

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

Based on the specific facts set forth in the '1455 requester's petition under 37 CFR 1.183, the '1455 requester's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a comments submission in compliance with the 50-page limit and submitting the resulting comments submission (which is in excess of 50 pages),[15] and the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that the '1455 requester's April 28, 2011 comments submission exceeds 50 pages. Accordingly, the '1455 requester's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent necessary to permit entry of the '1455 requester's April 28, 2011 comments submission. This waiver makes the '1455 requester's April 28, 2011 comments submission page-length compliant.

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

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

[12] Id. at page 2.

[13] Id.

[14] Id.

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

ADDITIONAL DISCUSSION

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

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

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

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

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

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

CONCLUSION

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

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

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

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

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

06-17-2011

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,499 + 95/000595 + 95/001499	12/03/2010	7528782	3008.003REX2	7053

26111 7590 09/08/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/08/2011

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

BAKER BOTTS L.L.P.
PATENT DEPARTMENT
98 SAN JACINTO BLVD. SUITE 1500
AUSTIN, TX 78701-4039

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

REEXAMINATION CONTROL NUMBER 95/001,499 + 95/000595 + 95/001455

PATENT NUMBER 7528782.

TECHNOLOGY CENTER 3999.

ART UNIT 3992.

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

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

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

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

Decision on Petition for Extension of Time in Reexamination	Control No.: 95/001,455 + 95/000,595 + 95/001,499

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

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

3. FORMAL MATTERS
   Patent owner requests that the period for responding to the Office action mailed on 07/29/2011, which sets a two (2) month period for filing a response thereto, be extended by two (2) months.

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

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

5. CONCLUSION

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

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

[*Signature*] — (Title)

United States Patent and Trademark Office

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DEC 12 2011

CENTRAL REEXAMINATION UNIT

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

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

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

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

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

Patent owner's petition to terminate filed on September 16, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/001,499, filed on September 16, 2011, is **granted**.

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

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

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

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/001,499 (the '1499 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

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

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

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

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

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

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

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

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

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

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

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

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

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

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

The '1499 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for conclusion of that proceeding. The CRU will mail the present decision, and process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The file will be assigned an 822 status. A copy of the PALM "Application Number Information" screen and the "Contents" screen will be printed, the printed copy will be annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy will then be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

CONCLUSION

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

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

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

Kenneth M. Schor

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

Kenpet9

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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.
95/001,500	12/03/2010	7394432	3008.007REX2	7084

26111 7590 05/11/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/11/2011

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

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Commissioner for Patents
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BAKER BOTTS L.L.P.
PATENT DEPARTMENT
98 SAN JACINTO BLVD., SUITE 1500
AUSTIN, TX 78701-4039

Date: MAILED

MAY 1 1 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001500
PATENT NO. : 7394432
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

Decision on Petition for Extension of Time in Reexamination	Control No.: 95/000,588 & 95/001,483 & 95/001,500

MAILED

MAY 11 2011

CENTRAL REEXAMINATION UNIT

1. THIS IS A DECISION ON THE PETITION FILED 04 May 2011.

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

   The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS

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

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

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

5. CONCLUSION

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

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

In support of a factual accounting of reasonably diligent behavior of what action the patent owner has taken to date to provide a response.

In consideration of providing the patent owner with a fair opportunity to present an argument against any attack on the patent as balanced with the statutory mandate of conducting reexamination proceedings with special dispatch. This is the first request for extension of time in this proceeding. While the petition speaks to the considerations of the length and complexity of the Office action and speed at which Office action was prepared. The petitioner also noted other proceedings for which reexamination was granted It is agreed that patent owner needs to be given opportunity to complete all aspects of investigation prior to responding to the first Office action on the merits in a reexamination proceeding. This is why, absent litigation stayed for reexamination all patent owners are given a response period of two months for preparation of a response. Yet it is Patent owner who must exercise diligence in responding to an outstanding office action. The requirement for reasonably diligent behavior by patent owner includes a reasonable expectation of resource management. Resource management takes into consideration other proceedings before the Office. The petition identifying other concurrent proceedings is noted but is not germane to the issues under consideration as to "sufficient cause" for granting an extension of time. Additionally, the speed at which the Office action was prepared is required to meet the requirements of "special dispatch." All of that said, the length and complexity of the Office action does warrant consideration.

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

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,500	12/03/2010	7394432	3008.007REX2	7084

26111 7590 03/17/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/17/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BAKER BOTTS L.L.P.
PATENT DEPARTMENT
98 SAN JACINTO BLVD., SUITE 1500
AUSTIN, TX 78701-4039

Date:

MAILED

MAR 17 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001500
PATENT NO. : 7394432
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,588	12/13/2010	7394432	3008.007REX1	3628

26111 7590 03/17/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/17/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
MORRISSON & FOESTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2050

Date:

MAILED

MAR 17 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000588
PATENT NO. : 7394432
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.
95/001,483	11/11/2010	7,394,432	3008.007REX0	6128

26111 7590 03/17/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/17/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

MAR 17 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001483
PATENT NO. : 7394432
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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MAR 17 2011

CENTRAL REEXAMINATION UNIT

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

NOVAK DRUCE & QUIGG, LLP (For first *Inter Partes* Requester)
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

MORRISON & FOERSTER LLP (For second *Inter Partes* Requester)
1253 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

BAKER BOTTS L.L.P. (For third *Inter Partes* Requester)
PATENT DEPARTMENT
98 SAN JACINTO BLVD., SUITE 1500
AUSTIN, TX 78701-4039

Inter Partes Reexamination Proceeding
Control No. 95/001,483
Filed: November 11, 2010
For: U.S. Patent No. 7,394,432

Inter Partes Reexamination Proceeding
Control No. 95/000,588
Filed: December 13, 2010
For: U.S. Patent No. 7,394,432

Inter Partes Reexamination Proceeding
Control No. 95/001,500
Filed: December 3, 2010
For: U.S. Patent No. 7,394,432

DECISION,
SUA SPONTE,
TO MERGE
REEXAMINATION
PROCEEDINGS

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

REVIEW OF RELEVANT FACTS

1. On July 1, 2008, the Office issued U.S. Patent No. 7,394,432 (the '432 patent) to Carlos Puente Baliarda *et al.* with 6 claims.

2. On November 11, 2010, a first request for *inter partes* reexamination of claims 1-3 and 6 of the '432 patent, assigned control No. 95/001,483 ("the '1483 proceeding"), was filed by a third party requester on behalf of real party in interest Samsung Electronics Co., Ltd. ("the '1483 requester").

3. On November 12, 2010, a second request for *inter partes* reexamination of claims 1-3 and 6 of the '432 patent, assigned control No. 95/000,588 ("the '588 proceeding"), was initially deposited by a third party requester real party in interest Kyocera Communications, Inc. ("the '588 requester"), and a corrected request was filed on December 13, 2010.

4. On December 3, 2010, a third request for *inter partes* reexamination of claims 1-3 and 6 of the '432 patent, assigned control No. 95/001,500 ("the '1500 proceeding"), was filed by a third party requester on behalf of real party in interest HTC Corp. and HTC America, Inc. ("the ' 1500 requester").

5. On December 14, 2010, *inter partes* reexamination was ordered on claims 1-3 and 6 of the '432 patent in the '1483 proceeding.

6. On January 20, 2011, two orders for *inter partes* reexamination of claims 1-3 and 6 of the '432 patent were issued, for the '588 and '1500 proceedings, respectively.

7. To date, no Office action has issued in any of the three *inter partes* reexamination proceedings ordered for the '432 patent.

DECISION

I. MERGER OF PROCEEDINGS

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

The 95/000,588, 95/001,483 and 95/001,500 *inter partes* proceedings <u>are merged</u>. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

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

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

Upon merger of proceedings all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2).[1] First, an *inter partes* requester's right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requester's right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requesters' comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

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

2. Appeal Rights:

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

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

---

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

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

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

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

C. Papers mailed/filed:

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

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

by Mail to: Attn: Mail Stop "*Inter Partes* Reexam"
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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

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

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

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

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

D. Amendments:

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

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

E. Fees:

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

F. Citation of Patents and Printed Publications:

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

G. Appeal Procedure Reminders for *Inter Partes* Reexamination

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

rejection *that was previously proposed by that third party requester* that the third party requester intends to contest. (37 CFR 41.61) The appellant's brief shall present a concise statement of each issue. Further, no new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. (37 CFR 41.67(c)(1)(vi))

CONCLUSION

1. *Inter partes* Reexamination Control Nos. 95/000,588, 95/001,483 and 95/001,500 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above in Part III of this decision.

2. Any questions concerning this communication should be directed to Susy Tsang-Foster, Legal Advisor, at 571-272-7711.

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

March 17, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAILED

SEP 20 2011

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/001,483
Filed: November 11, 2010
For: U.S. Patent No. 7,394,432

Inter Partes Reexamination Proceeding
Control No. 95/001,500
Filed: December 3, 2010
For: U.S. Patent No. 7,394,432

Inter Partes Reexamination Proceeding
Control No. 95/000,588
Filed: December 13, 2010
For: U.S. Patent No. 7,394,432

DECISION GRANTING PETITIONS

This is a decision on the following petitions:

1. Patent owner paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on July 7, 2011.

2. The '1483 requester paper entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)," filed on August 8, 2011.

Both petitions are before the Office of Patent Legal Administration for consideration.

Both petitions under 37 CFR 1.183 are granted for the reasons set forth herein.

BACKGROUND

1. On July 1, 2008, United States Patent No. 7,394,432 (the '432 patent) issued to Baliarda et al.

2. On November 11, 2010, a first request for *inter partes* reexamination of the '432 patent was filed by a third party requester (the '1483 requester), which request was assigned Reexamination Control No. 95/001,483 (the '1483 proceeding).

3. On November 12, 2010, a second request for *inter partes* reexamination of the '432 patent, assigned Reexamination Control No. 95/000,588 (the '0588 proceeding), was initially deposited by a third party requester (the '0588 requester), and a corrected request was filed on December 13, 2010.

4. On December 3, 2010, a third request for *inter partes* reexamination of the '432 patent was filed by a third party requester (the '1500 requester), which request was assigned Reexamination Control No. 95/001,500 (the '1500 proceeding).

5. On December 14, 2010, the Office ordered reexamination in the '1483 proceeding.

6. On January 20, 2011, the Office ordered reexamination in the '0588 and '1500 proceedings.

7. On March 17, 2011, the Office issued a decision merging, *sua sponte*, the '1483, '1500 and '0588 proceedings (the merged proceeding).

8. On April 7, 2011, the Office issued a non-final action in the merged proceeding.

9. On July 7, 2011, the patent owner filed a response in the merged proceeding, concurrently with the instant petition entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION" (patent owner petition under 37 CFR 1.183).[1]

10. On August 8, 2011, the '1483 requester filed comments, concurrently with the instant petition entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(A)" ('1483 requestor petition under 37 CFR 1.183).

[1] On May 11, 2011, the Office mailed a decision granting patent owner's May 4, 2011 request for extension of time, extending the time period for patent owner's response by 1 month to July 7, 2011.

DECISION

I. 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(b) provides:

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

II. Petitions Under 37 CFR 1.183

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological** facts, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide

a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count

A. Patent Owner Petition Under 37 CFR 1.183

On July 7, 2011, patent owner filed the instant petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its July 7, 2011 response submission. In support of its request for waiver of the rule, patent owner "asserts that justice would be served by granting waiver of the 50-page limit, because the full length of the Response is needed to fully and adequately respond to the Office Action."[2] Further, patent owner asserts:

> This reexamination proceeding represents the merger of three *Inter Partes* reexaminations. Thus, the Office Action is based on the combination of three *Inter Partes* reexamination requests and grants. Specifically, the Office Action includes 20 separate grounds of rejection over 13 separate references. . . . While the pending Office action constitutes only 13 pages, it incorporates by reference over 500 pages of argument and detailed claim charts set forth by the three third party requesters in their requests for reexamination. It would be unjust to hold the Patent Owner to only 50 pages to respond to what is essentially three Office Actions, particularly given the size and complexity of the three *Inter Partes* reexamination requests upon which they are based."[3]

In addition to stating that the response satisfies the formatting requirements for a grantable petition under 37 CFR 1.183, patent owner asserts that it has "made a good faith effort to comply with the 50-page limit, making efforts to economize, avoid extraneous material and information already of record, and present arguments efficiently . . . . Despite these efforts, the argument portion of the Response exceeds the 50-page limit."[4]

Patent owner's July 7, 2011 response submission includes: (1) a remarks portion, (2) an 11-page declaration entitled "Declaration of Dr. Carles Puente Under 37 C.F.R. § 1.132", (3) a 15-page declaration entitled "Declaration of Dr. Carles Puente Under 37 C.F.R. § 1.132 Relating to Fractal and Multilevel Antennas", (4) a 9-page declaration entitled "Declaration of Drs. Carles Puente, Carmen Borja, Jaume Anguera, and Jordi Soler Under 37 C.F.R. § 1.132", (5) a 9-page declaration entitled "Declaration of Ruben Bonet Under 37 C.F.R. § 1.132", and (6) a 36-page declaration entitled "Declaration of Dr. Raj Mittra Under 37 C.F.R. § 1.132" (the Mittra declaration). In view of the guidance set forth herein, portions of the 36-page Mittra declaration are deemed to include an extension of arguments of counsel. Thus, the Mittra declaration is subject to the 50-page length requirement, in addition to 96 pages of the remarks portion[5] such

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[2] *See* patent owner petition at page 2.
[3] *See id.* at pages 2-3.
[4] *See id.*
[5] The cover page is excluded from the page count, as is the listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count.

that patent owner's July 7, 2011 response submission exceeds the regulatory page limit by up to 82 pages.

Based on the individual facts and circumstances of this case such as, for example, the size of the April 7, 2011 Office action, including the incorporation by reference of pages from multiple requests for reexamination in the merged proceeding,[6] it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that patent owner's response submission exceeds 50 pages. Accordingly, patent owner's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's July 7, 2011 response submission to exceed the regulatory page limit by up to 82 pages. This waiver makes patent owner's July 7, 2011 response submission page-length compliant.

B. The '1483 Requester's Petition Under 37 CFR 1.183

On August 8, 2011, the '1483 requester filed the instant petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its August 8, 2011 comments submission. The '1483 requester asserts that the August 8, 2011 comments submission includes "70 pages of double spaced 12 pt font arguments and a 11 page declaration from Dr. Balanis under 37 C.F.R. § 1.132."[7] The '1483 requester asserts, however, that "[i]f the Office agrees with [patent owner's] interpretation of MPEP § 2667(I)(A)(2), then Samsung's Comments are only 70 pages as Dr. Balanis's declaration discusses how one of ordinary skill in the art would understand the disclosure of the prior art at issue" such that no waiver would be needed.[8]

In support of its request for waiver of the rule, the '1483 requester asserts:

> Samsung has attempted to respond in as little a number of pages as possible but was unable to do so within the 50 page limit. The additional pages requested in this petition are necessary to provide a reply the all of the issues raised by the Patent Owner's 176 page response.
>
> Importantly, this waiver would not go beyond the 1:1 ratio proscribed [sic] for Patent Owner and Requester responses to Office Actions recited in 37 C.F.R. §

[6] *See* April 7, 2011 Office action which, on its face, spans only 11 pages in length but relies heavily on incorporation by reference of more than 500 pages from multiple requests for *inter partes* reexamination in the merged proceeding.

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

[8] *Id.* at page 4. The '1483 requester is cautioned that statements submitted in opposition to patent owner's petition under 37 CFR 1.183 are improper and may result in the requester's petition paper being returned and not considered, as set forth in 37 CFR 1.939(a). For example, on page 3 of the third party requester petition under 37 CFR 1.183, the '1483 requester presents arguments against patent owner's position set forth in patent owner's petition under 37 CFR 1.183. Pursuant to MPEP 2667(I)(B)(4), a requester does not have a statutory right to challenge this discretionary procedural process (*i.e.*, waiver of the regulatory page limit) in the reexamination proceeding. Pursuant to 35 U.S.C. § 314(b)(2), the third party requester in an ordered *inter partes* reexamination proceeding has a statutory right to once file written comments to a patent owner's response to an Office action on the merits. Patent owner's petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) for patent owner's response submission, however, is not a "response" to an Office action on the merits. Thus, in this instance, 35 U.S.C. § 314(b)(2) does not provide any right for the third party requester to file comments on a patent owner's petition under 37 CFR 1.183 for suspension of the rules. Accordingly, any future petition that contains such arguments will be treated as an improper opposition paper and, as such, will be returned by marking the paper "closed" and "not public" in the IFW for the proceeding and will not be considered. Thus, any reply that exceeds the regulatory page limit which accompanies such petition would be found not page-length compliant.

> 1.943(b). In fact, the Requester is asking for significantly fewer total pages that the Patent Owner has submitted (176 total pages for the Patent Owner while Requester is only asking for a total of 81 pages). Therefore in the interest of justice, the Office should grant this petition so that the Requester is able to provide the Office with a rebuttal of all the arguments raised by the Patent Owner.[9]

The '1483 requester's August 8, 2011 comments submission includes: (1) a remarks portion and (2) an 11-page declaration entitled "DECLARATION OF DR. CONSTANTINE A. BALANIS" (the Balanis declaration), and (3) additional reference materials. In view of the guidance set forth herein, portions of the 11-page Balanis declaration are deemed to include an extension of arguments of counsel. Thus, the 11-page Balanis declaration is subject to the 50-page length requirement, in addition to 70 pages of the remarks portion[10] such that the '1483 requester's August 8, 2011 comments submission exceeds the regulatory page limit by up to 31 pages.

Based on the specific facts set forth in the '1483 requester's petition under 37 CFR 1.183, the '1483 requester's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a comments submission in compliance with the 50-page limit and submitting the resulting comments submission (which is in excess of 50 pages), and the individual facts and circumstances of this case, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance to the extent that the '1483 requester's August 8, 2011 comments submission exceeds 50 pages. Accordingly, '1483 requestor's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting '1483 requester's comments submission to exceed the page limit by 31 pages. This waiver makes the '1483 requester's August 8, 2011 comments submission page-length compliant.

III. Time Period for Submission of the '1500 and '0588 Requesters' Comments

The '1500 and '0588 requesters have **30 days from the mailing date of this decision**, granting patent owner's petition under 37 CFR 1.183 and making patent owner's July 7, 2011 response submission page-length compliant, **to file a comments paper pursuant to 37 CFR 1.947**. It is noted that any petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) deemed necessary should accompany the comments submission. Further, to obtain a waiver of the 50-page length requirement of 37 CFR 1.943(b), any grantable petition under 37 CFR 1.183 must be accompanied by a requester comments submission that:

1) is one-and-a-half or double-spaced;[11]
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

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[9] *Id.* at page 2. It is noted, however, as set forth in section I(A) above, patent owner's July 7, 2011 response submission has been determined to include up to 132 pages that count toward the regulatory page limit.
[10] The cover page is excluded from the page count, as is the table of contents pages.
[11] Claim charts applying the art to the claims are permitted to be single-spaced so long as the charts have sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.

5) has sufficient clarity and contrast to permit direct reproduction, and electronic capture by digital imaging and optical character recognition.

See, generally, 37 CFR 1.943(a) and 37 CFR 1.52. Adherence to such formatting guidelines enables the Office to more accurately and uniformly determine the number of pages of a requester comments submission that the Office must review, analyze, and address to the extent needed. Attached reference materials, such as prior art references, are not subject to these formatting guidelines, as such papers are expressly excluded from the regulatory page limit count under 37 CFR 1.943(b).

CONCLUSION

1. Patent owner's July 7, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's response submission to exceed the regulatory page limit by up to 82 pages. This waiver makes patent owner's July 7, 2011 response submission page-length compliant.

2. The '1483 requester's August 8, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting the '1483 requester's comments submission to exceed the regulatory page limit by up to 31 pages. This waiver makes '1483 requester's August 8, 2011 comments submission page-length compliant.

3. The '1500 and '0588 requesters have 30 days from the mailing date of this decision, granting patent owner's petition under 37 CFR 1.183 and making patent owner's July 7, 2011 response submission page-length compliant, to file a comments paper pursuant to 37 CFR 1.947.

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

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

09-19-2011

United States Patent and Trademark Office

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Inter Partes Reexamination Proceeding
Control No. 95/000,588
Filed: December 13, 2010
For: U.S. Patent No.: 7,394,432

Inter Partes Reexamination Proceeding
Control No. 95/001,500
Filed: December 03, 2010
For: U.S. Patent No. 7,394,432

Inter Partes Reexamination Proceeding
Control No: 95/001,483
Filed: November 11, 2010
For: U.S. Patent No. 7,394,432

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

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

Patent owner's petition to terminate filed on September 16, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/001,500, filed on September 16, 2011, is **granted**.

Inter partes reexamination proceeding control number 95/001,500 is hereby **severed** from the merged proceeding of *inter partes* reexamination control numbers 95/001,500, 95/001,483 and 95/000,588.

Inter partes reexamination proceeding 95/001,500, filed on September 16, 2011, is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/001,483 and 95/000,588 **will continue** in the manner set forth in this decision.[1]

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/001,500 (the '1500 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

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

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

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

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,394,432 (the '432 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd.et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner submits a copy of a consent judgment, entered by the district court on September 15, 2011, in which the district court stated that ". . . HTC [the defendant/requester of the '1500 proceeding] has not sustained its burden of proving the invalidity of any of the above listed claims of the Patents-in-Suit" and that "[t]his Consent Judgment constitutes, for purposes of 35 U.S.C.

[1] This petition does not address the petition under 37 CFR 1.182 to terminate the '588 proceeding or the petition to expunge information submitted under MPEP § 724.02, both of which were filed on September 30, 2011. These petitions will be addressed by a separate decision.

§ 317(b), a final decision entered against HTC in a civil action arising in whole or in part under section 1338 of title 28". The "above listed claims" of one of the patents in suit, the '432 patent, which is the patent under reexamination in the '1500 proceeding, are listed in the consent judgment as claims 1-3 and 6, which are identical to the claims that were requested to be reexamined by HTC in the '1500 proceeding, and that are under reexamination in the merged proceeding. The court also stated, in the September 15, 2011 consent judgment, that "[a]ll of Fractus' claims against HTC are dismissed with prejudice. All of HTC's defenses, claims, and counterclaims of invalidity and unenforceability of each and every claim of the Patents-in-Suit [including the '432 patent] are dismissed with prejudice", and that "[t]he parties expressly waive their rights to appeal". Thus, the patent owner has provided sufficient evidence that (1) the requester HTC was a party to the litigation, (2) the district court's decision was final, and (3) the court determined that the requester/defendant HTC had not sustained its burden of proving the invalidity of the claims in suit, which are identical to the claims requested to be reexamined by requester HTC, and which are under reexamination in the merged proceeding. For these reasons, the above-described elements 1-3 have been shown to be satisfied.

Regarding element 4, the court also stated, in the September 15, 2011 consent judgment, that "[t]he prior art raised by [defendant/requester] HTC, Samsung, and Kyocera in the Reexaminations [listed by the court, and including the '1500 *inter partes* reexamination proceeding] was raised by HTC, or could have been raised by HTC, in this suit". Thus, element 4 has been shown to be satisfied.

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

Inter partes reexamination proceeding control no. 95/001,500 (the '1500 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/001,500 , 95/001,483 and 95/000,588.

Inter partes reexamination proceeding control no. 95/001,500 (the '1500 proceeding) is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/001,483 and 95/000,588 **will continue**.[2] Any rejection proposed by HTC (the requester of the '1500 proceeding) which has been adopted and applied by the examiner in an Office action in the merged proceeding, will remain in the merged proceeding. An examiner "adopts" a proposed rejection as his own. Any rejection proposed by the requester HTC, which was adopted by the examiner, will remain in the merged proceeding as a rejection raised by the examiner, unless the examiner, during the course of the reexamination, makes a determination based on the merits that the rejection should be withdrawn. The examiner's determination, in the merged proceeding, not to adopt any rejection that was proposed solely by the requester HTC, may not be appealed or otherwise addressed by the remaining requesters of the merged proceeding. The examiner's determination, in the merged proceeding, not to adopt any rejection proposed by HTC that was

[2] As pointed out above, this decision does not address the September 30, 2011 petition to terminate the '588 proceeding which is presently pending. This petition will be addressed by a separate decision.

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

All papers filed by the patent owner and by the remaining requesters of the merged proceeding must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for *inter partes* reexamination proceeding control nos. 95/001,483 and 95/000,588, for entry into the file of each proceeding. The conduct of the merged proceeding of 95/001,483 and 95/000,588 will otherwise remain, in general, as outlined by the decision, mailed on March 17, 2011, entitled "Decision, *Sua Sponte*, Merging *Inter Partes* Proceedings".

The '1500 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for conclusion of that proceeding. The CRU will mail the present decision, and process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The file will be assigned an 822 status. A copy of the PALM "Application Number Information" screen and the "Contents" screen will be printed, the printed copy will be annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy will then be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

CONCLUSION

- Patent owner's September 16, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/001,500 is **granted**.
- *Inter partes* reexamination proceeding control no. 95/001,500 (the '1500 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/001,500, 95/001,483 and 95/000,588.
- The merged proceeding of *inter partes* reexamination proceeding control numbers 95/001,483 and 95/000,588 **will continue** in the manner set forth in this decision.
- The prosecution of the '1500 *inter partes* reexamination proceeding is hereby **terminated** and will be concluded.
- The '1500 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for further processing to conclude the '1500 proceeding, as set forth in this decision.

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

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

Kenneth M. Schor

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

Kenpet9

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.
95/001,501	12/03/2010	7,123,208	079957.0105	7104

26111 7590 06/01/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/01/2011

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.
95/000,591	12/14/2010	7,123,208	3008.008REX1	2384

26111 7590 06/01/2011

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,389	07/01/2010	7123208	3008.008REX0	8373

26111 7590 06/01/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP (NDQ REEXAMINATION GROUP)
1000 LOUSIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED
JUL 01 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001389
PATENT NO. : 7123208
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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BAKER BOTTS L.L.P.
PATENT DEPARTMENT
98 SAN JACINTO BLVD. SUITE 1500
AUSTIN,TX 78701-4078

Date:

MAILED
JUL 07 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001501
PATENT NO. : 7123208
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
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SAN DIEGO, CA 92130-2040

Date:

MAILED
JUL 01 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95000591
PATENT NO. : 7123208
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

MAILED
JUL 01 2011
CENTRAL REEXAMINATION UNIT

NOVAK, DRUCE & QUIGG, LLP (For the '1389 requester)
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1000 LOUISIANA STREET, 53RD FLOOR
HOUSTON, TX 77002

BAKER BOTTS, LLP (For the '1501 requester)
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AUSTIN, TX 78701

MORRISON & FOERSTER LLP (For the '591 requester)
12531 HIGH BLUFF DRIVE
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SAN DIEGO, CA 92130

In re Puente Baliarda *et al.*
Inter Partes Reexamination
Control No. 95/001,389
Filed: July 1, 2010
For: U.S. Patent No. 7,123,208

In re Puente Baliarda *et al.*
Inter Partes Reexamination
Control No. 95/001,501
Filed: December 3, 2010
For: U.S. Patent No. 7,123,208

In re Puente Baliarda *et al.*
Inter Partes Reexamination
Control No. 95/000,591
Filed: December 14, 2010
For: U.S. Patent No. 7,123,208

DECISION,
SUA SPONTE,
TO MERGE
REEXAMINATION
PROCEEDINGS

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

REVIEW OF FACTS

1. On October 17, 2006 the Office issued U.S. Patent No. 7,123,208 (the '208 patent) to Carles Puente Baliarda *et al.* with 117 claims.

2. On July 1, 2010, a request for *inter partes* reexamination of claims 1, 5, 7, 10-12, 14-15, 18, 21, 24-26, 28-29, 33, 37, 40, 43-48, 54, 57-59 and 61 of the '208 patent was filed by a third party requester, and assigned control No. 95/001,389 ("the '1389 proceeding"). The request identified Samsung Electronics Co., Ltd. (hereinafter "the '1389 requester") as the real party in interest.

3. On August 12, 2010, *inter partes* reexamination was ordered on claims 1, 5, 7, 10-12, 14-15, 18, 21, 24-26, 28-29, 33, 37, 40, 43-48, 54, 57-59 and 61 of the '208 patent in the '1389 proceeding. An Office action rejecting all claims subject to reexamination accompanied the order.

4. On November 12, 2010, patent owner timely filed a response to the August 12, 2010 Office action in the '1389 proceeding.[1]

5. On December 3, 2010, a second request for *inter partes* reexamination of claims 1, 5, 7, 10-12, 14-15, 18, 21, 24-26, 28-29, 33, 37, 40, 43-48, 54, 57-59 and 61 of the '208 patent was filed by a third party requester, and assigned control No. 95/001,501 ("the '1501 proceeding"). The request identified HTC Corp. and HTC America, Inc. (hereinafter "the '1501 requester") as the real party in interest.

6. On December 13, 2010, third party requester timely filed responsive comments in accordance with 37 CFR 1.947 in the '1389 proceeding.

7. On December 14, 2010, a third request for *inter partes* reexamination of claims 1, 5, 7, 10-12, 14-15, 21, 24-26, 28-29, 33, 37, 40, 43-45, 48, 54, 57-59 and 61 of the '208 patent was filed by a third party requester, and assigned control No. 95/000,591 ("the '591 proceeding"). The request identified Kyocera Communications, Inc. (hereinafter "the '591 requester") as the real party in interest.

8. On January 25, 2011, *inter partes* reexamination was ordered on claims 1, 5, 7, 10-12, 14-15, 18, 21, 24-26, 28-29, 33, 37, 40, 43-48, 54, 57-59 and 61 of the '208 patent in the '1501 proceeding. An Office action was not concurrently issued. The order indicated that an Office action would issue in due course.

9. On January 31, 2011, *inter partes* reexamination was ordered on claims 1, 5, 7, 10-12, 14-15, 21, 24-26, 28-29, 33, 40, 43-45, 48, 54, 57-59 and 61 of the '208 patent in the

[1] The Office granted patent owner's request for a one month extension of time to file a response.

'591 proceeding. An Office action was not concurrently issued in the proceeding. The order indicated that an Office action would issue in due course.

10. To date, an Office action has issued in the '1389 *inter partes* reexamination proceeding and no Office action has issued in the '591 and '1501 *inter partes* reexamination proceedings for the '208 patent.

DECISION

I. MERGER OF PROCEEDINGS

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

The 95/001,389, 95/001,501 and 95/000,591 *inter partes* proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

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

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

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

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

right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester. Requester comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

2. Appeal Rights:

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

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

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

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

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

It is to be noted that, because the '591 *inter partes* third party requester did not propose any rejections of claims 18, 37, and 46-47 in their request for reexamination, the '591 requester has no appeal rights as to those claims as they appear in the '208 patent.

C. Papers mailed/filed:

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

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

by Mail to: Attn: Mail Stop "*Inter Partes* Reexam"
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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

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

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

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

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

D. Amendments:

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

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

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

E. Fees:

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

F. Citation of Patents and Printed Publications:

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

G. Appeal Procedure Reminders for *Inter Partes* Reexamination

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

CONCLUSION

1. *Inter partes* Reexamination Control Nos. 95/001,389, 95/001,501 and 95/000,591 are <u>merged into a single proceeding</u>, to be conducted in accordance with the procedure set forth above in Part III of this decision.

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

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

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26111 7590 06/21/2011

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1100 NEW YORK AVENUE, N.W.
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1000 LOUSIANA STREET
FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date: MAILED
12 2004
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

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AUSTIN,TX 78701-4078

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001501
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TECHNOLOGY CENTER : 3999
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Date: MAILED

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1100 NEW YORK AVENUE, N.W.
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1000 LOUISIANA STREET,
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MAILED
JUN 21 2011
CENTRAL REEXAMINATION

BAKER BOTTS LLP (For 95/001,501 Third Party Requester)
PATENT DEPARTMENT
98 SAN JACINTO BLVD., SUITE 1500
AUSTIN, TX 78701-4078

MORRISON & FOERSTER LLP (For 95/000,591 Third Party Requester)
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

Inter Partes Reexamination Proceeding Control No. 95/001,389 Filed: July 1, 2010 For: U.S. Patent No. 7,123,208	
Inter Partes Reexamination Proceeding Control No. 95/001,501 Filed: December 3, 2010 For: U.S. Patent No. 7,123,208	**DECISION ON PETITION UNDER 37 CFR 1.183**
Inter Partes Reexamination Proceeding Control No. 95/000,591 Filed: December 14, 2010 For: U.S. Patent No. 7,123,208	

This is a decision on the patent owner petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on April 11, 2011 in reexamination proceeding control no. 95/001,389.

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

The petition under 37 CFR 1.183 is **dismissed as unnecessary** for the reasons set forth below.

BACKGROUND

1. On October 17, 2006, U.S. patent number 7,123,208 (the '208 patent) issued to Baliarda *et al.*

2. On July 1, 2010, a third party requester filed a request for *inter partes* reexamination of the '208 patent, which request was assigned Reexamination Control No. 95/001,389 (the '1389 proceeding).

3. On August 12, 2010, the Office issued an order granting *inter partes* reexamination in the '1389 proceeding. Concurrently with the order, the Office issued a non-final Office action.

4. On November 12, 2010, patent owner filed a response to the August 12, 2010 Office action.[1]

5. On March 7, 2011, third party requester filed corrected comments after the August 12, 2010 Office action and patent owner's November 12, 2010 response.[2]

6. On March 25, 2011, the Office mailed a "NOTICE OF DEFECTIVE PAPER IN *INTER PARTES* REEXAMINATION" (the notice of defective paper), finding patent owner's November 12, 2010 response defective and setting a time period of 15 days from the mailing date of the notice of defective paper for patent owner to file a corrected response submission.

7. On April 11, 2011, patent owner filed the instant "PETITION UNDER 37 C.F.R. § 1.183 FOR LIMITED WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION" (patent owner petition under 37 CFR 1.183), concurrently with a corrected response to the August 12, 2010 Office action (patent owner corrected response submission).

8. On April 29, 2011, third party requester filed comments after the August 12, 2010 Office action and patent owner's April 11, 2011 corrected response submission (requester comments submission).

9. On June 1, 2011, the Office issued a "DECISION, *SUA SPONTE*, MERGING *INTER PARTES* PROCEEDINGS," merging the '1389 proceeding with *inter partes* reexamination proceeding

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[1] On September 29, 2010, the Office mailed a decision granting patent owner's September 27, 2010 petition for a one-month extension of time.

[2] On February 24, 2011, the Office mailed a decision granting patent owner's January 31, 2011 petition under 37 CFR 1.181 and expunging the '1389 requester's December 13, 2010 comments submission and giving the '1389 requester 15 days from the mailing date of that decision to file corrected comments.

control no. 95/001,501 (the '1501 proceeding) and with *inter partes* reexamination proceeding control no. 95/000,591 (the '591 proceeding).

DECISION

I. Relevant Statutes, Regulations and Procedures

35 U.S.C. 314(b)(2) provides:

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

37 CFR 1.183 provides:

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

37 CFR 1.943(b) provides:

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

II. Analysis

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts,** or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see*, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

III. Patent owner petition of April 11, 2011

On April 11, 2011, patent owner filed, in the '1389 proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b), to permit entry of its concurrently-filed corrected response submission. Patent owner asserts that the argument portion of the April 11, 2011 corrected response submission is 22 pages long, thereby complying with the 50-page limit of 37 CFR 1.943(b).[3] Patent owner states that "a number of 132 declarations are filed herewith" but asserts that "these declarations are drawn to fact, not argument, and thus do not count towards the 50-page limit."[4] Nonetheless, patent owner requests waiver of the 50-page limit "for the combination of the Corrected Response and any of the 132 declarations (or portion(s) thereof) considered to include argument as opposed to facts, to the extent such combination exceeds the 50-page limit of 37 C.F.R. § 1.943(b)."[5]

In support of its request for waiver of the rule, patent owner asserts that none of the declarations filed with the April 11, 2011 corrected response submission includes argument or opinions that would be counted towards the 50-page limit.[6] Additionally, patent owner asserts that "the full length of the Corrected Response and the 132 declarations are needed to fully and adequately

[3] Patent owner petition under 37 CFR 1.183 at page 2.
[4] Id. (stating that the "Declaration of Dr. Carles Puente Under 37 C.F.R. § 1.132 (10 pages)," the "Declaration of Drs. Carles Puente, Carmen Borja, Jaume Anguere, and Jordi Soler Under 37 C.F.R. § 1.132 (9 pages)," the "Declaration of Rubén Bonet Under 37 C.F.R. § 1.132 (7 pages)," and the "Declaration of Dr. Yahya Rahmat-Samii Under 37 C.F.R. § 1.132 (9 pages)" are filed herewith, and that "Dr. Rahmat-Samii attached to his declaration the Declaration of Dr. Dwight L. Jaggard solely for Dr. Jaggard's reference to what would constitute a person of ordinary skill.")
[5] Id.
[6] Id. at pages 2-4.

respond to the Office Action," and that although the Office action "constitutes only 7 pages, it incorporates by reference over 170 pages of argument and detailed claim charts set forth by the third party requester in its request for reexamination."[7] Patent owner further asserts that it has attempted to draft a corrected response in compliance with the 50-page limit, as well as in compliance with the formatting requirements set forth in the March 25, 2011 notice of defective paper, by taking measures to "economize, avoid extraneous material and information already of record, and present arguments efficiently."[8] As evidence of the reformatting and further editing made to reduce page length, patent owner submitted with the petition under 37 CFR 1.183 a redlined document comparing patent owner's November 12, 2010 original response submission to patent owner's April 11, 2011 corrected response submission. This redlined document has been expunged from the record of the '1389 proceeding by marking the paper "closed" and "not public" in the image file wrapper (IFW) as it contains the full content of the paper that was deemed defective by the March 25, 2011 notice of defective paper.

In this instance, patent owner's April 11, 2011 corrected response submission is page-length compliant as the total number of pages that count toward the regulatory page limit does not exceed 50 pages.[9] Thus, no waiver of 37 CFR 1.943(b) is required for entry of patent owner's April 11, 2011 corrected response submission. Accordingly, patent owner's request for waiver of the 50-page limit of 37 CFR 1.943(b) is dismissed as unnecessary.

CONCLUSION

1. Patent owner's April 11, 2011 petition under 37 CFR 1.183 for waiver of the 50-page limit of 37 CFR 1.943(b) is **dismissed as unnecessary**.

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

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

06-17-2011

[7] Id. at page 5.
[8] Id.
[9] 21 pages of the remarks portion of patent owner's April 11, 2011 corrected response submission count toward the page limit (the cover page is excluded from the page count, as is the 24-page listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count). Further, based on the guidance set forth in section II above, the portions of the 9-page "Declaration of Dr. Yahya Rahmat-Samii Under 37 C.F.R. § 1.132" that are subject to the regulatory page limit count do not cause the total number of pages of patent owner's April 11, 2011 corrected response submission to exceed the 50-page limit. It is noted that the pages of the "Declaration of Dr. Carles Puente Under 37 C.F.R. § 1.132," the "Declaration of Drs. Carles Puente, Carmen Borja, Jaume Anguere, and Jordi Soler Under 37 C.F.R. § 1.132," and the "Declaration of Rubén Bonet Under 37 C.F.R. § 1.132" do not count toward the regulatory page limit. Additionally, in this instance, the pages of the copies of the court documents that were filed as "Exhibit 5B" and "Exhibit 6" also do not count toward the regulatory page limit.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,501	12/03/2010	7,123,208	3008.008REX2	7104

EXAMINER

ART UNIT	PAPER NUMBER

26111 7590 08/03/2011
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

DATE MAILED: 08/03/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BAKER BOTTS L.L.P.
PATENT DEPARTMENT
98 SAN JACINTO BLVD. SUITE 1500
AUSTIN,TX 78701-4078

Date:

MAILED
AUG 03 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001501
PATENT NO. : 7123208
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

Decision on Petition for Extension of Time in Reexamination	Control No.: 95/001,389 & 95/001,501 & 95/001,591

1. THIS IS A DECISION ON THE PETITION FILED 28 July 2011.

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

   The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS
   Patent owner requests that the period for responding to the Office action dated 01 July 2011 which sets a two (2) month period for filing a response to the Office action, be extended by two (2) months.

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

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

5. CONCLUSION

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

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

In consideration of providing the patent owner with a fair opportunity to present an argument against any attack on the patent as balanced with the statutory mandate of conducting reexamination proceedings with special dispatch that the Office must fully consider the facts presented in any petitions for extension of time. This is the first request for extension of time in this proceeding. While the petition speaks to the considerations of many other proceedings as well as the overall length of the reexaminations if added together before council, concurrent with preparing a response, these are the same considerations of any patent owner in any reexamination proceeding. It is Patent owner who must exercise diligence in responding to the Office action. It is agreed that patent owner needs to be given opportunity to complete all aspects of investigation prior to responding to the Office action in an *inter partes* reexamination proceeding. It is Patent owner who must exercise diligence in responding to Office action. The requirement for reasonably diligent behavior by patent owner includes a reasonable expectation of resource management insofar as expecting a complete Office action on the merits.

It is further noted that the petition raises questions about the need for declatory evidence pursuant to 37 CFR § 1.132. The time needed to gather such evidence does support sufficient cause for a one (1) month extension of time.

The requirement for reasonably diligent behavior by the patent owner includes a reasonable expectation of resource management. Resource management takes into consideration other proceedings before the Office. The petition identifying other concurrent proceedings is noted but is not germane to the issues under consideration as to "sufficient cause" for granting an extension of time.

Per MPEP § 2665 (in-part)

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

On balance there is "sufficient cause" to grant-in-part the petition for extension of time for a period of one (1) month.

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,501	12/03/2010	7,123,208	3008.008REX2	7104

26111 7590 09/28/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/28/2011

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PATENT DEPARTMENT
98 SAN JACINTO BLVD. SUITE 1500
AUSTIN,TX 78701-4078

Date:

MAILED

SEP 2 8 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001501
PATENT NO. : 7123208
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

Decision on Petition for Extension of Time in Reexamination	Control No.: 95/001,501; 95/001,389; 95/000,591

1. THIS IS A DECISION ON THE PETITION FILED September 23, 2011.

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

3. FORMAL MATTERS
   Patent owner requests that the period for responding to the Office action mailed on July 1, 2011, which sets a 2-month period for filing a response thereto, be extended by another 2 months. A first request for a two month extension being granted in part (for one month) on August 3, 2011.

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

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

5. CONCLUSION

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

Eric Keasel
[Signature]

ERIC S. KEASEL
CRU SPE-AU 3992
(Title)

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,501 +95/000591 +95/001389	12/03/2010	7,123,208	3008.008REX2	7104

26111 7590 11/18/2011

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EXAMINER

ART UNIT	PAPER NUMBER

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Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001501 + 95/000591 + 95/001389
PATENT NO. : 7123208
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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AUSTIN, TX 78701-4039

Inter Partes Reexamination Proceeding
Control No. 95/000,591
Filed: December 14, 2010
For: U.S. Patent No. 7,123,208

Inter Partes Reexamination Proceeding
Control No. 95/001,389
Filed: July 1, 2010
For: U.S. Patent No. 7,123,208

Inter Partes Reexamination Proceeding
Control No. 95/001,501
Filed: December 3, 2010
For: U.S. Patent No. 7,123,208

DECISION ON PETITION UNDER 37 CFR 1.183

This is a decision on the patent owner petition paper entitled "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION," filed on October 3, 2011 in reexamination proceeding control nos. 95/000,591, 95/001,389 and 95/001,501.

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

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

RELEVANT BACKGROUND

1. On October 17, 2006, U.S. patent number 7,123,208 (the '208 patent) issued to Puente Baliarda *et al.*

2. Subsequently, three requests for *inter partes* reexamination of the '208 patent, which requests were assigned Reexamination Control Nos. 95/001,389, 95/001,501, and 95/000,591, were instituted by the Office.

3. On June 1, 2011, the Office issued a "DECISION, *SUA SPONTE*, TO MERGE REEXAMINATION PROCEEDINGS," merging the '1389 proceeding with the '1501 and '591 proceedings (the merged proceeding).

4. On July 1, 2011, the Office issued a non-final Office Action in the merged proceeding.

5. On October 3, 2011, patent owner filed a response to the July 1, 2011 Office action in the merged proceeding, concurrently with the instant "PETITION UNDER 37 C.F.R. § 1.183 FOR WAIVER OF 37 C.F.R. § 1.943(b) IN CONNECTION WITH RESPONSE TO OFFICE ACTION IN REEXAMINATION" (patent owner petition under 37 CFR 1.183).[1]

DECISION

I. Relevant Statutes, Regulations and Procedures

35 U.S.C. 314(b)(2) provides:

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

37 CFR 1.183 provides:

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

[1] On August 3 2011, the Office mailed a decision granting a one-month extension of time for patent owner's response to the July 1, 2011 Office Action.

37 CFR 1.943(b) provides:

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

II. Analysis

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a patent owner's response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts,** or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see*, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

III. Patent owner petition of October 3, 2011

On October 3, 2011, patent owner filed, in the merged proceeding, the instant petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b), to permit entry of its concurrently-filed response submission. Patent owner asserts that the argument portion of the October 3, 2011 response submission is 123 pages long, exceeding the 50-page limit of 37 CFR 1.943(b), and requests waiver of the regulatory page limit as to the response submission.[2] Patent owner states that it concurrently filed "a number of 132 declarations" but asserts that the declarations "include only facts and thus does not count towards the 50-page limit."[3] Nonetheless, patent owner also requests waiver of the 50-page limit for "those portions of the 132 Declarations that the PTO holds count towards the 50 page limit..."[4]

In support of its request for waiver of the rule, patent owner asserts that none of the declarations filed with the October 3, 2011 response submission includes argument or opinions that would be counted towards the 50-page limit.[5] Additionally, patent owner asserts that "the full length of the Response is needed to fully and adequately respond to the Office Action," and that although the Office action "constitutes only 35 pages, it incorporates by reference almost 800 pages of argument and detailed claim charts set forth by the three third party requesters in their requests for reexamination."[6] Patent owner further asserts that it has attempted to draft a response in compliance with the 50-page limit by taking measures to "economize, avoid extraneous material and information already of record, and present arguments efficiently."[7]

Based on the specific facts set forth in patent owner's petition under 37 CFR 1.183, patent owner's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft a response in compliance with the 50-page limit and submitting the resulting response (which is in excess of 50 pages),[8] and the individual facts and circumstances of this case (such as the length of the July 1, 2011 Office action),[9] it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. Accordingly, patent owner's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent

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

[3] Id. at page 4 (identifying two declaration(s) of Dr. Carles Puente under 37 C.F.R. § 1.132 (10 pages and 15 pages), a declaration of Drs. Carles Puente, Carmen Borja, Jaume Anguera and Jordi Soler under 37 C.F.R. § 1.132 (9 pages), a declaration of Aurora Andujar under 37 C.F.R. § 1.132 (13 pages), and two declaration(s) of Dr. Raj Mittra under 37 C.F.R. § 1.132 (each 20 pages)).

[4] Id. at page 2.

[5] Id. at pages 4-7.

[6] Id. at page 2-3.

[7] Id. at page 3.

[8] 123 pages of the remarks portion of patent owner's October 3, 2011 response submission count toward the page limit (the cover page and pages of the table of contents are excluded from the page count, as is the 23-page listing of the claims because 37 CFR 1.943(b) expressly excludes appendices of claims from the page limit count). Additionally, at least portions of the 20-page declaration of Dr. Raj Mittra under 37 C.F.R. § 1.132 are deemed to be an extension of the arguments of counsel and count toward the page limit. Thus, up to 143 pages of the patent owner's October 3, 2011 response submission count toward the 50-page limit.

[9] On its face, the substantive portion of the July 1, 2011 Office action spans only approximately 35 pages, but it incorporates by reference numerous pages from the '1389, '1501 and '591 requests for *inter partes* reexamination and comments submissions.

owner's October 3, 2011 response submission to exceed the regulatory page limit by up to 93 pages. This waiver makes patent owner's October 3, 2011 response submission page-length compliant.

ADDITIONAL DISCUSSION

The 95/001,389 third party requester, 95/001,501 third party requester and the 95/000,591 third party requester have 30 days from the date of this decision, granting patent owner's October 3, 2011 petition under 37 CFR 1.183 and entering patent owner's October 3, 2011 response submission, to file a comment paper pursuant to 37 CFR 1.947. MPEP 2666.05(I) provides:

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

CONCLUSION

1. Patent owner's October 3, 2011 petition under 37 CFR 1.183 is **granted** and the 50-page limit of 37 CFR 1.943(b) is waived to the extent of permitting patent owner's October 3, 2011 response submission to exceed the regulatory page limit by up to 93 pages. This waiver makes patent owner's October 3, 2011 response submission page-length compliant.

2. The 95/001,389 third party requester, 95/001,501 third party requester and the 95/000,591 third party requester each has 30 days from the mailing date of this decision, granting patent owner's October 3, 2011 petition under 37 CFR 1.183 and entering patent owner's October 3, 2011 response submission, to file a comment paper pursuant to 37 CFR 1.947.

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

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

11-17-2011

United States Patent and Trademark Office

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DEC 12 2011

CENTRAL REEXAMINATION UNIT

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Inter Partes Reexamination Proceeding
Control No. 95/000,591
Filed: December 14, 2010
For: U.S. Patent No.: 7,123,208

Inter Partes Reexamination Proceeding
Control No. 95/001,501
Filed: December 03, 2010
For: U.S. Patent No. 7,123,208

Inter Partes Reexamination Proceeding
Control No: 95/001,389
Filed: July 01, 2010
For: U.S. Patent No. 7,123,208

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

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

Patent owner's petition to terminate filed on September 16, 2011, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding 95/001,501, filed on September 16, 2011, is **granted**.

Inter partes reexamination proceeding control number 95/001,501 is hereby **severed** from the merged proceeding of *inter partes* reexamination control numbers 95/001,501, 95/000,591 and 95/001,389.

Inter partes reexamination proceeding 95/001,501, filed on September 16, 2011, is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,591 and 95/001,389 **will continue** in the manner set forth in this decision.[1]

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/001,501 (the '1501 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

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

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

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

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,123,208 (the '208 patent), was the subject of a civil action in district court, i.e., *Fractus, S.A. v. Samsung Electronics, Co., Ltd.et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.). The patent owner submits a copy of a consent judgment, entered by the district court on September 15, 2011, in which the district court stated that ". . . HTC [the defendant/requester of the '1501 proceeding] has not sustained its burden of proving the invalidity of any of the above listed claims of the Patents-in-Suit" and that "[t]his Consent Judgment constitutes, for purposes of 35 U.S.C.

[1] This petition does not address the petition under 37 CFR 1.182 to terminate the '591 proceeding or the petition to expunge information submitted under MPEP § 724.02, both of which were filed on September 30, 2011. These petitions will be addressed by a separate decision, which will issue in due course.

§ 317(b), a final decision entered against HTC in a civil action arising in whole or in part under section 1338 of title 28". The "above listed claims" of one of the patents in suit, the '208 patent, which is the patent under reexamination in the '1501 proceeding, are listed in the consent judgment as claims 1, 5, 7, 10-12, 14, 15, 18, 21, 24-26, 28, 29, 33, 37, 40, 43-48, 54, 57-59 and 61, which are identical to the claims that were requested to be reexamined by HTC in the '1501 proceeding, and that are under reexamination in the merged proceeding. The court also stated, in the September 15, 2011 consent judgment, that "[a]ll of Fractus' claims against HTC are dismissed with prejudice. All of HTC's defenses, claims, and counterclaims of invalidity and unenforceability of each and every claim of the Patents-in-Suit [including the '208 patent] are dismissed with prejudice", and that "[t]he parties expressly waive their rights to appeal". Thus, the patent owner has provided sufficient evidence that (1) the requester HTC was a party to the litigation, (2) the district court's decision was final, and (3) the court determined that the requester/defendant HTC had not sustained its burden of proving the invalidity of the claims in suit, which are identical to the claims requested to be reexamined by requester HTC, and which are under reexamination in the merged proceeding. For these reasons, the above-described elements 1-3 have been shown to be satisfied.

Regarding element 4, the court also stated, in the September 15, 2011 consent judgment, that "[t]he prior art raised by [defendant/requester] HTC, Samsung, and Kyocera in the Reexaminations [listed by the court, and including the '1501 *inter partes* reexamination proceeding] was raised by HTC, or could have been raised by HTC, in this suit". Thus, element 4 has been shown to be satisfied.

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

Inter partes reexamination proceeding control no. 95/001,501 (the '1501 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/001,501 , 95/000,591 and 95/001,389.

Inter partes reexamination proceeding control no. 95/001,501 (the '1501 proceeding) is hereby **terminated**.

The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,591 and 95/001,389 **will continue**.[2] Any rejection proposed by HTC (the requester of the '1501 proceeding) which has been adopted and applied by the examiner in an Office action in the merged proceeding, will remain in the merged proceeding. An examiner "adopts" a proposed rejection as his own. Any rejection proposed by the requester HTC, which was adopted by the examiner, will remain in the merged proceeding as a rejection raised by the examiner, unless the examiner, during the course of the reexamination, makes a determination based on the merits that the rejection should be withdrawn. The examiner's determination, in the merged proceeding, not to adopt any rejection that was proposed solely by the requester HTC, may not be appealed or otherwise addressed by the remaining requesters of the merged proceeding. The examiner's determination, in the merged proceeding, not to adopt any rejection proposed by HTC that was

[2] As pointed out above, this decision does not address the September 30, 2011 petition to terminate the '591 proceeding which is presently pending. This petition will be addressed by a separate decision.

also *properly* proposed by one or both of the remaining requesters, may be appealed in the merged proceeding only by the requester who *properly* proposed the rejection.[3] As noted in the June 1, 2011 decision entitled "Decision, *Sua Sponte*, Merging *Inter Partes* Proceedings" (the June 1, 2011 merger decision), because the requester of the '591 proceeding did not propose any rejections of claims 18, 37, and 46-47 in its request for reexamination, the requester of the '591 proceeding has no appeal rights as to those claims as they appear in the '208 patent.

All papers filed by the patent owner and by the remaining requesters of the merged proceeding must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for *inter partes* reexamination proceeding control nos. 95/000,591 and 95/001,389, for entry into the file of each proceeding. The conduct of the merged proceeding of 95/000,591 and 95/001,389 will otherwise remain, in general, as outlined by the June 1, 2011 merger decision.

The '1501 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for conclusion of that proceeding. The CRU will mail the present decision, and process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The file will be assigned an 822 status. A copy of the PALM "Application Number Information" screen and the "Contents" screen will be printed, the printed copy will be annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy will then be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

CONCLUSION

- Patent owner's September 16, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/001,501 is **granted**.
- *Inter partes* reexamination proceeding control no. 95/001,501 (the '1501 proceeding) is hereby **severed** from the merged proceeding of *inter partes* reexamination proceeding control nos. 95/001,501, 95/000,591 and 95/001,389.
- The merged proceeding of *inter partes* reexamination proceeding control numbers 95/000,591 and 95/001,389 **will continue** in the manner set forth in this decision.
- The prosecution of the '1501 *inter partes* reexamination proceeding is hereby **terminated** and will be concluded.
- The '1501 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for further processing to conclude the '1501 proceeding, as set forth in this decision.

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

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

Kenneth M. Schor

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

Kenpet9

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,504	12/09/2010	7,467,218 B2	167162800600	5295

58417 7590 01/12/2012

HEINZ GRETHER PC
G2 Technology Law
P.O. Box 202858
AUSTIN, TX 78720

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/12/2012

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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SUITE 3500
LOS ANGELES, CA 90013-1024

Date:

MAILED

JAN 1 2 2012

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001504
PATENT NO. : 7467218
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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JAN 12 2012

CENTRAL REEXAMINATION UNIT

Heinz Grether PC
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(For Patent Owner)

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(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,504
Filed: December 9, 2010
For: U.S. Patent No. 7,467,218 B2

DECISION
DISMISSING
PETITION

This is a decision on the October 31, 2011 third party requesters' (hereinafter "requester") petition paper entitled "THIRD PARTY REQUESTERS' PETITION PURSUANT TO 37 C.F.R. §1.183 TO WAIVE THE PAGE COUNT LIMIT OF 37 C.F.R. § 1.943(b)."

The petition is before the Office of Patent Legal Administration for decision.

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

DECISION

In the instant petition, the third party requester requests waiver of the page limit requirement of 37 CFR 1.943(b) for its comments submission filed on October 31, 2011.

On January 6, 2012, the Office mailed a Notice of Defective Paper stating that patent owner's 9/30/2011 comments submission filed after the Action Closing Prosecution (ACP) is defective and setting a time period of one (1) month or thirty (30) days, whichever is longer, for the patent owner to file a corrected comments submission.

Pursuant to MPEP § 2667(I)(A)(2), "Any previously submitted third party comments in response to [the] 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."

Since a proper comments submission after the ACP from the patent owner has not been made, the third party requester will have the opportunity to file new comments within 30 days of service of a corrected patent owner comments submission.

Accordingly, the third party requester's October 31, 2011 petition requesting waiver of 37 CFR 1.943(b) for its October 31, 2011 comments submission is moot, and the third party requester's October 31, 2011 petition is dismissed as moot.

CONCLUSION

1. The third party requester's October 31, 2011 petition paper entitled "THIRD PARTY REQUESTERS' PETITION PURSUANT TO 37 C.F.R. §1.183 TO WAIVE THE PAGE COUNT LIMIT OF 37 C.F.R. § 1.943(b)" is dismissed as moot.

2. Telephone inquiries with regard to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

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

01-11-2012

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,505	02/10/2011	7467229	39206/5	7013

EXAMINER

ART UNIT	PAPER NUMBER

25315 7590 06/22/2011
BLACK LOWE & GRAHAM, PLLC
701 FIFTH AVENUE
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SEATTLE, WA 98104

DATE MAILED: 06/22/2011

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Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/001,505*.

PATENT NUMBER *7467229*.

TECHNOLOGY CENTER *CRU*.

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 22 2011

CENTRAL REEXAMINATION UNIT

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In re Biggs, *et al.*	:	
Inter Partes Reexamination Proceeding	:	**DECISION**
Control No. 95/001,505	:	**ON**
Filed: February 10, 2011	:	**PETITION**
For: U.S. Patent No. 7,467,229	:	

This is a decision on *inter partes* third party requester's April 28, 2011 petition paper entitled "PETITION UNDER 37 C.F.R. § 1.182 TO MERGE WITH REEXAMINATION CONTROL NO. 90/010,851" (the petition under 37 CFR 1.182).

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

The petition under 37 CFR 1.182 is held in abeyance, subject to renewal if needed, for the reasons set forth below.

BACKGROUND

1. On December 16, 2008, the Office issued United States Patent Number 7,467,229 (the '229 patent) to Biggs, *et al.*

2. On February 4, 2010, a request for *ex parte* reexamination of claims 1-8 of the '229 patent was filed by a third party requester, Onoffline, Inc. (the *ex parte* requester), which request was assigned Reexamination Control No. 90/010,851 (the '10851 proceeding).

3. On March 16, 2010, the Office mailed a decision denying the February 4, 2010 request for *ex parte* reexamination in the '10851 proceeding.

4. On April 15, 2010, *ex parte* requester filed a petition under 37 CFR 1.181 to review the March 16, 2010 decision denying *ex parte* reexamination in the '10851 proceeding.

5. On December 10, 2010, a request for *inter partes* reexamination of claims 1-8 of the '229 patent was deposited by a third party requester (the *inter partes* requester), which request was assigned Reexamination Control No. 95/001,505 (the '1505 proceeding). Onoffline, Inc. was identified as the real party in interest. The request papers were found not to be compliant with the reexamination filing-date requirements.

6. On January 13, 2011, the Office issued a decision granting *ex parte* requester's April 15, 2010 petition under 37 CFR 1.181, and ordering *ex parte* reexamination of claims 1-8 of the '229 patent in the '10851 proceeding.

7. On February 11, 2011, a corrected request for *inter partes* reexamination of claims 1-8 of the '229 patent was filed by the *inter partes* requester.

8. On March 14, 2011, patent owner filed a patent owner's statement under 37 CFR 1.530 in the '10581 proceeding.

9. On April 1, 2011, the Office issued an order granting *inter partes* reexamination of claims 1-8 of the '229 patent in the '1505 proceeding, concurrently with a non-final Office action on the merits.

10. On April 12, 2011, *ex parte* requester filed a reply to patent owner's statement under 37 CFR 1.530 in the '10851 proceeding.

11. On April 28, 2011, *inter partes* requester filed the instant petition under 37 CFR 1.182 in the '1505 proceeding, requesting merger of the '10851 *ex parte* and the '1505 *inter partes* proceedings.

12. On April 29, 2011, patent owner filed a response to the April 1, 2011 Office action in the '1505 proceeding.

13. On May 3, 2011, the Office issued a non-final Office action in the '10851 proceeding.

14. On May 27, 2011, *inter partes* requester filed comments after the April 1, 2011 Office action and the patent owner's April 29, 2011 response in the '1505 proceeding.

DISCUSSION

37 CFR 1.985(b) provides:

> Notwithstanding any provision of the rules, any person at any time may file a paper in an *inter partes* reexamination proceeding notifying the Office of a prior or concurrent proceedings in which the same patent is or was involved, including

> but not limited to interference, reissue, reexamination, or litigation and the results of such proceedings. Such paper must be limited to merely providing notice of the other proceeding without discussion of issues of the current *inter partes* reexamination proceeding. Any paper not so limited will be returned to the sender.

37 CFR 1.989 provides:

> (a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance and publication of a single reexamination certificate under § 1.997.
>
> (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(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. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with "special dispatch."

In the instant petition under 37 CFR 1.182, petitioner requests merger of the '10851 *ex parte* and the '1505 *inter partes* reexamination proceedings. As of the date of this decision, however, an Office action remains outstanding in the '10851 *ex parte* proceeding. Because a decision to merge reexamination proceedings requires an analysis of whether the claims are the same in both proceedings (see, *e.g.*, MPEP 2686.01(III)), until such time as patent owner files a response to the outstanding Office action in the '10851 proceeding (or the time period for filing a patent owner's response expires), the issue of merger of the '10851 *ex parte* and the '1505 *inter partes* proceedings is not ripe for consideration by the Office. Thus, consideration of the instant petition under 37 CFR 1.182, requesting merger of the '10851 *ex parte* and the '1505 *inter partes* proceedings, would be premature. Accordingly, the *inter partes* requester's April 28, 2011 petition under 37 CFR 1.182 is held in abeyance, subject to renewal if needed.

Further, it is not necessary for a third party requester to file a petition under 37 CFR 1.182 to request merger, because the Office will generally, *sua sponte*, make a decision as to whether or not it is appropriate to exercise its discretion to merge the multiple proceedings. Such a decision

is solely within the discretion of the Office, and will depend upon the facts and circumstances of any given situation. Instead of filing a petition under 37 CFR 1.182 for merger in a reexamination proceeding, the third party requester may file a notification of concurrent proceedings pursuant to MPEP 2282 (in an *ex parte* reexamination) or MPEP 2686 (in an *inter partes* reexamination) to provide the Office with information regarding the existence of the copending proceedings involving the same patent. Accordingly, the instant petition under 37 CFR 1.182 is, at the present time, treated as a notification of concurrent proceedings pursuant to 37 CFR 1.985(b).

CONCLUSION

1. *Inter partes* requester's April 28, 2011 petition under 37 CFR 1.182 is held in abeyance, subject to renewal if needed.

2. After a patent owner's response is filed in the '10851 proceeding (or upon expiration of the time period for filing a patent owner's response), the requester may renew the petition without any further payment of fee.

3. Telephone inquiries with regard to this decision should be directed to Nicole D. Haines, 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

6-21-11

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,505 90/010551	02/10/2011	7467229	39206/5	7013

25315 7590 06/22/2011

BLACK LOWE & GRAHAM, PLLC
701 FIFTH AVENUE
SUITE 4800
SEATTLE, WA 98104

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/22/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 10-5-11

Matthew C. Phillips
STOEL RIVES, LLP-PDX
900 SW 5th Avenue, Suite 2600
Portland, OR 97204-1268

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001505
PATENT NO. : 7467229
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 05 2011

CENTRAL REEXAMINATION UNIT

Lowe Graham Jones, PLLC
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(For Patent Owner)

Matthew C. Phillips
Stoel Rives LLP - PDX
900 SW Fifth Avenue, Suite 2600
Portland, OR 97204

(For *Ex Parte* and *Inter Partes* Requesters)

Ex Parte Reexamination Proceeding	:
Control No.: 90/010,851	:
Filed: February 8, 2010	: **DECISION,**
For: U.S. Patent No. 7,467,229	: ***SUA SPONTE*,**
	: **TO MERGE**
Inter Partes Reexamination Proceeding	: **REEXAMINATION**
Control No.: 95/001,505	: **PROCEEDINGS**
Filed: February 11, 2011	:
For: U.S. Patent No. 7,467,229	:

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

Ex parte reexamination proceeding No. 90/010,851 and *inter partes* reexamination proceeding No. 95/001,505 **are merged** into a single proceeding.

REVIEW OF RELEVANT FACTS

For the 90/010,851 *Ex Parte* Reexamination Proceeding:

1. On December 16, 2008, United States Patent Number 7,467,229 (the '229 patent) was issued to Biggs, *et al.* with claims 1-8.

2. On February 4, 2010, a request for *ex parte* reexamination of claims 1-8 of the '229 patent was deposited by a third party requester, Onoffline, Inc. (the *ex parte* requester), which request was assigned Reexamination Control No. 90/010,851 (the '10851 proceeding).

3. On February 8, 2010, *ex parte* requester filed a supplemental certificate of service in the '10851 proceeding, and a filing date of February 8, 2010 was assigned to the '10851 proceeding.

4. On March 16, 2010, the Office mailed a decision denying the February 4, 2010 request for *ex parte* reexamination in the '10851 proceeding.

5. On April 15, 2010, *ex parte* requester filed a petition under 37 CFR 1.181 to review the March 16, 2010 decision denying *ex parte* reexamination in the '10851 proceeding.

6. On January 13, 2011, the Office issued a decision granting *ex parte* requester's April 15, 2010 petition under 37 CFR 1.181, and ordering *ex parte* reexamination of claims 1-8 of the '229 patent in the '10851 proceeding.

7. On March 14, 2011, patent owner filed a patent owner's statement under 37 CFR 1.530 in the '10851 proceeding.

8. On April 12, 2011, *ex parte* requester filed a reply to patent owner's statement under 37 CFR 1.530 in the '10851 proceeding.

9. On May 3, 2011, the Office issued a non-final Office action in the '10851 proceeding.

10. On July 1, 2011, patent owner filed a response in the '10851 proceeding to the May 3, 2011 Office action without any amendment to the claims.

For the 95/001,505 *Inter Partes* Reexamination Proceeding:

1. On December 16, 2008, United States Patent Number 7,467,229 (the '229 patent) was issued to Biggs, *et al.* with claims 1-8.

2. On December 10, 2010, a request for *inter partes* reexamination of claims 1-8 of the '229 patent was deposited by a third party requester (the *inter partes* requester), which request was assigned Reexamination Control No. 95/001,505 (the '1505 proceeding). Onoffline, Inc. was identified as the real party in interest. The request papers were found not to be compliant with the reexamination filing-date requirements.

3. On February 11, 2011, a corrected request for *inter partes* reexamination of claims 1-8 of the '229 patent was filed by the *inter partes* requester in the '1505 proceeding.

4. On April 1, 2011, the Office issued an order granting *inter partes* reexamination of claims 1-8 of the '229 patent in the '1505 proceeding, concurrently with a non-final Office action on the merits.

5. On April 28, 2011, *inter partes* requester filed, in the '1505 proceeding, a "PETITION UNDER 37 C.F.R. § 1.182 TO MERGE WITH REEXAMINATION CONTROL NO. 90/010,851" (the petition under 37 CFR 1.182).

6. On April 29, 2011, patent owner filed a response in the '1505 proceeding to the April 1, 2011 Office action without any amendment to the claims.

7. On May 27, 2011, *inter partes* requester filed comments in the '1505 proceeding after the April 1, 2011 Office action and the patent owner's April 29, 2011 response.

8. On June 22, 2011, the Office mailed a decision in the '1505 proceeding, holding *inter partes* requester's April 28, 2011 petition under 37 CFR 1.182 in abeyance, subject to renewal after the filing of a patent owner's response in the '10851 proceeding (or upon expiration of the time period for filing a patent owner's response).

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in the two above-captioned proceedings for the same claims of the same patent. One of the proceedings (the '10851 proceeding) is an *ex parte* proceeding. The other proceeding (the '1505 proceeding) is an *inter partes* proceeding. Both proceedings are still pending, and have not been terminated. Therefore, consideration of merger is ripe at this time.

MPEP 2686.01 points out:

> Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with "special dispatch."

In this instance, based upon the record as a whole it is found that merger of the proceedings would facilitate the orderly handling of the proceedings with special dispatch. Accordingly, the 90/010,851 and 95/001,505 proceedings **are hereby merged**. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by

37 CFR 1.902 through 1.997, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560.

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

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

2. Appeal Rights:

The *inter partes* requester and patent owner are reminded of the procedures for taking appeal in an *inter partes* reexamination.[2] The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest.

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP 2674 through 2675 and 2678 through 2683. As pointed out in MPEP 2674:

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

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

---

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

[2] As noted above, the rights of the *ex parte* requester are governed by 37 CFR 1.510 through 1.560. The active participation of the *ex parte* requester ends with the reply pursuant to 37 CFR 1.535, and no further submissions on behalf of the *ex parte* requester will be acknowledged or considered. *See* 37 CFR 1.550(g).

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

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

C. Papers mailed/filed:

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

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

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

Patent owner and requesters are reminded that every paper filed (including papers filed *via* facsimile transmission) in the merged proceeding subsequent to this decision must be served on the other parties, and every paper filed must reflect that such paper was served on the other

parties, pursuant to 37 CFR 1.903.[3] All papers are to be addressed to the Central Reexamination Unit as provided above.

D. Amendments:

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

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

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

E. Fees:

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

F. Citation of Patents and Printed Publications:

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,505 and *ex parte* Reexamination Control No. 90/010,851 are **merged into a single proceeding**, to be conducted in accordance with the procedure set forth above in Part III of this decision.

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

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

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

10-04-2011

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Kunzler, Needham, Massey & Thorpe 8 East Broadway Suite 600 Salt Lake City, UT 84111	FOR PATENT OWNER
Marvin A. Glazer, Cahill Glazer PLC 2141 E. Highland Ave. Suite 155 Phoenix, AZ 85016	FOR THIRD PARTY REQUESTER

MAILED

JAN 06 2012

CENTRAL REEXAMINATION UNIT

In re Arvanites Reexamination Proceeding Control No. : 95/001,507 Filed: December 27, 2010 Patent No. 6,918,355	**DECISION ON REQUESTER'S PETITION UNDER 37 CFR 1.181**

This is a decision addressing patent owner's petition, filed November 15, 2011 under 37 CFR 1.181, for entry of evidence submitted after the action closing prosecution (ACP).

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

SUMMARY

Patent owner'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. 6,918,355 (the '355 patent) issued on July 19, 2005.

2. A request for reexamination, assigned Control No. 95/001,507 (the '507 proceeding), was filed by a third party Requester on December 27, 2010.

3. Reexamination was ordered in the '507 reexamination proceeding on January 25, 2011. On even date, a non-final Office action was mailed.

4. On March 25, 2011, patent owner filed a response to the non-final Office action.

5. On April 24, 2011, third party requester filed a response.

6. An Action Closing Prosecution (ACP) was mailed on June 2, 2011.

7. On July 5, 2011, patent owner filed a response to the ACP.

8. On August 4, 2011, third party requester filed a response.

9. A Right of Appeal Notice (RAN) was mailed on August 15, 2011. In the RAN, the examiner indicated that neither the patent owner's July 5, 2011 nor the third party requester's August 4, 2011 response was entered.

10. On September 16, 2011, patent owner filed a notice of appeal.

11. On November 15, 2011, patent owner filed an appeal brief. On even date, the instant petition was filed.

11. On December 15, 2011, third party requester filed a respondent brief.

Discussion

Patent owner requests entry of evidence submitted on July 5, 2011, after the ACP, which was mailed on June 2, 2011. Specifically, patent owner requests entry of a declaration by Dr. David Brookstein, filed on July 5, 2011. Patent owner argues that in the ACP, the examiner argued, for the first time, that "it simply does not make sense that adding an outer fleece cover would reduce the durability of the pet toy. One of ordinary skill in the art would recognize that an added layer of material would predictably and logically increase durability of the pet toy." Patent owner contends that evidence presented in the Brookstein declaration goes to the question of how adding a fleece layer of material affects the durability of a pet toy. Patent owner points to 35 U.S.C. 1.116(e) and states that she has made a sufficient showing to merit entry of the Brookstein declaration. The examiner refused to enter the response of July 5, 2011 (which included the Brookstein declaration) and set forth her reasons for refusing entry in the RAN, which was mailed August 15, 2011.

The request to enter the Brookstein declaration after the ACP was mailed is <u>dismissed</u> as untimely.

Statement of Relevant Authority

37 CFR 1.181(f) states:

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

...

Decision

Patent owner brings before the Office a petition under 37 CFR § 1.181 to review the examiner's decision not to enter evidence, specifically the Brookstein declaration, after the mailing of the ACP on June 2, 2011. Patent owner filed the petition on November 15, 2011. The action from which relief is requested is the RAN, which was mailed on August 15, 2011. Therefore, the petition was filed over **two** months from the mailing date of the action from which relief is requested. As quoted above, 37 CFR 1.181(f) requires petitions under that section be filed within **two** months from the mailing date of the action from which relief is requested and that such time period is not extendable.

Therefore, the petition is dismissed as untimely because it was not filed within the two month time period required by 37 CFR 1.181(f).

CONCLUSION

1. Patent Owner's petition under 37 CFR 1.181, filed November 15, 2011, is **dismissed** as untimely for the reasons discussed above.

2. The present *inter parte* reexamination proceeding is being forwarded to the examiner for further consideration on the merits.

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

Irem Yucel
Director
Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,508	12/13/2010	7702809	11517.0001-00	9291

38878 7590 09/01/2011

F5 Networks, Inc.
c/o Frommer Lawrence & Haug LLP.
745 Fifth Avenue
NEW YORK, NY 10151

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/01/2011

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WASHINGTON, DC 20001-4413

Date:

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SEP 01 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001508
PATENT NO. : 7702809
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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F5 Networks, Inc.
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745 Fifth Avenue
NEW YORK, NY 10151

(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

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

(For Third Party Requester

In re: Szabo *et al.*	:	
Inter Partes Reexamination Proceeding	:	**DECISION ON PETITION**
Control No.: 95/001,508	:	**UNDER 37 CFR §§ 1.927 & 1.181**
Deposited: December 13, 2010	:	
For: U.S. Patent No.: 7,702,809	:	

This is a decision on the petition filed by the third party requester on March 14, 2011, entitled "PETITION UNDER 37 C.F.R § 1.927 TO REVIEW THE EXAMINER'S REFUSAL TO ORDER *INTER PARTES* REEXAMINATION" [hereinafter "the petition"]. Petitioner, the reexamination requester, seeks review of the Order Denying the Request for *Inter Partes* Reexamination mailed February 14, 2011, which denied the request for reexamination of claims 1-3 of U.S. Patent No. 7,702,809.

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

The petition is granted.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,702,809 issued on April 20, 2010.
- A request for *inter partes* reexamination was filed December 13, 2010 and assigned control no. 95/001,508. The third party requester proposed that a substantial new question of patentability was raised with respect to claims 1-3 by a number of prior art references.
- The examiner denied the request in a determination mailed February 14, 2011.
- The instant petition was timely filed on March 14, 2011. The petition requests reconsideration and reversal of the examiner's determinations that the proposed combinations of references failed to raise substantial new questions of patentability.

DECISION

Standard of Review

37 CFR § 1.927 provides for the filing of a petition under 37 CFR § 1.181 to review an examiner's determination refusing to order *inter partes* reexamination. The CRU Director's review on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination for claims 1-3 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for denying the request.

The Legal Standard for Ordering Reexamination

A review of 35 U.S.C. §§ 311 and 312 reveals that, by statute, *inter partes* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. 35 U.S.C. § 311 requires that a request for *inter partes* reexamination be based upon prior art as set forth in 35 U.S.C. § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.915(b)(3) requires that a request for *inter partes* reexamination include "A statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a

"substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final court holding of invalidity after all appeals, or by the Office in an earlier examination or in a reexamination of a patent. That is, the requester must "demonstrate[] that a patent or printed publication that is relied upon in a proposed rejection presents a new, non-cumulative technical teaching that was not previously considered and discussed on the record during the prosecution of the application that resulted in the patent for which reexamination is requested, and during the prosecution of any other prior proceeding involving the patent." MPEP § 2616. If a substantial new question of patentability is found to be raised, an order granting *inter partes* reexamination of the patent is issued.

Summary of the Prior Prosecution with Respect to the '809 Patent

The '809 patent contains claims 1-3, which are the same claims as originally filed, with claims 1 and 3 being independent. In a first Office action, claims 1-3 were rejected on the ground of non-statutory obviousness-type double patenting as not being patentably distinct from the claims of a commonly owned patent. In response, patent owner filed a terminal disclaimer to obviate the rejection. The examiner issued a Notice of Allowance, including the following statement of reasons for allowance:

> None of the prior art of record disclose or fairly suggest hashing a source IP address or destination address in a received packet to obtain the hash key and employing the hash key as index into allocation table traffic managers, wherein a response packet to each received packet is forwarded to the same corresponding traffic manager.

These limitations indicated as reasons for allowance do not correspond precisely to those of the claims, but are somewhat a hybrid of portions of limitation (b) of independent claim 1 and portions of limitations (c) and (d) from independent claim 3. It would appear to be that the examiner meant, as to claim 1:

> None of the prior art of record disclose or fairly suggest hashing a source [information] or destination [information] in a received packet to obtain the hash key [useable] as index into allocation table [of] traffic managers, wherein a response packet to each received packet is forwarded to the same corresponding traffic manager.

And as to claim 3:

> None of the prior art of record disclose or fairly suggest hashing a source IP address or destination address in a received packet to obtain the hash key and employing the hash key [useable to determine the] traffic manager, wherein [the received] packet is forwarded to the [determined] corresponding traffic manager.

In other words, claim 1 does not require hashing of a source or destination IP address, only hashing "information." Claim 3 does not require the hash key is an index of an allocation table, but is only required as useable "to determine" the traffic manager. Claim 3 also does not require anything about a responsive packet; only the received packet is required to be forwarded to the determined traffic manager. In any case, as the above altered quotations appear to best show correspondence from the claims to the indicated reasons for allowance, a reasonable examiner would consider references showing such limitations important to patentability.

Decision on the Request for Reexamination

The request for reexamination proposed that SNQs are raised by the references as in the following proposed rejections. We are only concerned with proposals where the requester provided the statutory "pertinency and manner of applying the cited art to every claim for which reexamination is requested," 35 U.S.C. § 311, therefore the SNQs are analyzed in the context of those proposals, which follow. See Request pp. i-ii:

A. Claims 1-3 are anticipated by Foundry App. Note. Request pp. 18-27.
B. Claims 1-3 are anticipated by Albert. Request pp. 27-34.
C. Claims 1-3 are anticipated by Bommareddy. Request pp. 34-42.
D. Claim 3 is obvious over Bommareddy in view of Chung. Request pp. 42-44.
E. Claims 1-3 are anticipated by Carvey. Request pp. 44-50.
F. Claims 1 and 2 are obvious over Carvey in view of BIG/ip Admin. Request pp. 50-52.
G. Claims 1 and 2 are obvious over Carvey in view of Foundry App. Note. Request pp. 52-54.
H. Claims 1 and 2 are obvious over Carvey in view of Magnussen. Request pp. 54-57.
I. Claims 1 and 2 are obvious over Carvey in view of Cieslak. Request pp. 57-59.
J. Claims 1-3 are obvious over Wolf in view of each of Shah, Carvey, Jarvis, and Foundry App. Note. Request pp. 59-72.
K. Claims 1-3 are obvious over BIG/ip Admin. in view of each of Carvey, Foundry App. Note, Jarvis, and Shah. Request pp. 72-86.
L. Claims 1-3 are obvious over BIG/ip Admin. in view of each of Carvey, Foundry App. Note, Jarvis, and Shah, and further in view of BIG/ip Ref. Request pp. 86-90.

Proposal A:
The Director agrees that Foundry App. Note raises an SNQ as to claims 1-3. As noted by the requester at Request pp. 6-7, Foundry App. Note at p. 2 describes using a hashing algorithm to select a firewall based on source and destination IP address and port number. The same algorithm is used for incoming and outgoing traffic, therefore a received and responsive packet will go to the same firewall. The '809 patent states at col. 8 lines 14-16 that firewalls are traffic management devices. While there is no explicit discussion of obtaining a hash key or using such key as an index of an allocation table of traffic managers, this might be deemed implicit by a person of skill in the art in using a hashing algorithm.

Foundry App. Note's teachings appear to be at least similar to the limitations deemed missing from the prior art during the original prosecution. Given these findings, along with the detailed item matching of the reference to the claims, a reasonable examiner would have found Foundry App. Note important in considering the patentability of the claims.

The Director therefore reverses the examiner's determination in the Order at pp. 7-9 that the reference does not raise an SNQ. The examiner in denying the request focused on the finding that Foundry App. Note describes the hashing algorithm is the same in both the received and responsive directions, and states the claim language requires different algorithms. The Director disagrees. Neither the claims nor the original examiner's indicated reasons for allowance have any requirement as to the algorithm used. Even to the extent the specification might require different algorithms, the language of the claims is not so limited to the embodiments expressly shown. Finally, even if the claims were limited to the embodiments of the specification and required different algorithms, Foundry App. Note would still appear to be similar to the literal language of the material the examiner indicated as reasons for allowance, and would therefore have been important to a reasonable examiner even if a rejection might not be made. The examiner was therefore incorrect in denying this proposal as raising an SNQ.

Proposal B:
The Director agrees that Albert raises an SNQ as to claims 1-3. As noted by the requester at Request pp. 7-9, Albert appears to describe that a 5-tuple called an affinity key includes source and destination IP addresses and port numbers, and a protocol ID. Affinities are found by hashing, and an affinity match, which seems to be a match of the ports and protocol of the affinity key, causes the packet to be forwarded on. Albert further indicates a response packet SYN ACK to each received packet SYN is forwarded to the same forwarding agent. These teachings do not expressly match what is in the claims, but there is a good deal of similarity.

Albert's teachings appear to be at least similar to the limitations deemed missing from the prior art during the original prosecution. Given these findings, along with the detailed item matching of the reference to the claims, a reasonable examiner would have found Albert important in considering the patentability of the claims.

The Director therefore reverses the examiner's determination in the Order at pp. 9-11 that Albertdoes not raise an SNQ. The examiner in denying the request focused on the finding that Albert describes a different algorithm than the '809 patent, and states the claim language requires particular algorithms. The Director disagrees. Neither the claims nor the original examiner's indicated reasons for allowance have any requirement as to the algorithm used. Even to the extent the specification might require different algorithms, the language of the claims is not so limited to the embodiments expressly shown. Finally, even if the claims were limited to the embodiments of the specification and required different algorithms, Albert would still appear to

be similar to the literal language of the material the examiner indicated as reasons for allowance, and would therefore have been important to a reasonable examiner even if a rejection might not be made. The examiner was therefore incorrect in denying this proposal as raising an SNQ.

Proposals C and D:
The Director agrees that Bommareddy raises an SNQ as to claims 1-3 (Proposal C). As noted by the requester at Request pp. 9-11, Bommareddy appears to describe a network flow controller includes a hash table storing flow information. The flow is identified using source and destination IP address and port, and it appears from the cited portions that it is the IP address that is hashed. Bommareddy further teaches the same firewall is used for incoming and outgoing traffic in a related flow, therefore a received and responsive packet will go to the same firewall. The '809 patent states at col. 8 lines 14-16 that firewalls are traffic management devices. A computed index is used to identify the selected firewall from the list of firewalls, using packet information in the packet IP header. Col. 9 lines 5-21.

Bommareddy's teachings appear to be at least similar to the limitations deemed missing from the prior art during the original prosecution. Given these findings, along with the detailed item matching of the reference to the claims, a reasonable examiner would have found Bommareddy important in considering the patentability of the claims.

For the same reasons, the Director finds that an SNQ is raised as to claim 3 by Bommareddy in view of Chung (Proposal D). As indicated in the Request at pp. 43-44, Chung is provided for the teachings as to claim 3 that the determining of the traffic manager is based in part on comparing the source and destination ports. The requester has at least plausibly indicated how Chung teaches such limitations, and why the references may be combined. The importance of Bommareddy remains as discussed above as to Bommareddy alone, therefore the combination of the references would likewise have been important to a reasonable examiner for the same reasons.

The Director therefore reverses the examiner's determination in the Order at pp. 12-14 that Bommareddy does not raise an SNQ, either alone or with Chung. The examiner in denying the request focused on the finding that Bommareddy does not use the same algorithm as the '809 patent for selection of the traffic manager. The Director disagrees this is relevant here. Neither the claims nor the original examiner's indicated reasons for allowance have any requirement as to the algorithm used. Even to the extent the specification might require particular algorithms, the language of the claims is not so limited to the embodiments expressly shown. Finally, even if the claims were limited to the embodiments of the specification and required certain algorithms, Bommareddy would still appear to be similar to the literal language of the material the examiner indicated as reasons for allowance, and would therefore have been important to a reasonable examiner even if a rejection might not be made. The examiner was therefore incorrect in denying these proposals as raising an SNQ.

Proposals E through I:
The Director agrees that Carvey raises an SNQ as to claims 1-3 (Proposal E). As noted by the requester at Request pp. 11-12, Carvey appears to show that source and destination IP addresses and ports are extracted to form a flow identifier, which is hashed to form a route selector, which is used as an index to look up a fabric route in a fabric forwarding table, selecting a particular trunk. The requester explains why this relates to selection of "traffic managers" as claimed. Request pp. 45-46. The requester also explains why Carvey can be interpreted to disclose that a response packet is forwarded to the same selected traffic manager. Request pp. 45-46.

Carvey's teachings appear to be at least similar to the limitations deemed missing from the prior art during the original prosecution. Given these findings, along with the detailed item matching of the reference to the claims, a reasonable examiner would have found Carvey important in considering the patentability of the claims.

For the same reasons, the Director finds that an SNQ is raised as to claims 1 and 2 by Carvey in view of either BIG/ip Admin., Foundry App. Note, Magnussen, or Cieslak as in proposals F-I respectively. As an alternative, the requester explains how these references show a response packet to each forwarded packet is forwarded to the same selected traffic manager. The requester has at least plausibly indicated how the references teach such limitations, and why they may be combined with Carvey. The combination of Carvey with these references would therefore have been important to a reasonable examiner for similar reasons as Carvey alone.

The Director therefore reverses the examiner's determination in the Order at pp. 14-17 that Carvey does not raise an SNQ, either alone or with the other references. The examiner in denying the request focused on the finding that Carvey does not use the same algorithm as the '809 patent for selection of the traffic manager. The Director disagrees this is relevant here. Neither the claims nor the original examiner's indicated reasons for allowance have any requirement as to the algorithm used. Even to the extent the specification might require particular algorithms, the language of the claims is not so limited to the embodiments expressly shown. Finally, even if the claims were limited to the embodiments of the specification and required certain algorithms, Carvey would still appear to be similar to the literal language of the material the examiner indicated as reasons for allowance, and would therefore have been important to a reasonable examiner even if a rejection might not be made. The examiner was therefore incorrect in denying these proposals as raising an SNQ.

Proposal H (Additional Discussion):
The '809 patent was filed on October 30, 2007, but claims an earliest priority date to a provisional application filed May 24, 2001. Magnussen is a U.S. Patent filed September 5, 2001, after the priority date of the '809 patent. The third party acknowledges this, stating "Although filed after the earliest claimed priority date for the '809 patent . . . Magnussen et al. ('713)

qualifies as prior art . . . because the provisional application fails to provide an enabling disclosure that "a response packet to each received packet is forwarded to the same corresponding traffic manager.""[1] Request p. 17. This is the only mention in the Request of the disclosure of the provisional application. MPEP 2617, however, does not appear to require the third party to explain why the patent is not entitled to the earlier filing date; it only requires that "The statement applying the prior art may, where appropriate, point out that the claims in the patent . . . are entitled only to the filing date of that patent and are not supported by an earlier [application]." The statement as to Magnussen is deemed sufficient as far as "point[ing] out" that the '809 patent is not entitled to the provisional filing date for the purposes of raising an SNQ. The examiner will determine in the first action on the merits if this is indeed the case, to the extent necessary to determine if a rejection should be made.

Proposal J:

First, the proposal is somewhat confusing in that it relies on four secondary references to teach the same limitation, thus it may be arguable whether this is a grouping of four alternative rejections, or one rejection involving five references. That is, the Director must clarify whether the rejection purports to rely on any one of Shah, Carvey, Jarvis, or Foundry App. Note, or whether it relies on all of these references together. The intent is clearly the latter. When the third party wanted to rely on references alternatively, it provided separate proposals, such as proposals F through I. Furthermore, Shah is relied upon for teaching of limitations additional to the limitation common to the other references; thus Shah would appear to be essential to the proposed rejection, therefore it would not be used alternatively. Additionally, if the proposal were grouping four alternative rejections together, it would render the request improper in accordance with MPEP § 2617(I) due to lumping of rejections. The third party clearly intends all of the references to be a part of the proposed rejection.

The Director agrees that the combination of Wolf with each of Shah, Carvey, Jarvis, and Foundry App. Note raises an SNQ as to claims 1-3. As shown in the third party's discussion of the proposed rejection, Request pp. 60-64, Wolf appears to teach that packet header information is used to determine the flow to which the packet belongs, and to which network processor (traffic manager) to send the packet. The third party admits that Wolf "does not explicitly disclose making this determination [i.e. determining the traffic manager] based in part on hashing either source information or destination information in each received packet to determine a hash key useable as an index into an allocation table of traffic managers." Request p. 61. The third party does, however, explain why each of Shah, Carvey, Jarvis, and Foundry App. Note teach such a limitation, and the Director generally agrees that these references appear to teach such a limitation. See Request pp. 61-63. The Director does not necessarily agree that it is clear that Wolf teaches a response packet to each received packet is forwarded to the same

[1] This limitation is not present in claim 3 and therefore the filing date of claim 3 is not questioned at this time, but Magnussen is not applied against claim 3.

corresponding traffic manager, but in any event this appears to be taught by Shah. See Request pp. 63-64. At least Foundry App. Note also teaches this, as shown above as to Proposal A.

The combination of Wolf with Shah, Carvey, Jarvis, and Foundry App. Note therefore appears to provide teachings at least similar to the limitations deemed missing from the prior art during the original prosecution. Given these findings, along with the detailed item matching of the references to the claims, a reasonable examiner would have found this combination of references important in considering the patentability of the claims.

The Director therefore reverses the examiner's determination in the Order that the references do not raise an SNQ. The examiner again focuses on whether the hashing algorithm of the references is the same as that in the '809 patent, and similar to the other proposals the Director again points out that the particular algorithm is not a part of the claims. The examiner's finding is reversed for similar reasons as the other proposals discussed above.

Proposals K and L:
The Director agrees that BIG/ip Admin raises an SNQ as to claims 1-3 when combined with each of Shah, Carvey, Jarvis, and Foundry App. Note (Proposal K) and further when combined with BIG/ip Ref. (Proposal L).

The Director agrees that the combination of BIG/ip Admin. with each of Shah, Carvey, Jarvis, and Foundry App. Note raises an SNQ as to claims 1-3. As shown in the third party's discussion of the proposed rejection, Request pp. 73-86, BIG/ip Admin. appears on its face to teach most of the limitations of the claims, including that after a connection, return data can be sent back through the same device from which the connection originated (i.e. a response packet is forwarded to the same traffic manager). The reference also appears to generally determine a traffic manager based on source or destination information, and it describes hashing, though it is not apparent in the cited sections that there is hashing of source or destination information. The third party does, however, explain why each of Shah, Carvey, Jarvis, and Foundry App. Note teach such a limitation, and the Director generally agrees that these references appear to teach such a limitation. See Request pp. 75-77.

The combination of BIG/ip Admin. with Shah, Carvey, Jarvis, and Foundry App. Note therefore appears to provide teachings at least similar to the limitations deemed missing from the prior art during the original prosecution. Given these findings, along with the detailed item matching of the references to the claims, a reasonable examiner would have found this combination of references important in considering the patentability of the claims.

In proposal L, BIG/ip Ref. is merely provided as yet another reference that teaches hashing source or destination information to determine a hash key useable as an index into an allocation table of traffic managers. BIG/ip Ref. does appear to hash a cookie value, and the cookie is

defined using source and destination IP address and port information. Adding this reference to the combination would not take away from the importance of the combination discussed as to proposal K, and would raise an SNQ for the same reasons.

The Director therefore reverses the examiner's determination in the Order that the references do not raise an SNQ. The examiner again focuses on whether the hashing algorithm of the references is the same as that in the '809 patent, and similar to the other proposals the Director again points out that the particular algorithm is not a part of the claims. The examiner's finding is reversed for similar reasons as the other proposals discussed above.

The teachings of the references discussed herein, whether alone or in the described combinations, are not cumulative to any written discussion on the record of the teachings of the prior art, were not previously considered nor addressed during a prior examination, and the same question was not the subject of a final holding of invalidity in the Federal Courts.

Accordingly, the petition is granted.

CONCLUSION

1. Based on a *de novo* review of the record as a whole, the petition is granted. Accordingly, the request for *inter partes* reexamination of claims 1-3 of the '809 patent is granted.

2. The decision is final and non-appealable. See 35 U.S.C. § 312(c) and 37 C.F.R. § 1.927. No further communication on this matter will be acknowledged or considered.

3. In accordance with this decision, an Office action on the merits will issue in due course.

4. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.

Irem Yucel
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,509	12/13/2010	7697427	11517.0002-00	9405

38878 7590 08/31/2011

F5 Networks, Inc.
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 08/31/2011

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

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Date:

MAILED

AUG 31 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001509
PATENT NO. : 7697427
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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AUG 31 2011

CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

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(For Third Party Requester)

In re: Amdahl *et al.*
Inter Partes Reexamination Proceeding :
Control No.: 95/001,509 :
Deposited: December 13, 2010 :
For: U.S. Patent No.: 7,697,427 :

DECISION ON PETITION
UNDER 37 CFR §§ 1.927 & 1.181

This is a decision on the petition filed by the third party requester on March 14, 2011, entitled "PETITION UNDER 37 C.F.R § 1.927 TO REVIEW THE EXAMINER'S REFUSAL TO ORDER *INTER PARTES* REEXAMINATION" [hereinafter "the petition"]. Petitioner, the reexamination requester, seeks review of the Order Denying the Request for *Inter Partes* Reexamination mailed February 14, 2011, which denied the request for reexamination of claims 1-3, 5, 7-9, 11, 12, 15, 16, 19, 20, 22 and 23 of U.S. Patent No. 7,697,427.

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

The petition is granted.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,697,427 issued on April 13, 2010.
- A request for *inter partes* reexamination was filed December 13, 2010 and assigned control no. 95/001,509. The third party requester proposed that a substantial new question of patentability was raised with respect to claims 1-3, 5, 7-9, 11, 12, 15, 16, 19, 20, 22 and 23 by a number of prior art references
- The examiner denied the request in a determination mailed February 14, 2011.
- The instant petition was timely filed on March 14, 2011. The petition requests reconsideration and reversal of the examiner's determinations that the proposed combinations of references failed to raise substantial new questions of patentability.

DECISION

Standard of Review

37 CFR § 1.927 provides for the filing of a petition under 37 CFR § 1.181 to review an examiner's determination refusing to order *inter partes* reexamination. The CRU Director's review on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for denying the request.

The Legal Standard for Ordering Reexamination

A review of 35 U.S.C. §§ 311 and 312 reveals that, by statute, *inter partes* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. 35 U.S.C. § 311 requires that a request for *inter partes* reexamination be based upon prior art as set forth in 35 U.S.C. § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.915(b)(3) requires that a request for *inter partes* reexamination include "A statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a

"substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final court holding of invalidity after all appeals, or by the Office in an earlier examination or in a reexamination of a patent. That is, the requester must "demonstrate[] that a patent or printed publication that is relied upon in a proposed rejection presents a new, non-cumulative technical teaching that was not previously considered and discussed on the record during the prosecution of the application that resulted in the patent for which reexamination is requested, and during the prosecution of any other prior proceeding involving the patent." MPEP § 2616. If a substantial new question of patentability is found to be raised, an order granting *inter partes* reexamination of the patent is issued.

Summary of the Prior Prosecution with Respect to the '427 Patent, and Claim Construction

The '427 patent contains 24 claims but was filed with 27 claims. In a first Office action claims 25 and 26 were rejected under 35 U.S.C. § 101 as drawn to non-statutory subject matter, and claims 1-27 were rejected on the ground of obviousness-type double patenting over the claims of the parent patent. In response the applicant filed a terminal disclaimer to obviate the double patenting rejection, amended claim 1 to correct a typographical error, and amended claims 25-27 to correct any § 101 problems. The examiner issued a Notice of Allowance, including numerous changes to the claims by examiner's amendment. Applicant filed an RCE for consideration of an IDS, and the examiner allowed the application again with no further comment. Reasons for allowance were given in the first Notice of Allowance, where the examiner stated:

> The prior art of the record fails to disclose a forwarding component that forwards each received packet to a determined traffic manager, wherein the forwarding component determines the traffic manager based on whether at least one address that is included with a received packet is also associated with a set of addresses, and wherein if the packet includes a source address that is associated with the set of addresses, using a destination address of the packet to determine the traffic manager and wherein the forwarding component forwards the packet to the determined traffic manager using the source address of the packet if it includes the destination address that is associated with another set of addresses in combination of other limitations recited in [the] claims . . . .

It is noted that all of the claims do not require all of these limitations. For example, independent claims 11, 15, 19 and 22 do not require "the forwarding component determines the traffic manager based on whether at least one address that is included with a received packet is also associated with a set of addresses" or even a "forwarding component." As numerous claims were allowed without having such limitations, these features clearly must not have been particularly significant to patentability. Rather, the remaining limitations stated in the reasons for allowance (the two if-then statements) are deemed the material the examiner found to be lacking during the original prosecution.

It is additionally noted that not all of the claims include identical language to that quoted in the reasons for allowance, but the Director agrees with the district court that the limitations should be construed in the same way because they are saying basically the same thing to describe the same operation. *See* F5 Networks Inc. v. A10 Networks Inc., Order on Claim Construction, 2:10-cv-00654 at 8-11 (W.D. Wash. 7/8/2011) (filed in this proceeding 7/15/2011) (hereinafter "D.Ct. Claims"). While the use of different language does imply that different meanings were intended, there is no evidence that there actually are different meanings in this case.

As to the quoted reasons for allowance, it is an open question whether the material in the reasons for allowance requires a determining step. That is, when the claim says "if X, Y" does the claim actually require the device to determine whether X occurs before deciding to do Y? Must the device check the packet source and destination addresses to determine whether they are associated with a set of addresses, before forwarding? Or is it enough that Y simply occurs whenever X is true, whether the system determined X was true or not?

The district court appears to have found that a determining step is implicitly required in the claim language. *See* D.Ct. Claims p. 10. The Director disagrees, and finds no such determining step in the claim language for the purpose of the present order.[1] The claim term "If X, Y" does not necessarily mean "Determine if X, and if so, do Y." It could merely mean "If X is the case, whether we have determined it or not, do Y." And the Director finds that this is the claim construction of these "if" statements, at least at present in this proceeding for the purpose of determining whether an SNQ is present.

First, it should be made clear that this is not a finding that the district court's findings were incorrect. The Office and the courts operate under different standards of claim construction, and may come to different and inconsistent conclusions that are nonetheless both correct under their respective standards. *See In re Trans Texas Holdings Corp.*, 498 F.3d 1290, 83 USPQ2d 1835 (Fed. Cir. 2007); *In re Translogic Technology, Inc.*, 504 F.3d 1249, 84 USPQ2d 1929 (Fed. Cir. 2007). The broader construction herein is consistent with that principal and with the Office's broader claim construction than that used in the courts. Additionally, the court stated "[t]his finding is based on the testimony of experts from both sides," D.Ct. Claims p. 10, and it is important that no such testimony is currently before the Office. The Office might change the claim construction later in light of further testimony or evidence.

Finally, a determination that an SNQ is present is not the same as a determination that the claims are *prima facie* unpatentable. *See* MPEP § 2640. If the references read on the literal claim

[1] It may be found that claims 1 and 7 require a determining step, as they require determining the traffic manager "based on" whether an address included with the packet is associated with a set of addresses. But as described *supra*, this is not an issue important to patentability, therefore this goes toward whether a rejection can be made rather than whether an SNQ is present.

language that the original examiner found was missing from the prior art, this may be sufficient to raise an SNQ, even if the examiner ultimately finds that the claims have additional implicit requirements that prevent a particular rejection from being proper. The Director's findings herein do not prevent the examiner from determining during the prosecution stage that there are additional implicit requirements of the claims that prevent a *prima facie* case of unpatentability.

The reason the Director brings up this point is that it may be considered important to patentability by a reasonable examiner. Some of the cited references appear to select a traffic manager based on source and destination address in all cases. For example, Foundry App. Note merely states that "ServerIron uses a configurable hashing algorithm to select a firewall based on the source IP address, source port number, destination IP address and destination port number." Foundry App. Note p. 2. There is no determination as to the "if" statements, as there is no determination whether the source/destination address is associated with a first/second set of addresses. But in any event the "then" parts each appear to occur in all cases, as the traffic manager is selected using a destination and source address, in all cases. As the "then" portions occur in all cases, they necessarily occur whenever the "if" statement is true. That they may also occur when the "if" statements are not true is not germane to the literal claim language.

Other references do not use the source and destination addresses to select a traffic manager in all cases. Thus, we cannot merely say that the "then" statements are always met, and are necessarily met whenever the "if" is satisfied. In such references we would actually need a disclosure of the "then" occurring when the "if" is satisfied, if we are to find the reference meets the claim.

The original examiner did not state whether the claims required a determination as to whether the "if" part of the claims occurred; it was merely found that the entirety of each "if then" statement was not in the prior art. Thus, if the references appear to teach the literal claim language, regardless of any implicit determination, such references would have been important in considering the patentability of the claims.

Decision on the Request for Reexamination

The request for reexamination proposed that SNQs are raised by the references as in the following proposed rejections. We are only concerned with proposals where the requester provided the statutory "pertinency and manner of applying the cited art to every claim for which reexamination is requested," 35 U.S.C. § 311, therefore the SNQs are analyzed in the context of those proposals, which follow. See Request pp. i-ii:

A. Claims 1-3, 5, 7-9, 11, 12, 15, 16, 19, 20, 22 and 23 are anticipated by Foundry App. Note. Request pp. 27-47.
B. Claims 1-3, 5, 7-9, 11, 12, 15, 16, 19, 20, 22 and 23 are anticipated by Albert. Request pp. 47-64.

C. Claims 1-3, 5, 7-9, 11, 12, 15, 16, 19, 20, 22 and 23 are anticipated by Bommareddy. Request pp. 64-83.
D. Claims 1-3, 5, 7-9, 11, 12, 15, 16, 19, 20, 22 and 23 are anticipated by Carvey. Request pp. 83-100.
E. Claims 1-3, 5, 7-9, 11, 12, 15, 16, 19, 20, 22 and 23 are anticipated by Jarvis. Request pp. 100-116.
F. Claims 1, 2, 5, 7-9, 11, 12, 15, 16, 19, 20, 22 and 23 are anticipated by BIG/ip Admin. Request pp. 116-144.
G. Claim 3 is obvious over BIG/ip Admin. in view of each of Shah, Carvey, Jarvis and Foundry App. Note. Request pp. 144-147.
H. Claim 3 is obvious over BIG/ip Admin. in view of BIG/ip Ref. Request pp. 147-149.
I. Claims 1, 2, 5, 7-9, 11, 12, 15, 16, 19, 20, 22 and 23 are obvious over Wolf in view of Shah. Request pp. 149-170.
J. Claim 3 is obvious over Wolf in view of each of Shah, Carvey, Jarvis and Foundry App. Note. Request pp. 170-173.

Proposal A:
The Director agrees that Foundry App. Note raises an SNQ as to the claims. The third party argues at Request pp. 9-10 that the reference discloses the subject matter quoted above from the examiner's reasons for allowance. The third party argues that page 2 of the Foundry App. Note teaches these features when it says "ServerIron uses a configurable hashing algorithm to select a firewall based on the source IP address, source port number, destination IP address and destination port number. ServerIron-A and ServerIron-B use the same algorithm to ensure that all packets for a given TCP connection flow through the same firewall . . . ." Foundry App. Note p. 2, quoted in Request p. 9.

The Director agrees that this appears to teach the limitations that were deemed missing during the original prosecution. The traffic manager is selected using a destination address of the packet as well as the source destination of the packet, apparently in all cases, therefore the "then" requirements necessarily occur whenever the "if" statements are true. It is stated the selected firewall is the same for each packet of the flow. Assuming there is no "determining" requirement as to the "if" statements, as described herein, the reference teaches what was missing during the original prosecution. Given these findings, along with the detailed item matching of the reference to the claims, a reasonable examiner would have found Foundry App. Note important in considering the patentability of the claims.

The Director therefore reverses the examiner's determination in the Order at pp. 8-9 that Foundry App. Note does not raise an SNQ. The examiner in denying the request focused on the finding that Foundry App. Note does not use the same attributes as the '427 patent in its hashing algorithm, and that Foundry App. Note does not teach the "associated" limitations of the claims.

While this may be true, and may go toward whether the reference renders the claims unpatentable, the reference does appear to read on the literal claim language, as construed herein. This is sufficient, the Director finds, to show that Foundry App. Note would have been important to a reasonable examiner in considering patentability, therefore the examiner was incorrect in denying this proposal as raising an SNQ.

Proposal B:
The Director agrees that Albert raises an SNQ as to the claims. The third party argues at Request pp. 11-12 that the reference discloses the subject matter quoted above from the examiner's reasons for allowance. It is clear from the quoted sections that Albert determines whether the source address and destination address of a packet are associated with a set of addresses; each are so tested to see if they match the wildcard affinity. It is not entirely clear, after such test of the source and destination address of the packet, whether the destination or source address, respectively is used to select a traffic manager as claimed. It appears that forwarding is done due to an affinity. Does that mean that the source and destination are "used?" Again, it is not entirely clear, but Albert does indicated that the affinity is a 5-tuple including the source and destination address, thus it may very well be the case. At the very least this requires further consideration, but it is similar enough to what is claimed that a reasonable examiner would find Albert important when considering patentability of the claims.

The Director therefore reverses the examiner's determination in the Order at pp. 10-12 that Albert does not raise an SNQ. The examiner in denying the request focused on the finding that Albert does not use the same algorithm as the '427 patent and does not perform certain determinations that are not included in the claims. The focus on what was not claimed, in light of the above findings, leads the Director to conclude the examiner was incorrect in denying this proposal as raising an SNQ.

Proposal C:
The Director agrees that Bommareddy raises an SNQ as to the claims. The third party argues at Request p. 14 that the reference discloses the subject matter quoted above from the examiner's reasons for allowance. The third party argues that Bommareddy teaches the material primarily in two sentences: "[B]oth the internal and the external network flow controller units 110 and 112 use the source and destination IP address and port to identify the client-server-flow." Col. 8 lines 57-60. "[F]or any given client-server connection flow, the same firewall is used by both the internal and external network flow controller units for every inbound and outbound packet . . . ." Col. 9 lines 13-16. Furthermore, a computed index is used to identify the selected firewall from the list of firewalls, using packet information in the packet IP header. Col. 9 lines 5-21.

The Director agrees that this appears to teach the limitations that were deemed missing during the original prosecution. The traffic manager is selected using a destination address of the packet as well as the source destination of the packet, apparently in all cases, therefore the "then"

requirements necessarily occur whenever the "if" statements are true. It is stated the selected firewall is the same for each packet of the flow. Assuming there is no "determining" requirement as to the "if" statements, as described herein, the reference teaches what was missing during the original prosecution. Given these findings, along with the detailed item matching of the reference to the claims, a reasonable examiner would have found Bommareddy important in considering the patentability of the claims.

The Director therefore reverses the examiner's determination in the Order at pp. 12-14 that Bommareddy does not raise an SNQ. The examiner in denying the request focused on the finding that Bommareddy does not use the same attributes as the '427 patent in its hashing algorithm, and that Bommareddy does not use a table to determine the algorithm. While this may be true, the particular algorithm is not a part of the claims, and the reference does appear to read on the literal claim language, as construed herein. This is sufficient, the Director finds, to show that Bommareddy would have been important to a reasonable examiner in considering patentability, therefore the examiner was incorrect in denying this proposal as raising an SNQ.

Proposal D:

The Director agrees that Carvey raises an SNQ as to the claims. The third party argues at Request p. 17 that the reference discloses the subject matter quoted above from the examiner's reasons for allowance. As cited by the third party, the reference appears to show that source and destination IP addresses and ports are extracted to form a flow identifier, which is hashed to form a route selector, which is used as an index to look up a fabric route in a fabric forwarding table, selecting a particular trunk which goes to the next hop router (traffic manager), and also explains that all packets of the same flow go to the same trunk, which leads to the router. See Request pp. 84-86.

The Director agrees that this appears to teach the limitations that were deemed missing during the original prosecution. While the selection is not direct, the claims do not preclude intermediate steps. It appears that the source and destination addresses of the packet are always used to form the flow identifier, therefore they are always used in the selection of the traffic manager. The "then" requirements therefore necessarily occur whenever the "if" statements are true. It is stated the selected trunk is the same for each packet of the flow, implying that the next hop router, the traffic manager, is always the same for a flow. Assuming there is no "determining" requirement as to the "if" statements, as described herein, the reference teaches what was missing during the original prosecution. Given these findings, along with the detailed item matching of the reference to the claims, a reasonable examiner would have found Carvey important in considering the patentability of the claims.

The Director therefore reverses the examiner's determination in the Order at pp. 14-16 that Carvey does not raise an SNQ. The examiner in denying the request focused first on the finding that Carvey does not use the same algorithm as the '427 patent for selection of the traffic

manager. The Director disagrees this is relevant here. Other than what has been discussed herein, neither the claims nor the original examiner's indicated reasons for allowance have any requirement as to the algorithm used, and the Director has explained why Carvey may be considered to show what is in the claim. This is sufficient, the Director finds, to show that Carvey would have been important to a reasonable examiner in considering patentability, therefore the examiner was incorrect in denying the proposal as raising an SNQ.

Proposal E:
The Director agrees that Jarvis raises an SNQ as to the claims. The third party argues at Request pp. 18-19 that the reference discloses the subject matter quoted above from the examiner's reasons for allowance. As cited by the third party, the reference appears to show that packets are routed to a path via a hash function depending only on source and destination IP addresses ((S,D) pair), and the resulting hash bin is mapped to a path. The hash function gives the same result for a given (S,D) pair, therefore each packet in a flow goes to the same path. The third party says the path leads to a next hop router, a traffic manager.

The Director agrees that this appears to teach the limitations that were deemed missing during the original prosecution. It appears that the source and destination addresses of the packet are always used as part of the hash function to select a path, therefore they are always used in the selection of the traffic manager. The "then" requirements therefore necessarily occur whenever the "if" statements are true. It is stated that all packets in a session take the same path, thus going through the same routers. While it is not explicitly stated that routers are selected, one might consider it inherent that there are routers along the path, as indicated by the third party, therefore selection of the same path is implicitly selection of the same next hop router (i.e. traffic manager). Assuming there is no "determining" requirement as to the "if" statements, as described herein, the reference teaches what was missing during the original prosecution. Given these findings, along with the detailed item matching of the reference to the claims, a reasonable examiner would have found Jarvis important in considering the patentability of the claims.

The Director therefore reverses the examiner's determination in the Order at pp. 17-19 that Jarvis does not raise an SNQ. The examiner in denying the request focused first on the finding that Jarvis does not use the same algorithm as the '427 patent for selection of the traffic manager. The Director disagrees this is relevant here. Other than what has been discussed herein, neither the claims nor the original examiner's indicated reasons for allowance have any requirement as to the algorithm used, and the Director has explained why Jarvis may be considered to show what is in the claim. The examiner additionally stated that the third party does not indicate what element is the traffic manager, that Jarvis does not teach the "associated with [i.e. the "if" statements]" steps, and that Jarvis fails to show using a destination address or source address of the packet to select a traffic manager. The Director disagrees. The "if" portions do not require a determination step, and to the extent the "then" portions are always true, they necessarily occur whenever the if portion is true, as described further herein. The Director has already explained

above how the requester indicates what is the traffic manager, and how it is selected "using" the source and destination addresses. The above description is sufficient, the Director finds, to show that Jarvis would have been important to a reasonable examiner in considering patentability, therefore the examiner was incorrect in denying the proposal as raising an SNQ.

Proposals F, G and H:
The Director does not agree that BIG/ip Admin. raises an SNQ as to the claims. The third party argues at Request pp. 20-21 that the reference discloses the subject matter quoted above from the examiner's reasons for allowance. The third party argues that the reference teaches these features as follows:

> Typical criteria that you define in IP filters are packet source IP addresses, packet destination IP addresses, and upper-layer protocol of the packet . . . . For a single filter, you can define multiple criteria in multiple, separate statements . . . . When you define an IP filter, you can filter traffic in two ways: You can filter traffic going to a specific destination or coming from a specific destination, or both. The filter can allow network traffic through, or it can reject network traffic.
>
> When you enable destination processing on a BIP/ip Controller interface, the interface functions in that manner: When the destination address on the packet is a virtual server, [i.e. incoming packet] then the interface routes the packet to the Node that is handling the connection that the packet is a part of, picking one if necessary.
>
> When a packet arrives that is destined for a virtual server [i.e. incoming packet] that does not match a current connection, the BIG/ip Controller can select a pool by evaluating a virtual server rule to pick a node pool . . . . You can also use the client_addr variable to select a pool. You can use this variable to load balance connections based on part of the client's address.

BIG/ip Admin pp. 2-7, 2-23, 3-7 to 3-8 (quoted in Request pp. 20-21)

BIG/ip Admin discloses, in the first paragraph quoted above, that you can set up IP filters. The filter can allow network traffic through or reject traffic, and the filter can be defined using specified criteria, including packet source IP address and packet destination IP address. It is apparent that this can be a disclosure of (1) "if the packet includes a source address that is associated with the set of addresses . . ." and (2) "forwarding the packet . . . if it includes a destination address that is associated with another set of addresses."

What is not clear though is what happens after the filtering and forwarding. That is, is the packet forwarded to a traffic manager, and how is that traffic manager selected? Recall the claims require that if (1) above is satisfied, the traffic manager is selected using a destination address of

the packet, and if (2) above is satisfied, the traffic manager is selected using a source address of the packet. The description at p. 2-7 says nothing of this.

The third party moves on to p. 2-23, the second paragraph quoted above, which discusses an entirely different feature of the system, interfaces, that do not appear to be related to filters. In any event, it is not clear what the third party is saying is taught in this paragraph. All it says is, if the packet destination is a virtual server, route the packet to the Node of the connection, picking one if necessary. But it is not said how the Node is picked, if it is done by using a source or destination address as required in the claims. Again, this is at best a disclosure of "forwarding the packet . . . if it includes a destination address that is associated with another set of addresses." There is nothing about what is used to select a traffic manager.

The third party then moves on to the next chapter, a section regarding the selection of a load balancing pool using a rule, at pp. 3-7 to 3-8. The creative use of ellipses, linking one sentence to another a page away in the quotation, is noted. In any case, the first sentence tells us that when a packet destined for a virtual server does not match a current connection, select a pool using a rule; the second sentence says a rule can be use source address to pick a pool. This combination could be considered "if the packet includes a destination address that is associated with a second set of addresses, selecting a pool using a source address of the packet."

First, it is not at all clear that a pool can be considered a traffic manager. The '427 patent is quite broad in defining the term, col. 10 line 55 – col. 11 line 29, and it is any device that manages traffic. A pool is certainly *a group of* traffic managers, but it is not clear that a pool *is* a traffic manager.[2] There is no indication in the cited portions that any particular member of the pool is selected, just the pool. It is not stated, in these cited sections, how the particular node in the pool is selected. Perhaps selecting a pool is enough, and then the particular node is selected at random? A particular node would not then be "selected" as claimed. The point is, the third party has not told us how a traffic manager is selected.

Additionally, even if this was sufficient, this description tells us nothing about the other if-then statement of the claims. There is no selection of a traffic manager using a destination address of the packet, if the packet includes a source address associated with a set of addresses. Recall that in references like Foundry App. Note, a traffic manager was always selected using both source and destination addresses, therefore the then statement was always satisfied. Here, that does not appear to be the case, therefore we need to know what happens if the source address is associated with a first set, as claimed. But we have no such disclosure, at all, therefore we do not have a disclosure of the material that was missing during the original prosecution.

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[2] This is akin to, if you asked me to select a USPTO employee and I selected "Central Reexamination Unit." The CRU is not an employee, and a group of traffic managers is not a traffic manager.

Additionally, in the body of the proposed rejection, the third party cites to Fig. 8.3 and pp. 8-13 to -14 as teaching the "if-then" statements through its disclosure of using destination processing. The Director disagrees. There is no teaching of using the destination address to select a node. The third party appears to argue that the evaluation of whether the destination address is part of an existing connection is the "use" of the destination address. The Director disagrees, as mere evaluation of the address is not using it. It is the use of the fact of whether there is a connection, not a use of the underlying address.

Given the lack of teachings, a reasonable examiner would not find BIG/ip Admin important in considering the patentability of the claims.

For the same reasons, the combinations with the various references in Proposals G and H do not raise an SNQ. These references are not provided in a way that remedies the problems in BIG/ip Admin. described above. That is, any SNQ in these proposals is based on BIG/ip Admin. raising an SNQ. Even if some of these references independently raise an SNQ, they are only provided here for their teachings as to dependent claims. There is no provided reasoning as to how or why they would additionally be combined with BIG/ip Admin. to show the features missing during the original prosecution, and the Director declines to find any such reasoning. No SNQ is raised in proposals F, G and H.

Proposals I and J:

The Director agrees that the combination of Wolf and Shah raises an SNQ as to the claims as in proposal I. As described in the proposed rejection at Request pp. 149-153, Wolf appears to teach forwarding traffic to a network processor of a router using the packet header. Shah further teaches that packets are assigned to a hash bucket using a 4-tuple as a key to performing a hash function. The 4-tuple includes source and destination address. Shah also states that all packets in a connection are assigned to the same bucket.

The Director agrees that this appears to teach the limitations that were deemed missing during the original prosecution. It appears that Wolf teaches the basic principle of using a packet header to route a packet to a traffic manager. Shah further teaches the source and destination addresses of the packet are always used as part of the hash function to determine the hash bucket for routing, and the hash bucket is always the same in a particular connection. As Wolf uses the header for routing, and Shah indicates that the use of the header involves using the source and destination address in hashing, this would indicate, using the combined teachings of the references, that the source and destination addresses are always used for selecting a traffic manager to which the packet is forwarded. If all packets in a connection are assigned to the same bucket, then it would seem the first and second traffic managers would be the same. The "then" requirements of the claims therefore necessarily occur whenever the "if" statements are true. Assuming there is no "determining" requirement as to the "if" statements, as described herein, the reference teaches what was missing during the original prosecution. Given these

findings, along with the detailed item matching of the reference to the claims, a reasonable examiner would have found Wolf and Shah important in considering the patentability of the claims.

For the same reasons, the Director finds that an SNQ is raised as to claim 3 by adding Carvey, Jarvis and Foundry App. Note to the references (Proposal J). As indicated in the Request at pp. 171-174, Carvey, Jarvis and Foundry App. Note are provided for their teachings that "using" the source or destination address includes hashing it to obtain a value used for forwarding. The requester has at least plausibly indicated how these references teach such limitations, and why the references may be combined. The importance of Wolf and Shah remain as discussed above as to those references alone, therefore the combination of the references would likewise have been important to a reasonable examiner for the same reasons.

The Director therefore reverses the examiner's determination in the Order at pp. 20-23 that the combination of Wolf and Shah does not raise an SNQ. The examiner in denying the request focused first on the teachings of Wolf individually. This was not necessarily incorrect given the manner that the third party presented the request, and the Director agrees that Wolf alone fails to raise an SNQ as stated in the next paragraph. But all proposed rejections involving Wolf relied on a combination of Wolf with Shah, therefore it is more relevant to consider the combined teachings of Wolf and Shah when considering whether an SNQ is raised. As described above, this combination does raise an SNQ. As to Shah, the examiner appears to have found that Shah does not disclose the limitations of the claims, though it is not entirely clear why. The Director disagrees for the reasons described in this section, and finds that such description is sufficient to show that the combination of Wolf and Shah would have been important to a reasonable examiner in considering patentability. The examiner was incorrect in denying these proposals as raising an SNQ.

Note that Wolf alone does not raise an SNQ. As to Wolf, the third party has only alleged (at Request p. 24) the new technological teaching is forwarding to a traffic manager determined based on whether an address of the packet is associated with a set of addresses. As described herein, this feature was not even present in many of the claims, and was not independently an important basis for patentability. But in any event, Wolf is only applied against the claims in combinations with Shah, and as described above the combination of Wolf and Shah does raise an SNQ.

The teachings of the references discussed herein, whether alone or in the described combinations, are not cumulative to any written discussion on the record of the teachings of the prior art, were not previously considered nor addressed during a prior examination, and the same question was not the subject of a final holding of invalidity in the Federal Courts.

Accordingly, while some proposals are denied herein, all requested claims are ordered for reexamination, therefore the petition is granted.

CONCLUSION

1. Based on a *de novo* review of the record as a whole, the petition is granted. Accordingly, the request for *inter partes* reexamination of claims 1-3, 5, 7-9, 11, 12, 15, 16, 19, 20, 22 and 23 of the '427 patent is granted.

2. The decision is final and non-appealable. See 35 U.S.C. § 312(c) and 37 C.F.R. § 1.927. No further communication on this matter will be acknowledged or considered.

3. In accordance with this decision, an Office action on the merits will issue in due course.

4. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.

Irem Yucel
Director, Central Reexamination Unit

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F5 Networks, Inc.
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EXAMINER

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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Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001510
PATENT NO. : 7395349
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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F5 Networks, Inc.
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(For Patent Owner)

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(For Third Party Requester

In re: Szabo *et al.*	:	
Inter Partes Reexamination Proceeding	:	**DECISION ON PETITION**
Control No.: 95/001,510	:	**UNDER 37 CFR §§ 1.927 & 1.181**
Deposited: December 13, 2010	:	
For: U.S. Patent No.: 7,395,349	:	

This is a decision on the petition filed by the third party requester on March 4, 2011, entitled "PETITION UNDER 37 C.F.R § 1.927 TO REVIEW THE EXAMINER'S REFUSAL TO ORDER *INTER PARTES* REEXAMINATION" [hereinafter "the petition"]. Petitioner, the reexamination requester, seeks review of the Order Denying the Request for *Inter Partes* Reexamination mailed February 4, 2011, which denied the request for reexamination of claims 11-13 of U.S. Patent No. 7,395,349.

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

The petition is granted.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,395,349 issued on July 1, 2008.
- A request for *inter partes* reexamination was filed December 13, 2010 and assigned control no. 95/001,510. The third party requester proposed that a substantial new question of patentability was raised with respect to claims 11-13 by a number of prior art references.
- The examiner denied the request in a determination mailed February 4, 2011.
- The instant petition was timely filed on March 4, 2011. The petition requests reconsideration and reversal of the examiner's determinations that the proposed combinations of references failed to raise substantial new questions of patentability.

DECISION

Standard of Review

37 CFR § 1.927 provides for the filing of a petition under 37 CFR § 1.181 to review an examiner's determination refusing to order *inter partes* reexamination. The CRU Director's review on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination for claims 11-13 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for denying the request.

The Legal Standard for Ordering Reexamination

A review of 35 U.S.C. §§ 311 and 312 reveals that, by statute, *inter partes* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. 35 U.S.C. § 311 requires that a request for *inter partes* reexamination be based upon prior art as set forth in 35 U.S.C. § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.915(b)(3) requires that a request for *inter partes* reexamination include "A statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a

"substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final court holding of invalidity after all appeals, or by the Office in an earlier examination or in a reexamination of a patent. That is, the requester must "demonstrate[] that a patent or printed publication that is relied upon in a proposed rejection presents a new, non-cumulative technical teaching that was not previously considered and discussed on the record during the prosecution of the application that resulted in the patent for which reexamination is requested, and during the prosecution of any other prior proceeding involving the patent." MPEP § 2616. If a substantial new question of patentability is found to be raised, an order granting *inter partes* reexamination of the patent is issued.

Summary of the Prior Prosecution with Respect to the '349 Patent

The '349 patent contains 29 claims. The application as filed included claims 1-33, and application claims 12-14 matured into patent claims 11-13, at issue here. In a first Office action, claims 1-33 were rejected on the ground of non-statutory obviousness-type double patenting, and claims 31-33 were rejected over prior art. In response, patent owner filed a terminal disclaimer to obviate the double patenting rejection and cancelled claims 31-33. The examiner issued a second non-final Office action, rejecting claims 1-5 and 8-30 over prior art to Albert (not the same reference from the Request), and objecting to dependent claims 6 and 7 as including allowable subject matter. Patent owner responded by incorporating the limitations of claim 6 into each independent claim, including claim 12, and the examiner issued a Notice of Allowance without reasons for allowance. In light of the above, it is apparent that the features of objected to claim 6 from the application were the features that the examiner deemed missing from the prior art. The limitation was added to application claim 12 (current claim 11) as underlined below:

> determining a target traffic manager based on at least a first field in the received packet, by hashing at least the first field in the received packet to obtain a hash key and employing the hash key to select the target traffic manager to which the received packet is forwarded.

For context, in the claim the above step occurs in a method of routing packets between first and second network devices over a network. After a packet is received, if the packet is from the first network device, the above occurs, and the packet is then forwarded to the target traffic manager. Other steps occur if the packet is from the second network device (hashing is not required), but the claim requires packets from the second device is forwarded to the same target traffic manager as from the first network device. In any event, as the original examiner apparently found the underlined feature to be lacking in the prior art, a reasonable examiner would consider references showing such features to be important to patentability.

Decision on the Request for Reexamination

The request for reexamination proposed that SNQs are raised by the references as in the following proposed rejections. We are only concerned with proposals where the requester provided the statutory "pertinency and manner of applying the cited art to every claim for which reexamination is requested," 35 U.S.C. § 311, therefore the SNQs are analyzed in the context of those proposals, which follow. See Request pp. i-ii:

A. Claims 11-13 are anticipated by Foundry App. Note. Request pp. 18-24.
B. Claim 12 is obvious over Foundry App. Note in view of Dietz. Request pp. 24-26.
C. Claims 11-13 are anticipated by Albert. Request pp. 26-31.
D. Claim 12 is obvious over Albert in view of Dietz. Request pp. 31-33.
E. Claims 11-13 are anticipated by Bommareddy. Request pp. 33-39.
F. Claim 12 is obvious over Bommareddy in view of Albert. Request pp. 40-41.
G. Claim 12 is obvious over Bommareddy in view of Dietz. Request pp. 41-43.
H. Claims 11-13 are anticipated by Carvey. Request pp. 43-47.
I. Claim 12 is obvious over Carvey in view of Dietz. Request pp. 48-49.
J. Claims 11-13 are anticipated by Jarvis. Request pp. 50-54.
K. Claim 12 is obvious over Jarvis in view of Dietz. Request pp. 54-56.
L. Claims 11-13 are obvious over Wolf in view of each of Shah, Carvey, Jarvis, and Foundry App. Note. Request pp. 56-66.
M. Claim 12 is obvious over Wolf in view of each of Shah, Carvey, Jarvis, and Foundry App. Note, and also in view of Dietz. Request pp. 66-68.
N. Claims 11-13 are obvious over BIG/ip Admin. in view of each of Carvey, Foundry App. Note, Jarvis, and Shah. Request pp. 68-77.
O. Claim 12 is obvious over BIG/ip Admin. in view of each of Carvey, Foundry App. Note, Jarvis, and Shah, and also in view of Dietz. Request pp. 77-79.
P. Claims 11-13 are obvious over BIG/ip Admin. in view of BIG/ip Ref. Request pp. 79-82.

<u>Proposals A and B:</u>
The Director agrees that Foundry App. Note raises an SNQ as to claims 11-13. As noted by the requester at Request pp. 7-8, Foundry App. Note at p. 2 describes using a hashing algorithm to select a firewall based on source and destination IP address and port number fields of a received packet. The algorithm is used to select the firewall to which the packet is forwarded. The '349 patent states that firewalls are traffic management devices. While there is no explicit discussion of obtaining a hash key or using such key to select the firewall, this might be deemed implicit by a person of skill in the art in using a hashing algorithm.

Foundry App. Note's teachings appear to be at least similar to the limitations deemed missing from the prior art during the original prosecution. Given these findings, along with the detailed item matching of the reference to the claims, a reasonable examiner would have found Foundry App. Note important in considering the patentability of the claims.

For the same reasons, the Director finds that an SNQ is raised as to claim 12 by Foundry App. Note in view of Dietz (Proposal B). As indicated in the Request at pp. 24-26, Dietz is provided for the teachings as to claim 12 of determining whether the received packet is from the first network device based on comparing packet header fields. The requester has at least plausibly indicated how Dietz teaches such limitations, and why the references may be combined. The importance of Foundry App. Note remains as discussed above as to the reference alone, therefore the combination of the references would likewise have been important to a reasonable examiner for the same reasons.

The Director therefore reverses the examiner's determination in the Order at pp. 8-10 that Foundry App. Note does not raise an SNQ. The examiner in denying the request focused on the finding that Foundry App. Note describes the hashing algorithm is the same in both the received and responsive directions, and states the claim language requires different algorithms. The Director disagrees. Neither the claims nor the original examiner's indicated reasons for allowance have any requirement as to the algorithm used. Even to the extent the specification might require different algorithms, the language of the claims is not so limited to the embodiments expressly shown. Finally, even if the claims were limited to the embodiments of the specification and required different algorithms, Foundry App. Note would still appear to be similar to the literal language of the material the examiner indicated as reasons for allowance, and would therefore have been important to a reasonable examiner even if a rejection might not be made. The examiner was therefore incorrect in denying these proposals as raising an SNQ.

Proposals C and D:

The Director agrees that Albert raises an SNQ as to claims 11-13. As noted by the requester at Request pp. 12-13, Albert appears to describe that a 5-tuple called an affinity key includes source and destination IP addresses and port numbers, and a protocol ID. Affinities are found by hashing, and an affinity match, which seems to be a match of the ports and protocol of the affinity key, causes the packet to be forwarded on. These teachings do not expressly match what is in the claims, but there is a good deal of similarity, in that it is determined where to forward the packet based on hashing a field of the packet. Enough similarity that a reasonable examiner would consider Albert important.

Albert's teachings appear to be at least similar to the limitations deemed missing from the prior art during the original prosecution. Given these findings, along with the detailed item matching of the reference to the claims, a reasonable examiner would have found Albert important in considering the patentability of the claims.

For the same reasons, the Director finds that an SNQ is raised as to claim 12 by Albert in view of Dietz (Proposal D). As indicated in the Request at pp. 31-33, Dietz is provided for the teachings as to claim 12 of determining whether the received packet is from the first network device based on comparing packet header fields. The requester has at least plausibly indicated how Dietz

teaches such limitations, and why the references may be combined. The importance of Albert remains as discussed above as to the reference alone, therefore the combination of the references would likewise have been important to a reasonable examiner for the same reasons.

The Director therefore reverses the examiner's determination in the Order at pp. 17-19 that Albert does not raise an SNQ. The examiner in denying the request focused on the finding that Albert describes a different algorithm than the '349 patent, and states the claim language requires particular algorithms. The Director disagrees. Neither the claims nor the original examiner's indicated reasons for allowance have any requirement as to the algorithm used. Even to the extent the specification might require different algorithms, the language of the claims is not so limited to the embodiments expressly shown. Finally, even if the claims were limited to the embodiments of the specification and required different algorithms, Albert would still appear to be similar to the literal language of the material the examiner indicated as reasons for allowance, and would therefore have been important to a reasonable examiner even if a rejection might not be made. The examiner was therefore incorrect in denying this proposal as raising an SNQ.

Proposals E, F and G:

The Director agrees that Bommareddy raises an SNQ as to claims 11-13. As noted by the requester at Request pp. 8-10, Bommareddy appears to describe a network flow controller includes a hash table storing flow information. The flow is identified using source and destination IP address and port, and it appears from the cited portions that it is the IP address that is hashed. Bommareddy further teaches the same firewall is used for incoming and outgoing traffic in a related flow, therefore a received and responsive packet will go to the same firewall. The '349 patent states that firewalls are traffic management devices. A computed index is used to identify the selected firewall from the list of firewalls, using packet information in the packet IP header. Col. 9 lines 5-21. It therefore appears that a target firewall is determined by hashing fields of the received packet.

Bommareddy's teachings appear to be at least similar to the limitations deemed missing from the prior art during the original prosecution. Given these findings, along with the detailed item matching of the reference to the claims, a reasonable examiner would have found Bommareddy important in considering the patentability of the claims.

For the same reasons, the Director finds that an SNQ is raised as to claim 12 by Bommareddy in view of Albert (Proposal F) or in view of Dietz (Proposal G). As indicated in the Request at pp. 40-43, Albert and Dietz are provided for the teachings as to claim 12 of determining whether the received packet is from the first network device based on comparing packet header fields. The requester has at least plausibly indicated how Albert or Dietz teaches such limitations, and why the references may be combined with Bommareddy. The importance of Bommareddy remains as discussed above as to the reference alone, therefore the combination of the references would likewise have been important to a reasonable examiner for the same reasons.

The Director therefore reverses the examiner's determination in the Order at pp. 10-12 that Bommareddy does not raise an SNQ, either alone or with Albert or Dietz. The examiner in denying the request focused on the finding that Bommareddy does not use the same algorithm as the '349 patent for selection of the traffic manager. The Director disagrees this is relevant here. Neither the claims nor the original examiner's indicated reasons for allowance have any requirement as to the algorithm used. Even to the extent the specification might require particular algorithms, the language of the claims is not so limited to the embodiments expressly shown. Finally, even if the claims were limited to the embodiments of the specification and required certain algorithms, Bommareddy would still appear to be similar to the literal language of the material the examiner indicated as reasons for allowance, and would therefore have been important to a reasonable examiner even if a rejection might not be made. The examiner was therefore incorrect in denying these proposals as raising an SNQ.

Proposals H and I:
The Director agrees that Carvey raises an SNQ as to claims 11-13. As noted by the requester at Request p. 10, Carvey appears to show that source and destination IP addresses and ports are extracted to form a flow identifier, which is hashed to form a route selector, which is used as an index to look up a fabric route in a fabric forwarding table, selecting a particular trunk. The requester explains why this relates to selection of "traffic managers" as claimed. Request pp. 44-45.

Carvey's teachings appear to be at least similar to the limitations deemed missing from the prior art during the original prosecution. Given these findings, along with the detailed item matching of the reference to the claims, a reasonable examiner would have found Carvey important in considering the patentability of the claims.

For the same reasons, the Director finds that an SNQ is raised as to claim 12 by Carvey in view of Dietz (Proposal I). As indicated in the Request at pp. 48-49, Dietz is provided for the teachings as to claim 12 of determining whether the received packet is from the first network device based on comparing packet header fields. The requester has at least plausibly indicated how Dietz teaches such limitations, and why the references may be combined. The importance of Carvey remains as discussed above as to the reference alone, therefore the combination of the references would likewise have been important to a reasonable examiner for the same reasons.

The Director therefore reverses the examiner's determination in the Order at pp. 12-15 that Carvey does not raise an SNQ. The examiner in denying the request focused on the finding that Carvey does not use the same algorithm as the '349 patent for selection of the traffic manager. The Director disagrees this is relevant here. Neither the claims nor the original examiner's indicated reasons for allowance have any requirement as to the algorithm used. Even to the extent the specification might require particular algorithms, the language of the claims is not so

limited to the embodiments expressly shown. Finally, even if the claims were limited to the embodiments of the specification and required certain algorithms, Carvey would still appear to be similar to the literal language of the material the examiner indicated as reasons for allowance, and would therefore have been important to a reasonable examiner even if a rejection might not be made. The examiner was therefore incorrect in denying these proposals as raising an SNQ.

Proposals J and K:
The Director agrees that Jarvis raises an SNQ as to claims 11-13. As noted by the requester at Request p. 11, Jarvis appears to show that source and destination addresses and ports are hashed to determine a hash bin, which is mapped to a path, and the packet is routed to this path and to a next hop router, and the third party explains this disclosure of Jarvis (and why it meets a traffic manager) at Request p. 51.

Jarvis's teachings appear to be at least similar to the limitations deemed missing from the prior art during the original prosecution. Given these findings, along with the detailed item matching of the reference to the claims, a reasonable examiner would have found Jarvis important in considering the patentability of the claims.

For the same reasons, the Director finds that an SNQ is raised as to claim 12 by Jarvis in view of Dietz (Proposal K). As indicated in the Request at pp. 54-56, Dietz is provided for the teachings as to claim 12 of determining whether the received packet is from the first network device based on comparing packet header fields. The requester has at least plausibly indicated how Dietz teaches such limitations, and why the references may be combined. The importance of Jarvis remains as discussed above as to the reference alone, therefore the combination of the references would likewise have been important to a reasonable examiner for the same reasons.

The Director therefore reverses the examiner's determination in the Order at pp. 15-17 that Jarvis does not raise an SNQ. The examiner in denying the request focused on the finding that Carvey does not use the same algorithm as the '349 patent for selection of the traffic manager. The Director disagrees this is relevant here. Neither the claims nor the original examiner's indicated reasons for allowance have any requirement as to the algorithm used. Even to the extent the specification might require particular algorithms, the language of the claims is not so limited to the embodiments expressly shown. Finally, even if the claims were limited to the embodiments of the specification and required certain algorithms, Jarvis would still appear to be similar to the literal language of the material the examiner indicated as reasons for allowance, and would therefore have been important to a reasonable examiner even if a rejection might not be made. The examiner additionally looked at other limitations of the claims which Jarvis allegedly does not disclose. Even if the examiner is correct, which the Director does not decide, this would go toward whether a rejection can be made, not whether an SNQ is raised, and the above findings are sufficient to show an SNQ is raised. The examiner was therefore incorrect in denying these proposals as raising an SNQ.

Proposals L and M:
First, the proposals are somewhat confusing in that they rely on four secondary references to teach the same limitation, thus it may be arguable whether this is a grouping of four alternative rejections, or one rejection involving five references. That is, the Director must clarify whether the rejection purports to rely on any one of Shah, Carvey, Jarvis, or Foundry App. Note, or whether it relies on all of these references together. The intent is clearly the latter. When the third party wanted to rely on references alternatively, it provided separate proposals, such as proposals F and G. Furthermore, Shah is relied upon for teaching of limitations additional to the limitation common to the other references; thus Shah would appear to be essential to the proposed rejection, therefore it would not be used alternatively. Additionally, if the proposal were grouping four alternative rejections together, it would render the request improper in accordance with MPEP § 2617(I) due to lumping of rejections. The third party clearly intends all of the references to be a part of the proposed rejection.

The Director agrees that the combination of Wolf with each of Shah, Carvey, Jarvis, and Foundry App. Note raises an SNQ as to claims 11-13. As shown in the third party's discussion of the proposed rejection, Request pp. 56-62, Wolf appears to teach that packet header information is used to determine the flow to which the packet belongs, and to which network processor (traffic manager) to send the packet. The third party admits that Wolf does not explicitly disclose determining the traffic manager based in part on hashing a first field in the received packet to determine a hash key to select the target traffic managers. Request p. 58. The third party does, however, explain why each of Shah, Carvey, Jarvis, and Foundry App. Note teach such a limitation, and the Director generally agrees that these references appear to teach such a limitation. See Request pp. 58-60.

The combination of Wolf with Shah, Carvey, Jarvis, and Foundry App. Note therefore appears to provide teachings at least similar to the limitations deemed missing from the prior art during the original prosecution. Given these findings, along with the detailed item matching of the references to the claims, a reasonable examiner would have found this combination of references important in considering the patentability of the claims.

For the same reasons, the Director finds that an SNQ is raised as to claim 12 by these references in view of Dietz (Proposal M). As indicated in the Request at pp. 66-68, Dietz is provided for the teachings as to claim 12 of determining whether the received packet is from the first network device based on comparing packet header fields. The requester has at least plausibly indicated how Dietz teaches such limitations, and why the references may be combined. The importance of the other references remains as discussed above, therefore the combination with Dietz would likewise have been important to a reasonable examiner for the same reasons.

The Director therefore reverses the examiner's determination in the Order that the references do not raise an SNQ. The examiner again focuses on whether the hashing algorithm of the references is the same as that in the '349 patent, and similar to the other proposals the Director again points out that the particular algorithm is not a part of the claims. The examiner's finding is reversed for similar reasons as the other proposals discussed above.

Proposals N, O, and P:
The Director agrees that BIG/ip Admin raises an SNQ as to claims 11-13 when combined with each of Shah, Carvey, Jarvis, and Foundry App. Note (Proposal N), and further when combined with Dietz (Proposal O, claim 12), or when combined only with BIG/ip Ref (Proposal P claims 11-13).

The Director agrees that the combination of BIG/ip Admin. with each of Shah, Carvey, Jarvis, and Foundry App. Note raises an SNQ as to claims 11-13. As shown in the third party's discussion of the proposed rejection, Request pp. 69-74, BIG/ip Admin. appears on its face to teach most of the limitations of the claims. The reference also appears to generally determine a traffic manager based on fields of a received packet, and it describes hashing of a cookie, though it is not apparent the cookie is the same as a first field in the received packet as claimed. The third party does, however, explain why each of Shah, Carvey, Jarvis, and Foundry App. Note teach such a limitation, and the Director generally agrees that these references appear to teach such a limitation. See Request pp. 71-73.

The combination of BIG/ip Admin. with Shah, Carvey, Jarvis, and Foundry App. Note therefore appears to provide teachings at least similar to the limitations deemed missing from the prior art during the original prosecution. Given these findings, along with the detailed item matching of the references to the claims, a reasonable examiner would have found this combination of references important in considering the patentability of the claims.

For the same reasons, the Director finds that an SNQ is raised as to claim 12 by these references in view of Dietz (Proposal O). As indicated in the Request at pp. 77-79, Dietz is provided for the teachings as to claim 12 of determining whether the received packet is from the first network device based on comparing packet header fields. The requester has at least plausibly indicated how Dietz teaches such limitations, and why the references may be combined. The importance of the other references remains as discussed above, therefore the combination with Dietz would likewise have been important to a reasonable examiner for the same reasons.

In proposal P, BIG/ip Ref. is merely provided as yet another reference that teaches hashing source or destination information to determine a hash key used to select a target traffic manager. BIG/ip Ref. does appear to hash a cookie value, and the cookie is defined using source and destination IP address and port information, i.e. fields of the packet. Combining this reference

with BIG/ip Admin. would therefore be important to patentability for the same reasons as the references provided in proposal N above.

The Director therefore reverses the examiner's determination in the Order that the references do not raise an SNQ. The examiner again focuses on whether the hashing algorithm of the references is the same as that in the '349 patent, and similar to the other proposals the Director again points out that the particular algorithm is not a part of the claims. The examiner's finding is reversed for similar reasons as the other proposals discussed above.

The teachings of the references discussed herein, whether alone or in the described combinations, are not cumulative to any written discussion on the record of the teachings of the prior art, were not previously considered nor addressed during a prior examination, and the same question was not the subject of a final holding of invalidity in the Federal Courts.

Accordingly, the petition is granted.

CONCLUSION

1. Based on a *de novo* review of the record as a whole, the petition is granted. Accordingly, the request for *inter partes* reexamination of claims 11-13 of the '349 patent is granted.

2. The decision is final and non-appealable. See 35 U.S.C. § 312(c) and 37 C.F.R. § 1.927. No further communication on this matter will be acknowledged or considered.

3. In accordance with this decision, an Office action on the merits will issue in due course.

4. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.

Irem Yucel
Director, Central Reexamination Unit

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CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

In re: Amdahl *et al.*
Inter Partes Reexamination Proceeding
Control No.: 95/001,511
Deposited: December 13, 2010
For: U.S. Patent No.: 7,102,996

DECISION ON PETITION UNDER 37 CFR §§ 1.927 & 1.181

This is a decision on the petition filed by the third party requester on March 10, 2011, entitled "PETITION UNDER 37 C.F.R § 1.927 TO REVIEW THE EXAMINER'S REFUSAL TO ORDER *INTER PARTES* REEXAMINATION" [hereinafter "the petition"]. Petitioner, the reexamination requester, seeks review of the Order Denying the Request for *Inter Partes* Reexamination mailed February 10, 2011, which denied the request for reexamination of claims 1-3, 12, 13, 17, 19, 20 and 33 of U.S. Patent No. 7,102,996.

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

The petition is granted.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,102,996 issued on September 5, 2006.
- A request for *inter partes* reexamination was filed December 13, 2010 and assigned control no. 95/001,511. The third party requester proposed that a substantial new question of patentability was raised with respect to claims 1-3, 12, 13, 17, 19, 20 and 33 by a number of prior art references
- The examiner denied the request in a determination mailed February 10, 2011.[1]
- The instant petition was timely filed on March 10, 2011. The petition requests reconsideration and reversal of the examiner's determinations that the proposed combinations of references failed to raise substantial new questions of patentability.

DECISION

Standard of Review

37 CFR § 1.927 provides for the filing of a petition under 37 CFR § 1.181 to review an examiner's determination refusing to order *inter partes* reexamination. The CRU Director's review on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for denying the request.

The Legal Standard for Ordering Reexamination

A review of 35 U.S.C. §§ 311 and 312 reveals that, by statute, *inter partes* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. 35 U.S.C. § 311 requires that a request for *inter partes* reexamination be based upon prior art as set forth in 35 U.S.C. § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.915(b)(3) requires that a request for *inter partes* reexamination include "A statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of

[1] An earlier denial was mailed January 31, 2011, but used the form for *ex parte* reexaminations. The re-mailing on February 10th was likely to correct this as there seem to be no other changes. February 10th is taken as the date of the determination, therefore the petition is timely.

patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final court holding of invalidity after all appeals, or by the Office in an earlier examination or in a reexamination of a patent. That is, the requester must "demonstrate[] that a patent or printed publication that is relied upon in a proposed rejection presents a new, non-cumulative technical teaching that was not previously considered and discussed on the record during the prosecution of the application that resulted in the patent for which reexamination is requested, and during the prosecution of any other prior proceeding involving the patent." MPEP § 2616. If a substantial new question of patentability is found to be raised, an order granting *inter partes* reexamination of the patent is issued.

Summary of the Prior Prosecution with Respect to the '996 Patent, and Claim Construction

The '996 patent contains 33 claims. The application as filed included claims 1-34. In a first Office action claim 33 was rejected over prior art to Datta, and claims 1-32 and 34 were allowed. In response, patent owner cancelled claim 33 and the examiner issued a notice of allowance, renumbering claim 34 as 33. Reasons for allowance were given only in the first action, where the examiner stated:

> [T]he prior art fails to teach a combination of:
> if the packet includes a source address that is associated with a first set of addresses, forwarding the packet to a first traffic manager that is selected using a destination address of the packet, and
> if the packet includes a destination address that is associated with a second set of addresses, forwarding the packet to a second traffic manager that is selected using a source address of the packet,
> wherein the first traffic manager and the second traffic manager are the same for each packet in a flow between two network devices.

It is noted that claim 12 uses slightly different language (when rather than if), but the Director agrees with the district court that the limitations should be construed in the same way because they are saying basically the same thing to describe the same operation. *See* F5 Networks Inc. v. A10 Networks Inc., Order on Claim Construction, 2:10-cv-00654 at 8-11 (W.D. Wash. 7/8/2011) (filed in this proceeding 7/15/2011) (hereinafter "D.Ct. Claims"). While the use of different language does imply that different meanings were intended, there is no evidence that there actually are different meanings in this case.

As to the quoted reasons for allowance, it is an open question whether the material in the reasons for allowance requires a determining step. That is, when the claim says "if X, Y" does the claim actually require the device to determine whether X occurs before deciding to do Y? Must the device check the packet source and destination addresses to determine whether they are associated with a set of addresses, before forwarding? Or is it enough that Y simply occurs whenever X is true, whether the system determined X was true or not?

The district court appears to have found that a determining step is implicitly required in the claim language. *See* D.Ct. Claims p. 10. The Director disagrees, and finds no such determining step in the claim language at present. The claim term "If X, Y" does not necessarily mean "Determine if X, and if so, do Y." It could merely mean "If X is the case, whether we have determined it or not, do Y." And the Director finds that this is the claim construction of these "if" statements, at least at present in this proceeding for the purpose of determining whether an SNQ is present.

First, it should be made clear that this is not a finding that the district court's findings were incorrect. The Office and the courts operate under different standards of claim construction, and may come to different and inconsistent conclusions that are nonetheless both correct under their respective standards. *See In re Trans Texas Holdings Corp.*, 498 F.3d 1290, 83 USPQ2d 1835 (Fed. Cir. 2007); *In re Translogic Technology, Inc.*, 504 F.3d 1249, 84 USPQ2d 1929 (Fed. Cir. 2007). The broader construction herein is consistent with that principal and with the Office's broader claim construction than that used in the courts. Additionally, the court stated "[t]his finding is based on the testimony of experts from both sides," D.Ct. Claims p. 10, and it is important that no such testimony is currently before the Office. The Office might change the claim construction later in light of further testimony or evidence.

Finally, a determination that an SNQ is present is not the same as a determination that the claims are *prima facie* unpatentable. *See* MPEP § 2640. If the references read on the literal claim language that the original examiner found was missing from the prior art, this may be sufficient to raise an SNQ, even if the examiner ultimately finds that the claims have additional implicit requirements that prevent a particular rejection from being proper. The Director's findings herein do not prevent the examiner from determining during the prosecution stage that there are additional implicit requirements of the claims that prevent a *prima* facie case of unpatentability.

The reason the Director brings up this point is that it may be considered important to patentability by a reasonable examiner. Some of the cited references appear to select a traffic manager based on source and destination address in all cases. For example, Foundry App. Note merely states that "ServerIron uses a configurable hashing algorithm to select a firewall based on the source IP address, source port number, destination IP address and destination port number." Foundry App. Note p. 2. There is no determination as to the "if" statements, as there is no determination whether the source/destination address is associated with a first/second set of addresses. But in any event the "then" parts each appear to occur in all cases, as the traffic

manager is selected using a destination and source address, in all cases. As the "then" portions occur in all cases, they necessarily occur whenever the "if" statement is true. That they may also occur when the "if" statements are not true is not germane to the literal claim language.

Other references do not use the source and destination addresses to select a traffic manager in all cases. Thus, we cannot merely say that the "then" statements are always met, and are necessarily met whenever the "if" is satisfied. In such references we would actually need a disclosure of the "then" occurring when the "if" is satisfied, if we are to find the reference meets the claim.

The original examiner did not state whether the claims required a determination as to whether the "if" part of the claims occurred; it was merely found that the entirety of each "if then" statement was not in the prior art. Thus, if the references appear to teach the literal claim language, regardless of any implicit determination, such references would have been important in considering the patentability of the claims.

Other references do not use the source and destination addresses to select a traffic manager in all cases. Thus, we cannot merely say that the "then" statements are always met, and are necessarily met whenever the "if" is satisfied. In such references we would actually need a disclosure of the "then" occurring when the "if" is satisfied, if we are to find the reference meets the claim.

It is furthermore noted that rejected original claim 33 was drawn to an apparatus for distributing packet flows including less detailed steps than in the other claims, but did require that the destination traffic manager is the same for each packet in a flow between two network devices. Merely showing this would therefore not be enough to raise a new question of patentability, the other requirements as quoted above (i.e. the if-then statements) are also needed.

Decision on the Request for Reexamination

The request for reexamination proposed that SNQs are raised by the references as in the following proposed rejections. We are only concerned with proposals where the requester provided the statutory "pertinency and manner of applying the cited art to every claim for which reexamination is requested," 35 U.S.C. § 311, therefore the SNQs are analyzed in the context of those proposals, which follow. See Request pp. i-ii:

A. Claims 1-3, 12, 13, 17, 19, 20 and 33 are anticipated by Foundry App. Note. Request pp. 16-38.
B. Claims 1-3, 12, 13, 17, 19, 20 and 33 are anticipated by Albert. Request pp. 38-51.
C. Claims 1-3, 12, 13, 17, 19, 20 and 33 are anticipated by Bommareddy Request pp. 51-67.
D. Claims 1-3, 12, 13, 17, 19, 20 and 33 are anticipated by Carvey. Request pp. 67-81.
E. Claim 20 is obvious over Carvey in view of Zisapel. Request pp. 81-84.
F. Claims 1-3, 12, 13, 17, 19, 20 and 33 are anticipated by Jarvis. Request pp. 84-98.

G. Claim 20 is obvious over Jarvis in view of Zisapel. Request pp. 98-102.
H. Claims 1, 12, 17, 19, 20 and 33 are obvious over Wolf in view of Shah. Request pp. 102-117.
I. Claims 2, 3 and 13 are obvious over Wolf in view of each of Shah, Carvey, Jarvis and Foundry App. Note. Request pp. 117-124.
J. Claim 20 is obvious over Wolf in view of Shah and further in view of Zisapel. Request pp. 124-127.
K. Claims 1, 12, 17, 19, 20 and 33 are anticipated by BIG/ip Admin. Request pp. 127-140.
L. Claims 2, 3 and 13 are obvious over BIG/ip Admin. in view of each of Carvey, Foundry App. Note, Jarvis, and Shah. Request pp. 140-146.
M. Claims 2, 3 and 13 are obvious over BIG/ip Admin. in view of BIG/ip Ref. Request pp. 146-148.

Proposal A:
The Director agrees that Foundry App. Note raises an SNQ as to the claims. The third party argues at Request p. 7 that the reference discloses the subject matter quoted above from the examiner's reasons for allowance. The third party argues that page 2 of the Foundry App. Note teaches these features when it says "ServerIron uses a configurable hashing algorithm to select a firewall based on the source IP address, source port number, destination IP address and destination port number. ServerIron-A and ServerIron-B use the same algorithm to ensure that all packets for a given TCP connection flow through the same firewall . . . ." Foundry App. Note p. 2, quoted in Request p. 7.

The Director agrees that this appears to teach the limitations that were deemed missing during the original prosecution. The traffic manager is selected using a destination address of the packet as well as the source destination of the packet, apparently in all cases, therefore the "then" requirements necessarily occur whenever the "if" statements are true. It is stated the selected firewall is the same for each packet of the flow. Assuming there is no "determining" requirement as to the "if" statements, as described herein, the reference teaches what was missing during the original prosecution. Given these findings, along with the detailed item matching of the reference to the claims, a reasonable examiner would have found Foundry App. Note important in considering the patentability of the claims.

The Director therefore reverses the examiner's determination in the Order at pp. 9-11 that Foundry App. Note does not raise an SNQ. The examiner in denying the request focused on the finding that Foundry App. Note does not use the same attributes as the '996 patent in its hashing algorithm, and that Foundry App. Note does not perform the "associat[ing]" steps of the claims. While this may be true, and may go toward whether the reference renders the claims unpatentable, the reference does appear to read on the literal claim language, as construed herein. This is sufficient, the Director finds, to show that Foundry App. Note would have been important to a reasonable examiner in considering patentability, therefore the examiner was incorrect in denying this proposal as raising an SNQ.

Proposal B:
The Director agrees that Albert raises an SNQ as to the claims. The third party argues at Request p. 8 that the reference discloses the subject matter quoted above from the examiner's reasons for allowance. It is clear from the quoted sections that Albert determines whether the source address and destination address of a packet are associated with a set of addresses; each are so tested to see if they match the wildcard affinity. It is not entirely clear, after such test of the source and destination address of the packet, whether the destination or source address, respectively is used to select a traffic manager as claimed. It appears that forwarding is done due to an affinity. Does that mean that the source and destination are "used?" Again, it is not entirely clear, but Albert does indicated that the affinity is a 5-tuple including the source and destination address, thus it may very well be the case. At the very least this requires further consideration, but it is similar enough to what is claimed that a reasonable examiner would find Albert important when considering patentability of the claims.

The Director therefore reverses the examiner's determination in the Order at pp. 11-14 that Albert does not raise an SNQ. The examiner in denying the request focused on the finding that Albert does not use the same algorithm as the '996 patent and does not perform certain determinations that are not included in the claims. The focus on what was not claimed, in light of the above findings, leads the Director to conclude the examiner was incorrect in denying this proposal as raising an SNQ.

Proposal C:
The Director agrees that Bommareddy raises an SNQ as to the claims. The third party argues at Request p. 9 that the reference discloses the subject matter quoted above from the examiner's reasons for allowance. The third party argues that Bommareddy teaches the material in two sentences: "[B]oth the internal and the external network flow controller units 110 and 112 use the source and destination IP address and port to identify the client-server-flow." Col. 8 lines 57-60. "[F]or any given client-server connection flow, the same firewall is used by both the internal and external network flow controller units for every inbound and outbound packet . . . ." Col. 9 lines 13-16. Furthermore, a computed index is used to identify the selected firewall from the list of firewalls, using packet information in the packet IP header. Col. 9 lines 5-21.

The Director agrees that this appears to teach the limitations that were deemed missing during the original prosecution. The traffic manager is selected using a destination address of the packet as well as the source destination of the packet, apparently in all cases, therefore the "then" requirements necessarily occur whenever the "if" statements are true. It is stated the selected firewall is the same for each packet of the flow. Assuming there is no "determining" requirement as to the "if" statements, as described herein, the reference teaches what was missing during the original prosecution. Given these findings, along with the detailed item

matching of the reference to the claims, a reasonable examiner would have found Bommareddy important in considering the patentability of the claims.

The Director therefore reverses the examiner's determination in the Order at pp. 15-16 that Bommareddy does not raise an SNQ. The examiner in denying the request focused on the finding that Bommareddy does not use the same attributes as the '996 patent in its hashing algorithm, and that Bommareddy does not use a table to determine the algorithm. While this may be true, the particular algorithm is not a part of the claims, and the reference does appear to read on the literal claim language, as construed herein. This is sufficient, the Director finds, to show that Bommareddy would have been important to a reasonable examiner in considering patentability, therefore the examiner was incorrect in denying this proposal as raising an SNQ.

Proposals D and E:
The Director agrees that Carvey raises an SNQ as to the claims. The third party argues at Request p. 10 that the reference discloses the subject matter quoted above from the examiner's reasons for allowance. As cited by the third party, the reference appears to show that source and destination IP addresses and ports are extracted to form a flow identifier, which is hashed to form a route selector, which is used as an index to look up a fabric route in a fabric forwarding table, selecting a particular trunk which goes to the next hop router (traffic manager), and also explains that all packets of the same flow go to the same trunk, which leads to the router. See Request pp. 68-70.

The Director agrees that this appears to teach the limitations that were deemed missing during the original prosecution. While the selection is not direct, the claims do not preclude intermediate steps. It appears that the source and destination addresses of the packet are always used to form the flow identifier, therefore they are always used in the selection of the traffic manager. The "then" requirements therefore necessarily occur whenever the "if" statements are true. It is stated the selected trunk is the same for each packet of the flow, implying that the next hop router, the traffic manager, is always the same for a flow. Assuming there is no "determining" requirement as to the "if" statements, as described herein, the reference teaches what was missing during the original prosecution. Given these findings, along with the detailed item matching of the reference to the claims, a reasonable examiner would have found Carvey important in considering the patentability of the claims.

For the same reasons, the Director finds that an SNQ is raised as to claim 20 by Carvey in view of Zisapel (Proposal E). As indicated in the Request at pp. 81-84, Zisapel is provided for the teachings as to claim 20 that the first/second traffic manager chooses a server to receive the packet. The requester has at least plausibly indicated how Zisapel teaches such limitations, and why the references may be combined. The importance of Carvey remains as discussed above as to the reference alone, therefore the combination of the references would likewise have been important to a reasonable examiner for the same reasons.

The Director therefore reverses the examiner's determination in the Order at pp. 16-18 that Carvey does not raise an SNQ. The examiner in denying the request focused first on the finding that Carvey does not use the same algorithm as the '996 patent for selection of the traffic manager. The Director disagrees this is relevant here. Other than what has been discussed herein, neither the claims nor the original examiner's indicated reasons for allowance have any requirement as to the algorithm used, and the Director has explained why Carvey may be considered to show what is in the claim. The examiner additionally stated that the third party does not indicate what element is the traffic manager, and that Carvey's network router is not selected using a destination address or source address of the packet. The Director disagrees. On, for example, p. 68 of the Request, the third party indicates that the routers are traffic managers, i.e. the next hop router. The third party further discusses how the source and destination addresses are used to form a flow identifier, which is hashed to form a route selector, which is used to lookup a fabric route, which selects a trunk, which goes to the next hop router. While there are a number of intermediate steps, it would seem the addresses ultimately are used to select the next hop router, even if several other selections occur in between, and the claims do not preclude other intermediate steps when all they require are that the manager is "selected using" the addresses. This is sufficient, the Director finds, to show that Carvey would have been important to a reasonable examiner in considering patentability, therefore the examiner was incorrect in denying these proposals as raising an SNQ.

Proposals F and G:

The Director agrees that Jarvis raises an SNQ as to the claims. The third party argues at Request p. 11 that the reference discloses the subject matter quoted above from the examiner's reasons for allowance. As cited by the third party, the reference appears to show that packets are routed to a path via a hash function depending only on source and destination IP addresses ((S,D) pair), and the resulting hash bin is mapped to a path. The hash function gives the same result for a given (S,D) pair, therefore each packet in a flow goes to the same path. The third party says the path leads to a next hop router, a traffic manager.

The Director agrees that this appears to teach the limitations that were deemed missing during the original prosecution. It appears that the source and destination addresses of the packet are always used as part of the hash function to select a path, therefore they are always used in the selection of the traffic manager. The "then" requirements therefore necessarily occur whenever the "if" statements are true. It is stated that all packets in a session take the same path, thus going through the same routers. While it is not explicitly stated that routers are selected, one might consider it inherent that there are routers along the path, as indicated by the third party, therefore selection of the same path is implicitly selection of the same next hop router (i.e. traffic manager). Assuming there is no "determining" requirement as to the "if" statements, as described herein, the reference teaches what was missing during the original prosecution. Given

these findings, along with the detailed item matching of the reference to the claims, a reasonable examiner would have found Jarvis important in considering the patentability of the claims.

For the same reasons, the Director finds that an SNQ is raised as to claim 20 by Jarvis in view of Zisapel (Proposal G). As indicated in the Request at pp. 98-102, Zisapel is provided for the teachings as to claim 20 that the first/second traffic manager chooses a server to receive the packet. The requester has at least plausibly indicated how Zisapel teaches such limitations, and why the references may be combined. The importance of Jarvis remains as discussed above as to the reference alone, therefore the combination of the references would likewise have been important to a reasonable examiner for the same reasons.

The Director therefore reverses the examiner's determination in the Order at pp. 19-20 that Jarvis does not raise an SNQ. The examiner in denying the request focused first on the finding that Jarvis does not use the same algorithm as the '996 patent for selection of the traffic manager. The Director disagrees this is relevant here. Other than what has been discussed herein, neither the claims nor the original examiner's indicated reasons for allowance have any requirement as to the algorithm used, and the Director has explained why Jarvis may be considered to show what is in the claim. The examiner additionally stated that the third party does not indicate what element is the traffic manager, that Jarvis does not teach the "associated with [i.e. the "if" statements]" steps, and that Jarvis fails to show using a destination address or source address of the packet to select a traffic manager. The Director disagrees. The "if" portions do not require a determination step, and to the extent the "then" portions are always true, they necessarily occur whenever the if portion is true, as described further herein. The Director has already explained above how the requester indicates what is the traffic manager, and how it is selected "using" the source and destination addresses. The above description is sufficient, the Director finds, to show that Jarvis would have been important to a reasonable examiner in considering patentability, therefore the examiner was incorrect in denying these proposals as raising an SNQ.

<u>Proposals H, I and J:</u>
The Director agrees that the combination of Wolf and Shah raises an SNQ as to the claims as in proposal H. As described in the proposed rejection at Request pp. 102-106, Wolf appears to teach forwarding traffic to a network processor of a router using the packet header. Shah further teaches that packets are assigned to a hash bucket using a 4-tuple as a key to performing a hash function. The 4-tuple includes source and destination address. Shah also states that all packets in a connection are assigned to the same bucket.

The Director agrees that this appears to teach the limitations that were deemed missing during the original prosecution. It appears that Wolf teaches the basic principle of using a packet header to route a packet to a traffic manager. Shah further teaches the source and destination addresses of the packet are always used as part of the hash function to determine the hash bucket for routing, and the hash bucket is always the same in a particular connection. As Wolf uses the

header for routing, and Shah indicates that the use of the header involves using the source and destination address in hashing, this would indicate, using the combined teachings of the references, that the source and destination addresses are always used for selecting a traffic manager to which the packet is forwarded. If all packets in a connection are assigned to the same bucket, then it would seem the first and second traffic managers would be the same. The "then" requirements of the claims therefore necessarily occur whenever the "if" statements are true. Assuming there is no "determining" requirement as to the "if" statements, as described herein, the reference teaches what was missing during the original prosecution. Given these findings, along with the detailed item matching of the reference to the claims, a reasonable examiner would have found Wolf and Shah important in considering the patentability of the claims.

For the same reasons, the Director finds that an SNQ is raised as to claims 2, 3 and 13 by adding Carvey, Jarvis and Foundry App. Note to the references (Proposal I) and as to claim 20 by adding Zisapel (Proposal J). As indicated in the Request at pp. 117-124, Carvey, Jarvis and Foundry App. Note are provided for their teachings that "using" the source or destination address includes hashing it to obtain a value used for forwarding, and as shown at Request pp. 124-127, Zisapel is provided for the teachings as to claim 20 that the first/second traffic manager chooses a server to receive the packet. The requester has at least plausibly indicated how these references teach such limitations, and why the references may be combined. The importance of Wolf and Shah remain as discussed above as to those references alone, therefore the combination of the references would likewise have been important to a reasonable examiner for the same reasons.

The Director therefore reverses the examiner's determination in the Order at pp. 20-23 that the combination of Wolf and Shah does not raise an SNQ. The examiner in denying the request focused first on the teachings of Wolf individually. This was not necessarily incorrect given the manner that the third party presented the request, and the Director agrees that Wolf alone fails to raise an SNQ as stated in the next paragraph. But all proposed rejections involving Wolf relied on a combination of Wolf with Shah, therefore it is more relevant to consider the combined teachings of Wolf and Shah when considering whether an SNQ is raised. As described above, this combination does raise an SNQ. As to Shah, the examiner appears to have found that Shah does not disclose the limitations of the claims, though it is not entirely clear why. The Director disagrees for the reasons described in this section, and finds that such description is sufficient to show that the combination of Wolf and Shah would have been important to a reasonable examiner in considering patentability. The examiner was incorrect in denying these proposals as raising an SNQ.

Note that Wolf alone does not raise an SNQ. As to Wolf, the third party has only alleged (at Request p. 12) the new technological teaching is that the first and second traffic manager are the same for each packet in a flow. This teaching was already present during the original prosecution as shown in the rejection of original claim 33. But in any event, Wolf is only

applied against the claims in combinations with Shah, and as described above the combination of Wolf and Shah does raise an SNQ.

Proposals K, L and M:
The Director does not agree that BIG/ip Admin. raises an SNQ as to the claims. The third party argues at Request pp. 14-15 that the reference discloses the subject matter quoted above from the examiner's reasons for allowance. The third party argues that the reference teaches these features as follows:

> Typical criteria that you define in IP filters are packet source IP addresses, packet destination IP addresses, and upper-layer protocol of the packet . . . . You can filter traffic going to a specific destination or coming from a specific destination, or both.
>
> When the destination address on the packet is a virtual server, [i.e. incoming packet] then the interface routes the packet to the Node that is handling the connection that the packet is a part of, picking one if necessary.
>
> When a packet arrives that is destined for a virtual server [i.e. incoming packet] that does not match a current connection, the BIG/ip Controller can select a pool by evaluating a virtual server rule to pick a node pool . . . . You can also use the client_addr variable to select a pool. You can use this variable to load balance connections based on part of the client's address.
>
> In situations where the BIG/ip Controller accepts connections for virtual servers from more than one router, you can send the return data back through the same device from which the connection originated. You can use this option to spread the load among outbound routers, or to ensure the connections go through the same device if that device is connection-oriented, such as a proxy, cache, firewall, or VPN router.

BIG/ip Admin pp. 2-7, 2-23, 3-7 to 3-8, 8-7 (quoted in Request pp. 14-15)

BIG/ip Admin discloses, in the first paragraph quoted above, that you can set up IP filters. The filter can allow network traffic through or reject traffic, and the filter can be defined using specified criteria, including packet source IP address and packet destination IP address. It is apparent that this can be a disclosure of (1) "if the packet includes a source address that is associated with a first set of addresses, forwarding the packet . . ." and (2) "if the packet includes a destination address that is associated with a second set of addresses, forwarding the packet . . ."

What is not clear though is what happens after the filtering and forwarding. That is, is the packet forwarded to a traffic manager, and how is that traffic manager selected? Recall the claims require that if (1) above is satisfied, the traffic manager is selected using a destination address of

the packet, and if (2) above is satisfied, the traffic manager is selected using a source address of the packet. The description at p. 2-7 says nothing of this.

The third party moves on to p. 2-23, the second paragraph quoted above, which discusses an entirely different feature of the system, interfaces, that do not appear to be related to filters. In any event, it is not clear what the third party is saying is taught in this paragraph. All it says is, if the packet destination is a virtual server, route the packet to the Node of the connection, picking one if necessary. But it is not said how the Node is picked, if it is done by using a source or destination address as required in the claims. Again, this is at best a disclosure of "if the packet includes a destination address that is associated with a second set of addresses, forwarding the packet . . ." There is nothing about what is used to select a traffic manager.

The third party then moves on to the next chapter, a section regarding the selection of a load balancing pool using a rule, at pp. 3-7 to 3-8. The creative use of ellipses, linking one sentence to another a page away in the quotation, is noted. In any case, the first sentence tells us that when a packet destined for a virtual server does not match a current connection, select a pool using a rule; the second sentence says a rule can be use source address to pick a pool. This combination could be considered "if the packet includes a destination address that is associated with a second set of addresses, selecting a pool using a source address of the packet."

First, it is not at all clear that a pool can be considered a traffic manager. The '996 patent is quite broad in defining the term, col. 10 line 55 – col. 11 line 29, and it is any device that manages traffic. A pool is certainly *a group of* traffic managers, but it is not clear that a pool *is* a traffic manager.[2] There is no indication in the cited portions that any particular member of the pool is selected, just the pool. It is not stated, in these cited sections, how the particular node in the pool is selected. Perhaps selecting a pool is enough, and then the particular node is selected at random? A particular node would not then be "selected" as claimed. The point is, the third party has not told us how a traffic manager is selected.

Additionally, even if this was sufficient, this description tells us nothing about the other if-then statement of the claims. There is no selection of a traffic manager using a destination address of the packet, if the packet includes a source address associated with a set of addresses. Recall that in references like Foundry App. Note, a traffic manager was always selected using both source and destination addresses, therefore the then statement was always satisfied. Here, that does not appear to be the case, therefore we need to know what happens if the source address is associated with a first set, as claimed. But we have no such disclosure, at all, therefore we do not have a disclosure of the material that was missing during the original prosecution.

---

[2] This is akin to, if you asked me to select a USPTO employee and I selected "Central Reexamination Unit." The CRU is not an employee, and a group of traffic managers is not a traffic manager.

The final paragraph quoted above was cited for the proposition that the selected traffic manager could be the same for each packet in a flow. This tells us nothing further about the if-then statements.

Additionally, in the body of the proposed rejection, the third party cites to Fig. 8.3 and pp. 8-13 to -14 as teaching the "if-then" statements through its disclosure of using destination processing. The Director disagrees. There is no teaching of using the destination address to select a node. The third party appears to argue that the evaluation of whether the destination address is part of an existing connection is the "use" of the destination address. The Director disagrees, as mere evaluation of the address is not using it. It is the use of the fact of whether there is a connection, not a use of the underlying address.

Given the lack of teachings, a reasonable examiner would not find BIG/ip Admin important in considering the patentability of the claims.

For the same reasons, the combinations with the various references in Proposals L and M do not raise an SNQ. These references are not provided in a way that remedies the problems in BIG/ip Admin. described above. That is, any SNQ in these proposals is based on BIG/ip Admin. raising an SNQ. Even if some of these references independently raise an SNQ, they are only provided here for their teachings as to dependent claims. There is no provided reasoning as to how or why they would additionally be combined with BIG/ip Admin. to show the features missing during the original prosecution, and the Director declines to find any such reasoning. No SNQ is raised in proposals K, L and M.

The teachings of the references discussed herein, whether alone or in the described combinations, are not cumulative to any written discussion on the record of the teachings of the prior art, were not previously considered nor addressed during a prior examination, and the same question was not the subject of a final holding of invalidity in the Federal Courts.

Accordingly, while some proposals are denied herein, all requested claims are ordered for reexamination, therefore the petition is granted.

CONCLUSION

1. Based on a *de novo* review of the record as a whole, the petition is granted. Accordingly, the request for *inter partes* reexamination of claims 1-3, 12, 13, 17, 19, 20 and 33 of the '996 patent is granted.

2. The decision is final and non-appealable. See 35 U.S.C. § 312(c) and 37 C.F.R. § 1.927. No further communication on this matter will be acknowledged or considered.

3. In accordance with this decision, an Office action on the merits will issue in due course.

4. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.

Irem Yucel
Director, Central Reexamination Unit

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EXAMINER

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Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001515
PATENT NO. : 6401415
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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CENTRAL REEXAMINATION UNIT

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In re Eugenio Cruz Garcia	:
Reexamination Proceeding	: DECISION ON § 1.182
Control No.: 95/001,515	: AND §1.183 PETITIONS
Filed: December 23, 2010	:
For: U.S. Patent No.: 6,401,415	:
Title: DIRECT LAMINATED FLOOR	:

This is a decision on a March 25, 2011 Patent Owner Petition under 37 CFR 1.182 seeking to vacate the filing date of a December 23, 2010 request for *inter partes* reexamination in that the real party in interest was not accurately identified in the request. This is also in response to an April 8, 2011 third party requester (Requester) Opposition to the petition for vacatur supported by a Petition under 37 CFR 1.183, requesting entry of the Opposition.

The Petitions and Opposition are before the Office of Patent Legal Administration for consideration.

The Patent Owner Petition for vacatur under 37 CFR 1.182 is Dismissed.

The Requester Petition under 37 CFR 1.183 is Granted and the Opposition has been entered.

I. FEES

The § 1.182 and § 1.183 petition fees of $400.00 each (as set forth in 37 CFR 1.17(f)) have been paid on March 25, 2011 and April 8, 2011 as indicated in Office PALM records.

II. BACKGROUND

1. U.S. Patent No. 6,401,415 (the '415 patent) was issued on June 11, 2002.

2. On December 23, 2010, a request for *inter partes* reexamination of the '415 patent was filed by Requester Andrew M. Calderon.[1] The request:
   a. set forth as the real party in interest Kronopol Sp.zo.o (Kronopol),[2] and
   b. noted a concurrent proceeding that identifies: [3]
      - copending litigation styled: Case No.: 1:09-CV-2583-JEC, in the U.S. District Court of the Northern District of Georgia.[4]

4. On January 10, 2011, the Office mailed:
   - Notice of Assignment *Inter Partes* Reexamination Request:
      a. assigning a filing date of December 23, 2010 for the request, and
      b. assigning a reexamination control No. 95/001,515 (the '515 reexamination proceeding) to the request.

5. On February 7, 2011 the Office mailed an order granting the request for *inter partes* reexamination accompanied by an Office action and reexamination has proceeded.

6. On March 25, 2011, Patent Owner filed the instant Petition under 37 CFR 1.182 to vacate the filing date of the present reexamination proceeding asserting that the request for reexamination failed to:
   - accurately identity the real party in interest.

7. On April 8, 2011 the Requester filed the instant Opposition to the Patent Owner petition to vacate the filing date of the reexamination and a Petition under § 1.183, requesting entry of the Opposition.

III. Petition Under 37 CFR 1.182 for Vacatur

Petitioner (Patent Owner) notes that:[5]

1. identification of the real party in interest is essential to enforce the estoppel provisions to prevent further filings of reexamination with the patent office or presentation of arguments in court,
2. the Office has authority to question a facially inaccurate identification of the real party in interest, and
3. extrinsic evidence may be submitted to demonstrate a facial inaccuracy in the

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[1] Request transmittal form, at page 1, paragraph 2a.
[2] *Id.*, at page 1, paragraph 2b.
[3] *Id.* at page 2, paragraph 16 d.
[4] Further identified in the accompanying request for reexamination, page 5, as Kronotex U.S.A. LLC v. Faus Group, Inc. and Industrias Auxiliares Faus, S.L.U.
[5] Petition, page 3.

identification of the real party in interest.

Petitioner attempts to establish the facial inaccuracy of the identification of the real party in interest based on the asserted (1) similarity of the invalidity contentions filed in the concurrent litigation to the asserted bases of the substantial new questions of patentability presented in the reexamination request, (2) familial relationship between the party identified as the real party in interest in the reexamination and the actual parties to the concurrent litigation, and (3) behaviour of the defendants in the concurrent litigation.

Petitioner believes that the parties to the concurrent litigation should also have been identified as real parties in interest in addition to the one party who was so identified, but who is not a party to the concurrent litigation.

Similarity of invalidity contentions and asserted grounds of a substantial new question of patentability:[6]

Petitioner points out that of the ten primary references relied upon as presenting a substantial new question of patentability seven were included in the earlier filed invalidity contentions in the concurrent litigation to which Kronopol is not a party to. Twenty-six of the 34 alleged new questions of patentability were the same or similar to the invalidity contentions in the litigation. A side-by-side comparison is given as an example of this asserted almost exact similarity.

Familial relationship:[7] The party identified as the real party in interest, Kronopol, and the defendants in the concurrent litigation are asserted to be sister companies that are under the control and direction of the same parent company, Krono Holdings AG. Kronopol is stated to not be acting on its own accord or financing based on the familial relationship, and the following that has been publically stated in an identified web site:

> Krono Holding AG is responsible for the strategic direction of the Group, supporting them in the area of long-term financing and development. The main Board and management at Krono Holding, decide on the use of resources in area such as product and process development, market positioning, research and development, and other investment opportunities.

Defendant behaviour:[8] The issuance by the defendant of a threat that a reexamination request would be filed, the request resulting in the present proceeding being filed shortly thereafter, and the defendants' reliance on the filing of the reexamination request to support a motion to stay the litigation pending reexamination is believed to clearly show participation by the defendants in the preparation of the reexamination request.

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[6] Petition, pages 4 and 5.
[7] Petition, page 6.
[8] *Id.*

IV. Petition under 37 CFR 1.183 for entry of Opposition and Decision Thereon

Third party petitioner (Requester) seeks entry of the Opposition to the Patent Owner Petition for vacatur of the reexamination filing date, such as by waiver of § 1.939(a).

Section 1.939(a) provides:

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

Because the Opposition sheds light on the proper identification of the real party in interest, as noted below, and, in addition, the requester has a right to defend against vacating its request, the Petition for waiver is granted.

V. Requester Opposition to Patent Owner Petition for Vacatur

The Opposition argues that the petition for vacatur of the reexamination filing date should be dismissed in that (1) the reexamination request complies with applicable statute and rules, (2) the Office lacks the authority and the tools to question the facially accurate unambiguous identification of the real party in interest, (3) it is premature to investigate the identity of the real party in interest, and (4) the petition for vacatur has not provided clear and objective evidence that the identification of the real party in interest is not accurate.

Compliance with statute and rules:[9] It is asserted that the statute and the rules require identification of the real party in interest to permit a future *inter partes* requester of the same patent to (1) make a certification that the future requester is not prohibited from filing the request by estoppel provisions (37 CFR 1.915(b)(7)), and (2) to permit the future requester to determine whether the requester is a privy with an earlier requester (37 CFR 1.915(b)(8)).

The Opposition notes that the request documents clearly and accurately identify the real party in interest, and there can be no ambiguity arising from the face of the request documents as to who has been identified as the real party in interest. Accordingly, a future requester can examin its relationship with the identified real party in interest to determine whether the future requester is a privy.

Office lack of authority and tools:[10] Reference is made to a particular rule making[11] where the Office has stated that it does not intend to look beyond a certification by the requester as to who the real party in interest is. References are also made to several other *inter partes* reexaminations containing prior decisions[12] where the Office has stated that it lacks the authority and the tools to conduct an investigation related to identification of the real party in interest. The Office has recognized that

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[9] Opposition, pages 2-4.
[10] Opposition, pages 4-6.
[11] 654 Fed. Reg. 76756, 76759 (Dec. 7, 2000).
[12] Control No. 95/001,206, June 22, 2010 Decision; Control No. 95/000,166, November 9, 2007 Decision; Control No. 95/000227, June 8, 2007 and September 7, 2007 Decisions.

the issue should be addressed by a court that would have the proper discovery tools.[13]

Premature:[14] It is pointed out that the instant reexamination is the only reexamination directed to the '415 patent (a second reexamination proceeding has not been filed), and there has been no final appealable decision in the concurrent litigation to trigger the issue as to whether the instant reexamination should be maintained. Accordingly, the determination of the real party in interest is urged to not be ripe for consideration. Rather, the Patent Owner in alleging that the identified real party in interest is really a "straw man" for the group of defendants in the concurrent litigation is "setting the stage" for the possibility of provoking the estoppel provisions, which is not yet a timely issue until the filing of a second *inter partes* reexamination request.

No evidence of participation: The Opposition believes that the assertions made by Petitioner - (1) the concurrent litigations defendants substantially participated in the reexamination request, (2) the familial relationship between the concurrent litigation defendants and the identified real party in interest in the reexamination request, and (3) the behaviour of the concurrent litigation defendants - do not factually establish that the real party in interest has been misidentified.

Participation:[15] It is asserted that - While the evidence establishes that there are similarities between the invalidity contentions in the concurrent litigation and the proposed rejections in the reexamination request, the evidence does not establish how the similarities arose. Any collaboration or sharing of information has not been shown to be for the purpose of the instant reexamination request. An explanation is provided whereby Kronopol being a sister company of some of the concurrent litigation defendants learned it would be a third party beneficiary of any license that resulted from settlement negotiations, and upon later learning that the negotiations had been unsuccessful independently, decided to file the instant reexamination.

Any possession by Kronopol of the invalidity contentions is alleged not to be indicative of participation by the concurrent litigation defendants in the preparation of the reexamination request. While the invalidity contentions are not publically available, they were readily obtainable by Kronopol due to its status as a sister company to the concurrent litigation defendants.

Familial relationship:[16] The Opposition points out that a corporate relationship does not *ipso facto* translate into the related entities being real parties in interest when one of the entities files a request for reexamination. The web site language referred by Petitioner relates to product and process development and other matters, but does not state or imply any other entity controls Kronopol's legal affairs or that there was

[13] Opposition, page 8.
[14] Opposition, pages 6-8.
[15] Opposition, pages 9-15.
[16] Opposition, pages 15-17.

any input or financing for the instant reexamination request. It is explicitly stated that:

> "Kronopol is acting independently and on its own accord for its own self-interest, is financing the instant *inter partes* reexamination, without receiving any payment from Krono Holding or any Krono Entity Defendant, and is the real party in interest."[17]

Behaviour of the concurrent litigation defendants:[18] The Opposition states that the threat of a reexamination filing is not tantamount to a statement that the concurrent litigation defendants would be filing a specific reexamination request. Similarly, the reliance on the filing of a reexamination request to seek a stay in the concurrent litigation pending the reexamination does not translate to a role in filing of the request.

VI. Decision on the Patent Owner § 1.182 Petition for Vacatur

The § 1.182 petition by patent owner seeking vacatur of the *inter partes* reexamination based on the failure to correctly identify the real party in interest to include the defendants in the concurrent litigation is dismissed.

The Office declines to establish a per se rule that a familial relationship between parties, such as between two subsidiaries of a corporation, or a corporation and one if its subsidiaries, on its face without more, would be enough to establish both parties as real parties in interest in a reexamination filed by one party.

The MPEP[19] makes it clear that the Office does not look beyond the required certification in the request for reexamination, except for the rare instance where a challenge to the sufficiency of the certification facially establishes that the identified real party in interest is not accurate. The certification cannot be successfully challenged merely because, at one point, the certified real party in interest was "involved" with another party, or there was some collaboration in a matter other than the request for reexamination.

The common interest among litigation defendants seeking to invalidate or defend against enforcement of a patent, such as in the litigation identified by Patent Owner, and a sister company not a party to the litigation does not translate *ipso facto* into each defendant being a real party in interest where a request for reexamination is filed by the sister company. This is not to say that concurrent litigation defendants cannot be real parties in interest with the sister company in the instant request for reexamination, but such result must be shown and not merely speculated on or theorized about. If, in fact, it could be evidenced that the parent company directed one sister to litigate, and another sister to file the reexamination request to influence the litigation, then an issue would be raised as to whether the litigating sister company is a real party in interest in the filing of the reexamination request, and as

[17] Opposition, page 17.
[18] Opposition, pages 17-18.
[19] MPEP § 2612.

to whether the sister companies are in privy with each other. To be required to be named as a real party in interest, a party must participate, contribute, or direct that action be taken in some concrete manner in the request for reexamination. This is not a situation where it can be argued that the Requester (sister company), being a defendant in the concurrent litigation, was a joint participant in the preparation of the litigation defense, which defense was then utilized in the reexamination request - the sister company is not a joint defendant. Even if such were the case, preparation of an invalidity defense, based on found and evaluated prior art to support a concurrent litigation defense, does not amount to participation, contribution, or directing that action be taken by all the defendants in a request for reexamination by one of the defendants based on such joint activity, where the joint activity was conducted with only an intent to defend the concurrent litigation suit. Evidence that the joint activity was also conducted with an intent to file an *inter partes* reexamination request is required, in order for a petitioner to establish that other concurrent litigation defendants are real parties in interest with the concurrent litigation defendant filing the reexamination request.

Notwithstanding any actual benefit that would result to the concurrent litigation defendants from a favorable result in the reexamination, or their ability to request a litigation stay based on the reexamination request, the question of whether a defendant in the litigation is a real party in interest in the reexamination must be determined on a case-by-case basis focusing on **the showing** of a party's participation, contribution, or directing that action be taken in regard to the filing of a request for reexamination, and not ancillary matters, such as the defendants taking advantage of the reexamination request, or the request taking advantage of arguments in the subsequent reexamination request that were previously drafted by others for the concurrent litigation. For example, if the Office were to follow petitioner's line of reasoning, a patent owner might challenge an identification of the real party in interest in a reexamination where a third party requester not involved in the litigation and ignorant thereof, was to file a request for reexamination of the patent in litigation utilizing one or more pieces of prior art employed by the unrelated defendants in the litigation. The third party requester could be placed in a position of having to prove a negative - that it was not supported by the litigation defendants. Similarly, here, the Office will not require the Requester to prove a negative - that the concurrent litigation defendants did not participate in the reexamination. The fact that a first party defended itself in litigation, and another party defendant or sister company to one or more defendants later filed a request for reexamination related to the patent in litigation utilizing in-part that defense, should not doom the first party to life as a real party in interest for any request for reexamination that may be later filed utilizing part of that defense. Rather, the burden is on the challenging Patent Owner to provide evidence of participation , contribution, or directing that action be taken as to the reexamination request.

It may be that a particular defendant in a litigation or in the instant situation a sister company thereto (whose actions are not subject to any control by its sibling) has decided to proceed with a request for reexamination in the face of hostile opposition by one or more other defendants in the litigation (who would rather settle the

matter in court, than before the Office, based on the nature of their case) who should therefore not be embraced as a real party in interest in the request for reexamination. To do so, would result in estoppel against parties who had no control over the request for reexamination. None-the-less, using petitioner's theory that the defendants in the litigation must be deemed to be real parties in interest in the sister company's initial reexamination request of the patent in litigation, the litigation defendants could then be barred (under 35 U.S.C. § 317(a)) from raising other known prior art that they may feel is better in a subsequent request for reexamination after the first request has been ordered.

In deciding a petition for vacatur, the Office will not engage in conjecture as to the participation in the request for reexamination of any particular alleged unnamed real party in interest. For purposes of this decision, it is not disputed that the concurrent litigation defendants may be impacted and even benefit from the filing of the instant reexamination. However, it is incumbent upon Patent Owner to present objective evidence that a party not identified as a real party in interest in fact participated in the request for reexamination, or in the reexamination proceeding after the request was filed.

A. The Identification Of The Real Party In Interest Is Not Facially Inaccurate Or Ambiguous. Therefore, The Office Lacks The Authority And The Tools To Question That Identification.

The arguments presented in the § 1.182 petition for vacatur fail to establish that the Office has the authority to question the accuracy of a third party requester's facially accurate and unambiguous identification of the real party in interest in this *inter partes* reexamination proceeding, or the tools to competently conduct an investigation of the matter.

To the extent that Patent Owner argues that the Office has the ability to investigate the accuracy of the identification of the real party in interest in an *inter partes* reexamination proceeding, or to issue a Show Cause Order requiring the identified real party in interest to confirm that it, and it alone, is the real party in interest, Patent Owner does not make a persuasive case that the Office is required to do so by either the reexamination statute or the reexamination regulations, when the *inter partes* reexamination as filed contains, on its face, an unambiguous identification of the identity of the real party in interest.[20]

Patent Owner's argument is not persuasive, because it does not reflect the intent of the provisions of 37 CFR 1.915(b)(7) and (b)(8). A certification statement made pursuant to 37 CFR 1.915(b)(7) is a statement by the third party requester to the effect that the third party requester is not itself estopped by the statutory estoppel provisions from filing a request for *inter partes* reexamination of a given patent. The *inter partes* rule making at 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), provides that:

[20] The Requester has in fact confirmed that it has identified the only real party in interest. Opposition, page 17.

> It should be noted that the Office generally will not have a need to resolve the factual issue of whether or not one party is a privy of another party. Section 1.915(b)(7) requires a third party requester to certify that the estoppel provisions of §1.907 do not prohibit the filing of the *inter partes* reexamination request, and the Office does not intend to look beyond this required certification. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would then need to be addressed.

A substantially identical statement also appears at 65 Fed. Reg. at 76764. These statements establish that the Office will, only in the rare instance that it is necessary to do so (a facial showing of inaccuracy or an ambiguity), "address" the accuracy of a certification that statutory estoppel does not bar the filing of a request for *inter partes* reexamination. Further, the rule making does not discuss the type or depth of investigation that can and will be undertaken, and it does not state or imply that a patent owner may trigger an investigation of the accuracy of the certification merely by advancing an unsupported allegation that another party is a real party in interest (by way of having participated in the reexamination request).

This is not an instance where the identification of the real party in interest required by 37 CFR 1.915(b)(8) is ambiguous or facially inaccurate, in which instance the third party requester who is before the Office can be queried by the Office, because the record is not clear at that point in time (*i.e.*, the ambiguity causes an issue that is ripe for consideration due to a required request statement being ambiguous). Since the present record in the instant reexamination proceeding is not ambiguous as to the identification of the real party in interest (and Patent Owner has provided no persuasive extrinsic evidence to establish ambiguity), there is no basis to proceed any further in this proceeding as to the matter.

Aside from the above, another reexamination proceeding that would be the subject of the above-cited paragraph of the rule making notice has not yet been filed, nor has a final decision apparently issued in the Federal Court litigation; thus the issue is not ripe for consideration (see discussion in part B. below). If the issue does become ripe for consideration via another reexamination proceeding filed by a subsequent requester (who is one of the co-defendants), the subsequent third party requester making such statement would become a party appearing before the Office. In other words, an actual defendant, *i.e.*, the subsequent third party requester, would then be available to be asked by the Office to clarify or support a 37 CFR 1.915(b)(7) certification statement that is asserted to be inaccurate. Presumably, that third party requester would be able to respond based on facts wholly within its knowledge and possession. The Office would be able to obtain information from the Patent Owner and the subsequent third party Requester, and would have no need to obtain information from a party not before the Office by reason of the filing of a first request for *inter partes* reexamination.

Apart from the inherent ability of the Office to issue an Show Cause Order directed to a party that is before the Office, Patent Owner does not point to any regulation that would provide a mechanism for conducting an investigation directed to determining whether parties not before the Office are in fact real parties in interest in an *inter partes* reexamination proceeding. For example, 37 CFR 1.105 was promulgated pursuant to 35 U.S.C. §§ 131 and 132, statutes that relate to the examination of applications and (via incorporation by the reexamination statute) the conduct of reexamination proceedings as to patentability. The regulation was promulgated for the purpose of requiring submission of information material to patentability from persons having a duty under 37 CFR 1.56 to disclose information to the Office that is material to patentability.[21] The identification of the real party in interest has no relationship to the duty to disclose information that is material to patentability (which applies to an applicant for patent and to a patent owner in a reexamination proceeding).[22] With respect to obtaining information from a party who is alleged to be an undisclosed real party in interest in an *inter partes* reexamination proceeding, it is not apparent how 37 CFR 1.105 could be applied to a party who is not before the Office in that proceeding.

Therefore, where a patent owner who is a party in an *inter partes* reexamination proceeding believes that an identification of the real party in interest is inaccurate, even though it is facially unambiguous, the courts are the appropriate venue from which the patent owner should seek relief to obtain evidence extrinsic to the record, for incorporation into the record. It is to be noted that there is precedent on the issue of "real party in interest" in the federal courts, on matters ranging from jurisdiction (*e.g.*, presence of diversity or amount of suit)[23] to actions in which the principle is applied to prevent multiple or conflicting lawsuits by persons such as assignees.[24] These examples of court proceedings resolving "real party in interest" issues demonstrate the reason why the Office cannot perform such a function here. Upon obtaining jurisdiction over the parties, courts may order discovery, taking of testimony with cross-examination and use of other evidentiary tools, while enforcing compliance with its requirements via its subpoena power and power to impose sanctions. Accordingly, the courts are the forums best equipped to determine who is, and who is not, the "real party in interest" when there is a reason to doubt the third party requester's identification of a party or parties as being the real party in interest in an *inter partes* reexamination proceeding. Further, courts may provide relief, as appropriate, by enjoining the filing of a further *inter partes* reexamination request by the other parties in a civil action. Once a court has determined that a party is a "real party in interest," the Office can make use of that determination to bar the filing of a subsequent *inter partes* reexamination request by that party. Of course at that point, the party could file an *ex parte* reexamination proceeding, the filing of which does not require identification of "a real party in

[21] 65 Fed. Reg. 54604, 54633, (Sept. 8, 2000).

[22] See 37 CFR 1.933, which refers back to 37 CFR 1.555, which in turn, references 37 CFR 1.105. These regulations do not create a duty to disclose information material to patentability (or any duty of disclosure) that attaches to a reexamination third party requester.

[23] *Varlotta Construction Corporation v. Carla Development Corporation*, 886 F. Supp 315 (E.D.N.Y. 1995).

[24] *First Hartford Corporation Pension Plan & Trust v. United States*, 194 F.3d 1279 (Fed. Cir. 1999).

interest" (35 U.S.C §§ 301 and 302), and is not prohibited by statute or rule, even after an *inter partes* reexamination was filed by the same real party in interest.[25]

A patent owner concerned with the issue of misidentification of the real party in interest in a request for *inter partes* reexamination may immediately seek relief from the alleged erroneous identification of the "real party in interest" via the courts, which possess the tools to investigate and obtain information as to the relationship of the parties to ascertain the veracity of the identified "real party in interest." The present petition is silent as to why Patent Owner did not approach the appropriate District Court for relief (*e.g.*, an investigation into the matter and an appropriate order). Given the emphasis that petitioner Patent Owner has placed on the importance of the "real party in interest" disclosure requirement, it would appear that Patent Owner could have immediately sought relief in the appropriate court regarding the identity of the real party in interest. The record does not show that Patent Owner has done so. The Office may consider that it is "the sole agency that administers the patent statute,"[26] and the Office certainly conducts the *inter partes* proceeding; however, it is common knowledge that the federal courts (which are not an agency in the sense used in the *inter partes* reexamination rule making) routinely adjudicate matters arising under the patent statute. Further, Patent Owner should appreciate the difference between conducting a reexamination proceeding, which is the province of the Office, and enforcing an estoppel provision of Federal law as a matter of equitable relief. Patent Owner has not provided any basis for believing that the district courts lack authority to act as described above.

As a final point in this section of the decision as to the Office lacking the authority to investigate: The reexamination statute requires, *inter alia*, that a request for *inter partes* reexamination proceeding "shall ... include the identity of the real party in interest... ."[27] The *inter partes* reexamination rules require that a request for *inter partes* reexamination include, *inter alia*, "[A] statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that party is a privy."[28] Requester has clearly stated that Kronopol is the real party in interest, and that is an identification to a sufficient extent that "a party, such as a concurrent litigation defendant, filing a subsequent *inter partes* reexamination request" can look into its interaction with the identified Kronopol to "determine whether that person is a privy" with the real party in interest that filed the present reexamination. Neither the *inter partes* reexamination statute nor the *inter partes* reexamination rules imposes a duty on the Office to investigate the accuracy of an unambiguous identification of the real party in interest in a third party requester's request for *inter partes* reexamination proceeding.

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[25] If the court makes a finding that the "real party in interest" was misstated, the Office can then take action, if appropriate, based upon the court's findings.
[26] 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), emphasis added.
[27] 35 U.S.C. § 311(b)(1).
[28] 37 CFR 1.915(b)(8).

In the present *inter partes* reexamination proceeding, the real party in interest is unambiguously identified in the current record. The identification of the real party in interest does not appear to be facially inaccurate. The Office will refuse to accord a filing date to a request for *inter partes* reexamination that does not identify the real party in interest, or which provides an identification of the real party in interest that is ambiguous or facially inaccurate. If the Office accords a filing date to a request for *inter partes* reexamination, and later discovers an ambiguity or a facial inaccuracy in the identification of the real party in interest, the Office can, and will, require that a party appearing before it as third party requester in an *inter partes* reexamination proceeding clarify the ambiguity or facial inaccuracy. However, it does not follow that the Office is empowered to conduct an investigation into the identity of the real party in interest when the statement identifying the real in interest in the record of an *inter partes* reexamination proceeding is neither facially inaccurate nor ambiguous. The Office will not conduct an investigation into the accuracy of the identification of the real party interest in the instant reexamination proceeding, because there is no legal reason to do so, even if the Office's ability to do so could be shown (which it has not been, as discussed above).

B. The Office Has No *Present* Duty To Investigate The Identity Of The Real Party In Interest In The Instant *Inter Partes* Reexamination Proceeding.

It is also to be noted that, in the instant reexamination proceeding, Patent Owner is requesting relief based upon an injury that has not yet occurred, and may never occur, even according to Patent Owner's view of the situation. Patent Owner does not allege that the named real party in interest is itself estopped from filing and participating in the instant reexamination proceeding. Rather, Patent Owner's concern must be that Patent Owner might be harassed by the filing of a subsequent request for *inter partes* reexamination of the patent or that the instant reexamination will be inappropriately maintained by a party that should have been identified as a real party in interest in the instant reexamination proceeding, but was not so identified. Such a hypothetical party, as a real party in interest in the instant reexamination proceeding, would be subject to a statutory estoppel that could preclude (if the statutory provisions are satisfied) its filing of another *inter partes* reexamination proceeding, or from maintaining the instant reexamination proceeding if such a party "loses" as a defendant in any litigation of the patent. While a patent owner is statutorily entitled to be protected from harassment by the filing of a subsequent request for *inter partes* reexamination of the patent by a party who is estopped from filing such a request, the record simply does not show that such a circumstance presently exists as to the instant reexamination proceeding. No additional requests for *inter partes* reexamination of the patent have been filed by any defendant in the concurrent litigation, nor is the only identified litigation (as to the patent) final. Thus, clearly there is presently no cause for concern that a misidentification of the real party in interest has permitted a party subject to statutory estoppel to file an additional request for *inter partes* reexamination of the patent or inappropriately maintained the instant one. Patent Owner's arguments relative to Kronopol being commonly owned and controlled are matters of whether

privity exists between Kronopol and the litigation defendants that would bar a subsequent reexamination request by the litigation defendants.

Accordingly, there is no need to consider addressing the relief requested by Patent Owner in the present *inter partes* reexamination proceeding, since Patent Owner cannot have been injured by the filing of another request for *inter partes* reexamination for the patent or by maintaining a reexamination that is barred by statutory estoppel.

C. Synopsis

Rather than having presented clear and undisputed evidence establishing that Kronopol is not the only real party in interest in the instant reexamination proceeding, the petition is supported only by supposition and conjecture on Patent Owner's part. Accordingly, Patent Owner has not demonstrated a persuasive basis for the requested relief of vacatur of the filing date of the instant reexamination proceeding or issuance of a show cause order why the filing date should not be vacated. Therefore, such request for relief is dismissed.

VII. CONCLUSION

1. The March 25, 2011 Patent Owner § 1.182 petition seeking vacatur of the reexamination is dismissed.

2. The April 8, 2011 third party Requester § 1.183 petition for entry of a concomitant Opposition to the Patent Owner petition has been granted and the Opposition entered.

3. Telephone inquiries related to this decision should be directed to Hiram H. Bernstein, Senior Legal Advisor, at (571) 272-7707.

/Kenneth M. Schor/

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

12-19-11
Kenpet9/...

APPENDIX OF RELEVANT STATUTORY, REGULATORY AND PRACTICE PROVISIONS

35 U.S.C. § 311 Request for inter partes reexamination.

(a) IN GENERAL.— Any third-party requester at any time may file a request for inter partes reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.
(b) REQUIREMENTS.— The request shall—
(1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an inter partes reexamination fee established by the Director under section 41; and
(2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.

35 U.S.C. § 315 Appeal.

* * * * *

(c) CIVIL ACTION.— A third-party requester whose request for an inter partes reexamination results in an order under section 313 is estopped from asserting at a later time, in any civil action arising in whole or in part under section 1338 of title 28, the invalidity of any claim finally determined to be valid and patentable on any ground which the third-party requester raised or could have raised during the inter partes reexamination proceedings. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

35 U.S.C. § 317 Inter partes reexamination prohibited.

(a) ORDER FOR REEXAMINATION.— Notwithstanding any provision of this chapter, once an order for inter partes reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for inter partes reexamination of the patent until an inter partes reexamination certificate is issued and published under section 316, unless authorized by the Director.
(b) FINAL DECISION.— Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an inter partes reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

37 CFR 1.105 Requirement for information.

(a)(1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

(i) *Commercial databases*: The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.

(ii) *Search*: Whether a search of the prior art was made, and if so, what was searched.

(iii)*Related information*: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(iv) *Information used to draft application*: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v) *Information* used in invention process: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) *Improvements*: Where the claimed invention is an improvement, identification of what is being improved.

(vii) *In Use*: Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(viii) *Technical information* known to applicant.

Technical information known to applicant concerning the related art, the disclosure, the claimed subject matter, other factual information pertinent to patentability or concerning the accuracy of the examiner's stated interpretation of such items.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(i), (iii), and (vii) of this section may also be applied to such assignee.

(3) Requirements for factual information known to applicant may be presented in any appropriate
manner, for example:

(i) A requirement for factual information;

(ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or

(iii) Stipulations as to facts with which the applicant may agree or disagree.

(4) Any reply to a requirement for information pursuant to this section that states either that the information required to be submitted is unknown to or is not readily available to the party or parties from which it was requested may be accepted as a complete reply.

(b)The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section will be governed
by §§ 1.135 and 1.136.

37 CFR 1.907 *Inter Partes* reexamination prohibited.

(a) Once an order to reexamine has been issued under § 1.931, neither the third party requester, nor its privies, may file a subsequent request for *inter partes* reexamination of the

patent until an *inter partes* reexamination certificate is issued under § 1.997, unless authorized by the Director.

(b) Once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. 1338 that the party has not sustained its burden of proving invalidity of any patent claim-in-suit, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such civil action, and an *inter partes* reexamination requested by that party, or its privies, on the basis of such issues may not thereafter be maintained by the Office.

(c) If a final decision in an *inter partes* reexamination proceeding instituted by a third party requester is favorable to patentability of any original, proposed amended, or new claims of the patent, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claims on the basis of issues which that party, or its privies, raised or could have raised in such *inter partes* reexamination proceeding.

37 CFR 1.913 Persons eligible to file request for *inter partes* reexamination.

Except as provided for in § 1.907, any person other than the patent owner or its privies may, at any time during the period of enforceability of a patent which issued from an original application filed in the United States on or after November 29, 1999, file a request for *inter partes* reexamination by the Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501.

37 CFR 1.915 Content of request for *inter partes* reexamination.

(b) A request for *inter partes* reexamination must include the following parts:

(7) A certification by the third party requester that the estoppel provisions of § 1.907 do not prohibit the inter partes reexamination.

(8) A statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy.

...

(d) If *the inter partes* request does not include the fee for requesting *inter partes* reexamination required by paragraph (a) of this section and meet all the requirements of paragraph (b) of this section, then the person identified as requesting *inter partes* reexamination will be so notified and will generally be given an opportunity to complete the request within a specified time. Failure to comply with the notice will result in the *inter partes* reexamination request not being granted a filing date, and will result in placement of the request in the patent file as a citation if it complies with the requirements of § 1.501.

37 CFR 1.919 Filing date of request for *inter partes* reexamination.

(a) The filing date of a request for *inter partes* reexamination is the date on which the request satisfies all the requirements for the request set forth in § 1.915.

§ 1.939 Unauthorized papers in *inter partes* reexamination

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

(b) Unless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the *inter partes* reexamination.

§ 1.985 Notification of prior or concurrent proceedings in *inter partes* reexamination.

(a) In any *inter partes* reexamination proceeding, the patent owner shall call the attention of the Office to any prior or concurrent proceedings in which the patent is or was involved, including but not limited to interference, reissue, reexamination, or litigation and the results of such proceedings.

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

MPEP § 2612 Persons Who May File a Request

37 CFR 1.907 defines specific situations where a third party is prohibited from filing a request for an inter partes reexamination. 37 CFR 1.915(b)(7) requires the third party requester to certify that the estoppel provisions of 37 CFR 1.907 do not prohibit the filing of the inter partes reexamination request by the real party in interest (note that it is the real party in interest that is subject to the estoppel provisions and not the party who actually files the request). The certification identified in 37 CFR 1.915(b)(7) will constitute a prima facie showing that the party requesting the inter partes reexamination is not barred from doing so under 37 CFR 1.907. The Office does not intend to look beyond this required certification. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would then need to be addressed. A challenge to the accuracy of the certification must facially establish that the third party requesting the inter partes reexamination is barred from doing so under 37 CFR 1.907. Thus, for example, the challenger cannot rely on an argument that the third party requesting reexamination was, at one point, involved with a party barred under 37 CFR 1.907, and should thus be considered as a real party in interest (and barred from filing the request). Involvement *per se* does not facially establish that the other party is a real party in interest. The fact that a second party may benefit from an earlier reexamination request filed by a first party or a civil action conducted by the first party, or that the second party may have collaborated with the first party in a matter, does not facially evidence the second party was a real party in interest with the first party. With respect to the Office conducting an investigation to uncover whether the second party was a "real party in interest," the statute does not require, nor does it provide the tools, for the Office to investigate such matter. Further, Congress has not provided the Office with subpoena power or discovery tools and has not provided the Office with the ability to conduct hearings for eliciting testimony and cross-examination. The Office has not been authorized to impose punitive sanctions for non-compliance. Such evidentiary tools are, however, available to the courts, which are the appropriate vehicle to make a factual investigation as to the accuracy of the identification of a "real party in interest."

MPEP § 2614 Content of Request for *Inter Partes* Reexamination

The reexamination request must identify the real party in interest who is responsible for filing the reexamination request. This information will be used by future parties requesting reexamination of the same patent, in making the certifications required by 37 CFR 1.915(b)(8).

MPEP 2625 Untimely Paper Filed Prior to First Office Action

Pursuant to 37 CFR 1.939, after filing of a request for *inter partes* reexamination, no papers directed to the merits of the reexamination other than (A) citations of patents or printed publications under 37 CFR 1.501 and 1.933, (B) another complete request under 37 CFR 1.510 or 37 CFR 1.915, or (C) notifications pursuant to MPEP § 2686, should be filed with the Office prior to the date of the first Office action in the reexamination proceeding. Any papers directed to the merits of the reexamination, other than those under 37 CFR 1.501, 1.933, 1.510 or 1.915, or under MPEP § 2686, filed prior to the date of the first Office action will be returned to the sender without consideration. >If the papers are entered prior to discovery of the impropriety, such papers will be expunged from the record.< A copy of the letter *>providing notification of< the returned papers >or expungement< will be made of record in the patent file. However, no copy of the *>returned/expunged< papers will be retained by the Office. If the submission of the *>returned/expunged< papers is appropriate later in the proceedings, they may be filed, and accepted by the Office, at that time. See *Patlex Corp. v. Mossinghoff*, 771 F.2d 480, 226 USPQ 985 (Fed. Cir. 1985); *In re Knight*, 217 USPQ 294 (Comm'r Pat.1982); and *In re Amp*, 212 USPQ 826 (Comm'r Pat. 1981) which addressed the situation analogous to the present situation for *ex parte* reexamination proceedings.

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McKenna Long and Aldridge LLP
c/o Song K. Jung
1900 K Street NW
Washington, DC 20006

For Patent Owner

MAILED

JAN 11 2012

CENTRAL REEXAMINATION UNIT

Andrew M. Calderon
Roberts, Mlotkowski, Safran & Cole, P.C.
P.O. Box 10064
McLean, VA 22102-8064

3d Party Requester

Inter Partes Reexamination Proceeding
Control No. 95/001,515
Filed: December 23, 2010
For: U.S. Patent No. 6,401,415

DECISION ON PETITION
UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed October 6, 2011, to expunge information from the above identified reexamination proceedings, which information is deemed to be subject to a Protective Order associated with pending litigation in *Kronotex U.S.A. LLC, v. Faus Group Inc., et al.,* Case No. 1:09-cv-2583-JEC.

The decision on the petition will be held in abeyance until the issuance of the Notice of Intent to Issue *Inter Parts* Reexamination Certificate (NIRC) is mailed.

Petitioner requests that material that is subject to a protective order, submitted in a sealed envelope on October 6, 2011, be expunged from the file of the above referenced reexamination proceeding if found not to be material to patentability. The request purports to have been filed in compliance with the requirements of MPEP § 724.02.

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

Reexam Control Nos. 95/001,515

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

Telephone inquiries with regard to this decision should be directed to Andres Kashnikow, Supervisory Patent Reexamination Specialist in the Central Reexamination Unit, Art Unit 3993, at (571) 272-4361.

Andres Kashnikow, SPRS
Central Reexamination Unit 3993

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,516	12/23/2010	6688061	6200-37196	1440

30827 7590 12/20/2011
MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON, DC 20006

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/20/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Andrew M. Calderon
ROBERTS MLOTKOWSKI SAFRAN & COLE, P.C.
P.O. BOX 10064
McLean, VA 22102-8064

Date:

MAILED

DEC 20 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001516
PATENT NO. : 6688061
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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DEC 20 2011

CENTRAL REEXAMINATION UNIT

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(For Requester)

Mckenna Long and Aldridge LLP
c/o Song K. Jung
1900 K Street, NW
Washington, DC 20006

(For Patent Owner)

In re Eugenio Cruz Garcia	:
Reexamination Proceeding	: DECISION ON § 1.182
Control No.: 95/001,516	: AND §1.183 PETITIONS
Filed: December 23, 2010	:
For: U.S. Patent No.: 6,688,061	:
Title: DIRECT LAMINATED FLOOR	:

This is a decision on an April 4, 2011 Patent Owner Petition under 37 CFR 1.182 seeking to vacate the filing date of a December 23, 2010 request for *inter partes* reexamination in that the real party in interest was not accurately identified in the request. This is also in response to an April 14, 2011 third party requester (Requester) Opposition to the petition for vacatur supported by a Petition under 37 CFR 1.183, requesting entry of the Opposition.

The Petitions and Opposition are before the Office of Patent Legal Administration for consideration.

The Patent Owner Petition for vacatur under 37 CFR 1.182 is Dismissed.

The Requester Petition under 37 CFR 1.183 is Granted and the Opposition has been entered.

I. FEES

The § 1.182 and § 1.183 petition fees of $400.00 each (as set forth in 37 CFR 1.17(f)) have been paid on April 4, 2011 and April 14, 2011 as indicated in Office PALM records.

II. BACKGROUND

1. U.S. Patent No. 6,688,061 (the '061 patent) was issued on February 10, 2004.

2. On December 23, 2010, a request for *inter partes* reexamination of the '061 patent was filed by Requester Andrew M. Calderon.[1] The request:
   a. set forth as the real party in interest Kronopol Sp.zo.o (Kronopol),[2] and
   b. noted a concurrent proceeding that identifies: [3]
      - copending litigation styled: Case No.: 1:09-CV-2583-JEC, in the U.S. District Court of the Northern District of Georgia.[4]

4. On January 10, 2011, the Office mailed:
   - Notice of Assignment *Inter Partes* Reexamination Request:
      a. assigning a filing date of December 23, 2010 for the request, and
      b. assigning a reexamination control No. 95/001,516 (the '516 reexamination proceeding) to the request.

5. On February 16, 2011 the Office mailed a combined order granting the request for *inter partes* reexamination accompanied by an Office action and reexamination has proceeded.

6. On April 4, 2011, Patent Owner filed the instant Petition under 37 CFR 1.182 to vacate the filing date of the present reexamination proceeding asserting that the request for reexamination failed to:
   - accurately identity the real party in interest.

7. On April 14, 2011 the Requester filed the instant Opposition to the Patent Owner petition to vacate the filing date of the reexamination and a Petition under § 1.183, requesting entry of the Opposition.

III. Petition Under 37 CFR 1.182 for Vacatur

Petitioner (Patent Owner) notes that:[5]

1. identification of the real party in interest is essential to enforce the estoppel provisions to prevent further filings of reexamination with the patent office or presentation of arguments in court,
2. the Office has authority to question a facially inaccurate identification of the real party in interest, and
3. extrinsic evidence may be submitted to demonstrate a facial inaccuracy in the identification of the real party in interest.

Petitioner attempts to establish the facial inaccuracy of the identification of the real party in interest based on the asserted (1) the similarity of the invalidity contentions filed in the concurrent litigation to the asserted bases of the substantial new

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[1] Request transmittal form, at page 1, paragraph 2a.
[2] *Id.*, at page 1, paragraph 2b.
[3] *Id.* at page 2, paragraph 16 d.
[4] Further identified in the accompanying request for reexamination, page 6, as Kronotex U.S.A. LLC v. Faus Group, Inc. and Industrias Auxiliares Faus, S.L.U.
[5] Petition, page 3.

questions of patentability presented in the reexamination request, (2) familial relationship between the party identified as the real party in interest in the reexamination and the actual parties to the concurrent litigation, and (3) behaviour of the defendants in the concurrent litigation.

Petitioner believes that the parties to the concurrent litigation should also have been identified as real parties in interest in addition to the one party who was so identified, but who is not a party to the concurrent litigation.

Similarity of invalidity contentions and asserted grounds of a substantial new question of patentability:[6]

Petitioner points out that of the nine primary references relied upon as presenting a substantial new question of patentability five were included in the earlier filed invalidity contentions in the concurrent litigation to which Kronopol is not a party to. Fourteen of the 18 alleged new questions of patentability were the same or similar to the invalidity contentions in the litigation. A side-by-side comparison is given as an example of this almost exact similarity.

Familial relationship:[7] The party identified as the real party in interest, Kronopo, and the defendants in the concurrent litigation are asserted to be sister companies that are under the control and direction of the same parent company, Krono Holdings AG. Kronopol is stated to not be acting on its own accord or financing based on the familial relationship, and the following that has been publically stated in an identified web site:

> Krono Holding AG is responsible for the strategic direction of the Group, supporting them in the area of long-term financing and development. The main Board and management at Krono Holding, decide on the use of resources in area such as product and process development, market positioning, research and development, and other investment opportunities.

Defendant behaviour:[8] The issuance by the defendant of a threat that a reexamination request would be filed, the request resulting in the present procedding being filed shortly thereafter, and the defendants' reliance on the filing of the reexamination request to support a motion to stay the litigation pending reexamination is believed to clearly show participation by the defendants in the preparation of the reexamination request.

IV. Petition under 37 CFR 1.183 for entry of Opposition and Decision Thereon

Third party petitioner (Requester) seeks entry of the Opposition to the Patent Owner Petition for vacatur of the reexamination filing date, such as by waiver of § 1.939(a).

Section 1.939(a) provides:

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[6] Petition, pages 4 and 5.
[7] Petition, pages 5 and 6.
[8] Petition, page 6.

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

Because the Opposition sheds light on the proper identification of the real party in interest, as noted below, and in addition the requester has a right to defend against vacating its requires, the Petition for waiver is granted.

V. Requester Opposition to Patent Owner Petition for Vacatur

The Opposition argues that the petition for vacatur of the reexamination filing date should be dismissed in that (1) the reexamination request complies with applicable statute and rules, (2) the Office lacks the authority and the tools to question the facially accurate unambiguous identification of the real party in interest, (3) it is premature to investigate the identity of the real party in interest, and (4) the petition for vacatur has not provided clear and objective evidence that the identification of the real party in interest is not accurate.

Compliance with statute and rules:[9] It is asserted that the statute and the rules require identification of the real party in interest to permit a future *inter partes* requester of the same patent to (1) make a certification that the future requester is not prohibited from filing the request by estoppel provisions (37 CFR 1.915(b)(7)), and (2) to permit the future requester to determine whether the requester is a privy with an earlier requester (37 CFR 1.915(b)(8)).

The Opposition notes that the request documents clearly and accurately identify the real party in interest and there can be no ambiguity arising from the face of the request documents as to who has been identified as the real party in interest. Accordingly, a future requester can examin its relationship with the identified real party in interest to determine whether the future requester is a privy.

Office lack of authority and tools:[10] Reference is made to a particular rule making[11] where the Office has stated that it does not intend to look beyond a certification by the requester as to who the real party in interest is. References are also made to several other *inter partes* reexaminations containing prior decisions[12] where the Office has stated that it lacks the authority and the tools to conduct an investigation related to identification of the real party in interest. The Office has recognized that the issue should be addressed by a court that would have the proper discovery tools.[13]

Premature:[14] It is pointed out that the instant reexamination is the only reexamination directed to the '061 patent (a second reexamination proceeding has

[9] Opposition, pages 2-4.
[10] Opposition, pages 4-6.
[11] 654 Fed. Reg. 76756, 76759 (Dec. 7, 2000).
[12] Control No. 95/001,206, June 22, 2010 Decision; Control No. 95/000,166, November 9, 2007 Decision; Control No. 95/000227, June 8, 2007 and September 7, 2007 Decisions.
[13] Opposition, page 8.
[14] Opposition, pages 6-8.

not been filed), and there has been no final appealable decision in the concurrent litigation to trigger the issue as to whether the instant reexamination should be maintained. Accordingly, the determination of the real party in interest is urged not to be ripe for consideration. Rather, the Patent Owner in alleging that the identified real party in interest is really a "straw man" for the group of defendants in the concurrent litigation is "setting the stage" for the possibility of provoking the estoppel provisions, which is not yet a timely issue until the filing of a second *inter partes* reexamination request.

No evidence of participation: The Opposition believes that the assertions made by Petitioner - (1) the concurrent litigations defendants substantially participated in the reexamination request, (2) the familial relationship between the concurrent litigation defendants and the identified real party in interest in the reexamination request, and (3) the behaviour of the concurrent litigation defendants - do not factually establish that the real party in interest has been misidentified.

Participation:[15] It is asserted that - While the evidence establishes that there are similarities between the invalidity contentions in the concurrent litigation and the proposed rejections in the reexamination request, the evidence does not establish how the similarities arose. Any collaboration or sharing of information has not been shown to be for the purpose of the instant reexamination request. An explanation is provided whereby Kronopol being a sister company of some of the concurrent litigation defendants learned it would be a third party beneficiary of any license that resulted from settlement negotiations and upon later learning that the negotiations had been unsuccessful independently decided to file the instant reexamination.

Any possession by Kronopol of the invalidity contentions is alleged not to be indicative of participation by the concurrent litigation defendants in the preparation of the reexamination request. While the invalidity contentions are not publically available, they were readily obtainable by Kronopol due to its status as a sister company to the concurrent litigation defendants.

Familial relationship:[16] The Opposition points out that a corporate relationship does not *ipso facto* translate into the related entities being real parties in interest when one of the entities files a request for reexamination. The web site language referred by Petitioner relates to product and process development and other matters, but does not state or imply any other entity controls Kronopol's legal affairs or that there was any input or financing for the instant reexamination request. It is explicitly stated that:

> "Kronopol is acting independently and on its own accord for its own self-interest, is financing the instant *inter partes* reexamination, without receiving any payment from Krono Holding or any Krono Entity Defendant, and is the real party in interest."[17]

[15] Opposition, pages 9-15.
[16] Opposition, pages 15-17.
[17] Opposition, page 17.

Behaviour of the concurrent litigation defendants:[18] The Opposition states that the threat of a reexamination filing is not tantamount to a statement that the concurrent litigation defendants would be filing a specific reexamination request. Similarly, the reliance on the filing of a reexamination request to seek a stay in the concurrent litigation pending the reexamination does not translate to a role in filing of the request.

VI. Decision on the Patent Owner § 1.182 Petition for Vacatur

The § 1.182 petition by patent owner seeking vacatur of the *inter partes* reexamination based on the failure to correctly identify the real party in interest to include the defendants in the concurrent litigation is dismissed.

The MPEP[19] makes it clear that the Office does not look beyond the required certification in the request for reexamination, except for the rare instance where a challenge to the sufficiency of the certification facially establishes that the identified real party in interest is not accurate. The certification cannot be successfully challenged merely because, at one point, the certified real party in interest was "involved" with another party, or there was some collaboration in a matter other than the request for reexamination.

The Office declines to establish a per se rule that a familial relationship between parties, such as between two subsidiaries of a corporation, or a corporation and one if its subsidiaries, on its face without more, would be enough to establish both parties as real parties in interest in a reexamination filed by one party.

Moreover, the common interest among litigation defendants seeking to invalidate or defend against enforcement of a patent, such as in the litigation identified by Patent Owner, and a sister company not a party to the litigation does not translate *ipso facto* into each defendant being a real party in interest where a request for reexamination is filed by the sister company. This is not to say that concurrent litigation defendants cannot be real parties in interest with the sister company in the instant request for reexamination, but such result must be shown and not merely speculated on or theorized about. If, in fact, it could be evidenced that the parent company directed one sister to litigate, and another sister to file the reexamination request to influence the litigation, than an issue would be raised as to whether the litigating sister company is a real party in interest in the filing of the reexamination request, and as to whether the sister companies are in privy with each other. To be required to be named as a real party in interest, a party must participate, contribute, or direct that action be taken in some concrete manner in the request for reexamination. This is not a situation where it can be argued that the Requester (sister company), being a defendant in the concurrent litigation, was a joint participant in the preparation of the litigation defense, which defense was then utilized in the reexamination request

[18] Opposition, pages 17-18.
[19] MPEP § 2612.

– the sister company is not a joint defendant. Even if such were the case, preparation of an invalidity defense, based on found and evaluated prior art to support a concurrent litigation defense, does not amount to participation, contribution, or directing that action be taken by all the defendants in a request for reexamination by one of the defendants based on such joint activity, where the joint activity was conducted with only an intent to defend the concurrent litigation suit. Evidence that the joint activity was also conducted with an intent to file an *inter partes* reexamination request is required, in order for a petitioner to establish that other concurrent litigation defendants are real parties in interest with the concurrent litigation defendant filing the reexamination request.

Notwithstanding any actual benefit that would result to the concurrent litigation defendants from a favorable result in the reexamination, or their ability to request a litigation stay based on the reexamination request, the question of whether a defendant in the litigation is a real party in interest in the reexamination must be determined on a case-by-case basis focusing on **the showing** of a party's participation, contribution, or directing that action be taken in regard to the filing of a request for reexamination, and not ancillary matters, such as the defendants taking advantage of the reexamination request, or the request taking advantage of arguments in the subsequent reexamination request that were previously drafted by others for the concurrent litigation. For example, if the Office were to follow petitioner's line of reasoning, a patent owner might challenge an identification of the real party in interest in a reexamination where a third party requester not involved in the litigation and ignorant thereof, was to file a request for reexamination of the patent in litigation utilizing one or more pieces of prior art employed by the unrelated defendants in the litigation. The third party requester could be placed in a position of having to prove a negative – that it was not supported by the litigation defendants. Similarly, here, the Office will not require the Requester to prove a negative – that the concurrent litigation defendants did not participate in the reexamination. The fact that a first party defended itself in litigation, and another party defendant or sister company to one or more defendants later filed a request for reexamination related to the patent in litigation utilizing in-part that defense, should not doom the first party to life as a real party in interest for any request for reexamination that may be later filed utilizing part of that defense. Rather, the burden is on the challenging Patent Owner to provide evidence of participation contribution, or directing that action be taken as to the reexamination request.

It may be that a particular defendant in a litigation or in the instant situation a sister company thereto (whose actions are not subject to any control by its sibling) has decided to proceed with a request for reexamination in the face of hostile opposition by one or more other defendants in the litigation (who would rather settle the matter in court, than before the Office, based on the nature of their case) who should therefore not be embraced as a real party in interest in the request for reexamination. To do so, would result in estoppel against parties who had no control over the request for reexamination. None-the-less, using petitioner's theory that the defendants in the litigation must be deemed to be real parties in interest in the sister company's initial reexamination request of the patent in litigation, the litigation

defendants could then be barred (under 35 U.S.C. § 317(a)) from raising other known prior art that they may feel is better in a subsequent request for reexamination after the first request has been ordered.

In deciding a petition for vacatur, the Office will not engage in conjecture as to the participation in the request for reexamination of any particular alleged unnamed real party in interest. For purposes of this decision, it is not disputed that the concurrent litigation defendants may be impacted and even benefit from the filing of the instant reexamination. However, it is incumbent upon Patent Owner to present objective evidence that a party not identified as a real party in interest in fact participated in the request for reexamination, or in the reexamination proceeding after the request was filed.

A. The Identification Of The Real Party In Interest Is Not Facially Inaccurate Or Ambiguous. Therefore, The Office Lacks The Authority And The Tools To Question That Identification.

The arguments presented in the § 1.182 petition for vacatur fail to establish that the Office has the authority to question the accuracy of a third party requester's facially accurate and unambiguous identification of the real party in interest in this *inter partes* reexamination proceeding, or the tools to competently conduct an investigation of the matter.

To the extent that Patent Owner argues that the Office has the ability to investigate the accuracy of the identification of the real party in interest in an *inter partes* reexamination proceeding, or to issue a Show Cause Order requiring the identified real party in interest to confirm that it, and it alone, is the real party in interest, Patent Owner does not make a persuasive case that the Office is required to do so by either the reexamination statute or the reexamination regulations, when the *inter partes* reexamination as filed contains, contains on its face, an unambiguous identification of the identity of the real party in interest.[20]

Patent Owner's argument is not persuasive, because it does not reflect the intent of the provisions of 37 CFR 1.915(b)(7) and (b)(8). A certification statement made pursuant to 37 CFR 1.915(b)(7) is a statement by the third party requester to the effect that the third party requester is not itself estopped by the statutory estoppel provisions from filing a request for *inter partes* reexamination of a given patent. The *inter partes* rule making at 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), provides that:

> It should be noted that the Office generally will not have a need to resolve the factual issue of whether or not one party is a privy of another party. Section 1.915(b)(7) requires a third party requester to certify that the estoppel provisions of §1.907 do not prohibit the filing of the *inter partes* reexamination request, and the Office does not intend to look beyond this

[20] The Requester has in fact confirmed that it has identified the only real party in interest. Opposition, page 17.

> required certification. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would then need to be addressed.

A substantially identical statement also appears at 65 Fed. Reg. at 76764. These statements establish that the Office will, only in the rare instance that it is necessary to do so (a facial showing of inaccuracy or an ambiguity), "address" the accuracy of a certification that statutory estoppel does not bar the filing of a request for *inter partes* reexamination. Further, the rule making does not discuss the type or depth of investigation that can and will be undertaken, and it does not state or imply that a patent owner may trigger an investigation of the accuracy of the certification merely by advancing an unsupported allegation that another party is a real party in interest (by way of having participated in the reexamination request).

This is not an instance where the identification of the real party in interest required by 37 CFR 1.915(b)(8) is ambiguous or facially inaccurate, in which instance the third party requester who is before the Office can be queried by the Office, because the record is not clear at that point in time (*i.e.*, the ambiguity causes an issue that is ripe for consideration due to a required request statement being ambiguous). Since the present record in the instant reexamination proceeding is not ambiguous as to the identification of the real party in interest (and Patent Owner has provided no persuasive extrinsic evidence to establish ambiguity), there is no basis to proceed any further in this proceeding as to the matter.

Aside from the above, another reexamination proceeding that would be the subject of the above-cited paragraph of the rule making notice has not yet been filed, nor has a final decision apparently issued in the Federal Court litigation; thus the issue is not ripe for consideration (see discussion in part B. below). If the issue does become ripe for consideration via another reexamination proceeding filed by a subsequent requester (who is one of the co-defendants), the subsequent third party requester making such statement would become a party appearing before the Office. In other words, an actual defendant, *i.e.*, the subsequent third party requester, would then be available to be asked by the Office to clarify or support a 37 CFR 1.915(b)(7) certification statement that is asserted to be inaccurate. Presumably, that third party requester would be able to respond based on facts wholly within its knowledge and possession. The Office would be able to obtain information from the Patent Owner and the subsequent third party Requester, and would have no need to obtain information from a party not before the Office by reason of the filing of a first request for *inter partes* reexamination.

Apart from the inherent ability of the Office to issue an Show Cause Order directed to a party that <u>is before the Office</u>, Patent Owner does not point to any regulation that would provide a mechanism for conducting an investigation directed to determining whether parties not before the Office are in fact real parties in interest in an *inter partes* reexamination proceeding. For example, 37 CFR 1.105 was promulgated pursuant to 35 U.S.C. §§ 131 and 132, statutes that relate to the examination of applications and (via incorporation by the reexamination statute) the

conduct of reexamination proceedings as to patentability. The regulation was promulgated for the purpose of requiring submission of information material to patentability from persons having a duty under 37 CFR 1.56 to disclose information to the Office that is material to patentability.[21] The identification of the real party in interest has no relationship to the duty to disclose information that is material to patentability (which applies to an applicant for patent and to a patent owner in a reexamination proceeding).[22] With respect to obtaining information from a party who is alleged to be an undisclosed real party in interest in an *inter partes* reexamination proceeding, it is not apparent how 37 CFR 1.105 could be applied to a party who is not before the Office in that proceeding.

Therefore, where a patent owner who is a party in an *inter partes* reexamination proceeding believes that an identification of the real party in interest is inaccurate, even though it is facially unambiguous, the courts are the appropriate venue from which the patent owner should seek relief to obtain evidence extrinsic to the record, for incorporation into the record. It is to be noted that there is precedent on the issue of "real party in interest" in the federal courts, on matters ranging from jurisdiction (*e.g.*, presence of diversity or amount of suit)[23] to actions in which the principle is applied to prevent multiple or conflicting lawsuits by persons such as assignees.[24] These examples of court proceedings resolving "real party in interest" issues demonstrate the reason why the Office cannot perform such a function here. Upon obtaining jurisdiction over the parties, courts may order discovery, taking of testimony with cross-examination and use of other evidentiary tools, while enforcing compliance with its requirements via its subpoena power and power to impose sanctions. Accordingly, the courts are the forums best equipped to determine who is, and who is not, the "real party in interest" when there is a reason to doubt the third party requester's identification of a party or parties as being the real party in interest in an *inter partes* reexamination proceeding. Further, courts may provide relief, as appropriate, by enjoining the filing of a further *inter partes* reexamination request by the other parties in a civil action. Once a court has determined that a party is a "real party in interest," the Office can make use of that determination to bar the filing of a subsequent *inter partes* reexamination request by that party. Of course at that point, the party could file an *ex parte* reexamination proceeding, the filing of which does not require identification of "a real party in interest" (35 U.S.C §§ 301 and 302), and is not prohibited by statute or rule, even after an *inter partes* reexamination was filed by the same real party in interest.[25]

A patent owner concerned with the issue of misidentification of the real party in interest in a request for *inter partes* reexamination may immediately seek relief from the alleged erroneous identification of the "real party in interest" via the courts,

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[21] 65 Fed. Reg. 54604, 54633, (Sept. 8, 2000).

[22] See 37 CFR 1.933, which refers back to 37 CFR 1.555, which in turn, references 37 CFR 1.105. These regulations do not create a duty to disclose information material to patentability (or any duty of disclosure) that attaches to a reexamination third party requester.

[23] *Varlotta Construction Corporation v. Carla Development Corporation*, 886 F. Supp 315 (E.D.N.Y. 1995).

[24] *First Hartford Corporation Pension Plan & Trust v. United States*, 194 F.3d 1279 (Fed. Cir. 1999).

[25] If the court makes a finding that the "real party in interest" was misstated, the Office can then take action, if appropriate, based upon the court's findings.

which possess the tools to investigate and obtain information as to the relationship of the parties to ascertain the veracity of the identified "real party in interest." The present petition is silent as to why Patent Owner did not approach the appropriate District Court for relief (*e.g.*, an investigation into the matter and an appropriate order). Given the emphasis that petitioner Patent Owner has placed on the importance of the "real party in interest" disclosure requirement, it would appear that Patent Owner could have immediately sought relief in the appropriate court regarding the identity of the real party in interest. The record does not show that Patent Owner has done so. The Office may consider that it is "the sole agency that administers the patent statute,"[26] and the Office certainly conducts the *inter partes* proceeding; however, it is common knowledge that the federal courts (which are not an agency in the sense used in the *inter partes* reexamination rule making) routinely adjudicate matters arising under the patent statute. Further, Patent Owner should appreciate the difference between conducting a reexamination proceeding, which is the province of the Office, and enforcing an estoppel provision of Federal law as a matter of equitable relief. Patent Owner has not provided any basis for believing that the district courts lack authority to act as described above.

As a final point in this section of the decision as to the Office lacking the authority to investigate: The reexamination statute requires, *inter alia*, that a request for *inter partes* reexamination proceeding "shall ... include the identity of the real party in interest... ."[27] The *inter partes* reexamination rules require that a request for *inter partes* reexamination include, *inter alia*, "[A] statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that party is a privy."[28] Requester has clearly stated that Kronopol is the real party in interest, and that is an identification to a sufficient extent that "a party, such as a concurrent litigation defendant, filing a subsequent *inter partes* reexamination request" can look into its interaction with the identified Kronopol to "determine whether that person is a privy" with the real party in interest that filed the present reexamination. Neither the *inter partes* reexamination statute nor the *inter partes* reexamination rules imposes a duty on the Office to investigate the accuracy of an unambiguous identification of the real party in interest in a third party requester's request for *inter partes* reexamination proceeding.

In the present *inter partes* reexamination proceeding, the real party in interest is unambiguously identified in the current record. The identification of the real party in interest does not appear to be facially inaccurate. The Office will refuse to accord a filing date to a request for *inter partes* reexamination that does not identify the real party in interest, or which provides an identification of the real party in interest that is ambiguous or facially inaccurate. If the Office accords a filing date to a request for *inter partes* reexamination, and later discovers an ambiguity or a facial inaccuracy in the identification of the real party in interest, the Office can, and will, require that a party appearing before it as third party requester in an *inter partes* reexamination

[26] 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), emphasis added.
[27] 35 U.S.C. § 311(b)(1).
[28] 37 CFR 1.915(b)(8).

proceeding clarify the ambiguity or facial inaccuracy. However, it does not follow that the Office is empowered to conduct an investigation into the identity of the real party in interest when the statement identifying the real in interest in the record of an *inter partes* reexamination proceeding is neither facially inaccurate nor ambiguous. The Office will not conduct an investigation into the accuracy of the identification of the real party interest in the instant reexamination proceeding, because there is no legal reason to do so, even if the Office's ability to do so could be shown (which it has not been, as discussed above).

B. The Office Has No *Present* Duty To Investigate The Identity Of The Real Party In Interest In The Instant *Inter Partes* Reexamination Proceeding.

It is also to be noted that, in the instant reexamination proceeding, Patent Owner is requesting relief based upon an injury that has not yet occurred, and may never occur, even according to Patent Owner's view of the situation. Patent Owner does not allege that the named real party in interest is itself estopped from filing and participating in the instant reexamination proceeding. Rather, Patent Owner's concern must be that Patent Owner might be harassed by the filing of a subsequent request for *inter partes* reexamination of the patent or that the instant reexamination will be inappropriately maintained by a party that should have been identified as a real party in interest in the instant reexamination proceeding, but was not so identified. Such a hypothetical party, as a real party in interest in the instant reexamination proceeding, would be subject to a statutory estoppel that could preclude (if the statutory provisions are satisfied) its filing of another *inter partes* reexamination proceeding, or from maintaining the instant reexamination proceeding if such a party "loses" as a defendant in any litigation of the patent. While a patent owner is statutorily entitled to be protected from harassment by the filing of a subsequent request for *inter partes* reexamination of the patent by a party who is estopped from filing such a request, the record simply does not show that such a circumstance presently exists as to the instant reexamination proceeding. No additional requests for *inter partes* reexamination of the patent have been filed by any defendant in the concurrent litigation, nor is the only identified litigation (as to the patent) final. Thus, clearly there is presently no cause for concern that a misidentification of the real party in interest has permitted a party subject to statutory estoppel to file an additional request for *inter partes* reexamination of the patent or inappropriately maintained the instant one. Patent Owner's arguments relative to Kronopol being commonly owned and controlled are matters of whether privity exists between Kronopol and the litigation defendants that would bar a subsequent reexamination request by the litigation defendants.

Accordingly, there is no need to consider addressing the relief requested by Patent Owner in the present *inter partes* reexamination proceeding, since Patent Owner cannot have been injured by the filing of another request for *inter partes* reexamination for the patent or by maintaining a reexamination that is barred by statutory estoppel.

C. Synopsis

Rather than having presented clear and undisputed evidence establishing that Kronopol is not the only real party in interest in the instant reexamination proceeding, the petition is supported only by supposition and conjecture on Patent Owner's part. Accordingly, Patent Owner has not demonstrated a persuasive basis for the requested relief of vacatur of the filing date of the instant reexamination proceeding or issuance of a show cause order why the filing date should not be vacated. Therefore, such request for relief is dismissed.

VII. CONCLUSION

1. The April 4, 2011 Patent Owner § 1.182 petition seeking vacatur of the reexamination is dismissed.

2. The April 14, 2011 third party Requester § 1.183 petition for entry of a concomitant Opposition to the Patent Owner petition has been granted and the Opposition entered.

3. Telephone inquiries related to this decision should be directed to Hiram H. Bernstein, Senior Legal Advisor, at (571) 272-7707.

/Kenneth M. Schor/

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

12-19-11
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APPENDIX OF RELEVANT STATUTORY, REGULATORY AND PRACTICE PROVISIONS

35 U.S.C. § 311 Request for inter partes reexamination.

(a) IN GENERAL.— Any third-party requester at any time may file a request for inter partes reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.
(b) REQUIREMENTS.— The request shall—
(1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an inter partes reexamination fee established by the Director under section 41; and
(2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.

35 U.S.C. § 315 Appeal.

* * * * *

(c) CIVIL ACTION.— A third-party requester whose request for an inter partes reexamination results in an order under section 313 is estopped from asserting at a later time, in any civil action arising in whole or in part under section 1338 of title 28, the invalidity of any claim finally determined to be valid and patentable on any ground which the third-party requester raised or could have raised during the inter partes reexamination proceedings. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

35 U.S.C. § 317 Inter partes reexamination prohibited.

(a) ORDER FOR REEXAMINATION.— Notwithstanding any provision of this chapter, once an order for inter partes reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for inter partes reexamination of the patent until an inter partes reexamination certificate is issued and published under section 316, unless authorized by the Director.
(b) FINAL DECISION.— Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an inter partes reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

37 CFR 1.105 Requirement for information.

(a)(1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

(i) *Commercial databases*: The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.

(ii) *Search*: Whether a search of the prior art was made, and if so, what was searched.

(iii)*Related information*: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(iv) *Information used to draft application*: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v) *Information* used in invention process: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) *Improvements*: Where the claimed invention is an improvement, identification of what is being improved.

(vii) *In Use*: Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(viii) *Technical information* known to applicant.

Technical information known to applicant concerning the related art, the disclosure, the claimed subject matter, other factual information pertinent to patentability or concerning the accuracy of the examiner's stated interpretation of such items.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(i), (iii), and (vii) of this section may also be applied to such assignee.

(3) Requirements for factual information known to applicant may be presented in any appropriate
manner, for example:

(i) A requirement for factual information;

(ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or

(iii) Stipulations as to facts with which the applicant may agree or disagree.

(4) Any reply to a requirement for information pursuant to this section that states either that the information required to be submitted is unknown to or is not readily available to the party or parties from which it was requested may be accepted as a complete reply.

(b)The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section will be governed
by §§ 1.135 and 1.136.

37 CFR 1.907 *Inter Partes* reexamination prohibited.

(a) Once an order to reexamine has been issued under § 1.931, neither the third party requester, nor its privies, may file a subsequent request for *inter partes* reexamination of the

patent until an *inter partes* reexamination certificate is issued under § 1.997, unless authorized by the Director.
(b) Once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. 1338 that the party has not sustained its burden of proving invalidity of any patent claim-in-suit, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such civil action, and an *inter partes* reexamination requested by that party, or its privies, on the basis of such issues may not thereafter be maintained by the Office.
(c) If a final decision in an *inter partes* reexamination proceeding instituted by a third party requester is favorable to patentability of any original, proposed amended, or new claims of the patent, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claims on the basis of issues which that party, or its privies, raised or could have raised in such *inter partes* reexamination proceeding.

37 CFR 1.913 Persons eligible to file request for *inter partes* reexamination.

Except as provided for in § 1.907, any person other than the patent owner or its privies may, at any time during the period of enforceability of a patent which issued from an original application filed in the United States on or after November 29, 1999, file a request for *inter partes* reexamination by the Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501.

37 CFR 1.915 Content of request for *inter partes* reexamination.

(b) A request for *inter partes* reexamination must include the following parts:
(7) A certification by the third party requester that the estoppel provisions of § 1.907 do not prohibit the inter partes reexamination.
(8) A statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy.

...

(d) If *the inter partes* request does not include the fee for requesting *inter partes* reexamination required by paragraph (a) of this section and meet all the requirements of paragraph (b) of this section, then the person identified as requesting *inter partes* reexamination will be so notified and will generally be given an opportunity to complete the request within a specified time. Failure to comply with the notice will result in the *inter partes* reexamination request not being granted a filing date, and will result in placement of the request in the patent file as a citation if it complies with the requirements of § 1.501.

37 CFR 1.919 Filing date of request for *inter partes* reexamination.

(a) The filing date of a request for *inter partes* reexamination is the date on which the request satisfies all the requirements for the request set forth in § 1.915.

§ 1.939 Unauthorized papers in *inter partes* reexamination

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

(b) Unless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the *inter partes* reexamination.

§ 1.985 Notification of prior or concurrent proceedings in *inter partes* reexamination.

(a) In any *inter partes* reexamination proceeding, the patent owner shall call the attention of the Office to any prior or concurrent proceedings in which the patent is or was involved, including but not limited to interference, reissue, reexamination, or litigation and the results of such proceedings.

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

MPEP § 2612 Persons Who May File a Request

37 CFR 1.907 defines specific situations where a third party is prohibited from filing a request for an inter partes reexamination. 37 CFR 1.915(b)(7) requires the third party requester to certify that the estoppel provisions of 37 CFR 1.907 do not prohibit the filing of the inter partes reexamination request by the real party in interest (note that it is the real party in interest that is subject to the estoppel provisions and not the party who actually files the request). The certification identified in 37 CFR 1.915(b)(7) will constitute a prima facie showing that the party requesting the inter partes reexamination is not barred from doing so under 37 CFR 1.907. The Office does not intend to look beyond this required certification. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would then need to be addressed. A challenge to the accuracy of the certification must facially establish that the third party requesting the inter partes reexamination is barred from doing so under 37 CFR 1.907. Thus, for example, the challenger cannot rely on an argument that the third party requesting reexamination was, at one point, involved with a party barred under 37 CFR 1.907, and should thus be considered as a real party in interest (and barred from filing the request). Involvement *per se* does not facially establish that the other party is a real party in interest. The fact that a second party may benefit from an earlier reexamination request filed by a first party or a civil action conducted by the first party, or that the second party may have collaborated with the first party in a matter, does not facially evidence the second party was a real party in interest with the first party. With respect to the Office conducting an investigation to uncover whether the second party was a "real party in interest," the statute does not require, nor does it provide the tools, for the Office to investigate such matter. Further, Congress has not provided the Office with subpoena power or discovery tools and has not provided the Office with the ability to conduct hearings for eliciting testimony and cross-examination. The Office has not been authorized to impose punitive sanctions for non-compliance. Such evidentiary tools are, however, available to the courts, which are the appropriate vehicle to make a factual investigation as to the accuracy of the identification of a "real party in interest."

MPEP § 2614 Content of Request for *Inter Partes* Reexamination

The reexamination request must identify the real party in interest who is responsible for filing the reexamination request. This information will be used by future parties requesting reexamination of the same patent, in making the certifications required by 37 CFR 1.915(b)(8).

MPEP 2625 Untimely Paper Filed Prior to First Office Action

Pursuant to 37 CFR 1.939, after filing of a request for *inter partes* reexamination, no papers directed to the merits of the reexamination other than (A) citations of patents or printed publications under 37 CFR 1.501 and 1.933, (B) another complete request under 37 CFR 1.510 or 37 CFR 1.915, or (C) notifications pursuant to MPEP § 2686, should be filed with the Office prior to the date of the first Office action in the reexamination proceeding. Any papers directed to the merits of the reexamination, other than those under 37 CFR 1.501, 1.933, 1.510 or 1.915, or under MPEP § 2686, filed prior to the date of the first Office action will be returned to the sender without consideration. >If the papers are entered prior to discovery of the impropriety, such papers will be expunged from the record.< A copy of the letter *>providing notification of< the returned papers >or expungement< will be made of record in the patent file. However, no copy of the *>returned/expunged< papers will be retained by the Office. If the submission of the *>returned/expunged< papers is appropriate later in the proceedings, they may be filed, and accepted by the Office, at that time. See *Patlex Corp. v. Mossinghoff*, 771 F.2d 480, 226 USPQ 985 (Fed. Cir. 1985); *In re Knight*, 217 USPQ 294 (Comm'r Pat.1982); and *In re Amp*, 212 USPQ 826 (Comm'r Pat. 1981) which addressed the situation analogous to the present situation for *ex parte* reexamination proceedings.

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JAN 11 2012

CENTRAL REEXAMINATION UNIT

McKenna Long and Aldridge LLP
c/o Song K. Jung
1900 K Street NW
Washington, DC 20006

For Patent Owner

Andrew M. Calderon
Roberts, Mlotkowski, Safran & Cole, P.C.
P.O. Box 10064
McLean, VA 22102-8064

3d Party Requester

Inter Partes Reexamination Proceeding
Control No. 95/001,516
Filed: December 23, 2010
For: U.S. Patent No. 6,688,061

DECISION ON PETITION
UNDER 37 CFR 1.59

This is a decision on the petition under 37 CFR 1.59(b), filed October 6, 2011, to expunge information from the above identified reexamination proceedings, which information is deemed to be subject to a Protective Order associated with pending litigation in *Kronotex U.S.A. LLC, v. Faus Group Inc., et al.,* Case No. 1:09-cv-2583-JEC.

The decision on the petition will be held in abeyance until the issuance of the Notice of Intent to Issue *Inter Parts* Reexamination Certificate (NIRC) is mailed.

Petitioner requests that material that is subject to a protective order, submitted in a sealed envelope on October 6, 2011, be expunged from the file of the above referenced reexamination proceeding if found not to be material to patentability. The request purports to have been filed in compliance with the requirements of MPEP § 724.02.

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

Reexam Control Nos. 95/001,516

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

Telephone inquiries with regard to this decision should be directed to Andres Kashnikow, Supervisory Patent Reexamination Specialist in the Central Reexamination Unit, Art Unit 3993, at (571) 272-4361.

Andres Kashnikow, SPRS
Central Reexamination Unit 3993

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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,518	01/10/2011	7037321	132.0007-02REX	3178

22882 7590 02/22/2012

MARTIN & FERRARO, LLP
1557 LAKE O'PINES STREET, NE
HARTVILLE, OH 44632

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/22/2012

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ARNOLD & PORTER LLP
ATTN: IP DOCKETING DEPT.
555 TWELFTH STREET, NW
WASHINGTON, DC 20004-1206

Date: MAILED
FEB 22 2012
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001518
PATENT NO. : 7037321
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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FEB 22 2012

CENTRAL REEXAMINATION UNIT

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ARNOLD & PORTER LLP (For 95/001,518 Requester)
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ANDREW J. VANCE, ESQ. (For 90/009,876 Requester)
FINNEGAN HENDERSON FARABOW ET AL.
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WASHINGTON, DC 20001-4413

FISH & RICHARDSON P.C. (DC) (For 95/001,556 Requester)
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

Inter Partes Reexamination Proceeding Control No. 95/001,518 Filed: January 10, 2011 For: U.S. Patent No. 7,037,321 B2	
Ex Parte Reexamination Proceeding Control No. 90/009,876 Filed: February 15, 2011 For: U.S. Patent No. 7,037,321 B2	**DECISION ON PETITIONS AND MERGING REEXAMINATION PROCEEDINGS**
Inter Partes Reexamination Proceeding Control No. 95/001,556 Filed: February 25, 2011 For: U.S. Patent No. 7,037,321 B2	

This is a decision on the following patent owner petitions:

(1) Petition entitled "Petition Under 37 C.F.R. § 1.183 to Waive the Requirement Under 37 CFR 1.939(b)" filed on December 13, 2011 in reexamination proceeding 95/001,556;

(2) Petition entitled "Petition Under 37 C.F. R. § 1.182 to Stay Proceeding or, in the Alternative, not Merge Proceedings" filed on December 13, 2011 in reexamination proceeding 95/001,556; and

(3) Petition entitled "Petition Under 37 C.F. R. § 1.182 to Stay Proceeding or, in the Alternative, not Merge Proceedings" filed on December 13, 2011 in reexamination proceeding 90/009,876.

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

SUMMARY

The patent owner's December 13, 2011 petition under 37 CFR 1.183 filed in the 95/001,556 proceeding requesting waiver of the requirement under 37 CFR 1.939(b) in order to permit consideration of the concurrently filed patent owner petition under 37 CFR 1.182 in the 95/001,556 proceeding is **granted**.

For the reasons set forth below, the patent owner's December 13, 2011 petitions filed in the 90/009,876 and 95/001,556 proceedings requesting (1) that the 90/009,876 and 95/001,556 proceedings be suspended until the conclusion of the 95/001,518 proceeding or (2) in the alternative, that the 90/009,876 and 95/001,556 proceedings not be merged with the 95/001,518 proceeding, are **dismissed**.

Ex parte reexamination proceeding 90/009,876 and *inter partes* reexamination proceedings 95/001,518 and 95/001,556 **are merged** into a single proceeding.

REVIEW OF THE RELEVANT FACTS

1. On May 2, 2006, United States Patent Number 7,037,321 B2 ("the '321 patent") issued to Sachdeva et al., with claims 1-9.

2. On January 10, 2011, a first request for *inter partes* reexamination of claims 1, 2, and 7 of the '321 patent was filed by a third party requester and assigned Reexamination Control No. 95/001,518 ("the '518 proceeding"). The request identified Boston Scientific Corporation as the real party in interest.

3. On February 15, 2011, a request for *ex parte* reexamination of claims 1-3, and 7 of the '321 patent was filed by a third party requester and was assigned control number 90/009,876 ("the '876 proceeding").

4. On February 25, 2011, a second request for *inter partes* reexamination of claims 1-9 of the '321 patent was filed by a third party requester and assigned Reexamination Control No. 95/001,556 ("the '556 proceeding"). The request identified MicroStrategy Incorporated as the real party in interest.

5. On March 2, 2011, *inter partes* reexamination of claims 1, 2, and 7 of the '321 patent was granted in the '518 proceeding. The order stated that the patent owner waived its right under 37 CFR 1.530 to file a patent owner statement. The order was also accompanied by a non-final Office action rejecting claims 1, 2, and 7.

6. On March 28, 2011, *inter partes* reexamination of claims 1-9 of the '321 patent was granted in the '556 proceeding.

7. On April 2, 2011, *ex parte* reexamination of claims 1-3 and 7 of the '321 patent was granted in the '876 proceeding. The patent owner did not amend or add any claims.
8. On May 2, 2011, the patent owner timely filed a response to the March 2, 2011 non-final Office action in the '518 proceeding.

9. On June 1, 2011, the third party requester timely filed comments after the patent owner's response in the '518 proceeding.

10. On December 13, 2011, the patent owner filed a petition entitled "Petition Under 37 C.F. R. § 1.182 to Stay Proceeding or, in the Alternative, not Merge Proceedings" in the '876 proceeding.

11. On December 13, 2011, the patent owner filed a petition entitled "Petition Under 37 C.F.R. § 1.183 to Waive the Requirement Under 37 CFR 1.939(b)" in the '556 proceeding. The patent owner concurrently filed a petition in the '556 proceeding entitled "Petition Under 37 C.F. R. § 1.182 to Stay Proceeding or, in the Alternative, not Merge Proceedings."

12. On February 15, 2012, the patent owner filed a power of attorney and statement under 37 CFR 3.73(b) in the '518, '556, and '876 proceedings.

13. To date, no Office action has issued in either of the '556 and '876 proceedings.

DECISION

I. PATENT OWNER'S PETITION UNDER 37 CFR 1.183 REQUESTING WAIVER OF 37 CFR 1.939(B)

In the December 13, 2011 petition under 37 CFR 1.183 filed in the '556 proceeding, the patent owner requests waiver of the requirements under 37 CFR 1.939(b) that no paper shall be filed prior to the initial Office Action on the merits of an *inter partes* reexamination proceeding in order to permit consideration of the concurrently filed petition under 37 CFR 1.182 requesting stay or non-merger of the '556 proceeding. In support of its request for waiver of the rule, the patent owner argues that the Office recognizes situations where the requirements of 37 CFR 1.939(b) may be waived. The patent owner points out that such a situation is set forth in MPEP 2686.01(VI) where the Office will waive the requirements of 37 CFR 1.939(b) when deciding on a petition to merge multiple reexamination proceedings.

The December 13, 2011 patent owner petition under 37 CFR 1.183 is granted to the extent that the requirements of 37 CFR 1.939(b) are hereby waived to assure that the patent owner's concurrently filed petition under 37 CFR 1.182 requesting stay or non-merger of the '556 proceeding will be considered at the earliest possible stage.

II. PATENT OWNER'S PETITIONS UNDER 37 CFR 1.182 REQUESTING EITHER STAY OF THE '556 AND '876 PROCEEDINGS, OR NOT TO MERGE THESE PROCEEDINGS WITH THE '518 PROCEEDING

In the December 13, 2011 petitions under 37 CFR 1.182 filed in the '556 and '876 proceedings, the patent owner requests that these proceedings be stayed or not merged with the '518 proceeding. In support of its request to stay the '556 and '876 proceedings, the patent owner argues that the prosecution of the '518 proceeding is well under way and that proceeding with the prosecution of the '556 and '876 proceedings would delay the prosecution of the '518 proceeding. The patent owner contends that the delay would be due to the possibility that the concurrent prosecution of the same claims from each proceeding may lead to different results. Furthermore, the patent owner argues that staying the '556 and '876 proceedings would permit the '518 proceeding to conclude more quickly in accordance with special dispatch. In the alternative, the patent owner requests that the Office not merge the '556 and '876 proceedings with the '518 proceeding. In support of its requests for not merging these proceedings, the patent owner argues that merging these proceedings would also delay the prosecution of the '518 proceeding.

In response, the patent owner's arguments to stay or not merge the proceedings are found to be unpersuasive. Contrary to the patent owner's premise that the prosecution of the '518 proceeding is well under way, the prosecution of the '518 proceeding is still in the early stages of prosecution. Specifically, the Office issued a non-final Office action on March 2, 2011 in the '518 proceeding and the patent owner and the third party requester have respectively filed responses and comments on May 2, 2011 and June 1, 2011. No further action has been taken by the Office in the '518 proceeding. Therefore, merging the '556 and the '876 proceedings with the '518 proceeding at this point would not unduly delay the '518 reexamination proceeding. Furthermore, the Office does not have discretion to indefinitely suspend an *ex parte* reexamination proceeding pending conclusion of another reexamination proceeding. (*See*, *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988).)

Reexamination has been ordered in the '556, '876, and '518 proceedings for overlapping claims of the same patent. All proceedings are still pending and have not been terminated. In addition, in the '876 proceeding, the patent owner has waived the right to file a patent owner statement under 37 CFR 1.530.[1] Therefore, consideration of merger is now ripe.

MPEP 2686.01 points out:

[1] See page 2 of the April 2, 2011 Order granting *ex parte* reexamination in the '876 proceeding.

> Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with "special dispatch."

The 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. The general policy of the Office is that three reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the three proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in the three proceedings, and (3) to expedite the prosecution of the three proceedings.

In this instance, based upon the record as a whole, it is found, based on the facts as they exist at present, that merger of the three proceedings should facilitate the orderly handling of the proceedings with special dispatch. Accordingly, the '518, '556, and '876 proceedings **are hereby merged**. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

III. THE SAME CLAIMS MUST BE MAINTAINED IN ALL THREE PROCEEDINGS

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

IV. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with two *inter partes* reexamination proceedings. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the requester of the '876 *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560.[2] The examiner will conduct reexamination in the merged proceeding for claims 1-9 of the '321 patent.

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

[2] Active participation of the *ex parte* requester ends with the reply pursuant to 37 CFR 1.535 or the expiration of the time period for such reply. As such period has expired, further submissions on behalf of the *ex parte* requester will not be acknowledged or considered. *See* 37 CFR 1.550(g).

Upon merger of proceedings, all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2).[3] First, an *inter partes* requester's right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requester's right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requester's comments must be submitted within 30 days from the date of service of the patent owner's response.

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

2. Appeal Rights:

A discussion of an *inter partes* requester's appeal rights can be found in section G below.

C. Papers mailed/filed:

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

All papers filed by the patent owner and the *inter partes* requesters should be directed:

by Mail to:	Attn: Mail Stop "*Inter Partes* Reexam" Central Reexamination Unit Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450
by FAX to:	(571) 273-9900 Central Reexamination Unit
by Hand to:	Customer Service Window Attn: Central Reexamination Unit Randolph Building, Lobby Level 401 Dulany Street Alexandria, VA 22314

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

by EFS: Registered users may submit papers via the electronic filing system EFS-Web, at: https://efs.uspto.gov/efile/myportal/efs-registered

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

D. Amendments:

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

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

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

E. Fees:

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

F. Citation of Patents and Printed Publications:

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

G. Appeal Rights and Procedures Reminders for *Inter Partes* Reexamination

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP §§ 2674 through 2675 and 2678 through 2683.

With respect to the patent owner's notice of appeal, the appeal must only be taken from the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the patent owner proposes to contest, and must identify each claim rejected by examiner that the patent owner intends to contest.

With respect to an *inter partes* requester's notice of appeal, the appeal must only be taken from the finding(s) of patentability of claims in the RAN that the *inter partes* requester proposes to contest. As set forth in MPEP § 2674, the *inter partes* requester must identify in the notice of appeal each rejection that was previously proposed by that *inter partes* requester that the *inter partes* requester intends to contest and each rejection made and later withdrawn by the examiner that the *inter partes* requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the *inter partes* requester must identify each previously proposed rejection to be contested.

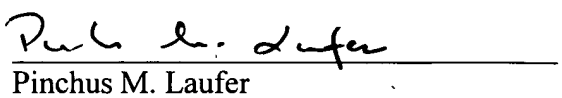
No new ground of rejection can be proposed by an *inter partes* requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the *inter partes* requester has not yet had an opportunity to propose it as an *inter partes* requester proposed ground of rejection. See 37 CFR 41.67(c)(1)(vi) as to the proposed rejections that an *inter partes* requester can challenge in the appellant brief.

It is to be noted that, because the '518 *inter partes* third party requester did not propose any rejections of claims 3-6, 8, and 9 in its request for reexamination, the '518 requester has no appeal rights as to those claims as they appear in the '321 patent.

CONCLUSION

1. *Ex parte* Reexamination Control No. 90/009,876 and *inter partes* Reexamination Control Nos. 95/001,518 and 95/001,556 are **merged into a single proceeding**, to be conducted in accordance with the procedure set forth above in Part IV of this decision.

2. Any questions concerning this communication should be directed to Susy Tsang-Foster, Legal Advisor, at 571-272-7711.



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

February 21, 2012

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,519	01/07/2011	7788169	094193.011300	7064

6449 7590 05/06/2011

ROTHWELL, FIGG, ERNST & MANBECK, P.C.
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WASHINGTON, DC 20005

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/06/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
GREENBERG TRAURIG, LLP
MET LIFE BUILDING
200 PARK AVENUE
NEW YORK, NY 10166

Date:

MAILED
MAY 06 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001519
PATENT NO. : 7788169
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

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

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

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

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

United States Patent and Trademark Office

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(For Patent Owner)

Greenberg Traurig, LLP
Met Life Building
200 Park Avenue
New York, NY 10166

(For Third Party Requester)

MAILED
MAY 06 2011
CENTRAL REEXAMINATION UNIT

In re Littlewood	:	
Inter partes Reexamination Proceeding	:	**DECISION DISMISSING**
Control No: 95/001,519	:	**PETITION TO**
Filing Date: January 7, 2011	:	**TERMINATE *INTER PARTES***
For: U.S. Patent No.: 7,788,169	:	**REEXAMINATION PROCEEDING**

This is a decision on patent owner's April 15, 2011 petition entitled "Petition to Terminate Reexamination Proceeding Under 35 U.S.C. § 317(b) and 37 CFR §§ 1.182, 1.907(b)" (the April 15, 2011 petition).

The April 15, 2011 petition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The $400 fee under 37 CFR 1.17(f) for patent owner's April 15, 2011 petition has been paid.

SUMMARY

The April 15, 2011 patent owner petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **dismissed**.

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/001,519 (the '1519 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

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

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

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

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,788,169 (the '169 patent), was the subject of a civil action in district court, i.e., *Investment Technology Group, Inc., et al. v. Liquidnet Holdings, Inc., et al.*, Civil Action No. 10-CF-6494 (S.D.N.Y.). The patent owner submits a copy of a stipulated order of dismissal, entered by the district court on March 31, 2011, in which the district court stated that the third party requester and real party in interest, Liquidnet Holdings, Inc., has not sustained its burden of proving the invalidity of claims 1-48 of the '169 patent, which satisfies item nos. 1 and 3. In addition, the patent owner has submitted a copy of the court's docket for the civil action at issue, thus showing that the order was entered before trial, i.e., at a sufficiently early stage of the litigation proceeding such that the requester/defendant could have introduced the prior art, and any other issues present in the '1519 reexamination proceeding, into the litigation, had the litigation not been terminated by the district court's March 31, 2011 stipulated order of dismissal. In other words, the prior art, and any other issues present in the '1519 proceeding, "could have been raised" by the requester in the civil action, which satisfies item no. 4.

It is not clear, however, whether item no. 2 has been satisfied. The March 31, 2011 order expressly states that the court dismissed all claims asserted between the parties "with prejudice to the right to pursue any such claim in the future *except as provided in the parties' settlement agreement*" (emphasis added). A copy of the parties' settlement agreement, however, has not been submitted by the patent owner. Without a copy of the parties' settlement agreement to complete the petition (and the record), the Office cannot make a determination whether the court's order is "final" as to any issue which is also raised in the reexamination proceeding.

Accordingly, the April 15, 2011 patent owner petition under 37 CFR 1.182 to terminate an *inter partes* reexamination proceeding is **dismissed**.

CONCLUSION

- The April 15, 2011 patent owner petition under 37 CFR 1.182 to terminate *inter partes* reexamination is **dismissed**.

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

Kenneth M. Schor

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

5-05-2011
Kenpet8

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,519	01/07/2011	7788169	2566-530	7064

6449 7590 06/30/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/30/2011

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

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United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
GREENBERG TRAURIG, LLP
MET LIFE BUILDING
200 PARK AVENUE
NEW YORK, NY 10166

Date: MAILED
JUN 30 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001519
PATENT NO. : 7788169
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

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

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

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

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

United States Patent and Trademark Office

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Rothwell, Figg, Ernst & Manbeck, P.C.
1425 K Street, N.W.
Suite 800
Washington, D.C. 20005

(For Patent Owner)

MAILED
JUN 30 2011
CENTRAL REEXAMINATION UNIT

Greenberg Traurig, LLP
Met Life Building
200 Park Avenue
New York, NY 10166

(For Third Party Requester)

In re Littlewood	:	
Inter partes Reexamination Proceeding	:	**DECISION GRANTING**
Control No: 95/001,519	:	**PETITION TO**
Filing Date: January 7, 2011	:	**TERMINATE *INTER PARTES***
For: U.S. Patent No.: 7,788,169	:	**REEXAMINATION PROCEEDING**

This is a decision on the following:

- Patent owner's May 19, 2011 renewed petition entitled "Request for Reconsideration of Petition to Terminate Reexamination Proceeding Under 35 U.S.C. § 317(b) and 37 CFR §§ 1.182, 1.907(b)" (the May 19, 2011 patent owner petition under 37 CFR 1.182); and

- Patent owner's May 9, 2011 petition entitled "Petition for Waiver of Page Limit Under 37 CFR § 1.183" (the May 9, 2011 patent owner petition under 37 CFR 1.183).

Patent owner's petitions under 37 CFR 1.182 and 1.183, filed on May 19, 2011 and May 9, 2011, respectively, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

The May 19, 2011 patent owner renewed petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **granted**. The prosecution of *inter partes* reexamination proceeding control no. 95/001,519 (the '1519 proceeding) is hereby **terminated**.

Patent owner's May 9, 2011 petition under 37 CFR 1.183 to waive the page limit requirements of 37 CFR 1.943(b) is **dismissed as moot**.

DECISION

Patent Owner's May 19, 2011 Renewed Petition under 37 CFR 1.182 to Terminate

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/001,519 (the '1519 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

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

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

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

On May 6, 2011, the Office mailed a decision dismissing patent owner's earlier-filed petition to terminate the '1519 proceeding. In the May 6, 2011 decision, the Office determined that item nos. 1, 3, and 4 were satisfied. It was not clear, however, whether item no. 2 was satisfied, because "the Office [could not] make a determination whether the court's order is "final" as to any issue which is also raised in the reexamination proceeding", without a copy of the settlement agreement to complete the petition (and the record).[1]

---

[1] The May 6, 2011 decision stated:

> The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,788,169 (the '169 patent), was the subject of a civil action in district court, i.e., *Investment Technology Group, Inc., et al. v. Liquidnet Holdings, Inc., et al.*, Civil Action No. 10-CF-6494 (S.D.N.Y.). The patent owner submits a copy of a stipulated order of dismissal, entered by the district court on March 31, 2011, in which the district court stated that the third party requester and real party in interest, Liquidnet Holdings, Inc., has not sustained its burden of proving the invalidity of claims 1-48 of the '169 patent, which satisfies item nos. 1 and 3. In addition, the patent owner has submitted a copy of the court's docket for the civil action at issue, thus showing that the order was entered before trial, i.e., at a sufficiently early stage of the litigation proceeding such that the requester/defendant could have introduced the prior art, and any other issues present in the '1519 reexamination proceeding, into the litigation, had the litigation not been terminated by the district court's March 31, 2011 stipulated order of dismissal. In other words, the prior art, and any other issues present in the '1519 proceeding, "could have been raised" by the requester in the civil action, which satisfies item no. 4 . . . It is not clear, however, whether item no. 2 has been satisfied. The March 31, 2011 order expressly states that the court dismissed all claims asserted between the parties "with prejudice to the right to pursue any such claim in the future *except as provided in the parties' settlement agreement*" (emphasis added). A copy of the parties' settlement agreement, however, has not been submitted by the patent owner. Without a copy of the parties' settlement agreement to complete the

In the renewed petition, the patent owner requests reconsideration of its earlier-filed petition in view of the copy of the redacted settlement agreement entitled "Settlement and Patent Cross-License Agreement", which accompanies the present petition.

In view of the copy of the redacted settlement agreement, the patent owner has provided an adequate showing that the court's March 31, 2011 order is a final decision, within the meaning of 35 U.S.C. 317(b). Thus, item no. 2 has been shown to be satisfied.

For the reasons given above, patent owner's May 19, 2011 renewed petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **granted**. The prosecution of *inter partes* reexamination proceeding control no. 95/001,519 (the '1519 proceeding) is hereby **terminated**.

The '1519 *inter partes* reexamination proceeding is being forwarded to the Central Reexamination Unit (CRU) for conclusion of the proceeding. The CRU will mail the present decision, and process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The file will be assigned an 822 status. A copy of the PALM "Application Number Information" screen and the "Contents" screen will be printed, the printed copy will be annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy will then be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

Patent Owner's May 9, 2011 Petition under 37 CFR 1.183 to Waive the Provisions of 37 CFR 1.943(b)

The present proceeding is being terminated and concluded by this decision. Accordingly, there is no need for a waiver of the page limit of any submission. Thus, patent owner's petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.943(b) is **dismissed as moot**.

CONCLUSION

- Patent owner's May 19, 2011 renewed petition under 37 CFR 1.182 to terminate *inter partes* reexamination is **granted**.
- The prosecution of the '1519 *inter partes* reexamination proceeding is hereby **terminated and will be concluded**.
- The '1519 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for further processing to conclude the '1519 proceeding, as set forth above.
- Patent owner's May 9, 2011 petition under 37 CFR 1.183 to waive the page limit requirements of 37 CFR 1.943(b) is **dismissed as moot**.

---

petition (and the record), the Office cannot make a determination whether the court's order is "final" as to any issue which is also raised in the reexamination proceeding.

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

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

6-29-2011
Kenpet8

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,520	01/07/2011	7739188	094193.011300	7170

6449 7590 05/06/2011

ROTHWELL, FIGG, ERNST & MANBECK, P.C.
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SUITE 800
WASHINGTON, DC 20005

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/06/2011

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Rothwell, Figg, Ernst & Manbeck, P.C.
1425 K Street, N.W.
Suite 800
Washington, D.C. 20005

(For Patent Owner)

MAILED
MAY 06 2011
CENTRAL REEXAMINATION UNIT

Greenberg Traurig, LLP
Met Life Building
200 Park Avenue
New York, NY 10166

(For Third Party Requester)

In re Littlewood	:	
Inter partes Reexamination Proceeding	:	**DECISION DISMISSING**
Control No: 95/001,520	:	**PETITION TO**
Filing Date: January 7, 2011	:	**TERMINATE *INTER PARTES***
For: U.S. Patent No.: 7,739,188	:	**REEXAMINATION PROCEEDING**

This is a decision on patent owner's April 15, 2011 petition entitled "Petition to Terminate Reexamination Proceeding Under 35 U.S.C. § 317(b) and 37 CFR §§ 1.182, 1.907(b)" (the April 15, 2011 petition).

The April 15, 2011 petition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

The $400 fee under 37 CFR 1.17(f) for the patent owner petition has been paid.

SUMMARY

The April 15, 2011 patent owner petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **dismissed**.

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/001,520 (the '1520 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

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

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

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

The patent owner informs the Office that the patent under reexamination, U.S. Patent 7,739,188 (the '188 patent), was the subject of a civil action in district court, i.e., *Investment Technology Group, Inc., et al. v. Liquidnet Holdings, Inc., et al.*, Civil Action No. 10-CF-6494 (S.D.N.Y.). The patent owner submits a copy of a stipulated order of dismissal, entered by the district court on March 31, 2011, in which the district court stated that the third party requester and real party in interest, Liquidnet Holdings, Inc., has not sustained its burden of proving the invalidity of claims 1-19of the '188 patent, which satisfies item nos. 1 and 3. In addition, the patent owner has submitted a copy of the court's docket for the civil action at issue, and the court's order itemizes the proceedings before the court, thus showing that the order was entered before trial, i.e., at a sufficiently early stage of the litigation proceeding such that the requester/defendant could have introduced the prior art, and any other issues present in the '1519 reexamination proceeding, into the litigation, had the litigation not been terminated by the district court's March 31, 2011 stipulated order of dismissal. In other words, the prior art, and any other issues present in the '1519 proceeding, "could have been raised" by the requester in the civil action, which satisfies item no. 4.

It is not clear, however, whether item no. 2 has been satisfied. The March 31, 2011 order expressly states that the court dismissed all claims asserted between the parties "with prejudice to the right to pursue any such claim in the future *except as provided in the parties' settlement agreement*" (emphasis added). A copy of the parties' settlement agreement, however, has not been submitted by the patent owner. Without a copy of the parties' settlement agreement to complete the petition (and the record), the Office cannot make a determination whether the court's order is "final" as to any issue which is also raised in the reexamination proceeding.

Accordingly, the April 15, 2011 patent owner petition under 37 CFR 1.182 to terminate an *inter partes* reexamination proceeding is **dismissed**.

CONCLUSION

- The April 15, 2011 patent owner petition under 37 CFR 1.182 to terminate *inter partes* reexamination is **dismissed**.

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

Kenneth M. Schor

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

5-05-2011
Kenpet8

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,520	01/07/2011	7739188	2566-529	7170

6449 7590 07/01/2011

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

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 07/01/2011

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95001520	07 January 2011	7739188	

EXAMINER

GREENBERG TRAURIG, LLP
MET LIFE BUILDING
200 PARK AVENUE
NEW YORK, NY 10166

ART UNIT	PAPER
	20110701-1

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DATE MAILED: JUL 01 2011

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Rothwell, Figg, Ernst & Manbeck, P.C.
1425 K Street, N.W.
Suite 800
Washington, D.C. 20005

(For Patent Owner)

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JUL 01 2011

CENTRAL REEXAMINATION UNIT

Greenberg Traurig, LLP
Met Life Building
200 Park Avenue
New York, NY 10166

(For Third Party Requester)

In re Littlewood	:	
Inter partes Reexamination Proceeding	:	**DECISION GRANTING**
Control No: 95/001,520	:	**PETITION TO**
Filing Date: January 7, 2011	:	**TERMINATE *INTER PARTES***
For: U.S. Patent No.: 7,739,188	:	**REEXAMINATION PROCEEDING**

This is a decision on the following:

- Patent owner's May 19, 2011 renewed petition entitled "Request for Reconsideration of Petition to Terminate Reexamination Proceeding Under 35 U.S.C. § 317(b) and 37 CFR §§ 1.182, 1.907(b)" (the May 19, 2011 patent owner petition under 37 CFR 1.182); and

- Patent owner's May 9, 2011 petition entitled "Petition for Waiver of Page Limit Under 37 CFR § 1.183" (the May 9, 2011 patent owner petition under 37 CFR 1.183).

Patent owner's petitions under 37 CFR 1.182 and 1.183, filed on May 19, 2011 and May 9, 2011, respectively, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

The May 19, 2011 patent owner renewed petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **granted**. The prosecution of *inter partes* reexamination proceeding control no. 95/001,520 (the '1520 proceeding) is hereby **terminated**.

Patent owner's May 9, 2011 petition under 37 CFR 1.183 to waive the page limit requirements of 37 CFR 1.943(b) is **dismissed as moot**.

DECISION

Patent Owner's May 19, 2011 Renewed Petition under 37 CFR 1.182 to Terminate

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/001,520 (the '1520 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

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

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

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

On May 6, 2011, the Office mailed a decision dismissing patent owner's earlier-filed petition to terminate the '1520 proceeding. In the May 6, 2011 decision, the Office determined that item nos. 1, 3, and 4 were satisfied. It was not clear, however, whether item no. 2 was satisfied, because "the Office [could not] make a determination whether the court's order is "final" as to any issue which is also raised in the reexamination proceeding", without a copy of the settlement agreement to complete the petition (and the record).

In the renewed petition, the patent owner requests reconsideration of its earlier-filed petition in view of the copy of the redacted settlement agreement entitled "Settlement and Patent Cross-License Agreement", which accompanies the present petition.

In view of the copy of the redacted settlement agreement, the patent owner has provided an adequate showing that the court's March 31, 2011 order is a final decision, within the meaning of 35 U.S.C. 317(b). Thus, item no. 2 has been shown to be satisfied.

For the reasons given above, patent owner's May 19, 2011 renewed petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **granted**. The prosecution of *inter partes* reexamination proceeding control no. 95/001,520 (the '1520 proceeding) is hereby **terminated**.

The '1520 *inter partes* reexamination proceeding is being forwarded to the Central Reexamination Unit (CRU) for conclusion of the proceeding. The CRU will mail the present

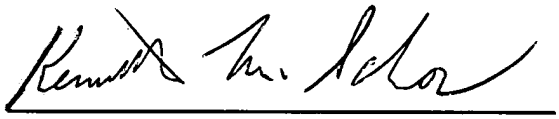
decision, and process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The file will be assigned an 822 status. A copy of the PALM "Application Number Information" screen and the "Contents" screen will be printed, the printed copy will be annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy will then be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

Patent Owner's May 9, 2011 Petition under 37 CFR 1.183 to Waive the Provisions of 37 CFR 1.943(b)

The present proceeding is being terminated and concluded by this decision. Accordingly, there is no need for a waiver of the page limit of any submission. Thus, patent owner's petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.943(b) is **dismissed as moot**.

CONCLUSION

- Patent owner's May 19, 2011 renewed petition under 37 CFR 1.182 to terminate *inter partes* reexamination is **granted**.
- The prosecution of the '1520 *inter partes* reexamination proceeding is hereby **terminated and will be concluded**.
- The '1520 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for further processing to conclude the '1520 proceeding, as set forth above.
- Patent owner's May 9, 2011 petition under 37 CFR 1.183 to waive the page limit requirements of 37 CFR 1.943(b) is **dismissed as moot**.
- Any inquiry concerning this communication should be directed to Cynthia Nessler, Senior Legal Advisor, at (571) 272-7724, or in her absence, to the undersigned at (571) 272-7710.



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

6-29-2011
Kenpet8

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,521	01/07/2011	7,843,508	8157.019.IP508	7631

83275 7590 03/25/2011

AMPACC Law Group, PLLC
6100 219th Street SW, Suite 580
Mountlake Terrace, WA 98043

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/25/2011

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

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

MAR 25 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001521
PATENT NO. : 7843508
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

Decision on Petition for Extension of Time in Reexamination	Control No.: 95/001,521

1. THIS IS A DECISION ON THE PETITION FILED 28 February 2011.

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

3. FORMAL MATTERS
   Patent owner requests that the period for responding to the Office action dated 14 February 2011 which sets a two (2) month period for filing a response to the Office action, be extended by two (2) months.

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

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

5. CONCLUSION

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

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

U.S. Patent and Trademark Office
PTO-2293 (Rev. 09-2010)

In consideration of providing the patent owner with a fair opportunity to present an argument against any attack on the patent as balanced with the statutory mandate of conducting reexamination proceedings with special dispatch. This is the first request for extension of time in this proceeding. While the petition speaks to the considerations of many other proceedings before council in preparing a response, these are the same considerations of any patent owner in any reexamination proceeding. It is Patent owner who must exercise diligence in responding to the Office action. It is agreed that patent owner needs to be given opportunity to complete all aspects of investigation prior to responding to the Office action in an *inter partes* reexamination proceeding. It is Patent owner who must exercise diligence in responding to Office action. Further, MPEP § 2260 states in part, "The first Office action on the merits will ordinarily be mailed together with the order." So the Patent Owner could have reasonable expected an Office action to be issued with the Order granting reexamination. The requirement for reasonably diligent behavior by patent owner includes a reasonable expectation of resource management insofar as expecting a complete Office action on the merits.

The requirement for reasonably diligent behavior by patent owner includes a reasonable expectation of resource management. Resource management takes into consideration other proceedings before the Office. The petition identifying other concurrent proceedings is noted but is not germane to the issues under consideration as to "sufficient cause" for granting an extension of time. Further, while the personal interview is noted, interviews are not considered to support great weight when considering "sufficient cause" for the purpose of extensions of time.

The petition for extension of time is hereby dismissed.

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,521	01/07/2011	7,843,508	169AA-000500US	7631

83275 7590 10/28/2011

AMPACC Law Group, PLLC
6100 219th Street SW, Suite 580
Mountlake Terrace, WA 98043

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/28/2011

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
OCT 28 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001521
PATENT NO. : 7843508
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

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

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

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

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

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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MAILED

OCT 28 2011

CENTRAL REEXAMINATION UNIT

AMPACC Law Group, PLLC (For Patent Owner)
6100 219th Street SW
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Mountlake Terrace, Washington 98043

Novak Druce & Quigg, LLP (For 95/001,521 Requester)
(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-Third Floor
Houston, Texas 77002

Woodcock Washburn LLP (Microsoft Corporation) (For 95/000,617 Requester)
CIRA Centre
12th Floor
2929 Arch Street
Philadelphia, Pennsylvania 19104-2891

Kenyon & Kenyon LLP (For 95/001,534 Requester)
One Broadway
New York, New York 10004

In re Qiang Huang :
Inter Partes Reexamination Proceeding :
Control No.: 95/001,521 :
Filed: January 7, 2011 :
For: U.S. Patent No. 7,843,508 :
:
In re Qiang Huang : **DECISION, *SUA SPONTE*,**
Inter Partes Reexamination Proceeding : **TO MERGE**
Control No.: 95/000,617 : **REEXAMINATION**
Filed: January 25, 2011 : **PROCEEDINGS**
For: U.S. Patent No. 7,843,508 :
:
In re Qiang Huang :
Inter Partes Reexamination Proceeding :
Control No.: 95/001,534 :
Filed: January 31, 2011 :
For: US. Patent No. 7,843,508 :

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.989.

BACKGROUND

1. U.S. Patent No. 7,843,508 ("the '508 patent") issued to Qiang Huang on November 30, 2010, with 46 claims.

2. A request for *inter partes* reexamination of claims 1-46 of the '508 patent was filed on January 7, 2011, by a third party requester, and was assigned control number 95/001,521 ("the '1521 *inter partes* proceeding"). The request identified Apple Inc.as the real party in interest.

3. A second request for *inter partes* reexamination of claims 1-46 of the '508 patent was filed on January 25, 2011, by a third party requester, and was assigned control number 95/000,617 ("the '617 *inter partes* proceeding"). The request identified Microsoft Corporation as the real party in interest.

4. A third request for *inter partes* reexamination of claims 1-46 of the '508 patent was filed on January 31, 2011, by a third party requester, and was assigned control number 95/001,534 ("the '1534 *inter partes* proceeding"). The request identified Sony Corporation and Sony Electronics Inc. as real party in interest.

5. On February 14, 2011, *inter partes* reexamination was ordered for claims 1-46 of the '508 patent in the '1521 *inter partes* proceeding based on the examiner's determination that the January 7, 2011 request raised a substantial new question of patentability affecting these claims. The order was accompanied by a non-final rejection Office action.

6. On March 25, 2011, *inter partes* reexamination was ordered for claims 1-46 of the '508 patent in the '617 *inter partes* proceeding based on the examiner's determination that the January 25, 2011 request raised a substantial new question of patentability affecting these claims. No Office action on the merits has been issued in the '617 proceeding.

7. On March 25, 2011, *inter partes* reexamination was ordered for claims 1-46 of the '508 patent in the '1534 *inter partes* proceeding based on the examiner's determination that the January 31, 2011 request raised a substantial new question of patentability affecting these claims. No Office action on the merits has been issued in the '1534 proceeding.

8. On April 15, 2011, patent owner submitted a response to the February 14, 2011 non-final rejection action in the '1521 *inter partes* proceeding. The April 15, 2011 patent owner response did not include any amendment to the specification or claims.

9. On May 16, 2011, the '1521 requester filed comments to patent owner's April 15, 2011 response.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in three proceedings for the same claims of the same patent. All three proceedings are *inter partes* proceedings. All three proceedings are still pending, and have not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989 provides:

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

In accordance with 37 CFR 1.989(a), the 95/001,521, 95/000,617 and 95/001,534 proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL THREE PROCEEDINGS

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

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges three *inter partes* reexamination proceedings. The merged proceeding is governed by 37 CFR 1.902 through 1.997. Pursuant to 37 CFR 1.989(a), the merged examination will normally result in the issuance and publication of a single reexamination certificate under 37 CFR 1.997.

It is noted that reexamination was ordered for each of claims 1-46 of the '508 patent in each of the '1521, '617, and '1534 proceedings. Accordingly, the examiner will conduct reexamination in the merged proceeding for claims 1-46 of the '508 patent.

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

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

2. Appeal Rights:

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP 2674 through 2675 and 2678 through 2683. As pointed out in MPEP 2674:

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

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

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

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

C. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all three proceedings. All papers issued by the Office, or filed by the patent owner and the third party requester(s), will contain the identifying data for all three

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

proceedings and will be entered in each reexamination file. All papers filed by the patent owner and the third party requester(s) must consist of a single paper, **filed in triplicate**, each bearing a signature and identifying data for all three proceedings, for entry into each file.

All papers filed by the patent owner and the third party requester(s) should be directed:

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

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

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

D. Amendments:

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

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

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

E. Fees:

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

F. Citation of Patents and Printed Publications:

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

G. Appeal Procedure Reminders for *Inter Partes* Reexamination

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

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,521, *inter partes* Reexamination No. 95/000,617 and *inter partes* Reexamination Control No. 95/001,534 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. The examiner will issue an Office action for the merged proceeding in due course.

3. Any questions concerning this communication should be directed to Raul Tamayo in the Office of Patent Legal Administration, at (571) 272-7728.

Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

October 27, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,521	01/07/2011	7,843,508	169AA-000500US	7631

83275 7590 11/29/2011

AMPACC Law Group, PLLC
6100 219th Street SW, Suite 580
Mountlake Terrace, WA 98043

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/29/2011

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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(NDQ REEXAMINATION GROUP)
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HOUSTON, TX 77002

Date: MAILED
NOV 29 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001521
PATENT NO. : 7843508
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

Decision on Petition for Extension of Time in Reexamination	Control No.: 95/001,521; 95/000,617 & 95/001,534

MAILED
NOV 29 2011
CENTRAL REEXAMINATION UNIT

1. THIS IS A DECISION ON THE PETITION FILED 21 November 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:
   A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.

   The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS
   Patent owner requests that the period for responding to the Office action dated 04 November 2011 which sets a two(2)month period for filing a response to the Office action, be extended by two (2) months.

   A. ☒ Petition fee per 37 CFR §1.17(g)):
      i. ☐ Petition includes authorization to debit a deposit account.
      ii. ☐ Petition includes authorization to charge a credit card account.
      iii. ☐ Other: _____.
   B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
   C. ☒ Petition was timely filed.
   D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)
   A. ☐ Granted or ☒ Granted-in-part for one (1) month, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
   B. ☐ Other/comment: see attached
   C. ☐ Dismissed because:
      i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
      ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
      iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
      iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
      v. ☐ The petition is moot, _____.
      vi. ☐ Other/comment: see attached.

5. CONCLUSION

   Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611. In his absence, calls may be directed to Sudhanshu C Pathak at 571-272-5509 in the Central Reexamination Unit.

/Mark Reinhart/ [*Signature*]	SPRS, AU 3992 Central Reexamination Unit (Title)

In consideration of providing the patent owner with a fair opportunity to present an argument against any attack on the patent as balanced with the statutory mandate of conducting reexamination proceedings with special dispatch that the Office must fully consider the facts presented in any petitions for extension of time.

Pursuant to MPEP § 2665 (in part) Extension of Time

First requests for extensions of these time periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments within the statutory time period. Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary situations. (emphasis added)

On balance, there is "sufficient cause" for granting of one (1) month extension of time. Requests for more than one month will only be granted in extraordinary situations.

The petition for extension of time is hereby granted-in-part.

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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,521 + 95/001534 + 95/000617	01/07/2011	7,843,508	169AA-000500US	7631

83275 7590 02/24/2012

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Mountlake Terrace, WA 98043

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/24/2012

Please find below and/or attached an Office communication concerning this application or proceeding.

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 2-24-12

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HOUSTON, TX 77002

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001521 + 95/001534 + 95/000617
PATENT NO. : 7843508
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450
www.uspto.gov

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FEB 24 2012

CENTRAL REEXAMINATION UNIT

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New York, New York 1004 (For 95/001,534 Requester)

In re Huang
Inter Partes Reexamination Proceeding
Control No.: 95/001,521
Filed: January 7, 2011
For: U.S. Patent No.: 7,843,508

In re Huang
Inter Partes Reexamination Proceeding
Control No. 95/000,617
Filed: January 25, 2011
U.S. Patent No.: 7,843,508

In re Huang
Inter Partes Reexamination Proceeding
Control No.: 95/001,534
Filed: January 31, 2011
For: U.S. Patent No.: 7,843,508

: DECISION ON § 1.181,
: §1.182, AND § 1.183
: PETITIONS

This is a decision on February 23, 2011 patent owner petitions under 37 CFR 1.181, 1.182 and/or 37 CFR 1.183 seeking to vacate or suspend *inter partes* reexamination control number 95/000,617 (the '617 reexamination), filed January 25, 2001 and reexamination control number 95/001,534 (the '1534 reexamination), filed January 31, 2011 based on the assertion

that the requesters of the instant reexaminations are real party in interests or privies with the requester in *inter partes* reexamination control number 95/001,521 (the '1521 reexamination), filed January 7, 2011. This decision also takes into consideration a March 9, 2011 third party requester (Requester) Opposition, filed in the '1,534 reexamination, and a March 12, 2011 Opposition, filed in the '617 reexamination, the two oppositions being filed to address the respective petitions for vacatur; the Oppositions are supported by Petitions under 37 CFR 1.181, 1.182 and/or 1.183, requesting entry of the Oppositions.

The Petitions and Oppositions are before the Office of Patent Legal Administration for consideration.

The Patent Owner Petitions for vacatur under 37 CFR 1.181, 1.182 and/or 1.183 are Dismissed.

The Requester Petitions under 37 CFR 1.181, 1.182 and/or 1.183 are Granted and the Oppositions have been entered.

I. FEES

Notwithstanding the reliance on alternative petition rules by both the Patent Owner and the Requesters, only one petition fee from each party will be required to consider the matter raised. A review of Office PALM records reveals that:

- in the '1,534 reexamination, the Patent Owner's $400 fee, pursuant to § 1.17(f), has been charged on February 24, 2011, as authorized in the petition (at page7), but not the Requester's $400 petition fee, which fee was authorized in the petition (at page 6) and will be so charged, and

- in the '617 reexamination, the Patent Owner's $400 fee, pursuant to § 1.17(f), has been charged on February 24, 2011, as authorized in the petition (at page 7), and the Requester's similar $400 fee was charged on March 14, 2011 as authorized in the petition (at page 10).

II. BACKGROUND

1. U.S. Patent No. 7,843,508 (the '508 patent) was issued on November 30, 2010.

2. On January 7, 2011, a first request for reexamination of the '508 patent was filed on behalf of Apple, Inc (Apple)[1] and was given a reexamination control number 95/001,521 (the '1,521 reexamination):
   a. The request noted copending litigation styled as *MedioStream, Inc. v. Acer Inc. et al.*, Case No. 3:10-cv-05762 (N.D. Cal. December 17, 2010).[2]
   b. Reexamination was ordered on February 14, 2011.

3. On January 25, 2011, a second request for *inter partes* reexamination of the '508 patent

[1] Request transmittal form, at page 1, paragraph 2a.
[2] *Id.*, at page 2, paragraph 16d.

was filed on behalf of Microsoft Corporation[3] (Microsoft) and was given a reexamination control number 95/000,617 (the '617 reexamination):

a The request noted copending litigation styled as *MedioStream, Inc. v. Acer et al.*, Civil Action No. 3:10-CV-05762 (EMC), December 17, 2010.[4]

b. Reexamination was ordered on March 25, 2011.

4. On January 31, 2011, a third request for *inter partes* reexamination of the '508 patent was filed on behalf of Sony Corporation and Sony Electonics Inc[5] (Sony) and was given a reexamination control number 95/001,534 (the '1,534 reexamination):

   a. The request noted copending litigation styled as *MedioStream, Inc. v. Acer et al.*, 3:10-cv-05762-RS (N.D. Cal.),[6]

   b. Reexamination was ordered on March 25, 2011.

5. On February 23, 2011, Patent Owner filed petitions under 1.181, § 1.182 and/or § 1.183 in reexaminations '617 and '1,534 to vacate or suspend the reexaminations in that Microsoft and Sony are real parties in interest in the first reexamination '1,521 or privies to Apple on whose behalf the first reexamination was filed.

6. On March 9, 2011, and March 12, 2011, the requesters submitted Oppositions in reexaminations '617 and '1,534 to the February 23, 2011 petitions by the Patent Owner supported by petitions under 37 CFR 1.181, 1.182 and/or 1.183.

7. On October 28, 2011, the Office mailed a Decision, Sua Sponte, to Merge Reexamination Proceedings for the following reexaminations:

   a. '1,521,

   b. '617, and

   c. '1,534.

III. Patent Owner Petition Under 37 CFR 1.182 and/or 1.183 for Vacatur

Petitioner (Patent Owner) notes that a reexamination order of the '508 patent on behalf of Apple (the '1521 reexamination) has been issued, and that, therefore, the '617 and '1,534 subsequent requests for reexamination of that patent are precluded for all real parties in interest to the first reexamination request, and for all privies, until a reexamination certificate has issued on the first reexamination.[7]

Petitioner does not attempt to factually distinguish between Microsoft and Sony in terms of their being alleged real parties in interest or privies with Apple.

The Supreme Court decision in *Taylor v. Sturgell*[8] (*Taylor*) is relied upon for its holdings that[9]:

1. a non-party may be bound by a judgement, because he/she was adequately represented

[3] Request transmittal from, at page 1, paragraph 2a.
[4] Id., at page 2, paragraph 16d.
[5] Request transmittal form, at page 1, paragraph 2a.
[6] Request transmittal form, paragraph 16d.
[7] Petition, bridge of pages 1 and 2, citing 35 U.S.C. 317(a).
[8] *Taylor v. Sturgell*, 128 S. Ct. 2161 (2008).
[9] Petition, bridge of pages 2 and 3.

by someone with the same interests who was a party to a suit, and
2. a party may not avoid a preclusive effect by relitigating through a proxy.

As to being adequately represented, it is asserted that Apple's representation of Microsoft and Sony (joint defendants in concurrent litigation) is adequate for preclusion purposes because[10]:

1. the interests of the joint defendants are aligned,
2. the Office as the administrative body adjudicating an *inter partes* reexamination has taken the necessary care to assert any additional prior art or arguments required to protect the interests of the other joint defendants, and
3. all joint defendants had notice of the reexamination filed by Apple.

As to relitigating through a proxy, it is asserted that a joint agency relationship has been admitted in the underlying litigation, and that may not now be renounced in the reexamination in that[11]:

1. there is in place a joint defense agreement thereby making all the joint defendants privies to the reexamination filed by Apple, and
2. the joint defendants have asserted an attorney privilege and joint defense privilege in the underlying litigation.

The instant patent being reexamined is part of a family of patents, including U.S. patents 7,009,655 and 7,282,172.[12] A discussion is provided in regard to litigation of these two other patents to establish a relationship between Apple and Microsoft and Sony, including the absence of additional reexamination requests by Microsoft and Sony for those patents.[13] Additionally, it is noted by petitioner that in regard the reexamination of the other two patents, the examiner did not merely adopt the invalidity arguments made by Apple, but instead added other arguments not found in Apple's briefs.

It is also asserted and argued that the joint defendants have exchanged prior art and are aware of all the *inter partes* reexaminations requested by Apple.

IV. Petition under 37 CFR 1.183 for entry of Opposition and Decision Thereon

Third party petitioners (Requesters) seek entry of their Oppositions to the Patent Owner petitions for vacatur of the reexamination filing dates, such as by waiver of § 1.939(a) (or (b)).

Section 1.939(a) provides:

(a) If an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned.

Because the Oppositions shed light on the proper identification of the real party in interest, as noted below, and in addition the Requesters have a right to defend against vacating their requests, the petitions for waiver are granted.

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[10] Petition, at page 3.
[11] *Id.*
[12] *Id.*
[13] Petition, at page 5.

V. Requesters' Oppositions to Patent Owner Petition for Vacatur

Oppositions have been filed by each of the Requesters in reexaminations '1,521 and '1,534.

Microsoft:[14] The Opposition by the Requester of the '617 reexamination (Microsoft) explicitly states:

> Microsoft properly certified under 37 CFR § 1.917(b)(7) that the estoppel provisions do not apply to it.[15]

The Opposition also addresses the lack of privity between Microsoft and Apple by pointing out that petitioner's reliance on the mere existence of a joint defense agreement is not, as a matter of law, sufficient to establish privity or a joint agency agreement.[16] The Opposition by Microsoft, as does the Opposition by Sony, notes that, in *Taylor*, the Supreme Court rejected the D.C. Circuit's expansive use of the doctrine of virtual representation to preclude a claim brought by a non-party. It is added that Petitioner seeks to expand the limited exception in precisely the manner that *Taylor* forbade.[17] The D.C. Circuit held incorrectly that preclusion based on virtual representation can exist where there was both an identity of interest and adequate representation together with a third factor, such as a close relationship or substantial participation. It is asserted by requester that the admitted joint defense agreement in the underlying litigation is not the same as a class action suit or suit brought by fiduciaries, and guardians that are the basis of the exception to the general rule of non-preclusion.

Requester provides that, while Petitioner would have the Office believe that the Office is well-suited to protect Microsoft's interests in the Apple reexamination, Microsoft notes that it has presented its own substantial new questions of patentability which are different from those raised by Apple, and they would not be considered if the petition was granted. It is asserted that if the Office were fully able to protect the interest of third parties in a reexamination proceeding, then there would be no need for the statute to allow the filing of any subsequent *inter partes* reexamination request, including those of third parties.[18]

Sony: The Opposition by the Requester of the '1,534 reexamination (Sony) explicitly states that:

> Sony is not a 'real party in interest' to the '521 reexamination and is not in privity with Apple in the '521 reexamination.[19]

It is stated that Sony has:

> certified that the estoppel provisions of 37 CFR 1.907 do not prohibit this

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[14] The Opposition has raised what requester believes to be legal defects in the petition for Vacatur in that: (a) the instant petitions were filed before reexamination was ordered (based on the requests by Microsoft and Sony), so there is no action of the Office that could be suspended or vacated, Opposition, page 4, and (b) without a first order for reexamination (based on the Apple request), there can be no preclusion of a second request for reexamination - the February 14, 2011 order for reexamination on the Apple request in the first request for reexamination was after the January 25, 2011 Microsoft and January 31, 2011 Sony (second) requests for reexamination, Opposition, pages 4 and 5.

[15] Opposition, page 9.

[16] Opposition, pages 6 and 7.

[17] *Id.*

[18] *Id.*, page 8.

[19] Opposition, page 2.

reexamination.[20]

It is also stated that the Patent Owner has failed to establish that Sony's certification is in any way ambiguous or facially inaccurate, nor has the Patent Owner attempted to even allege any such ambiguity or inaccuracy.[21]

While it is recognized that Sony is a co-defendant with Apple in concurrent litigation and Sony admits that it has cooperated with Apple in the litigation, such actions are asserted to not to amount to control over, or privity, in the present reexamination.

It is pointed out that *Taylor* actually supports denial of the Patent Owner's petition based on the Court's recognition, in reversing the lower court's finding of a virtual representation, that everyone should have his own day in court.[22]

VI. Decision on the Patent Owner Petitions for Vacatur

The petitions by patent owner seeking vacatur of the subsequent *inter partes* reexaminations requested by Microsoft and Sony are dismissed.

At page 2, the petitions assert:

> Once a third party requester has filed a request for *inter partes* reexamination and the request has been granted by the PTO, neither the third party requester nor its privies may file a subsequent request for *inter partes* reexamination on the same patent until a reexamination certificate has issued. *See* 35 U.S.C. § 317(a).

The petitions go on to state:

> The limitation provided in section 317(a) of the patent statute takes effect as soon as reexamination is ordered by the PTO, See 35 U.S.C. § 317(a) (requiring that an order for *inter partes* reexamination be issued). The limitation applies for the entire patent, regardless of the claims for which the *inter partes* reexamination was requested, and regardless of whether all claims are actually examined. See 35 U.S.C. § 317(a) ("...neither the third-party requester nor its privies may file a subsequent request for *inter partes* reexamination of the patent ....

Petitioner misreads 35 U.S.C. 317(a). The pertinent part of section 317(a) provides that:

> ...<u>once an order for inter partes reexamination of a patent has been issued</u> under section 313, <u>neither the third-party requester nor its privies may file</u> a subsequent request for inter partes reexamination of the patent until an inter partes reexamination certificate is issued and published under section 316, unless authorized by the Director. [Emphasis added.]

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[20] *Id.*
[21] Opposition, bridge of pages 2 and 3.
[22] Opposition, page 5.

In this instance, the '1521 reexamination was filed January 7, 2011, the '617 reexamination was filed January 25, 2001, and the '1534 reexamination was filed January 31, 2011. The '1521 reexamination was ordered February 14, 2011, and the '617 and '1534 reexaminations were ordered March 25, 2011. Thus, all three reexaminations were requested before any of the three were ordered. Accordingly, all three of the reexaminations may continue, regardless of whether filed by the same party, a real party in interest, or a privy.

It is also pointed out that *inter partes* reexamination is a "creature of the statute," and the estoppels stated in the statute are the only estoppels that apply; preclusion based on virtual representation does not apply unless it fits within one of the statutory estoppels, and it does not fit here.

The following discussion is provided only to address the extent that the Patent Owner petition could be interpreted to request vacatur or suspension of reexaminations '617 and '1,534 because of the assertion that Microsoft and Sony are real parties in interest in the first reexamination '1,521 or privies to Apple on whose behalf the first reexamination was filed, yet, Microsoft and Sony were not identified as such, and thus, the filing date requirement of 37 CFR 1.515(b)(8) to identify the real parties in interest was not satisfied.

The MPEP[23] makes it clear that the Office does not look beyond the required certification in the request for reexamination, except for the rare instance where a challenge to the sufficiency of the certification facially establishes that the identified real party in interest is not accurate. The certification cannot be successfully challenged merely because, at one point, the certified real party in interest was "involved" with another party, or there was some collaboration in a matter other than the request for reexamination.

The common interest among litigation defendants seeking to invalidate or defend against enforcement of a patent, such as in the identified copending litigation does not translate *ipso facto* into each defendant being a real party in interest in any request for reexamination filed by one of the defendants. This is not to say that concurrent litigation defendants cannot be real parties in interest in requests for reexaminations of the patent in litigation, but such result must be shown and not merely speculated on or theorized about. To be required to be named as a real party in interest, a party must participate, contribute, or direct that action be taken in some concrete manner in the request for reexamination. If, in fact, it could be evidenced that a party not identified as a real party in interest participated, contributed or directed action to be taken in some concrete manner in the Apple request for reexamination, than an issue could be raised as to whether Microsoft or Sony is a real party in interest in the filing of the Apple reexamination request, and as to whether Microsoft or Sony are in privy with Apple.

Preliminarily, it is noted that the allegations regarding a joint defense are not even directed towards the particular patent that is the subject of the reexaminations, but other patents alleged to be in a family of patents for which the instant patent is a member. Nonetheless, even if the joint defense involved litigation of the instant patent being reexamined, preparation of an invalidity defense, based on found and evaluated prior art to support a concurrent litigation defense, does not amount to participation, contribution, or directing that action be taken by all the defendants in a request for reexamination by one of the defendants based on such joint activity, where the joint activity was conducted with only an intent to defend the concurrent litigation suit. Evidence that the joint activity was also conducted with

[23] MPEP § 2612.

an intent to file an *inter partes* reexamination request is required, in order for a petitioner to establish that other concurrent litigation defendants are real parties in interest or privy with the concurrent litigation defendant filing the reexamination request.

Notwithstanding any actual benefit that would result to the concurrent litigation defendants from a favorable result in the reexamination, or their ability to request a litigation stay based on the reexamination request, the question of whether a defendant in the litigation is a real party in interest or privy in the reexamination must be determined on a case-by-case basis focusing on **the showing** of a party's participation, contribution, or directing that action be taken in regard to the filing of a request for reexamination, and not ancillary matters, such as the defendants taking advantage of the reexamination request, or taking advantage of arguments in the subsequent reexamination request that were previously drafted by others for the concurrent litigation. For example, if the Office were to follow petitioner's line of reasoning, a patent owner might challenge an identification of the real party in interest in a reexamination where a third party requester not involved in the litigation and ignorant thereof, was to file a request for reexamination of the patent in litigation utilizing one or more pieces of prior art employed by the unrelated defendants in the litigation. The third party requester could be placed in a position of having to prove a negative – that it was not supported by the litigation defendants. Similarly, here, the Office will not require the Requester to prove a negative – that the concurrent litigation defendants did not participate, contribute or direct the action to be taken in the reexamination. The fact that a first party defended itself in litigation, and another party defendant later filed a request for reexamination related to the patent in litigation utilizing in-part that defense, should not doom the first party to life as a real party in interest for any request for reexamination that may be later filed utilizing part of that defense. Rather, the burden is on the challenging Patent Owner to provide evidence of participation contribution, or directing that action be taken as to the reexamination request.

It may be that a particular defendant in a litigation has decided to proceed with a request for reexamination in the face of hostile opposition by one or more other defendants in the litigation. To embrace each defendant as a real party in interest to a first reexamination request, would result in estoppel against parties who had no control over the initial request for reexamination. None-the-less, using petitioner's theory that the defendants in the litigation must be deemed to be real parties in interest in any initial reexamination request of the patent in litigation, the litigation defendants would then be barred (under 35 U.S.C. § 317(a)) from raising other substantial new questions of patentability that they may feel is better in a subsequent request for reexamination after the first request has been ordered, which at least Microsoft has alleged in its Opposition (at page 8).

In deciding a petition for vacatur, the Office will not engage in conjecture as to the participation, contribution or direction of action to be taken in the request for reexamination of any particular alleged unnamed real party in interest. For purposes of this decision, it is not disputed that the concurrent litigation defendants may be impacted and even benefit from the filing of the instant reexamination. However, it is incumbent upon Patent Owner to present objective evidence that a party not identified as a real party in interest in fact participated contributed or directed action to be taken in the request for reexamination, or in the reexamination proceeding after the request was filed. Similarly, it is incumbent upon Patent Owner to present objective evidence that a subsequent reexamination requester is in privity with a prior reexamination requester for which reexamination has been ordered.

A. The Identification Of The Real Party In Interest Is Not Facially Inaccurate Or Ambiguous. Therefore, The Office Lacks The Authority And The Tools To Question That Identification.

The arguments presented in the petitions for vacatur fail to establish that the Office has the authority to question the accuracy of a third party requester's facially accurate and unambiguous identification of the real party in interest in the *inter partes* reexamination proceeding, or the tools to competently conduct an investigation of the matter.

To the extent that Patent Owner argues that the Office has the ability to investigate the accuracy of the identification of the real party in interest in an *inter partes* reexamination proceeding, or to issue a Show Cause Order requiring the identified real party in interest to confirm that it, and it alone, is the real party in interest, Patent Owner does not make a persuasive case that the Office is required to do so by either the reexamination statute or the reexamination regulations, when the *inter partes* reexamination as filed, contains on its face, an unambiguous identification of the identity of the real party in interest.[24]

Patent Owner's argument is not persuasive, because it does not reflect the intent of the provisions of 37 CFR 1.915(b)(7) and (b)(8). A certification statement made pursuant to 37 CFR 1.915(b)(7) is a statement by the third party requester to the effect that the third party requester is not itself estopped by the statutory estoppel provisions from filing a request for *inter partes* reexamination of a given patent. The *inter partes* rule making at 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), provides that:

> It should be noted that the Office generally will not have a need to resolve the factual issue of whether or not one party is a privy of another party. Section 1.915(b)(7) requires a third party requester to certify that the estoppel provisions of §1.907 do not prohibit the filing of the *inter partes* reexamination request, and the Office does not intend to look beyond this required certification. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would then need to be addressed.

A substantially identical statement also appears at 65 Fed. Reg. at 76764. These statements establish that the Office will, only in the rare instance that it is necessary to do so (a facial showing of inaccuracy or an ambiguity), "address" the accuracy of a certification that statutory estoppel does not bar the filing of a request for *inter partes* reexamination. Further, the rule making does not discuss the type or depth of investigation that can and will be undertaken, and it does not state or imply that a patent owner may trigger an investigation of the accuracy of the certification merely by advancing an unsupported allegation that another party is a real party in interest or privy (by way of having participated contributed or directed that action be taken in the reexamination request).

This is not an instance where the identification of the real party in interest required by 37 CFR 1.915(b)(8) is ambiguous or facially inaccurate, in which such instance a third party requester which is before the Office can be queried by the Office, because the instant record is not clear (*i.e.*, the ambiguity causes an issue that is ripe for consideration due to a required request statement being ambiguous). Since the present record in the instant reexamination

[24] The Requesters have in fact confirmed that they have identified the only real party in interest.

proceeding is not ambiguous as to the identification of the real party in interest (and Patent Owner has provided no persuasive extrinsic evidence to establish ambiguity), there is no basis to proceed any further in this proceeding as to the matter.

Moreover, the third party requesters, Microsoft and Sony in their Oppositions have responded based on facts wholly within their knowledge and possession. Both third party requesters have clearly stated that their certifications are correct that they are not barred from filing their requests for reexamination. No facts have been presented by Petitioner that would cause the Office to believe any issue regarding real party in interest or privity is raised that would need further clarification by the requesters. It is noted that Petitioner has not challenged the identification of the real party in interest in the initial reexamination 95/000,617, although Petitioner herein argues that that Microsoft and Sony are true real parties in interest along with Apple or privies thereof.[25]

Where a patent owner who is a party in an *inter partes* reexamination proceeding believes that an identification of the real party in interest is inaccurate, even though it is facially unambiguous, the courts are the appropriate venue from which the patent owner should seek relief to obtain evidence extrinsic to the record, for incorporation into the record. It is to be noted that there is precedent on the issue of "real party in interest" in the federal courts, on matters ranging from jurisdiction (*e.g.*, presence of diversity or amount of suit)[26] to actions in which the principle is applied to prevent multiple or conflicting lawsuits by persons such as assignees.[27] These examples of court proceedings resolving "real party in interest" issues demonstrate the reason why the Office cannot perform such a function here. Upon obtaining jurisdiction over the parties, courts may order discovery, taking of testimony with cross-examination and use of other evidentiary tools, while enforcing compliance with its requirements via its subpoena power and power to impose sanctions. Accordingly, the courts are the forums best equipped to determine who is, and who is not, the "real party in interest" when there is a reason to doubt the third party requester's identification of a party or parties as being the real party in interest in an *inter partes* reexamination proceeding. Further, courts may provide relief, as appropriate, by enjoining the filing of a further *inter partes* reexamination request by the other parties in a civil action. Once a court has determined that a party is a "real party in interest," the Office can make use of that determination to bar the filing of a subsequent *inter partes* reexamination request by that party. Of course at that point, the party could file an *ex parte* reexamination proceeding, the filing of which does not require identification of "a real party in interest" (35 U.S.C §§ 301 and 302), and is not prohibited by statute or rule, even after an *inter partes* reexamination was filed by the same real party in interest.[28]

A patent owner concerned with the issue of misidentification of the real party in interest in a request for *inter partes* reexamination may immediately seek relief from the alleged erroneous identification of the "real party in interest" via the courts, which possess the tools to investigate and obtain information as to the relationship of the parties to ascertain the veracity of the identified "real party in interest." The present petition is silent as to why Patent Owner did not approach the appropriate District Court for relief (*e.g.*, an investigation into the matter and an appropriate order). Given the emphasis that petitioner Patent Owner

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[25] Petition, page 1.
[26] *Varlotta Construction Corporation v. Carla Development Corporation*, 886 F. Supp 315 (E.D.N.Y. 1995).
[27] *First Hartford Corporation Pension Plan & Trust v. United States*, 194 F.3d 1279 (Fed. Cir. 1999).
[28] If the court makes a finding that the "real party in interest" was misstated, the Office can then take action, if appropriate, based upon the court's findings.

has placed on the importance of the "real party in interest" disclosure requirement, it would appear that Patent Owner could have immediately sought relief in the appropriate court regarding the identity of the real party in interest. The record does not show that Patent Owner has done so. The Office may consider that it is "the sole agency that administers the patent statute,"[29] and the Office certainly conducts the *inter partes* proceeding; however, it is common knowledge that the federal courts (which are not an agency in the sense used in the *inter partes* reexamination rule making) routinely adjudicate matters arising under the patent statute. Further, Patent Owner should appreciate the difference between conducting a reexamination proceeding, which is the province of the Office, and enforcing an estoppel provision of Federal law as a matter of equitable relief. Patent Owner has not provided any basis for believing that the district courts lack authority to act as described above.

As a final point in this section of the decision as to the Office lacking the authority to investigate: The reexamination statute requires, *inter alia*, that a request for *inter partes* reexamination proceeding "shall ... include the identity of the real party in interest... ."[30] The *inter partes* reexamination rules require that a request for *inter partes* reexamination include, *inter alia*, "[A] statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that party is a privy."[31] Requester Apple has clearly stated it is the real party in interest, and that is an identification to a sufficient extent that a party, such as a concurrent litigation defendant, filing the subsequent *inter partes* reexamination request can look into its interaction with the identified real party in interest to "determine whether the subsequent requester is a privy" with Apple who filed the initial reexamination. Neither the *inter partes* reexamination statute nor the *inter partes* reexamination rules imposes a duty on the Office to investigate the accuracy of an unambiguous identification of the real party in interest in a third party requester's request for *inter partes* reexamination proceeding.

In the subsequent *inter partes* reexamination proceedings, the real party in interest is unambiguously identified in the records. The identification of the real party in interest does not appear to be facially inaccurate. The Office will refuse to accord a filing date to a request for *inter partes* reexamination that does not identify the real party in interest, or which provides an identification of the real party in interest that is ambiguous or facially inaccurate. If the Office accords a filing date to a request for *inter partes* reexamination, and later discovers an ambiguity or a facial inaccuracy in the identification of the real party in interest, the Office can, and will, require that a party appearing before it as third party requester in an *inter partes* reexamination proceeding clarify the ambiguity or facial inaccuracy. However, it does not follow that the Office is empowered to conduct an investigation into the identity of the real party in interest when the statement identifying the real in interest in the record of an *inter partes* reexamination proceeding is neither facially inaccurate nor ambiguous. The Office will not conduct an investigation into the accuracy of the identification of the real party interest in the instant subsequent reexamination proceedings, because there is no legal reason to do so.

B. Synopsis

[29] 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), emphasis added.
[30] 35 U.S.C. § 311(b)(1).
[31] 37 CFR 1.915(b)(8).

Rather than having presented clear and undisputed evidence establishing that Microsoft and Sony are either real parties in interest along with Apple or privies thereof, the petition is supported only by supposition and conjecture on Patent Owner's part based on a joint defense agreement in concurrent litigation, which basis is insufficient to support the allegations.. Accordingly, Patent Owner has not demonstrated a persuasive basis for the requested relief of vacatur of the filing date of the instant reexamination proceedings or issuance of a show cause order why the filing date should not be vacated. Therefore, such request for relief is dismissed.

VII. CONCLUSION

1. The February 23, 2011 Patent Owner petitions under 37 CFR 1.181, 1.182 and 1.183, seeking vacatur of the reexamination, are dismissed.

2. The March 9 and March 12, 2011 third party Requester §§ 1.181, 1.182 and 1.183 petitions for entry of a concomitant Oppositions to the Patent Owner petition have been granted and the Oppositions entered.

3. The $400 Requester petition fee for the '1,534 reexamination will be charged to Deposit Account 11-0600.

4. Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-7707.

Hiram H. Bernstein
Senior Legal Advisor
Office of Patent Legal Administration

1-17-12

APPENDIX OF GENERALLY RELEVANT STATUTORY, REGULATORY AND PRACTICE PROVISIONS

35 U.S.C. § 311 Request for inter partes reexamination.

(a) IN GENERAL.— Any third-party requester at any time may file a request for inter partes reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.
(b) REQUIREMENTS.— The request shall—
(1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an inter partes reexamination fee established by the Director under section 41; and
(2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.

35 U.S.C. § 315 Appeal.

* * * * *

(c) CIVIL ACTION.— A third-party requester whose request for an inter partes reexamination results in an order under section 313 is estopped from asserting at a later time, in any civil action arising in whole or in part under section 1338 of title 28, the invalidity of any claim finally determined to be valid and patentable on any ground which the third-party requester raised or could have raised during the inter partes reexamination proceedings. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

35 U.S.C. § 317 Inter partes reexamination prohibited.

(a) ORDER FOR REEXAMINATION.— Notwithstanding any provision of this chapter, once an order for inter partes reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for inter partes reexamination of the patent until an inter partes reexamination certificate is issued and published under section 316, unless authorized by the Director.
(b) FINAL DECISION.— Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an inter partes reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

37 CFR 1.105 Requirement for information.

(a)(1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

(i) *Commercial databases*: The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.

(ii) *Search*: Whether a search of the prior art was made, and if so, what was searched.

(iii)*Related information*: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(iv) *Information used to draft application*: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v) *Information* used in invention process: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) *Improvements*: Where the claimed invention is an improvement, identification of what is being improved.

(vii) *In Use*: Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(viii) *Technical information* known to applicant.

Technical information known to applicant concerning the related art, the disclosure, the claimed subject matter, other factual information pertinent to patentability or concerning the accuracy of the examiner's stated interpretation of such items.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(i), (iii), and (vii) of this section may also be applied to such assignee.

(3) Requirements for factual information known to applicant may be presented in any appropriate
manner, for example:

(i) A requirement for factual information;

(ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or

(iii) Stipulations as to facts with which the applicant may agree or disagree.

(4) Any reply to a requirement for information pursuant to this section that states either that the information required to be submitted is unknown to or is not readily available to the party or parties from which it was requested may be accepted as a complete reply.

(b)The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section will be governed
by §§ 1.135 and 1.136.

37 CFR 1.907 *Inter Partes* reexamination prohibited.

(a) Once an order to reexamine has been issued under § 1.931, neither the third party requester, nor its privies, may file a subsequent request for *inter partes* reexamination of the

patent until an *inter partes* reexamination certificate is issued under § 1.997, unless authorized by the Director.
(b) Once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. 1338 that the party has not sustained its burden of proving invalidity of any patent claim-in-suit, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such civil action, and an *inter partes* reexamination requested by that party, or its privies, on the basis of such issues may not thereafter be maintained by the Office.
(c) If a final decision in an *inter partes* reexamination proceeding instituted by a third party requester is favorable to patentability of any original, proposed amended, or new claims of the patent, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claims on the basis of issues which that party, or its privies, raised or could have raised in such *inter partes* reexamination proceeding.

37 CFR 1.913 Persons eligible to file request for *inter partes* reexamination.

Except as provided for in § 1.907, any person other than the patent owner or its privies may, at any time during the period of enforceability of a patent which issued from an original application filed in the United States on or after November 29, 1999, file a request for *inter partes* reexamination by the Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501.

37 CFR 1.915 Content of request for *inter partes* reexamination.

(b) A request for *inter partes* reexamination must include the following parts:
(7) A certification by the third party requester that the estoppel provisions of § 1.907 do not prohibit the inter partes reexamination.
(8) A statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy.

...

(d) If *the inter partes* request does not include the fee for requesting *inter partes* reexamination required by paragraph (a) of this section and meet all the requirements of paragraph (b) of this section, then the person identified as requesting *inter partes* reexamination will be so notified and will generally be given an opportunity to complete the request within a specified time. Failure to comply with the notice will result in the *inter partes* reexamination request not being granted a filing date, and will result in placement of the request in the patent file as a citation if it complies with the requirements of § 1.501.

37 CFR 1.919 Filing date of request for *inter partes* reexamination.

(a) The filing date of a request for *inter partes* reexamination is the date on which the request satisfies all the requirements for the request set forth in § 1.915.

§ 1.939 Unauthorized papers in *inter partes* reexamination

(a) If an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned.

(b) Unless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the *inter partes* reexamination.

§ 1.985 Notification of prior or concurrent proceedings in *inter partes* reexamination.

(a) In any *inter partes* reexamination proceeding, the patent owner shall call the attention of the Office to any prior or concurrent proceedings in which the patent is or was involved, including but not limited to interference, reissue, reexamination, or litigation and the results of such proceedings.

(b) Notwithstanding any provision of the rules, any person at any time may file a paper in an *inter partes* reexamination proceeding notifying the Office of a prior or concurrent proceedings in which the same patent is or was involved, including but not limited to interference, reissue, reexamination, or litigation and the results of such proceedings. Such paper must be limited to merely providing notice of the other proceeding without discussion of issues of the current *inter partes* reexamination proceeding. Any paper not so limited will be returned to the sender.

MPEP § 2612 Persons Who May File a Request

37 CFR 1.907 defines specific situations where a third party is prohibited from filing a request for an inter partes reexamination. 37 CFR 1.915(b)(7) requires the third party requester to certify that the estoppel provisions of 37 CFR 1.907 do not prohibit the filing of the inter partes reexamination request by the real party in interest (note that it is the real party in interest that is subject to the estoppel provisions and not the party who actually files the request). The certification identified in 37 CFR 1.915(b)(7) will constitute a prima facie showing that the party requesting the inter partes reexamination is not barred from doing so under 37 CFR 1.907. The Office does not intend to look beyond this required certification. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would then need to be addressed. A challenge to the accuracy of the certification must facially establish that the third party requesting the inter partes reexamination is barred from doing so under 37 CFR 1.907. Thus, for example, the challenger cannot rely on an argument that the third party requesting reexamination was, at one point, involved with a party barred under 37 CFR 1.907, and should thus be considered as a real party in interest (and barred from filing the request). Involvement *per se* does not facially establish that the other party is a real party in interest. The fact that a second party may benefit from an earlier reexamination request filed by a first party or a civil action conducted by the first party, or that the second party may have collaborated with the first party in a matter, does not facially evidence the second party was a real party in interest with the first party. With respect to the Office conducting an investigation to uncover whether the second party was a "real party in interest," the statute does not require, nor does it provide the tools, for the Office to investigate such matter. Further, Congress has not provided the Office with subpoena power or discovery tools and has not provided the Office with the ability to conduct hearings for eliciting testimony and cross-examination. The Office has not been authorized to impose punitive sanctions for non-compliance. Such evidentiary tools are, however, available to the courts, which are the appropriate vehicle to make a factual investigation as to the accuracy of the identification of a "real party in interest."

MPEP § 2614 Content of Request for *Inter Partes* Reexamination

The reexamination request must identify the real party in interest who is responsible for filing the reexamination request. This information will be used by future parties requesting reexamination of the same patent, in making the certifications required by 37 CFR 1.915(b)(8).

MPEP 2625 Untimely Paper Filed Prior to First Office Action

Pursuant to 37 CFR 1.939, after filing of a request for *inter partes* reexamination, no papers directed to the merits of the reexamination other than (A) citations of patents or printed publications under 37 CFR 1.501 and 1.933, (B) another complete request under 37 CFR 1.510 or 37 CFR 1.915, or (C) notifications pursuant to MPEP § 2686, should be filed with the Office prior to the date of the first Office action in the reexamination proceeding. Any papers directed to the merits of the reexamination, other than those under 37 CFR 1.501, 1.933, 1.510 or 1.915, or under MPEP § 2686, filed prior to the date of the first Office action will be returned to the sender without consideration. >If the papers are entered prior to discovery of the impropriety, such papers will be expunged from the record.< A copy of the letter *>providing notification of< the returned papers >or expungement< will be made of record in the patent file. However, no copy of the *>returned/expunged< papers will be retained by the Office. If the submission of the *>returned/expunged< papers is appropriate later in the proceedings, they may be filed, and accepted by the Office, at that time. See *Patlex Corp. v. Mossinghoff*, 771 F.2d 480, 226 USPQ 985 (Fed. Cir. 1985); *In re Knight*, 217 USPQ 294 (Comm'r Pat.1982); and *In re Amp*, 212 USPQ 826 (Comm'r Pat. 1981) which addressed the situation analogous to the present situation for *ex parte* reexamination proceedings.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,522	01/11/2011	6,640,086	SCEA.150454	1913

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Intellectual Property Law Office of David Lathrop
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/13/2011

Please find below and/or attached an Office communication concerning this application or proceeding.

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CENTRAL REEXAMINATION UNIT

Eric A. Buresh
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(For Requester)

In re Wall	: DECISION GRANTING
Reexamination Proceeding	: PETITION UNDER
Control No. 95/001,522	: 37 CFR 1.181 AND
For: U.S. Patent No. 6,640,086	: 37 CFR 1.515(c)

This is a decision on the January 13, 2011 paper entitled "PETITION TO THE DIRECTROR FOR REVIEW OF REFUSAL TO ORDER INTER PARTES REEXAMINATION (37 CFR §§1.181 AND 1.927)." No fee is required. The petition is before the Director of the Central Reexamination Unit for decision.

The petition is **granted** for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 6,640,086 (hereinafter, the '086 patent) issued on October 28, 2003 to Wall.

2. On December 1, 2009, a first request for *inter partes* reexamination of the '086 patent was deposited by a Third Party Requester, and this reexamination proceeding was assigned Control No. 95/001,273 (hereinafter, the '1273 proceeding). The request in the '1273 proceeding sought reexamination of claims 1-3, 5-7, 9-12, 14-16, 18-21, 23-28, 30-32, and 34.

3. On January 20, 2010, reexamination was granted in the '1273 proceeding for all requested claims. A non-final office action was mailed along with the Order Granting Reexamination that rejected all requested claims.

4. On March 22, 2010, Patent Owner responded to January 20, 2010 non-final office action by amending independent claims 1, 10, 19, and 26 by incorporating the features of dependent claims 6 and 7.

5. On April 20, 2010, Third Party Requester responded and argued that the amended claims should be rejected in view of the originally filed prior art. Third Party Requester further submitted additional grounds of rejection of the amended claims using newly submitted prior art references.

6. On October 5, 2010, the Examiner issued an Action Closing Prosecution that indicated that all pending claims were allowable as amended.

7. On October 29, 2010, Patent Owner responded to the Action Closing Prosecution and amended the claims to address procedural issues set forth in the prior office action.

8. On November 29, 2010, Third Party Requester responded to the Action Closing Prosecution.

9. On April 11, 2011, the Examiner issued a Right of Appeal Notice that indicated that all pending claims were allowable as amended.

10. On January 11, 2011, the instant request for *inter partes* reexamination of the '086 patent was deposited by a Third Party Requester, and this reexamination proceeding was assigned Control No. 95/001,522 (hereinafter, the '1522 proceeding).

11. An order denying the request for *inter partes* reexamination was mailed on April 8, 2011. The order did not find that a Substantial New Question (SNQ) of Patentability was raised for any of the requested claims.

12. On May 9, 2011, the present petition was filed.

DECISION

Third party requester ("Petitioner") in the '1522 proceeding has petitioned seeking relief from the Examiner's December 14, 2010 Order denying *inter partes* reexamination for all requested claims.

I. Standard of Review

37 CFR 1.927 and 1.181 provide for the filing of a petition to review an examiner's determination refusing to order *inter partes* reexamination. The CRU Director's review of the reexamination request on petition is *de novo*. Therefore, this review will determine whether the examiner's refusal to order reexamination for patent claims 1-7, 9-16, 18-32, and 34 was correct.

The following rules and procedures are applicable to this review:

35 U.S.C. § 312(c) provides:

A determination by the Director under subsection (a) shall be final and non-appealable. Upon a determination that no substantial new question of patentability has been raised, the Director may refund a portion of the inter partes reexamination fee required under section 311.

37 CFR § 1.927 provides:

The third party requester may seek review by a petition to the Director under § 1.181within one month of the mailing date of the examiner's determination refusing to order inter partes reexamination. Any such petition must comply with § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable.

MPEP § 2648 provides, in pertinent part:

Once a request for inter partes reexamination has been denied, jurisdiction over the reexamination proceeding is retained by the Central Reexamination Unit (CRU) to await any petition seeking review of the examiner's determination refusing reexamination. If no petition is filed within one (1) month, the CRU will process the reexamination as a concluded reexamination file. See MPEP § 2647 and § 2694. If a petition is timely filed, the petition (together with the reexamination file) is forwarded to the office of the CRU Director for decision. The CRU Director will then review the examiner's determination that a substantial new question of patentability has not been raised. The CRU Director's review will be de novo.

MPEP § 2642 provides, in pertinent part:

For "a substantial new question of patentability" to be present, it is only necessary that: (A) the prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the (prior art) patents and printed publications is such that a reasonable examiner would consider the teaching to be

important in deciding whether or not the claim is patentable; and (B) the same question of patentability as to the claim has not been decided by the Office in a previous examination or pending reexamination of the patent or in a final holding of invalidity by the Federal Courts in a decision on the merits involving the claim.

II. Summary of the Prosecution and Reexamination History of the '086 Patent

The '086 patent issued to Wall on October 28, 2003. Claims 1-34 were allowed in a first action allowance mailed on May 20, 2003. In the notice of allowance, the Examiner indicated the following as the reasons for allowance:

> "...the prior art of record fails to specifically disclose presenting information through the rasterized visual display to the operator that assists the operator in controlling the operation of the handheld apparatus; providing through the one or more output devices to the operator a presentation of a representation of first content; receiving through the one or more input devices from the operator a second content that overlaps in time the presentation of first content according to a temporal relationship controlled by the operator and an identification of one or more recipients; and sending through the wireless transmitter a representation of the second content and identification of one or more recipients to a remote server that is separated in space from the handheld apparatus, and causing the remote server to send to the one or more recipients a message representing the first content and the second content arranged according to the temporal relationship." *'086 Patent, Notice of Allowance at Pages 2-3.*

The '086 patent was then subject to a first *inter partes* reexamination proceeding, the '1273 proceeding. In the '1273 proceeding, the Patent Owner amended each independent claim to incorporate the features of claims 6 and 7. As a result, the independent claims were amended to incorporate the features of:

> "presenting sounds to the operator through the one or more output devices in response to actuation of the array of switches, and adapting the sound generated in response to the activation of a particular switch within the array of switches according to characteristics of the first content, wherein the second content comprises indications of the actuation of the array of switches by the operator." *See Response after Non-Final Office Action by Patent Owner received on March 22, 2010 at Page 2, Claim 1.*

The Examiner then issued an Action Closing Prosecution (ACP) that withdrew all of the rejections of the amended claims. In the ACP, the Examiner indicated that the rejections presented in Issues 1, 4, 8, 9, and 11 using the Comas, Weiner, Jameson alone, Terada, Ozkan, and Catona references were withdrawn in view of the above noted amendment incorporating claims 6 and 7 into the independent claims (*see ACP mailed October 5, 2010 at Pages 6-7).* The Examiner further indicated that the rejections in view of Jameson were withdrawn because Jameson did not teach "sending through the wireless transmitter a...identification of one or more recipients" (*see ACP mailed October 5, 2010 at Pages 9*).

A Right of Appeal notice was mailed on June 17, 2011. The '1273 proceeding is still pending and a reexamination certificate has not issued. Accordingly, the original claims of the '086 patent remain in force.

III. *De Novo* Review of the Request for Reexamination

In accordance with the requirements of the reexamination statute and rules, a review of the record as it appeared before the Examiner at the time of the order has been undertaken prior to the preparation of this decision. A de novo determination, has been made as to whether the October 6, 2010 request for *inter partes* reexamination raises at least one substantial new question of patentability (hereinafter "SNQ"). This review will focus on the correctness of the ultimate decision to grant or deny reexamination and will not review specific findings in the order denying reexamination.

Petitioner argues that the Examiner denied the Request without substantive analysis of the proposed SNQs. Petitioner asserts that the Examiner did not substantively address the vast majority of the secondary references. Petitioner requests that the Request for Reexamination be granted as to the original claims and the new and amended claims of the '1273 proceeding.

As noted in MPEP 2642:

> "Once the second or subsequent request has provided a "different" substantial new question of patentability based on the claims in effect at the time of the determination, the second or subsequent request for reexamination may also provide information directed to any proposed new or amended claim in the pending reexamination, to permit examination of the entire patent package."

Accordingly, this decision focuses upon the original claims of the '086 patent because the '1273 proceeding is still pending and the original claims remain in effect.

For the reasons set forth below, the request for *inter partes* reexamination of the '086 patent filed in the '1522 proceeding has been found to present an SNQ over original claims 1-7, 9-16, 18-32, and 34. Therefore, the examiner's decision to deny reexamination is improper.

The Request for Reexamination in the '1522 proceeding proposes the following rejections of the original claims of the '086 patent:

1. Jameson in view of Hasegawa allegedly render claims 1-3, 5-7, 9-12, 14-16, 18-21, 23-28, 30-32, and 34 obvious.
2. Jameson in view of Hasegawa and Hotz '274 allegedly render claims 6-7, 15-16, 24, and 31-32 obvious.

3. Jameson in view of Hasegawa and Hotz PCT allegedly render claims 6-7, 15-16, 24, and 31-32 obvious.
4. Jameson in view of Wright allegedly render claims 1-3, 5-7, 9-12, 14-16, 18-21, 23-28, 30-32, and 34 obvious.
5. Jameson in view of Wright and Hotz '274 allegedly render claims 6-7, 15-16, 24, and 31-32 obvious.
6. Jameson in view of Wright and Hotz PCT allegedly render claims 6-7, 15-16, 24, and 31-32 obvious.
7. Comas in view of Miyamoto allegedly render claims 6-7, 15-16, 24, and 31-32 obvious.
8. Comas in view of Yamada allegedly render claims 6-7, 15-16, 24, and 31-32 obvious.
9. Weiner in view of Aoki allegedly render claims 6-7, 15-16, 24, and 31-32 obvious.
10. Weiner in view of Hotz '274 allegedly render claims 6-7, 15-16, 24, and 31-32 obvious.
11. Weiner in view of Hotz PCT allegedly render claims 6-7, 15-16, 24, and 31-32 obvious.
12. Weiner in view of Haferback allegedly render claims 4, 13, 22, and 29 obvious.

The '1522 proceeding is the third request for reexamination of the '086 patent ('1273 proceeding currently pending, '1277 proceeding denied reexamination, and the instant '1522 proceeding). Accordingly, in order for the instant request for reexamination to be granted, it must provide a substantial new question of patentability which is different from that raised in the pending reexamination for the claims in effect at the time of the determination. The decision on a second or subsequent request is thus based on the claims in effect at the time of the determination (37 CFR 1.923). If a "different" substantial new question of patentability is not provided by the second or subsequent request for the claims in effect at the time of the determination, the second or subsequent request for reexamination must be denied since the Office is only authorized by statute to grant a reexamination proceeding based on a substantial new question of patentability "affecting any claim of the patent." See 35 U.S.C. 312. Accordingly, there must be at least one substantial new question of patentability established for the existing claims in the patent in order to grant reexamination.

Each of the references noted above in the proposed rejections will be addressed below. Beginning first with Jameson, the Jameson reference was previously considered and applied in the '1273 proceeding with regards to claims 1-3, 5-7, 9-12, 14-16, 18-21, 23-28, 30-32, and 34. As a result, Jameson will only raise if it has been presented in a "new light." In this case, the Request does not present Jameson in a new light. Instead, the Request merely proposes a new combination of Jameson with the Hasegawa and Wright references. *See Request for Reexamination at Pages 5-6.* Accordingly, Jameson is cumulative to the teachings previously considered and does not raise a SNQ over the requested claims.

Turning to Hasegawa, Hasegawa has not previously been considered against any of the claims of the '086 patent during either prosecution or in the '1273 proceeding. Hence, Hasegawa is new with respect to both the previous prosecution and reexamination proceedings. The Request asserts that Hasegawa raises a SNQ by stating:

> "The combination of Jameson and Hasegawa teaches "sending through the wireless transmitter... one or more recipients." Specifically, Hasegawa describes an electronic musical instrument coupled to a portable telephone terminal[.] Hasegawa at FIG. 1; see also id. at Abstract; 9:40-67; FIGs. 2(a)-(d). The portable telephone terminal includes a transmitter and receiver for wireless communication of music performance information. Id. at 10:18-29; 7:33-58; 12:36-51. Additionally, Hasegawa discloses that users send music performances to a destination through a "dial operation." Hasegawa at 12:34-51; 8:18-27; 9:9-12." *Request for Reexamination at Pages 5-6.*

Hasegawa raises a SNQ by providing teachings relevant to the distinguishing features that were described in the '1273 proceeding relating to Jameson's lack of teaching of "sending through the wireless transmitter a...identification of one or more recipients" (*see ACP mailed October 5, 2010 at Pages 9*). Hasegawa's teachings related to an electronic musical instrument that can dial into a destination to send music information is relevant to the feature of sending through the wireless transmitter an identification of one or more recipients because the sending of a dialed destination may be viewed as sending through the wireless transmitter an identification of a recipient. This teaching would be important to a reasonable Examiner in determining the patentability of the claims. Accordingly, for at least this reason, Hasegawa raises a SNQ over claims 1-3, 5-7, 9-12, 14-16, 18-21, 23-28, 30-32, and 34.

Turning to Hotz '274, Hotz '274 has not previously been considered against any of the claims of the '086 patent during either prosecution or in the '1273 proceeding. Hence, Hotz '274 is new with respect to both the previous prosecution and reexamination proceedings. The Request asserts that Hotz '274 raises a SNQ by stating:

> "Hotz '274 describes a musical instrument having an array of input switching devices (e.g., keys in a keyboard configuration). Hotz '274 at 3:23-39. Hotz '274 also discloses presenting musical sounds through one or more output devices (e.g., tone generators) in response to the user's "manipulations of the keyboard." Id. at 4:11-17. Hotz '274 discloses the use of translation tables in the form of chord and scale tables, to assign keys to particular musical notes and allow dynamic reconfiguration of the keyboard. Id. at 1:27-42; 2:13-16; 6:15-21; 6:38-46; 7:5-12; 7:57-59; 8:15-17; 8:26-29; Tables 1, 2; Abstract. Hotz '274 discloses that a user can "play along" with previously recorded music. Id. at 1:34-37; 2:29-34; 3:23-39; 4:11-17; 6:39-47; 7:5-12. Hotz '274 specifically recites: "Since the chord change and any scale change timing is synchronously provided by the prerecorded media, the musician has creative input but does not have the option of playing an incorrect chord or note." Hotz '274 at 6:44-47." *Request for Reexamination at Pages 6-7.*

Hotz '274 raises a SNQ by providing teachings relevant to the distinguishing features described in claims 6, 7, 15, 16, 24, 31, and 32 of the '086 patent (*see Section II above)*. Hotz '274 teaches that a musical keyboard or guitar neck is presented to the user to allow the user to generate musical notes (*Hotz '274, column 3 lines 23-39*). The user actuates force sensing resistors to generate musical tones in order to "play along" with prerecorded music (*Hotz '274, column 3 lines 23-39; column 6 lines 38-49)*. The chord or scales that are mapped to a particular resistor/switch are synchronized with the prerecorded music thus the tones that are generated depend on the timing of the underlying prerecorded music (*Hotz '274, column 6 lines 39-47).* These teachings would be important to a reasonable Examiner in determining the patentability of the claims because they are relevant to the features of presenting sounds to the operator through the one or more output devices in response to actuation of the array of switches, and adapting the sound generated in response to the activation of a particular switch within the array of switches according to characteristics of the first content, wherein the second content comprises indications of the actuation of the array of switches by the operator. Accordingly, for at least this reason, Hotz '274 raises a SNQ over claims 6, 7, 15, 16, 24, 31, and 32.

Turning to Hotz PCT, Hotz PCT has not previously been considered against any of the claims of the '086 patent during either prosecution or in the '1273 proceeding. Hence, Hotz PCT is new with respect to both the previous prosecution and reexamination proceedings. The Request asserts that Hotz PCT raises a SNQ by stating:

> "Hotz PCT describes an electronic musical instrument with sound generation equipment 24 (i.e., output devices) for presenting musical sounds to users in response to the user manipulating a gesture controller, such as pressing keys on a keyboard (i.e., switch actuations). Hotz PCT at 6:13-17; 6:34-7:14; FIG. 9, item 50. Hotz PCT describes stored rhythm and phrase tables which assign the note value, duration, and velocity that corresponds to a particular depressed key. Id. at Abstract; 8:3-5; 8:11-22; 10:20-33. Hotz PCT discloses that a user can "play along" with previously recorded music. Id. at 6:34-7:5; 10:13-18. Hotz PCT specifically discloses that rhythm and phrase tables "may be changed as a user plays, either by the user or automatically as dictated by a prerecorded musical piece being played along with by the user." Id. at Abstract.)." *Request for Reexamination at Pages 7-8.*

Hotz PCT raises a SNQ by providing teachings relevant to the distinguishing features described in claims 6, 7, 15, 16, 24, 31, and 32 of the '086 patent (*see Section II above)*. Hotz PCT teaches that a musical keyboard or guitar neck allows the user to generate musical notes (*Hotz PCT, page 6 lines 13-28*). The user actuates a switch to generate musical tones in order to "play along" with prerecorded music (*Hotz PCT, page 3 lines 13-24)*. The rhythm, chord, and scale of the notes that are mapped to a particular switch are synchronized with the prerecorded music thus the tones that are generated depend on the timing of the underlying prerecorded music (*Hotz PCT, page 6 lines 24 – page 7line 36).* These teachings would be important to a reasonable Examiner in determining the patentability of the claims because they are relevant to the features of

presenting sounds to the operator through the one or more output devices in response to actuation of the array of switches, and adapting the sound generated in response to the activation of a particular switch within the array of switches according to characteristics of the first content, wherein the second content comprises indications of the actuation of the array of switches by the operator. Accordingly, for at least this reason, Hotz PCT raises a SNQ over claims 6, 7, 15, 16, 24, 31, and 32.

Turning to Wright, the Request asserts that Wright raises a SNQ by stating:

> "Wright teaches "sending through the wireless transmitter one or more recipients," but was not considered by the Examiner in the Pending Proceeding. Id. Specifically, Wright describes an electronic greeting card communication system wherein a portable personal communicator "can communicate through wireless transmissions" with a central system. Wright at 3:32-33. See also id. at 3:29-46; 7:6-14. Specifically, the personal communicator includes a radio transmitter (i.e., wireless transmitter). See, e.g., id. at 3:67-4:3; FIGs. 1 and 2. A user enters recipient addresses or destination information (i.e., identification of one or more recipients) through, for example, the keyboard on the personal communicator. Id. at 11:48-53; 12:68-13:2; FIG. 5 (step 506). The personal communicator sends a request message through an "antenna" to the central system, where the request message includes an identified "destination address." Id. at 9:55-57; 10:2-16; 11:48-57; FIG. 3, item 302."

Wright raises a SNQ by providing teachings relevant to the distinguishing features that were described in the '1273 proceeding relating to Jameson's lack of teaching of "sending through the wireless transmitter a...identification of one or more recipients" (*see ACP mailed October 5, 2010 at Pages 9*). Wright teaches a personal communicator that may transmit messages to a central system for relay to a recipient (*Wright, column 3 lines 27-54*). Wright's system is designed to allow user to choose an electronic greeting card and then add a typed, written, or voice message to the electronic greeting card (*Wright, column 6 lines 60-69).* The electronic message is then sent through a wireless transmitter along with an identification of one or more recipients (*Wright, column 3 lines 27-54; column 6 lines 35-45; Figure 5 – 506).* Wright's teachings of a personal communicator that may transmit messages to a central system for relay to a recipient would be important to a reasonable Examiner in determining the patentability of the claims. Accordingly, for at least this reason, Wright raises a SNQ over claims 1-3, 5-7, 9-12, 14-16, 18-21, 23-28, 30-32, and 34.

Turning to Comas, the Comas reference was previously considered and applied in the '1273 proceeding with regards to claims 1-3, 5-7, 9-12, 14-16, 18-21, 23-28, 30-32, and 34. As a result, Comas will only raise a SNQ if it has been presented in a "new light." In this case, the Request does not present Comas in a new light. Instead, the Request merely proposes a new combination of Comas with the Miyamoto reference. *See Request for Reexamination at Page 11.* Accordingly, Comas is cumulative to the teachings previously considered and does not raise a SNQ over the requested claims.

Turning to Miyamoto, Miyamoto has not previously been considered against any of the claims of the '086 patent during either prosecution or in the '1273 proceeding. Hence, Miyamoto is new with respect to both the previous prosecution and reexamination proceedings. The Request asserts that Miyamoto raises a SNQ by stating:

> "Miyamoto discloses generating sounds in response to switch actuations. Specifically, Miyamoto describes a video game system with a sound generating device that generates sound based on user input. Miyamoto at 26:15-23. For example, a musical score is displayed to a user with symbols of the switches corresponding to the sounds or notes to be played by the user. Id. at 19:31-33; FIGs. 14-18. The user then operates the controller by pressing push-button switches and/or tilting the joystick. Id. at 7:37-8:25; 20:30-40; 22:44-24:20; 18:36-50; 10:49-52." *Request for Reexamination at Page 11.*

Miyamoto raises a SNQ by providing teachings relevant to the distinguishing features described in claims 6, 7, 15, 16, 24, 31, and 32 of the '086 patent (*see Section II above).* Miyamoto discloses a video game system that presents an image to the user and uses push-button switches and an analog joystick (*Miyamoto, column 7 lines 37-49; Figure 22).* The game system displays a musical score and symbols of the switches (*Miyamoto, column 19 lines 31-33).* Sound is generated based upon the user input of the switches and joystick as well as the display which shows the user the sounds associated with each switch (*Miyamoto, column 7 line 37 – column 8 line 7; Figure 17; column 20 lines 41-67*). These teachings would be important to a reasonable Examiner in determining the patentability of the claims because they are relevant to the features of presenting sounds to the operator through the one or more output devices in response to actuation of the array of switches, and adapting the sound generated in response to the activation of a particular switch within the array of switches according to characteristics of the first content, wherein the second content comprises indications of the actuation of the array of switches by the operator. Accordingly, for at least this reason, Miyamoto raises a SNQ over claims 6, 7, 15, 16, 24, 31, and 32.

Turning to Yamada, Yamada has not previously been considered against any of the claims of the '086 patent during either prosecution or in the '1273 proceeding. Hence, Yamada is new with respect to both the previous prosecution and reexamination proceedings. The Request asserts that Yamada raises a SNQ by stating:

> "Yamada discloses generating sounds in response to switch actuations. Specifically, Yamada discloses a video game device that presents "identification sounds" to the user of the device in response to the user pressing the game control buttons. Yamada at 6:2-28. Specifically, Yamada discloses that the "identification sounds are output as sounds with musical notes that differ according to the pressed operating buttons, as if from a piano." Id. at 7:19-24; see also FIGs 2B and 2C. Yamada discloses that a user is presented with an input sequence of symbols indicating operating buttons to be pressed. Id. at 4:33-5:12. As the user presses buttons on the controller, "identification sounds are made to have different pitches differentiating between them, so that the player can readily perceive

> whether the input sequence was successful." Id. at 6:7-10." *Request for Reexamination at Page 12.*

Yamada raises a SNQ by providing teachings relevant to the distinguishing features described in claims 6, 7, 15, 16, 24, 31, and 32 of the '086 patent (*see Section II above).* Yamada discloses a video game system where a user moves a character around the screen using a push button controller (*Yamada, column 4 lines 15-53*). As the user presses buttons in a particular sequence, sounds are generated that have different pitches (*Yamada, column 6 lines 2-20*). Further, with each sequential button press, the visual indications on the screen inform the user that the correct button has been pressed. The generated sounds depend upon the successful and correct sequence of button presses (*Yamada, column 6 lines 2-20*). These teachings would be important to a reasonable Examiner in determining the patentability of the claims because they are relevant to the features of presenting sounds to the operator through the one or more output devices in response to actuation of the array of switches, and adapting the sound generated in response to the activation of a particular switch within the array of switches according to characteristics of the first content, wherein the second content comprises indications of the actuation of the array of switches by the operator. Accordingly, for at least this reason, Yamada raises a SNQ over claims 6, 7, 15, 16, 24, 31, and 32.

Turning to Weiner, the Weiner reference was previously considered and applied in the '1273 proceeding with regards to claims 6-7, 15-16, 24, and 31-32. As a result, Weiner will only raise if it has been presented in a "new light." In this case, the Request does not present Weiner in a new light. Instead, the Request merely proposes the combination of Weiner with the Aoki, Hotz, and Haferback references. *See Request for Reexamination at Pages 13-16.* Accordingly, Weiner is cumulative to the teachings previously considered and does not raise a SNQ over the requested claims.

Turning to Aoki, Aoki has not previously been considered against any of the claims of the '086 patent during either prosecution or in the '1273 proceeding. Hence, Aoki is new with respect to both the previous prosecution and reexamination proceedings. The Request asserts that Aoki raises a SNQ by stating:

> "Aoki discloses a portable communication device that includes a music composing section for inputting a melody comprised of rhythm and pitch data. Aoki at 1:40-44. Aoki's portable communication device includes a "ten key pad and various function switches" and musical tone speaker "for converting the analog musical tone signal into act[u]al sounds." Id. at 4:10-23; 4:36-62; FIG. 1, items 12 and 26. Aoki also discloses a method for generating a melody where a user first inputs rhythm and pitch data. Id. at 9:23-12:18. Aoki recites: [T]he musical scale is assigned to the numeric and symbol switches 12N, and the pitches are directly inputted by the operation of these switches. Every time each switch is pressed, a beat having a predetermined shortest musical not length (for example, an eighth note) and a pitch corresponding to that switch are inputted.

> Id. at 11:61-67; see also id. at FIG. 12(a). Further, Aoki discloses that in addition to displaying inputted pitches, the pitches are "reproduced" or "vocalized." Id. at FIG. 11, item S50; 11:25-29; 11:34-48; 9:36-38; 9:48-51." *Request for Reexamination at Pages 13-14.*

Aoki raises a SNQ by providing teachings relevant to the distinguishing features described in claims 6, 7, 15, 16, 24, 31, and 32 of the '086 patent (*see Section II above)*. Aoki discloses a system to allow user to compose a musical melody using a portable communication terminal apparatus (*Aoki, Abstract*). Aoki's portable terminal displays rhythm data on the screen as a sequence of musical notes (*Aoki, column 9 lines 23-27)*. The buttons of the communication terminal apparatus are then assigned to a particular musical scale (*Aoki, column 11 lines 60-67)*. When the user presses one of the buttons, the musical note is reproduced or vocalized (*Aoki, Figure 11, Items S50*). These teachings would be important to a reasonable Examiner in determining the patentability of the claims because they are relevant to the features of presenting sounds to the operator through the one or more output devices in response to actuation of the array of switches, and adapting the sound generated in response to the activation of a particular switch within the array of switches according to characteristics of the first content, wherein the second content comprises indications of the actuation of the array of switches by the operator. Accordingly, for at least this reason, Aoki raises a SNQ over claims 6, 7, 15, 16, 24, 31, and 32.

Turning to Haferback, Haferback has not previously been considered against any of the claims of the '086 patent during either prosecution or in the '1273 proceeding. Hence, Haferback is new with respect to both the previous prosecution and reexamination proceedings. Further, Haferback is cited as raising a SNQ over claims 4, 13, 22, and 29 that have not previously been reexamined. The Request asserts that Haferback raises a SNQ by stating:

> "...original claims 4, 13, 22, and 29 are not subject to the Pending Proceeding and Haferback discloses the limitations of these claims. Haferback is generally directed to methods for supporting transmission and reception of multimedia data (e.g., image data, voice data, etc.) over a mobile telecommunication system. Haferback at 2:16-21. Haferback discloses means by which "flexibility can be improved with respect to the transmission bandwidth in the use of multimedia services" with respect to transmitting multimedia data using a wireless terminal a cellular telephone). Id. at 2:16-27."*Request for Reexamination at Pages 15-16.*

Haferback raises a SNQ by providing teachings relevant to the claim elements of claims 4, 13, 22, and 29 of the '086 patent. Haferback discloses a telecommunications system that supports multimedia that include both voice and image transmissions (*Haferback, Abstract*). Haferback's discloses an adaptive bandwidth system that balances a voice channel with image carrying channels (*Haferback, column 2 lines 16-21*). These teachings would be important to a reasonable Examiner in determining the patentability of the claims because they are relevant to the feature of a first signal that conveys an adaptive bandwidth-compressed representation of the first content having a bandwidth requirement that changes in response to characteristics of the representation of second content sent by the handheld apparatus and the method comprises

expanding the adaptive bandwidth-compressed representation as presented in claim 4 and in similar form in claims 13, 22, and 29. Accordingly, for at least this reason, Haferback raises a SNQ over claims 4, 13, 22, and 29.

Accordingly, the petition is **granted**.

SUMMARY AND CONCLUSION

1. Based on a de novo review of the record as a whole, the petition is **GRANTED**.

2. Accordingly, the request for *inter partes* reexamination of claims 1-7, 9-16, 18-32, and 34 is hereby ordered.

3. The examiner assignment of the ordered reexamination proceeding will be made pursuant to MPEP 2648.

4. This decision is final and nonappealable. See 35 U.S.C. 312(c) and 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.

5. Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-0700.

Irem Yucel, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
www.uspto.gov

CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,522	01/11/2011	6,640,086	SCEA.150454

EXAMINER
NALVEN, ANDREW

ART UNIT	PAPER
3992	

SUGHRUE MION, PLLC
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SUITE 800
WASHINGTON, DC 20037

DATE MAILED:

02/02/2012

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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EXAMINER
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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Date: MAILED
FEB 02 2012
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001522
PATENT NO. : 6640086
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.
95/001,522	01/11/2011	6,640,086	SCEA.150454	1913

88488 7590 02/02/2012

Intellectual Property Law Office of David Lathrop
No. 827
39120 Argonaut Way
Fremont, CA 94538

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/02/2012

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

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(For Patent Owner)

MAILED

FEB 02 2012

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(Courtesy Copy)

In re Wall
Reexamination Proceeding
Control No. 95/001,522
Filed: April 30, 2009
For: U.S. Patent No. 6,640,086

: **DECISION**
: **DISMISSING**
: **PETITION**

This is a decision on third party requester's September 22, 2011 "PETITION TO MERGE MULTIPLE COPENDING *INTER PARTES* REEXAMINATION PROCEEDINGS (37 CFR § 1.182)" (the petition under 37 CFR 1.182), requesting that *inter partes* reexamination proceeding control no. 95/001,273 be merged with the instant *inter partes* reexamination proceeding.

The petition under 37 CFR 1.182 is before the Office of Patent Legal Administration for consideration.

The petition is dismissed, for the reasons set forth below.

PATENT OWNER'S ADDRESS

The patent owner is called upon to coordinate the proper correspondence addresses in the patent and the reexamination proceedings. Different patent owner addresses are of record for the patent and reexamination proceedings. The current correspondence address of record for the patent file is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c), and it is that of Sughrue Mion, PLLC, 2100 Pennsylvania Avenue, N.W., Suite 800, Washington, DC 20037. Accordingly, all future correspondence will be directed to Sughrue Mion, PLLC, 2100 Pennsylvania Avenue, N.W., Suite 800, Washington, DC 20037, unless, **within ONE (1) MONTH of this decision, patent owner changes the correspondence address of record in the patent, using form PTO/SB/123**.

FEE

The petition under 37 CFR 1.182 was not accompanied by the fee set forth in 37 CFR 1.17(f). The fee for this petition is $400 and will be charged to the '1522 requester's deposit account no. 19-2112 pursuant to the oral authorization of Mr. Eric A. Buresh (Reg. No. 50,394) in a November 14, 2011 phone call.

BACKGROUND

On October 28, 2003, U.S. Patent No. 6,640,086 (the '086 patent) issued to Corbett Wall having claims 1-34.[1]

The 95/001,273 *inter partes* reexamination proceeding

1. On December 01, 2009, a request for *inter partes* reexamination of claims 1-3, 5-7, 9-12, 14-16, 18-21, 23-28, 30-32 and 34 of the '086 patent was filed by a third party requester (the '1273 requester), and the request was assigned control number 95/001,273 (the '1273 proceeding).

2. On January 20, 2010, *inter partes* reexamination was ordered in the '1273 proceeding for claims 1-3, 5-7, 9-12, 14-16, 18-21, 23-28, 30-32 and 34 of the '086 patent. During prosecution of the '1273 proceeding, patent owner filed amendments to the claims, adding new claims 35-94 and cancelling claims 1-3, 6, 7, 10-12, 15, 16, 19-21, 24, 26-28, 31, 32 and 79-82.[2]

3. Prosecution in the '1273 proceeding progressed to the point where, on June 17, 2011, a supplemental Right of Appeal Notice was mailed indicating claims 5, 9, 14, 18, 23, 25, 30, 34-78 and 83-94 are patentable.

4. On July 18, 2011, the '1273 requester filed a Notice of Appeal.

5. On September 19, 2011, the '1273 requester filed an appeal brief, which was found defective in the notification of October 07, 2011. A corrected brief was filed on October 26, 2011.

6. On November 22, 2011, patent owner filed a respondent brief.

The 95/001,522 *inter partes* reexamination proceeding

1. On January 11, 2011, a request for *inter partes* reexamination of original claims 1-7, 9-16, 18-32 and 34 and new and amended claims 5, 9, 14, 18, 23, 25, 30, 34-78, and 83-94 of the '086 patent was filed by a third party requester (the '1522 requester), and the request was assigned control number 95/001,522 (the '1522 proceeding).

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[1] The '086 patent is the subject of litigation in the case styled *Wall Wireless, LLC v. Nintendo Co., Ltd.*, Civil Action No. 6:09-cv-64 (E.D. Texas), which litigation has been stayed pending the outcome in the 95/001,273 reexamination proceeding pursuant to the court order signed January 25, 2010.

[2] See patent owner responses of March 22, 2010 and October 29, 2010.

2. On April 08, 2011, the request for *inter partes* reexamination in the '1522 proceeding was denied.

3. On May 09, 2011, the '1522 requester filed a petition under 37 CFR 1.181 for review of the April 08, 2011 denial.

4. On September 13, 2011, the '1522 requester's May 09, 2011 petition was granted and, *inter partes* reexamination was ordered in the '1522 proceeding for claims 1-7, 9-16, 18-32 and 34 of the '086 patent. To date, no Office action on the merits has been mailed in the '1522 proceeding.

5. On September 22, 2011, the '1522 requester filed the instant petition under 37 CFR 1.182, requesting merger of the '1273 and '1522 reexamination proceedings (37 CFR § 1.182).

RELEVANT AUTHORITY

35 U.S.C. 314(c) states:

> SPECIAL DISPATCH.- Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

37 CFR 1.182 states:

> All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.989(a) states (emphasis added):

> 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 <u>may be made to merge the two proceedings</u> or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

MPEP 2686.01 (I) states in-part (emphasis added):

> 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 <u>(in its discretion)</u> 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."

MPEP 2686.01 (IV) states in-part (emphasis added):

> Pursuant to 35 U.S.C. 314(c), "[u]nless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section shall be conducted with special dispatch within the Office." This statutory provision is grounded on the need for certainty and finality as to the question of patentability raised by the request for reexamination. Thus, if a second request for reexamination will unduly delay the first reexamination proceeding, the two proceedings generally will not be merged. If the Office were to merge the two proceedings, the first reexamination proceeding would need to be withdrawn from its place in the process, thus delaying, instead of advancing, prosecution. This would run contrary to the statutory "special dispatch" requirement of 35 U.S.C. 314 and its intent. On the other hand, if the Office does not merge, the first reexamination proceeding can be concluded, and any substantial new question of patentability raised by the second reexamination request can be resolved in the second proceeding, with no delay resulting. The second request is then considered based on the claims in the patent as indicated in the issued reexamination certificate, rather than the original claims of the patent. However, the Office always retains the authority to merge because in some instances, it may be more efficient to merge the two proceedings, which would foster "special dispatch." The instances where the Office may, or may not, merge an ongoing reexamination proceeding with a subsequent reexamination proceeding, are addressed on a case-by-case basis.

MPEP 2686.01 (VI) states in-part:

> No petition to merge multiple reexamination proceedings is necessary since the Office will generally, *sua sponte*, make a decision as to whether or not it is appropriate to merge the multiple reexamination proceedings.

DECISION

I. Status of the proceedings

Inter partes reexamination of the '086 patent has been ordered in both the '1273 proceeding and the '1522 proceeding.

A review of the file for the '1273 proceeding reveals that claims 1-3, 5-7, 9-12, 14-16, 18-21, 23-28, 30-32, 34-78 and 83-94 are subject to reexamination. Claims 4, 8, 13, 17, 22, 29 and 33 are not subject to reexamination. Claims 1-3, 6, 7, 10-12, 15, 16, 19-21, 24, 26-28, 31, 32 and 79-82 have been cancelled. The examiner has determined that amended and new claims 5, 9, 14, 18, 23, 25, 30, 34-78 and 83-94 are patentable, and the '1273 requester has appealed this finding to the Board of Patent Appeals and Interferences (BPAI).

A review of the file for the '1522 proceeding reveals that claims 1-7, 9-16, 18-32 and 34 are subject to reexamination. Claims 8, 17, and 33 are not subject to reexamination. To date, no Office action on the merits has been mailed in the '1522 proceeding.

II. The '1522 requester's petition under 37 CFR 1.182

In the instant petition under 37 CFR 1.182, the '1522 requester requests merger of the '1522 and the '1273 proceedings. In particular, the '1522 requester requests merger "to prevent inconsistent, and possibly conflicting amendments from being introduced into the two proceedings on behalf of patent owner, to provide a comprehensive examination of the patent based on the issues raised in both of the proceedings, and to expedite the prosecution of both proceedings."[3] Additionally, the '1522 requester asserts "[m]erger is particularly appropriate in light of the procedural posture of both reexamination proceedings" and that "[a]bsent merger, two co-pending reexamination proceedings concerning the same patent will be conducted by two different examiners."[4]

III. Findings and Analysis

The instant petition under 37 CFR 1.182 has been fully considered. To date, the Office has not exercised its discretion to *sua sponte* merge the '1273 and '1522 *inter partes* reexamination proceedings pursuant to 37 CFR 1.989(a).

There is no statutory requirement for the Office to merge, or not to merge, two pending *inter partes* reexamination proceedings. Rather, as set forth in 37 CFR 1.989(a), the determination on whether to merge, or not to merge, two *inter partes* reexamination proceedings is reserved to the sole discretion of the Office. Thus, no petition to merge multiple reexamination proceedings is necessary since the Office will generally, *sua sponte*, make a decision as to whether or not it is appropriate to merge the multiple reexamination proceedings.[5] 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.[6] MPEP 2686.01 (IV) provides that "[w]here 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," and further provides that "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.'"

Contrary to the '1522 requester's assertions, the Office has decided that, based on the individual facts and circumstances in this instance, the statutory mandate for special dispatch is best served

---

[3] Petition under 37 CFR 1.182 at pages 1-2.

[4] Id. at page 2 (stating that upon granting the '1522 requester's petition for review of the examiner's refusal to order inter partes reexamination in the '1522 proceeding, an examiner different from the examiner of the '1273 proceeding was assigned to the '1522 proceeding).

[5] MPEP 2686.01 (VI)

[6] MPEP 2686.01 (IV)

by not merging the '1522 and '1273 proceedings at this time. In this instance, a first Office action on the merits has yet to be mailed in the '1522 proceeding and the '1273 proceeding is at the on-appeal stage. Thus, if the Office were to merge the '1522 and '1273 proceedings, the '1273 proceeding would need to be withdrawn from its on-appeal stage, thus delaying, instead of advancing, prosecution in the '1273 proceeding, which would run contrary to the statutory "special dispatch" requirement of 35 U.S.C. 314.[7] As set forth in MPEP 2681.01 (IV), "if a second request for reexamination will unduly delay the first reexamination proceeding, the two proceedings generally will not be merged."

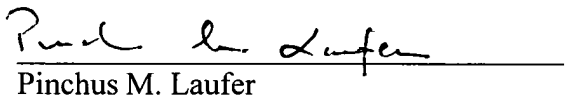
By not merging the two proceedings, the '1273 proceeding can be concluded, resolving the issues raised therein, with no delay resulting in the '1273 proceeding. When a certificate issues for the '1273 proceeding, an amendment would be required from patent owner in the '1522 proceeding to conform the claims in accordance with the issued reexamination certificate. Any substantial new question of patentability raised by the reexamination request in the '1522 proceeding that remains will then be resolved in the '1522 proceeding.

For at least the foregoing reasons, the Office has not found that merger of the '1522 and '1273 proceedings is appropriate at this time. Nonetheless, should the facts and circumstances change, the Office retains the authority to *sua sponte* merge the '1522 and '1273 proceedings at a later date.[8] Accordingly, the instant petition under 37 CFR 1.182 is **dismissed**.

CONCLUSION

1. The petition under 37 CFR 1.182 filed on September 22, 2011 is dismissed.

2. Any questions concerning this communication should be directed to Nicole D. Haines, Legal Advisor, at 571-272-7717.



Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

February 1, 2012

[7] See id.
[8] See id. (stating, "However, the Office retains the authority to merge because in some instances, it may be more efficient to merge the two proceedings, which would foster "special dispatch.").

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,525	01/21/2011	7777783	017874-0003	4939

23308 7590 06/08/2011

PETERS VERNY , L.L.P.
425 SHERMAN AVENUE
SUITE 230
PALO ALTO, CA 94306

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/08/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
David R. Yohannan, Esq.
KELLEY DRYE & WARREN LLP
3050 K Street, NW, Suite 400
Washington, DC 20007

Date:
MAILED
JUN 08 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001525
PATENT NO. : 7777783
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

Decision on Petition for Extension of Time in Reexamination	Control No.: 95/001,525

1. THIS IS A DECISION ON THE PETITION FILED June 7, 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:
   A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.

   The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS
   Patent owner requests that the period for responding to the Office action mailed on March 7, 2011, which sets a one month period for filing a response thereto, be extended by **one month**.

   A. ☒ Petition fee per 37 CFR §1.17(g)):
      i. ☐ Petition includes authorization to debit a deposit account.
      ii. ☐ Petition includes authorization to charge a credit card account.
      iii. ☒ Other: paid via EFS Web.
   B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
   C. ☒ Petition was timely filed.
   D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)
   A. ☒ Granted or ☐ Granted-in-part for _____, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
      ☐ Other/comment: _____.
   B. ☐ Dismissed because:
      i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
      ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
      iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
      iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
      v. ☐ The petition is moot.
      vi. ☐ Other/comment: _____.

5. CONCLUSION
   ONE MONTH Extension of time **GRANTED**.
   Telephone inquiries with regard to this decision should be directed to J. Harrison at 571-272-4449 . In his/her absence, calls may be directed to M. Reinhart at 571-272-1611 in the Central Reexamination Unit.

/J. Harrison/	SPE, AU 3992
[*Signature*]	(Title)

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,525	01/21/2011	7777783	017874-0003	4939

38790 7590 08/03/2011

THE SMALL PATENT LAW GROUP LLP
225 S. MERAMEC, STE. 725T
ST. LOUIS, MO 63105

EXAMINER

ART UNIT	PAPER NUMBER

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,525	01/21/2011	7777783	017874-0003	4939

23308 7590 06/08/2011

PETERS VERNY , L.L.P.
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PALO ALTO, CA 94306

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 8-3-11

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Date: 8-3-11

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
David R. Yohannan, Esq.
KELLEY DRYE & WARREN LLP
3050 K Street, NW, Suite 400
Washington, DC 20007

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001525
PATENT NO. : 7777783
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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CENTRAL REEXAMINATION UNIT

(For Patent Owner)

PETERS VERNY , L.L.P.
425 SHERMAN AVENUE
SUITE 230
PALO ALTO CA 94306

(For Requester)

KELLEY DRYE & WARREN LLP
3050 K STREET, NW
SUITE 400
WASHINGTON, DC 20007

(Courtesy Copy)

THE SMALL PATENT LAW GROUP LLP
225 S. MERAMEC, STE. 725T
ST. LOUIS MO 63105

In re: Chin *et alia*	:
Reexamination Proceeding	: **DECISION**
Control No. 95/001,525	: **DISMISSING**
Request Deposited: January 21, 2011	: **PETITION**
For: U.S. Patent No. 7,777,783	:

The *inter partes* reexamination is before the Central Reexamination Unit to address the July 29, 2011 third party requester (3PR) paper entitled "PETITION UNDER 37 C.F.R. § 1.181(a)(1) or (a)(3) TO DENY ENTRY OF IMPROPER PATENT OWNER RESPONSE TO OFFICE ACTION".

A review of the record reveals that patent owner (PO) filed a response on July 8, 2011 via the Electronic Filing System – Web (EFS-Web).

The "LEGAL FRAMEWORK FOR EFS-WEB" reads, in part:

> When the USPTO successfully receives documents filed in accordance with the EFS-Web requirements, the USPTO will convert the PDF files submitted by users into Tagged Image File Format (TIFF) image files and then store the TIFF image files in the Image File

> Wrapper (IFW) as part of the official record...Accordingly, the official record for the patent application and reexamination proceeding comprises...TIFF images of all other original documents as stored in IFW as well as the Electronic Acknowledgement Receipt...

Therefore, the July 8, 2011 papers submitted by PO are part of the official record by virtue of the successful reception of the documents via EFS-Web. It is noted that the Office has not yet issued an Office Action considering or not considering the response of July 8, 2011. Nor has the Office expunged the papers.

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

As the Office has not yet issued an Office Action considering, not considering, or expunging the comments of July 8, 2011, there is no action or requirement of any examiner to petition. Therefore, the request is **dismissed as premature** under 37 CFR 1.181.

It should be noted that this decision does not address the substance of the July 8, 2011 papers as to compliance issues. Also, this decision does not address the merits of the papers with respect to prosecution.

Inquiries regarding this decision may be directed to Eric Keasel, Supervisory Patent Examiner, at (571) 272-4929.

This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.

Eric Keasel

Eric Keasel
SPE, Central Reexamination Unit, Art Unit 3992

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CENTRAL REEXAMINATION UNIT

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225 Franklin Street
Boston, MA 02110

(For Requester)

Procopio, Cory, Hargreaves & Savitch LLP
525B Street, Suite 2200
San Diego CA 92101

(For Patent Owner)

In re Arviv, et al
Reexamination Proceeding
Control No.: 95/001,526
Filed: January 21, 2011
For: U.S. Patent No.: 6,549,759
Title: Asymmetric Adaptive Modulation In A Wireless Communication System

: DECISION DISMISSING
: §1.182 and § 1.183
: PETITIONS

This is a decision on March 11, 2011 Patent Owner petition under 37 CFR 1.182 and 1.183 seeking to vacate the filing date of a January 21, 2011 request for *inter partes* reexamination, in that (1) one of the real party in interests was not named, and (2) a reference to a co-pending litigation was omitted. The petitions for vacatur will be treated only under 37 CFR 1.182.

The petitions are before the Office of Patent Legal Administration for consideration.

The March 11, 2011 Patent Owner petition under 37 CFR 1.182 and 1.183 is dismissed, except that the rules have been waived to the extent necessary to substantively consider the petition.

I. FEES

The § 1.182/1.183 petition fee of $400.00 fee (as set forth in 37 CFR 1.17(f)) has been paid as indicated in Office PALM records.

II. BACKGROUND

1. U.S. Patent No. 6,549,759 (the '759 patent) was issued on April 15, 2003.

2. On January 21, 2011, a request for *inter partes* reexamination of the '759 patent was filed by Requester Gilbert H. Hennessey.[1] The request:

    a. Sets forth as the real party in interest CSR plc,[2] and

    b. Notes a concurrent proceeding that identifies:[3]

        i. Copending reexamination Control No. 95/001,299, (the '299 proceeding),

        ii. Real parties in interest for the '299 proceeding: Broadcom Corporation and Intel Corporation, and

        iii. Concurrent litigation *Wi-LAN, Inc. v. Acer Inc. et. al.*, Case No. 2 :07-CV-473 (E.D. Tex.).

4. On February 9, 2011, the Office mailed:

    a. A Notice of *Inter Partes* Reexamination Request Filing Date,

        i. Recognizing a filing date of January 21, 2011 for the request, and

        ii. Assigning a reexamination control No. 95/001,526 (the '526 reexamination proceeding), and

    b. A Notice of Assignment of *Inter Partes* Reexamination Request, noting assignment of the proceeding to Art Unit 3992 for prosecution:

    To date, the reexamination request has not been acted on.

5. On March 11, 2011, Patent Owner filed the instant petitions under 37 CFR 1.182 and 37 CFR 1.183 to vacate the filing date of the present reexamination proceeding as failing to:

    a. Name a real party in interest, and

    b. Identify concurrent litigation.

---

[1] Request, at page 1, paragraph 2a.
[2] *Id.*, at page 1, paragraph 2b.
[3] *Id.* at page 2, paragraph 16.

6. On March 24, 2011 Requester submitted A Notice stating that:

   a. Requester will refrain from contesting the Patent Owner's pending petition to vacate or the grant thereof, and

   b. In the alternative, Requester requests immediate withdrawal of its pending re-examination request.

7. On March 25, 2011 the request for *inter partes* re-examination was denied based on its failure to raise a substantial new question of patentability.

Notes:

(1) Notwithstanding the denial of the reexamination request and consequent loss of filing date for the reexamination request, the instant petition seeking vacatur of the filing date based on failure to identify a real party in interest will be acted upon for, if it were granted, the denial of the reexamination request based on failure to raise a substantial new question of patentability would have been vacated.

(2) After the request for *inter partes* reexamination ,including the entire fee for requesting reexamination is received in the Office, no abandonment, withdrawal, or striking of the request is possible, regardless of who requests the same.[4]

III. Petition Under 37 CFR 1.183

The petition under 37 CFR 1.183 requests waiver of 37 CFR 1.939. 37 CFR 1.939(b) provides that, unless authorized, no paper shall be filed prior to the initial Office action on the merits of the *inter partes* reexamination. As an initial action on the merits has not occurred, third-party Requester (Requester) seeks waiver of that prohibition to permit entry of the petition under 37 CFR 1.182, seeking vacatur of the reexamination filing date.

IV. Decision on Petition Under 37 CFR 1.183

The instant petition under 37 CFR 1.182 is directed towards identification of a real party in interest. It is in the interest of the reexamination process that reexamination requests are not granted a filing date without identification of the real party in interest, since without such identification, the estoppel provision of *inter partes* reexamination under 35 U.S.C. 315(c) and 317(a), and 37 CFR 1.907(a) and (b) cannot be given effect.

[4] MPEP 2610.

Accordingly, the Office will waive 37 CFR 1.939(b) to the extent such waiver is needed to substantively consider the present petition.

V. Petition Under 37 CFR 1.182 for Vacatur

Petitioner (Patent Owner) notes that: [5]

1. The requester of an *inter partes* reexamination by statute must identify the real party in interest who is requesting the reexamination,
2. The Office has acknowledged its responsibility that all real parties in interest be identified,
3. A filing date will not be granted until the actual real parties in interest are named, and
4. Extrinsic evidence may be submitted to support a petition to vacate the filing date or an order by the Office for the Requester to show cause why the filing date should not be vacated.

Patent Owner asserts that the filing date of the instant reexamination should be vacated in that:

(1) The real party in interest, SiRF Technology, Inc (SiRF) (along with CSR plc (CSR)), was not properly identified in the request for reexamination as required by § 1.915(b)(8),[6] and

(2) A reference to a co-pending litigation was omitted.[7]

Asserted failure to name a real party in interest:

Petitioner relies on the filing of papers by SiRF and CSR in concurrent litigation[8] as establishing both to be a real party in interest in the instant reexamination request. The litigation record is asserted to establish that SiRF and CSR "are commonly owned corporate entities who worked together as named defendants through the same counsel,"[9] and who filed answers "identical in substance" as to issues involving the '759 patent being reexamined, including "seventeen affirmative defences and eight counterclaims" as well as an "identical assertion of invalidity of the '759 patent.[10]

The decision to omit any mention of SiRF in the *inter parties* reexamination request is asserted to be part of a "well orchestrated attempt ... to minimize the estoppel effects of 35 U.S.C. § 315(c) associated with the filing of the instant *inter partes* re-examination" in regard to the SiRF U.S. subsidiary of British holding company CSR and "opens the door to potential harassment through subsequent *inter partes* re-examination requests by SiRF Technology, In."[11]

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[5] Petition, at page 5.
[6] Petition, at pages 1 and 2.
[7] Petition, at page 7.
[8] *Wi-Lan, Inc. v. Acer Inc. et al.*, Civil Action No. 2 :10-ev-124 (E.D. Tx.) ('124 litigation).
[9] Petition, at page 5.
[10] Petition, at pages 6 and 7.
[11] *Id.*

Reference to concurrent litigation omitted:

Patent Owner also points to the absence of a reference by Requester to the concurrent '124 litigation and asserts that such absence also warrants vacating the filing date of the instant reexamination proceeding.[12]

VI. DECISION ON § 1.182 PETITION BY PATENT OWNER

Failure to name a real party in interest:

The § 1.182 petition by patent owner seeking vacatur of the *inter partes* reexamination based on the failure to name SiRF as a real party in interest is dismissed.

The MPEP[13] makes clear that the Office does not look beyond the required certification in the request for reexamination, except for the rare instance where a challenge to the sufficiency of the certification facially establishes that the identified real party in interest is not accurate. The certification cannot be successfully challenged merely because, at one point, the certified real party in interest was "involved" with another party, or there was some collaboration in a matter other than the request for reexamination.

The common interest among litigation defendants seeking to invalidate or defend against enforcement of a patent, such as in the litigation identified by Patent Owner, does not translate *ipso facto* into each defendant being a real party in interest where a request for reexamination is filed by only one of the defendants in the litigation. This is not to say that the other defendants cannot be real parties in interest in a request for reexamination, but the existence of such result cannot be assumed merely on the basis of the concomitant use of the same counsel, defenses and/or counterclaims. To be required to be named as a real party in interest, a party must participate in some manner in the request for reexamination. Accordingly, even a search for prior art, review of possibly useful prior art with respect to the patent claims, preparation of an invalidity defense based on found and evaluated prior art to support a litigation defense, and financial support *to carry out a litigation defense* - do not amount to participation in a request for reexamination based on such activities, where the activities were conducted with only an intent to defend the litigation suit. Evidence that the activities were conducted with an intent to file an *inter partes* reexamination request is required, in order for a petitioner to establish that other defendants (co-defendants) in the litigation are real parties in interest in a request for reexamination. And, in this case, no such persuasive evidence has been provided.

Notwithstanding any actual benefit that would result to other defendants from a favorable result in the reexamination, the question of whether a co-defendant is a

[12] Petition, page 7.
[13] MPEP § 2612.

real party in interest in the reexamination must be determined on a case-by-case basis focusing on **a proffered showing** of participation of a party in regard to the filing of a request for reexamination, and not ancillary matters, such as a party being a co-defendant in a litigation. For example, if the Office were to follow petitioner's line of reasoning, a patent owner might challenge an identification of the real party in interest in a reexamination where a third party requester not involved in the litigation (as to the patent) and even ignorant thereof, was to file a request for reexamination of the patent in litigation utilizing one or more pieces of prior art employed by unrelated defendants in the litigation. The third party requester could be placed in a position of having to prove a negative - that it did not participate in the litigation. Similarly, here, a co-defendant need not prove a negative - that it did not participate in the reexamination. The fact that a first party defendant participated in a joint defense, or utilized the same counsel, and another party defendant later filed a request for reexamination, should not doom the first party to life as a real party in interest for any request for reexamination that may be later filed by another defendant in the joint litigation defense or who utilized joint counsel. Rather, the burden is on the challenging patent owner to provide evidence of participation.

To further illustrate the Office's position: It may be that a particular defendant in a litigation has decided to proceed with a request for reexamination in the face of hostile opposition by one or more other defendants in the litigation (who would rather settle the matter in court, than before the Office, based on the nature of their case) who should therefore not be embraced as a real party in interest in the request for reexamination. To do so, would result in estoppel against parties who had no control over the request for reexamination. None-the-less, using petitioner's theory that the other co-defendants in the litigation must be deemed to be real parties in interest in a first defendant's initial request (for reexamination of the patent in litigation), the other defendants may be barred (under 35 U.S.C. § 317(a)) from raising other known prior art that they may feel is better in a subsequent request for reexamination after the first request has been ordered.

In deciding a petition for vacatur, the Office will not engage in conjecture as to the participation in the request for reexamination of any particular alleged unnamed real party in interest. For purposes of this decision, it is not disputed that co-defendant SiRF may be impacted, and may even benefit from the filing of the instant reexamination. However, it is incumbent upon Patent Owner to present objective evidence that a party not identified as a real party in interest in fact participated (a) in the request for reexamination, or (b) in the reexamination proceeding after the request was filed.

A. <u>The Identification Of The Real Party In Interest Is Not Facially Inaccurate Or Ambiguous. Therefore, The Office Lacks The Authority And The Tools To Question That Identification.</u>

The arguments presented in the § 1.182 petition for vacatur fail to establish that the Office has the authority to question the accuracy of a third party requester's facially accurate and unambiguous identification of the real party in interest in this *inter partes* reexamination proceeding, or the tools to competently conduct an investigation of the matter.

To the extent that Patent Owner argues that the Office has the ability to investigate the accuracy of the identification of the real party in interest in an *inter partes* reexamination proceeding, or to issue a Show Cause Order requiring the identified real party in interest to confirm that it, and it alone, is the real party in interest, Patent Owner does not make a persuasive case that the Office is required to do so by either the reexamination statute or the reexamination regulations, when the *inter partes* reexamination as filed contains an unambiguous identification of the identity of the real party in interest.

Patent owner's argument is not persuasive, because it does not reflect the intent of the provisions of 37 CFR 1.915(b)(7) and (b)(8). A certification statement made pursuant to 37 CFR 1.915(b)(7) is a statement <u>by</u> the third party requester to the effect that the third party requester is not <u>itself</u> estopped by the statutory estoppel provisions from filing a request for *inter partes* reexamination of a given patent. The *inter partes* rule making at 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), provides that:

> It should be noted that the Office generally will not have a need to resolve the factual issue of whether or not one party is a privy of another party. Section 1.915(b)(7) requires a third party requester to certify that the estoppel provisions of §1.907 do not prohibit the filing of the *inter partes* reexamination request, and the Office does not intend to look beyond this required certification. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would then need to be addressed.

A substantially identical statement also appears at 65 Fed. Reg. 76756, 76764. These statements establish that the Office will, only in the rare instance that it is necessary to do so (a facial showing of inaccuracy or an ambiguity), "address" the accuracy of a certification that statutory estoppel does not bar the filing of a request for *inter partes* reexamination. Further, the rule making does not discuss the type or depth of investigation that can and will be undertaken, and it does not state or imply that a patent owner may trigger an investigation of the accuracy of the certification merely by advancing an unsupported allegation that another party is a real party in interest (by way of having participated in the reexamination request).

This is not an instance where the identification of the real party in interest required by 37 CFR 1.915(b)(8) is ambiguous or facially inaccurate, in which instance the third party requester who is before the Office can be queried by the Office, because the record is not clear at that point in time (*i.e.*, the ambiguity causes an issue that is ripe for consideration). Since the present record in the instant reexamination proceeding is not ambiguous as to the identification of the real party in interest (and Patent

Owner has provided no persuasive extrinsic evidence to establish ambiguity), there is no basis to proceed any further in this proceeding as to the matter. Likewise, this is not an instance where all co-defendants have been shown to appear to rely on the request for reexamination as a basis for a joint motion to stay the litigation, where, in an appropriate circumstance, a third party requester who is before the Office can be queried by the Office, to provide an explanation.

Aside from the above, another reexamination proceeding that would be the subject of the above-cited paragraph of the rule making notice has not yet been filed, nor has a final decision apparently issued in the litigation; thus the issue is not ripe for consideration (see discussion in part B. below). If the issue does become ripe for consideration via another reexamination proceeding filed by a subsequent requester (who is one of the co-defendants),[14] the Office can then query an *ambiguous or facially inaccurate* 37 CFR 1.915(b)(7) certification statement. In that instance, the subsequent third party requester making such statement would become a party appearing before the Office. In other words, a second co-defendant, *i.e.*, the subsequent third party requester, would then be available to be asked by the Office to clarify or support a 37 CFR 1.915(b)(7) certification statement that is ambiguous or facially inaccurate. Presumably, that third party requester would be able to respond based on facts wholly within its knowledge and possession. In such a case, the Office could obtain information from the patent owner and the subsequent third party requester, and would have no need to obtain information from a party not before the Office by reason of the filing of a first request for *inter partes* reexamination.

Apart from the inherent ability of the Office to issue an Show Cause Order directed to a party that <u>is before the Office</u>, Patent Owner does not point to any regulation that would provide a mechanism for conducting an investigation directed to determining whether parties not before the Office are in fact real parties in interest in an *inter partes* reexamination proceeding. For example, 37 CFR 1.105 was promulgated pursuant to 35 U.S.C. §§ 131 and 132, statutes that relate to the examination of applications and (via incorporation by the reexamination statute) the conduct of reexamination proceedings <u>as to patentability</u>. The regulation was promulgated <u>for the purpose of requiring submission of information material to patentability from persons having a duty under 37 CFR 1.56 to disclose information to the Office that is material to patentability</u>.[15] The identification of the real party in interest has no relationship to the duty to disclose information that is material to patentability (which applies to an applicant for patent and to a patent owner in a reexamination proceeding).[16] With respect to obtaining information from a party who is alleged to be an undisclosed real party in interest in an *inter partes* reexamination proceeding, it is not apparent how 37 CFR 1.105 could be applied to a party who is not before the Office in that proceeding.

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[14] The is no allegation by Patent Owner that the earlier '1,299 reexamination was filed by a party in privy with CSR, or SiRF thereby baring the instant reexamination.

[15] 65 Fed. Reg. 54604, 54633, (Sept. 8, 2000).

[16] See 37 CFR 1.933, which refers back to 37 CFR 1.555, which in turn, references 37 CFR 1.105. These regulations do not create a duty to disclose information material to patentability (or any duty of disclosure) that attaches to a reexamination third party requester.

Therefore, where a patent owner who is a party in an *inter partes* reexamination proceeding believes that an identification of the real party in interest is inaccurate, even though it is facially unambiguous, the courts are the appropriate venue from which the patent owner should seek relief to obtain evidence extrinsic to the record, for incorporation into the record. It is to be noted that there is precedent on the issue of "real party in interest" in the federal courts, on matters ranging from jurisdiction (*e.g.*, presence of diversity or amount of suit)[17] to actions in which the principle is applied to prevent multiple or conflicting lawsuits by persons such as assignees.[18] These examples of court proceedings resolving "real party in interest" issues demonstrate the reason why the Office cannot perform such a function here. Upon obtaining jurisdiction over the parties, courts may order discovery, taking of testimony with cross-examination and use of other evidentiary tools, while enforcing compliance with its requirements via its subpoena power and power to impose sanctions. Accordingly, the courts are the forums best equipped to determine who is, and who is not, the "real party in interest" when there is a reason to doubt the third party requester's identification of a party or parties as being the real party in interest in an *inter partes* reexamination proceeding. Further, courts may provide relief, as appropriate, by enjoining the filing of a further *inter partes* reexamination request by the other parties in a civil action. Even if an *inter partes* reexamination request was filed by one of the other parties in the civil action who is barred from requesting *inter partes* reexamination by statutory estoppel, a court could always enjoin participation by that requester in the proceeding and essentially turn the proceeding into an *ex parte* reexamination proceeding, the filing of which does not require identification of "a real party in interest" (35 U.S.C §§ 301 and 302), and is not prohibited by statute or rule, even after an *inter partes* reexamination was filed by the same real party in interest.[19]

A patent owner concerned with the issue of misidentification of the real party in interest in a request for *inter partes* reexamination may immediately seek relief from the alleged erroneous identification of the "real party in interest" via the courts, which possess the tools to investigate and obtain information as to the relationship of the parties to ascertain the veracity of the identified "real party in interest." The present petition is silent as to why Patent Owner has not approached the appropriate District Court for relief (*e.g.*, an investigation into the matter and issuance of an appropriate order). Given the emphasis that petitioner Patent Owner has placed on the importance of the "real party in interest" disclosure requirement, it would appear that Patent Owner could have immediately sought relief in the appropriate court regarding the identity of the real party in interest. The record does not show that Patent Owner has done so. The Office may consider that it is "the sole agency that administers the patent statute,"[20] and the Office certainly conducts the *inter partes* proceeding; however, it is common knowledge that the

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[17] *Varlotta Construction Corporation v. Carla Development Corporation*, 886 F. Supp 315 (E.D.N.Y. 1995).
[18] *First Hartford Corporation Pension Plan & Trust v. United States*, 194 F.3d 1279 (Fed. Cir. 1999).
[19] If the court makes a finding that the "real party in interest" was misstated, the Office can then take action, if appropriate, based upon the court's findings.
[20] 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), emphasis added.

federal courts (which are not an agency in the sense used in the *inter partes* reexamination rule making) routinely adjudicate matters arising under the patent statute. Further, Patent Owner should appreciate the difference between conducting a reexamination proceeding, which is the province of the Office, and enforcing an estoppel provision of Federal law as a matter of equitable relief. Patent Owner has not provided any basis for believing that the district courts lack authority to act as described above.

As a final point in this section of the decision as to the Office lacking the authority to investigate: The reexamination statute requires, *inter alia*, that a request for *inter partes* reexamination proceeding "shall ... include the identity of the real party in interest... ."[21] The *inter partes* reexamination rules require that a request for *inter partes* reexamination include, *inter alia*, "[A] statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that party is a privy."[22] Requester has clearly stated that CSR is the real party in interest, and that is an identification to a sufficient extent that "a party, such as SiRF, filing a subsequent *inter partes* reexamination request" can look into its interaction with the identified CSR to "determine whether that person is a privy" with the real party in interest that filed the present reexamination. Neither the *inter partes* reexamination statute nor the *inter partes* reexamination rules imposes a duty on the Office to investigate the accuracy of an unambiguously identified real party in interest in a third party requester's request for *inter partes* reexamination proceeding.

In the present *inter partes* reexamination proceeding, the real party in interest is unambiguously identified in the current record. The identification of the real party in interest does not appear to be facially inaccurate. The Office will refuse to accord a filing date to a request for *inter partes* reexamination that does not identify the real party in interest, or which provides an identification of the real party in interest that is ambiguous or facially inaccurate. If the Office accords a filing date to a request for *inter partes* reexamination, and later discovers an ambiguity or a facial inaccuracy in the identification of the real party in interest, the Office can, and will, require that a party appearing before it as third party requester in an *inter partes* reexamination proceeding clarify the ambiguity or facial inaccuracy. However, it does not follow that the Office is empowered to conduct an investigation into the identity of the real party in interest when the statement identifying the real in interest in the record of an *inter partes* reexamination proceeding is neither facially inaccurate nor ambiguous. The Office will not conduct an investigation into the accuracy of the identification of the real party interest in the instant reexamination proceeding, because there is no legal reason to do so, even if the Office's ability to do so could be shown (which it has not been, as discussed above).

[21] 35 U.S.C. § 311(b)(1).
[22] 37 CFR 1.915(b)(8).

B. The Office Has No *Present* Duty To Investigate The Identity Of The Real Party In Interest In The Instant *Inter Partes* Reexamination Proceeding.

It is also to be noted that, in the instant reexamination proceeding, Patent Owner is requesting relief based upon an injury that has not yet occurred, and may never occur, even according to Patent Owner's view of the situation. Patent Owner does not allege that the named real party in interest is itself estopped from filing and participating in the instant reexamination proceeding. Rather, Patent Owner's concern must be that Patent Owner might be harassed by the filing of a subsequent request for *inter partes* reexamination of the patent or that the instant reexamination will be inappropriately maintained by a party that should have been identified as a real party in interest in the instant reexamination proceeding, but was not so identified. Such a hypothetical party, as a real party in interest in the instant reexamination proceeding, would be subject to a statutory estoppel that could preclude (if the statutory provisions are satisfied) its filing of another *inter partes* reexamination proceeding, or from maintaining the instant reexamination proceeding if such a party "loses" as a defendant in any litigation of the patent. While a patent owner is statutorily entitled to be protected from harassment by the filing of a subsequent request for *inter partes* reexamination of the patent by a party who is estopped from filing such a request, the record simply does not show that such a circumstance presently exists as to the instant reexamination proceeding. No additional requests for *inter partes* reexamination of the patent have been filed by co-defendant SiRF nor is the only identified litigation (as to the patent) final. Thus, clearly there is presently no cause for concern that a misidentification of the real party in interest has permitted a party subject to statutory estoppel to file an additional request for *inter partes* reexamination of the patent or inappropriately maintained the instant one. Patent Owner's arguments directed to SiRF being commonly owned and controlled by CSR holding company are matters of whether privity exists between SiRF and CSR that could bar a subsequent reexamination request by SiRF, if proven by evidence.

Accordingly, there is no need to consider addressing the relief requested by Patent Owner in the present *inter partes* reexamination proceeding, since Patent Owner cannot have been injured by the filing of another request for *inter partes* reexamination for the patent or by maintaining a reexamination that is barred by statutory estoppel.

C. Synopsis

Rather than having presented clear and undisputed evidence establishing that CSR is not the only real party in interest in the instant reexamination proceeding, the petition is supported only by supposition and conjecture on patent owner's part. Accordingly, Patent Owner has not demonstrated a persuasive basis for the requested relief of vacatur of the filing date of the instant reexamination proceeding or issuance of a show cause order why the filing date should not be vacated. Therefore, such request for relief is dismissed.

Reference to concurrent litigation omitted:

Other than a bare allegation that Requester's failure to reference the '124 litigation is sufficient basis to vacate the filing date of the instant reexamination, Patent Owner has provided no support for this position.

37 CFR 1.915 sets forth the required items for an *inter partes* reexamination request, which items do not include a reference to concurrent litigation. Therefore, the failure by Requester to submit a reference to concurrent litigation is not an issue relating to the filing date of the reexamination.

The Office's form PTO/SB/58, for requesting *inter partes* reexamination, provides an opportunity to identify concurrent litigation as such information is important to the Office. Notice of concurrent litigation is required to be submitted pursuant to 37 CFR 1.985, and MPEP 2686. The rule, however, places the requirement for such notice *on the Patent Owner* and not on the Requester. In any case, it is noted that (1) Requester did reference the pending prior request for *inter partes* reexamination, which itself references that '124 litigation, and (2) Patent Owner has now supplied the notice of concurrent litigation as called for by rule.

VII. CONCLUSION

1. The March 11, 2011 Patent Owner petition is dismissed as to the aspect of the petition seeking vacatur of the reexamination.

2. The March 11, 2011 Patent Owner petition is granted to the extent that the rules have been waived to the extent necessary to substantively consider the petition.

3. Telephone inquiries related to this decision should be directed to Hiram H. Bernstein, Senior Legal Advisor, at (571) 272-7707.

/Kenneth M. Schor/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

4-14-11
Kenpet8/IP/...

APPENDIX OF RELEVANT STATUTORY, REGULATORY, AND PRACTICE PROVISIONS

35 U.S.C. § 311 Request for inter partes reexamination.

(a) IN GENERAL.— Any third-party requester at any time may file a request for inter partes reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.
(b) REQUIREMENTS.— The request shall—
(1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an inter partes reexamination fee established by the Director under section 41; and
(2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.

35 U.S.C. § 315 Appeal.

* * * * *

(c) CIVIL ACTION.— A third-party requester whose request for an inter partes reexamination results in an order under section 313 is estopped from asserting at a later time, in any civil action arising in whole or in part under section 1338 of title 28, the invalidity of any claim finally determined to be valid and patentable on any ground which the third-party requester raised or could have raised during the inter partes reexamination proceedings. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

35 U.S.C. § 317 Inter partes reexamination prohibited.

(a) ORDER FOR REEXAMINATION.— Notwithstanding any provision of this chapter, once an order for inter partes reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for inter partes reexamination of the patent until an inter partes reexamination certificate is issued and published under section 316, unless authorized by the Director.
(b) FINAL DECISION.— Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an inter partes reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

37 CFR 1.105 Requirement for information.

(a)(1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

(i) *Commercial databases*: The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.

(ii) *Search*: Whether a search of the prior art was made, and if so, what was searched.

(iii)*Related information*: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(iv) *Information used to draft application*: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v) *Information* used in invention process: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) *Improvements*: Where the claimed invention is an improvement, identification of what is being improved.

(vii) *In Use*: Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(viii) *Technical information* known to applicant.

Technical information known to applicant concerning the related art, the disclosure, the claimed subject matter, other factual information pertinent to patentability or concerning the accuracy of the examiner's stated interpretation of such items.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(i), (iii), and (vii) of this section may also be applied to such assignee.

(3) Requirements for factual information known to applicant may be presented in any appropriate
manner, for example:

(i) A requirement for factual information;

(ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or

(iii) Stipulations as to facts with which the applicant may agree or disagree.

(4) Any reply to a requirement for information pursuant to this section that states either that the information required to be submitted is unknown to or is not readily available to the party or parties from which it was requested may be accepted as a complete reply.

(b)The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section will be governed
by §§ 1.135 and 1.136.

37 CFR 1.907 *Inter Partes* reexamination prohibited.

(a) Once an order to reexamine has been issued under § 1.931, neither the third party requester, nor its privies, may file a subsequent request for *inter partes* reexamination of the

patent until an *inter partes* reexamination certificate is issued under § 1.997, unless authorized by the Director.
(b) Once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. 1338 that the party has not sustained its burden of proving invalidity of any patent claim-in-suit, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such civil action, and an *inter partes* reexamination requested by that party, or its privies, on the basis of such issues may not thereafter be maintained by the Office.
(c) If a final decision in an *inter partes* reexamination proceeding instituted by a third party requester is favorable to patentability of any original, proposed amended, or new claims of the patent, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claims on the basis of issues which that party, or its privies, raised or could have raised in such *inter partes* reexamination proceeding.

37 CFR 1.913 Persons eligible to file request for *inter partes* reexamination.

Except as provided for in § 1.907, any person other than the patent owner or its privies may, at any time during the period of enforceability of a patent which issued from an original application filed in the United States on or after November 29, 1999, file a request for *inter partes* reexamination by the Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501.

37 CFR 1.915 Content of request for *inter partes* reexamination.

(b) A request for *inter partes* reexamination must include the following parts:
(7) A certification by the third party requester that the estoppel provisions of § 1.907 do not prohibit the inter partes reexamination.
(8) A statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy.

...

(d) If *the inter partes* request does not include the fee for requesting *inter partes* reexamination required by paragraph (a) of this section and meet all the requirements of paragraph (b) of this section, then the person identified as requesting *inter partes* reexamination will be so notified and will generally be given an opportunity to complete the request within a specified time. Failure to comply with the notice will result in the *inter partes* reexamination request not being granted a filing date, and will result in placement of the request in the patent file as a citation if it complies with the requirements of § 1.501.

37 CFR 1.919 Filing date of request for *inter partes* reexamination.

(a) The filing date of a request for *inter partes* reexamination is the date on which the request satisfies all the requirements for the request set forth in § 1.915.

§ 1.939 Unauthorized papers in *inter partes* reexamination

(a) If an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned.

(b) Unless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the *inter partes* reexamination.

§ 1.985 Notification of prior or concurrent proceedings in *inter partes* reexamination.

(a) In any *inter partes* reexamination proceeding, the patent owner shall call the attention of the Office to any prior or concurrent proceedings in which the patent is or was involved, including but not limited to interference, reissue, reexamination, or litigation and the results of such proceedings.

(b) Notwithstanding any provision of the rules, any person at any time may file a paper in an *inter partes* reexamination proceeding notifying the Office of a prior or concurrent proceedings in which the same patent is or was involved, including but not limited to interference, reissue, reexamination, or litigation and the results of such proceedings. Such paper must be limited to merely providing notice of the other proceeding without discussion of issues of the current *inter partes* reexamination proceeding. Any paper not so limited will be returned to the sender.

MPEP § 2612 Persons Who May File a Request

37 CFR 1.907 defines specific situations where a third party is prohibited from filing a request for an inter partes reexamination. 37 CFR 1.915(b)(7) requires the third party requester to certify that the estoppel provisions of 37 CFR 1.907 do not prohibit the filing of the inter partes reexamination request by the real party in interest (note that it is the real party in interest that is subject to the estoppel provisions and not the party who actually files the request). The certification identified in 37 CFR 1.915(b)(7) will constitute a prima facie showing that the party requesting the inter partes reexamination is not barred from doing so under 37 CFR 1.907. The Office does not intend to look beyond this required certification. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would then need to be addressed. A challenge to the accuracy of the certification must facially establish that the third party requesting the inter partes reexamination is barred from doing so under 37 CFR 1.907. Thus, for example, the challenger cannot rely on an argument that the third party requesting reexamination was, at one point, involved with a party barred under 37 CFR 1.907, and should thus be considered as a real party in interest (and barred from filing the request). Involvement *per se* does not facially establish that the other party is a real party in interest. The fact that a second party may benefit from an earlier reexamination request filed by a first party or a civil action conducted by the first party, or that the second party may have collaborated with the first party in a matter, does not facially evidence the second party was a real party in interest with the first party. With respect to the Office conducting an investigation to uncover whether the second party was a "real party in interest," the statute does not require, nor does it provide the tools, for the Office to investigate such matter. Further, Congress has not provided the Office with subpoena power or discovery tools and has not provided the Office with the ability to conduct hearings for eliciting testimony and cross-examination. The Office has not been authorized to impose punitive sanctions for non-compliance. Such evidentiary tools are, however, available to the courts, which are the appropriate vehicle to make a factual investigation as to the accuracy of the identification of a "real party in interest."

MPEP § 2614 Content of Request for *Inter Partes* Reexamination

The reexamination request must identify the real party in interest who is responsible for filing the reexamination request. This information will be used by future parties requesting reexamination of the same patent, in making the certifications required by 37 CFR 1.915(b)(8).

MPEP 2625 Untimely Paper Filed Prior to First Office Action

Pursuant to 37 CFR 1.939, after filing of a request for *inter partes* reexamination, no papers directed to the merits of the reexamination other than (A) citations of patents or printed publications under 37 CFR 1.501 and 1.933, (B) another complete request under 37 CFR 1.510 or 37 CFR 1.915, or (C) notifications pursuant to MPEP § 2686, should be filed with the Office prior to the date of the first Office action in the reexamination proceeding. Any papers directed to the merits of the reexamination, other than those under 37 CFR 1.501, 1.933, 1.510 or 1.915, or under MPEP § 2686, filed prior to the date of the first Office action will be returned to the sender without consideration. >If the papers are entered prior to discovery of the impropriety, such papers will be expunged from the record.< A copy of the letter *>providing notification of< the returned papers >or expungement< will be made of record in the patent file. However, no copy of the *>returned/expunged< papers will be retained by the Office. If the submission of the *>returned/expunged< papers is appropriate later in the proceedings, they may be filed, and accepted by the Office, at that time. See *Patlex Corp. v. Mossinghoff*, 771 F.2d 480, 226 USPQ 985 (Fed. Cir. 1985); *In re Knight*, 217 USPQ 294 (Comm'r Pat.1982); and *In re Amp*, 212 USPQ 826 (Comm'r Pat. 1981) which addressed the situation analogous to the present situation for *ex parte* reexamination proceedings.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,530	01/27/2011	7767400	2706.002REX0	2503

EXAMINER

ART UNIT	PAPER NUMBER

21710 7590 05/09/2011
BROWN RUDNICK LLP
ONE FINANCIAL CENTER
BOSTON, MA 02111

DATE MAILED: 05/09/2011

Please find below and/or attached an Office communication concerning this application or proceeding.

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, D.C. 20005

Date:
MAILED

MAY 09 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001530
PATENT NO. : 7767400
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

Decision on Petition for Extension of Time in Reexamination	Control No.:95/001,530

1. THIS IS A DECISION ON THE PETITION FILED May 5, 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:
   A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.

   The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS
   Patent owner requests that the period for responding to the Office action mailed on April 1, 2011, which sets a two-month period for filing a response thereto, be extended by one month.

   A. ☒ Petition fee per 37 CFR §1.17(g)):
      i. ☐ Petition includes authorization to debit a deposit account.
      ii. ☒ Petition includes authorization to charge a credit card account.
      iii. ☐ Other: _____.
   B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
   C. ☒ Petition was timely filed.
   D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)
   A. ☒ Granted or ☐ Granted-in-part for _____, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
      ☐ Other/comment: _____.
   B. ☐ Dismissed because:
      i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
      ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
      iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
      iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
      v. ☐ The petition is moot.
      vi. ☐ Other/comment: _____.

5. CONCLUSION **Response is due on June 10, 2011**

   Telephone inquiries with regard to this decision should be directed to Deborah Jones at 571-272-1535, in the Central Reexamination Unit.

Deborah Jones 5/16/2011
[Signature]

DEBORAH D. JONES
(Title) CRU SPE-AU 3991

U.S. Patent and Trademark Office
PTO-2293 (Rev. 09-2010)

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,530	01/27/2011	7767400	2706.002REX0	2503

21710 7590 02/28/2012
BROWN RUDNICK LLP
ONE FINANCIAL CENTER
BOSTON, MA 02111

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/28/2012

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FEB 28 2012

CENTRAL REEXAMINATION UNIT

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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:

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001530
PATENT NO. : 7767400
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
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Thomas C. Meyers : (For Patent Owner)
BROWN RUDNICK LLP :
One Financial Center :
Boston, MA 02111 :

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FEB 28 2012

CENTRAL REEXAMINATION UNIT

Eldora L. Ellison :
STERNE KESSLER GOLDSTEIN
& FOX, PLLC : (For Third Party
1100 New York Ave, N.W. : Requester)
Washington D.C. 20005 :

In re: Harris :
Inter Partes Reexamination Proceeding : DECISION ON PETITIONS
Control No.: 95/001,530 :
For: U.S. Patent No.: 7,767,400 :

This is a decision on a petition filed by the Patent Owner: a petition filed on July 19, 2011, entitled "PETITION UNDER 37 C.F.R. § 1.182 PATENT OWNER'S REEQUEST TO STRIKE A PORTION OF REQUESTER'S JULY 11, 2011 COMMENT PAPERS FROM THE RECORD" and a decision on an opposition petition by Third Party Requester filed on July 22, 2011 entitled "THIRD PARTY REQUESTER'S PETITION UNDER 37 C.F.R.§ 1.182 OPPOSING PATENT OWNER'S REEQUEST TO STRIKE A PORTION OF REQUESTER'S JULY 11, 2011 COMMENT PAPERS FROM THE RECORD."

The petitions are before the Director of the Central Reexamination Unit.

The petitions are **dismissed as moot**.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,767,400 issued on August 3, 2010.
- A request for *inter partes* reexamination was January 27, 2011 and assigned control no. 95/001,530.
- *Inter partes* reexamination was ordered on March 10, 2011.
- A Non-Final Office Action was mailed on March 10, 2011.
- Patent Owner filed a petition for an extension of time on May 5, 2011
- A one month extension of time was granted on May 9, 2011.
- Patent Owner's Response to the Non-Final Office Action was received by the Office and serviced to the Third Party Requestor on June 10, 2011.
- The Third Party Requestor's Comments responsive to the Patent Owners comments after the Non-Final Office Action were received and serviced to the Patent Owner on July 11, 2011.
- The Patent Owner filed the above-identified petition on July 19, 2011.
- The Third Party Requester filed the above-identified Opposition Petition on July 22, 2011.
- The Office mailed a Notice of Defective Paper, on October 12, 2011, in regards to the Third Party Requester's Response, and provided a time period of 15 days to make specified corrections.
- The Third Party Requester filed Corrected comments, in response to the Notice of Defective Paper, on October 27, 2011.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.181 Petition to the Director

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

37 C.F.R. § 1.943 Requirements of responses, written comments, and briefs in inter partes reexamination.

(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.

MPEP § 2267.I.A.2

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.

MPEP § 2267.I.B.2

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.

DECISION

As a procedural matter, the petitions are treated as petitions under 37 CFR § 1.181. As pointed

out, the Patent Owner filed a July 19, 2011 petition under 37 CFR 1.182 to expunge the Third Party Requester's July 11, 2011 comments and the Requester filed a July 22, 2011 opposition petition under 37 CFR 1.182. It is noted that petitions under 37 CFR 1.182 are 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 is not the proper means to seek relief for the issues raised in the July 19, 2011 and July 22, 2011 petitions. In summary, although the petitions contain statements that relief sought is under 37 CFR 1.182, the petitions are being addressed as petitions under 37 CFR 1.181.

The Patent Owner argues in the petition filed July 19, 2011 that the Third Party Requester's comments and accompanying declaration dated July 11, 2011, which contain arguments that the rejections are supported exceeds 50 pages in length and therefore should be stricken from the record.

The Third Party Requester argues in their Opposition Petition that Patent Owner's petition should be denied as MPEP § 2267 requires the Office issue a notice to comply with the page limit and give 15 days from the date of notice to respond. Third Party Requester asks that in the event the Office deems Third Party Requester's comments to exceed the 50 page limit, to issue a Notice of Defective Paper and give Requester 15 days to bring its submission into compliance with the rules.

On October 12, 2011, as discussed above, the Office mailed a Notice of Defective Paper that determined that the July 11, 2011 comments were not compliant with the requirements of 37 CFR 1.943(b) and gave the Requester 15 days to file replacement comments. As a result of the Notice of Defective Paper, the July 11, 2011 comments, which have been entered into the electronic Image File Wrapper (IFW) record, will be expunged from the record by closing the papers in the IFW record, and marking the papers nonpublic. See MPEP 2667.

As a result of the October 12, 2011 Notice of Defective Paper, the remedy of expungement of the July 11, 2011 comments and the setting of a 15 day time period to file corrected comments was already given. In other words, the ultimate relief requested by the July 19, 2011 petition and the Requester's July 22, 2011 petition, was given by the October 12, 2011 Notice of Defective Paper.

For these reasons, the Patent Owner's July 19, 2011 petition and Requester's July 22, 2011 opposition petition are moot, and hereby, dismissed.

CONCLUSION

1. The petition filed by Patent Owner on July 19, 2011, is **dismissed as moot**.

2. The opposition petition filed by Requester on July 22, 2011 is **dismissed as moot**.

3. Telephone inquiries related to this decision should be directed to Deborah Jones, Supervisory Patent Reexamination Examiner, at (571) 272-1535 or in his absence to the undersigned at (571) 272-0700.

Irem Yucel
Director, Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,534	01/31/2011	7,843,508	10760/203	8379

83275 7590 10/28/2011

AMPACC Law Group, PLLC
6100 219th Street SW, Suite 580
Mountlake Terrace, WA 98043

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/28/2011

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

Date:
MAILED
OCT 28 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001534
PATENT NO. : 7843508
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

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OCT 28 2011

CENTRAL REEXAMINATION UNIT

AMPACC Law Group, PLLC (For Patent Owner)
6100 219th Street SW
Suite 580
Mountlake Terrace, Washington 98043

Novak Druce & Quigg, LLP (For 95/001,521 Requester)
(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-Third Floor
Houston, Texas 77002

Woodcock Washburn LLP (Microsoft Corporation) (For 95/000,617 Requester)
CIRA Centre
12th Floor
2929 Arch Street
Philadelphia, Pennsylvania 19104-2891

Kenyon & Kenyon LLP (For 95/001,534 Requester)
One Broadway
New York, New York 10004

In re Qiang Huang :
Inter Partes Reexamination Proceeding :
Control No.: 95/001,521 :
Filed: January 7, 2011 :
For: U.S. Patent No. 7,843,508 :
:
In re Qiang Huang : **DECISION, *SUA SPONTE*,**
Inter Partes Reexamination Proceeding : **TO MERGE**
Control No.: 95/000,617 : **REEXAMINATION**
Filed: January 25, 2011 : **PROCEEDINGS**
For: U.S. Patent No. 7,843,508 :
:
In re Qiang Huang :
Inter Partes Reexamination Proceeding :
Control No.: 95/001,534 :
Filed: January 31, 2011 :
For: US. Patent No. 7,843,508 :

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.989.

BACKGROUND

1. U.S. Patent No. 7,843,508 ("the '508 patent") issued to Qiang Huang on November 30, 2010, with 46 claims.

2. A request for *inter partes* reexamination of claims 1-46 of the '508 patent was filed on January 7, 2011, by a third party requester, and was assigned control number 95/001,521 ("the '1521 *inter partes* proceeding"). The request identified Apple Inc.as the real party in interest.

3. A second request for *inter partes* reexamination of claims 1-46 of the '508 patent was filed on January 25, 2011, by a third party requester, and was assigned control number 95/000,617 ("the '617 *inter partes* proceeding"). The request identified Microsoft Corporation as the real party in interest.

4. A third request for *inter partes* reexamination of claims 1-46 of the '508 patent was filed on January 31, 2011, by a third party requester, and was assigned control number 95/001,534 ("the '1534 *inter partes* proceeding"). The request identified Sony Corporation and Sony Electronics Inc. as real party in interest.

5. On February 14, 2011, *inter partes* reexamination was ordered for claims 1-46 of the '508 patent in the '1521 *inter partes* proceeding based on the examiner's determination that the January 7, 2011 request raised a substantial new question of patentability affecting these claims. The order was accompanied by a non-final rejection Office action.

6. On March 25, 2011, *inter partes* reexamination was ordered for claims 1-46 of the '508 patent in the '617 *inter partes* proceeding based on the examiner's determination that the January 25, 2011 request raised a substantial new question of patentability affecting these claims. No Office action on the merits has been issued in the '617 proceeding.

7. On March 25, 2011, *inter partes* reexamination was ordered for claims 1-46 of the '508 patent in the '1534 *inter partes* proceeding based on the examiner's determination that the January 31, 2011 request raised a substantial new question of patentability affecting these claims. No Office action on the merits has been issued in the '1534 proceeding.

8. On April 15, 2011, patent owner submitted a response to the February 14, 2011 non-final rejection action in the '1521 *inter partes* proceeding. The April 15, 2011 patent owner response did not include any amendment to the specification or claims.

9. On May 16, 2011, the '1521 requester filed comments to patent owner's April 15, 2011 response.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in three proceedings for the same claims of the same patent. All three proceedings are *inter partes* proceedings. All three proceedings are still pending, and have not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989 provides:

> (a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance and publication of a single reexamination certificate under § 1.997.

In accordance with 37 CFR 1.989(a), the 95/001,521, 95/000,617 and 95/001,534 proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN ALL THREE PROCEEDINGS

Presently, the claims (and specification) are identical in all three files. Patent owner is required to continue to maintain the same claims (and specification) in all three files *throughout the merged proceeding*.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges three *inter partes* reexamination proceedings. The merged proceeding is governed by 37 CFR 1.902 through 1.997. Pursuant to 37 CFR 1.989(a), the merged examination will normally result in the issuance and publication of a single reexamination certificate under 37 CFR 1.997.

It is noted that reexamination was ordered for each of claims 1-46 of the '508 patent in each of the '1521, '617, and '1534 proceedings. Accordingly, the examiner will conduct reexamination in the merged proceeding for claims 1-46 of the '508 patent.

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

Upon merger of proceedings, all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2).[1] First, an *inter partes* requesters' right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requesters' right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requesters' comments must be submitted within 30 days from the date of service of the patent owner's response. No *inter partes* requester has a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester. Requester comments must be submitted within the statutory time period of 30 days from date of service of patent owner's response.

2. Appeal Rights:

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP 2674 through 2675 and 2678 through 2683. As pointed out in MPEP 2674:

> A notice of appeal by a third party requester must identify each rejection *that was previously proposed* by *that third party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested.

Thus, each *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN that the individual third party requester proposed in the request, and any that the individual third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi):

> No new ground of *rejection* can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

Thus, the appellant's brief shall present a concise statement of each issue. And, no new ground of rejection (i.e., a ground that the individual requester did not propose) can be proposed by a third party requester appellant, unless that ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester did not yet have an opportunity to propose it as a third party requester proposed ground of rejection.

C. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all three proceedings. All papers issued by the Office, or filed by the patent owner and the third party requester(s), will contain the identifying data for all three

[1] Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

proceedings and will be entered in each reexamination file. All papers filed by the patent owner and the third party requester(s) must consist of a single paper, **filed in triplicate**, each bearing a signature and identifying data for all three proceedings, for entry into each file.

All papers filed by the patent owner and the third party requester(s) should be directed:

by Mail to:	Attn: Mail Stop "*Inter Partes* Reexam" Central Reexamination Unit Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450
by FAX to:	(571) 273-9900 Central Reexamination Unit
by Hand to:	Customer Service Window Attn: Central Reexamination Unit Randolph Building, Lobby Level 401 Dulany Street Alexandria, VA 22314
by EFS:	Registered users may submit papers via the electronic filing system EFS-Web, at:

https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html

Patent owner and requesters are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on the other parties, and every paper filed must reflect that such paper was served on the other parties, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

D. Amendments:

The filing of any amendments to the specification, claims, or drawings must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530 and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

E. Fees:

Where a paper is filed which requires payment of a fee (e.g., extension of time fee, excess claims fee, petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appellant brief (or that of one of the *inter partes* reexamination requesters) which may be filed, even though the brief relates to merged multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

F. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

G. Appeal Procedure Reminders for *Inter Partes* Reexamination

The parties are reminded of the procedures for taking appeal in an *inter partes* reexamination as explained in MPEP 2674 and 2675. The appeal must only be taken from (1) the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the *patent owner* proposes to contest, or (2) the finding(s) of patentability of claims in the RAN that the *third party requester* proposes to contest. Therefore, in the notice of appeal, the patent owner must identify each claim rejected by examiner that the patent owner intends to contest. The third party requester must identify each rejection *that was previously proposed by that third party requester* that the third party requester intends to contest, and each rejection made and later withdrawn by the examiner that the third party requester intends to contest. No new ground of rejection (including one proposed by another requester, but not the appellant requester) can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection. See 37 CFR 41.67(c)(1)(vi) as to the proposed rejections that each individual requester can challenge in the appellant brief.

CONCLUSION

1. *Inter partes* Reexamination Control No. 95/001,521, *inter partes* Reexamination No. 95/000,617 and *inter partes* Reexamination Control No. 95/001,534 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.

2. The examiner will issue an Office action for the merged proceeding in due course.

3. Any questions concerning this communication should be directed to Raul Tamayo in the Office of Patent Legal Administration, at (571) 272-7728.

Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

October 27, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,534	01/31/2011	7,843,508	169AA-000600US	8379

83275 7590 11/29/2011

AMPACC Law Group, PLLC
6100 219th Street SW, Suite 580
Mountlake Terrace, WA 98043

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/29/2011

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

Date: MAILED

NOV 29 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001534
PATENT NO. : 7843508
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

Decision on Petition for Extension of Time in Reexamination	Control No.: 95/001,521; 95/000,617 & 95/001,534

MAILED
NOV 29 2011
CENTRAL REEXAMINATION UNIT

1. THIS IS A DECISION ON THE PETITION FILED 21 November 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:
   A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.

   The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS
   Patent owner requests that the period for responding to the Office action dated 04 November 2011 which sets a two(2)month period for filing a response to the Office action, be extended by two (2) months.

   A. ☒ Petition fee per 37 CFR §1.17(g)):
      i. ☐ Petition includes authorization to debit a deposit account.
      ii. ☐ Petition includes authorization to charge a credit card account.
      iii. ☐ Other: _____.
   B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
   C. ☒ Petition was timely filed.
   D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)
   A. ☐ Granted or ☒ Granted-in-part for one (1) month, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
   B. ☐ Other/comment: see attached
   C. ☐ Dismissed because:
      i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
      ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
      iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
      iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
      v. ☐ The petition is moot, _____.
      vi. ☐ Other/comment: see attached.

5. CONCLUSION

   Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611. In his absence, calls may be directed to Sudhanshu C Pathak at 571-272-5509 in the Central Reexamination Unit.

/Mark Reinhart/ [*Signature*]	SPRS, AU 3992 Central Reexamination Unit (Title)

In consideration of providing the patent owner with a fair opportunity to present an argument against any attack on the patent as balanced with the statutory mandate of conducting reexamination proceedings with special dispatch that the Office must fully consider the facts presented in any petitions for extension of time.

Pursuant to MPEP § 2665 (in part) Extension of Time

First requests for extensions of these time periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments within the statutory time period. Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary situations. (emphasis added)

On balance, there is "sufficient cause" for granting of one (1) month extension of time. Requests for more than one month will only be granted in extraordinary situations.

The petition for extension of time is hereby granted-in-part.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,534 +95/000617 +95/001521	01/31/2011	7,843,508	169AA-000600US	8379

83275 7590 02/24/2012

AMPACC Law Group, PLLC
6100 219th Street SW, Suite 580
Mountlake Terrace, WA 98043

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/24/2012

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 2-24-12

KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001534 + 95/000617 + 95/001531
PATENT NO. : 7843508
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

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FEB 24 2012

CENTRAL REEXAMINATION UNIT

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New York, New York 1004 (For 95/001,534 Requester)

In re Huang
Inter Partes Reexamination Proceeding
Control No.: 95/001,521
Filed: January 7, 2011
For: U.S. Patent No.: 7,843,508

In re Huang
Inter Partes Reexamination Proceeding
Control No. 95/000,617
Filed: January 25, 2011
U.S. Patent No.: 7,843,508

In re Huang
Inter Partes Reexamination Proceeding
Control No.: 95/001,534
Filed: January 31, 2011
For: U.S. Patent No.: 7,843,508

: DECISION ON § 1.181,
: §1.182, AND § 1.183
: PETITIONS

This is a decision on February 23, 2011 patent owner petitions under 37 CFR 1.181, 1.182 and/or 37 CFR 1.183 seeking to vacate or suspend *inter partes* reexamination control number 95/000,617 (the '617 reexamination), filed January 25, 2001 and reexamination control number 95/001,534 (the '1534 reexamination), filed January 31, 2011 based on the assertion

that the requesters of the instant reexaminations are real party in interests or privies with the requester in *inter partes* reexamination control number 95/001,521 (the '1521 reexamination), filed January 7, 2011. This decision also takes into consideration a March 9, 2011 third party requester (Requester) Opposition, filed in the '1,534 reexamination, and a March 12, 2011 Opposition, filed in the '617 reexamination, the two oppositions being filed to address the respective petitions for vacatur; the Oppositions are supported by Petitions under 37 CFR 1.181, 1.182 and/or 1.183, requesting entry of the Oppositions.

The Petitions and Oppositions are before the Office of Patent Legal Administration for consideration.

The Patent Owner Petitions for vacatur under 37 CFR 1.181, 1.182 and/or 1.183 are Dismissed.

The Requester Petitions under 37 CFR 1.181, 1.182 and/or 1.183 are Granted and the Oppositions have been entered.

I. FEES

Notwithstanding the reliance on alternative petition rules by both the Patent Owner and the Requesters, only one petition fee from each party will be required to consider the matter raised. A review of Office PALM records reveals that:

- in the '1,534 reexamination, the Patent Owner's $400 fee, pursuant to § 1.17(f), has been charged on February 24, 2011, as authorized in the petition (at page7), but not the Requester's $400 petition fee, which fee was authorized in the petition (at page 6) and will be so charged, and

- in the '617 reexamination, the Patent Owner's $400 fee, pursuant to § 1.17(f), has been charged on February 24, 2011, as authorized in the petition (at page 7), and the Requester's similar $400 fee was charged on March 14, 2011 as authorized in the petition (at page 10).

II. BACKGROUND

1. U.S. Patent No. 7,843,508 (the '508 patent) was issued on November 30, 2010.

2. On January 7, 2011, a first request for reexamination of the '508 patent was filed on behalf of Apple, Inc (Apple)[1] and was given a reexamination control number 95/001,521 (the '1,521 reexamination):
   a. The request noted copending litigation styled as *MedioStream, Inc. v. Acer Inc. et al.*, Case No. 3:10-cv-05762 (N.D. Cal. December 17, 2010).[2]
   b. Reexamination was ordered on February 14, 2011.

3. On January 25, 2011, a second request for *inter partes* reexamination of the '508 patent

[1] Request transmittal form, at page 1, paragraph 2a.
[2] *Id.*, at page 2, paragraph 16d.

was filed on behalf of Microsoft Corporation[3] (Microsoft) and was given a reexamination control number 95/000,617 (the '617 reexamination):

a The request noted copending litigation styled as *MedioStream, Inc. v. Acer et al.*, Civil Action No. 3:10-CV-05762 (EMC), December 17, 2010.[4]

b. Reexamination was ordered on March 25, 2011.

4. On January 31, 2011, a third request for *inter partes* reexamination of the '508 patent was filed on behalf of Sony Corporation and Sony Electonics Inc[5] (Sony) and was given a reexamination control number 95/001,534 (the '1,534 reexamination):

   a. The request noted copending litigation styled as *MedioStream, Inc. v. Acer et al.*, 3:10-cv-05762-RS (N.D. Cal.),[6]

   b. Reexamination was ordered on March 25, 2011.

5. On February 23, 2011, Patent Owner filed petitions under 1.181, § 1.182 and/or § 1.183 in reexaminations '617 and '1,534 to vacate or suspend the reexaminations in that Microsoft and Sony are real parties in interest in the first reexamination '1,521 or privies to Apple on whose behalf the first reexamination was filed.

6. On March 9, 2011, and March 12, 2011, the requesters submitted Oppositions in reexaminations '617 and '1,534 to the February 23, 2011 petitions by the Patent Owner supported by petitions under 37 CFR 1.181, 1.182 and/or 1.183.

7. On October 28, 2011, the Office mailed a Decision, Sua Sponte, to Merge Reexamination Proceedings for the following reexaminations:

   a. '1,521,

   b. '617, and

   c. '1,534.

III. Patent Owner Petition Under 37 CFR 1.182 and/or 1.183 for Vacatur

Petitioner (Patent Owner) notes that a reexamination order of the '508 patent on behalf of Apple (the '1521 reexamination) has been issued, and that, therefore, the '617 and '1,534 subsequent requests for reexamination of that patent are precluded for all real parties in interest to the first reexamination request, and for all privies, until a reexamination certificate has issued on the first reexamination.[7]

Petitioner does not attempt to factually distinguish between Microsoft and Sony in terms of their being alleged real parties in interest or privies with Apple.

The Supreme Court decision in *Taylor v. Sturgell*[8] (*Taylor*) is relied upon for its holdings that[9]:

1. a non-party may be bound by a judgement, because he/she was adequately represented

[3] Request transmittal from, at page 1, paragraph 2a.
[4] Id., at page 2, paragraph 16d.
[5] Request transmittal form, at page 1, paragraph 2a.
[6] Request transmittal form, paragraph 16d.
[7] Petition, bridge of pages 1 and 2, citing 35 U.S.C. 317(a).
[8] *Taylor v. Sturgell*, 128 S. Ct. 2161 (2008).
[9] Petition, bridge of pages 2 and 3.

by someone with the same interests who was a party to a suit, and
2. a party may not avoid a preclusive effect by relitigating through a proxy.

As to being adequately represented, it is asserted that Apple's representation of Microsoft and Sony (joint defendants in concurrent litigation) is adequate for preclusion purposes because[10]:

1. the interests of the joint defendants are aligned,
2. the Office as the administrative body adjudicating an *inter partes* reexamination has taken the necessary care to assert any additional prior art or arguments required to protect the interests of the other joint defendants, and
3. all joint defendants had notice of the reexamination filed by Apple.

As to relitigating through a proxy, it is asserted that a joint agency relationship has been admitted in the underlying litigation, and that may not now be renounced in the reexamination in that[11]:

1. there is in place a joint defense agreement thereby making all the joint defendants privies to the reexamination filed by Apple, and
2. the joint defendants have asserted an attorney privilege and joint defense privilege in the underlying litigation.

The instant patent being reexamined is part of a family of patents, including U.S. patents 7,009,655 and 7,282,172.[12] A discussion is provided in regard to litigation of these two other patents to establish a relationship between Apple and Microsoft and Sony, including the absence of additional reexamination requests by Microsoft and Sony for those patents.[13] Additionally, it is noted by petitioner that in regard the reexamination of the other two patents, the examiner did not merely adopt the invalidity arguments made by Apple, but instead added other arguments not found in Apple's briefs.

It is also asserted and argued that the joint defendants have exchanged prior art and are aware of all the *inter partes* reexaminations requested by Apple.

IV. Petition under 37 CFR 1.183 for entry of Opposition and Decision Thereon

Third party petitioners (Requesters) seek entry of their Oppositions to the Patent Owner petitions for vacatur of the reexamination filing dates, such as by waiver of § 1.939(a) (or (b)).

Section 1.939(a) provides:

(a) If an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned.

Because the Oppositions shed light on the proper identification of the real party in interest, as noted below, and in addition the Requesters have a right to defend against vacating their requests, the petitions for waiver are granted.

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[10] Petition, at page 3.
[11] *Id.*
[12] *Id.*
[13] Petition, at page 5.

V. Requesters' Oppositions to Patent Owner Petition for Vacatur

Oppositions have been filed by each of the Requesters in reexaminations '1,521 and '1,534.

Microsoft:[14] The Opposition by the Requester of the '617 reexamination (Microsoft) explicitly states:

> Microsoft properly certified under 37 CFR § 1.917(b)(7) that the estoppel provisions do not apply to it.[15]

The Opposition also addresses the lack of privity between Microsoft and Apple by pointing out that petitioner's reliance on the mere existence of a joint defense agreement is not, as a matter of law, sufficient to establish privity or a joint agency agreement.[16] The Opposition by Microsoft, as does the Opposition by Sony, notes that, in *Taylor*, the Supreme Court rejected the D.C. Circuit's expansive use of the doctrine of virtual representation to preclude a claim brought by a non-party. It is added that Petitioner seeks to expand the limited exception in precisely the manner that *Taylor* forbade.[17] The D.C. Circuit held incorrectly that preclusion based on virtual representation can exist where there was both an identity of interest and adequate representation together with a third factor, such as a close relationship or substantial participation. It is asserted by requester that the admitted joint defense agreement in the underlying litigation is not the same as a class action suit or suit brought by fiduciaries, and guardians that are the basis of the exception to the general rule of non-preclusion.

Requester provides that, while Petitioner would have the Office believe that the Office is well-suited to protect Microsoft's interests in the Apple reexamination, Microsoft notes that it has presented its own substantial new questions of patentability which are different from those raised by Apple, and they would not be considered if the petition was granted. It is asserted that if the Office were fully able to protect the interest of third parties in a reexamination proceeding, then there would be no need for the statute to allow the filing of any subsequent *inter partes* reexamination request, including those of third parties.[18]

Sony: The Opposition by the Requester of the '1,534 reexamination (Sony) explicitly states that:

> Sony is not a 'real party in interest' to the '521 reexamination and is not in privity with Apple in the '521 reexamination.[19]

It is stated that Sony has:

> certified that the estoppel provisions of 37 CFR 1.907 do not prohibit this

---

[14] The Opposition has raised what requester believes to be legal defects in the petition for Vacatur in that: (a) the instant petitions were filed before reexamination was ordered (based on the requests by Microsoft and Sony), so there is no action of the Office that could be suspended or vacated, Opposition, page 4, and (b) without a first order for reexamination (based on the Apple request), there can be no preclusion of a second request for reexamination - the February 14, 2011 order for reexamination on the Apple request in the first request for reexamination was after the January 25, 2011 Microsoft and January 31, 2011 Sony (second) requests for reexamination, Opposition, pages 4 and 5.

[15] Opposition, page 9.

[16] Opposition, pages 6 and 7.

[17] *Id.*

[18] *Id.*, page 8.

[19] Opposition, page 2.

reexamination.[20]

It is also stated that the Patent Owner has failed to establish that Sony's certification is in any way ambiguous or facially inaccurate, nor has the Patent Owner attempted to even allege any such ambiguity or inaccuracy.[21]

While it is recognized that Sony is a co-defendant with Apple in concurrent litigation and Sony admits that it has cooperated with Apple in the litigation, such actions are asserted to not to amount to control over, or privity, in the present reexamination.

It is pointed out that *Taylor* actually supports denial of the Patent Owner's petition based on the Court's recognition, in reversing the lower court's finding of a virtual representation, that everyone should have his own day in court.[22]

VI. Decision on the Patent Owner Petitions for Vacatur

The petitions by patent owner seeking vacatur of the subsequent *inter partes* reexaminations requested by Microsoft and Sony are dismissed.

At page 2, the petitions assert:

> Once a third party requester has filed a request for *inter partes* reexamination and the request has been granted by the PTO, neither the third party requester nor its privies may file a subsequent request for *inter partes* reexamination on the same patent until a reexamination certificate has issued. *See* 35 U.S.C. § 317(a).

The petitions go on to state:

> The limitation provided in section 317(a) of the patent statute takes effect as soon as reexamination is ordered by the PTO, See 35 U.S.C. § 317(a) (requiring that an order for *inter partes* reexamination be issued). The limitation applies for the entire patent, regardless of the claims for which the *inter partes* reexamination was requested, and regardless of whether all claims are actually examined. See 35 U.S.C. § 317(a) ("...neither the third-party requester nor its privies may file a subsequent request for *inter partes* reexamination of the patent ....

Petitioner misreads 35 U.S.C. 317(a). The pertinent part of section 317(a) provides that:

> ...<u>once an order for inter partes reexamination of a patent has been issued</u> under section 313, <u>neither the third-party requester nor its privies may file</u> a subsequent request for inter partes reexamination of the patent until an inter partes reexamination certificate is issued and published under section 316, unless authorized by the Director. [Emphasis added.]

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[20] *Id.*
[21] Opposition, bridge of pages 2 and 3.
[22] Opposition, page 5.

In this instance, the '1521 reexamination was filed January 7, 2011, the '617 reexamination was filed January 25, 2001, and the '1534 reexamination was filed January 31, 2011. The '1521 reexamination was ordered February 14, 2011, and the '617 and '1534 reexaminations were ordered March 25, 2011. Thus, all three reexaminations were requested before any of the three were ordered. Accordingly, all three of the reexaminations may continue, regardless of whether filed by the same party, a real party in interest, or a privy.

It is also pointed out that *inter partes* reexamination is a "creature of the statute," and the estoppels stated in the statute are the only estoppels that apply; preclusion based on virtual representation does not apply unless it fits within one of the statutory estoppels, and it does not fit here.

The following discussion is provided only to address the extent that the Patent Owner petition could be interpreted to request vacatur or suspension of reexaminations '617 and '1,534 because of the assertion that Microsoft and Sony are real parties in interest in the first reexamination '1,521 or privies to Apple on whose behalf the first reexamination was filed, yet, Microsoft and Sony were not identified as such, and thus, the filing date requirement of 37 CFR 1.515(b)(8) to identify the real parties in interest was not satisfied.

The MPEP[23] makes it clear that the Office does not look beyond the required certification in the request for reexamination, except for the rare instance where a challenge to the sufficiency of the certification facially establishes that the identified real party in interest is not accurate. The certification cannot be successfully challenged merely because, at one point, the certified real party in interest was "involved" with another party, or there was some collaboration in a matter other than the request for reexamination.

The common interest among litigation defendants seeking to invalidate or defend against enforcement of a patent, such as in the identified copending litigation does not translate *ipso facto* into each defendant being a real party in interest in any request for reexamination filed by one of the defendants. This is not to say that concurrent litigation defendants cannot be real parties in interest in requests for reexaminations of the patent in litigation, but such result must be shown and not merely speculated on or theorized about. To be required to be named as a real party in interest, a party must participate, contribute, or direct that action be taken in some concrete manner in the request for reexamination. If, in fact, it could be evidenced that a party not identified as a real party in interest participated, contributed or directed action to be taken in some concrete manner in the Apple request for reexamination, than an issue could be raised as to whether Microsoft or Sony is a real party in interest in the filing of the Apple reexamination request, and as to whether Microsoft or Sony are in privy with Apple.

Preliminarily, it is noted that the allegations regarding a joint defense are not even directed towards the particular patent that is the subject of the reexaminations, but other patents alleged to be in a family of patents for which the instant patent is a member. Nonetheless, even if the joint defense involved litigation of the instant patent being reexamined, preparation of an invalidity defense, based on found and evaluated prior art to support a concurrent litigation defense, does not amount to participation, contribution, or directing that action be taken by all the defendants in a request for reexamination by one of the defendants based on such joint activity, where the joint activity was conducted with only an intent to defend the concurrent litigation suit. Evidence that the joint activity was also conducted with

[23] MPEP § 2612.

an intent to file an *inter partes* reexamination request is required, in order for a petitioner to establish that other concurrent litigation defendants are real parties in interest or privy with the concurrent litigation defendant filing the reexamination request.

Notwithstanding any actual benefit that would result to the concurrent litigation defendants from a favorable result in the reexamination, or their ability to request a litigation stay based on the reexamination request, the question of whether a defendant in the litigation is a real party in interest or privy in the reexamination must be determined on a case-by-case basis focusing on **the showing** of a party's participation, contribution, or directing that action be taken in regard to the filing of a request for reexamination, and not ancillary matters, such as the defendants taking advantage of the reexamination request, or taking advantage of arguments in the subsequent reexamination request that were previously drafted by others for the concurrent litigation. For example, if the Office were to follow petitioner's line of reasoning, a patent owner might challenge an identification of the real party in interest in a reexamination where a third party requester not involved in the litigation and ignorant thereof, was to file a request for reexamination of the patent in litigation utilizing one or more pieces of prior art employed by the unrelated defendants in the litigation. The third party requester could be placed in a position of having to prove a negative – that it was not supported by the litigation defendants. Similarly, here, the Office will not require the Requester to prove a negative – that the concurrent litigation defendants did not participate, contribute or direct the action to be taken in the reexamination. The fact that a first party defended itself in litigation, and another party defendant later filed a request for reexamination related to the patent in litigation utilizing in-part that defense, should not doom the first party to life as a real party in interest for any request for reexamination that may be later filed utilizing part of that defense. Rather, the burden is on the challenging Patent Owner to provide evidence of participation contribution, or directing that action be taken as to the reexamination request.

It may be that a particular defendant in a litigation has decided to proceed with a request for reexamination in the face of hostile opposition by one or more other defendants in the litigation. To embrace each defendant as a real party in interest to a first reexamination request, would result in estoppel against parties who had no control over the initial request for reexamination. None-the-less, using petitioner's theory that the defendants in the litigation must be deemed to be real parties in interest in any initial reexamination request of the patent in litigation, the litigation defendants would then be barred (under 35 U.S.C. § 317(a)) from raising other substantial new questions of patentability that they may feel is better in a subsequent request for reexamination after the first request has been ordered, which at least Microsoft has alleged in its Opposition (at page 8).

In deciding a petition for vacatur, the Office will not engage in conjecture as to the participation, contribution or direction of action to be taken in the request for reexamination of any particular alleged unnamed real party in interest. For purposes of this decision, it is not disputed that the concurrent litigation defendants may be impacted and even benefit from the filing of the instant reexamination. However, it is incumbent upon Patent Owner to present objective evidence that a party not identified as a real party in interest in fact participated contributed or directed action to be taken in the request for reexamination, or in the reexamination proceeding after the request was filed. Similarly, it is incumbent upon Patent Owner to present objective evidence that a subsequent reexamination requester is in privity with a prior reexamination requester for which reexamination has been ordered.

A. The Identification Of The Real Party In Interest Is Not Facially Inaccurate Or Ambiguous. Therefore, The Office Lacks The Authority And The Tools To Question That Identification.

The arguments presented in the petitions for vacatur fail to establish that the Office has the authority to question the accuracy of a third party requester's facially accurate and unambiguous identification of the real party in interest in the *inter partes* reexamination proceeding, or the tools to competently conduct an investigation of the matter.

To the extent that Patent Owner argues that the Office has the ability to investigate the accuracy of the identification of the real party in interest in an *inter partes* reexamination proceeding, or to issue a Show Cause Order requiring the identified real party in interest to confirm that it, and it alone, is the real party in interest, Patent Owner does not make a persuasive case that the Office is required to do so by either the reexamination statute or the reexamination regulations, when the *inter partes* reexamination as filed, contains on its face, an unambiguous identification of the identity of the real party in interest.[24]

Patent Owner's argument is not persuasive, because it does not reflect the intent of the provisions of 37 CFR 1.915(b)(7) and (b)(8). A certification statement made pursuant to 37 CFR 1.915(b)(7) is a statement by the third party requester to the effect that the third party requester is not itself estopped by the statutory estoppel provisions from filing a request for *inter partes* reexamination of a given patent. The *inter partes* rule making at 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), provides that:

> It should be noted that the Office generally will not have a need to resolve the factual issue of whether or not one party is a privy of another party. Section 1.915(b)(7) requires a third party requester to certify that the estoppel provisions of §1.907 do not prohibit the filing of the *inter partes* reexamination request, and the Office does not intend to look beyond this required certification. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would then need to be addressed.

A substantially identical statement also appears at 65 Fed. Reg. at 76764. These statements establish that the Office will, only in the rare instance that it is necessary to do so (a facial showing of inaccuracy or an ambiguity), "address" the accuracy of a certification that statutory estoppel does not bar the filing of a request for *inter partes* reexamination. Further, the rule making does not discuss the type or depth of investigation that can and will be undertaken, and it does not state or imply that a patent owner may trigger an investigation of the accuracy of the certification merely by advancing an unsupported allegation that another party is a real party in interest or privy (by way of having participated contributed or directed that action be taken in the reexamination request).

This is not an instance where the identification of the real party in interest required by 37 CFR 1.915(b)(8) is ambiguous or facially inaccurate, in which such instance a third party requester which is before the Office can be queried by the Office, because the instant record is not clear (*i.e.*, the ambiguity causes an issue that is ripe for consideration due to a required request statement being ambiguous). Since the present record in the instant reexamination

[24] The Requesters have in fact confirmed that they have identified the only real party in interest.

proceeding is not ambiguous as to the identification of the real party in interest (and Patent Owner has provided no persuasive extrinsic evidence to establish ambiguity), there is no basis to proceed any further in this proceeding as to the matter.

Moreover, the third party requesters, Microsoft and Sony in their Oppositions have responded based on facts wholly within their knowledge and possession. Both third party requesters have clearly stated that their certifications are correct that they are not barred from filing their requests for reexamination. No facts have been presented by Petitioner that would cause the Office to believe any issue regarding real party in interest or privity is raised that would need further clarification by the requesters. It is noted that Petitioner has not challenged the identification of the real party in interest in the initial reexamination 95/000,617, although Petitioner herein argues that that Microsoft and Sony are true real parties in interest along with Apple or privies thereof.[25]

Where a patent owner who is a party in an *inter partes* reexamination proceeding believes that an identification of the real party in interest is inaccurate, even though it is facially unambiguous, the courts are the appropriate venue from which the patent owner should seek relief to obtain evidence extrinsic to the record, for incorporation into the record. It is to be noted that there is precedent on the issue of "real party in interest" in the federal courts, on matters ranging from jurisdiction (*e.g.*, presence of diversity or amount of suit)[26] to actions in which the principle is applied to prevent multiple or conflicting lawsuits by persons such as assignees.[27] These examples of court proceedings resolving "real party in interest" issues demonstrate the reason why the Office cannot perform such a function here. Upon obtaining jurisdiction over the parties, courts may order discovery, taking of testimony with cross-examination and use of other evidentiary tools, while enforcing compliance with its requirements via its subpoena power and power to impose sanctions. Accordingly, the courts are the forums best equipped to determine who is, and who is not, the "real party in interest" when there is a reason to doubt the third party requester's identification of a party or parties as being the real party in interest in an *inter partes* reexamination proceeding. Further, courts may provide relief, as appropriate, by enjoining the filing of a further *inter partes* reexamination request by the other parties in a civil action. Once a court has determined that a party is a "real party in interest," the Office can make use of that determination to bar the filing of a subsequent *inter partes* reexamination request by that party. Of course at that point, the party could file an *ex parte* reexamination proceeding, the filing of which does not require identification of "a real party in interest" (35 U.S.C §§ 301 and 302), and is not prohibited by statute or rule, even after an *inter partes* reexamination was filed by the same real party in interest.[28]

A patent owner concerned with the issue of misidentification of the real party in interest in a request for *inter partes* reexamination may immediately seek relief from the alleged erroneous identification of the "real party in interest" via the courts, which possess the tools to investigate and obtain information as to the relationship of the parties to ascertain the veracity of the identified "real party in interest." The present petition is <u>silent as to why Patent Owner did not approach the appropriate District Court for relief</u> (*e.g.*, an investigation into the matter and an appropriate order). Given the emphasis that petitioner Patent Owner

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[25] Petition, page 1.
[26] *Varlotta Construction Corporation v. Carla Development Corporation*, 886 F. Supp 315 (E.D.N.Y. 1995).
[27] *First Hartford Corporation Pension Plan & Trust v. United States*, 194 F.3d 1279 (Fed. Cir. 1999).
[28] If the court makes a finding that the "real party in interest" was misstated, the Office can then take action, if appropriate, based upon the court's findings.

has placed on the importance of the "real party in interest" disclosure requirement, it would appear that Patent Owner could have immediately sought relief in the appropriate court regarding the identity of the real party in interest. The record does not show that Patent Owner has done so. The Office may consider that it is "the sole agency that administers the patent statute,"[29] and the Office certainly conducts the *inter partes* proceeding; however, it is common knowledge that the federal courts (which are not an agency in the sense used in the *inter partes* reexamination rule making) routinely adjudicate matters arising under the patent statute. Further, Patent Owner should appreciate the difference between conducting a reexamination proceeding, which is the province of the Office, and enforcing an estoppel provision of Federal law as a matter of equitable relief. Patent Owner has not provided any basis for believing that the district courts lack authority to act as described above.

As a final point in this section of the decision as to the Office lacking the authority to investigate: The reexamination statute requires, *inter alia*, that a request for *inter partes* reexamination proceeding "shall ... include the identity of the real party in interest... ."[30] The *inter partes* reexamination rules require that a request for *inter partes* reexamination include, *inter alia*, "[A] statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that party is a privy."[31] Requester Apple has clearly stated it is the real party in interest, and that is an identification to a sufficient extent that a party, such as a concurrent litigation defendant, filing the subsequent *inter partes* reexamination request can look into its interaction with the identified real party in interest to "determine whether the subsequent requester is a privy" with Apple who filed the initial reexamination. Neither the *inter partes* reexamination statute nor the *inter partes* reexamination rules imposes a duty on the Office to investigate the accuracy of an unambiguous identification of the real party in interest in a third party requester's request for *inter partes* reexamination proceeding.

In the subsequent *inter partes* reexamination proceedings, the real party in interest is unambiguously identified in the records. The identification of the real party in interest does not appear to be facially inaccurate. The Office will refuse to accord a filing date to a request for *inter partes* reexamination that does not identify the real party in interest, or which provides an identification of the real party in interest that is ambiguous or facially inaccurate. If the Office accords a filing date to a request for *inter partes* reexamination, and later discovers an ambiguity or a facial inaccuracy in the identification of the real party in interest, the Office can, and will, require that a party appearing before it as third party requester in an *inter partes* reexamination proceeding clarify the ambiguity or facial inaccuracy. However, it does not follow that the Office is empowered to conduct an investigation into the identity of the real party in interest when the statement identifying the real in interest in the record of an *inter partes* reexamination proceeding is neither facially inaccurate nor ambiguous. The Office will not conduct an investigation into the accuracy of the identification of the real party interest in the instant subsequent reexamination proceedings, because there is no legal reason to do so.

B. Synopsis

[29] 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), emphasis added.
[30] 35 U.S.C. § 311(b)(1).
[31] 37 CFR 1.915(b)(8).

Rather than having presented clear and undisputed evidence establishing that Microsoft and Sony are either real parties in interest along with Apple or privies thereof, the petition is supported only by supposition and conjecture on Patent Owner's part based on a joint defense agreement in concurrent litigation, which basis is insufficient to support the allegations.. Accordingly, Patent Owner has not demonstrated a persuasive basis for the requested relief of vacatur of the filing date of the instant reexamination proceedings or issuance of a show cause order why the filing date should not be vacated. Therefore, such request for relief is dismissed.

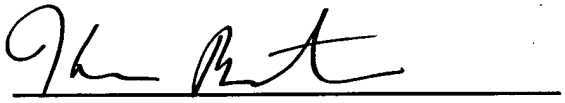
VII. CONCLUSION

1. The February 23, 2011 Patent Owner petitions under 37 CFR 1.181, 1.182 and 1.183, seeking vacatur of the reexamination, are dismissed.

2. The March 9 and March 12, 2011 third party Requester §§ 1.181, 1.182 and 1.183 petitions for entry of a concomitant Oppositions to the Patent Owner petition have been granted and the Oppositions entered.

3. The $400 Requester petition fee for the '1,534 reexamination will be charged to Deposit Account 11-0600.

4. Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-7707.



Hiram H. Bernstein
Senior Legal Advisor
Office of Patent Legal Administration

1-17-12

APPENDIX OF GENERALLY RELEVANT STATUTORY, REGULATORY AND PRACTICE PROVISIONS

35 U.S.C. § 311 Request for inter partes reexamination.

(a) IN GENERAL.— Any third-party requester at any time may file a request for inter partes reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.
(b) REQUIREMENTS.— The request shall—
(1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an inter partes reexamination fee established by the Director under section 41; and
(2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.

35 U.S.C. § 315 Appeal.

* * * * *

(c) CIVIL ACTION.— A third-party requester whose request for an inter partes reexamination results in an order under section 313 is estopped from asserting at a later time, in any civil action arising in whole or in part under section 1338 of title 28, the invalidity of any claim finally determined to be valid and patentable on any ground which the third-party requester raised or could have raised during the inter partes reexamination proceedings. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

35 U.S.C. § 317 Inter partes reexamination prohibited.

(a) ORDER FOR REEXAMINATION.— Notwithstanding any provision of this chapter, once an order for inter partes reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies may file a subsequent request for inter partes reexamination of the patent until an inter partes reexamination certificate is issued and published under section 316, unless authorized by the Director.
(b) FINAL DECISION.— Once a final decision has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit or if a final decision in an inter partes reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office, notwithstanding any other provision of this chapter. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

37 CFR 1.105 Requirement for information.

(a)(1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

(i) *Commercial databases*: The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.

(ii) *Search*: Whether a search of the prior art was made, and if so, what was searched.

(iii)*Related information*: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(iv) *Information used to draft application*: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v) *Information* used in invention process: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) *Improvements*: Where the claimed invention is an improvement, identification of what is being improved.

(vii) *In Use*: Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(viii) *Technical information* known to applicant.
Technical information known to applicant concerning the related art, the disclosure, the claimed subject matter, other factual information pertinent to patentability or concerning the accuracy of the examiner's stated interpretation of such items.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(i), (iii), and (vii) of this section may also be applied to such assignee.

(3) Requirements for factual information known to applicant may be presented in any appropriate
manner, for example:

(i) A requirement for factual information;

(ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or

(iii) Stipulations as to facts with which the applicant may agree or disagree.

(4) Any reply to a requirement for information pursuant to this section that states either that the information required to be submitted is unknown to or is not readily available to the party or parties from which it was requested may be accepted as a complete reply.

(b)The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section will be governed
by §§ 1.135 and 1.136.

37 CFR 1.907 *Inter Partes* reexamination prohibited.

(a) Once an order to reexamine has been issued under § 1.931, neither the third party requester, nor its privies, may file a subsequent request for *inter partes* reexamination of the

patent until an *inter partes* reexamination certificate is issued under § 1.997, unless authorized by the Director.
(b) Once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. 1338 that the party has not sustained its burden of proving invalidity of any patent claim-in-suit, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claim on the basis of issues which that party, or its privies, raised or could have raised in such civil action, and an *inter partes* reexamination requested by that party, or its privies, on the basis of such issues may not thereafter be maintained by the Office.
(c) If a final decision in an *inter partes* reexamination proceeding instituted by a third party requester is favorable to patentability of any original, proposed amended, or new claims of the patent, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claims on the basis of issues which that party, or its privies, raised or could have raised in such *inter partes* reexamination proceeding.

37 CFR 1.913 Persons eligible to file request for *inter partes* reexamination.

Except as provided for in § 1.907, any person other than the patent owner or its privies may, at any time during the period of enforceability of a patent which issued from an original application filed in the United States on or after November 29, 1999, file a request for *inter partes* reexamination by the Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501.

37 CFR 1.915 Content of request for *inter partes* reexamination.

(b) A request for *inter partes* reexamination must include the following parts:
(7) A certification by the third party requester that the estoppel provisions of § 1.907 do not prohibit the inter partes reexamination.
(8) A statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy.

...

(d) If *the inter partes* request does not include the fee for requesting *inter partes* reexamination required by paragraph (a) of this section and meet all the requirements of paragraph (b) of this section, then the person identified as requesting *inter partes* reexamination will be so notified and will generally be given an opportunity to complete the request within a specified time. Failure to comply with the notice will result in the *inter partes* reexamination request not being granted a filing date, and will result in placement of the request in the patent file as a citation if it complies with the requirements of § 1.501.

37 CFR 1.919 Filing date of request for *inter partes* reexamination.

(a) The filing date of a request for *inter partes* reexamination is the date on which the request satisfies all the requirements for the request set forth in § 1.915.

§ 1.939 Unauthorized papers in *inter partes* reexamination

(a) If an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned.

(b) Unless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the *inter partes* reexamination.

§ 1.985 Notification of prior or concurrent proceedings in *inter partes* reexamination.

(a) In any *inter partes* reexamination proceeding, the patent owner shall call the attention of the Office to any prior or concurrent proceedings in which the patent is or was involved, including but not limited to interference, reissue, reexamination, or litigation and the results of such proceedings.

(b) Notwithstanding any provision of the rules, any person at any time may file a paper in an *inter partes* reexamination proceeding notifying the Office of a prior or concurrent proceedings in which the same patent is or was involved, including but not limited to interference, reissue, reexamination, or litigation and the results of such proceedings. Such paper must be limited to merely providing notice of the other proceeding without discussion of issues of the current *inter partes* reexamination proceeding. Any paper not so limited will be returned to the sender.

MPEP § 2612 Persons Who May File a Request

37 CFR 1.907 defines specific situations where a third party is prohibited from filing a request for an inter partes reexamination. 37 CFR 1.915(b)(7) requires the third party requester to certify that the estoppel provisions of 37 CFR 1.907 do not prohibit the filing of the inter partes reexamination request by the real party in interest (note that it is the real party in interest that is subject to the estoppel provisions and not the party who actually files the request). The certification identified in 37 CFR 1.915(b)(7) will constitute a prima facie showing that the party requesting the inter partes reexamination is not barred from doing so under 37 CFR 1.907. The Office does not intend to look beyond this required certification. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would then need to be addressed. A challenge to the accuracy of the certification must facially establish that the third party requesting the inter partes reexamination is barred from doing so under 37 CFR 1.907. Thus, for example, the challenger cannot rely on an argument that the third party requesting reexamination was, at one point, involved with a party barred under 37 CFR 1.907, and should thus be considered as a real party in interest (and barred from filing the request). Involvement *per se* does not facially establish that the other party is a real party in interest. The fact that a second party may benefit from an earlier reexamination request filed by a first party or a civil action conducted by the first party, or that the second party may have collaborated with the first party in a matter, does not facially evidence the second party was a real party in interest with the first party. With respect to the Office conducting an investigation to uncover whether the second party was a "real party in interest," the statute does not require, nor does it provide the tools, for the Office to investigate such matter. Further, Congress has not provided the Office with subpoena power or discovery tools and has not provided the Office with the ability to conduct hearings for eliciting testimony and cross-examination. The Office has not been authorized to impose punitive sanctions for non-compliance. Such evidentiary tools are, however, available to the courts, which are the appropriate vehicle to make a factual investigation as to the accuracy of the identification of a "real party in interest."

MPEP § 2614 Content of Request for *Inter Partes* Reexamination

The reexamination request must identify the real party in interest who is responsible for filing the reexamination request. This information will be used by future parties requesting reexamination of the same patent, in making the certifications required by 37 CFR 1.915(b)(8).

MPEP 2625 Untimely Paper Filed Prior to First Office Action

Pursuant to 37 CFR 1.939, after filing of a request for *inter partes* reexamination, no papers directed to the merits of the reexamination other than (A) citations of patents or printed publications under 37 CFR 1.501 and 1.933, (B) another complete request under 37 CFR 1.510 or 37 CFR 1.915, or (C) notifications pursuant to MPEP § 2686, should be filed with the Office prior to the date of the first Office action in the reexamination proceeding. Any papers directed to the merits of the reexamination, other than those under 37 CFR 1.501, 1.933, 1.510 or 1.915, or under MPEP § 2686, filed prior to the date of the first Office action will be returned to the sender without consideration. >If the papers are entered prior to discovery of the impropriety, such papers will be expunged from the record.< A copy of the letter *>providing notification of< the returned papers >or expungement< will be made of record in the patent file. However, no copy of the *>returned/expunged< papers will be retained by the Office. If the submission of the *>returned/expunged< papers is appropriate later in the proceedings, they may be filed, and accepted by the Office, at that time. See *Patlex Corp. v. Mossinghoff*, 771 F.2d 480, 226 USPQ 985 (Fed. Cir. 1985); *In re Knight*, 217 USPQ 294 (Comm'r Pat.1982); and *In re Amp*, 212 USPQ 826 (Comm'r Pat. 1981) which addressed the situation analogous to the present situation for *ex parte* reexamination proceedings.

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Date: 9-25-11

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
J. Steven Baughman
ROPES & GRAY LLP, PRUDENTIAL TOWER
800 Boylston St., IPRM-Floor 43
Boston, MA 02199-3600

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001535
PATENT NO. : D622088
TECHNOLOGY CENTER : 3999
ART UNIT : 2900

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

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MAILED
AUG 25 2011
CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
J. Steven Baughman
ROPES & GRAY LLP, PRUDENTIAL TOWER
800 Boylston St., IPRM-Floor 43
Boston, MA 02199-3600

REEXAMINATION CONTROL NO. : 95001535	:	
PATENT NO. : D622088	:	PETITION DECISION
TECHNOLOGY CENTER: 3999	:	
ART UNIT : 2900	:	
Filed: 1/31/2011	:	
For: Mattress Design		

This is a decision on the petition filed by Third Party Requester on 6/17/2011.

The petition is DENIED.

Petitioner requests issuance of a corrected Order Granting Reexamination confirming the substantial new questions of patentability. Petitioner alleges the Examiner's April 18, 2011 Order granting reexamination of the patent identified above includes three errors:

> (1) finding that one reference, U.S. Patent No. D616,236 (the "D'236 patent"), both raised and failed to raise a substantial new question of patentability in the same Request;
>
> (2) finding that the "Tenuta" reference (U.S. Patent No. 5,428,852) provided new, non-cumulative technical teachings that raised a substantial new question of patentability, but that Tenuta in combination with each of three other additional references did not; and
>
> (3) applying an erroneous legal standard - inconsistent with controlling Federal Circuit precedent - for anticipation of design patents to deny an additional substantial new question of patentability.

Regarding item (1):

Petitioner points out the Examiner concluded that the D'236 patent did raise a "substantial new question of patentability" as to obviousness-type double patenting (a proposed rejection described on pages 230-233 of Petitioner's Request), but did not raise a "substantial new question" as to statutory double patenting (a proposed rejection described on pages 228-230 of Petitioner's

Request). Petitioner requests issuance of a corrected Order clarifying that the D'236 patent raises a SNQ without regard to a particular proposed basis for rejection.

The examiner's statement contains no error. The examiner states:

> It is agreed that the consideration of Tenuta raises a substantial new question of patentability as to the single claim of Morrison. As pointed out on page 110 of the request Tenuta teaches a top and bottom edging of a mattress connected by vertical strap-like handles. This teaching was not present in the prosecution of the application which became the Morrison patent. Further, there is substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not the claim is patentable. Accordingly, Tenuta raises a substantial new question of patentability as to the single claim.

The Examiner's statement regarding Tenuta (D'326) is clear and unequivocal. The Examiner's statement that Tenuta does not raise a SNQ regarding the particular statutory double patenting rejection proposed does not diminish the examiner's plain statement that Tenuta does raise a substantial new question of patentability as to the single claim.

Regarding item (2):

Petitioner points out while the Examiner concluded that Tenuta provided new, non-cumulative teachings that raised a substantial new question of patentability, the Examiner simultaneously stated in the Order that Tenuta failed to raise a "substantial new question of patentability" when it was combined with each of three other additional cited references - Jomel 1 (Exhibit 34 to the Request), Jomel 2 (Exhibit 35 to the Request), and Barnhardt (Exhibit 36 to the Request). Petitioner requests issuance of a corrected Order confirming that substantial new questions of patentability are raised by each of Tenuta in view of Jomel 1, Tenuta in view of Jomel 2, and Tenuta in view of Barnhardt.

The examiner's statement contains no error. The Examiner's plain statement that Tenuta raises a substantial new question of patentability as to the single claim is not diminished by statements that the combinations of Tenuta with other references do not raise and SNQ.

Regarding item (3):

Petitioner states that in considering whether the D'236 patent (Tenuta) raises a SNQ regarding statutory double patenting, the Examiner stated that this reference must be "identical in all material respects" with the claim in order to anticipate, citing *Hupp v. Siroflex of America Inc.*, 122 F.3d 1456,43 USPQ2d 1887 (Fed. Cir. 1997). But the Examiner failed to consider and apply current controlling law for anticipation of design patents.

The examiner's statement contains no error. The determination of an SNQ is not dependent upon whether a rejection can be given or upon any particular legal standard that might be applied in a rejection. The examiner applies her legal standards in her first action. Petitioner should address any argument regarding the legal standard when responding to the examiner's first action.

The following is a statement clarifying the Office's position regarding the issues raised in this petition:

- Exhibit 29: U.S. Patent No. 5,428,852, filed on April 20, 1994 and issued on July 4, 1995, to Tenuta raises a substantial new question of patentability as to the single claim of Morrison. Tenuta teaches a top and bottom edging of a mattress connected by vertical strap-like handles. This teaching was not present in the prosecution of the application which became the Morrison patent. Further, there is substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not the claim is patentable. Accordingly, Tenuta raises a substantial new question of patentability as to the single claim.

- Exhibit 34, Jomel 1 does not raise a substantial new question of patentability alone or in combination with Tenuta as to the single claim of Morrison.

- Exhibit 35, Jomel 2 does not raise a substantial new question of patentability alone or in combination with Tenuta as to the single claim of Morrison.

- Exhibit 36, Barnhardt does not raise a substantial new question of patentability alone or in combination with Tenuta as to the single claim of Morrison.

Should there be any questions with regard to this letter please contact Joel Sincavage by letter addressed to the Director, Technology Center 1700/2900, P.O. Box 1450, Alexandria, VA

22313-1450, or by telephone at (571) 272-2610.

/Robert Olszewski/
Robert Olszewski
Director, Technology Center 2900
Designs

js

CC:
PATENT OWNER'S CORRESPONDENCE ADDRESS
James C. Scott
ROETZEL & ANDRESS
1375 East 9th Street
Suite 900
Cleveland OH 44114

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,535	01/31/2011	D622088	SMCY-172-601	8469

7590 11/23/2011

James C. Scott
ROETZEL & ANDRESS
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2011

Please find below and/or attached an Office communication concerning this application or proceeding.

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CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
J. Steven Baughman
ROPES & GRAY LLP, PRUDENTIAL TOWER
800 Boylston St., IPRM-Floor 43
Boston, MA 02199-3600

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001535
PATENT NO. : D622088
TECHNOLOGY CENTER : 3999
ART UNIT : 2900

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed 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

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
J. Steven Baughman
ROPES & GRAY LLP, PRUDENTIAL TOWER
800 Boylston St., IPRM-Floor 43
Boston, MA 02199-3600

REEXAMINATION CONTROL NO. : 95001535	:	
PATENT NO. : D622088	:	PETITION DECISION
TECHNOLOGY CENTER: 3999	:	
ART UNIT : 2900	:	
Filed: 1/31/2011	:	
For: Mattress Design		

Although jurisdiction over the reexamination proceeding is retained by the Central Reexamination Unit (CRU), reexaminations of Design patents, including petitions, have been delegated to Technology Center 2900.

This is a decision on the petition filed by Third Party Requester on 10/14/2011.

The petition is DENIED.

Petitioner requests the Director to reconsider and correct three clear errors in the Office's August 25, 2011 decision denying Petitioner's June 17, 2011 petition ("Decision").

June 17, 2011 petition requested issuance of a corrected Order Granting Reexamination confirming the substantial new questions of patentability. Petitioner alleges the Examiner's April 18, 2011 Order granting reexamination of the patent identified above includes three errors:

> (1) finding that one reference, U.S. Patent No. D616,236 (the "D'236 patent"), both raised and failed to raise a substantial new question of patentability in the same Request;
>
> (2) finding that the "Tenuta" reference (U.S. Patent No. 5,428,852) provided new, non-cumulative technical teachings that raised a substantial new question of patentability, but that Tenuta in combination with each of three other additional references did not; and
>
> (3) applying an erroneous legal standard - inconsistent with controlling Federal Circuit precedent - for anticipation of design patents to deny an additional substantial new question

of patentability.

The June 17, 2011 petition decision does not warrant reconsideration because neither party is entitled to review of a decision granting a request for reexamination.

> 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. MPEP 2648

This decision is final and nonappealable. See 35 U.S.C. 312(c) and 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.

Should there be any questions with regard to this letter please contact Joel Sincavage by letter addressed to the Director, Technology Center 1700/2900, P.O. Box 1450, Alexandria, VA 22313-1450, or by telephone at (571) 272-2610.

js

/Robert Olszewski/
Robert Olszewski
Director, Technology Center 2900
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CC:
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,540	02/08/2011	D622996	SMCY-172-602	8383

37287 7590 09/27/2011

ROETZEL & ANDRESS
1375 EAST 9TH STREET
CLEVELAND, OH 44114

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/27/2011

Please find below and/or attached an Office communication concerning this application or proceeding.

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ROPES & GRAY LLP
PRUDENTIAL TOWER, IPRM - FLOOR 43
800 BOYLSTON STREET
BOSTON, MA 02199-360

Date:

MAILED

SEP 27 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001540
PATENT NO. : D622996
TECHNOLOGY CENTER : 3999
ART UNIT : 2900

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed 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 27 2011

CENTRAL REEXAMINATION UN

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
J. Steven Baughman
ROPES & GRAY LLP, PRUDENTIAL TOWER
800 Boylston St., IPRM-Floor 43
Boston, MA 02199-3600

REEXAMINATION CONTROL NO. : 95/001,540	:	
PATENT NO. : D622,996	:	PETITION DECISION
TECHNOLOGY CENTER: 3999	:	
ART UNIT : 2900	:	
Filed: 2/8/2011	:	
For: Pillow-Top Mattress Design		

This is a decision on the petition filed by Third Party Requester on 7/1/2011.

The petition is DENIED.

The petition is denied primarily because , 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. MPEP 2648

Petitioner requests issuance of a corrected Order Granting Reexamination confirming the substantial new questions of patentability. Petitioner alleges the Examiner's April 18, 2011 Order granting reexamination of the patent identified above includes three errors:

> (1) finding that two references, U.S. Patent No. D622,088 (the "D'088 patent") and U.S. Patent No. D622,531 (the "D'531 patent"), each simultaneously raised and failed to raise a substantial new question of patentability in the same Request;
>
> (2) finding that the "Tenuta" reference (U.S. Patent No. 5,428,852) provided new, non-cumulative technical teachings that raised a substantial new question of patentability, but that Tenuta in combination with each of three other additional references did not;
>
> (3) applying an erroneous legal standard - inconsistent with controlling Federal Circuit

precedent - for anticipation of design patents to deny an additional substantial new question of patentability; and

(4) finding that multiple references that lacked a "distinct pillow-top feature" failed to raise substantial new questions of patentability in combination with references disclosing such a feature, in conflict with the subsequently issued order in the reexamination of the D'531 patent (Control No. 95/001,549, also requested by Petitioner), in which the same references in such a combination were found to raise substantial new questions of patentability.

Regarding item (1):

Petitioner points out the Examiner concluded that the D'088 patent did raise a "substantial new question of patentability" as to obviousness-type double patenting (a proposed rejection described on pages 279-91 of Petitioner's Request), but did not raise a "substantial new question" as to statutory double patenting (a proposed rejection described on pages 277-79 of Petitioner's Request). *See* Order at 106-09. Petitioner is concerned that confusion arises regarding the SNQ status of D'088 and D'531 since, a single reference cannot both raise and fail to raise a SNQ. Petitioner requests issuance of a corrected Order clarifying that the D'236 patent raises a SNQ without regard to a particular proposed basis for rejection.

The examiner's statement contains no error. The examiner states:

> It is agreed that the consideration of the new reference '088 patent raises a substantial new question of patentability as to the single claim of the '996 patent.
>
> As pointed out on page 280 of the request, '088 teaches a mattress design with edging along the horizontal edges and vertical handles. This teaching was not considered during the prosecution of the application which became the '996 patent. Further, there is substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not the claim is patentable.
>
> Accordingly, a substantial new question of patentability of the design in the '996 patent is raised by the '088 patent.
>
> ***
>
> It is agreed that the '531 patent raises a substantial new question of patentability as to the single claim of '996. As pointed out on page 294 of the request '531 patent teaches a top and bottom edging of a mattress connected by vertical strap-like handles and a pillow-top with edging. This teaching was not considered during the prosecution of the application which became the Morrison

> '088 patent. Further, there is substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not the claim is patentable.

The Examiner's statements regarding D'088 and D'531 are clear and unequivocal. The Examiner's statement that D'088 and D'531 do not raise a SNQs regarding the respective statutory double patenting rejections proposed does not diminish the examiner's plain statement that D'088 and D'531 do raise a substantial new questions of patentability as to the single claim.

Regarding item (2):

Petitioner points out while the Examiner concluded that Tenuta (Exhibit 29 to the Request) provided new, non-cumulative teachings that raise a substantial new question of patentability, the Examiner simultaneously stated in the Order that Tenuta failed to raise a "substantial new question of patentability" when it was combined with each of three other additional cited references—"Jomel 1" (Exhibit 34 to the Request), "Jomel 2" (Exhibit 35 to the Request), and "Barnhardt" (U.S. Patent No. 6,684,461, Exhibit 36 to the Request). *See, Order* at 45-47. Petitioner requests issuance of a corrected Order confirming that substantial new questions of patentability are raised by each of Tenuta in view of Jomel 1, Tenuta in view of Jomel 2, and Tenuta in view of Barnhardt. The examiner's statement contains no error. The Examiner's plain statement that Tenuta raises a substantial new question of patentability as to the single claim is not diminished by statements that the combinations of Tenuta with other references do not raise and SNQ.

Regarding item (3):

Petitioner states that in considering whether the D'236 patent (Tenuta) raises a SNQ regarding statutory double patenting, the Examiner stated that this reference must be "identical in all material respects" with the claim in order to anticipate, citing *Hupp v. Siroflex of America Inc.*, 122 F.3d 1456,43 USPQ2d 1887 (Fed. Cir. 1997). But the Examiner failed to consider and apply current controlling law for anticipation of design patents.

The examiner's statement contains no error. The determination of an SNQ is not dependent upon whether a rejection can be given or upon any particular legal standard that might be applied in a

rejection. The examiner applies her legal standards in her first action. Petitioner should address any argument regarding the legal standard when responding to the examiner's first action.

Regarding item (4):

Petitioner points out the Examiner's finding that multiple references without a "distinct pillow-top feature" did not raise SNQs regarding the D'996 patent's design. And these findings directly conflict with the findings in the subsequently issued reexamination order in the reexamination of the D'531 patent, Control No. 95/001,549, Order Granting Request for Inter Partes Reexamination (May 13, 2011) ("D'531 Order").

Petitioner requests the Director to correct this error and issue a corrected Order confirming that each of the above-listed references raises a SNQ as to the D'996 patent.

The examiner's statement contains no error. There is no right to review of this matter because the claim will be reexamined in view of all prior art during the reexamination under 37 CFR 1.937. MPEP 2648.

The following is a statement clarifying the Office's position regarding the issues raised in this petition:

- Exhibit 29: U.S. Patent No. 5,428,852, filed on April 20, 1994 and issued on July 4, 1995, to Tenuta raises a substantial new question of patentability as to the single claim of Morrison. Tenuta teaches a top and bottom edging of a mattress connected by vertical strap-like handles. This teaching was not present in the prosecution of the application which became the Morrison patent. Further, there is substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not the claim is patentable. Accordingly, Tenuta raises a substantial new question of patentability as to the single claim.

- Exhibit 34, Jomel 1 does not raise a substantial new question of patentability alone or in combination with Tenuta as to the single claim of Morrison.

- Exhibit 35, Jomel 2 does not raise a substantial new question of patentability alone or in combination with Tenuta as to the single claim of Morrison.

- Exhibit 36, Barnhardt does not raise a substantial new question of patentability alone or in combination with Tenuta as to the single claim of Morrison.

Should there be any questions with regard to this letter please contact Joel Sincavage by letter addressed to the Director, Technology Center 1700/2900, P.O. Box 1450, Alexandria, VA 22313-1450, or by telephone at (571) 272-2610.

js

/Robert Olszewski/
Robert Olszewski
Director, Technology Center 2900
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Suite 900
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,540	02/08/2011	D622996	SMCY-172-602	8383

37287 7590 02/22/2012
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/22/2012

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800 BOYLSTON STREET
BOSTON, MA 02199-360

Date:

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FEB 2 2 2012

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001540
PATENT NO. : D622996
TECHNOLOGY CENTER : 3999
ART UNIT : 2900

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed 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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REEXAMINATION CONTROL NO. : 95/001,540	:	
PATENT NO. : D622,996	:	PETITION DECISION
TECHNOLOGY CENTER: 3999	:	
ART UNIT : 2900	:	
Filed: 2/8/2011	:	
For: Pillow-Top Mattress Design		

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CENTRAL REEXAMINATION UNIT

This is a decision on the petition filed by Third Party Requester on 11/23/2011.

The petition is DENIED.

Petitioner requests issuance of a corrected Order Granting Reexamination confirming the substantial new questions of patentability. Petitioner alleges the Examiner's May 13, 2011 Order granting reexamination of the patent identified above includes three errors:

(1) applying an erroneous legal standard – inconsistent with controlling Federal Circuit precedent – for anticipation of design patents to deny substantial new questions of patentability for multiple references;

(2) finding that the "Tenuta" reference (U.S. Patent No. 5,428,852) provided new, non-cumulative technical teachings that raised a substantial new question of patentability, but that Tenuta in combination with each of three other additional references did not;

(3) Regarding item (1) in the decision, it impossible to determine the Director's grounds for denying the petition;

The petition is denied because, 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. MPEP 2648

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CENTRAL REEXAMINATION U

This decision is final and nonappealable. See 35 U.S.C. 312(c) and 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.

Should there be any questions with regard to this letter please contact Joel Sincavage by letter addressed to the Director, Technology Center 1700/2900, P.O. Box 1450, Alexandria, VA 22313-1450, or by telephone at (571) 272-2610.

js

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,541	02/08/2011	7,781,228	113221-002REX	8764

27189 7590 04/18/2012

PROCOPIO, CORY, HARGREAVES & SAVITCH LLP
525 B STREET
SUITE 2200
SAN DIEGO, CA 92101

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/18/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 4-18-12

CLARK & ELBING LLP
101 FEDERAL STREET
BOSTON, MA 02110

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001541
PATENT NO. : 7781228
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

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CENTRAL REEXAMINATION UNIT

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525 B Street, Suite 2200
San Diego, CA 92101

Clark & Elbing LLP (For Third Party Requester)
101 Federal Street
Boston, MA 02110

In re Menon et al.	:	**DECISION**
Reexamination Proceeding	:	**DISMISSING**
Control No. 95/001,541	:	**PETITION AND**
Filed: February 8, 2011	:	**EXPUNGING**
For: U.S. Patent No. 7,781,228	:	**IMPROPER PAPER**

This is a decision on the December 16, 2011 third party requester petition entitled "PETITION UNDER 37 C.F.R. § 1.182 AND MPEP § 2686.03(V) FOR STAY OF REISSUE APPLICATION OR, ALTERNATIVELY, MERGER OF THE *INTER PARTES* REEXAMINATION AND REISSUE PROCEEDINGS" (the petition under 37 CFR 1.182).

The petition under 37 CFR 1.182 is before the Office of Patent Legal Administration.

The petition under 37 CFR 1.182 is dismissed as not having a right of entry.

The third party requester petition paper is an improper paper. Because the present petition papers have been scanned into the electronic Image File Wrapper (IFW), the petition papers are **expunged** from the record by marking them "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.[1]

REVIEW OF THE RELEVANT FACTS

1. U.S. Patent Number 7,781,228 (the '228 patent) issued to Menon et al. on August 24, 2010 with claims 1-14.

2. On February 8, 2011, a third party requester filed a request for *inter partes* reexamination of the '228 patent. The resulting reexamination proceeding was assigned Control Number 95/001,541 (the '1541 reexamination proceeding).

[1] See MPEP 2267.

3. On April 13, 2011, the Office issued an order granting reexamination in the '1541 proceeding.

4. On April 20, 2011, the patent owner filed an application for reissue of the '228 patent, which was assigned reissue application number 13/090,418 (the '418 reissue application).

5. On December 16, 2011, third party requester filed the instant petition under 37 CFR 1.182 in the '1541 proceeding.

6. The '1541 proceeding progressed to the point where, on March 23, 2012, the Office issued an Action Closing Prosecution.

7. To date, no Office action on the merits has been issued in the '418 reissue application.

APPLICABLE REGULATIONS AND EXAMINING PROCEDURE

37 C.F.R. § 1.182 addresses questions not specifically provided for:

> All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 C.F.R. § 1.939(a) addresses unauthorized papers in *inter partes* reexamination:

> If an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned.

37 C.F.R. § 1.985(b) addresses notification of prior or concurrent proceedings:

> Notwithstanding any provision of the rules, any person at any time may file a paper in an *inter partes* reexamination proceeding notifying the Office of a prior or concurrent proceedings in which the same patent is or was involved, including but not limited to interference, reissue, reexamination, or litigation and the results of such proceedings. Such paper must be limited to merely providing notice of the other proceeding without discussion of issues of the current *inter partes* reexamination proceeding. Any paper not so limited will be returned to the sender.

MPEP 2686.03 provides in-part (emphasis added):

> The third party requester may file a petition under 37 CFR 1.182 to merge a reexamination proceeding and a reissue application examination, <u>or stay the **reexamination proceeding**</u>, after the order to reexamine (37 CFR 1.931), in the

event the Office has not acted prior to that date to merge or stay. Any such petition under 37 CFR 1.182 filed prior to the initial Office action on the merits must also be filed under 37 CFR 1.183 to waive the requirement of 37 CFR 1.933(b) that no paper shall be filed prior to the initial Office action on the merits of the inter partes reexamination proceeding. Any petition to merge or stay which is filed by a party other than the patent owner or the third party requester of the reexamination will not be considered, but will be returned to that party by the OPLA.

DECISION

In the instant petition under 37 CFR 1.182, third party requester requests that the '418 reissue application be stayed pending completion of the instant '1541 *inter partes* reexamination proceeding. Alternatively, third party requester requests merger of the '418 reissue application and the '1541 reexamination proceeding. Third party requester has not specified any statutory basis permitting such a third party requester paper including a request that the Office stay a reissue proceeding in which the requester is not a party. Accordingly, for the reasons set forth herein, the petition under 37 CFR 1.182 is an improper paper and does not have an entry right in the '1541 reexamination proceeding. Thus, this decision does not address the merits of third party requester's alternative request for merger.[2]

The instant petition under 37 CFR 1.182 is improper because it includes a request by the third party requester that the Office take action in a proceeding other than the '1541 reexamination proceeding in which the petition was filed - a reissue proceeding in which requester is not a party. Neither 35 U.S.C. § 314(b)(2), nor any other provision of the reexamination statute, provides any right for the third party requester to file a paper in an *inter partes* reexamination proceeding that requests action be taken in a separate proceeding.[3] While enactment of the *inter partes* reexamination statute was for the purpose of expanding a third party requester's participation in the merits of a reexamination proceeding, there is no indication whatsoever in the legislative history of the *inter partes* reexamination statute that the requester was granted any right to participate in other Office proceedings. Such a right was not provided in the enactment of the *inter partes* reexamination statute (nor in any of its precursor bills), and there is no evidence to indicate that enacting such rights was ever contemplated by Congress.

While a third party may file a paper notifying the Office of the existence of a concurrent reissue proceeding under 37 CFR 1.985(b), any such paper "must be limited to merely providing notice of the other proceeding without discussion of issues of the current *inter partes* reexamination proceeding." Any paper that is not so limited will be returned to the sender per § 1.985(b) or expunged if inadvertently entered. The instant third party requester paper goes beyond mere notice as to requesting that the Office take action in a proceeding other than the '1541

[2] It is noted that such a request for merger, presented alone in a petition under 37 CFR 1.182, is permitted by MPEP 2686.03. However, as further set forth in MPEP 2686.03, "The decision on whether to merge the reissue application examination and reexamination proceeding, or stay one of them, will be made on a case-by-case basis. The decision to merge, or not to merge, is within the sole discretion of the Office to facilitate/carry out the orderly operation of the Office in addressing the proceedings." (emphasis added)

[3] *See Animal Defense Fund v. Quigg*, 932 F.2d 920, 930, 18 USPQ2d 1677, 1685 (Fed. Cir. 1991) (stating "we find nothing in the law which gives rise to a right in nonapplicants to object to the way in which patent applications of others are prosecuted").

reexamination proceeding in which the petition was filed. Therefore, the instant third party requester paper is not a proper submission under § 1.985(b).

Further, the instant petition under 37 CFR 1.182, if granted, would circumvent the *ex parte* nature of reissue applications and permit third party participation in the examination of a reissue application, contrary to the existing laws and regulations. Therefore, the petition is not appropriate under § 1.182, which may only provide relief for "situations not specifically provided for in the regulations," but may not waive rules or provisions of the laws.

For the above reasons, the instant petition under 37 CFR 1.182 is dismissed as not having a right of entry in the '1541 proceeding and is being expunged from the record of the '1541 proceeding.

CONCLUSION

1. The December 16, 2011 third party requester petition under 37 CFR 1.182 is **dismissed** as not having a right of entry in the '1541 proceeding.

2. The December 16, 2011 third party requester petition under 37 CFR 1.182 is being **expunged** from the record as not having an entry right. This will be carried out by closing the petition paper (document) in the Office's Image File Wrapper (IFW) file of the '1541 proceeding and marking the paper "closed" and "not public."

3. No copy of the petition paper will be maintained of record in the IFW for the '1541 proceeding, or elsewhere in the Office.

4. A copy of this decision will be made of record in the IFW for the '1541 proceeding.

5. Telephone inquiries relating to this decision should be directed to Nicole D. Haines at (571) 272-7717.

Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

04-16-2012

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,544	02/14/2011	7,400,274	2855.001REX4	6059

26111 7590 05/11/2011

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/11/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BAKER BOTTS LLP
910 LOUISIANA STREET
ONE SHELL PLAZA
HOUSTON, TX 77002

Date:

MAILED

MAY 11 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001544
PATENT NO. : 7400274
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

Decision on Petition for Extension of Time in Reexamination	Control No.: 95/001,544

1. THIS IS A DECISION ON THE PETITION FILED 03 May 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:
   A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS
   Patent owner requests that the period for responding to the Office action dated 25 March 2011 which sets a two (2) month period for filing a response to the Office action, be extended by one (1) month.

   A. ☒ Petition fee per 37 CFR §1.17(g)):
      i. ☐ Petition includes authorization to debit a deposit account.
      ii. ☐ Petition includes authorization to charge a credit card account.
      iii. ☐ Other: _____.
   B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
   C. ☒ Petition was timely filed.
   D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)
   A. ☐ Granted or ☒ Granted-in-part for one (1) month, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
   B. ☒ Other/comment: see attached
   C. ☐ Dismissed because:
      i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
      ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
      iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
      iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
      v. ☐ The petition is moot.
      vi. ☐ Other/comment: _____.

5. CONCLUSION

   Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611. In his/her absence, calls may be directed to Eric Keasel at 571-272-4929 in the Central Reexamination Unit.

/Mark Reinhart/	SPE, AU 3992 Central Reexamination Unit
[*Signature*]	(Title)

In support of a factual accounting of reasonably diligent behavior of what action the patent owner has taken to date to provide a response.

In consideration of providing the patent owner with a fair opportunity to present an argument against any attack on the patent as balanced with the statutory mandate of conducting reexamination proceedings with special dispatch. This is the first request for extension of time in this proceeding. While the petition speaks to the considerations of the length and complexity of the Office action and speed at which Office action was prepared. The petitioner also noted other proceedings for which reexamination was granted It is agreed that patent owner needs to be given opportunity to complete all aspects of investigation prior to responding to the first Office action on the merits in a reexamination proceeding. This is why, absent litigation stayed for reexamination all patent owners are given a response period of two months for preparation of a response. Yet it is Patent owner who must exercise diligence in responding to an outstanding office action. The requirement for reasonably diligent behavior by patent owner includes a reasonable expectation of resource management. Resource management takes into consideration other proceedings before the Office. The petition identifying other concurrent proceedings is noted but is not germane to the issues under consideration as to "sufficient cause" for granting an extension of time. Additionally, the speed at which the Office action was prepared is required to meet the requirements of "special dispatch." All of that said, the length and complexity of the Office action does warrant consideration.

MPEP 2665 states, "First requests for extensions of these time periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments within the statutory time period. Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary situations." (emphasis added.

On balance the petition for extension of time supports "sufficient cause" to grant a one (1) month extension of time.

The petition for extension of time is hereby granted-in-part

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,545	02/15/2011	7887568	09364.0017	6818

30328 7590 06/23/2011

NuVasive
c/o CPA Global
P.O. Box 52050
Minneapolis, MN 55402

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/23/2011

Please find below and/or attached an Office communication concerning this application or proceeding.

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
FINNEGAN HENDERSON FARABOW ET AL.
901 New York Ave., N.W.
Washington, DC 20001-4413

Date:
MAILED

JUN 23 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001545
PATENT NO. : 7887568
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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NuVasive
c/o CPA Global
P.O. Box 52050
Minneapolis, MN 55402

(For Patent Owner)

MAILED

JUN 23 2011

CENTRAL REEXAMINATION UNIT

Finnegan Henderson Farabow et al.
901 New York Ave., N.W.
Washington, D.C. 20001-4413

(For Requester)

In re *Ahlgren*
Reexamination Proceeding
Control No. 95/001, 545
Filed: February 15, 2011
For: U.S. Patent No. 7,887,568

DECISION ON PETITION UNDER 37 CFR 1.181 and 1.927

The paper filed by requester on April 8, 2011, styled as "Petition Under 37 CFR §§ 1.181 and 1.927 to Review the Examiner's Order Denying *Inter Partes* Reexamination" is before the Technology Center Director overseeing the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the Order Denying Request for *Inter Partes* Reexamination dated March 11, 2011. Specifically, petitioner requests that the CRU Director find that a substantial new question of patentability exists based upon the references cited.

The petition is denied for the reasons set forth below.

REVIEW OF FACTS

1. U.S. Patent No. 7,887,568 (hereinafter, the '568 patent) issued on February 15, 2011.

2. On February 15, 2011, a third party requester deposited a request for *inter partes* reexamination for claims 1-7 of the '568 patent, and the resulting reexamination

proceeding was assigned Control No. 95/001,545 (hereinafter, the '545 reexamination proceeding).

3. On March 11, 2011, an order denying the request for reexamination for claims 1-7 of the '568 patent was mailed.

4. On April 8, 2011, the third party requester timely filed the above-mentioned petition under 37 CFR §§ 1.181 and 1.927.

Petitioner's Grounds in Support of the Requested Relief

The following is a list of the prior art cited by requester:

1. Steffee, U.S. Patent No. 5,443,514 (hereinafter "Steffee");
2. Zucherman et al., U.S. Patent No. 5,860,977 (hereinafter "Zucherman");
3. Coates et al., U.S. Patent No. 5,989,289 (hereinafter "Coates");
4. Johnson et al., U.S. Patent No. 6,595,998 (hereinafter "Johnson");
5. Ahlgren, U.S. Patent Publication No. 2002/0082693 (hereinafter "Ahlgren"); and
6. Grunberg et al., U.S. Patent Publication No. 2003/0171812 (hereinafter "Grunberg").

Petitioner (the third party requester) alleges that the examiner incorrectly denied the request for reexamination and requests three points to be reviewed:

a. Whether claims 1-7 are entitled to the priority benefit of the parent applications under §§ 119 and 120, and the identified intervening art raises at least one SNQ;
b. Whether Zucherman has been presented in a new light and raises at least one SNQ; and
c. Whether Grunberg is prior art for purposes of reexamination under § 135(b)(2) and whether Grunberg raises an SNQ.

Petitioner then requests that the Director reverse the examiner's order denying the request for *inter partes* reexamination and return the request to another examiner for further consideration with instructions to grant the request and issue an Office action rejecting all the claims.

DECISION

I. Standard of Review

37 CFR 1.927 and 1.181 provide for the filing of a petition to review an examiner's determination refusing to order *inter partes* reexamination. The CRU Director's review of the reexamination request on petition is *de novo*. Therefore, the review will determine

whether the examiner's refusal to order reexamination for claims 1-7 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination for claims 1-7 the '568 patent. As will be discussed in further detail in section III.B. below, consideration is limited as to whether the cited patents raise a substantial new question of patentability (SNQ) to patent claims 1-7.

II. The Legal Standard for Ordering Reexamination

A review of 35 USC §§ 302 and 37 CFR 1.915 shows that *inter partes* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. In particular, 35 USC § 302 requires that a request for *inter partes* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.510(b)(1) requires that a request for *inter partes* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final holding of invalidity after all appeals, or by the Office in a previous examination or in a reexamination of a patent. If a substantial new question of patentability is found, an order for *inter partes* reexamination of the patent is issued.

An SNQ is not raised by the old prior art if the Office has previously considered (in an earlier examination of the patent) the <u>same</u> question of patentability as to the patent and has decided that question in favor of the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

Looking to the legislative history for the original reexamination statute,[1] Congress stated:

> "Section I provides for a system of administrative reexamination of patents within the patent office. This new procedure will permit any party to petition the patent office to review the efficacy of a patent, subsequent to its issuance, on the basis of **new information about preexisting technology which may have escaped review at the time of the initial examination of the patent application**. H.R. Rep. No. 96-1307, 96th Cong., 2d Sess. 3 (1980), reprinted in 1980 U.S.C.C.A.N. 6460, 6461, 6462." [Emphasis added]

[1] Public Law 96-517, enacted on December 12, 1980.

Reexamination is limited to review of **new information** about preexisting **technology** that may have escaped review at the time of the initial examination of the patent application. It was not designed for harassment of a patent owner by review of old information about preexisting technology, even if a third party feels the Office's conclusion based on that old information was erroneous. The Office may assume jurisdiction over a patent for which reexamination is requested in order to review the patentability of one or more claims of that patent only if such new information about preexisting technology is presented in a request for reexamination. Absent establishment of at least one SNQ, the Office does not have jurisdiction to revisit the issue of claim patentability.

In accordance with this legislative history, MPEP 2642, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request." [2],[3] This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. For example, a reference may be read in a "new light" if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent.

If a substantial new question of patentability is not found, an order denying for *inter partes* reexamination of the patent is issued. MPEP 2647 provides guidelines for such an order, and requires that the examiner's decision in the order state, for each patent and printed publication cited in the request, why the citation is:

> (A) Cumulative to the teachings of the art cited in the earlier concluded examination of the patent;
>
> (B) Not available against the claims (e.g., the reference is not available as prior art because of its date or the reference is not a publication);
>
> (C) Not important to a reasonable examiner in deciding whether any claim of the patent for which reexamination is requested is patentable, even though the citation is not cumulative and the citation is available against the claim; or

---

[2] See: *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351 (Bd. Pat. App. & Inter. 1984).
[3] For additional discussion regarding technical teachings viewed "in a new light, see: *In re Melvin J. Swanson et al*, 540 F.3d 1368,1376, 2008 U.S. APP. Lexis 18928, **16-17 (citing H.R. Rep. No. 96-1307 (1980) and H.R. Rep. No. 107-120, at 2-3

(D) One which was cited in the record of the patent and is barred by the guidelines set forth in MPEP § 2642 subsection II. A.

Further, the examiner is instructed that the decision respond to the substance of each argument raised by the requester which is based on patents or printed publications.

III. Analysis of the Request for Reexamination

Regarding petitioner's argument a) above:

A review of the position taken by petitioner in the *inter partes* reexamination request clearly shows that the request argues that the claims 1-7 of the '568 patent are not entitled to the benefit of the filing date of the either the parent non-provisional application 09/904,179 (hereinafter the "'179 application") or the grandparent provisional application 60/218,975 (hereinafter the "'975 application") because the claims 1-7 lack essential elements of the invention disclosed in and required by the earlier-filed applications.

Petitioner has argued that when reexamining a patent, it is appropriate to reassess benefit claims and/or foreign priority claims in light of new facts.[4] Reassessing the benefit claims in the '568 patent as to whether the invention of claims 1-7 is enabled by, or has the required written description, in the '179 application or the '975 application within the meaning of 35 USC § 112, first paragraph, is not proper in this instance because to reassess that issue with respect to the parent patent(s) would **necessarily** amount to a reassessment of that enablement issue with respect to the specification of the '568 patent. **However, the United States Patent and Trademark Office cannot conduct an initial reassessment of the original specification and claims of the '568 patent for compliance with 35 USC § 112, first paragraph in an *inter partes* reexamination proceeding before the Office, whether that initial reassessment is explicitly requested or merely implicit in the reexamination request.**

A 35 USC 112, first paragraph assessment of the sort necessitated by the instant reexamination request might be proper during certain proceedings in the United States Patent and Trademark Office when not precluded by statute, or during proceedings by a court of competent jurisdiction during proceedings before the court. For example, a prior final court decision holding that the claims of a given parent patent are not enabled by the disclosure of that patent might later be utilized as a basis for limiting the effective date of an invention claimed in a "child" patent being reexamined in the United States Patent and Trademark Office, **because the court proceedings in which the determination was made were not an *inter partes* reexamination proceeding within the Patent and Trademark Office, and therefore were not subject to the provisions of 35 USC §§ 311-317**. Again, in the instant *inter partes* reexamination proceeding, the argument that the specification of a parent applications '179 and '975 is not enabling for subject matter in claims 1-7 of the '568 patent is also **necessarily** an argument that the invention

[4] MPEP § 2617 supports this view, but does not do expressly do so with respect to a continuation (i.e. "child") patent having a disclosure that is essentially identical to the disclosure in its parent patent.

claimed in the '568 patent is not enabled by the specification of the '568 patent. That argument, **advanced for the first time in an *inter partes* reexamination proceeding governed by 35 USC §§ 311-317**, is clearly not a permissible argument.

In addition, at pages 3-7 of the decision denying the request for *inter partes* reexamination, the examiner has carefully and thoroughly considered petitioner's arguments that claims 1-7 of the '568 patent are not entitled to the benefit of priority under 35 USC 119(e) and 120 because the claims encompass embodiments that were not described sufficiently to demonstrate possession of the invention. A review of the examiner's analysis and conclusions reveals that the examiner did not err in his conclusions.

Thus, as pointed out by the examiner at page 7 of the decision denying the request for *inter partes* reexamination, Ahlgren, Johnson and Grunberg are eliminated as prior art.

Regarding petitioner's argument b) above:

The evidence and explanation, as set forth in the request dated February 15, 2011, simply does not support ordering a request for reexamination based on Zucherman. The request does not present sufficient evidence that Zucherman, a reference that was previously considered and applied, taken alone and together with Steffee and Coates, is presented in a new light, or otherwise provides any new technical teaching that was not previously discussed and considered on the record in a previous examination. As pointed out by the examiner at page 9 of the order denying reexamination, "...3PR's proposed combination of elements from the Figs. 11, 18-20 and 51 inserts into a set of stackable inserts would results in consideration of a basic technological teaching. . . .that is substantially the same as the technological teaching already considered with respect to Zucherman. Therefore, no new SNQ of claims 1, 2, 5 and 6 is raised by Zucherman because the "new light" consideration of Zucherman proposed by 3PR is cumulative to the teachings of Zucherman as applied in the earlier concluded examination." MPEP 2247 is clear that references that are cumulative to the teachings of the art cited in the earlier concluded examination of the patent cannot raise a SNQ.

Regarding petitioner's argument c) above:

As Grunberg has been eliminated as prior art, petitioner's argument that Grunberg is prior art for purposes of reexamination under § 135(b)(2) and whether Grunberg raises an SNQ similarly fails. See the above discussion of petitioner's argument a).

CONCLUSION

1. The PETITION is DENIED.

2. This decision is final and nonappealable. 35 U.S.C. § 303(c); 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.

3. Telephone inquiries related to this decision should be directed Supervisory Patent Examiner Andres Kashnikow, at (571) 272-4361.

Irem Yucel, Director
Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,545	02/15/2011	7887568	09364.0017	6818

30328 7590 11/29/2011

NuVasive
c/o CPA Global
P.O. Box 52050
Minneapolis, MN 55402

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/29/2011

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Date: 11-29-11

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
FINNEGAN HENDERSON FARABOW ET AL.
901 New York Ave., N.W.
Washington, DC 20001-4413

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001545
PATENT NO. : 7887568
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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MINNEAPOLIS, MN 55402

(For Patent Owner)

FINNEGAN, HENDERSON, FARABOW ET AL.
901 NEW YORK AVE., N.W.
WASHINGTON, DC 20001-4413

(For Third Party Requester)

In re Dan K. Ahlgren	:	**DECISION DISMISSING**
Inter Partes Reexamination Proceeding	:	**PETITION UNDER**
Control No.: 95/001,545	:	**37 CFR 1.181 AND**
Filed: February 15, 2011	:	***SUA SPONTE* REMANDING**
For: U.S. Patent No. 7,887,568	:	**THE PROCEEDING**
	:	**TO THE CRU**

The above-captioned proceeding is before the Office of Patent Legal Administration for consideration of requester's "PETITION UNDER 37 CFR § 1.181 TO THE OFFICE OF PATENT LEGAL ADMINISTRATION FOR REVIEW OF GROUP DIRECTOR'S DECISION" filed on August 22, 2011.

The petition is dismissed to the extent set forth herein.

The proceeding is *sua sponte* remanded to the CRU for consideration in accordance with this decision.

BACKGROUND

1. On February 15, 2011, U.S. Patent No. 7,887,568 (the '568 patent) issued to Dan K. Ahlgren.

2. On February 15, 2011, a request for *inter partes* reexamination was filed by a third party requester, and assigned re-examination proceeding control no. 95/001,545 (the '1545 proceeding).

3. On March 11, 2011, the Office issued an order denying the request for re-examination in the '1545 proceeding.

4. On April 8, 2011, third party requester timely filed a petition requesting supervisory review under 37 CFR §§ 1.181 and 1.927 of the examiner's March 11, 2011 order denying *inter partes* re-examination in the '1545 proceeding.

5. On June 23, 2011, the CRU director issued a decision denying requester's April 8, 2011 petition.

6. On August 22, 2011, third party requester filed the present petition entitled, "PETITION UNDER 37 CFR § 1.181 TO THE OFFICE OF PATENT LEGAL ADMINISTRATION FOR REVIEW OF GROUP DIRECTOR'S DECISION," requesting review under 37 CFR 1.181 of the Director's June 23, 2011 decision denying the April 8, 2011 petition and *inter partes* re-examination in the '1545 proceeding.

DECISION

Relevant Statutes, Regulations and Practice

35 U.S.C. § 312 provides, in 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.
>
> ****
>
> (c) FINAL DECISION. - <u>A determination by the Director under subsection (a) shall be final and non-appealable</u>. Upon a determination that no substantial new question of patentability has been raised, the Director may refund a portion of the inter partes reexamination fee required under section 311. [Emphasis added]

37 CFR 1.927 provides:

> The third party requester may seek review by a petition to the Director under § 1.181 within one month of the mailing date of <u>the examiner's determination</u> refusing to order *inter partes* reexamination. Any such petition must comply with § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, <u>the determination shall be final and non-appealable</u>. [Emphasis added]

MPEP 2649 provides in pertinent part:

> The requester may seek review of a denial of a request for reexamination only by petitioning the Director of the USPTO under 37 CFR 1.927 and 1.181 within one

(1) month of the mailing date of the decision denying the request for reexamination. Additionally, any request for an extension of the time period to file such a petition from the examiner's denial of a request for reexamination can only be entertained by filing a petition under 37 CFR 1.183 with the appropriate fee to waive the time provisions of 37 CFR 1.927.

After the time for petition has expired without a petition having been filed, or a petition has been filed and the decision thereon affirms the denial of the request, a partial refund of the filing fee for the request for reexamination will be made to the third party requester. 35 U.S.C. 312(c) and 37 CFR 1.26(c). A decision on a petition under 37 CFR 1.927 and 1.181 is final and is not appealable.

Requester's Petition under 37 CFR 1.181

1. In the instant petition, third party requester is petitioning under 37 CFR 1.181 for review of the June 23, 2011 CRU director decision denying reexamination. Such a petition is not provided for by rule, and 37 CFR 1.939(b) provides that "[u]nless otherwise authorized, no paper shall be filed prior to the initial Office action on the merits of the *inter partes* reexamination."[1] Requester has not requested waiver under 37 CFR 1.183 for the Office to consider the present petition.

2. More important, the June 23, 2011 decision denying reexamination is a decision on the petition authorized under 37 CFR 1.927 which holds that no substantial new question of patentability has been raised, and it is the "determination by the Director under subsection (a)" of 35 U.S.C. § 312. Pursuant to 35 U.S.C. § 312(c), a "determination by the Director under subsection (a) shall be final and non-appealable." Thus, the petition is statutorily barred.

Accordingly, the petition is dismissed.

***Sua Sponte* Remand of Proceeding**

Upon *sua sponte* review of the record which is before the Office of Patent Legal Administration, the present proceeding is being remanded to the Central Reexamination Unit (CRU). Based on the recent decision of *In re NTP* 654 F.3d 1268, 99 USPQ2d 1500 (Fed. Cir. 2011), the CRU is directed to consider the requester's priority issues under 35 U.S.C. §§ 112[2], 119 and 120 in light of that decision and issue a supplemental order. Further, in accordance with *Ryan v. Young*,

---

[1] 37 CFR 1.927 was implemented to provide for **one** review of "the examiner's determination" under 37 CFR 1.181 (by the CRU or Technology Center director), and there is no provision for further Office review of the determination under 37 CFR 1.181. To the contrary, 37 CFR 1.927 provides "If no petition [i.e., no § 1.927 petition] is timely filed or **if the decision on petition affirms that no substantial new question of patentability has been raised**, the determination shall be final and non-appealable." (Emphasis and bracketed text added).

[2] Regarding requester's specific "lack of an essential element" argument MPEP §§ 2163.I.B and 2163.05.I are to be noted.

Interference 105,504 and 105,505 (Bd. Pat. App. & Interference 2008 Informative Decision)[3], the CRU is also directed to consider requester's 35 U.S.C. 135(b)(2) issue contingent upon the outcome of the examiner's priority determination, and to further supplement the order as needed.[4]

CONCLUSION

1. Third party requester's August 22, 2011 petition under 37 CFR 1.181 is dismissed.

2. The proceeding is remanded to the CRU for further consideration in accordance with this decision.

3. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at (571) 272-7759.

/Kenneth M. Schor/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

11-28-11
Kenpet9/deny or grant

[3] See also *Ding v. Singer*, Interference 105,436 (Bd. Pat. App. & Int. 2007).
[4] Regarding requester's specific 35 U.S.C. 135(b)(2) argument MPEP §§ 2301.03 and 2304.02 (c) II are to be noted.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,549	02/17/2011	D622531	SMCY-172-603	1917

37287 7590 11/23/2011
ROETZEL & ANDRESS
1375 EAST 9TH STREET
CLEVELAND, OH 44114

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/23/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ROPES & GRAY LLP
PRUDENTIAL TOWER, IPRM - FLOOR 43
800 BOYLSTON STREET
BOSTON, MA 02199-3600

Date:

MAILED

NOV 28 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001549
PATENT NO. : D622531
TECHNOLOGY CENTER : 3999
ART UNIT : 2900

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

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NOV 23 2011

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
J. Steven Baughman
ROPES & GRAY LLP, PRUDENTIAL TOWER
800 Boylston St., IPRM-Floor 43
Boston, MA 02199-3600

REEXAMINATION CONTROL NO. : 95/001,549	:	
PATENT NO. : D622,996	:	PETITION DECISION
TECHNOLOGY CENTER: 3999	:	
ART UNIT : 2900	:	
Filed: 2/8/2011	:	
For: Euro-Top Mattress Design		

This is a decision on the petition filed by Third Party Requester on 7/13/2011.

The petition is DENIED.

Petitioner requests issuance of a corrected Order Granting Reexamination confirming the substantial new questions of patentability. Petitioner alleges the Examiner's May 13, 2011 Order granting reexamination of the patent identified above includes three errors, however only two were identified:

> (1) finding that U.S. Patent No. D616,236 ("the D'236 patent") simultaneously raised and failed to raise a substantial new question of patentability in the same Request;
>
> (2) applying an erroneous legal standard – inconsistent with controlling Federal Circuit precedent – for anticipation of design patents to deny substantial new questions of patentability for multiple references;

The petition is denied because, 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. MPEP 2648

This decision is final and nonappealable. See 35 U.S.C. 312(c) and 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.

Should there be any questions with regard to this letter please contact Joel Sincavage by letter addressed to the Director, Technology Center 1700/2900, P.O. Box 1450, Alexandria, VA 22313-1450, or by telephone at (571) 272-2610.

/Robert Olszewski/
Robert Olszewski
Director, Technology Center 2900
Designs

js

CC:
PATENT OWNER'S CORRESPONDENCE ADDRESS
James C. Scott
ROETZEL & ANDRESS
1375 East 9th Street
Suite 900
Cleveland OH 44114

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,551	02/18/2011	6,747,350	6747350RX	3568

26111 7590 11/03/2011

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/03/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

SLATER & MATSIL, L.L.P.
17950 PRESTON ROAD
SUITE 1000
DALLAS, TX 75252-5793

Date:

MAILED

NOV 03 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001551
PATENT NO. : 6747350
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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Michael D. Specht : (For Patent Owner)
STERNE, KESSLER, GOLDSTEIN :
& FOX P.L.L.C. :
1100 NEW YORK AVE., NW :
WASHINGTON, DC 20005 :

MAILED

NOV 03 2011

CENTRAL REEXAMINATION UNIT

SLATER & MATSIL, L.L.P. : (For Third Party
17950 PRESTON ROAD : Requester)
SUITE 1000 :
DALLAS, TX 75252-5793 :

In re: Lin *et al.* :
Inter Partes Reexamination Proceeding : DECISION ON PETITION
Control No.: 95/001,551 : UNDER 37 CFR § 1.181
Deposited: February 18, 2011 :
For: U.S. Patent No.: 6,747,350 :

This is a decision on a petition filed by the patent owner on September 14, 2011, entitled: "Petition to Expunge Third Party Requester's Comments Under 37 C.F.R. § 1.181" [hereinafter "the petition"].

The petition is a request to the Director to exercise his discretion pursuant to 37 CFR § 1.181 to review the allegedly improper entry of a paper into the record.

The petition is before the Director of the Central Reexamination Unit. Also before the Director is an opposition filed September 28, 2011. The petition is dismissed.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,747,350 issued on June 8, 2004.
- A request for *inter partes* reexamination was filed on February 18, 2011 and assigned control no. 95/001,551.
- *Inter partes* reexamination was ordered and a rejection was mailed on April 22, 2011.

- On June 22, 2011, patent owner responded to the Office action.
- On July 22, 2011, the third party requester filed comments to the patent owner's response.
- On September 14, 2011, patent owner filed the instant petition. The third party filed an opposition on September 28, 2011.
- On October 28, 2011, the examiner issued a notice of defective paper holding the June 22, 2011 patent owner response defective.

DECISION

Patent owner argues that the third party requester's comments filed July 22, 2011 are improper and should not have been entered. However, patent owner's response has been held to be non-compliant by the examiner. Thus, "[a]ny 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." MPEP § 2667(I)(A)(2). Accordingly, the third party requester's comments filed July 22, 2011 are already not considered, and patent owner's petition to expunge the comments is dismissed as moot.

CONCLUSION

1. The petition filed September 14, 2011 is dismissed as moot.

2. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Reexamination Specialist, at (571) 272-1611 or in his absence to Sudhanshu C Pathak, Supervisory Patent Reexamination Specialist, at 571-272-5509.

Mark Reinhart
Supervisory Patent Reexamination Specialist,
Art Unit 3992, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,554	02/22/2011	6,314,754		7296

34313 7590 12/30/2011

ORRICK, HERRINGTON & SUTCLIFFE, LLP
IP PROSECUTION DEPARTMENT
2050 Main Street, Suite 1100
IRVINE, CA 92614

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/30/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date 12-30-11

KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001554
PATENT NO. : 6314754
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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Orrick, Herrington & Sutcliffe , LLP (For Patent Owner)
IP Prosecution Department
2050 Main Street, Suite 1100
Irvine, CA 92614

Kenyon & Kenyon LLP (For Third Party Requester)
One Broadway
New York, New York 10004

In re Kotliar	:
Inter Partes Reexamination Proceeding	: **DECISION**
Control No. 95/001,554	: **GRANTING**
Filed: February 22, 2011	: **PETITION**
For: U.S. Patent No. 6,314,754	:

This is a decision on the third party requester's paper entitled "REQUESTER AIRBUS S.A.S.'S PETITION UNDER 37 C.F.R. §1.183 TO WAIVE THE PAGE LIMIT FOR REQUESTER'S RESPONSE UNDER 37 C.F.R. §1.943(b)" (the petition under 37 CFR 1.183), filed on September 19, 2011.

The third party requester petition is being treated as a renewed petition under 37 CFR 1.183 and is before the Office of Patent Legal Administration.

The renewed petition under 37 CFR 1.183 is granted, for the reasons set forth herein.

FEES

Third party requester timely filed a petition under 37 CFR 1.183 on July 27, 2011 requesting waiver of the 50-page limit for the concurrently-filed comments submission after patent owner's June 27, 2011 response to the April 25, 2011 Office action. A charge of $400.00 was applied to requester's credit card on July 28, 2011. For the reasons set forth herein, requester's July 27, 2011 is dismissed as moot. Patent owner filed a corrected response submission on August 29, 2011 and, on September 19, 2011; requester timely resubmitted the instant petition under 37 CFR 1.183, concurrently with its comments submission. A charge of $400.00 for the instant petition under 37 CFR 1.183 was applied to requester's credit card on September 20, 2011. However, because the instant petition under 37 CFR 1.183 is being treated as a renewed petition, no additional petition fee is required. Accordingly, requester is being refunded the $400.00 petition fee that was charged on September 20, 2011.

BACKGROUND

1. U.S. Patent Number 6,314,754 (the '754 patent) issued to Igor K. Kotliar on November 13, 2001, with claims 1-18.

2. On February 22, 2011, a request for *inter partes* reexamination of claims 1, 2, 4-6 and 8 of the '754 patent was filed by a third party requester, which request was assigned Reexamination Control No. 95/001,554 (the '1554 proceeding). The request identifies Airbus S.A.S. as the real party in interest.

3. On April 25, 2011, an order granting *inter partes* reexamination of claims 1, 2, 4-6 and 8 of the '754 patent was mailed for the '1554 proceeding. Concurrently with the order, the Office mailed a non-final Office action.

4. On June 27, 2011, patent owner filed a response after the April 25, 2011 Office action, including an amendment to the claims. In the claim amendment, patent owner amended original claim 8 and presented new claims 19-101.

5. On July 27, 2011, 2011, third party requester filed a paper entitled "REQUESTER AIRBUS S.A.S.'S PETITION UNDER 37 C.F.R. §1.183 TO WAIVE THE PAGE LIMIT FOR REQUESTER'S RESPONSE UNDER 37 C.F.R. §1.943(b)," concurrently with its comments submission.

6. On August 19, 2011, the Office mailed a "NOTICE RE DEFECTIVE PAPER IN INTER PARTES REEXAMINATION" (the notice of non-compliance), stating that patent owner's June 27, 2011 amendment does not comply with 37 CFR 1.530 and giving patent owner a time period of 15 days to make an appropriate correction.

7. On August 29, 2011, patent owner filed a corrected response submission, responsive to the August 19, 2011 notice of non-compliance.[1]

8. On September 19, 2011, third party requester filed the instant renewed petition under 37 CFR 1.183, concurrently with its comments submission.

DECISION

I. Relevant Statutes, Regulations and Procedures

37 CFR 1.183 provides:

[1] Patent owner filed a "Supplemental Amendment and Response" on June 30, 2011, correcting the format of the claim amendments; however, because the August 19, 2011 notice of non-compliance did not address the June 30, 2011 response submission, the August 29, 2011 corrected response submission supersedes the June 30, 2011 response submission. Accordingly, the June 30, 2011 response submission will be annotated "not for entry" in the electronic image file wrapper (IFW) for the '1554 proceeding.

> In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

> Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

II. Third Party Requester's July 27, 2011 Petition under 37 CFR 1.183

Third party requester originally filed "REQUESTER AIRBUS S.A.S.'S PETITION UNDER 37 C.F.R. §1.183 TO WAIVE THE PAGE LIMIT FOR REQUESTER'S RESPONSE UNDER 37 C.F.R. §1.943(b)" on July 27, 2011, concurrently with its comments submission after the April 25, 2011 Office action and patent owner's June 27, 2011 response submission. Subsequently, on August 19, 2011, the Office issued the notice of non-compliance, stating that patent owner's June 27, 2011 response submission does not comply with 37 CFR 1.530.

Because the June 27, 2011 patent owner response submission was defective and not entered, the patent owner did not in fact respond to the Office action in accordance with the rules, and requester statutorily had no comment right under 35 USC § 314(b)(2). Thus, requester's July 27, 2011 comments submission is being expunged from the record of the '1554 proceeding by marking the papers "closed" and "non-public." Further, because requester's July 27, 2011 comments submission is being expunged, requester's July 27, 2011 petition under 37 CFR 1.183 is **dismissed as moot**.

III. Third Party Requester's September 19, 2011 Petition under 37 CFR 1.183

Because patent owner timely filed a corrected response submission on August 29, 2011, in accordance with the August 19, 2011 notice of non-compliance, requester's September 19, 2011 comments submission was timely under 37 CFR 1.947. Also on September 19, 2011, third party requester filed the instant renewed petition under 37 CFR 1.183, requesting waiver of 37 CFR 1.943(b) to permit entry of a comments submission of up to 312 pages.[2]

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner

[2] Third party requester petition under 37 CFR 1.183 at page 1 (stating that "Airbus requests permission to file comments totaling 312 pages (consisting of: 36 pages of "Comments of Requester, Airbus S.A.S., Pursuant to 37 CFR 1.947;" 271 pages of claim charts; and 5 pages of "Declaration of N. Albert Moussa Under 37 CFR 1.132").

can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft comments in compliance with the 50-page limit, and submission of resulting comments that are in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted comments. Such comments can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed comments: (1) for justification that more pages are needed to complete the comments, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the comments.

In support of waiver of the rule, requester asserts that in its August 29, 2011 response, patent owner presents 83 proposed new claims "which increased the number of claims under reexamination from 6 claims (i.e., claims 1, 2, 4-6 and 8) to 89 claims (i.e. claims 1, 2, 4-6, 8 and 19-101)".[3] Requester also asserts that it "has attempted to keep its written comments within the 50-page limit and has exceeded the 50-page limit only to the extent reasonably necessary to adequately explain new proposed grounds of rejections that are necessitated by FirePass's proposed amendment of claim 8 and its addition of new claims 19-101".[4]

Additionally, requester has made a showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft comments in compliance with the 50-page limit, and submitting the resulting comments, and accompanying declaration and claim charts, which in total exceed 50 pages. Requester asserts that patent owner has submitted in its response "more than 80 new claims added by amendment (i.e., claims 19-101), many of which are independent and many of which are multiple dependent", and that, as a result of the newly added claims by patent owner, "271 of the additional pages Airbus requests for its comments submission consist of claim charts addressing new claims 19-101 in order to comply with the Office's own procedures".[5]

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts,** or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see*, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-

[3] Id.
[4] Id. at page 7.
[5] Id. (citing MPEP § 2617 subsection I).

felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

In this instance, the September 19, 2011 comments submission includes 36 pages of remarks. Additionally the comments submission includes a 5-page declaration by N. Albert Moussa (the Moussa declaration) and a 271-page claim chart (the claim chart) addressing new claims 19-101. Based on the guidance set forth above, the Moussa declaration is deemed to include legal argument (*e.g.*, as to the obviousness of the claims) and is subject to the regulatory page limit count. The claim chart is also subject to the regulatory page limit count. Based on the individual facts and circumstances of this case such as, for example, the 83 new claims presented by patent owner, it is deemed equitable in this instance to waive the 50-page limit of 37 CFR 1.943(b) to the extent that third party requester's September 19, 2011 comments submission exceeds the regulatory page limit by up to 262 pages.

Accordingly, requester's September 19, 2011 petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting third party requester's September 19, 2011 comments submission to exceed the regulatory page limit by up to 262 pages. This waiver makes third party requester's September 19, 2011 comments submission page-length compliant.

CONCLUSION

1. Third party requester's July 27, 2011 comments submission is being expunged from the record of the '1554 proceeding by marking the papers "closed" and "non-public" and third party requester's July 27, 2011 petition under 37 CFR 1.183 is **dismissed as moot**.

2. Third party requester's September 19, 2011 petition under 37 CFR 1.183 is **granted** and the page limit of 37 CFR 1.943(b) is waived to the extent of permitting requester's September 19, 2011 comments submission to exceed the page limit by up to 262 pages. **This waiver makes requester's September 19, 2011 comments submission page-length compliant**.

3. Any questions concerning this communication should be directed to Maria Nuzzolillo, Legal Advisor, at (571) 272-8150 or Nicole D. Haines, Legal Advisor, at (571) 272-7717.

Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

12-27-2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,555	02/23/2011	6418752		7309

7590 09/14/2011

EXAMINER

Igor K. Kotliar
P.O. BOX 2021
New York, NY 10159-2021

ART UNIT	PAPER NUMBER

DATE MAILED: 09/14/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: 9-14-11

Clifford A. Ulrich
KENYON & KENYON LLP
One Broadway
New York, NY 10004

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001555
PATENT NO. : 6418752
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

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CENTRAL REEXAMINATION UNIT

Igor K. Kotliar
P.O. BOX 2021
New York, NY 10159-2021

(For Patent Owner)

Clifford A. Ulrich
KENYON & KENYON LLP
One Broadway
New York, NY 10004

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,555
Filed: February 23, 2011
For: U.S. Patent No. 6,418,752

DECISION DISMISSING PETITION

This is a decision on the July 20, 2011 third party requester petition paper entitled "REQUESTER AIRBUS S.A.S.'S PETITION UNDER 37 C.F.R § 1.183 TO WAIVE THE PAGE LIMIT FOR REQUESTER'S RESPONSE UNDER 37 C.F.R. § 1.943(b)."

The petition is before the Office of Patent Legal Administration for decision.

The petition is **dismissed as moot**, for the reasons set forth below.

DECISION

In the instant petition, third party requester requests waiver of the page limit requirement of 37 CFR 1.943(b) for its comments submission filed on July 20, 2011.

On August 19, 2011, the Office mailed a "NOTICE RE DEFECTIVE PAPER IN INTER PARTES REEXAMINATION' (the notice of non-compliance), stating that patent owner's June 30, 2011 response is defective and setting a time period of 15 days for patent owner to file a corrected response submission. Pursuant to MPEP § 2667(I)(A)(2), "Any previously submitted third party comments in response to [the] 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." Accordingly, requester's July 20, 2011 petition

requesting waiver of 37 CFR 1.943(b) for its July 20, 2011 comments submission is moot, and requester's July 20, 2011 petition is dismissed as moot. It is noted that requester resubmitted its petition on August 30, 2011. This petition will be addressed in due course.

CONCLUSION

1. Third party requester's July 20, 2011 petition paper entitled "REQUESTER AIRBUS S.A.S.'S PETITION UNDER 37 C.F.R § 1.183 TO WAIVE THE PAGE LIMIT FOR REQUESTER'S RESPONSE UNDER 37 C.F.R. § 1.943(b)" is dismissed as moot.

2. Telephone inquiries with regard 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

09-12-2011
Kenpet8

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,555	02/23/2011	6418752		7309

34313 7590 11/08/2011

ORRICK, HERRINGTON & SUTCLIFFE, LLP
IP PROSECUTION DEPARTMENT
2050 Main Street, Suite 1100
IRVINE, CA 92614

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/08/2011

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Date: NOV 08 2011

CENTRAL REEXAMINATION UN

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Clifford A. Ulrich
KENYON & KENYON LLP
One Broadway
New York, NY 10004

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001555
PATENT NO. : 6418752
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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Igor K. Kotliar
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(For Patent Owner)

MAILED

NOV 08 2011

CENTRAL REEXAMINATION UNIT

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(Courtesy Copy)

Inter Partes Reexamination Proceeding
Control No. 95/001,555
Filed: February 23, 2011
For: U.S. Patent No. 6,418,752 B2

: **DECISION**
: **GRANTING**
: **PETITION**
: **AND EXPUNGING**
: **IMPROPER PAPER**

This is a decision on third party requester's petition paper entitled "REQUESTER AIRBUS S.A.S.'S PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE PAGE LIMIT FOR REQUESTER'S RESPONSE UNDER 37 C.F.R. § 1.943(b)," filed on August 30, 2011, as supplemented by third party's petition paper entitled "REQUESTER AIRBUS S.A.S.'S (CORRECTED) PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE PAGE LIMIT FOR REQUESTER'S RESPONSE UNDER 37 C.F.R. § 1.943(b)," filed on September 19, 2011 (hereinafter "the petition"). The petition requests waiver of the requirement of 37 CFR 1.943(b) that the written comments by third party requester not exceed fifty (50) pages in length, and requests that the page limit be extended to 280 pages.

The petition is before the Office of Patent Legal Administration for consideration.

Third party requester's petition under 37 CFR 1.183 to waive the 37 CFR 1.943(b) limit as to the number of pages permitted in the August 30, 2011 comments by third party requester is granted to the extent that the page limit for the August 30, 2011 comments by third party requester is extended to not exceed 306 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

In addition, third party requester timely filed comments under 37 CFR 1.947 on August 30, 2011. Thus, third party requester's September 19, 2011 "corrected" comments submission filed on is an improper paper for the reasons set forth below.

Since the third party requester's September 19, 2011 corrected comments paper has been scanned into the record, i.e., the Office's Image File Wrapper (IFW) file of the above-captioned reexamination proceeding, it is being expunged from the record by closing it and marking it "not public."

REVIEW OF THE RELEVANT FACTS

1. On July 16, 2002, United States Patent Number 6,418,752 B2 (the '752 patent) was granted to Igor K. Kotliar, with claims 1-28.

2. On February 23, 2011, a request for *inter partes* reexamination was submitted by a third party requester, which request was assigned control number 95/001,555 ("the '555 proceeding").

3. On April 18, 2011, the Office issued an order was granting *inter partes* reexamination in the '555 proceeding, with an accompanying Office action on the merits.

4. On June 20, 2011, patent owner timely filed a response to the Office action. The patent owner response amended independent claim 8 and added new claims 29-100.

5. On July 20, 2011, third party requester filed a petition entitled "REQUESTER AIRBUS S.A.S.'S PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE PAGE LIMIT FOR REQUESTER'S RESPONSE UNDER 37 C.F.R. § 1.943(b)." Third party requester timely filed a 37 CFR 1.947 comments submission concurrently with the July 20, 2011 petition.

6. On August 19, 2011, the Office mailed a "NOTICE RE DEFECTIVE PAPER IN INTER PARTES REEXAMINATION" (the notice of defective paper), stating that patent owner's June 20, 2011 response was defective and setting a time period of 15 days for patent owner to file a corrected response submission. The notice stated that the strikethrough in claim 8 was improper and that brackets were required for deletions.

7. On August 29, 2011, patent owner filed a corrected response via EFS-Web.

8. On August 30, 2011, third party requester resubmitted its July 20, 2011 written comments and petition via EFS-Web.

9. On September 14, 2011, the Office mailed a decision dismissing the July 20, 2011 third party requester petition as moot. The decision noted that the third party requester petition resubmitted on August 30, 2011 would be considered in due course.

10. On September 19, 2011, third requester filed a petition entitled "REQUESTER AIRBUS S.A.S.'S (CORRECTED) PETITION UNDER 37 C.F.R. § 1.183 TO WAIVE THE PAGE LIMIT FOR REQUESTER'S RESPONSE UNDER 37 C.F.R. § 1.943(b)." Third party requester filed a paper entitled "(CORRECTED) COMMENTS OF REQUESTER, AIRBUS S.A.S., PURSUANT TO 37 C.F.R. § 1.947" concurrently with the September 19, 2011 supplemental petition.

DECISION

I. RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

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.

37 CFR 1.947 provides (emphasis added):

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 1.183 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.

II. Third Party Requester's Petition

In the instant petition, third party requester requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for third party requester's comments filed on August 30, 2011, and as corrected by the comments submission filed on September 19, 2011, and requests that the page limit be extended to 280 pages. In support of its request for waiver of the rule, third party requester argues that additional pages are needed to adequately address newly presented claims 29-100, many of which are independent claims and multiple dependent claims.

III. Analysis and Findings

A. <u>The Requester's September 19, 2011 Corrected Comments Submission is an Improper Paper</u>

As noted by third party requester in the first paragraph of the introduction section of requester's September 19, 2011 "corrected" written comments, the comments address patent owner's corrected response filed on August 29, 2011. Third party requester also states in this first paragraph that "the time limit for filing written comments by requester is September 28, 2011, which is 30 days from August 29, 2011 as stated in 37 C.F.R. 1.947." The third party requester does not appear to mention, in the papers filed on September 19, 2011, that the July 20, 2011 written comments were resubmitted on August 30, 2011 by third party requester via EFS-Web.

Pursuant to MPEP § 2667(I)(A)(2), if a patent owner's corrected response to a notice of defective paper is received, then under 37 CFR 1.947, third party requester <u>may once</u> 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. The resubmission of the July 20, 2011 third party requester comments on August 30, 2011 serves as the one opportunity that requester has to file comments under 37 CFR 1.947. Since requester has filed its "one" submission comments on August 30, 2011 by resubmitting a copy of the July 20, 2011 written comments via EFS-Web, the "corrected" comments submission filed on September 19, 2011 by third party requester is an improper paper. Since the third party requester's

September 19, 2011 comments paper has been scanned into the record, i.e., the Office's Image File Wrapper (IFW) file of the above-captioned reexamination proceeding, it is being expunged from the record by closing it and marking it "not public."

For the purposes of prosecution of this present reexamination proceeding, the August 30, 2011 comments filed by the third party requester is considered to be the timely filed written comments pursuant to 37 CFR 1.947. The August 30, 2011 comments submission is treated as the subject of requester's present petition under 37 CFR 1.183 for page limit waiver of its comments submission.

B. The Page Limit Requirement of 37 CFR 1.943(b) is Waived for the August 30, 2011 Comments Submission

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.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response or comments, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts,** or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see*, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

Third party requester's August 30, 2011 comments submission is found to consist of a 44-page comments section, Appendices A-J, and Exhibits 1-4.[1]

Appendices A-J are a 230-page set of ten claims charts that count toward the page limit.

[1] This decision is limited to the page-limit issue and the propriety of third party requester's written comments will be reviewed by the Central Reexamination Unit (CRU).

Exhibit 1 is a 6-page declaration under 37 CFR 1.132 of N. Albert Moussa. The §1.132 Moussa declaration is also accompanied by Appendix A. Appendix A is a *curriculum vitae* of N. Albert Moussa that does not count toward the page limit. However, the 6-page §1.132 Moussa declaration contains a legal argument/conclusion on page 4, paragraph 9. Therefore, one page of the Moussa declaration is counted toward the page limit.

Exhibit 2 is a 31-page patent owner's claim construction brief filed in the concurrent litigation. Third party requester's August 30, 2011 comments section cites this patent owner claim construction brief. Consequently, these 31 pages are counted toward the page limit.

Exhibits 3 and 4 are references and do not count toward the page limit.

Accordingly, the August 30, 2011 third party requester comments submission includes *in toto* 306 pages in length as to pages counting toward the regulatory page limit.

It is found that the 256 pages of arguments in excess of 50 required to complete the third party requester's comments are not unreasonable in this instance, in view of the present facts and circumstances. This includes the point that patent owner's response added 72 new claims, which includes 43 independent claims and numerous multiple dependent claims. Regarding claims written in multiple dependent form, MPEP 608.01(n) states that, "35 U.S.C. 41(a), provides that claims in proper multiple dependent form may not be considered as single dependent claims for the purpose of calculating fees. Thus, a multiple dependent claim is considered to be that number of dependent claims to which it refers." Therefore, the total number of claims effectively added by patent owner's response, taking into account the number of dependent claims to which the multiple dependent claims refer, is 186. 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 reexamination proceeding, the instant third party requester petition is deemed to establish that a waiver of 37 CFR 1.943(b) to the extent of permitting third party requester's comments to run 306 pages in length is appropriate in the interest of justice.

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's comments submission to exceed the page limit by 256 pages. This waiver makes requester's August 30, 2011 comments submission page-length compliant.

PATENT OWNER'S ADDRESS

The patent owner is called upon to coordinate the proper correspondence addresses in (1) the patent and (2) the '555 proceeding. The current correspondence address of record **in the patent file** is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c), and it is that of IGOR K. KOTLIAR, P.O. BOX 2021, NEW YORK NY 10159-2021.

Accordingly, all future correspondence will be directed to IGOR K. KOTLIAR, P.O. BOX 2021, NEW YORK NY 10159-2021, unless patent owner changes the correspondence address of record in the patent (the same address should be explicitly made of record in the reexamination proceeding).

As a one-time courtesy, this decision is being mailed to both addresses. However, as pointed out above, the address of IGOR K. KOTLIAR, P.O. BOX 2021, NEW YORK NY 10159-2021, will be used in future correspondence, unless the address of record is changed as set forth above.

CONCLUSION

1. Third party requester's petition under 37 CFR 1.183 is granted, and the page limit of 37 CFR 1.943(b) is waived to the extent that third party requester's comments submission filed on August 30, 2011 may exceed the page limit by 256 pages. This waiver makes the August 30, 2011 third party requester comments submission page-length compliant.

2. Third party requester's written comments submission filed on September 19, 2011 is an improper paper, and therefore will NOT be made a part of the record of the '555 proceeding. Since third party requester's September 19, 2011 comments submission and accompanying exhibits were scanned into the electronic Image File Wrapper (IFW) of the '555 proceeding, these papers are expunged by closing them in the '555 reexamination proceeding's IFW file and marking them as "not-public."

3. No copy of the third party requester's September 19, 2011 written comments submission will be maintained in the record, or elsewhere in the Office.

4. The proceeding is being referred to the Central Reexamination Unit for issuance of an Office action in due course addressing the patent owner's August 29, 2011 corrected response and requester's written comments filed on August 30, 2011.

5. Telephone inquiries related to the present decision should be directed to the Susy Tsang-Foster, Legal Advisor, at 571-272-7711.

/Kenneth M. Schor/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

11/7/11
Kenpet9/

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,556	02/25/2011	7037321	132.0007-02RX3	2571

22882 7590 02/22/2012

MARTIN & FERRARO, LLP
1557 LAKE O'PINES STREET, NE
HARTVILLE, OH 44632

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/22/2012

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Date: MAILED
FEB 22 2012
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001556
PATENT NO. : 7037321
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

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CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

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(For 95/001,518 Requester)

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(For 90/009,876 Requester)

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P.O. BOX 1022
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(For 95/001,556 Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,518
Filed: January 10, 2011
For: U.S. Patent No. 7,037,321 B2

Ex Parte Reexamination Proceeding
Control No. 90/009,876
Filed: February 15, 2011
For: U.S. Patent No. 7,037,321 B2

Inter Partes Reexamination Proceeding
Control No. 95/001,556
Filed: February 25, 2011
For: U.S. Patent No. 7,037,321 B2

DECISION ON PETITIONS AND MERGING REEXAMINATION PROCEEDINGS

This is a decision on the following patent owner petitions:

(1) Petition entitled "Petition Under 37 C.F.R. § 1.183 to Waive the Requirement Under 37 CFR 1.939(b)" filed on December 13, 2011 in reexamination proceeding 95/001,556;

(2) Petition entitled "Petition Under 37 C.F. R. § 1.182 to Stay Proceeding or, in the Alternative, not Merge Proceedings" filed on December 13, 2011 in reexamination proceeding 95/001,556; and

(3) Petition entitled "Petition Under 37 C.F. R. § 1.182 to Stay Proceeding or, in the Alternative, not Merge Proceedings" filed on December 13, 2011 in reexamination proceeding 90/009,876.

The patent owner petitions are before the Office of Patent Legal Administration.

SUMMARY

The patent owner's December 13, 2011 petition under 37 CFR 1.183 filed in the 95/001,556 proceeding requesting waiver of the requirement under 37 CFR 1.939(b) in order to permit consideration of the concurrently filed patent owner petition under 37 CFR 1.182 in the 95/001,556 proceeding is **granted**.

For the reasons set forth below, the patent owner's December 13, 2011 petitions filed in the 90/009,876 and 95/001,556 proceedings requesting (1) that the 90/009,876 and 95/001,556 proceedings be suspended until the conclusion of the 95/001,518 proceeding or (2) in the alternative, that the 90/009,876 and 95/001,556 proceedings not be merged with the 95/001,518 proceeding, are **dismissed**.

Ex parte reexamination proceeding 90/009,876 and *inter partes* reexamination proceedings 95/001,518 and 95/001,556 **are merged** into a single proceeding.

REVIEW OF THE RELEVANT FACTS

1. On May 2, 2006, United States Patent Number 7,037,321 B2 ("the '321 patent") issued to Sachdeva et al., with claims 1-9.

2. On January 10, 2011, a first request for *inter partes* reexamination of claims 1, 2, and 7 of the '321 patent was filed by a third party requester and assigned Reexamination Control No. 95/001,518 ("the '518 proceeding"). The request identified Boston Scientific Corporation as the real party in interest.

3. On February 15, 2011, a request for *ex parte* reexamination of claims 1-3, and 7 of the '321 patent was filed by a third party requester and was assigned control number 90/009,876 ("the '876 proceeding").

4. On February 25, 2011, a second request for *inter partes* reexamination of claims 1-9 of the '321 patent was filed by a third party requester and assigned Reexamination Control No. 95/001,556 ("the '556 proceeding"). The request identified MicroStrategy Incorporated as the real party in interest.

5. On March 2, 2011, *inter partes* reexamination of claims 1, 2, and 7 of the '321 patent was granted in the '518 proceeding. The order stated that the patent owner waived its right under 37 CFR 1.530 to file a patent owner statement. The order was also accompanied by a non-final Office action rejecting claims 1, 2, and 7.

6. On March 28, 2011, *inter partes* reexamination of claims 1-9 of the '321 patent was granted in the '556 proceeding.

7. On April 2, 2011, *ex parte* reexamination of claims 1-3 and 7 of the '321 patent was granted in the '876 proceeding. The patent owner did not amend or add any claims.
8. On May 2, 2011, the patent owner timely filed a response to the March 2, 2011 non-final Office action in the '518 proceeding.

9. On June 1, 2011, the third party requester timely filed comments after the patent owner's response in the '518 proceeding.

10. On December 13, 2011, the patent owner filed a petition entitled "Petition Under 37 C.F. R. § 1.182 to Stay Proceeding or, in the Alternative, not Merge Proceedings" in the '876 proceeding.

11. On December 13, 2011, the patent owner filed a petition entitled "Petition Under 37 C.F.R. § 1.183 to Waive the Requirement Under 37 CFR 1.939(b)" in the '556 proceeding. The patent owner concurrently filed a petition in the '556 proceeding entitled "Petition Under 37 C.F. R. § 1.182 to Stay Proceeding or, in the Alternative, not Merge Proceedings."

12. On February 15, 2012, the patent owner filed a power of attorney and statement under 37 CFR 3.73(b) in the '518, '556, and '876 proceedings.

13. To date, no Office action has issued in either of the '556 and '876 proceedings.

DECISION

I. PATENT OWNER'S PETITION UNDER 37 CFR 1.183 REQUESTING WAIVER OF 37 CFR 1.939(B)

In the December 13, 2011 petition under 37 CFR 1.183 filed in the '556 proceeding, the patent owner requests waiver of the requirements under 37 CFR 1.939(b) that no paper shall be filed prior to the initial Office Action on the merits of an *inter partes* reexamination proceeding in order to permit consideration of the concurrently filed petition under 37 CFR 1.182 requesting stay or non-merger of the '556 proceeding. In support of its request for waiver of the rule, the patent owner argues that the Office recognizes situations where the requirements of 37 CFR 1.939(b) may be waived. The patent owner points out that such a situation is set forth in MPEP 2686.01(VI) where the Office will waive the requirements of 37 CFR 1.939(b) when deciding on a petition to merge multiple reexamination proceedings.

The December 13, 2011 patent owner petition under 37 CFR 1.183 is granted to the extent that the requirements of 37 CFR 1.939(b) are hereby waived to assure that the patent owner's concurrently filed petition under 37 CFR 1.182 requesting stay or non-merger of the '556 proceeding will be considered at the earliest possible stage.

II. PATENT OWNER'S PETITIONS UNDER 37 CFR 1.182 REQUESTING EITHER STAY OF THE '556 AND '876 PROCEEDINGS, OR NOT TO MERGE THESE PROCEEDINGS WITH THE '518 PROCEEDING

In the December 13, 2011 petitions under 37 CFR 1.182 filed in the '556 and '876 proceedings, the patent owner requests that these proceedings be stayed or not merged with the '518 proceeding. In support of its request to stay the '556 and '876 proceedings, the patent owner argues that the prosecution of the '518 proceeding is well under way and that proceeding with the prosecution of the '556 and '876 proceedings would delay the prosecution of the '518 proceeding. The patent owner contends that the delay would be due to the possibility that the concurrent prosecution of the same claims from each proceeding may lead to different results. Furthermore, the patent owner argues that staying the '556 and '876 proceedings would permit the '518 proceeding to conclude more quickly in accordance with special dispatch. In the alternative, the patent owner requests that the Office not merge the '556 and '876 proceedings with the '518 proceeding. In support of its requests for not merging these proceedings, the patent owner argues that merging these proceedings would also delay the prosecution of the '518 proceeding.

In response, the patent owner's arguments to stay or not merge the proceedings are found to be unpersuasive. Contrary to the patent owner's premise that the prosecution of the '518 proceeding is well under way, the prosecution of the '518 proceeding is still in the early stages of prosecution. Specifically, the Office issued a non-final Office action on March 2, 2011 in the '518 proceeding and the patent owner and the third party requester have respectively filed responses and comments on May 2, 2011 and June 1, 2011. No further action has been taken by the Office in the '518 proceeding. Therefore, merging the '556 and the '876 proceedings with the '518 proceeding at this point would not unduly delay the '518 reexamination proceeding. Furthermore, the Office does not have discretion to indefinitely suspend an *ex parte* reexamination proceeding pending conclusion of another reexamination proceeding. (*See*, *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988).)

Reexamination has been ordered in the '556, '876, and '518 proceedings for overlapping claims of the same patent. All proceedings are still pending and have not been terminated. In addition, in the '876 proceeding, the patent owner has waived the right to file a patent owner statement under 37 CFR 1.530.[1] Therefore, consideration of merger is now ripe.

MPEP 2686.01 points out:

---

[1] See page 2 of the April 2, 2011 Order granting *ex parte* reexamination in the '876 proceeding.

> Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with "special dispatch."

The 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. The general policy of the Office is that three reexamination proceedings will not be conducted separately, and at the same time, as to a particular patent. The rationale for this policy is (1) to prevent inconsistent, and possibly conflicting, amendments from being introduced into the three proceedings on behalf of the patent owner, (2) to provide a comprehensive examination of the patent based on the issues raised in the three proceedings, and (3) to expedite the prosecution of the three proceedings.

In this instance, based upon the record as a whole, it is found, based on the facts as they exist at present, that merger of the three proceedings should facilitate the orderly handling of the proceedings with special dispatch. Accordingly, the '518, '556, and '876 proceedings **are hereby merged**. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

III. THE SAME CLAIMS MUST BE MAINTAINED IN ALL THREE PROCEEDINGS

The patent owner is required to maintain the same claims (and specification) in all files throughout the merged proceeding. Currently the claims are identical for all three proceedings. Therefore a "housekeeping amendment" is NOT needed.

IV. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with two *inter partes* reexamination proceedings. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997, except that the rights of the requester of the '876 *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560.[2] The examiner will conduct reexamination in the merged proceeding for claims 1-9 of the '321 patent.

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

[2] Active participation of the *ex parte* requester ends with the reply pursuant to 37 CFR 1.535 or the expiration of the time period for such reply. As such period has expired, further submissions on behalf of the *ex parte* requester will not be acknowledged or considered. *See* 37 CFR 1.550(g).

Upon merger of proceedings, all *inter partes* requesters can comment pursuant to 35 U.S.C. 314(b)(2).[3] First, an *inter partes* requester's right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, an *inter partes* requester's right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requester's comments must be submitted within 30 days from the date of service of the patent owner's response.

No *inter partes* requester has a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but not raised in the most recent Office action or response) or the request and comments from another requester.

2. Appeal Rights:

A discussion of an *inter partes* requester's appeal rights can be found in section G below.

C. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to all proceedings. All papers issued by the Office, or filed by the patent owner and the *inter partes* requesters, will contain the identifying data for all proceedings and will be physically entered in each reexamination file. All papers filed by the patent owner and the *inter partes* requesters must consist of a single paper, **filed in triplicate**, each bearing a signature and identifying data for all files, for entry into each file.

All papers filed by the patent owner and the *inter partes* requesters should be directed:

by Mail to:	Attn: Mail Stop "*Inter Partes* Reexam" Central Reexamination Unit Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450
by FAX to:	(571) 273-9900 Central Reexamination Unit
by Hand to:	Customer Service Window Attn: Central Reexamination Unit Randolph Building, Lobby Level 401 Dulany Street Alexandria, VA 22314

[3] Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the *inter partes* third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

by EFS: Registered users may submit papers via the electronic filing system EFS-Web, at: https://efs.uspto.gov/efile/myportal/efs-registered

The patent owner and the *inter partes* requesters are reminded that every paper filed (including papers filed *via* facsimile transmission) in the merged proceeding subsequent to this decision must be served on all the other parties, and every paper filed must reflect that such paper was served on all the other parties, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

D. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530, and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

E. Fees:

Where a paper is filed that requires payment of a fee (*e.g.*, petition fee, excess claims fee, extension of time fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner's appellant brief (or that of an *inter partes* reexamination requester) which may be filed, even though the brief relates to merged multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

F. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

G. Appeal Rights and Procedures Reminders for *Inter Partes* Reexamination

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP §§ 2674 through 2675 and 2678 through 2683.

With respect to the patent owner's notice of appeal, the appeal must only be taken from the rejection(s) of the claims in the Right of Appeal Notice (RAN) that the patent owner proposes to contest, and must identify each claim rejected by examiner that the patent owner intends to contest.

With respect to an *inter partes* requester's notice of appeal, the appeal must only be taken from the finding(s) of patentability of claims in the RAN that the *inter partes* requester proposes to contest. As set forth in MPEP § 2674, the *inter partes* requester must identify in the notice of appeal each rejection that was previously proposed by that *inter partes* requester that the *inter partes* requester intends to contest and each rejection made and later withdrawn by the examiner that the *inter partes* requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the *inter partes* requester must identify each previously proposed rejection to be contested.

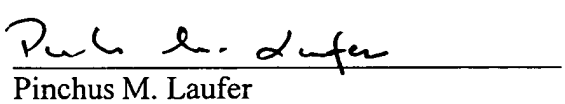
No new ground of rejection can be proposed by an *inter partes* requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the *inter partes* requester has not yet had an opportunity to propose it as an *inter partes* requester proposed ground of rejection. See 37 CFR 41.67(c)(1)(vi) as to the proposed rejections that an *inter partes* requester can challenge in the appellant brief.

It is to be noted that, because the '518 *inter partes* third party requester did not propose any rejections of claims 3-6, 8, and 9 in its request for reexamination, the '518 requester has no appeal rights as to those claims as they appear in the '321 patent.

CONCLUSION

1. *Ex parte* Reexamination Control No. 90/009,876 and *inter partes* Reexamination Control Nos. 95/001,518 and 95/001,556 are **merged into a single proceeding**, to be conducted in accordance with the procedure set forth above in Part IV of this decision.

2. Any questions concerning this communication should be directed to Susy Tsang-Foster, Legal Advisor, at 571-272-7711.



Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

February 21, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,560	03/01/2011	7426720	13557.105125	8687

25226 7590 05/06/2011
MORRISON & FOERSTER LLP
755 PAGE MILL RD
PALO ALTO, CA 94304-1018

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 05/06/2011

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patents and Trademark Office
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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KING & SPALDING
1180 PEACHTREE STREET, N.E.
ATLANTA, GA 30309-3521

Date:
MAILED

MAY 06 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001560
PATENT NO. : 7426720
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

Decision on Petition for Extension of Time in Reexamination	Control No.: 95/001,560

1. THIS IS A DECISION ON THE PETITION FILED 29 April 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:
   A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS
   Patent owner requests that the period for responding to the Office action dated 18 April 2011 which sets a one (1) month period for filing a response to the Office action, be extended by one (1) month.

   A. ☒ Petition fee per 37 CFR §1.17(g)):
      i. ☐ Petition includes authorization to debit a deposit account.
      ii. ☐ Petition includes authorization to charge a credit card account.
      iii. ☐ Other: _____.
   B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
   C. ☒ Petition was timely filed.
   D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)
   A. ☐ Granted or ☐ Granted-in-part for one (1) month, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
   B. ☐ Other/comment: see attached
   C. ☒ Dismissed because:
      i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
      ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
      iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
      iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
      v. ☒ The petition is moot.
      vi. ☒ Other/comment: petition is moot because of re-mailing of non-final and resetting of time period.

5. CONCLUSION

   Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611. In his/her absence, calls may be directed to Eric Keasel at 571-272-4929 in the Central Reexamination Unit.

/Mark Reinhart/	SPE, AU 3992 Central Reexamination Unit
[*Signature*]	(Title)

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JUL 18 2011

CENTRAL REEXAMINATION UNIT

FISH & RICHARDSON P.C. (DC)
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

(For Patent Owner)

MICHAEL A. HAWES
910 LOUISIANA, ONE SHELL PLAZA
HOUSTON, TX 77002

(For Third Party Requester)

In re Kim et al.	:	
Inter Partes Reexamination Proceeding	:	**DECISION ON**
Control No. 95/001,562	:	**PETITION UNDER**
Filed: March 3, 2011	:	**37 CFR 1.181 & 1.927**
For: U.S. Patent No. 7,520,139	:	

The paper filed by requester on June 20, 2011, entitled "Petition under 37 C.F.R. §§ 1.927 and 1.181 for the Director to Review the Refusal to Order Reexamination for Claims 9-17 and 29-34," (hereinafter the Petition) is before the Director of TC 1600, who oversees the Central Reexamination Unit (CRU). Petitioner, the reexamination requester, seeks review of the Order Denying-In-Part the Request for *Inter Partes* Reexamination mailed May 19, 2011.

The Petition is **GRANTED-IN-PART**.

REVIEW OF FACTS

1. U.S. Patent No. 7,520,139 (hereinafter, the '139 patent) issued on April 21, 2009.

2. A request for *inter partes* reexamination was filed by a third party requester, on March 3, 2011. The resulting reexamination proceeding was assigned Control No. 95/001,562 (hereinafter, the '562 proceeding). Reexamination was requested for claims 1-34 of the '139 patent.

3. A Notice of Reexamination Request Filing Date for the '562 proceeding was issued on March 10, 2011.

4. An order denying-in-part the request for reexamination for claims 1-34 in the '562 proceeding was mailed on May 19, 2011. A first Office action on the merits was mailed on the same day.

5. On June 17, 2011, the third party requester filed a Petition under 37 CFR §§ 1.181 and 1.927 in the '562 proceeding. The petition was not signed in accordance with 37 CFR 1.4(d)(2).

6. On June 20, 2011, the third party requester filed the present corrected Petition under 37 CFR §§ 1.181 and 1.927 in the '562 proceeding, which was properly signed.

Petitioner's Grounds in Support of the Requested Relief

Petitioner (the third party requester) alleges that the examiner's denial-in-part of the request for reexamination is inconsistent with Office policy and procedures. Specifically, the petitioner advances the examiner incorrectly concluded that the request in the '562 proceeding does not raise a substantial new question of patentability (SNQ) for claims 9-17 and 29-34. The examiner determined that request in the '562 proceeding only raised SNQs for claims 1-8 and 18-28 based upon the new teachings presented by the Yuida and Pink references. See pages 7-9 of the order mailed May 19, 2011.

DECISION

I. Standard of Review

35 USC § 312(c) and 37 CFR 1.927 provide for the filing of a petition to review an examiner's determination refusing to order *inter partes* reexamination. The CRU Director's review on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination for claims 9-17 and 29-34 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the

examiner's rationale for the denial of the request to order reexamination for claims 9-17 and 29-34 of the '139 patent.

II. The Legal Standard for Ordering Reexamination

A review of 35 USC §§ 311-317 and 37 CFR 1.915, 1.919, and 1.923 shows that *inter partes* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. In particular, 35 USC 311(a) requires that a request for *inter partes* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.915(b)(3) requires that a request for *inter partes* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final holding of invalidity after all appeals, or by the Office in a previous examination or in a reexamination of a patent.

In accordance with this legislative history for the original reexamination statute,[1] MPEP 2642, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier examination(s), in view of a material new argument or interpretation presented in the request." This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. For example, a reference may be read in a "new light" if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent. If a substantial new question of patentability is found, an order for *inter partes* reexamination of the patent is issued. An SNQ is not raised by the old prior art if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to the patent and has decided that question in favor of the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

---

[1] Public Law 96-517, enacted on December 12, 1980.

III. Analysis of the Request for Reexamination in the '562 proceeding

The request in the '562 proceeding sets forth eighteen proposed rejections asserted to be supported by substantial new questions (SNQs) of patentability based upon the new technical teachings presented by the Yuida and Pink references. See pages 11-12 and 16-17 of the request, which only asserts SNQs based upon the Yuida reference for proposed rejections identified as SNQ #1-9, and pages 13-14 and 18-19, which only asserts SNQs based upon the Pink reference for proposed rejections identified as SNQ #10-18.

The request was denied-in-part in the May 19, 2011 order, wherein the examiner determined that a SNQ was not raised by Yuida and Pink for independent claims 9 and 29 because neither reference taught the "shared wall" limitation found to be missing in the prior examination. See pages 4-5 of the order that summarize the prior examinations. Specifically, for claims 9 and 29, Yuida and Pink failed to teach an ice compartment in the refrigerating compartment with one or more shared insulating walls being configured to define a portion of the ice compartment and a portion of the refrigerating compartment (the "shared wall" limitation). See pages 7-9 of the order. The examiner stated that the Najewicz reference was applied to the claims in the prior examination, but the Najewicz reference was found to not teach the shared wall limitation. In other words, the request was applying the Najewicz reference to answer the same question of patentability already addressed in the prior examination. The examiner also determined that the request did not assert a SNQ based on the teachings of the other cited references (e.g., Buscher, Frick, Cur, or Yasuzo) for independent claims 9 and 29. Therefore, the examiner determined that the request did not present a SNQ for independent claims 9 and 29 and its dependent claims. Thus, the order held that the request only raised a SNQ for independent claims 1 and 18 and its dependent claims.

As pointed out above, 37 CFR 1.927 provides for the filing of a petition to review an examiner's determination refusing to order *inter partes* reexamination. The Director reviews the request *de novo* in response to the petition, and such a review of the record, as a whole, has been made in this case. Petitioner advances that the examiner erred by not finding a SNQ for dependent claims 13-15 and not finding a SNQ based upon the teachings of the Cur, Yasuzo, or Najewicz references.

A. Dependent Claims 13-15

A review of record shows that the May 19, 2011 order mistakenly assumed that claims 13-15 depend from independent claim 9, and therefore, denied reexamination of these claims based upon the SNQ analysis performed for claim 9. Claims 13-15 of the '139 patent, however, depend from claim 1 of the '139 patent. Therefore, based upon the granting of reexamination for independent claim 1, reexamination should have been granted for dependent claims 13-15. Accordingly, the June 20, 2011 petition is granted-

in-part to the extent that this reexamination proceeding will include examination of claims 13-15.

In summary, the May 19, 2011 order is modified by this decision as follows:

1. Reexamination is granted for claims 1-8, 13-15, and 18-28 based upon a new technical teaching raised by the Yuida reference, for the reason stated on page 7 of the May 19, 2011 order.

2. Reexamination is granted for claims 1-8, 13-15, and 18-28 based upon a new technical teaching raised by the Pink reference, for the reason stated on pages 8-9 of the May 19, 2011 order.

B. Cur, Yasuzo, and Najewicz References

Turning to the Request, it is first noted that the request is clear that the asserted SNQs are only based on the teachings of Yuida and Pink. See pages 11-19 of the request. Petitioner now asserts that Cur, Yasuzo, and Najewicz raise SNQs for claims 9-12, 16, 17, and 29-34 and points to their detailed explanation for how the references are applied in the proposed rejections to the claim limitation for support in the request. See pages 5-10 of the petition. However, the asserted SNQs must be separately identified and discussed from the detailed explanation of the proposed rejection in order to meet the filing date requirements in *inter partes* reexamination. See MPEP 2616. Therefore, upon review of the request, the director finds that the examiner did not err in determining that the request only asserted SNQs based upon the teachings of Yuida and Pink.

A review of the prior examination records reveals that independent patent claim 9 was dependent claim 10 in the application that issued as the '139 patent. Claim 10 contained the limitations "wherein the ice compartment being defined within the refrigerating compartment by one or more insulating walls includes the ice compartment being defined within the refrigerating compartment by one or more shared insulating walls, the one or more shared insulating walls being configured to define a portion of the ice compartment and a portion of the refrigerating compartment," and depended on claim 1. Claim 10 was objected to for being dependent on a rejected base claim but indicated as having patentable subject matter. Claim 1 was rejected based, in-part, on the teachings of the Najewicz reference. Specifically, the examiner recognized that Najewicz teaches a refrigerator with an ice compartment 26 within the refrigerating compartment. See page 2 of the October 10, 2008 Office action. Therefore, a review of the records show that the examiner properly determined that the limitations found in application claim 10 (e.g., the shared wall limitations) were the limitations determined to be missing from the cited prior art, including the Najewicz reference applied against the claims, in the prior examination. Patent claim 29 was introduced as new claim 30 in the January 6, 2009 amendment. No rejection was made on this claim. Claim 30

included the shared wall limitations, like claim 10, and did not include similar limitations regarding the ice discharge duct defining the portion of the ice flow passage through a front of the insulating walls of the ice compartment as in patent claims 1 and 18. Accordingly, the examiner's determination that patent claim 29 was allowed because the prior art failed to teach the shared wall limitation is consistent with the records of the prior examinations. Therefore, the director finds no error in the examiner's determination that the shared wall limitations were the limitations of claims 9 and 29 that the prior art failed to teach in the prior examinations. In other words, a reference must have teachings relevant to the shared wall limitations in order to raise a SNQ for independent claims 9 and 29. The request fails to clearly assert a SNQ based upon new technical teachings relevant to the shared wall limitations of claims 9 and 29. Instead the request focuses the SNQ analysis on the ice discharge duct defining a flow passage through the front of the insulating walls, which are limitations found to be missing in patent claims 1 and 18 in the prior examination. See pages 11-19 of the request. Therefore, the request fails to show that any of the cited references have new, non-cumulative teachings relevant to the shared wall limitation in the SNQ discussion.

Furthermore, even if the request is deemed to have asserted a SNQ based on the teachings of Cur, Yasuzo, or/and Najewicz, the *de novo* review of the records show that these references do not present any new technical teachings regarding the shared wall limitations. Specifically, Cur and Yasuzo have teachings of a refrigerator that has an ice compartment within the refrigerating compartment substantially similar to Najewicz's teachings, which were recognized by the examiner in the prior examination, as discussed in the above paragraph. See, e.g., page 47 of the request, which applied Najewicz's teachings to the shared wall limitations and pages 115 and 182 of the request, which apply Cur and Yasuzo, respectively, to the shared walled limitations. The request fails to explain how Cur and Yasuzo present a new, non-cumulative teaching relevant to the shared wall limitations of claims 9 and 29 that is different from Najewicz's teaching, which was applied in the prior examination. The request also fails to show how Najewicz's teachings are applied in a new light. Therefore, the request in the '562 proceeding has failed to clearly assert a SNQ based on Cur, Yasuzo, or Najewicz for claims 9 and 29 by showing new technical teachings, or a new light, not considered in a prior examination. In other words, the technical teachings of Cur, Yasuzo, and Najewicz, asserted in the petition as raising a SNQ, would not be important to a reasonable examiner in determining the patentability of the claims because the references raise the same question of patentability that was already considered in the prior examination.

For the reasons stated above, the director has reviewed the entire record, and has determined that the examiner properly determined that the request failed to raise substantial new question of patentability for claims 9-12, 16, 17, and 29-34. As stated above, reexamination is limited to review of **new information** about preexisting **technology** that may have escaped review at the time of the initial examination of the

patent application. Without a showing of a new technological teaching that was not present in the prior examination, the Office does not have the jurisdiction to order reexamination for claims 9-12, 16, 17, and 29-34. Therefore, the examiner correctly concluded that the cited references failed to raise a substantial new question of patentability with respect to the claims 9-12, 16, 17, and 29-34. The examiner did err in not finding a SNQ for dependent claims 13-15. Accordingly, the petition is GRANTED-IN-PART, and reexamination is hereby ordered for claims 13-15 in addition to claims 1-8 and 18-28 as determined by the May 19, 2011 order.

CONCLUSION

1. Based on a *de novo* review of the record as a whole, the **PETITION is GRANTED-IN-PART**.

2. Accordingly, the request for *inter partes* reexamination of claims 1-8, 13-15, and 18-28 of the '139 patent is GRANTED.

3. **The first Office action on the merits mailed May 19, 2011 is hereby vacated**.

4. A corrected first Office action on the merits, consistent with this decision, will be mailed in due course.

5. This decision is final and nonappealable. 37 CFR 1.927. No further communication on this matter will be acknowledged or considered.

6. Telephone inquiries related to this decision should be directed to Andres Kashnikow, Supervisory Patent Examiner, at (571) 272-4361.

Irem Yucel, Director
Technology Center 1600

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,565	03/04/2011	7149549	080200-0293	3758

64064 7590 04/01/2011

ORTIZ & LOPEZ, PLLC
P.O. BOX 4484
ALBUQUERQUE, NM 87196-4484

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 8-18-11

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
George C. Beck
FOLEY & LARDNER, LLP
3000 K Street, NW, Suite 500
Washington, DC 20007

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001565
PATENT NO. : 7149549
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

(For Patent Owner)

ORTIZ & LOPEZ, PLLC
P.O. BOX 4484
ALBUQUERQUE NM 87196-4484

(For Requester)

FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

(Courtesy Copy)

LOWE GRAHAM JONES, PLLC
701 FIFTH AVENUE
SUITE 4800
SEATTLE WA 98104

In re: Ortiz *et alia*	:
Reexamination Proceeding	: **DECISION**
Control No. 95/001,565	: **DISMISSING**
Request Deposited: March 4, 2011	: **PETITION**
For: U.S. Patent No. 7,149,549	:

This is a decision on the June 27, 2011 paper entitled "PETITION TO STRIKE UNDER 37 C.F.R. 1.182".

Petitioner requests the Office strike the May 26, 2011 paper. However, the Notification of Defective Paper mailed July 13, 2011 found the May 26, 2011 paper defective. 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.

3. This decision is not a final agency decision and is without prejudice to request reconsideration or higher-level review.

Eric Keasel
SPE, AU 3992, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,565	03/04/2011	7149549	080200-0293	3758

64064 7590 04/01/2011

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Date: 8-18-11

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Washington, DC 20007

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001565
PATENT NO. : 7149549
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

Ortiz & Lopez, PLLC
P.O. Box 4484
Albuquerque, NM 87196-4484

(For Patent Owner)

Foley & Lardner, LLP
3000 K. Street, NW, Suite 600
Washington, DC 20007

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,565
Filed: March 4, 2011
For: U.S. Patent No. 7,149,549

DECISION DISMISSING PETITION

This is a decision on the June 27, 2011 third party requester's petition paper entitled "PETITION UNDER 37 C.F.R 1.183".

The petition is before the Office of Patent Legal Administration for decision.

The petition is **dismissed as moot**, for the reasons set forth below.

DECISION

In the instant petition, third party requester requests waiver of the page limit requirement of 37 CFR 1.943(b) for its comments submission filed on June 27, 2011. On July 13, 2011, the Office mailed a "NOTICE RE DEFECTIVE PAPER IN INTER PARTES REEXAMINATION" (the notice of non-compliance), stating that patent owner's May 26, 2011 response submission is defective and setting a time period for patent owner to file a corrected response submission. Pursuant to MPEP § 2667(I)(A)(2), "Any previously submitted third party comments in response to [the] 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." Accordingly, requester's June 27, 2011 petition requesting waiver of 37 CFR 1.943(b) for its concurrently-filed comments submission is dismissed as moot.

Given that the requester statutorily has no right to file a comments submission, requester's June 27, 2011 comments submission is being expunged from the record. 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. Once the patent owner files a compliant response, then under 37 CFR 1.947, requester may file written comments, limited to issues raised by the Office action or the patent owner's response submission, which may be accompanied by a renewed requester petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b). In the event the requester files a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), no additional fee need be submitted.

A one-time courtesy copy of this decision is being mailed, consistent with the communication entitled "COMMUNICATION REGARDING PATENT OWNER'S CORRESPONDENCE ADDRESS", mailed on date even herewith, to the address below:

Foster Pepper PLLC
1111 3rd Avenue Suite 3400
Seattle, WA 98101-3299

CONCLUSION

1. Third party requester's June 27, 2011 petition paper entitled "PETITION UNDER 37 C.F.R 1.183" is dismissed as moot.

2. Requester's June 27, 2011 comments submission is being expunged from the record. Because these papers have been scanned into the Office's 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.

3. Telephone inquiries with regard to this decision should be directed to Nicole D. Haines, Legal Advisor, at (571) 272-7717.

Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

08-17-2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,565	03/04/2011	7149549	080200-0293	3758

64064 7590 04/01/2011

ORTIZ & LOPEZ, PLLC
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EXAMINER

ART UNIT	PAPER NUMBER

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Date: 11-4-11

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3000 K Street, NW, Suite 500
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Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001565
PATENT NO. : 7149549
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.
95/001,565	03/04/2011	7149549	206182-14000-101	3758

16579 7590 11/04/2011

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EXAMINER

ART UNIT	PAPER NUMBER

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ORTIZ & LOPEZ, PLLC P.O. BOX 4484 ALBUQUERQUE, NM 87196-4484	:	(For Patent Owner)
FOLEY & LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007	:	(For Third Party Requester)
FOSTER PEPPER PLLC 1111 THIRD AVENUE SUITE 3400 SEATTLE, WA 98101	:	(Courtesy Copy)
In re: Ortiz *et al.* *Inter Partes* Reexamination Proceeding Control No.: 95/001,565 Deposited: March 4, 2011 For: U.S. Patent No.: 7,149,549	:	DECISION ON PETITION UNDER 37 CFR § 1.181

This is a decision on a petition filed by the patent owner on August 12, 2011, entitled: "PATENT OWNER'S PETITION UNDER 37 C.F.R. § 1.181 TO REQUEST WITHDRAWAL OF THE JULY 13, 2011 NOTICE OF DEFECTIVE PAPER" [hereinafter "the petition"].

The petition is a request to the Director to exercise his discretion pursuant to 37 CFR § 1.181 to review the examiner's action of holding a response as defective.

The petition is before the Director of the Central Reexamination Unit. The petition is granted in part.

This decision also addresses patent owner's petition filed August 29, 2011, requesting that portions of a third party comments submission be redacted or stricken from the record. That petition is dismissed as moot because the third party submission has already been expunged.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,149,549 issued on December 12, 2006.
- A request for *inter partes* reexamination was filed on March 4, 2011 and assigned control no. 95/001,565.
- *Inter partes* reexamination was ordered and a rejection was mailed on April 1, 2011.
- On May 26, 2011, patent owner responded to the Office action.
- On June 27, 2011, the third party requester filed comments to the patent owner's response. On that same date the third party filed a petition to waive the page limit for its comments, and also filed a petition to strike patent owner's response.
- On July 13, 2011, the examiner issued a notice of defective paper holding patent owner's May 26, 2011 non-compliant due improper numbering, lack of discussion of support for claim amendments, and for being too long.
- On August 12, 2011 patent owner filed the instant petition for withdrawal of the notice of defective paper.
- On August 18, 2011, the Office dismissed each of the third party's petitions of June 27.
- On August 29, 2011, patent owner filed a petition to redact/strike portions of the June 27 comments submission.

DECISION

August 12, 2011 Petition

In the August 12, 2011 petition, the patent owner requests withdrawal of the July 13, 2011 Notice from the proceeding record. Patent owner alleges that the July 13, 2011 Notice was not permitted because the Notice is not in accordance with reexamination laws and policies. See, e.g., pages 1-3 of the petition. Patent owner also asserts that even if the July 13, 2011 Notice was proper, the requester does not have opportunity to submit comments. See pages 3-4 of the petition. In addition, patent owner argues that the July 13, 2011 Notice ". . . would violate basic Constitutional principals [sic] of fair play." See pages 4-5 of the petition. Finally, patent owner

alternatively requests waiver under 37 CFR § 1.183 of the page limit requirement of 37 CFR 1.943(b). See page 5 of the petition. For these reasons, patent owner asserts that the July 13, 2011 Notice should be expunged from the proceeding record.

First, the portion of the petition regarding relief under 37 CFR § 1.183 is procedurally dismissed under 37 CFR § 1.4(c). The petition improperly combines different subjects into a single petition, which is not in compliance with the requirements of 37 CFR § 1.4(c).

In regard to patent owner's assertion that the July 13, 2011 Notice is an unauthorized action, the instructions in MPEP 2666.05 require the examiner to notify the patent owner of the reasons for noncompliance and to give the patent owner an additional opportunity to file replacement response. Upon review of the record, the director finds that the July 13, 2011 Notice appropriately determined that patent owner's May 26, 2011 response submission exceeded the 50 page limit of 37 CFR § 1.943(b). Specifically, the response itself was 45 pages. In addition, as described in more detailed in a new Notice, more than five pages of the over 100 pages of declarations contain legal arguments and therefore, are counted in the 50 page limit. However, the explanation provided in the July 13, 2011 notice did not clearly explain the basis for its determination, and for this reason, the Notice is vacated. A new Notice Re Defective Paper will be mailed contemporaneously with this decision that provides a clear basis for the determination that the May 26, 2011 response submission is noncompliant with Office regulations. The new Notice will give the patent owner an opportunity to submit a replacement response submission in compliance with Office regulations.

In regard to patent owner's argument that requester is not permitted to file comments, patent owner is correct that the statute only permits comments to a patent owner's response to an action on the merits, and the Notice of Defective Paper is not such an action. Of course, no such comments have been filed, and the Office has therefore not accepted any improper comments. Yet, patent owner complains because the Transmittal of Communication form apparently invites improper comments. This is a standard Office form used in all *inter partes* reexamination actions, therefore the act of the examiner (or the mailing paralegal as the case may be) in using this form was not improper. An Office action does not in itself create any rights beyond what the statute explicitly provides, therefore to the extent the form is not entirely accurate in all circumstances this is a harmless error. The new contemporaneous Notice will almost certainly include such statements as well, and again such statements will not serve to extend rights to the parties beyond the statute. Patent owner is advised not to petition such issue again as it will be summarily dismissed <u>unless</u> the third party actually files an improper submission, and/or the Office actually accepts such improper submission.

In regard to patent owner's fundamental fairness arguments, the director does not find these arguments persuasive for the following reasons. The reexamination 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 enable special dispatch by limiting responses by patent owners and comments by requesters. In addition, the rules and procedures permit waiver of the page limit and extensions of time in appropriate circumstances. Furthermore, the rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing an action. The record shows that the examiner followed Office procedures by issuing the July 13, 2011 Notice and giving the patent owner another chance to submit a compliant response. Therefore, the record does not show that the July 13, 2011 Notice denied patent owner its Constitutional rights or is fundamentally unfair. Accordingly, the record shows that the examiner appropriately followed Office rules and procedures in the determination to issue the July 13, 2011 Notice, and did not categorically deprive the patent owner of its statutory rights to present amendments, evidence, and arguments in reexamination proceedings.

For these reasons, the Patent Owner's August 12, 2011 petition is granted-in-part to the extent that the July 13, 2011 Notice is vacated and a clarified Notice of noncompliance will be mailed contemporaneously with this decision.

August 29, 2011 Petition

In the August 29, 2011 petition the patent owner makes numerous arguments concerning the third party's comments submission. Patent owner is invited to re-read the Decision mailed August 18, 2011 by the Office of Patent Legal Administration, concerning the third party's petition under 37 CFR § 1.183. As stated in that decision, the papers that patent owner complains of have already been expunged from the record, therefore the petition is dismissed as moot.

Additionally, the papers filed with the petition, which are a re-filing of those already expunged from the record with proposed redactions, are likewise expunged.

POWER OF ATTORNEY & CORRESPONDENCE ADDRESS ISSUES

The power of attorney and change of correspondence address communications, filed June 15, 2011 and August 11, 2011, are ineffective because the communications were not filed in the file for the '549 patent. See the "Communication Regarding Patent Owner's Correspondence Address," mailed on August 18, 2011. For this reason, the "Notice of Acceptance of Power of Attorney," mailed on August 25, 2011, was improper, and is hereby, vacated.

The current power of attorney and correspondence address in this reexamination proceeding remains Ortiz & Lopez, PLLC, P.O. Box 4484, Albuquerque, NM 87196-4484. All future

Office correspondence will be mailed to the above-mentioned address. As a courtesy, in light of the improper mailing of the "Notice of Acceptance of Power of Attorney," a copy is also being mailed to Foster Pepper PLLC at the address listed in the petition.

Patent owner is again called upon to file any change of power of attorney and correspondence address in the patent file (Application No. 09/708,776) in order to properly effectuate a change in this reexamination proceeding. Patent owner should not expect any further courtesy copies, as it has been put on notice several times about the proper manner of effectuating its address and power of attorney changes.

CONCLUSION

1. Patent owner's petition filed August 12, 2011 is granted in part to the extent that the July 13, 2011 Notice is vacated and a clarified Notice will be mailed contemporaneously with this decision.

2. Patent owner's May 26, 2011 response submission will be expunged and marked "closed" and "non-public" to remove the submission from the reexamination record.

3. Patent owner's petition filed August 29, 2011 is dismissed as moot.

4. The submissions with the August 29 petition that are redacted versions of the already-expunged third party comments are likewise expunged.

5. The August 25, 2011 Office notice regarding power of attorney is vacated.

6. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.

Irem Yucel
Director, Central Reexamination Unit

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95/001,565	03/04/2011	7149549	206182-14000-101	3758

64064 7590 01/26/2012

ORTIZ & LOPEZ, PLLC
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ALBUQUERQUE, NM 87196-4484

EXAMINER

ART UNIT	PAPER NUMBER

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16579 7590 01/26/2012

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3000 K Street, NW, Suite 500
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Date: **MAILED**

JAN 26 2012

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001565
PATENT NO. : 7149549
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

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JAN 26 2012

CENTRAL REEXAMINATION UNI

ORTIZ & LOPEZ, PLLC
P.O. BOX 4484
ALBUQUERQUE, NM 87196-4484

(For Patent Owner)

GEORGE C. BECK
FOLEY & LARDNER, LLP
3000 K STREET, NW, SUITE 500
WASHINGTON, DC 20007

(For Third Party Requester)

FOSTER PEPPER, PLLC
1111 3RD AVENUE SUITE 3400
SEATTLE, WA 98101-3299

(Courtesy Copy)

Inter Partes Reexamination Proceeding
Control No. 95/001,565
Filed: March 4, 2011
For: U.S. Patent No. 7,149,549

DECISION
DISMISSING
PETITION

This is a decision on the patent owner's petition under 37 CFR 1.183 requesting waiver of the page limit requirement of 37 CFR 1.943(b), filed on November 21, 2011.

The patent owner's petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

For the reasons set forth below, the patent owner's petition under 37 CFR 1.183 is **dismissed.**

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).

In the present petition under 37 CFR 1.183, the patent owner requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for the patent owner's response filed on May 26, 2011.

On November 4, 2011, the Office issued a "Notice of Re Defective Paper" stating that the patent owner's May 26, 2011 response exceeded the 50-page limit requirement of 37 CFR 1.943(b). [1] On November 21, 2011, the patent owner filed a petition under 37 CFR 1.181 requesting that the Office withdraw the "Notice of Re Defective Paper." Since the patent owner's November 21, 2011 § 1.181 petition has not yet been decided, the instant patent owner petition under 37 CFR 1.183 is premature; if the patent owner's § 1.181 petition should be granted, then the present patent owner petition requesting waiver of the requirement of 37 CFR 1.943(b) would be moot, since there would be no need to consider waiver of a rule.[2] The patent owner retains the option of seasonably filing a renewed petition under 37 CFR 1.183 requesting waiver of the requirement of 37 CFR 1.943(b) for its response to the April 1, 2011 non-final Office action should the decision on the § 1.181 petition be not to grant the petition, and reconsideration of such a decision is not requested. Until such time, the issue is not ripe for consideration by the Office under 37 CFR 1.183. When no further petition under 37 CFR 1.181 is filed by the patent owner to withdraw the November 4, 2011 Notice of Defective paper, patent owner may renew the present petition under 37 CFR 1.183.

In view of the above, the petition under 37 CFR 1.183 is dismissed as premature.

PATENT OWNER'S CORRESPONDENCE ADDRESS

37 CFR 1.33(c) provides (emphasis added):

> All notices, official letters, and other communications for the patent owner or **owners in a reexamination proceeding will be directed to the correspondence address.** Amendments and other papers filed in a reexamination proceeding on behalf of the patent owner must be signed by the patent owner, or if there is more than one owner by all the owners, or by an attorney or agent of record in the patent file, or by a registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34. **Double correspondence with the patent owner or owners and the patent owner's attorney or agent, or with more than one attorney or agent, will not be undertaken.**

The correspondence address for the patent to be reexamined, or being reexamined is the correct address for all notices, official letters, and other communications for patent owners in reexamination proceedings.[3] In the instant case, the patent owner is called upon to clarify and

[1] It is noted that a copy of the original patent owner's response filed concurrently with the November 21, 2011 petition under 37 CFR 1.181 is unsigned.
[2] That is, if relief is granted under 37 CFR 1.181 to withdraw the November 4, 2011 Notice of Defective paper, then the present request to waive the page limit requirement of 37 CFR 1.943(b) for the patent owner response would be moot .
[3] *See* MPEP 2622

coordinate the proper correspondence addresses in (1) the 7,149,549 patent and (2) the 95/001,565 reexamination proceeding. Different patent owner addresses are currently of record for the patent and the reexamination proceeding.

Furthermore, the power of attorney filed on November 16, 2011 in this reexamination proceeding was incorrectly accepted on December 2, 2011. The power of attorney filed did not include a proper 37 CFR 3.73(b) statement from the assignee.[4] The 37 CFR 3.73(b) statement filed on May 26, 2011 in this reexamination proceeding is deficient because it does not state the extent of assignee's interest in the patent. Therefore, the acceptance of power of attorney on December 2, 2011 is hereby rescinded, and such will be processed in due course by the Central Reexamination Unit. Further, to correspond to the correspondence address for the patent being reexamined, the correspondence address found of record in this reexamination proceeding is being changed to that for the patent file (i.e., Ortiz & Lopez, PLLC, P.O. Box 4484, Albuquerque, NM 87196-4484) pursuant to 37 CFR 1.33(c). As a courtesy, a copy of this decision is also being mailed to Foster Pepper, PLLC at the address listed on the November 21, 2011 patent owner petition under 37 CFR 1.183. Patent owner should not expect any further courtesy copies, as it has been put on notice several times about the proper manner of effectuating its address and power of attorney changes.

CONCLUSION

1. The patent owner petition under 37 CFR 1.183 filed on November 21, 2011 is dismissed as being premature.

2. **Parties are put on NOTICE that the correspondence address for the present reexamination proceeding is Ortiz & Lopez, PLLC, P.O. Box 4484, Albuquerque, NM 87196-4484), pursuant to 37 CFR 1.33(c). As pointed out above, a copy of this decision is also being mailed to Foster Pepper, PLLC at the address listed on the November 21, 2011 patent owner petition. Patent owner should not expect any further courtesy copies, as it has been put on notice several times as to the proper manner of effectuating its address and power of attorney changes.**

3. Telephone inquiries related to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

/Kenneth M. Schor/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

01-25-201201-25-2012; pet3/

[4] It is noted that the power of attorney filed on November 16, 2011 in the 7,149,549 patent file was denied on November 29, 2011 because a 37 CFR 3.73(b) statement was not received from the assignee.

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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.
95/001,565	03/04/2011	7149549	206182-14000-101	3758

64064 7590 02/03/2012

ORTIZ & LOPEZ, PLLC
P.O. BOX 4484
ALBUQUERQUE, NM 87196-4484

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/03/2012

Please find below and/or attached an Office communication concerning this application or proceeding.

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
George C. Beck
FOLEY & LARDNER, LLP
3000 K Street, NW, Suite 500
Washington, DC 20007

Date:

MAILED

FEB 0 3 2012

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001565
PATENT NO. : 7149549
TECHNOLOGY CENTER : 3999
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If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

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CENTRAL REEXAMINATION UNIT

ORTIZ & LOPEZ, PLLC P.O. BOX 4484 ALBUQUERQUE, NM 87196-4484	: : :	(For Patent Owner)
FOLEY & LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007	: : : :	(For Third Party Requester)
In re: Ortiz *et al.* *Inter Partes* Reexamination Proceeding Control No.: 95/001,565 Deposited: March 4, 2011 For: U.S. Patent No.: 7,149,549	: : : : :	DECISION ON PETITION UNDER 37 CFR § 1.181

This is a decision on a petition filed by the patent owner on November 21, 2011, entitled: "PATENT OWNER'S PETITION UNDER 37 C.F.R. § 1.181" [hereinafter "the petition"].

The petition is a request to the Director to exercise his discretion pursuant to 37 CFR § 1.181 to review the examiner's action of holding a response as defective.

The petition is before the Director of the Central Reexamination Unit. The petition is denied.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,149,549 issued on December 12, 2006.
- A request for *inter partes* reexamination was filed on March 4, 2011 and assigned control no. 95/001,565.
- *Inter partes* reexamination was ordered and a rejection was mailed on April 1, 2011.
- On May 26, 2011, patent owner responded to the Office action.
- On July 13, 2011, the examiner issued a notice of defective paper holding patent owner's May 26, 2011 response non-compliant.
- On August 12, 2011 patent owner filed a petition for withdrawal of the notice of defective paper.
- On November 4, 2011, the Office granted the August 12 petition, and the examiner issued a new notice of defective paper holding the response non-compliant for lack of clarity and for being greater than the permissible length.
- On November 21, 2011 patent owner replied to the notice and filed the instant petition requesting withdrawal of the notice.
- A petition to waive the page limit requirement was also filed November 21, 2011, and was dismissed as premature on January 26, 2012.

POWER OF ATTORNEY & CORRESPONDENCE ADDRESS ISSUES

This paper is being mailed to the address of record in the patent. Patent owner has been told several times how to effectuate an address change and not to expect further courtesy copies at addresses not of record in the patent. *See, e.g.*, Decision mailed January 26, 2012 at pp. 2-3.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.943 Requirements of responses, written comments, and briefs in *inter partes* reexamination (in part)

(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.

MPEP § 2667(I)(A)(2) provides, in pertinent part (emphasis added):

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

Patent owner ["petitioner"] requests withdrawal of the November 4, 2011 Notice of Defective Paper ["Notice"]. The Notice held that the May 26, 2011 response was longer than the page limit set forth in 37 CFR § 1.943(b), and also required "that the response to this Notice must have clearer and larger text because the response . . . is difficult to read and does not readily permit direct reproduction." Notice at p. 3. Petitioner argues that its numerous declarations should not count against the page limit because they are drawn to facts and not arguments, and

also argues that the response met the various formatting requirements of the Office and any lack of clarity was not the fault of petitioner. Petitioner also has re-filed the response electronically in an attempt to cure any scanning issues and has redacted some sentences of the declarations.

Regarding the clarity issue, the Director agrees that at least the newly electronically filed response of November 21 is of adequate quality and appears to meet the Office's various formatting requirements. Any requirement in the Notice as to the clarity of the response is therefore withdrawn.

As to the length, the Director does not agree that the petitioner has shown the examiner acted improperly in holding the response non-compliant. Petitioner argues that the entirety of each declaration is factual in nature, and not argument. Petitioner cites to various prior petition decisions throughout the petition, characterizing them as "binding precedent" supporting its position.

The Director does not necessarily concede that petition decisions are "precedent" that is binding on the Office, as characterized by petitioner. But in any event, most of the proceedings cited by the petitioner included the above quoted paragraph from MPEP § 2667(I)(A)(2) in a petition decision concerning page limits. See 95/000,469 Decision July 16, 2010 at 2-3; 95/000,396 Decision May 6, 2010 at 2-3; 95/000,397 Decision May 26, 2010 at 3; 95/000,398 Decision May 5, 2010 at 2-3. The only one that does not, 95/000,016 Decision July 14, 2004, was decided prior to the MPEP being revised to include said paragraph. *Compare* MPEP Eighth ed. Rev. 6, Sept. 2007, *with* Rev. 7, July 2008 at http://www.uspto.gov/web/offices/pac/mpep/old/index.htm To the extent there is an Office policy as to this issue that is "binding", it is set forth in the MPEP as quoted above, as that can be considered the Office's interpretation of its regulations. *See Molins PLC v. Textron Inc.*, 33 USPQ2d 1823, 1828 n.10 (Fed. Cir. 1995) (stating the MPEP, while not law, is entitled to notice as the official interpretation of statutes and regulations with which it does not conflict). Thus, rather than look to unrelated petition decisions, whose facts and relevance to this proceeding are not even explained by petitioner, we will look to the MPEP to determine what types of information do and do not fall within the page limit requirement.

The MPEP states that a declaration containing opinions as to whether the art does or does not anticipate or render obvious claims, or specific claim elements, of the patent under reexamination, counts against the page limit. MPEP § 2667(I)(A)(2). Any argument as to how a rejection would be overcome counts against the limit. *Id.* Any page including such argument counts against the limit. *Id.* The MPEP gives examples of the types of material that do not count against the page limit, such as factual evidence of the dates of invention or publication, secondary consideration evidence such as test data, or the like. For example, a declaration drawn solely to the commercial success of the invention is the type of declaration that does not count against the page limit. It is apparent that the MPEP does not envision as "factual" whether a

reference teaches a particular claim limitation, as that would be an opinion as to whether the art does or does not anticipate a claim element, which is explicitly included within the page limit.

Here the response itself, without considering the declarations, is at least 44 pages (pages 3-46, excluding introductory page 1, table of contents page 2, and signature page 47). The declarations include greater than six pages including argument, and thus the response is over the page limit.

The Gordon Declaration states that "ChoiceSeat was not a system for wirelessly receiving venue-based data at a hand-held device." Heading above ¶ 5 on p. 3. Gordon then says the requester is incorrect and that adapting ChoiceSeat to a wireless network (¶ 9 on p. 4) or to a hand-held client (¶ 10 on p. 5) would not have been obvious to a person of ordinary skill in the art. Gordon then states that the Choice seat system would have been significantly compromised if used wirelessly with a hand-held device. ¶ 12 on p. 6. Considering the claims are drawn to wirelessly receiving venue-based data at a hand-held device, all of these statements can be considered arguments as to why the art does not render the claims or claim elements obvious, and thus would be considered as falling under the page limit requirements. Thus, *at least* 4 pages of Gordon count against the limit.

The Javed Declaration at ¶ 10, pp. 5-6, explains that Bassett only mentions wireless networks in one sentence concerning satellite or microwave networks, and that use of wireless networks in hand held devices is far different. It is stated that this would not have been obvious to anyone reading the patent. Javed further states that just once is a notebook computer or PDA mentioned, but no explicit mention is made of a video stream over a wireless network. Javed concludes that it would not have been apparent to a person of ordinary skill in the art how video data streams are transferred from a wireless network to a receiving device. While none of this discussion directly mentions the claims, it is a clear discussion of why the reference does not render the claims unpatentable. Javed tells us that Verna does not transmit video over a data network to a server, which would be required to send it to a hand held device. ¶ 11 on p. 7. Javed additionally explains that Anderson cannot be combined with various other references. ¶ 12 on p. 8. At ¶ 13 (pp. 9-10) Javed tells us that Digital Video does not teach transmission of video data streams over wireless networks to handheld devices. All of these features that the references allegedly do not teach are related to the claims. Thus *at least* 6 pages of Javed count against the page limit.

The Matthews Declaration at ¶ 18 p. 2 states that Bassett and Matthews references fail to describe and instruct how to apply venue-based multimedia systems over wireless infrastructure. In other words, Matthews distinguishes the references from the '549 patent. At ¶¶ 20-21 p. 3 Matthews states that the references lack wireless infrastructure, comparing to SNQ1. At ¶ 23 p. 4 Matthews states that the ChoiceSeat system would be prior art if the '549 patent used wired networks, but of course the claims are limited to wireless activities. Again, even if the declaration does not explicitly refer to the claims, this is clearly argument concerning the

patentability of the claims. Moving on, Matthews compares Verna to the '549 patent in ¶ 24 pp. 5-6, and distinguishes the reference from the '549 patent because Verna is drawn to receiving discrete video clips and auxiliary information, while the '549 patent is drawn to time-unrestricted venue-based data, i.e. streaming video. All of these can be considered arguments as to why the art does not anticipate or make obvious limitations of the claims, and thus *at least* 4 pages of Matthews count against the page limit.

The Ferguson Declaration devotes three pages (pp. 3-5) to "the distinctions between Ortiz and the Bassett reference." Bassett was applied against the claims in the rejection, and features of the claims are mentioned, therefore it is apparent that these pages are arguments as to why the reference does not anticipate or render obvious elements of the claims. The same can be said of pp. 6-7, describing "the distinctions between Ortiz and the Anderson reference." Thus, *at least* 5 pages of the Ferguson Declaration count against the page limit.

The Davis Declaration describes how the references are different than the '549 patent, and that they are not associated with interactive, 2-way, wireless communication and delivery of consumer content. See ¶ 49 (p. 9). This is a clear comparison of the references to the '549 patent, an argument in favor of patentability. *At least* 1 page should count against the page limit.

The Knight Declaration spends a number of paragraphs directly contrasting Verna and Ortiz. See ¶¶ 17-34 on pp. 4-7. A number of times, Knight explicitly mentions the claims of Ortiz. See, e.g., ¶ 18. It is apparent that if one is contrasting the reference from the patent under reexamination, including its claims, then that person is expressing opinions about patentability. *At least* 3 pages should count against the page limit.

There are several other declarations, and the above discussion should not necessarily be considered exhaustive, but this is enough to show that the petitioner is taking an unreasonably limited view[1] of whether its declarations include facts or argument. It is enough to show that the examiner did not err in holding the response non-compliant. The Director concludes that at least the above 23 pages can be considered to include argument. Patent owner apparently believes, based on its redactions, that if it does not explicitly say "the reference anticipates/renders obvious the claims" then it is somehow not making an argument. Clearly, when the claims include "X" limitation, and the patent owner or his declarant states "the reference does not teach X" or "does not render obvious X" this is not intended as a mere description of facts. Under

[1] Petitioner is also advised that in future correspondence it would be useful for it to restrict its use of hyperbole and/or total misrepresentation of the examiner's position. For example, at petition p. 5 n. 2 petitioner states that the examiner held that Mr. Verna's description of celebrities he has met is argument. In actuality, the Notice pointed to pages 3-8 of the Verna Declaration as including argument, not to the particular paragraph concerning Mr. Verna's career or acquaintances. Page 3 is where Verna described celebrities he's met, and that page, prior to redaction, clearly stated at ¶ 15 that Verna's patent does not "negate[] Ortiz' invention." It was certainly reasonable for the examiner to find this to be an argument that Verna does not render the Ortiz patent unpatentable.

MPEP § 2667(I)(A)(2), it is "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."

Accordingly, the response was not compliant with 37 CFR § 1.943(b) and the examiner was not incorrect to hold it non-compliant. The petition is denied.

Patent owner did not file an appropriate response to the April 1, 2011 Office action. Accordingly, prosecution is hereby limited to the claims found patentable in that action. *See* 37 CFR § 1.957(c). It is also noted that the defect in the response was the length and patent owner filed a petition to waive the page limit requirement. That petition was dismissed as premature in the Decision mailed January 26, 2012, which also stated that patent owner could renew its petition if, as herein, the present petition were denied. Accordingly, patent owner has a time period of fourteen days from the mailing date of this decision to renew its petition under 37 CFR § 1.183 for waiver of the requirements of 37 CFR § 1.943 and avoid the limitation of prosecution. In deciding any such petition, the Office of Patent Legal Administration is of course free to determine whether even more pages of the various declarations should count against the page limit, and OPLA will decide such a petition accordingly based on its own determination of the pages to be counted.

CONCLUSION

1. Patent owner's petition filed November 21, 2011 is denied. The substitute response filed November 21, 2011 is not compliant and not accepted.

2. Patent owner has a period of fourteen days from the mailing date of this paper to renew its petition under § 1.183 for waiver of the 37 CFR § 1.943 page limit requirements.

3. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.

Irem Yücel
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,565	03/04/2011	7149549	206182-14000-101	3758

64064 7590 03/02/2012

ORTIZ & LOPEZ, PLLC
P.O. BOX 4484
ALBUQUERQUE, NM 87196-4484

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/02/2012

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Date: MAR 0 2 2012

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
George C. Beck
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Washington, DC 20007

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001565
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CENTRAL REEXAMINATION UNIT

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(For Patent Owner)

GEORGE C. BECK
FOLEY & LARDNER, LLP
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WASHINGTON, DC 20007

(For Third Party Requester)

Inter Partes Reexamination Proceeding	:	**DECISION**
Control No. 95/001,565	:	**DISMISSING**
Filed: March 4, 2011	:	**PETITION**
For: U.S. Patent No. 7,149,549	:	

This is a decision on the December 14, 2011 third party requester petition under 37 CFR 1.183 requesting waiver of the page limit requirement of 37 CFR 1.943(b) for its December 14, 2011 comments submission filed in reply to the November 21, 2011 patent owner response.

The third party requester petition is before the Office of Patent Legal Administration.

For the reasons set forth below, the third party requester petition is **dismissed as moot**.

DECISION

In its petition, the third party requester requests waiver of the page limit requirement of 37 CFR 1.943(b) for its comments submission filed on December 14, 2011 that is directed to the November 21, 2011 patent owner response.

On February 3, 2012, the Office mailed a decision denying patent owner's petition filed on November 21, 2011 requesting that the Office withdraw the November 4, 2011 Notice of defective paper. The decision also found that the patent owner's November 21, 2011 substitute response was not compliant and not accepted.

Pursuant to MPEP § 2667(I)(A)(2), "Any previously submitted third party comments in response to [the] 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."

Accordingly, the third party requester's December 14, 2011 petition requesting waiver of 37 CFR 1.943(b) for its December 14, 2011 comments submission is moot, and the third party requester's December 14, 2011 petition is dismissed as moot.

CONCLUSION

1. The third party requester's petition under 37 CFR 1.183 is **dismissed**.

2. Telephone inquiries with regard to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

03-01-2012

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95/001,565	03/04/2011	7149549	206182-14000-101	3758

64064 7590 03/07/2012

ORTIZ & LOPEZ, PLLC
P.O. BOX 4484
ALBUQUERQUE, NM 87196-4484

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/07/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
George C. Beck
FOLEY & LARDNER, LLP
3000 K Street, NW, Suite 500
Washington, DC 20007

Date: MAILED

MAR 07 2012

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001565
PATENT NO. : 7149549
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

ORTIZ & LOPEZ, PLLC
P.O. BOX 4484
ALBUQUERQUE, NM 87196-4484

(For Patent Owner)

GEORGE C. BECK
FOLEY & LARDNER, LLP
3000 K STREET, NW, SUITE 500
WASHINGTON, DC 20007

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,565
Filed: March 4, 2011
For: U.S. Patent No. 7,149,549

: **DECISION**
: **DISMISSING**
: **PETITION**

This is a decision on the February 16, 2012 patent owner petition under 37 CFR 1.183 requesting waiver of the page limit requirement of 37 CFR 1.943(b) for its February 16, 2012 response submission filed in reply to the April 1, 2011 non-final Office action.

The patent owner petition is before the Office of Patent Legal Administration.

For the reasons set forth below, the patent owner petition is **dismissed as moot**.

DECISION

In the February 16, 2012 petition, the patent owner requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for its February 16, 2012 response submission filed concurrently with the petition.

A review of the February 16, 2012 patent owner response submission shows that it is unsigned.[1] Therefore, it is an improper paper and will not be considered by the examiner. Accordingly, the

[1] It is noted that **the February 16, 2012 patent owner response submission** contains the following **additional defects**: (1) it contains a declaration by Walt Evanyk for the 95/001,566 proceeding as identified on the first page of the declaration, which was not filed in the original May 26, 2011 patent owner response, and (2) it does not contain claim amendments (which were filed with the original May 26, 2011 patent owner response submission) referred to in the February 16, 2012 patent owner remarks.

present patent owner petition is dismissed as moot because no proper timely response has been filed.[2]

Per the February 3, 2012 Office decision, since the patent owner has not filed an appropriate response to the April 1, 2011 Office action, prosecution is hereby limited to the claims found patentable in that action. *See* 37 CFR 1.957(c).

CONCLUSION

1. The patent owner petition under 37 CFR 1.183 is **dismissed**.

2. The proceeding is being referred to the Central Reexamination Unit for issuance of an Office action in due course without consideration of the February 16, 2012 patent owner response submission.

3. Telephone inquiries with regard to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

03-05-2012

[2] This is the second time that the patent owner has submitted an unsigned response to the April 1, 2011 non-final Office action. As stated in the January 26, 2012 Office decision, the previous November 21, 2011 patent owner response submission was unsigned.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,566	03/04/2011	7620426	080200-0294	3911

64064 7590 08/18/2011

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Date: 8-18-11

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

George C. Beck
FOLEY & LARDNER LLP
3000 K Street, N.W., Suite 500
Washington, DC 20007

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001566
PATENT NO. : 7620426
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

Ortiz & Lopez, PLLC
P.O. Box 4484
Albuquerque, NM 87196-4484

(For Patent Owner)

Foley & Lardner, LLP
3000 K. Street, NW, Suite 600
Washington, DC 20007

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,566
Filed: March 4, 2011
For: U.S. Patent No. 7,620,426

DECISION
DISMISSING
PETITION

This is a decision on the July 18, 2011 third party requester's petition paper entitled "PETITION UNDER 37 C.F.R 1.183".

The petition is before the Office of Patent Legal Administration for decision.

The petition is **dismissed as moot**, for the reasons set forth below.

DECISION

In the instant petition, third party requester requests waiver of the page limit requirement of 37 CFR 1.943(b) for its comments submission filed on July 18, 2011. On July 27, 2011, the Office mailed a "NOTICE RE DEFECTIVE PAPER IN INTER PARTES REEXAMINATION" (the notice of non-compliance), stating that patent owner's June 17, 2011 response submission is defective and setting a time period for patent owner to file a corrected response submission. Pursuant to MPEP § 2667(I)(A)(2), "Any previously submitted third party comments in response to [the] 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." Accordingly, requester's July 18, 2011 petition requesting waiver of 37 CFR 1.943(b) for its concurrently-filed comments submission is dismissed as moot.

Given that the requester statutorily has no right to file a comments submission, requester's July 18, 2011 comments submission is being expunged from the record. 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. Once the patent owner files a compliant response, then under 37 CFR 1.947, requester may file written comments, limited to issues raised by the Office action or the patent owner's response submission, which may be accompanied by a renewed requester petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b). In the event the requester files a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), no additional fee need be submitted.

A one-time courtesy copy of this decision is being mailed, consistent with the communication entitled "COMMUNICATION REGARDING PATENT OWNER'S CORRESPONDENCE ADDRESS", mailed on date even herewith, to the address below:

Foster Pepper PLLC
1111 3rd Avenue Suite 3400
Seattle, WA 98101-3299

CONCLUSION

1. Third party requester's July 18, 2011 petition paper entitled "PETITION UNDER 37 C.F.R 1.183" is dismissed as moot.

2. Requester's July 18, 2011 comments submission is being expunged from the record. Because these papers have been scanned into the Office's 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.

3. Telephone inquiries with regard to this decision should be directed to Nicole D. Haines, Legal Advisor, at (571) 272-7717.

Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

08-17-2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,566	03/04/2011	7620426	080200-0294	3911

64064 7590 08/18/2011

ORTIZ & LOPEZ, PLLC
P.O. BOX 4484
ALBUQUERQUE, NM 87196-4484

EXAMINER

ART UNIT	PAPER NUMBER

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,566	03/04/2011	7620426	206182-14001-101	3911

16579 7590 11/04/2011

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EXAMINER

ART UNIT	PAPER NUMBER

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
George C. Beck
FOLEY & LARDNER LLP
3000 K Street NW, Suite 500
Washington, DC 20007

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001566
PATENT NO. : 7620426
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

Ortiz & Lopez PLLC (For Patent Owner)
P.O. Box 4484
Albuquerque, NM 87196-4484

George C. Beck, Esq. (For Third Party Requester)
Foley & Lardner, LLP
3000 K. Street, NW
Suite 500
Washington, DC 20007

Foster Pepper PLLC (Courtesy Copy)
1111 3rd Avenue Suite 3400
Seattle, WA 98101-3299

In re Application of: Ortiz *et al.* : **DECISION**
Control No. 95/001,566 : **ON PETITIONS**
Filed: March 4, 2011 : **UNDER**
For: U.S. Patent No. 7,620,426 : **37 CFR 1.181**

This decision is in response to two third party requester's petitions, filed on July 18, 2011, entitled "Petition to Strike under 37 C.F.R. 1.182" and "Petition under 37 C.F.R. 1.182 for Office to Require Factual Information as to Declarations Submitted by Patent Owner." The petitions are treated as petitions under 37 CFR 1.181 and are before the Director of Technology Center 1600, who oversees the Central Reexamination Unit. This decision also addresses the August 26, 2011 patent owner petition under 37 CFR 1.181 requesting that the Office withdraw its Notice of July 27, 2011.

The requester's petitions filed, on July 18, 2011, are dismissed as moot for the reasons expressed below.

The patent owner's petition, filed August 26, 2011, is granted-in-part.

STATEMENT OF FACTS RELEVANT TO THE DECISION

1. U.S. Patent No. 7,620,426 (the '426 patent) issued on November 17, 2009.

2. A completed request for reexamination of the '831 patent was filed on March 4, 2011. The request was assigned control No. 95/001,566 (the '566 proceeding).

3. On April 22, 2011, the Office ordered that the patent be reexamined. On the same day, the Office mailed a first Office action in the '566 proceeding.

4. On June 17, 2011, the patent owner filed a response submission to the Office action. The response submission included 48 pages of arguments, declarations, and supporting exhibits.

5. On July 18, 201, the third party requester filed comments and three petitions, two of which are being addressed in this decision.

6. On July 27, 2011, the Office mailed a Notice of Defective Papers ("Notice") which stated that the patent owner's comments of June 17, 2011 were noncompliant with the requirements of 37 CFR 1.943. The Notice gave the patent owner 30 days to file a replacement response.

7. On August, 9, 2011, the July 27, 2011 Notice was mailed again.

8. On August 18, 2011, the Office dismissed requester's petition under 37 CFR 1.183, filed on July 18, 2011, as moot in light of the July 27, 2011 Notice. The Office also sent a communication regarding the power of attorney for the patent owner.

9. On August 24, 2011, the Office mailed "Notice of Acceptance of Power of Attorney."

10. On August 26, 2011, the patent owner filed a petition under 37 CFR 1.181 requesting that the Office withdraw its Notice of July 27, 2011.

DECISION

Requester's July 18, 2011 Petitions:

As pointed out, the requester filed two July 18, 2011 petitions, which are treated as petitions under 37 CFR 1.181. The petition entitled "Petition to Strike under 37 C.F.R. 1.182" is a request to expunge the patent owner's June 17, 2011 as noncompliant with Office rules. The petition entitled "Petition under 37 C.F.R. 1.182 for Office to Require Factual Information as to Declarations Submitted by Patent Owner" is a request for the Office to require information from the patent owner regarding the declarations filed as part of the June 17, 2011 submission. Both petitions are treated as petitions under 37 CFR 1.181 requesting supervisory review of the examiner's evaluation of the response and the declarations.

On July 27, 2011, as discussed above, the Office mailed a Notice that determined that the June 17, 2011 response submission was noncompliant with Office regulations and policy. Therefore, the June 17, 2011 response submission was not considered and will be expunged from the record. As the June 17, 2011 response submission has been entered into the electronic Image File Wrapper (IFW) record, the response submission will be expunged from the record by closing the papers in the IFW record, and marking the papers nonpublic. See MPEP 2667.

As a result of the July 27, 2011 Notice, the remedy of expungement of the June 17, 2011 response, requested by the petition to strike, is already given. In addition, the expungement of the June 17, 2011 response submission includes expungement of the declarations. Therefore, the relief requested by the Office requiring further information is not available. In other words, the ultimate relief requested by the July 18, 2011 petitions is given by the July 27, 2011 Notice.

For these reasons, the third party requester's July 18, 2011 petitions are moot, and hereby, dismissed.

It is further noted that any comments the requester has as to the propriety or accuracy of submitted declarations by the patent owner should be included as part of their comment submission. A petition under 37 CFR 1.182 will normally not be entertained for such comments because the regulations, specifically 37 CFR 1.947 and 1.948, provide means for the requester to submit comments on the patent owner's response, including any declarations. Accordingly, a petition under 37 CFR 1.182 is not proper vehicle for this type of request. In other words, if a similar petition is filed in response to patent owner's replacement response submission, it is likely that such a petition will be counted as part of the requester's comments, subject to the page limit requirement of 37 CFR 1.943(b), or alternatively, treated as an improper paper.

Patent owner's August 26, 2011 Petition:

In the August 26, 2011 petition, the patent owner requests withdrawal of the July 27, 2011 Notice from the proceeding record. Patent owner alleges that the July 27, 2011 Notice was not permitted because the Notice is not in accordance with reexamination laws and policies. See, e.g., pages 1-3 of the petition. Patent owner also asserts that even if the July 27, 2011 Notice was proper, the requester does not have opportunity to submit comments. See page 4 of the petition. In addition, patent owner argues that the July 27, 2011 Notice "... violates basic Constitutional principals [sic] of fair play." See pages 4-5 of the petition. Finally, patent owner alternatively requests waiver under 37 CFR 1.183 of the page limit requirement of 37 CFR 1.943(b). For these reasons, patent owner asserts that the July 27, 2011 Notice should be expunged from the proceeding record.

First, the portion of the petition regarding relief under 37 CFR 1.183 is procedurally dismissed under 37 CFR 1.4(c). The petition improperly combines different subjects into a single petition, which is not in compliance with the requirements of 37 CFR 1.4(c).

In regard to patent owner's assertion that the July 27, 2011 Notice is an unauthorized action, the instructions in MPEP 2666.05 require the examiner to notify the patent owner of the reasons for

noncompliance and to give the patent owner an additional opportunity to file replacement response. Upon review of the record, the director finds that the July 27, 2011 Notice appropriately determined that patent owner's June 17, 2011 response submission exceeded the 50 page limit of 37 CFR 1.943(b). Specifically, the response itself was 48 pages. In addition, as described in more detailed in a new Notice of noncompliance, more than three pages of the 119 pages of declarations contain legal arguments and therefore, are counted in the 50 page limit. However, the explanation provided in the July 27, 2011 notice did not clearly explain the basis for its determination, and for this reason, the Notice (including the Notice mailed again on August 9, 2011) is vacated. A new Notice of noncompliance will be mailed contemporaneously with this decision that provides a clear basis for the determination that the June 17, 2011 response submission is noncompliant with Office regulations. The new Notice will give the patent owner an opportunity to submit a replacement response submission in compliance with Office regulations.

In regard to patent owner's argument that requester is not permitted to file comments, patent owner is correct that the statute only permits comments to a patent owner's response to an action on the merits, and the Notice of Defective Paper is not such an action. Of course, no such comments have been filed, and the Office has therefore not accepted any improper comments. Yet, patent owner complains because the Transmittal of Communication form apparently invites improper comments. This is a standard Office form used in all *inter partes* reexamination actions, therefore the act of the examiner (or the mailing paralegal as the case may be) in using this form was not improper. An Office action does not in itself create any rights beyond what the statute explicitly provides, therefore to the extent the form is not entirely accurate in all circumstances this is a harmless error. The new contemporaneous Notice will almost certainly include such statements as well, and again such statements will not serve to extend rights to the parties beyond the statute. Patent owner is advised not to petition such issue again as it will be summarily dismissed unless the third party actually files an improper submission, and/or the Office actually accepts such improper submission.

In regard to patent owner's fundamental fairness arguments, the director does not find these arguments persuasive for the following reasons. The reexamination 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 enable special dispatch by limiting responses by patent owners and comments by requesters. In addition, the rules and procedures permit waiver of the page limit and extensions of time in appropriate circumstances. Furthermore, the rules and procedures encourage examiners to look at the facts involved in a particular proceeding and to weigh the equities before issuing an action. The record shows that the examiner followed Office procedures by issuing the July 27, 2011 Notice and giving the patent owner another chance to submit a compliant response. Therefore, the record does not show that the July 27, 2011 Notice denied patent owner its Constitutional rights or is fundamentally unfair. Accordingly, the record shows that the examiner appropriately followed Office rules and procedures in the determination to issue the July 27, 2011 Notice, and did not categorically deprive the patent owner of its statutory rights to present amendments, evidence, and arguments in reexamination proceedings.

For these reasons, the Patent Owner's August 26, 2011 petition is granted-in-part to the extent

that the July 27, 2011 Notice is vacated and a clarified Notice of noncompliance will be mailed contemporaneously with this decision.

POWER OF ATTORNEY & CORRESPONDENCE ADDRESS ISSUES

The power of attorney and change of correspondence address communications, filed June 15, 2011 and August 11, 2011, are ineffective because the communications were not filed in the file for the '426 patent. See the "Communication Regarding Patent Owner's Correspondence Address," mailed on August 18, 2011. For this reason, the "Notice of Acceptance of Power of Attorney," mailed on August 26, 2011, was improper, and is hereby, vacated.

The current power of attorney and correspondence address in this reexamination proceeding remains to be Ortiz & Lopez, PLLC, P.O. Box 4484, Albuquerque, NM 87196-4484. All future Office correspondence will be mailed to the above-mentioned address. As a courtesy, a copy is also being mailed to Foster Pepper PLLC at the address listed in the August 11, 2011 communication.

Patent owner is called upon to file any change of power of attorney and correspondence address in the patent file (Application No. 11/738,088) in order to properly effectuate a change in this reexamination proceeding.

CONCLUSION

1. The July 18, 2011 third party requester's petitions are dismissed as moot.

2. Patent owner's August 26, 2011 petition is granted-in-part to the extent that the July 27, 2011 Notice is vacated and a clarified Notice of noncompliance will be mailed contemporaneously with this decision.

3. Patent owner's June 17, 2011 response submission will be expunged and marked "closed" and "non-public" to remove the submission from the reexamination record.

4. Third party requester's July 18, 2011 comment submission is expunged from the reexamination record.

5. The August 24, 2011 Office notice regarding the power of attorney is vacated.

6. Telephone inquiries related to this decision should be directed Mark Reinhart, Supervisory Patent Examiner, 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.
95/001,566	03/04/2011	7620426	206182-14001-101	3911

64064 7590 01/26/2012

ORTIZ & LOPEZ, PLLC
P.O. BOX 4484
ALBUQUERQUE, NM 87196-4484

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,566	03/04/2011	7620426	206182-14001-101	3911

16579 7590 01/26/2012
Foster Pepper PLLC
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Seattle, WA 98101-3299

EXAMINER

ART UNIT	PAPER NUMBER

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
George C. Beck
FOLEY & LARDNER LLP
3000 K Street NW, Suite 500
Washington, DC 20007

Date:
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JAN 26 2012
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001566
PATENT NO. : 7620426
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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JAN 26 2012

CENTRAL REEXAMINATION UNIT

ORTIZ & LOPEZ, PLLC
P.O. BOX 4484
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(For Patent Owner)

GEORGE C. BECK
FOLEY & LARDNER, LLP
3000 K STREET, NW, SUITE 500
WASHINGTON, DC 20007

(For Third Party Requester)

FOSTER PEPPER, PLLC
1111 3RD AVENUE, SUITE 3400
SEATTLE, WA 98101-3299

(Courtesy Copy)

Inter Partes Reexamination Proceeding	: **DECISION**
Control No. 95/001,566	: **DISMISSING**
Filed: March 4, 2011	: **PETITION**
For: U.S. Patent No. 7,620,426	:

This is a decision on the patent owner's petition under 37 CFR 1.183 requesting waiver of the page limit requirement of 37 CFR 1.943(b), filed on November 21, 2011.

The patent owner's petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

For the reasons set forth below, the patent owner's petition under 37 CFR 1.183 is **dismissed.**

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).

In the present petition under 37 CFR 1.183, the patent owner requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for the patent owner's response filed on June 17, 2011.

On November 4, 2011, the Office issued a "Notice of Re Defective Paper" stating that the patent owner's June 17, 2011 response exceeded the 50-page limit requirement of 37 CFR 1.943(b). On November 21, 2011, the patent owner filed a petition under 37 CFR 1.181 requesting that the Office withdraw the "Notice of Re Defective Paper." Since the patent owner's November 21, 2011 § 1.181 petition has not yet been decided, the instant patent owner petition under 37 CFR 1.183 is premature; if the patent owner's § 1.181 petition should be granted, then the present patent owner petition requesting waiver of the requirement of 37 CFR 1.943(b) would be moot, since there would be no need to consider waiver of a rule.[1] The patent owner retains the option of seasonably filing a renewed petition under 37 CFR 1.183 requesting waiver of the requirement of 37 CFR 1.943(b) for its response to the April 22, 2011 non-final Office action should the decision on the § 1.181 petition be not to grant the petition, and reconsideration of such a decision is not requested. Until such time, the issue is not ripe for consideration by the Office under 37 CFR 1.183. When no further petition under 37 CFR 1.181 is filed by the patent owner to withdraw the November 4, 2011 Notice of Defective paper, patent owner may renew the present petition under 37 CFR 1.183.

In view of the above, the petition under 37 CFR 1.183 is dismissed as premature.

PATENT OWNER'S CORRESPONDENCE ADDRESS

37 CFR 1.33(c) provides (emphasis added):

> All notices, official letters, and other communications for the patent owner or **owners in a reexamination proceeding will be directed to the correspondence address**. Amendments and other papers filed in a reexamination proceeding on behalf of the patent owner must be signed by the patent owner, or if there is more than one owner by all the owners, or by an attorney or agent of record in the patent file, or by a registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34. **Double correspondence with the patent owner or owners and the patent owner's attorney or agent, or with more than one attorney or agent, will not be undertaken.**

The correspondence address for the patent to be reexamined, or being reexamined is the correct address for all notices, official letters, and other communications for patent owners in reexamination proceedings.[2] In the instant case, the patent owner is called upon to clarify and coordinate the proper correspondence addresses in (1) the 7,620,426 patent and (2) the

[1] That is, if relief is granted under 37 CFR 1.181 to withdraw the November 4, 2011 Notice of Defective paper, then the present request to waive the page limit requirement of 37 CFR 1.943(b) for the patent owner response would be moot .

[2] *See* MPEP 2622

95/001,566 reexamination proceeding. Different patent owner addresses are currently of record for the patent and the reexamination proceeding.

Furthermore, the power of attorney filed on November 16, 2011 in this reexamination proceeding was incorrectly accepted on December 1, 2011. The power of attorney filed did not include a proper 37 CFR 3.73(b) statement from the assignee.[3] The 37 CFR 3.73(b) statement filed on June 15, 2011 in this reexamination proceeding is deficient because it does not state the extent of assignee's interest in the patent. Therefore, the acceptance of power of attorney on December 1, 2011 is hereby rescinded, and such will be processed in due course by the Central Reexamination Unit. Further, to correspond to the correspondence address for the patent being reexamined, the correspondence address in this reexamination proceeding is being changed to that for the patent file (i.e., Ortiz & Lopez, PLLC, P.O. Box 4484, Albuquerque, NM 87196-4484) pursuant to 37 CFR 1.33(c). As a courtesy, a copy of this decision is also being mailed to Foster Pepper, PLLC at the address listed on the November 21, 2011 patent owner petition under 37 CFR 1.183. Patent owner should not expect any further courtesy copies, as it has been put on notice several times about the proper manner of effectuating its address and power of attorney changes.

CONCLUSION

1. The patent owner petition under 37 CFR 1.183 filed on November 21, 2011 is dismissed as being premature.

2. **Parties are put on NOTICE that the correspondence address for the present reexamination proceeding is Ortiz & Lopez, PLLC, P.O. Box 4484, Albuquerque, NM 87196-4484), pursuant to 37 CFR 1.33(c). As pointed out above, a copy of this decision is also being mailed to Foster Pepper, PLLC at the address listed on the November 21, 2011 patent owner petition. Patent owner should not expect any further courtesy copies, as it has been put on notice several times as to the proper manner of effectuating its address and power of attorney changes.**

3. Telephone inquiries related to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

/Kenneth M. Schor/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

1-25-2012; pet3/

[3] It is noted that the power of attorney filed on November 16, 2011 in the 7,620,426 patent file was denied on November 29, 2011 because a 37 CFR 3.73(b) statement was not received from the assignee.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,566	03/04/2011	7620426	206182-14001-101	3911

64064 7590 02/03/2012

ORTIZ & LOPEZ, PLLC
P.O. BOX 4484
ALBUQUERQUE, NM 87196-4484

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/03/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

George C. Beck
FOLEY & LARDNER LLP
3000 K Street NW, Suite 500
Washington, DC 20007

Date:

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FEB 0 3 2012

CENTRAL REEXAMINATION

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001566
PATENT NO. : 7620426
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 03 2012

CENTRAL REEXAMINATION UNIT

ORTIZ & LOPEZ, PLLC P.O. BOX 4484 ALBUQUERQUE, NM 87196-4484	:	(For Patent Owner)
FOLEY & LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007	:	(For Third Party Requester)

In re: Ortiz *et al.* *Inter Partes* Reexamination Proceeding Control No.: 95/001,566 Deposited: March 4, 2011 For: U.S. Patent No.: 7,620,426	:	DECISION ON PETITION UNDER 37 CFR § 1.181

This is a decision on a petition filed by the patent owner on November 21, 2011, entitled: "PATENT OWNER'S PETITION UNDER 37 C.F.R. § 1.181" [hereinafter "the petition"].

The petition is a request to the Director to exercise his discretion pursuant to 37 CFR § 1.181 to review the examiner's action of holding a response as defective.

The petition is before the Director of the Central Reexamination Unit. The petition is denied.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,620,426 issued on November 17, 2009.
- A request for *inter partes* reexamination was filed on March 4, 2011 and assigned control no. 95/001,566.
- *Inter partes* reexamination was ordered and a rejection was mailed on April 22, 2011.
- On June 17, 2011, patent owner responded to the Office action.
- On July 27, 2011, the examiner issued a notice of defective paper holding patent owner's June 17, 2011 response non-compliant.
- On August 26, 2011 patent owner filed a petition for withdrawal of the notice of defective paper.
- On November 4, 2011, the Office granted the August 12 petition, and the examiner issued a new notice of defective paper holding the response non-compliant for lack of clarity and for being greater than the permissible length.
- On November 21, 2011 patent owner replied to the notice and filed the instant petition requesting withdrawal of the notice.
- A petition to waive the page limit requirement was also filed November 21, 2011, and was dismissed as premature on January 26, 2012.

POWER OF ATTORNEY & CORRESPONDENCE ADDRESS ISSUES

This paper is being mailed to the address of record in the patent. Patent owner has been told several times how to effectuate an address change and not to expect further courtesy copies at addresses not of record in the patent. *See, e.g.*, Decision mailed January 26, 2012 at pp. 2-3.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.943 Requirements of responses, written comments, and briefs in *inter partes* reexamination (in part)

(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.

MPEP § 2667(I)(A)(2) provides, in pertinent part (emphasis added):

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

Patent owner ["petitioner"] requests withdrawal of the November 4, 2011 Notice of Defective Paper ["Notice"]. The Notice held that the June 17, 2011 response was longer than the page limit set forth in 37 CFR § 1.943(b), and also required "that the response to this Notice must have clearer and larger text because the response . . . is difficult to read and does not readily permit direct reproduction." Notice at p. 3. Petitioner argues that its numerous declarations should not count against the page limit because they are drawn to facts and not arguments, and

also argues that the response met the various formatting requirements of the Office and any lack of clarity was not the fault of petitioner. Petitioner also has re-filed the response electronically in an attempt to cure any scanning issues and has redacted some sentences of the declarations.

Regarding the clarity issue, the Director agrees that at least the newly electronically filed response of November 21 is of adequate quality and appears to meet the Office's various formatting requirements. Any requirement in the Notice as to the clarity of the response is therefore withdrawn.

As to the length, the Director does not agree that the petitioner has shown the examiner acted improperly in holding the response non-compliant. Petitioner argues that the entirety of each declaration is factual in nature, and not argument. Petitioner cites to various prior petition decisions throughout the petition, characterizing them as "binding precedent" supporting its position.

The Director does not necessarily concede that petition decisions are "precedent" that is binding on the Office, as characterized by petitioner. But in any event, most of the proceedings cited by the petitioner included the above quoted paragraph from MPEP § 2667(I)(A)(2) in a petition decision concerning page limits. See 95/000,469 Decision July 16, 2010 at 2-3; 95/000,396 Decision May 6, 2010 at 2-3; 95/000,397 Decision May 26, 2010 at 3; 95/000,398 Decision May 5, 2010 at 2-3. The only one that does not, 95/000,016 Decision July 14, 2004, was decided prior to the MPEP being revised to include said paragraph. *Compare* MPEP Eighth ed. Rev. 6, Sept. 2007, *with* Rev. 7, July 2008 at http://www.uspto.gov/web/offices/pac/mpep/old/index.htm To the extent there is an Office policy as to this issue that is "binding", it is set forth in the MPEP as quoted above, as that can be considered the Office's interpretation of its regulations. *See Molins PLC v. Textron Inc.*, 33 USPQ2d 1823, 1828 n.10 (Fed. Cir. 1995) (stating the MPEP, while not law, is entitled to notice as the official interpretation of statutes and regulations with which it does not conflict). Thus, rather than look to unrelated petition decisions, whose facts and relevance to this proceeding are not even explained by petitioner, we will look to the MPEP to determine what types of information do and do not fall within the page limit requirement.

The MPEP states that a declaration containing opinions as to whether the art does or does not anticipate or render obvious claims, or specific claim elements, of the patent under reexamination, counts against the page limit. MPEP § 2667(I)(A)(2). Any argument as to how a rejection would be overcome counts against the limit. *Id.* Any page including such argument counts against the limit. *Id.* The MPEP gives examples of the types of material that do not count against the page limit, such as factual evidence of the dates of invention or publication, secondary consideration evidence such as test data, or the like. For example, a declaration drawn solely to the commercial success of the invention is the type of declaration that does not count against the page limit. It is apparent that the MPEP does not envision as "factual" whether a

reference teaches a particular claim limitation, as that would be an opinion as to whether the art does or does not anticipate a claim element, which is explicitly included within the page limit.

Here the response itself, without considering the declarations, is at least 48 pages (pages 2-49, excluding table of contents page 1). The declarations include greater than two pages including argument, and thus the response is over the page limit.

The Gordon Declaration states that "ChoiceSeat was not a system for wirelessly receiving venue-based data at a hand-held device." Heading above ¶ 5 on p. 3. Gordon then says the requester is incorrect and that adapting ChoiceSeat to a wireless network (¶ 9 on p. 4) or to a hand-held client (¶ 10 on p. 5) would not have been obvious to a person of ordinary skill in the art. Gordon then states that the Choice seat system would have been significantly compromised if used wirelessly with a hand-held device. ¶ 12 on p. 6. Considering the claims are drawn to wirelessly receiving venue event data at a hand-held device, all of these statements can be considered arguments as to why the art does not render the claims or claim elements obvious, and thus would be considered as falling under the page limit requirements. Thus, *at least* 4 pages of Gordon count against the limit.

The Javed Declaration at ¶ 10, pp. 5-6, explains that Bassett only mentions wireless networks in one sentence concerning satellite or microwave networks, and that use of wireless networks in hand held devices is far different. It is stated that this would not have been obvious to anyone reading the patent. Javed further states that just once is a notebook computer or PDA mentioned, but no explicit mention is made of a video stream over a wireless network. Javed concludes that it would not have been apparent to a person of ordinary skill in the art how video data streams are transferred from a wireless network to a receiving device. While none of this discussion directly mentions the claims, it is a clear discussion of why the reference does not render the claims unpatentable. Javed tells us that Verna does not transmit video over a data network to a server, which would be required to send it to a hand held device. ¶ 11 on p. 7. Javed additionally explains that Anderson cannot be combined with various other references. ¶ 12 on p. 8. At ¶ 13 (pp. 9-10) Javed tells us that Digital Video does not teach transmission of video data streams over wireless networks to handheld devices. All of these features that the references allegedly do not teach are related to the claims. Thus *at least* 6 pages of Javed count against the page limit.

The Matthews Declaration at ¶ 18 p. 2 states that Bassett and Matthews references fail to describe and instruct how to apply venue-based multimedia systems over wireless infrastructure. In other words, Matthews distinguishes the references from the '426 patent. At ¶¶ 20-21 p. 3 Matthews states that the references lack wireless infrastructure, comparing to SNQ1. At ¶ 23 p. 4 Matthews states that the ChoiceSeat system would be prior art if the '426 patent used wired networks, but of course the claims are limited to wireless activities. Again, even if the declaration does not explicitly refer to the claims, this is clearly argument concerning the

patentability of the claims. Moving on, Matthews compares Verna to the '426 patent in ¶ 24 pp. 5-6, and distinguishes the reference from the '426 patent because Verna is drawn to receiving discrete video clips and auxiliary information, while the '426 patent is drawn to time-unrestricted venue-based data, i.e. streaming video. All of these can be considered arguments as to why the art does not anticipate or make obvious limitations of the claims, and thus *at least* 4 pages of Matthews count against the page limit.

The Ferguson Declaration devotes three pages (pp. 3-5) to "the distinctions between Ortiz and the Bassett reference." Bassett was applied against the claims in the rejection, and features of the claims are mentioned, therefore it is apparent that these pages are arguments as to why the reference does not anticipate or render obvious elements of the claims. The same can be said of pp. 6-7, describing "the distinctions between Ortiz and the Anderson reference." Thus, *at least* 5 pages of the Ferguson Declaration count against the page limit.

The Davis Declaration describes how the references are different than the '426 patent, and that they are not associated with interactive, 2-way, wireless communication and delivery of consumer content. See ¶ 49 (p. 9). This is a clear comparison of the references to the '426 patent, an argument in favor of patentability. *At least* 1 page should count against the page limit.

The Knight Declaration spends a number of paragraphs directly contrasting Verna and Ortiz. See ¶¶ 17-34 on pp. 4-7. A number of times, Knight explicitly mentions the claims of Ortiz. See, e.g., ¶ 18. It is apparent that if one is contrasting the reference from the patent under reexamination, including its claims, then that person is expressing opinions about patentability. *At least* 3 pages should count against the page limit.

There are several other declarations, and the above discussion should not necessarily be considered exhaustive, but this is enough to show that the petitioner is taking an unreasonably limited view[1] of whether its declarations include facts or argument. It is enough to show that the examiner did not err in holding the response non-compliant. The Director concludes that at least the above 23 pages can be considered to include argument. Patent owner apparently believes, based on its redactions, that if it does not explicitly say "the reference anticipates/renders obvious the claims" then it is somehow not making an argument. Clearly, when the claims include "X" limitation, and the patent owner or his declarant states "the reference does not teach X" or "does not render obvious X" this is not intended as a mere description of facts. Under

[1] Petitioner is also advised that in future correspondence it would be useful for it to restrict its use of hyperbole and/or total misrepresentation of the examiner's position. For example, at petition p. 5 n. 2 petitioner states that the examiner held that Mr. Verna's description of celebrities he has met is argument. In actuality, the Notice pointed to pages 3-8 of the Verna Declaration as including argument, not to the particular paragraph concerning Mr. Verna's career or acquaintances. Page 3 is where Verna described celebrities he's met, and that page, prior to redaction, clearly stated at ¶ 15 that Verna's patent does not "negate[] Ortiz' invention." It was certainly reasonable for the examiner to find this to be an argument that Verna does not render the Ortiz patent unpatentable.

MPEP § 2667(I)(A)(2), it is "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."

Accordingly, the response was not compliant with 37 CFR § 1.943(b) and the examiner was not incorrect to hold it non-compliant. The petition is denied.

Patent owner did not file an appropriate response to the April 22, 2011 Office action. Accordingly, prosecution is hereby limited to the claims found patentable in that action. *See* 37 CFR § 1.957(c). It is also noted that the defect in the response was the length and patent owner filed a petition to waive the page limit requirement. That petition was dismissed as premature in the Decision mailed January 26, 2012, which also stated that patent owner could renew its petition if, as herein, the present petition were denied. Accordingly, patent owner has a time period of fourteen days from the mailing date of this decision to renew its petition under 37 CFR § 1.183 for waiver of the requirements of 37 CFR § 1.943 and avoid the limitation of prosecution. In deciding any such petition, the Office of Patent Legal Administration is of course free to determine whether even more pages of the various declarations should count against the page limit, and OPLA will decide such a petition accordingly based on its own determination of the pages to be counted.

CONCLUSION

1. Patent owner's petition filed November 21, 2011 is denied. The substitute response filed November 21, 2011 is not compliant and not accepted.

2. Patent owner has a period of fourteen days from the mailing date of this paper to renew its petition under § 1.183 for waiver of the 37 CFR § 1.943 page limit requirements.

3. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.

Irem Yucel
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,566	03/04/2011	7620426	206182-14001-101	3911

64064 7590 03/02/2012
ORTIZ & LOPEZ, PLLC
P.O. BOX 4484
ALBUQUERQUE, NM 87196-4484

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/02/2012

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CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
George C. Beck
FOLEY & LARDNER LLP
3000 K Street NW, Suite 500
Washington, DC 20007

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001566
PATENT NO. : 7620426
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

GEORGE C. BECK
FOLEY & LARDNER, LLP
3000 K STREET, NW, SUITE 500
WASHINGTON, DC 20007

(For Third Party Requester)

Inter Partes Reexamination Proceeding	:	**DECISION**
Control No. 95/001,566	:	**DISMISSING**
Filed: March 4, 2011	:	**PETITION**
For: U.S. Patent No. 7,620,426	:	

This is a decision on the December 14, 2011 third party requester petition under 37 CFR 1.183 requesting waiver of the page limit requirement of 37 CFR 1.943(b) for its December 14, 2011 comments submission filed in reply to the November 21, 2011 patent owner response.

The third party requester petition is before the Office of Patent Legal Administration.

For the reasons set forth below, the third party requester petition is **dismissed**.

DECISION

In its petition, the third party requester requests waiver of the page limit requirement of 37 CFR 1.943(b) for its comments submission filed on December 14, 2011 that is directed to the November 21, 2011 patent owner response.

On February 3, 2012, the Office mailed decision denying patent owner's petition filed on November 21, 2011 requesting that the Office withdraw the November 4, 2011 Notice of defective paper. The decision also found that the patent owner's November 21, 2011 substitute response was not compliant and not accepted.

Pursuant to MPEP § 2667(I)(A)(2), "Any previously submitted third party comments in response to [the] 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."

Accordingly, the third party requester's December 14, 2011 petition requesting waiver of 37 CFR 1.943(b) for its December 14, 2011 comments submission is moot, and the third party requester's December 14, 2011 petition is dismissed as moot.

CONCLUSION

1. The third party requester's petition under 37 CFR 1.183 is **dismissed**.

2. Telephone inquiries with regard to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

03-01-2012

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,567	03/07/2011	7376388	080200-0295	5686

64064 7590 03/16/2012

ORTIZ & LOPEZ, PLLC
P.O. BOX 4484
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/16/2012

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Inter partes MLB Advanced Media, LP
v.
Front Row Technologies, LLC

Reexamination Control No. 95/001,567
Patent 7,376,388
Technology Center 3900

DECISION ON PETITIONS

This is a decision on "Patent Owner's Petition under 37 C.F.R § 1.182 to Strike Improper Portions of Appellant Brief," filed February 21, 2012 (petition). Petitioner requests that the requester's appellant brief of January 23, 2012, be stricken for being in direct violation of 35 U.S.C. § 314, 37 C.F.R. § 1.948, 37 C.F.R. § 1.116(e), and 37 C.F.R. § 1.63(c), because it introduces new evidence which was not made of record previously. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f) was charged to petitioner's deposit account on February 22, 2012.

This is also a decision on "Requester's Petition under 37 C.F.R §1.182 to Oppose Patent Owner's Petition to Strike, or in the Alternative for Waiver of Rules under 37 C.F.R §1.183," filed March 6, 2012 (opposition). In the opposition, requester asks that the Office deny patent owner's request to strike portions of appellant's brief of January 23, 2012. Requester alternatively petitions that the Office waive such regulations under 37 C.F.R. § 1.183 to ensure consideration by the Board of information material to the issues raised on appeal and consistency with other proceedings. The petition fee of $400 in accordance with 37 C.F.R. § 1.17(f) was charged to requester's credit card on March 7, 2012.

See 75 Fed. Reg. 50,750-51 (Aug. 17, 2010) for authority of the Chief Administrative Patent Judge.

FINDINGS

1. Third party requester filed a request for *inter partes* reexamination of U.S. Patent No. 7,376,388 on March 7, 2011.

2. On April 22, 2011, reexamination was ordered and a non-final Office action was mailed.

3. Prosecution was conducted, no responses were filed by patent owner and on October 26, 2011, a Right of Appeal Notice (RAN) was mailed.

4. Requester filed a Notice of Appeal on November 23, 2011, appealing the non-adopted rejections of claims 5-7 and 15.

5. Requester filed an appellant brief on January 23, 2012.

6. Patent Owner filed a respondent brief on February 21, 2012.

7. The instant petition was filed by patent owner on February 21, 2012.

8. On February 23, 2012, a Notice of Non-Compliant Brief was mailed, requiring a corrected respondent brief.

9. Requester filed the instant opposition to the patent owner's petition on March 6, 2012.

DISCUSSION

In the petition, patent owner requests that the third party requester's appellant brief of January 23, 2012, be stricken for not being in compliance with 35 U.S.C. § 314, 37 C.F.R. § 1.948, 37 C.F.R. §1.116(e), and 37 C.F.R. §1.63(c) because it introduces new evidence which was not previously made of record. Petitioner asserts that the appellant's brief contains Exhibits A, B and C containing declarations and prior art references that have not been previously entered nor considered. Petitioner suggests that these new declarations and prior art references should have been submitted with the request if requester wanted them to be entered and considered in the record. Petitioner also requests that all references to and discussion of the website www.scanz.com are improper and should be stricken from the appellant's brief because the website does not constitute a prior art patent or printed publication. Petitioner further contends that all references to issues raised under 35 U.S.C. § 112 be stricken from the appellant brief as patent owner has not amended the claims nor presented new claims. Petitioner also asserts that the appellant brief fails to comply with the specificity requirement of MPEP § 2675 in the Summary of Claimed Subject Matter.

In the opposition, requester asks that the Office deny patent owner's request to strike portions of appellant's brief of January 23, 2012. Requester alternatively petitions that the Office waive such regulations under 37 C.F.R.

§ 1.183 to ensure consideration by the Board of information material to the issues raised on appeal and consistency with other proceedings. 37 C.F.R. § 1.4(c) provides:

> Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

The filing of multiple petitions as a single petition in the alternative, with payment of a single petition fee, is not in compliance with to 37 C.F.R. § 1.4(c). Therefore, we will only address the first appearing petitionable matter in this decision, *i.e.*, requester's petition under 37 C.F.R §1.182 opposing patent owner's petition to strike.

RELEVANT AUTHORITY

35 U.S.C. § 314 provides:

> (a) IN GENERAL. - Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133. In any inter partes reexamination proceeding under this chapter, the patent owner shall be permitted to propose any amendment to the patent and a new claim or claims, except that no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted.
>
> (b) RESPONSE.-
>
> > (1) With the exception of the inter partes reexamination request, any document filed by either the patent owner or the third-party requester shall be served on the other party. In addition, the Office shall send to the third-party requester a copy of any communication sent by the Office to the patent owner concerning the patent subject to the inter partes reexamination proceeding.

> (2) Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

> (c) SPECIAL DISPATCH.- Unless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

37 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(h).

37 C.F.R. § 1.116(e) provides:

> An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

37 C.F.R. § 1.948 provides:

> (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.

37 C.F.R. § 41.63(c) provides:

> (c) Affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.61 will not be admitted except as permitted by reopening prosecution under § 41.77(b)(1).

37 C.F.R. § 41.67(c)(2) provides:

> A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.63 for amendments, affidavits or other evidence after the date of filing the appeal.

ANALYSIS

Petitioner requests that the appellant brief be stricken for not being in compliance with 37 C.F.R. § 1.948, 37 C.F.R. §1.116(e), and 37 C.F.R. §1.63(c) because it introduces new evidence not previously made of record. Petitioner's arguments focus on the new declarations and prior art references in appellant's brief, as well as the cited website, issues raised under 35 U.S.C. § 112, and the failure to comply with the specificity requirement of MPEP § 2675 in the Summary of Claimed Subject Matter.

In the opposition, requester argues that patent owner did not file any responses to the Office actions prior to appeal, therefore requester did not have an opportunity to file comments addressing the confirmation of claims 5-7 and 15 until the filing of the appellant brief. Requester argues that the Office has discretion under 37 C.F.R. § 116(e) and § 41.63 to consider material information from related proceedings submitted for the first time in the present proceeding with appellant's brief.

Pursuant to 37 C.F.R. § 41.67(c) and § 41.63(c), new evidence is not permitted in an appellant brief. A review of the brief reveals that newly cited declarations and references are included in the Evidence Appendix. These newly cited declarations and references apparently have been submitted in related cases, but were not filed with the original request for reexamination, and they were not entered and considered in the instant *inter partes* reexamination. Requester could have presented arguments in favor of entering such new information in a petition under 37 C.F.R §1.183 accompanying requester's appellant brief seeking a waiver of 37 C.F.R. § 41.67(c) and § 41.63(c). However, no waiver of the applicable rules was sought prior to the filing of the patent owner's petition to strike appellant's brief.

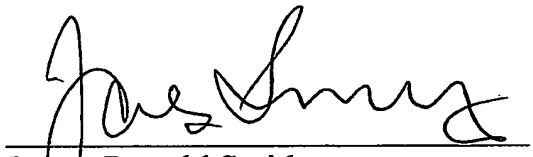
The appellant brief of January 23, 2012, is improper and not in compliance with 37 C.F.R. § 41.63(c) and 37 C.F.R. § 41.67(c) because it introduces new evidence which was not made of record previously. All references to and discussion of the website "www.scanz.com," as well as all references to issues raised under 35 U.S.C. § 112 are also improper. Additionally, the appellant brief far exceeds the page limit pursuant to

37 C.F.R. § 1.943(c) because the new declarations and the Office Actions cited in the Evidence Appendix (if it were proper to include them), all contain arguments that count toward the page limit of the brief. The petition is **granted**. The opposition is **denied.**

DECISION

In view of the foregoing, the Petition is GRANTED. The opposition is DENIED.

Requester is given one opportunity to file a corrected appellant brief in compliance with 37 C.F.R. § 41.67(c), § 41.63(c) and 37 C.F.R. § 1.943(c), within a non-extendable time period of one (1) month from the mailing date of this decision. If a compliant appellant brief is not timely received, then the requester's appeal will be dismissed. If a compliant appellant brief is timely filed, then patent owner will have one month from the date of service to file a respondent brief.



James Donald Smith
Chief Administrative Patent Judge

Counsel for Patent Owner:
ORTIZ & LOPEZ, PLLC
P.O. BOX 4484
ALBUQUERQUE, NM 87196-4484

Counsel for Third Party Requester:
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3000 K Street NW, Suite 500
Washington DC 20007

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,568	03/07/2011	7826877	206182-14003-101	5798

25315 7590 10/27/2011
LOWE GRAHAM JONES, PLLC
701 FIFTH AVENUE
SUITE 4800
SEATTLE, WA 98104

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/27/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
FOLEY AND LARDNER LLP
3000 K STREET, NW
SUITE 500
WASHINGTON, DC 20007

Date:
MAILED
OCT 27 2011
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001568
PATENT NO. : 7826877
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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Lowe Graham Jones, PLLC
701 Fifth Avenue
Suite 4800
Seattle Washington 98104

(For Patent Owner)

MAILED

OCT 27 2011

CENTRAL REEXAMINATION UNIT

Foley & Lardner, LLP
3000 K. Street, NW, Suite 600
Washington, DC 20007

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,568
Filed: March 7, 2011
For: U.S. Patent No. 7,826,877

DECISION
DISMISSING
PETITION

This is a decision on the August 12, 2011 third party requester's petition paper entitled "PETITION UNDER 37 C.F.R 1.183 TO WAIVE THE PAGE LIMITS OF 37 C.F.R. 1.943(B)".

The petition is before the Office of Patent Legal Administration for decision.

The petition is **dismissed as moot**, for the reasons set forth below.

DECISION

In the instant petition, third party requester requests waiver of the page limit requirement of 37 CFR 1.943(b) for its comments submission filed on August 12, 2011. On October 13, 2011, the Office mailed a "NOTICE RE DEFECTIVE PAPER IN INTER PARTES REEXAMINATION" (a notice of non-compliance), stating that patent owner's July 18, 2011 response submission is defective and setting a time period for patent owner to file a corrected response submission. Pursuant to MPEP § 2667(I)(A)(2), "Any previously submitted third party comments in response to [the] 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." Accordingly, requester's August 12, 2011 petition requesting waiver of 37 CFR 1.943(b) for its concurrently-filed comments submission is dismissed as moot.

Given that the requester statutorily has no right to file a comments submission, requester's August 12, 2011 comments submission is being expunged from the record. 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. Once the patent owner files a compliant response, then under 37 CFR 1.947, requester may file written comments, limited to issues raised by the Office action or the patent owner's response submission, which may be accompanied by a renewed requester petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b). In the event the requester files a renewed petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), no additional fee need be submitted.

CONCLUSION

1. Third party requester's August 12, 2011 petition paper entitled "PETITION UNDER 37 C.F.R 1.183" is dismissed as moot.

2. Requester's August 12, 2011 comments submission is being expunged from the record. Because these papers have been scanned into the Office's 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.

3. Telephone inquiries with regard 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

October 26, 2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,568	03/07/2011	7826877	206182-14003-101	5798

25315 7590 11/04/2011
LOWE GRAHAM JONES, PLLC
701 FIFTH AVENUE
SUITE 4800
SEATTLE, WA 98104

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 11/04/2011

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3000 K STREET, NW
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WASHINGTON, DC 20007

Date:

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001568
PATENT NO. : 7826877
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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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,568	03/07/2011	7826877	

EXAMINER
NASSER, ROBERT

ART UNIT	PAPER
3992	

FOSTER PEPPER PLLC
1111 3rd AVENUE
SUITE 3400
SEATTLE, WA 98101-3299

DATE MAILED:

11/04/11

INTER PARTES REEXAMINATION COMMUNICATION

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EXAMINER
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Lowe Graham Jones, PLLC
701Fifth Avenue, Suite 4800
Seattle, WA 98104

(For Patent Owner)

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NOV 04 2011

CENTRAL REEXAMINATION UNIT

George C. Beck, Esq.
Foley & Lardner, LLP
3000 K. Street, NW
Suite 500
Washington, DC 20007

(For Third Party Requester)

Foster Pepper PLLC
1111 3rd Avenue Suite 3400
Seattle, WA 98101-3299

(Courtesy Copy)

In re Application of: Oritz *et al.*
Control No. 95/001,568
Filed: March 7, 2011
For: U.S. Patent No. 7,826,877

: **DECISION**
: **ON PETITIONS**
: **UNDER**
: **37 CFR 1.181**

This decision is in response to two third party requester's petitions, filed on August 12, 2011, entitled "Petition to Strike under 37 C.F.R. 1.182" and "Petition under 37 C.F.R. 1.182 for Office to Require Factual Information as to Declarations Submitted by Patent Owner." The petitions are treated as petitions under 37 CFR 1.181 and are before the Director of Technology Center 1600, who oversees the Central Reexamination Unit.

The requester's petitions filed, on August 12, 2011, are dismissed as moot for the reasons expressed below.

STATEMENT OF FACTS RELEVANT TO THE DECISION

1. U.S. Patent No. 7,826,877 (the '877 patent) issued on November 2, 2010.

2. A completed request for reexamination of the '877 patent was filed on March 7, 2011. The request was assigned control No. 95/001,568 (the '568 proceeding).

3. On May 19, 2011, the Office ordered that the patent be reexamined. On the same day, the Office mailed a first Office action in the '568 proceeding.

4. On July 14, 2011, the patent owner filed a response submission to the Office action. The response submission included 47 pages of arguments, declarations, and supporting exhibits.

5. On August 12, 201, the third party requester filed comments and three petitions, two of which are being addressed in this decision.

6. On October 13, 2011, the Office mailed a Notice of Defective Papers which stated that the patent owner's comments of July 14, 2011 were noncompliant with the requirements of 37 CFR 1.943. The Notice gave the patent owner 30 days to file a replacement response.

7. On October 27, 2011, the Office dismissed requester's petition under 37 CFR 1.183, filed on August 12, 2011, as moot in light of the October 13, 2011 Notice.

8. On October 28, 2011, the Office mailed "Notice of Acceptance of Power of Attorney."

DECISION

As pointed out, the requester filed two August 12, 2011 petitions, which are treated as petitions under 37 CFR 1.181. The petition entitled "Petition to Strike under 37 C.F.R. 1.182" is a request to expunge the patent owner's July 14, 2011 as noncompliant with Office rules. The petition entitled "Petition under 37 C.F.R. 1.182 for Office to Require Factual Information as to Declarations Submitted by Patent Owner" is a request for the Office to require information from the patent owner regarding the declarations filed as part of the July 14, 2011 submission. Both petitions are treated as petitions under 37 CFR 1.181 requesting supervisory review of the examiner's evaluation of the response and the declarations.

On October 13, 2011, as discussed above, the Office mailed a Notice that determined that the July 14, 2011 response submission was noncompliant with Office regulations and policy. Therefore, the July 14, 2011 response submission was not considered and will be expunged from the record. As the July 14, 2011 response submission has been entered into the electronic Image File Wrapper (IFW) record, the response submission will be expunged from the record by closing the papers in the IFW record, and marking the papers nonpublic. See MPEP 2667.

As a result of the October 13, 2011 Notice, the remedy of expungement of the July 14, 2011

response, requested by the petition to strike, is already given. In addition, the expungement of the July 14, 2011 response submission includes expungement of the declarations. Therefore, the relief requested by the Office requiring further information is not available. In other words, the ultimate relief requested by the August 12, 2011 petitions is given by the October 13, 2011 Notice.

For these reasons, the third party requester's August 12, 2011 petitions are moot, and hereby, dismissed.

It is further noted that any comments the requester has as to the propriety or accuracy of submitted declarations by the patent owner should be included as part of their comment submission. A petition under 37 CFR 1.182 will normally not be entertained for such comments because the regulations, specifically 37 CFR 1.947 and 1.948, provide means for the requester to submit comments on the patent owner's response, including any declarations. Accordingly, a petition under 37 CFR 1.182 is not proper vehicle for this type of request. In other words, if a similar petition is filed in response to patent owner's replacement response submission, it is likely that such a petition will be counted as part of the requester's comments, subject to the page limit requirement of 37 CFR 1.943(b), or alternatively, treated as an improper paper.

The August 12, 2011 third party requester comments submission after the July 14, 2011 patent owner response submission is not considered, because, given that July 14, 2011 patent owner response submission has been refused, the patent owner did not, in fact, respond to the May 19, 2011 Office action in accordance with the rules, and requester has no comment right under 35 USC 314(b)(2). Because requester has no right to comment statutorily, requester's August 12, 2011 comments submission will be expunged from the record, and will not constitute part of the record of the present reexamination proceeding. For these reasons, requester is authorized to file comments in response to patent owner's replacement response in accordance with 35 U.S.C. 314.

POWER OF ATTORNEY & CORRESPONDENCE ADDRESS ISSUES

The power of attorney and change of correspondence address communications, filed July 14, 2011 and August 11, 2011, are ineffective because the communications were not filed in the file for the '877 patent. See the "Communication Regarding Patent Owner's Correspondence Address," mailed on August 18, 2011 in the related reexamination proceeding 95/001,566. Therefore, patent owner is required to clarify the current power of attorney and correspondence address by filing appropriate papers in the file for the '877 patent (e.g., application number 12/329,631).

The current power of attorney and correspondence address in this reexamination proceeding is indicated to be: Lowes Graham Jones, PLLC, 701 Fifth Avenue, Suite 4800, Seattle, WA 98104, according to the October 28, 2011 notices. As a courtesy, a copy is also being mailed to Foster Pepper PLLC at the address listed in the August 11, 2011 communication.

Patent owner is called upon to clarify the change of power of attorney and correspondence address in the patent file (Application No. 12/329,631) in order to properly effectuate a change in this reexamination proceeding.

CONCLUSION

1. The August 12, 2011 third party requester's petitions are dismissed as moot.

2. Patent owner's July 14, 2011 response submission will be expunged and marked "closed" and "non-public" to remove the submission from the reexamination record.

3. Third party requester's August 12, 2011 comment submission is expunged from the reexamination record.

4. Patent owner must file a change of power of attorney and correspondence address in the patent file (Application No. 12/329,631) in order to properly effectuate a change in this reexamination proceeding.

5. Telephone inquiries related to this decision should be directed Mark Reinhart, Supervisory Patent Examiner, 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.
95/001,568	03/07/2011	7826877	206182-14003-101	5798

64064 7590 01/26/2012

ORTIZ & LOPEZ, PLLC
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EXAMINER

ART UNIT	PAPER NUMBER

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,568	03/07/2011	7826877	206182-14003-101	5798

16579 7590 01/26/2012

Foster Pepper PLLC
1111 3rd Avenue Suite 3400
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EXAMINER

ART UNIT	PAPER NUMBER

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SUITE 500
WASHINGTON, DC 20007

Date: **MAILED**

JAN 26 2012

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001568
PATENT NO. : 7826877
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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CENTRAL REEXAMINATION UNIT

ORTIZ & LOPEZ, PLLC
P.O. BOX 4484
ALBUQUERQUE, NM 87196-4484

(For Patent Owner)

GEORGE C. BECK
FOLEY & LARDNER, LLP
3000 K STREET, NW, SUITE 500
WASHINGTON, DC 20007

(For Third Party Requester)

FOSTER PEPPER, PLLC
1111 3RD AVENUE, SUITE 3400
SEATTLE, WA 98101-3299

(Courtesy Copy)

Inter Partes Reexamination Proceeding
Control No. 95/001,568
Filed: March 7, 2011
For: U.S. Patent No. 7,826,877

DECISION DISMISSING PETITION

This is a decision on the patent owner's petition under 37 CFR 1.183 requesting waiver of the page limit requirement of 37 CFR 1.943(b), filed on November 21, 2011.

The patent owner's petition under 37 CFR 1.183 is before the Office of Patent Legal Administration.

For the reasons set forth below, the patent owner's petition under 37 CFR 1.183 is **dismissed.**

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).

In the present petition under 37 CFR 1.183, the patent owner requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for the patent owner's response filed on June 17, 2011.

On November 4, 2011, the Office issued a "Notice of Re Defective Paper" stating that the patent owner's June 17, 2011 response exceeded the 50-page limit requirement of 37 CFR 1.943(b). On November 21, 2011, the patent owner filed a petition under 37 CFR 1.181 requesting that the Office withdraw the "Notice of Re Defective Paper." [1] Since the patent owner's November 21, 2011 § 1.181 petition has not yet been decided, the instant patent owner petition under 37 CFR 1.183 is premature; if the patent owner's § 1.181 petition should be granted, then the present patent owner petition requesting waiver of the requirement of 37 CFR 1.943(b) would be moot, since there would be no need to consider waiver of a rule.[2] The patent owner retains the option of seasonably filing a renewed petition under 37 CFR 1.183 requesting waiver of the requirement of 37 CFR 1.943(b) for its response to the May 19, 2011 non-final Office action should the decision on the § 1.181 petition be not to grant the petition, and reconsideration of such a decision is not requested. Until such time, the issue is not ripe for consideration by the Office under 37 CFR 1.183. When no further petition under 37 CFR 1.181 is filed by the patent owner to withdraw the November 4, 2011 Notice of Defective paper, patent owner may renew the present petition under 37 CFR 1.183.

In view of the above, the petition under 37 CFR 1.183 is dismissed as premature.

PATENT OWNER'S CORRESPONDENCE ADDRESS

37 CFR 1.33(c) provides (emphasis added):

> All notices, official letters, and other communications for the patent owner or **owners in a reexamination proceeding will be directed to the correspondence address**. Amendments and other papers filed in a reexamination proceeding on behalf of the patent owner must be signed by the patent owner, or if there is more than one owner by all the owners, or by an attorney or agent of record in the patent file, or by a registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34. **Double correspondence with the patent owner or owners and the patent owner's attorney or agent, or with more than one attorney or agent, will not be undertaken.**

The correspondence address for the patent to be reexamined, or being reexamined is the correct address for all notices, official letters, and other communications for patent owners in reexamination proceedings.[3]

---

[1] It is noted that a copy of the original patent owner's response filed concurrently with the November 21, 2011 petition under 37 CFR 1.181 is unsigned.

[2] That is, if relief is granted under 37 CFR 1.181 to withdraw the November 4, 2011 Notice of Defective paper, then the present request to waive the page limit requirement of 37 CFR 1.943(b) for the patent owner response would be moot.

[3] *See* MPEP 2622

The current correspondence addresses found to be of record for the patent file and the reexamination proceeding are the same, which is the Foster Pepper, PLLC address listed on the November 21, 2011 patent owner petition under 37 CFR 1.183. However, the power of attorney filed on November 16, 2011 in the patent file is ineffective because a 37 CFR 3.73(b) statement was not filed by the assignee. The power of attorney filed on November 16, 2011, in the patent file was improperly accepted, and the acceptance of the power of attorney will be rescinded by the Central Reexamination Unit in due course. The correspondence address in the patent file will be changed back to Ortiz & Lopez, PLLC, P.O. Box 4484, Albuquerque, NM 87196-4484, and that address is the proper patent owner address for reexamination mailings pursuant to 37 CFR 1.33(c). Therefore, the correspondence address in this proceeding will be changed back to Ortiz & Lopez, PLLC, P.O. Box 4484, Albuquerque, NM 87196-4484 to conform with the patent, because no such transaction of correspondence address change properly occurred in the 7,826,877 patent file.

In this instance, a courtesy copy of this decision is being mailed to Foster Pepper, PLLC at the address listed on the November 21, 2011 patent owner petition under 37 CFR 1.183; no future courtesy copy should be expected in the future. Absent the concurrent filing of (1) a proper change of correspondence address in the patent file and (2) a new (i.e., renewed) request to change the correspondence address to the same address (i.e., Foster Pepper, PLLC address) for this proceeding, all future correspondence in the 95/001, 568 proceeding will be mailed to the proper address for the patent owner (i.e., Ortiz & Lopez, PLLC, P.O. Box 4484, Albuquerque, NM 87196-4484).

CONCLUSION

1. The patent owner petition under 37 CFR 1.183 filed on November 21, 2011 is dismissed as being premature.

2. **The parties are hereby put on NOTICE that absent the concurrent filing of a proper change of correspondence address in the patent file and a new (renewed) request to change the correspondence address in this proceeding to the same address, all future correspondence in the 95/001, 568 proceeding will be mailed to the proper address for the patent owner (i.e., Ortiz & Lopez, PLLC, P.O. Box 4484, Albuquerque, NM 87196-4484.**

3. Telephone inquiries related to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

/Kenneth M. Schor/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

01-25-201201-25-2012; pet3/

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,568	03/07/2011	7826877	206182-14003-101	5798

7590 02/02/2012

ORITIZ & LOPEZ PLLC
P.O. BOX 4484
ALBUQUERQUE, NM 87196-4484

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/02/2012

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,568	03/07/2011	7826877	206182-14003-101	5798

16579 7590 02/02/2012

Foster Pepper PLLC
1111 3rd Avenue Suite 3400
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/02/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
FOLEY AND LARDNER LLP
3000 K STREET, NW
SUITE 500
WASHINGTON, DC 20007

Date:
MAILED
FEB 02 2012
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001568
PATENT NO. : 7826877
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

ORTIZ & LOPEZ, PLLC P.O. BOX 4484 ALBUQUERQUE, NM 87196-4484	:	(For Patent Owner)
FOLEY & LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007	:	(For Third Party Requester)

In re: Ortiz *et al.* *Inter Partes* Reexamination Proceeding Control No.: 95/001,568 Deposited: March 7, 2011 For: U.S. Patent No.: 7,826,877	:	DECISION ON PETITION UNDER 37 CFR § 1.181

This is a decision on a petition filed by the patent owner on November 21, 2011, entitled: "PATENT OWNER'S PETITION UNDER 37 C.F.R. § 1.181" [hereinafter "the petition"].

The petition is a request to the Director to exercise his discretion pursuant to 37 CFR § 1.181 to review the examiner's action of holding a response as defective.

The petition is before the Director of the Central Reexamination Unit. The petition is denied.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,826,877 issued on November 2, 2010.
- A request for *inter partes* reexamination was filed on March 7, 2011 and assigned control no. 95/001,568.
- *Inter partes* reexamination was ordered and a rejection was mailed on May 19, 2011.
- On July 14, 2011, patent owner responded to the Office action.
- On October 13, 2011, the examiner issued a notice of defective paper holding patent owner's July 14, 2011 response non-compliant.
- On November 4, 2011, the examiner issued a new notice of defective paper holding the response non-compliant for lack of clarity and for being greater than the permissible length.
- On November 21, 2011 patent owner replied to the notice and filed the instant petition requesting withdrawal of the notice.
- A petition to waive the page limit requirement was also filed November 21, 2011, and was dismissed as premature on January 26, 2012.

POWER OF ATTORNEY & CORRESPONDENCE ADDRESS ISSUES

This paper is being mailed to the address of record in the patent. Patent owner has been told several times how to effectuate an address change and not to expect further courtesy copies at addresses not of record in the patent. *See, e.g.*, Decision mailed January 26, 2012 at pp. 2-3.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 C.F.R. § 1.943 Requirements of responses, written comments, and briefs in *inter partes* reexamination (in part)

(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.

MPEP § 2667(I)(A)(2) provides, in pertinent part (emphasis added):

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

Patent owner ["petitioner"] requests withdrawal of the November 4, 2011 Notice of Defective Paper ["Notice"]. The Notice held that the July 14, 2011 response was longer than the page limit set forth in 37 CFR § 1.943(b), and also required "that the response to this Notice must have clearer and larger text because the response . . . is difficult to read and does not readily permit direct reproduction." Notice at p. 3. Petitioner argues that its numerous declarations should not count against the page limit because they are drawn to facts and not arguments, and also argues

that the response met the various formatting requirements of the Office and any lack of clarity was not the fault of petitioner. Petitioner also has re-filed the response electronically in an attempt to cure any scanning issues and has redacted some sentences of the declarations.

Regarding the clarity issue, the Director agrees that at least the newly electronically filed response of November 21 is of adequate quality and appears to meet the Office's various formatting requirements. Any requirement in the Notice as to the clarity of the response is therefore withdrawn.

As to the length, the Director does not agree that the petitioner has shown the examiner acted improperly in holding the response non-compliant. Petitioner argues that the entirety of each declaration is factual in nature, and not argument. Petitioner cites to various prior petition decisions throughout the petition, characterizing them as "binding precedent" supporting its position.

The Director does not necessarily concede that petition decisions are "precedent" that is binding on the Office, as characterized by petitioner. But in any event, most of the proceedings cited by the petitioner included the above quoted paragraph from MPEP § 2667(I)(A)(2) in a petition decision concerning page limits. See 95/000,469 Decision July 16, 2010 at 2-3; 95/000,396 Decision May 6, 2010 at 2-3; 95/000,397 Decision May 26, 2010 at 3; 95/000,398 Decision May 5, 2010 at 2-3. The only one that does not, 95/000,016 Decision July 14, 2004, was decided prior to the MPEP being revised to include said paragraph. *Compare* MPEP Eighth ed. Rev. 6, Sept. 2007, *with* Rev. 7, July 2008 at http://www.uspto.gov/web/offices/pac/mpep/old/index.htm To the extent there is an Office policy as to this issue that is "binding", it is set forth in the MPEP as quoted above, as that can be considered the Office's interpretation of its regulations. *See Molins PLC v. Textron Inc.*, 33 USPQ2d 1823, 1828 n.10 (Fed. Cir. 1995) (stating the MPEP, while not law, is entitled to notice as the official interpretation of statutes and regulations with which it does not conflict). Thus, rather than look to unrelated petition decisions, whose facts and relevance to this proceeding are not even explained by petitioner, we will look to the MPEP to determine what types of information do and do not fall within the page limit requirement.

The MPEP states that a declaration containing opinions as to whether the art does or does not anticipate or render obvious claims, or specific claim elements, of the patent under reexamination, counts against the page limit. MPEP § 2667(I)(A)(2). Any argument as to how a rejection would be overcome counts against the limit. *Id.* Any page including such argument counts against the limit. *Id.* The MPEP gives examples of the types of material that do not count against the page limit, such as factual evidence of the dates of invention or publication, secondary consideration evidence such as test data, or the like. For example, a declaration drawn solely to the commercial success of the invention is the type of declaration that does not count against the page limit. It is apparent that the MPEP does not envision as "factual" whether a

reference teaches a particular claim limitation, as that would be an opinion as to whether the art does or does not anticipate a claim element, which is explicitly included within the page limit.

Here the response itself, without considering the declarations, is at least 47 pages (pages 1-47). The declarations include greater than three pages including argument, and thus the response is over the page limit.

The Gordon Declaration states that "ChoiceSeat was not a system for wirelessly receiving venue-based data at a hand-held device." Heading above ¶ 5 on p. 3. Gordon then says the requester is incorrect and that adapting ChoiceSeat to a wireless network (¶ 9 on p. 4) or to a hand-held client (¶ 10 on p. 5) would not have been obvious to a person of ordinary skill in the art. Gordon then states that the Choice seat system would have been significantly compromised if used wirelessly with a hand-held device. ¶ 12 on p. 6. Considering the claims are drawn to wirelessly receiving venue-based data at a hand-held device, all of these statements can be considered arguments as to why the art does not render the claims or claim elements obvious, and thus would be considered as falling under the page limit requirements. Thus, *at least* 4 pages of Gordon count against the limit.

The Javed Declaration at ¶ 10, pp. 5-6, explains that Bassett only mentions wireless networks in one sentence concerning satellite or microwave networks, and that use of wireless networks in hand held devices is far different. It is stated that this would not have been obvious to anyone reading the patent. Javed further states that just once is a notebook computer or PDA mentioned, but no explicit mention is made of a video stream over a wireless network. Javed concludes that it would not have been apparent to a person of ordinary skill in the art how video data streams are transferred from a wireless network to a receiving device. While none of this discussion directly mentions the claims, it is a clear discussion of why the reference does not render the claims unpatentable. Javed tells us that Verna does not transmit video over a data network to a server, which would be required to send it to a hand held device. ¶ 11 on p. 7. Javed additionally explains that Anderson cannot be combined with various other references. ¶ 12 on p. 8. At ¶ 13 (pp. 9-10) Javed tells us that Digital Video does not teach transmission of video data streams over wireless networks to handheld devices. All of these features that the references allegedly do not teach are related to the claims. Thus *at least* 6 pages of Javed count against the page limit.

The Matthews Declaration at ¶ 18 p. 2 states that Bassett and Matthews references fail to describe and instruct how to apply venue-based multimedia systems over wireless infrastructure. In other words, Matthews distinguishes the references from the '877 patent. At ¶¶ 20-21 p. 3 Matthews states that the references lack wireless infrastructure, comparing to SNQ1. At ¶ 23 p. 4 Matthews states that the ChoiceSeat system would be prior art if the '877 patent used wired networks, but of course the claims are limited to wireless activities. Again, even if the declaration does not explicitly refer to the claims, this is clearly argument concerning the

patentability of the claims. Moving on, Matthews compares Verna to the '877 patent in ¶ 24 pp. 5-6, and distinguishes the reference from the '877 patent because Verna is drawn to receiving discrete video clips and auxiliary information, while the '877 patent is drawn to time-unrestricted venue-based data, i.e. streaming video. All of these can be considered arguments as to why the art does not anticipate or make obvious limitations of the claims, and thus *at least* 4 pages of Matthews count against the page limit.

The Ferguson Declaration devotes three pages (pp. 3-5) to "the distinctions between Ortiz and the Bassett reference." Bassett was applied against the claims in the rejection, and features of the claims are mentioned, therefore it is apparent that these pages are arguments as to why the reference does not anticipate or render obvious elements of the claims. The same can be said of pp. 6-7, describing "the distinctions between Ortiz and the Anderson reference." Thus, *at least* 5 pages of the Ferguson Declaration count against the page limit.

The Davis Declaration describes how the references are different than the '877 patent, and that they are not associated with interactive, 2-way, wireless communication and delivery of consumer content. See ¶ 49 (p. 9). This is a clear comparison of the references to the '877 patent, an argument in favor of patentability. *At least* 1 page should count against the page limit.

The Knight Declaration spends a number of paragraphs directly contrasting Verna and Ortiz. See ¶¶ 17-34 on pp. 4-7. A number of times, Knight explicitly mentions the claims of Ortiz. See, e.g., ¶ 18. It is apparent that if one is contrasting the reference from the patent under reexamination, including its claims, then that person is expressing opinions about patentability. *At least* 3 pages should count against the page limit.

There are several other declarations, and the above discussion should not necessarily be considered exhaustive, but this is enough to show that the petitioner is taking an unreasonably limited view[1] of whether its declarations include facts or argument. It is enough to show that the examiner did not err in holding the response non-compliant. The Director concludes that at least the above 23 pages can be considered to include argument. Patent owner apparently believes, based on its redactions, that if it does not explicitly say "the reference anticipates/renders obvious the claims" then it is somehow not making an argument. Clearly, when the claims include "X" limitation, and the patent owner or his declarant states "the reference does not teach X" or "does not render obvious X" this is not intended as a mere description of facts. Under

[1] Petitioner is also advised that in future correspondence it would be useful for it to restrict its use of hyperbole and/or total misrepresentation of the examiner's position. For example, at petition p. 5 n. 2 petitioner states that the examiner held that Mr. Verna's description of celebrities he has met is argument. In actuality, the Notice pointed to pages 3-8 of the Verna Declaration as including argument, not to the particular paragraph concerning Mr. Verna's career or acquaintances. Page 3 is where Verna described celebrities he's met, and that page, prior to redaction, clearly stated at ¶ 15 that Verna's patent does not "negate[] Ortiz' invention." It was certainly reasonable for the examiner to find this to be an argument that Verna does not render the Ortiz patent unpatentable.

MPEP § 2667(I)(A)(2), it is "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."

Accordingly, the response was not compliant with 37 CFR § 1.943(b) and the examiner was not incorrect to hold it non-compliant. The petition is denied.

Patent owner did not file an appropriate response to the May 19, 2011 Office action. Accordingly, prosecution is hereby limited to the claims found patentable in that action. *See* 37 CFR § 1.957(c). It is also noted that the defect in the response was the length and patent owner filed a petition to waive the page limit requirement. That petition was dismissed as premature in the Decision mailed January 26, 2012, which also stated that patent owner could renew its petition if, as herein, the present petition were denied. Accordingly, patent owner has a time period of fourteen days from the mailing date of this decision to renew its petition under 37 CFR § 1.183 for waiver of the requirements of 37 CFR § 1.943 and avoid the limitation of prosecution. In deciding any such petition, the Office of Patent Legal Administration is of course free to determine whether even more pages of the various declarations should count against the page limit, and OPLA will decide such a petition accordingly based on its own determination of the pages to be counted.

CONCLUSION

1. Patent owner's petition filed November 21, 2011 is denied. The substitute response filed November 21, 2011 is not compliant and not accepted.

2. Patent owner has a period of fourteen days from the mailing date of this paper to renew its petition under § 1.183 for waiver of the 37 CFR § 1.943 page limit requirements.

3. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.

Irem Yucel
Director, Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,568	03/07/2011	7826877	206182-14003-101	5798

16579 7590 03/02/2012
Foster Pepper PLLC
1111 3rd Avenue Suite 3400
Seattle, WA 98101-3299

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 03/02/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
FOLEY AND LARDNER LLP
3000 K STREET, NW
SUITE 500
WASHINGTON, DC 20007

Date:

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MAR 02 2012

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001568
PATENT NO. : 7826877
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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ORTIZ & LOPEZ, PLLC
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(For Patent Owner)

GEORGE C. BECK
FOLEY & LARDNER, LLP
3000 K STREET, NW, SUITE 500
WASHINGTON, DC 20007

(For Third Party Requester)

Inter Partes Reexamination Proceeding	**DECISION**
Control No. 95/001,568	**DISMISSING**
Filed: March 7, 2011	**PETITION**
For: U.S. Patent No. 7,826,877	

This is a decision on the December 14, 2011 third party requester petition under 37 CFR 1.183 requesting waiver of the page limit requirement of 37 CFR 1.943(b) for its December 14, 2011 comments submission filed in reply to the November 21, 2011 patent owner response.

The third party requester petition is before the Office of Patent Legal Administration.

For the reasons set forth below, the third party requester petition is **dismissed**.

DECISION

In its petition, the third party requester requests waiver of the page limit requirement of 37 CFR 1.943(b) for its comments submission filed on December 14, 2011 that is directed to the November 21, 2011 patent owner response.

On February 2, 2012, the Office mailed decision denying patent owner's petition filed on November 21, 2011 requesting that the Office withdraw the November 4, 2011 Notice of defective paper. The decision also found that the patent owner's November 21, 2011 substitute response was not compliant and not accepted.

Pursuant to MPEP § 2667(I)(A)(2), "Any previously submitted third party comments in response to [the] 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."

Accordingly, the third party requester's December 14, 2011 petition requesting waiver of 37 CFR 1.943(b) for its December 14, 2011 comments submission is moot, and the third party requester's December 14, 2011 petition is dismissed as moot.

CONCLUSION

1. The third party requester's petition under 37 CFR 1.183 is **dismissed**.

2. Telephone inquiries with regard to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

03-01-2012

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16579 7590 03/07/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
FOLEY AND LARDNER LLP
3000 K STREET, NW
SUITE 500
WASHINGTON, DC 20007

Date: MAILED

MAR 07 2012

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001568
PATENT NO. : 7826877
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

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MAR 07 2012
CENTRAL REEXAMINATION UNIT

ORTIZ & LOPEZ, PLLC
P.O. BOX 4484
ALBUQUERQUE, NM 87196-4484

(For Patent Owner)

GEORGE C. BECK
FOLEY & LARDNER, LLP
3000 K STREET, NW, SUITE 500
WASHINGTON, DC 20007

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,568
Filed: March 7, 2011
For: U.S. Patent No. 7,826,877

DECISION DISMISSING PETITION

This is a decision on the February 16, 2012 patent owner petition under 37 CFR 1.183 requesting waiver of the page limit requirement of 37 CFR 1.943(b) for its February 16, 2012 response submission filed in reply to the May 19, 2011 non-final Office action.

The patent owner petition is before the Office of Patent Legal Administration.

For the reasons set forth below, the patent owner petition is **dismissed as moot**.

DECISION

In the February 16, 2012 petition, the patent owner requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for its February 16, 2012 response submission filed concurrently with the petition.

A review of the February 16, 2012 patent owner response submission shows that it is unsigned.[1] Therefore, it is an improper paper and will not be considered by the examiner. Accordingly, the

[1] It is further noted that the February 16, 2012 patent owner response contains numerous declarations **for the 95/001,566 and 95/001,565 proceedings** as identified on the first page of these declarations.

present patent owner petition is dismissed as moot because no proper timely response has been filed.[2]

Since the patent owner has failed to file a timely and appropriate response to the May 19, 2011 non-final Office action in which no claims were found patentable, prosecution is hereby terminated and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under 37 CFR 1.997 in accordance with the May 19, 2011 Office action. *See* 37 CFR 1.957(b).[3]

CONCLUSION

1. The patent owner petition under 37 CFR 1.183 is **dismissed**.

2. The proceeding is being referred to the Central Reexamination Unit for issuance of a Notice of Intent to Issue *Inter Partes* Reexamination Certificate (NIRC) in due course without consideration of the February 16, 2012 patent owner response submission.

3. Telephone inquiries with regard to this decision should be directed to Susy Tsang-Foster, Legal Advisor, at (571) 272-7711.

Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

03-05-2012

[2] This is the second time that the patent owner has submitted an unsigned response to the May 19, 2011 non-final Office action. As stated in the January 26, 2012 Office decision, the previous November 21, 2011 patent owner response submission was unsigned.

[3] The limitations of 37 CFR 1.957(c) discussed in the February 2, 2012 Office decision do not apply to the present proceeding because no claims have been found patentable in the May 19, 2011 non-final Office action. Instead, the provisions of 37 CFR 1.957(b) apply to this proceeding.

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2nd Reexam Group – Novak Druce + Quigg LLP (For Patent Owner)
1000 Louisiana Street, Fifty-Third Floor
Houston, TX 77002

Haynes and Boone, LLP (For '1571 *Inter Partes* Requester)
IP Section
2323 Victory Avenue, Suite 700
Dallas, TX 75219

MAILED

SEP 26 2011

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding	:	**DECISION**
Control No. 95/001,571	:	**GRANTING**
Filed: March 9, 2011	:	**PETITION**
For: U.S. Patent No. 6,993,669	:	

This is a decision on the third party requester paper entitled "PETITION TO WAIVE PAGE LIMIT REQUIREMENT FOR THIRD PARTY REQUESTER COMMENTS" (the petition under 37 CFR 1.183), filed on August 26, 2011.

The petition is before the Office of Patent Legal Administration for consideration.

The petition is granted for the reasons set forth herein.

BACKGROUND

1. On January 31, 2006 United States Patent No. 6,993,669 (the '669 patent) issued to Robert Warren Sherburne, Jr. with claims 1-22.

2. On March 9, 2011, a request for *inter partes* reexamination of claims 1-22 of the '669 patent was filed by a third party requester (the '1571 requester), which request was assigned Reexamination Control No. 95/001,571 (the '1571 proceeding).

3. On May 27, 2011, the Office ordered *inter partes* reexamination of claims 1-22 of the '669 patent in the '1571 proceeding and concurrently issued a non-final action rejecting claims 1-22.

4. On July 27, 2011, the patent owner timely filed a response to the non-final action in the '1571 proceeding with a claim amendment presenting new claims 23-38.

5. On August 26, 2011, the '1571 requester timely filed comments and concurrently filed the instant petition under 37 CFR 1.183.

DECISION

I. 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(b) provides:

> Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

II. Petition Under 37 CFR 1.183

On August 26, 2011, the '1571 requester filed the instant petition under 37 CFR 1.183, requesting waiver of the 50-page limit of 37 CFR 1.943(b) for its August 26, 2011 comments submission.

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a response in compliance with the 50-page limit, and submission of a resulting response that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted response. Such a response can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record. In this way, petitioner can rely on the proposed response: (1) for justification that more pages are needed to complete the response, and (2) to set forth an accurate determination of exactly how many additional pages petitioner deems to be needed for the response.

In support for a waiver of the rule, petitioner asserts:

> The Comments By Third Party Requester . . . include 23 pages (pp. 1-23) of comments directed to issues raised by the [patent owner's May 27, 2011]

> Remarks with respect to the original claims. The comments also refer to a declaration of Dr. Ray Mercer, which includes 15 pages (pp. 4-18) of discussion directed to the original claims. Thus, the Requester is providing 23 + 15 = 38 pages of discussion directed to the original claims.
>
> The Comments also include a new claim chart (Exhibit DD) that proposes several new rejections for the 16 new claims. In total, the new claim chart is 16 pages long. It is noted that the new claim chart is directed exclusively to the new claims, and does not propose any new or modified rejections of the original claims.[1]

Petitioner further states that "the total number of pages being provided . . . .exceeds the 50 page limit by 4 pages" and "[t]he Third Party Requester submits that this petition to waive is in keeping with the substantial interest of justice, in that the Requester should have the opportunity to effectively address all of the issues raised by the PO Remarks and each of the 16 new claims."[2]

III. Findings and Analysis

37 CFR 1.943(b) expressly excludes from the regulatory page count "amendments, appendices of claims, and reference materials such as prior art references." A document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains a legal argument that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological** facts, or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (see, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations **limited to** establishing commercial success, long-felt need and failure of others, skepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

In this instance, requester has made a showing in support of the request for waiver of 37 CFR 1.943(b) by submitting a comments submission that is in excess of 50 pages. With respect to the '1571 requester's August 26, 2011 comments submission, (1) 23 pages of the remarks portion, (2) up to 15 pages of the declaration of M. Ray Mercer, and (3) 16 pages of the claim chart are deemed to count toward the regulatory page limit such that the comments submission exceeds the 50-page limit.

---

[1] Petition at page 1.
[2] *Id.* at page 2.

Based on requester's showing in support of the request for waiver of the 50-page limit of 37 CFR 1.943(b) by attempting to draft comments in compliance with the 50-page limit and submitting the resulting comments which are in excess of 50 pages, and the individual facts and circumstances of this case such as, for example, the addition of 16 new claims (claims 23-38) by patent owner in the July 27, 2011 response submission, it is deemed equitable to waive the 50-page limit of 37 CFR 1.943(b) in this instance. Accordingly, the '1571 requester's petition under 37 CFR 1.183 is **granted** and the page limit of 37 CFR 1.943(b) is waived to the extent that requester's comments submission exceeds the regulatory page limit. **This waiver makes the '1571 requester's August 26, 2011 comments submission page-length compliant.**

CONCLUSION

1. The '1571 requester's petition under 37 CFR 1.183 is granted and the page limit of 37 CFR 1.943(b) is waived to the extent requester's August 26, 2011 comments submission exceeds the regulatory page limit. This waiver makes '1571 requester's August 26, 2011 comments submission page-length compliant.

2. Any questions concerning this communication should be directed to Nicole D. Haines, Legal Advisor, at (571) 272-7717.

Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

09-23-2011

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,573	03/15/2011	7,473,362	324.001	8571

34111 7590 09/12/2011

Maxey Law Offices, PLLC
15500 Roosevelt Blvd.
SUITE 305
CLEARWATER, FL 33760

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 09/12/2011

Please find below and/or attached an Office communication concerning this application or proceeding.

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NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD
11TH FLOOR
ARLINGTON, VA 22203

Date:

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SEP 12 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001573
PATENT NO. : 7473362
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry

addresses given at the end of the communication enclosed with this transmittal.

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CENTRAL REEXAMINATION UNIT

Michael J. Colitz, Jr.
640 Douglas Avenue
Dunedin, FL 34698

(For Patent Owner)

Nixon & Vanderhye, P.C.
901 North Glebe Road
11th Floor
Arlington, VA 22203

(For Third Party Requester)

Stephen Lewellyn
15500 Roosevelt Blvd., Suite 305
Clearwater, FL 33760

(On Petition)

In re Nohren, Jr.	:	
Inter Partes Reexamination Proceeding	:	DECISION ON
Control No. 95/001,573	:	PETITION UNDER
Filed: March 15, 2011	:	37 CFR 1.181
For: U.S. Patent No. 7,473,362	:	

The paper filed by patent owner on May 26, 2011, entitled "Petition to Vacate the Order Granting Reexamination" is being treated as a petition under 37 CFR 1.181 (hereinafter the Petition). The Petition is before the Group Director overseeing the Central Reexamination Unit (CRU). Petitioner, the patent owner, seeks vacatur of the Order Granting the Request for *Inter Partes* Reexamination mailed April 22, 2011.

The Petition is **DENIED**.

REVIEW OF FACTS

1. U.S. Patent No. 7,473,362 (hereinafter, the '362 patent) issued on January 6, 2009.

2. A request for *inter partes* reexamination was filed by a third party requestor, on March 15, 2011. The resulting reexamination proceeding was assigned Control No. 95/001,573 (hereinafter, the '573 proceeding).

3. Reexamination was requested for claims 1-17 of the '362 patent.

4. A Notice of Reexamination Request Filing Date was issued on March 23, 2011.

5. An order granting the request for reexamination for claims 1-17 was mailed on April 22, 2011.

6. On even date, a non-final Office action in the '573 proceeding was mailed. Claims 1-17 were rejected over the prior art presented in the request.

7. On May 26, 2011, the patent owner filed the present Petition under 37 CFR §§ 1.181.

8. Subsequent to the filing of the petition, patent owner has filed a response to the non-final Office action mailed April 22, 2011 (filed June 22, 2011) and the third party requester has filed a response to the patent owner's response (filed July 21, 2011).

SUMMARY OF PETITIONER'S GROUNDS IN SUPPORT OF THE REQUESTED RELIEF

Petitioner requests that the order granting reexamination be vacated because the request included 1) allegations of fraud and misconduct and 2) improper information pertaining to litigation. See page 2 of the petition. Petitioner further argues that allegations of fraud and misconduct have no bearing on how patent or printed publications might establish or raise a substantial new question of patentability and thus, the filing dates for the reexamination proceeding should be vacated. See pages 2 and 5 of the petition. Petitioner specifically points to pages 4, 5, 5 fn. 5, 6 fn. 11, 7, 9, 10 and 16-19 as examples of allegations of fraud and misconduct made by the requester in the request. See page 2 of the petition. Petitioner further argues that the request contains discussions of prior litigation that has no bearing on how patents or publications might establish/raise a substantial new question of patentability and would unduly lengthen and complicate the record. See page 4 of the petition.

DECISION

I. Standard of Review

35 USC § 312(c) and 37 CFR 1.927 provide for the filing of a petition to review an examiner's determination refusing to order *inter partes* reexamination. The CRU Director's review on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination for claims 1-46 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination for claims 1-46 of the '915 patent.

II. The Legal Standard for Ordering Reexamination

A review of 35 USC §§ 311-317 and 37 CFR 1.915, 1.919, and 1.923 shows that *inter partes* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. In particular, 35 USC 311(a) requires that a request for *inter partes* reexamination be based upon prior art as set forth in 35 USC § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.915(b)(3) requires that a request for *inter partes* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final holding of invalidity after all appeals, or by the Office in a previous examination or in a reexamination of a patent.

In accordance with this legislative history for the original reexamination statute,[1] MPEP 2642, part II.A. was drafted to require, in order to raise a SNQ for old art, that the old art must be "presented/viewed in a new light, or in a different way, as compared with its use in the earlier examination(s), in view of a material new argument or interpretation presented in the request." This new light must be in terms of how to interpret the state of the "pre-existing technology," as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. For example, a reference may be read in a "new light" if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent. If a substantial new question of patentability is found, an order for *inter partes* reexamination of the

[1] Public Law 96-517, enacted on December 12, 1980.

patent is issued. An SNQ is not raised by the old prior art if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to the patent and has decided that question in favor of the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

III. Analysis

Patent owner does not argue or show that the order failed to establish that the cited references presented a new technical teaching that would be important to a reasonable examiner in determining the patentability of claims 1-17. Patent owner, instead, argues that the request contained improper allegations of misconduct and fraud and improper discussions of prior litigation and, for those reasons, should be vacated.

Upon review of the reexamination record, the record does not support petitioner's conclusion that the request should be vacated because it contains allegations of fraud and misconduct and discussions of prior litigation. The noted instances of the allegations of fraud and misconduct in the request do not rise to the level of offenses that are either reportable to the Office of Enrollment and Discipline or that would interfere with the timely processing of the instant re-examination proceeding. Furthermore, it should be noted that requesters are permitted to discuss prior litigation in a request. Such as discussion does not unduly lengthen and/or complicate the record. The record reveals that the order properly stated how the teachings of cited references present new, non-cumulative technological teachings. It is not required that the examiner include a discussion of the prior litigation nor is it required that the examiner address any statements made by opposing parties. The requirement remains that the cited references have teachings that a reasonable examiner would consider important in determining whether claims 1-17 of the '362 patent are patentable. The order of April 22, 2011 provides such a showing to meet this requirement on 2-4. Therefore, the determination that the cited references raise a SNQ with respect to claims 1-17 of the '362 patent was in accordance with 35 U.S.C. 311 and 312, its implementing regulations, 37 CFR 1.915 and 1.922, and the guidelines set forth in MPEP 2640, 2642, 2644, and 2646. Accordingly, Office had discretion to grant the request for reexamination.

In view of the above, the petition to vacate the reexamination proceeding is denied.

PATENT OWNER'S CORRESPONDENCE ADDRESS

The current power of attorney and correspondence address remains to be Michael J. Colitz, Jr., 640 Douglas Avenue
Dunedin, FL 34698. Patent owner is called upon to file any change of power of attorney and correspondence address in the patent file in order to properly effectuate a change in this reexamination proceeding. As a courtesy, this decision is being mailed to the address listed in the May 26, 2011 petition. However, all future correspondence may only be

made to the official correspondence address of record at the time the correspondence is mailed.

CONCLUSION

1. The patent owner's petition vacate the reexamination under 37 CFR §§ 1.181 is hereby **denied.**

2. Jurisdiction over the present reexamination proceeding is hereby forwarded to the examiner in charge of the proceeding for further action.

4. Response should be addressed as follows:

By Mail to: Mail Stop *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
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By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html . EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

5. Telephone inquiries with regard to this decision should be directed to Deborah Jones at (571) 272-1535.

IREM YUCEL
DIRECTOR
TECHNOLOGY CENTER 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,573	03/15/2011	7,473,362	324.001	8571

34111 7590 02/24/2012

Maxey Law Offices, PLLC
15500 Roosevelt Blvd.
SUITE 305
CLEARWATER, FL 33760

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/24/2012

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Date:

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CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001573
PATENT NO. : 7473362
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

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Maxey Law Offices, PLLC
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(Patent Owner)

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FEB 24 2012

CENTRAL REEXAMINATION UNIT

Nixon & Vanderhye P.C.
901 North Glebe Road, 11th Floor
Arlington, VA 22203

(Requester)

Inventor: Nohren, Jr.	: **DECISION ON**
Inter Partes Reexamination Proceeding	: **§§ 1.182/1.183 PETITIONS**
95/001,573	:
Filed: March 15, 2011	:
For: U. S. Patent No. 7,473,362	:
Issued: January 6, 2009	:
Title: Water Treatment System	:

This is a decision on (1) an August 22, 2011 patent owner petition, which will be treated under § 1.182, seeking to disqualify a law firm from representing the requester, and (2) a September 2, 2011 requester opposition to the patent owner petition supported by a requester petition under §§ 1.182 and/or 1.183. The requester petition also requests the imposition of sanctions under 37 CFR 11.18. The petitions and opposition are now before the Office of Patent Legal Administration for decision.

The patent owner § 1.182 petition, and the requester opposition supported by a petition under §§ 1.182 and/or 1.183 are dismissed and will be closed along with the instant decision.

Fees

A review of Office records reveals payment of the $400 § 1.182 patent owner petition fee pursuant to § 1.17(f).

A review of Office records reveals payment of the $400 § 1.182 and/or 1.183 requester petition fee pursuant to § 1.17(f).

Brief Review of Facts

1. U.S. Patent No. 7,473,362 (the '362 patent) issued on January 6, 2009.

2. On March 15, 2011 a request for *inter partes* reexamination of claims 1-17 was filed by the third party requester (Nixon & Vanderhye P.C.) and identified Alhstrom Filtration LLC as the real party in interest.. The request was assigned Control No. 95/001,573 (the '1,573 reexamination proceedings).

3. On April 22, 2011 an Order Granting Request for Inter Partes Reexamination was mailed concurrently with a non-final action.

4. On May 26, 2011 the patent owner filed "PETITION TO VACATE THE ORDER GRANTING REEXAMINATION."

5. On June 22, 2011 the patent owner filed a response to the non-final action.

6. On July 21, 2011 the third party requester filed comments to the patent owner's June 22, 2011 response.

7. On August 22, 2011 the patent owner filed the instant § 1.182 petition to disqualify the firm of Nixon & Vanderhye P.C. from representing the third party requester in the instant '1,573 reexamination proceedings.

8. On September 2, 2011 the third party requester submitted §§ 1.182 and/or 1.183 petitions and an opposition to the patent owner's August 22, 2011 § 1.182 petition to disqualify Nixon & Vanderhye P.C., and a petition under § 11.18 to impose sanctions on the patent owner.

Patent Owner Petition to Disqualify Practitioner for Requester

The patent owner's August 22, 2011 § 1.182 petition states that it seeks to disqualify the firm of Nixon and Vanderhye P.C. from representing the third party requester in the instant reexamination proceeding. The patent owner alleges a conflict of interest based upon:

A. Former Representation – The patent owner alleges that the patent owner is a former client or vicarious client of Nixon & Vanderhye, due to his position as Chairman for Nixon & Vanderhye's client Innova Pure Water, Inc.[1] During the time the patent owner was Chairman for Innova, Nixon & Vanderhye prosecuted numerous patent applications for Innova as directed by the patent owner and represented Innova in patent infringement suits. Several of these patent applications are now being asserted by Nixon & Vanderhye against the patent owner to invalidate the '362 patent. The patent owner alleges these patent applications are substantially related subject matter to the '362 patent such that Nixon & Vanderhye should be disqualified from representing the adverse party in this proceeding.[2]

B. Possession of Confidential Information – The patent owner alleges Nixon & Vanderhye possesses relevant confidential information from its prior representation of Innova and the patent owner.[3] This confidential information includes (1) methods for evaluating patent-infringement allegations, (2) the existence and use of prior art and (3) the intimate relationship between prior and subsequent patents invented by the patent owner and Innova. The patent owner alleges this confidential information puts Nixon

[1] Patent Owner petition at page 9.
[2] *Id* at 8.
[3] *Id* at 9.

& Vanderhye at a significant advantage in the proceedings and, therefore, Nixon & Vanderhye should be disqualified.[4]

Requester Petition and Opposition to Disqualification of its Counsel and Petition to Impose Sanctions

A substantive response to the position taken by patent owner is set forth in the belief that should patent owner's petition for disqualification be entertained, so would an opposition thereto be entertained.

The requester opposes the disqualification of its counsel on the following grounds:

A. Lack of Former Representation – The requester alleges that Nixon & Vanderhye never represented the patent owner personally, but rather Innova.[5] The patent owner had been notified on several occasions that Nixon and Vanderhye represented Innova and to represent the patent owner as well may have been an ethical violation.[6] Further, the requester states the USPTO does not recognize the "vicarious client" theory and an extension of this theory to corporate clients is unwarranted by law.[7]

B. Information is Not "Substantially Related" – The requester asserts the "substantial relationship" test requires a showing that the subject matter of the prior applications and the '362 is identical or essentially the same.[8] Due to the fact that the Examiner only allowed the '362 patent because the prior applications did not teach the particular filtration media, the prior applications do not describe the identical or essentially same subject matter of the '362 patent.[9]

C. Information is Not Confidential – The requester asserts all the alleged confidential information is either publicly available or information regarding Innova and not the patent owner.[10] Further, the requester alleges that Mr. Kagen, the counsel that prosecuted the previous applications, has been screened from any participation in the current proceedings so that any of the patent owner's potential confidential information has not been compromised.[11]

In conjunction with the above petition, the requester, also, requests the USPTO to sanction the patent owner for violating § 11.18. The requester alleges the petition to disqualify is litigation-style tactic to increase delay and expense in the proceeding.[12] This allegation is based on arguments that the petition is not timely,[13] omits and buries highly relevant information,[14] and misrepresents or omits governing law.[15]

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[4] *Id.*
[5] Requester petition at 10.
[6] *Id* at 11-13.
[7] *Id* at 13-17.
[8] *Id* at 17.
[9] *Id* at 18.
[10] *Id* at 19.
[11] *Id* at 20.
[12] *Id* at 21.
[13] *Id* at 23.
[14] *Id* at 24 and 25.

Standard for Disqualification of Opposing Counsel.

The Office does not have a specific rule which governs submission of a petition to disqualify opposing counsel and such matters are therefore handled under § 1.182.[16] Decisions on such petitions will be based on the provisions of the Office's Code of Professional Responsibility, aided by decisions of federal courts.[17]

The Office has utilized the following standard in regard to representations of patent matters[18]:

> An attorney should be disqualified if a party can show that the:
> (1) attorney was its former attorney,
> (2) attorney now represents an adverse party, and
> (3) subject matter embraced by the present representation is "substantially related" to the subject matter where the attorney previously represented the first party.

The assumption will be made where the standard is met that confidences were disclosed an inquiry will not be made into their nature and extent.[19] The Office has chosen a narrow interpretation of the expression "substantially related" to mean 'identical or essentially the same."[20]

Decision

I. The patent owner petition seeking removal of counsel for requester is defective for: inappropriate forum. A review of the § 1.182 petition to disqualify a practitioner reveals that the intent of the petition is to raise the issue of attorney conflict in the context of the instant reexamination proceeding.[21] The reexamination statute, rules and procedures do not provide for resolution of attorney conflicts. Therefore, the instant reexamination proceeding is not the forum for resolving this issue. Instead, the appropriate vehicle for addressing this issue is a request to the Director of the U.S. Patent & Trademark Office that the practitioner be disqualified.

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[15] *Id* at 25.

[16] 35 U.S.C. 32 is directed towards exclusion of a practitioner shown to be "incompetent, or disreputable, or guilty of gross misconduct ...." 37 CFR 11.19(c) states "[p]etitions to disqualify a practitioner in ex parte or inter partes matters in the Office are not governed by §§ 11.19 through 11.60 and will be handled on a case-by-case basis under such conditions as the USPTO Director deems appropriate. The MPEP does not generally address Part 11, and in particular §11.19(c).

[17] *Anderson, et al., Junior Party (Patent 5,399,346) v. Eppstein et al., Senior Party (Application 08/609,702),* Disqualification Case No. 98-1, Board of Patent Appeals and Interferences, 2001 Pat App. Lexis 1.

[18] SCM v. Aktieselskabet Niro Atomizer.

[19] *Anderson v Eppstein*

[20] *Id.*

[21] *E.g.*, the heading of the petition is directed to the reexamination file as would any paper intended to be submitted in the reexamination file. Moreover, there is no explicit request that the Director of the Office address this matter.

II. The requester petitions and opposition will not be treated in view of the dismissal of the patent owner petition. It is noted that it would be premature to decide on the petition to impose sanctions under § 11.18 at this time. In order to impose sanctions under § 11.18(c), there must be a finding of a violation of § 11.18(b)(2)(i) through (iv). Such a finding would be impractical without a ruling on the petition to disqualify by the Director.

Conclusion

1. The patent owner petition, seeking removal of counsel for requester, will not be treated.

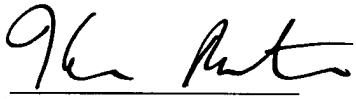
2. The requester petition and opposition to patent owner petition will not be treated.

3. The following papers will be closed:

   A. August 22, 2011 § 1.182 petition by patent owner,

   B. September 2, 2011 § 1.182 petition and opposition to patent owner petition, and

   C. The instant decision.



Hiram H. Bernstein
Senior Legal Advisor
Office of Patent Legal Administration
(571) 272-7710

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET.NO.	CONFIRMATION NO.
95/001,576	03/16/2011	6757682	2230.0002L	1495

27896 7590 06/24/2011

EDELL, SHAPIRO & FINNAN, LLC
1901 RESEARCH BOULEVARD
SUITE 400
ROCKVILLE, MD 20850

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/24/2011

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Date: 6-24-11

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
Lissi M. Marquis
NOVAK DRUCE & QUIGG(2nd REEXAM GROUP)
1000 Louisiana Street, 53rd Floor
Houston, TX 77002

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001576
PATENT NO. : 6757682
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

Decision on Petition for Extension of Time in Reexamination	Control No.: 95/001,576

1. THIS IS A DECISION ON THE PETITION FILED 21 June 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:
   A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS
   Patent owner requests that the period for responding to the Office action dated 03 June 2011 which sets a two (2) month period for filing a response to the Office action, be extended by one (1) month.

   A. ☒ Petition fee per 37 CFR §1.17(g)):
      i. ☐ Petition includes authorization to debit a deposit account.
      ii. ☐ Petition includes authorization to charge a credit card account.
      iii. ☐ Other: _____.
   B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
   C. ☒ Petition was timely filed.
   D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)
   A. ☐ Granted or ☒ Granted-in-part for seven (7) days, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
   B. ☒ Other/comment: see attached
   C. ☐ Dismissed because:
      i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
      ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
      iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
      iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
      v. ☐ The petition is moot.
      vi. ☐ Other/comment: _____.

5. CONCLUSION

   Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611. In his/her absence, calls may be directed to Eric Keasel at 571-272-4929 in the Central Reexamination Unit.

/Mark Reinhart/	SPE, AU 3992 Central Reexamination Unit
[*Signature*]	(Title)

In consideration of providing the patent owner with a fair opportunity to present an argument against any attack on the patent as balanced with the statutory mandate of conducting reexamination proceedings with special dispatch the Office must fully consider the facts presented in any petitions for extension of time. This is the second request for extension of time in this proceeding. While the petition speaks to the considerations of the unexpected need to seek new counsel following the mailing of the first action on the merits, the petitioner additionally notes that the time with the prior law firm is "lost." It is agreed that patent owner needs to be given opportunity to complete all aspects of investigation prior to responding to the first Office action on the merits in a reexamination proceeding. This is why, absent litigation stayed for reexamination all patent owners are given a response period of two months for preparation of a response. Yet it is Patent owner who must exercise diligence in responding to an outstanding office action. The requirement for reasonably diligent behavior by patent owner includes a reasonable expectation of resource management. Resource management takes into consideration the actions by counsel representing the patent owner. It is expected that the time with the earlier counsel was in fact monitored by the patent owner who must exercise diligence in response to any Office action.

It is noted that the patent owner did not expect the earlier counsel to withdraw and the time lost seeking new representation could not have been anticipated. As such the time from 08 June 2011 when the patent owner was apprised of the withdrawal of the representation and the new counsel on 15 June 2011 suggests a period of seven (7) days during which action could not have been taken.

On balance the petition for extension of time supports "sufficient cause" to grant a seven (7) day extension of time.

The petition for extension of time is hereby granted-in-part.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,577	03/16/2011	Paul A. FREIBERGER	2607.335REX1	1540

27896 7590 06/20/2011

EDELL, SHAPIRO & FINNAN, LLC
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ROCKVILLE, MD 20850

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/20/2011

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,577	03/16/2011	6,778,314	

STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, NW
WASHINGTON, DC 20006

EXAMINER
HUGHES, DEANDRA

ART UNIT	PAPER
3992	

DATE MAILED:

06/20/11

INTER PARTES REEXAMINATION COMMUNICATION

BELOW/ATTACHED YOU WILL FIND A COMMUNICATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE OFFICIAL(S) IN CHARGE OF THE PRESENT REEXAMINATION PROCEEDING.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this communication.

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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,577	03/16/2011	6,778,314	

STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, NW
WASHINGTON, DC 20006

EXAMINER
HUGHES, DEANDRA

ART UNIT	PAPER
3992	

DATE MAILED:

INTER PARTES REEXAMINATION COMMUNICATION

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(For Patent Owner)

MAILED

JUN 20 2011

CENTRAL REEXAMINATION UNIT

EDELL, SHAPIRO & FINNAN, LLC
1901 RESEARCH BOULEVARD
SUITE 400
ROCKVILLE MD 20850

(For Third-Party Requester)

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

In re Freiberger *et alia*	: DECISION
Reexamination Proceeding	: DISMISSING
Control No. 95/001,577	: PETITION FOR
Request Deposited: March 16, 2011	: EXTENSTION OF TIME
For: U.S. Patent No. 6,778,314	: 37 CFR 1.956

This is a decision on the June 15, 2011, patent owner "REQUEST FOR EXTENSION OF TIME PURSUANT TO 37 C.F.R. §1.956" requesting a two-month extension of time to respond to the May 19, 2011 Office Action.

The petition is before the Central Reexamination Unit for consideration.

The petition is **dismissed** for a two-month extension of time for the reasons set forth below.

DECISION

The Patent Owner requests an extension of time in which to file a response to the office action mailed May 19, 2011. The request for extension is the first request for an extension of time. The present petition for extension of time was timely filed on June 15, 2011, together with fee set forth in 37 CFR 1.17(g). The petition is considered under 37 CFR 1.956.

37 CFR 1.956 states:

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 of time request, MPEP 2665 states, in pertinent part:

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 stated in the request will be evaluated by the CRU Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period.

MPEP 2665 also states, in part, "requests for more than one month, will be granted only in extraordinary situations."

Analysis and Findings

On balance, the Patent Owner's showing of "sufficient cause" is insufficient to justify a two-month extension of time.

A review of the record reveals that a non-final office action was mailed on May 19, 2011. In said action, the office rejected each of the 15 claims over either Kjorsvik (a 19-page patent) alone or Kjorsvik in view of Salm (4 pages of a Popular Mechanics article). The remainder of the action explained why various other proposed rejections based on those two references as well as a third patent (Rakavy) were not adopted. The action set a two-month period for response.

It is noted that patent owner spent one week of the 2-month period for response seeking new representation. However, this does not rise to the level of an extraordinary situation. Thus seeking an additional 2 months to respond is not justified. Given the relatively few issues before patent owner, the 2-month period for response is considered sufficient to provide patent owner with a fair opportunity to respond.

Petitioner's request for an extension of time is **dismissed.**

CONCLUSION

1. Petitioner's request is **dismissed**.

2. **All** correspondence relating to this *inter partes* reexamination proceeding should be directed:

By EFS: Registered users may submit via the electronic filing system EFS-Web, at **https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html**.

By Mail to: Mail Stop *Inter Partes* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

3. Telephone inquiries related to this decision should be directed to Eric Keasel, at (571) 272-4929, or Mark Reinhart, at (571) 272-1611, Jessica Harrison, at (571) 272-4449.

Eric Keasel

Eric Keasel
SPE, AU 3992

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,577	03/16/2011	Paul A. FREIBERGER	2230.0001L	1540

27896 7590 06/23/2011

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SUITE 400
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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 06/23/2011

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, NW
WASHINGTON, DC 20005

Date:

MAILED

JUN 23 2011

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001577
PATENT NO. : 6778314
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

Decision on Petition for Extension of Time in Reexamination	Control No.: 95/001,577

MAILED

JUN 23 2011

CENTRAL REEXAMINATION UNIT

1. THIS IS A DECISION ON THE PETITION FILED 22 June 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:
   A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.

   The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS
   Patent owner requests that the period for responding to the Office action dated 19 May 2011 which sets a two (2) month period for filing a response to the Office action, be extended by one (1) month.

   A. ☒ Petition fee per 37 CFR §1.17(g)):
      i. ☐ Petition includes authorization to debit a deposit account.
      ii. ☐ Petition includes authorization to charge a credit card account.
      iii. ☐ Other: _____.
   B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
   C. ☒ Petition was timely filed.
   D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)
   A. ☐ Granted or ☒ Granted-in-part for seven (7) days, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
   B. ☒ Other/comment: see attached
   C. ☐ Dismissed because:
      i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
      ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
      iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
      iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
      v. ☐ The petition is moot.
      vi. ☐ Other/comment: _____.

5. CONCLUSION

   Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611. In his/her absence, calls may be directed to Eric Keasel at 571-272-4929 in the Central Reexamination Unit.

/Mark Reinhart/	SPE, AU 3992 Central Reexamination Unit
[*Signature*]	(Title)

In consideration of providing the patent owner with a fair opportunity to present an argument against any attack on the patent as balanced with the statutory mandate of conducting reexamination proceedings with special dispatch that the Office must fully consider the facts presented in any petitions for extension of time. This is the second request for extension of time in this proceeding. While the petition speaks to the considerations of the unexpected need to seek new counsel following the mailing of the first action on the merits, the petitioner additionally notes that the time with the prior law firm is "lost." It is agreed that patent owner needs to be given opportunity to complete all aspects of investigation prior to responding to the first Office action on the merits in a reexamination proceeding. This is why, absent litigation stayed for reexamination all patent owners are given a response period of two months for preparation of a response. Yet it is Patent owner who must exercise diligence in responding to an outstanding office action. The requirement for reasonably diligent behavior by patent owner includes a reasonable expectation of resource management. Resource management takes into consideration the actions by counsel representing the patent owner. It is expected that the time with the earlier counsel was in fact monitored by the patent owner who must exercise diligence in response to any Office action.

It is noted that the patent owner did not expect the earlier counsel to withdraw and the time lost seeking new representation could not have been anticipated. As such the time from 08 June 2011 when the patent owner was apprised of the withdrawal of the representation and the new counsel on 15 June 2011 suggests a period of seven (7) days during which action could not have been taken.

On balance the petition for extension of time supports "sufficient cause" to grant a seven (7) day extension of time.

The petition for extension of time is hereby granted-in-part.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,578	04/19/2011	Dino J Farina	3028-0039	5314

32361 7590 02/27/2012

GREENBERG TRAURIG (NY)
MET LIFE BUILDING
200 PARK AVENUE
NEW YORK, NY 10166

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 02/27/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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ALEXANDRIA, VA 22314

Date: MAILED

FEB 27 2012

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001578
PATENT NO. : 6785400
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 27 2012

CENTRAL REEXAMINATION UNIT

Kenealy Vaidya, LLP (For Third Party Requester)
515 East Braddock Rd., Suite B
Alexandria, VA 22314

In re Farina	:	
Inter partes Reexamination Proceeding	:	**DECISION**
Control No: 95/001,578	:	**ON**
Filing Date: April 19, 2011	:	**PETITON**
For: U.S. Patent No.: 6,785,400	:	

This is a decision on patent owner's August 29, 2011 petition entitled "Proveris Scientific Corporation's Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317, 37 C.F.R. § 1.907(b), And MPEP § 2612" (patent owner's August 29, 2011 petition).

This decision also addresses requester's September 28, 2011 opposition paper, entitled "Response in Opposition to Proveris Scientific Corporation's Petition to Terminate *Inter Partes* Reexamination Pursuant to 35 U.S.C. § 317, 37 C.F.R. § 1.907(b), And MPEP § 2612" (requester's September 28, 2011 opposition).

Patent owner's August 29, 2011 petition, requester's September 28, 2011 opposition, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

The August 29, 2011 patent owner petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **dismissed**.

The Office, *sua sponte*, makes the following determination. A supplemental right of appeal notice (RAN) pursuant to this decision will follow. **The estoppel provisions of 35 U.S.C. 317(b) apply to any rejection in this proceeding of any of claims 3-10 and 13 that is limited to the application of one or more of the '333 patent, Deljouravesh, and Settles references.**

Any rejection in the '1578 reexamination proceeding which is presently applied against any of claims 3-10 and 13 of the '400 patent, i.e., the patent under reexamination, and which is limited to the application of one or more of the '333 patent, Deljouravesh, and Settles references, **will not be further maintained by the Office**. No further rejection of any of claims 3-10 and 13 of

the '400 patent, that is limited to the application of one or more of the '333 patent, Deljouravesh, and Settles references, **will be made** in the present reexamination proceeding.

The determination in this decision not to maintain any rejection of any of claims 3-10 and 13 of the '400 patent which is limited to the application of one or more of the '333 patent, Deljouravesh, and Settles references, is made pursuant to the estoppel provisions of 35 U.S.C. 317(b), and **is not a "non-adoption of" or a "determination not to make" such a rejection within the meaning of 37 CFR 41.61.** Any notice of appeal or cross-appeal of the present determination not to make or maintain a rejection of any of claims 3-10 and 13 of the '400 patent, which is limited to the application of one or more of the '333 patent, Deljouravesh, and Settles references, will be held to be **defective**.

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/001,578 (the '1578 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

> Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office . . . This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 35 U.S.C. 317(b) by determining whether:

1. The third party requester was a party to the litigation;
2. The decision is final, i.e., after all appeals;
3. The court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit, which claim is also under reexamination; and
4. The issue(s) raised in the reexamination proceeding are the same issue(s) that were raised or could have been raised by the requester in the civil action.

The patent owner informs the Office that the patent under reexamination, U.S. Patent 6,785,400 (the '400 patent), was the subject of a civil action, *Proveris Scientific Corporation v. InnovaSystems, Inc.*, 536 F.3d 1256, 87 USPQ2d 1602 (Fed. Cir. 2008). While the patent owner does not provide a copy of the decision, the Office was able to quickly obtain it.[1] Also, after brief

[1] The patent owner is reminded that documents filed in support of a petition must either be concurrently filed as an exhibit, or an attachment, to the petition, or, if the evidence has been filed prior to the petition, the evidence must be referenced in the petition such a manner that the evidence may be quickly located in the file of the reexamination proceeding after only a brief review. This is necessary due to the Office's statutory mandate to conduct reexamination proceedings with special dispatch, pursuant to 35 U.S.C. 314(c).

review of the file, the Office was able to verify that the requester of the instant reexamination proceeding was a defendant in the litigation.[2] The patent owner states that the district court granted patent owner's motion for judgment as a matter of law (JMOL) "as to requester's invalidity defense", which the requester appealed to the Federal Circuit. The patent owner, however, fails to specifically describe "requester's invalidity defense".[3] Again, after brief review of the Federal Circuit decision, requester's invalidity defense, apparently, was that claims 1, 2, and 9 of the '400 patent were invalid by reason of obviousness and that claims 3-8, 10, and 13 were invalid as anticipated by a single prior art reference. *Id* at 1267. The district court excluded or limited the expert testimony of requester's invalidity experts, and ruled in favor of the patent owner on the issue of validity as a matter of law. The Federal Circuit upheld the district court's ruling, holding that the district court did not abuse its discretion in excluding or limiting requester's invalidity experts. No record can be found of any further appellate action with respect to this decision. Since the Federal Circuit decision was rendered in 2008, the decision by the district court is determined to be a final decision. For these reasons, elements 1 and 2 have been satisfied.

Furthermore, since the court's decision was adverse to the requester on the issue of validity as matter of law, the decision is determined to be a final decision that the requester/defendant did not sustain its burden of proving the invalidity of the patent claims in suit, i.e., claims 1-10 and 13. The patent claims in suit, however, are not identical to the claims under reexamination. The claims under reexamination in the present proceeding are claims 3-13. Claims 11 and 12 were not at issue in the litigation. For this reason, element 3 appears to have been satisfied only with respect to claims 3-10 and 13.

Regarding element 4, the patent owner argues that the requester "raised or could have raised", during the civil action, "issues that it has raised in the request". Office records reveal that the present reexamination proceeding is based not only upon prior art raised in the litigation, but also upon other references. In the present reexamination proceeding, the requester raised issues regarding the patentability of the claims in view of at least nine references, only three of which were also raised in the litigation (i.e., the '333 patent, Deljouravesh, and Settles).[4] Thus, the

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[2]The patent owner is also reminded that the patent owner has the burden of providing a sufficient showing that each of the above-listed factors are met. Merely stating, for example, that the requester was a defendant in the litigation is insufficient. In the present case, after brief review, the Office was able to verify patent owner's statement, and was able to obtain the citation for the litigation. <u>However, if more than a brief review of the file is required to determine the above factors, then the showing of the patent owner will be determined to be insufficient</u>.

[3] Again see footnote 2. The patent owner has the burden of providing a sufficient showing that each of the above-listed factors is met. If more than a brief review of the file is required to determine the above factors, then the showing of the patent owner will be determined to be insufficient.

[4] The three references that were also raised in the litigation are:
1) U.S. Patent No. 5,396,333 (the '333 patent);
2) "An Optical Patternator for Quantitative and On-Line Spray Diagnostics", Rama Deljouravesh, Thesis Submitted to the Department of Mechanical Engineering, Queen's University, Kingston, Ontario, Canada (October 1997) (Deljouravesh); and
3) "A Flow Visualization Study of Airless Spray Painting", by Gary S. Settles, published in the proceedings of the ILASS –Americas 1997, May 18-21, 1997, Ottawa Canada, 10th Annual Conference on Liquid Atomization and Spray Systems" (Settles).

reexamination proceeding is not wholly based on issues of patentability in view of prior art that was raised in the litigation. As to the (at least six) references raised in the reexamination proceeding but not raised in the litigation, the patent owner effectively argues that these references could have been raised in the civil action because they were publicly available, either because they were issued patents or they were otherwise accessible by means of, for example, an internet search. However, the patent owner has not provided sufficient evidence that the issues of patentability based on the prior art other than the '333 patent, Deljouravesh, and Settles references, which are raised in the present reexamination proceeding, could have been raised by the requester at the time of the civil action. Specifically, the patent owner has not provided evidence that the patent owner was aware of the prior art applied in the reexamination proceeding, i.e., the prior art other than the '333 patent, Deljouravesh, and Settles references, at a time when those references could have been raised as issues in the earlier litigation, as also argued by the requester in its September 28, 2011 opposition.

Absent a sufficient evidentiary showing that the requester was aware of the prior art presently applied in the reexamination proceeding, including the prior art other than the '333 patent, Deljouravesh, and Settles references, at a time when the art could have been raised by the requester in the earlier civil action, the estoppel provision of 35 U.S.C. 317(b), relied upon by the patent owner as mandating the termination of the present reexamination proceeding, is inapplicable. It is beneficial to the interest of the public to continue the present reexamination proceeding, in order to examine the patent based on prior art that was not before the court in the litigation.

The patent owner appears to argue that the application of the estoppel provisions of the statute is not precluded by the last sentence of 35 U.S.C. 317(b), which permits "the assertion of invalidity based on newly discovered prior art unavailable to the third party requester". The last sentence of 35 U.S.C. 317(b) need not be addressed, however, because the patent owner has not shown that the requester was aware of the prior art such that requester *could have raised* it in the earlier litigation. Thus, the Office is relying on the "could have raised" provision of the first sentence of 35 U.S.C. 317(b). Even if the last sentence of 35 USC 317(b) is relied upon, however, the provisions of the last sentence of 35 U.S.C. 317(b) further support the requirement of a showing that the requester was aware of the prior art at a time when the requester could have raised it in the earlier litigation. The patent owner has not shown that the prior art applied in the reexamination proceeding, other than the '333 patent, Deljouravesh, and Settles references, was not "newly discovered prior art unavailable to the third party requester". See, e.g., the legislative history of 35 U.S.C. 317(b), which provides the meaning of the word "unavailable", as it appears in the statute (emphasis added in bold):[5]

> Further, if a third-party requester asserts patent invalidity in a civil action and a final decision is entered that the party failed to prove the assertion of invalidity . . . after any appeals, that

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See Exhibit D, which is attached to the present petition, and which is entitled "InnovaSystems Inc.'s Response in Opposition to Proveris Scientific Corporation's Motion for Summary Judgment", dated January 17, 2007; and Exhibit E, which is also attached to the present petition, and which is entitled "InnovaSystems, Inc.'s Supplement to Its Statement of Facts and Argument Supporting Its Cross-Motion for Summary Judgment on Validity", dated February 28, 2007. See also Exhibit F, which is attached to the present petition, and which is entitled "Joint Pretrial Memorandum", dated February 20, 2007.

[5] 106 Cong. Rec. S14720, Nov. 17, 1999. See also 106 Cong. Rec. H11805, Nov. 9, 1999.

> third-party requester cannot thereafter request inter partes reexamination on the basis of issues which were or which could have been raised. However, the third-party requester may assert invalidity based on **newly discovered prior art unavailable at the time of the civil action** or inter partes reexamination. **Prior art was unavailable at the time if it was not known to the individuals who were involved in the civil action** or inter partes reexamination proceeding on behalf of the third-party requester and the USPTO.

The patent owner has not provided evidence that the prior art applied in the reexamination proceeding, other than the '333 patent, Deljouravesh, and Settles, was known to the requester at a time when it could have been raised in the civil action.

The patent owner also appears to argue that because the issues of "anticipation and obviousness", in general, were raised in the litigation, the requester is precluded from raising *any* issue of anticipation or obviousness in the reexamination proceeding. The statute, however, expressly permits a later "assertion of invalidity based on newly discovered prior art unavailable to the third-party requester". Since an "assertion of invalidity based on . . . prior art" generally includes issues of anticipation and/or obviousness, the mere assertion, in general, of "anticipation and obviousness" does not preclude the assertion of these issues in view of prior art of which the requester was unaware at a time when the requester could have raised such issues in the litigation.

Patent owner's argument that the prior art raised in the reexamination proceeding but not raised in the ligitation are cumulative to the Deljouravesh and Settles references is not relevant to the issue of whether the estoppel provisions of 35 U.S.C. 317(b) mandate the termination of the present proceeding. This decision does not include a determination of whether the references presently applied in the reexamination proceeding, other than the '333 patent, Deljouravesh and Settles references, are cumulative to the teachings of Deljouravesh and Settles. However, even if such references are viewed as cumulative, the patent owner has not shown how the provisions of 35 U.S.C. 317(b) require the termination of the present proceeding merely because the references applied in the reexamination proceeding may be cumulative to those raised in the litigation. The patent owner has not shown how the mere fact that such references may be cumulative provides evidence that the requester was aware of the references at a time when they could have been raised in the litigation.[6]

For the reasons given above, element 4 has not been shown to have been satisfied with respect to issues raised by the prior art applied in the present reexamination proceeding, other than the '333 patent, Deljouravesh, and Settles references.

In summary, the present *inter partes* reexamination proceeding **<u>will not be terminated</u>** because the patent owner has failed to show that 1) the court decided that the requester/defendant did not sustain its burden of proving the invalidity of claims 11 and 12 of the '400 patent, which are under reexamination in the present reexamination proceeding, and 2) the present reexamination proceeding is *solely* based upon art issues that were raised or could have been raised by the

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[6] In any event, the mere fact that a reference is cumulative does not, for example, cause the reference to be unavailable as prior art under 35 U.S.C. 102(b), or prevent the reference from being properly applied in a rejection of the patent claims.

requester in the earlier litigation, within the meaning of 35 U.S.C. 317(b). The patent owner has not shown that the references other than the '333 patent, Deljouravesh, and Settles were known to the requester at a time when those references could have been raised in the litigation.

Accordingly, the August 29, 2011 patent owner petition under 37 CFR 1.182 to terminate an inter partes reexamination proceeding is **dismissed**.

The patent owner briefly mentions, in a footnote, that "[a]t a minimum, Deljouravesh, Settles, and the '333 patent should be precluded from consideration if the Office concludes that the reexamination may proceed". While a brief mention in a footnote is not considered to be an alternative petition by the patent owner to withdraw these references from consideration, the Office, *sua sponte*, makes the following determination.

In support of its request to terminate the present proceeding, discussed in detail above, the patent owner has provided evidence showing that the '333 patent, Deljouravesh, and Settles references were asserted in the earlier litigation.[7] This evidence is deemed sufficient to show that the issues raised in the present reexamination proceeding and limited to the application of one or more of these references against the litigated claims, i.e., claims 3-10 and 13, are issues that were either raised or could have been raised in the litigation.

The requester argues, in its September 28, 2011 opposition, that the court never ruled on the substantive merits of requester's prior-art-based invalidity defenses, and for this reason, the court's decision is not "final" as to the substantive merits of requester's defenses, and any rejection citing these references may be maintained in the present reexamination proceeding. However, the Federal Circuit expressly upheld the district court's grant of JMOL in favor of the patent owner, specifically on the issue of the requester's "affirmative defense of invalidity". *Proveris* at 1268. Since the Federal Circuit decision was rendered in 2008, and no other appellate action has been taken, the decision by the district court is determined to be a final decision. The requester has not pointed to any statutory language that would limit the term "final decision" to a decision on the substantive merits of requester's invalidity defenses. The statute further provides that where, as here, a final decision pursuant to 35 USC 317(b) has been entered against the requester:

> . . . then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim *on the basis of issues which that party or its privies raised or could have raised in such civil action* or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies *on the basis of such issues may not thereafter be maintained* by the Office . . .

The requester has not shown why the issues presently raised in the reexamination proceeding, and limited to the application of one or more of the '333 patent, Deljouravesh, and Settles references against the litigated claims, i.e., claims 3-10 and 13, were issues that either were not raised or could not have been raised during the earlier litigation.

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[7] See footnote 4.

For the reasons given above, the estoppel provisions of 35 U.S.C. 317(b) apply to any rejection in this proceeding of any of claims 3-10 and 13 that is limited to the application of one or more of the '333 patent, Deljouravesh, and Settles references. Any rejection in the '1578 reexamination proceeding which is presently applied against any of claims 3-10 and 13 of the '400 patent, i.e., the patent under reexamination, and which is limited to the application of one or more of the '333 patent, Deljouravesh, and Settles references, **will not be further maintained by the Office.** No further rejection of any of claims 3-10 and 13 of the '400 patent, that is limited to the application of one or more of the '333 patent, Deljouravesh, and Settles references, **will be made** in the present reexamination proceeding.

The determination in this decision not to maintain any rejection of any of claims 3-10 and 13 of the '400 patent which is limited to the application of one or more of the '333 patent, Deljouravesh, and Settles references, is made pursuant to the estoppel provisions of 35 U.S.C. 317(b), and **is not a "non-adoption of" or a "determination not to make" such a rejection within the meaning of 37 CFR 41.61**. For this reason, any notice of appeal or cross-appeal of the present determination not to make or maintain a rejection of any of claims 3-10 and 13 of the '400 patent, which is limited to the application of one or more of the '333 patent, Deljouravesh, and Settles references, will be held to be **defective**.

Appellant will be notified of the reasons for non-compliance and given a non-extendable time period within which to file an amended notice of appeal or cross appeal in accordance with this decision and in compliance with all other applicable rules or requirements of the Office. If the appellant does not then file an appropriately-amended notice of appeal or cross appeal within the set time period, or files a notice which does not overcome all the reasons for non-compliance stated in the notification of the reasons for non-compliance, that appellant's appeal or cross appeal will stand dismissed, pursuant to 37 CFR 41.61.

Any proper rejection[8] of any of the non-litigated claims, i.e., claims 11, 12, and new claims 14 and 15, including any rejection citing one or more of the '333 patent, Deljouravesh or Settles references, may be maintained, as appropriate, in the present proceeding. Any proper appeal or cross appeal of a rejection of any of claims 11, 12, and new claims 14 and 15, citing one or more of the '333 patent, Deljouravesh or Settles references, or of any determination by the Office not to adopt or maintain such a rejection, may be timely filed.

Any proper rejection of any of the litigated claims, i.e., claims 3-10 and 13, that *solely* applies prior art other than the '333 patent, Deljouravesh or Settles references (other art), or that applies other prior art *in addition to* the '333 patent, Deljouravesh, or Settles references, may be maintained, as appropriate, in the present proceeding. Any proper appeal or cross appeal of such a rejection, or of any determination by the Office not to adopt or maintain such a rejection, may be timely filed.

A supplemental right of appeal notice in accordance with this decision **will follow**.

[8] A proper rejection is a rejection that is in compliance with all applicable rules or requirements of the Office.

CONCLUSION

- The August 29, 2011 patent owner petition under 37 CFR 1.182 to terminate *inter partes* reexamination is **dismissed**.

- **The estoppel provisions of 35 U.S.C. 317(b) apply to any rejection in this proceeding of any of claims 3-10 and 13 that is limited to the application of one or more of the '333 patent, Deljouravesh, and Settles references.** Any rejection in the '1578 reexamination proceeding which is presently applied against any of claims 3-10 and 13 of the '400 patent, i.e., the patent under reexamination, and which is limited to the application of one or more of the '333 patent, Deljouravesh, and Settles references, **will not be further maintained** by the Office. No further rejection of any of claims 3-10 and 13 of the '400 patent, that is limited to the application of one or more of the '333 patent, Deljouravesh, and Settles references, **will be made** in the present reexamination proceeding.

- The determination in this decision not to maintain any rejection of any of claims 3-10 and 13 of the '400 patent which is limited to the application of one or more of the '333 patent, Deljouravesh, and Settles references, is made pursuant to the estoppel provisions of 35 U.S.C. 317(b), and **is not a "non-adoption of" or a "determination not to make" such a rejection within the meaning of 37 CFR 41.61**.

- Any notice of appeal or cross-appeal of the present determination not to make or maintain a rejection of any of claims 3-10 and 13 of the '400 patent, which is limited to the application of one or more of the '333 patent, Deljouravesh, and Settles references, **will be held to be defective**.

- A supplemental right of appeal notice in accordance with this decision **will follow**.

- The '1578 proceeding is being referred to the Central Reexamination Unit for further action pursuant to this decision.

- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.

/Cynthia L. Nessler/
Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

2 27 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.
95/001,579	03/18/2011	7080301	42299.19	5475

87916 7590 10/12/2011

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 10/12/2011

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

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CENTRAL REEXAMINATION UNI

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Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001579
PATENT NO. : 7080301
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 12 2011

CENTRAL REEXAMINATION UNIT

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Inter Partes Reexamination Proceeding : **DECISION**
Control No. 95/001,579 : **GRANTING**
Filed: March 18, 2011 : **PETITION**
For: U.S. Patent No. 7,080,301 :

This is a decision on third party requester's petition paper entitled "PETITION TO WAIVE PAGE LIMIT REQUIREMENT FOR THIRD PARTY REQUESTER COMMENTS," filed on August 4, 2011. The petition requests waiver of the requirement of 37 CFR 1.943(b) that the written comments by third party requester not exceed fifty (50) pages in length, and requests that the page limit be extended to 72 pages. Third party requester timely filed comments under 37 CFR 1.947 concurrently with the petition.

The petition is before the Office of Patent Legal Administration for consideration.

The petition is granted.

DECISION

I. Relevant Regulations and Procedure

37 CFR 1.183 provides:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.943(b) provides:

Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

MPEP § 2667(I), (TYPES OF PAPERS RETURNED WITH CENTRAL REEXAMINATION UNIT DIRECTOR OR REEXAMINATION LEGAL ADVISOR APPROVAL REQUIRED), provides in pertinent part:

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Any affidavit or declaration (or a clearly defined portion thereof) that contains opinion(s) of the affiant/declarant, or argument(s) that the art either does or does not anticipate or render obvious the claims, or specific claim elements, of the patent under reexamination, is considered to be part of the comments submitted by the patent owner, or by the third party requester, and is subject to the page limit requirements of 37 CFR 1.943. Affidavits or declarations that are excluded from the page limit requirements include, for example, declarations attempting to swear behind (antedate) the filing date of a reference, or to establish the date of a printed publication, or declarations that provide comparative test data and an analysis of same. However, if the patent owner's affidavit or declaration includes any argument as to how an outstanding/proposed rejection is overcome, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Likewise, if a third party requester affidavit or declaration includes any argument as to how a rejection is supported, then the page(s) of the affidavit or declaration upon which the argument appears would be included against of the page limit count. Similarly, attached exhibits presenting data or drawings are not included against the page limit count, unless an exhibit or drawing includes argument as to how the outstanding rejection is overcome. Any page(s) of the exhibit or sheet(s) of drawings that include such argument would be included against the page limit count.

II. Third Party Requester's Petition

In the instant petition, third party requester requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for third party requester's comments filed on August 4, 2011, and requests that the page limit be extended to 72 pages.[1] In support of its request for waiver of the rule, third party requester argues that additional pages are needed to effectively address the issues raised by the patent owner's remarks and each of the 20 newly presented claims.

III. Analysis and Findings

37 CFR 1.183 provides for suspension or waiver of any requirement of the regulations which is not a requirement of the statutes in an extraordinary situation, when justice requires, on petition of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which a requester petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a requester comments submission in compliance with the 50-page limit, and submission of a comments paper that is in excess of 50 pages concurrently

[1] Petition at page 2.

with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted comments paper. Such comments paper can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response or comments, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts,** or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see*, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

Third party requester's August 4, 2011 comments are found to consist of a 24-page comments section, an appendix A, and twenty-three exhibits (A-Q and CC-HH).

Appendix A is a 2-page list of exhibits relied on in the comments by third party requester and do not count toward the page limit.

Exhibits A-C, and E-Q are references and do not count toward the page limit.

Exhibits CC-HH are a 46-page set of six claims charts that count toward the page limit.

Exhibit D is an 18-page declaration under 37 CFR 1.132 of Dr. Ray Mercer. The §1.132 Mercer declaration is also accompanied by Appendices 1-4. Appendix 1 is a *curriculum vitae* of Dr. Ray Mercer and Appendices 2-4 are references. Therefore, Appendices 1-4 do not count toward the page limit. However, the 18-page §1.132 Mercer declaration is replete with legal argumentation/conclusion. For this reason, the entirety of the 18-page §1.132 Mercer declaration is counted toward the page limit. See *inter alia* the legal argument/conclusion made on page 5, paragraph 19; on page 6, paragraph 17; on pages 8-9, paragraph 27; on page 9, paragraph 28; on page 10, paragraph 33; on page 11, paragraph 36; on page 12, paragraph 40; on page 13, paragraph 45; on page 14, paragraph 47; on page 16, paragraph 57; and on page 17, paragraph 59.

Accordingly, the August 4, 2011 third party requester comments submission includes *in toto* 88 pages in length as to pages counting toward the regulatory page limit.

Upon review of the submitted response for economizing, extraneous material, and arrangement, without repetition of information already of record, it is found that the 38 pages of arguments in excess of 50 required to complete the third party requester's comments are not unreasonable in this instance, in view of the present facts and circumstances. This includes the point that patent owner's response added 20 new claims. 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 reexamination proceeding, the instant third party requester petition is deemed to establish that a waiver of 37 CFR 1.943(b) to the extent of permitting third party requester's comments to run 88 pages in length is appropriate in the interest of justice.

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's comments submission to exceed the page limit by 38 pages. This waiver makes requester's August 4, 2011 comments submission page-length compliant.

CONCLUSION

1. Third party requester's petition under 37 CFR 1.183 is granted, and the page limit of 37 CFR 1.943(b) is waived to the extent that third party requester's comments filed on August 4, 2011 may exceed the page limit by 38 pages. This waiver makes the August 4, 2011 third party requester comments submission page-length compliant.

2. Telephone inquiries related to the present decision should be directed to the Susy Tsang-Foster, Legal Advisor, at 571-272-7711.

/Kenneth M. Schor/

Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

10/11/11
Kenpet9/

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,581	03/21/2011	7,777,651	2855.001REX5	7734

26111 7590 12/22/2011

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 12/22/2011

Please find below and/or attached an Office communication concerning this application or proceeding.

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Date: 12-22-11

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BAKER BOTTS L.L.P.
910 LOUSIANA STREET
ONE SHELL PLAZA
HOUSTON, TX, 77002

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001581
PATENT NO. : 7777651
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

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DEC 22 2011

CENTRAL REEXAMINATION UNIT

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

(For Patent Owner)

BAKER BOTTS L.L.P.
910 LOUSIANA STREET
ONE SHELL PLAZA
HOUSTON, TX 77002

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,581
Filed: March 21, 2011
For: U.S. Patent No. 7,777,651 B2

: **DECISION**
: **GRANTING**
: **PETITION**
:

This is a decision on the third party requester's petition paper entitled "PETITION TO SUSPEND PAGE LIMIT FOR WRITTEN COMMENTS BY THE THIRD PARTY REQUESTER (37 C.F.R. §§ 1.183 AND 1.943)," filed on October 26, 2011. The petition requests waiver of the requirement of 37 CFR 1.943(b) that the written comments by the third party requester not exceed fifty (50) pages in length, and requests that the page limit be extended to 71 pages. The third party requester timely filed comments under 37 CFR 1.947 concurrently with the petition.

The petition is before the Office of Patent Legal Administration for consideration.

The petition is granted.

DECISION

I. 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.

II. Third Party Requester's Petition

In the instant petition, the third party requester requests waiver of the requirement under 37 CFR 1.943(b) with respect to the 50-page limit for the third party requester's comments filed on October 26, 2011, and requests that the page limit be extended to 71 pages.[1] In support of its request for waiver of the rule, the third party requester argues that additional pages are needed to address the issues raised by the patent owner's response and the Office action. In particular, the requester contends that the July 25, 2011 Office action addressed 123 claims of the patent at issue "with 12 claim groupings and 14 cited references over the course of 272 pages."[2]

III. Analysis and Findings

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

[1] Petition at page 2.
[2] *Id.*

of the interested party. The burden is on petitioner to set forth with specificity the facts that give rise to an extraordinary situation in which justice requires suspension of a rule. A showing which a requester petitioner can make in support of a request for waiver of the 50-page limit of 37 CFR 1.943(b) can be an attempt to draft a requester comments submission in compliance with the 50-page limit, and submission of a comments paper that is in excess of 50 pages concurrently with a petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b), requesting entry of the submitted comments paper. Such comments paper can be evaluated for economizing, extraneous material, and arrangement, without repetition of information already of record.

It is noted that, for purposes of making an accurate determination of exactly how many additional pages over 50 are deemed to be needed for the response or comments, a document is deemed to be subject to the 50-page length requirement when the document includes legal argument, *i.e.*, arguments of counsel such as, *e.g.*, arguments that the claims are patentable or unpatentable, or that are directed to how an outstanding or proposed rejection is overcome, or, in the case of a document filed by the requester, how an outstanding or proposed rejection is supported. Each determination of whether a document, such as an affidavit or declaration, contains information that will cause the document to be subject to the page count is made on a case-by-case basis. In determining whether a document such as an affidavit or declaration under 37 CFR 1.132, or any other document of a submission, includes legal argument, the Office analyzes whether the document is providing factual evidence, *i.e.*, evidence of **technological facts,** or whether the document contains argument that is merely an extension of the arguments of counsel. Factual evidence includes, for example, declarations that swear behind the filing date of a reference, that establish the date of a printed publication, that provide a technical explanation or technical definition of terms of art used by a reference, or that provide comparative test results and a scientific, or technological, analysis of the results (*see*, *e.g.*, MPEP 716.02). If a document is limited to factual evidence, the document is not included in the page count. In addition, affidavits or declarations limited to establishing commercial success, long-felt need and failure of others, scepticism of experts, or copying, as per MPEP 716.03-716.06, respectively, will not be included in the page count.

The third party requester's October 26, 2011 comments submission consists of a 62-page comments section, which is counted toward the page limit. The requester's comments submission is also accompanied by a 9-page declaration under 37 CFR 1.132 of Paul C. Clark, which is found to be replete with legal argumentation/conclusion. For this reason, the entirety of the 9-page §1.132 Clark declaration is counted toward the page limit. See *inter alia* the legal argument/conclusion made on page 1, paragraph 8; on page 2, paragraph 14; on page 3, paragraph 22; on page 4; paragraphs 23-26; on page 5, paragraph 33; on page 6, paragraph 36; on page 7, paragraphs 41 and 42; on page 8, paragraph 50; and on page 9, paragraph 53.

Accordingly, the October 26, 2011 third party requester comments submission includes *in toto* 71 pages in length as to pages counting toward the regulatory page limit.

Upon review of the submitted response for economizing, extraneous material, and arrangement, without repetition of information already of record, it is found that the 21 pages of arguments in excess of 50 required to complete the third party requester's comments are not unreasonable in this instance, in view of the present facts and circumstances. A review of the July 25, 2011 non-

final Office action reveals that at least 260 pages of the action are directed to the non-adoption of the requester's proposed rejections. It is therefore 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 reexamination proceeding, the instant third party requester petition is deemed to establish that a waiver of 37 CFR 1.943(b) to the extent of permitting the third party requester's comments to be 71 pages in length is appropriate in the interest of justice.

Accordingly, the 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 the requester's comments submission to exceed the page limit by 21 pages. This waiver makes the requester's October 26, 2011 comments submission page-length compliant.

CONCLUSION

1. The third party requester's petition under 37 CFR 1.183 is granted, and the page limit of 37 CFR 1.943(b) is waived to the extent that the third party requester's comments filed on October 26, 2011 may exceed the page limit by 21 pages. This waiver makes the October 26, 2011 third party requester comments submission page-length compliant.

2. Telephone inquiries related to the present decision should be directed to the Susy Tsang-Foster, Legal Advisor, at 571-272-7711.

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.
95/001,587 + 90/091604	03/28/2011	Bernhard Vosteen	857411.00001	7508

27386 7590 07/27/2011
GERSTENZANG, WILLIAM C.
NORRIS MCLAUGHLIN & MARCUS, PA
875 THIRD AVE, 8TH FLOOR
NEW YORK, NY 10022

EXAMINER
JOHNSON, JERRY D

ART UNIT	PAPER NUMBER
3991	

MAIL DATE	DELIVERY MODE
07/27/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Date: 7-27-11

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
REED SMITH, LLP
10 SOUTH WACKER DRIVE
CHICAGO, IL 60606-7507

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001587 + 90/011604
PATENT NO. : 6878358
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

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Shook, Hardy & Bacon LLP (For Patent Owner)
2555 Grand Blvd.
Kansas City, MO 64108-2613

Reed Smith LLP (For the '1587 Requester)
10 South Wacker Drive
Chicago, IL 60606-7507

In re Vosteen et al. *Ex Parte* Reexamination Proceeding Control No.: 90/011,604 Filed: April 6, 2011 For: U.S. Patent No. 6,878,358	**DECISION ON PETITION TO MERGE REEXAMINATION PROCEEDINGS**
In re Vosteen et al. *Inter Partes* Reexamination Proceeding Control No.: 95/001,587 Filed: March 28, 2011 For: U.S. Patent No.: 6,878,358	

The above-captioned reexamination proceedings are before the Office of Patent Legal Administration on petition by the patent owner for consideration on merging the above proceedings.

Ex parte reexamination proceeding No. 90/011,604 and *inter partes* reexamination proceeding No. 95/001,587 **are merged** into a single proceeding.

BACKGROUND

1. On April 12, 2005, United States Patent Number 6,878,358 ("the '358 patent") issued to Vosteen et al. with 16 claims.

2. On March 28, 2011, a request for *inter partes* reexamination of claims 1-16 of the '358 patent was filed by a third party requester and assigned Reexamination Control No. 95/001,587 ("the '1587 proceeding"). The request identified Nalco Co. ("the 1587 requester") as the real party in interest.

3. On April 6, 2011, patent owner filed a request for *ex parte* reexamination of claims 1, 7 and 13 of the '358 patent and assigned control number 90/011,604 ("the '11604 proceeding"). The request included a preliminary amendment to the claims, cancelling claim 1, amending claims 2, 4-8, 12 and 14-16 and adding new claims 17-51. Claims 3, 9-11 and 13 are as originally issued.

4. On May 26, 2011, *inter partes* reexamination of claims 1-16 of the '358 patent was granted in the '1587 proceeding. An Office action was not concurrently issued.

5. On May 27, 2011, *ex parte* reexamination of claims 1, 7 and 13 of the '358 patent was granted in the '11604 reexamination proceeding. An Office action was not concurrently issued. The time period for filing a statement under 37 CFR 1.530 has lapsed with out the filing of a patent owner statement in the '11604 reexamination proceeding.

6. On June 1, 2011, patent owner filed a petition for merger in the '11604 proceeding, requesting that the '1587 and the '11604 proceedings be merged.

7. To date, no Office action has issued in either of the two proceedings.

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in the above-captioned two proceedings for overlapping claims of the same patent. One of the proceedings (the '1604 proceeding) is an *ex parte* proceeding. The other proceeding (the '1587 proceeding) is an *inter partes* proceeding. Both proceedings are still pending, and have not been terminated. Therefore, consideration of merger is ripe at this point in time.

MPEP 2686.01 points out:

> Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with "special dispatch."

In this instance, based upon the record as a whole, it is found, based on the facts as they exist at present, that merger of the proceedings should facilitate the orderly handling of the proceedings with special dispatch. Accordingly, the 90/011,604 and 95/001,587 proceedings **are hereby merged**. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. A proposed amendment accompanied the patent owner's request *for ex parte* reexamination. Claim 1 has been cancelled, claims 2, 4-8, 12 and 14-16 have been

amended and new claims 17-51 have been added in the '11604 *ex parte* proceeding, while the claims in the '1587 *inter partes* proceeding have not been amended. Thus, the claims are not currently the same in both proceeding files. An Office action requiring an amendment placing the claims of both proceedings in identical form is being issued concurrently with this decision. Patent owner must respond to the Office action in accordance with the procedure provided in 37 CFR 1.111. The *inter partes* third party requesters will then have an opportunity to comment on patent owner's response in accordance with the procedures in 37 CFR 1.947.

The patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding.

III. CONDUCT OF MERGED PROCEEDING

A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997.

B. *Inter partes* Third Party Requester Participation:

1. Comment rights:

The *inter partes* requester can comment pursuant to 35 U.S.C. 314(b)(2).[1] First, an *inter partes* requester's right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, the *inter partes* requester's right to comment is limited to issues raised in either the Office action or the patent owner's response to the action.

2. Appeal Rights:

The *inter partes* reexamination procedures for taking appeal, and for participating in the patent owner's appeal, are explained in MPEP 2674 through 2675.02 and 2678 through 2683. As pointed out in MPEP 2674:

> A notice of appeal by a third party requester must identify each rejection *that was previously proposed by that* third *party requester* which the third party requester intends to contest. It is not sufficient to merely appeal from the allowance of a claim (i.e., the examiner's finding of a claim patentable); the third party requester must identify each previously proposed rejection to be contested.

[1] Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the *inter partes* third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

Thus, the *inter partes* reexamination requester's appeal must **only** be taken from the finding(s) of patentability of claims in the RAN as to the rejections the third party requester proposed in the *inter partes* reexamination request (not as to the rejections proposed in the *ex parte* reexamination request), and any that the *inter partes* third party requester properly added during the examination stage of the merged proceeding. Also, as provided by 37 CFR 41.67(c)(1)(vi):

> No new ground of rejection can be proposed by a third party requester appellant, unless such ground was withdrawn by the examiner during the prosecution of the proceeding, and the third party requester has not yet had an opportunity to propose it as a third party requester proposed ground of rejection.

Thus, an appellant's brief shall present a concise statement of each issue. And, no new ground of rejection (i.e., a ground that the requester did not propose in the *inter partes* reexamination request, or during the merged proceeding) can be proposed by the *inter partes* third party requester appellant, unless that ground was withdrawn by the examiner during the prosecution of the proceeding, and the *inter partes* third party requester did not yet have an opportunity to propose it as a third party requester proposed ground of rejection.

C. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to both proceedings. All papers issued by the Office, or filed by the patent owner and the third party requester, will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requester must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for both files, for entry into each file.

All papers filed by the patent owner and the third party requesters should be directed:

by Mail to:	Attn: Mail Stop "*Inter Partes* Reexam" Central Reexamination Unit Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450
by FAX to:	(571) 273-9900 Central Reexamination Unit
by Hand to:	Customer Service Window Attn: Central Reexamination Unit Randolph Building, Lobby Level 401 Dulany Street Alexandria, VA 22314
by EFS:	Registered users may submit papers via the

electronic filing system EFS-Web, at:

https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html

Patent owner and requester are reminded that every paper filed (including papers filed *via* facsimile transmission) in the merged proceeding subsequent to this decision must be served on the other party, and every paper filed must reflect that such paper was served on the other party, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

D. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530, and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

E. Fees:

Where a paper is filed that requires payment of a fee (*e.g.*, petition fee, excess claims fee, extension of time fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner's appellant brief (or that of the *inter partes* reexamination requester) which may be filed, even though the brief relates to merged multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

F. Citation of Patents and Printed Publications:

Upon return of the present merged proceeding to the examiner, the examiner will review the files to ensure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

CONCLUSION

1. *Ex parte* Reexamination Control No. 90/011,604 and *inter partes* Reexamination Control No. 95/001,587 are **merged into a single proceeding**, to be conducted in accordance with the procedure set forth above in Part III of this decision.

2. The examiner should not issue an Office action for the present merged proceeding until after the earlier of: (a) the submission of the required response to place the same amendment in all proceedings and requesters' comments on that response, or (b) the expiration of the time for filing the required response and any comments requesters elect to file.
3. Any questions concerning this communication should be directed to Joseph F. Weiss, Jr., Legal Advisor, at 571-272-7759.

Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

July 25, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,591	03/31/2011	6,936,268	TOYA129.012RX	5863

EXAMINER

ART UNIT	PAPER NUMBER

23628 7590 08/03/2011
WOLF GREENFIELD & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON, MA 02210-2206

DATE MAILED: 08/03/2011

Please find below and/or attached an Office communication concerning this application or proceeding.

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Date:

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KNOBBE, MARTENS, OLSON & BEAR LLP
2040 MAIN STREET
14th FLOOR
IRVINE, CA 92614

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001591
PATENT NO. : 6936268
TECHNOLOGY CENTER : 3999
ART UNIT : 3991

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

Decision on Petition for Extension of Time in Reexamination	Control No.: 95/001,389 & 95/001,501 & 95/001,591

1. THIS IS A DECISION ON THE PETITION FILED 28 July 2011.

2. THIS DECISION IS ISSUED PURSUANT TO:
   A. ☐ 37 CFR 1.550(c) – The time for taking any action by a patent owner in an *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
   B. ☒ 37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.

   The petition is before the Central Reexamination Unit for consideration.

3. FORMAL MATTERS
   Patent owner requests that the period for responding to the Office action dated 01 July 2011 which sets a two (2) month period for filing a response to the Office action, be extended by two (2) months.

   A. ☒ Petition fee per 37 CFR §1.17(g)):
      i. ☐ Petition includes authorization to debit a deposit account.
      ii. ☐ Petition includes authorization to charge a credit card account.
      iii. ☐ Other: _____.
   B. ☒ Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
   C. ☒ Petition was timely filed.
   D. ☒ Petition properly signed.

4. DECISION (See MPEP 2265 and 2665)
   A. ☐ Granted or ☒ Granted-in-part for one (1) month, because petitioner provided a factual accounting that established sufficient cause. (See 37 CFR 1.550(c) and 37 CFR 1.956).
   B. ☒ Other/comment: see attached
   C. ☐ Dismissed because:
      i. ☐ Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
      ii. ☐ Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
      iii. ☐ Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
      iv. ☐ The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
      v. ☐ The petition is moot.
      vi. ☐ Other/comment: see attachment.

5. CONCLUSION

   Telephone inquiries with regard to this decision should be directed to Mark Reinhart at 571-272-1611. In his/her absence, calls may be directed to Eric Keasel at 571-272-4929 in the Central Reexamination Unit.

/Mark Reinhart/	SPE, AU 3992 Central Reexamination Unit
[*Signature*]	(Title)

In consideration of providing the patent owner with a fair opportunity to present an argument against any attack on the patent as balanced with the statutory mandate of conducting reexamination proceedings with special dispatch that the Office must fully consider the facts presented in any petitions for extension of time. This is the first request for extension of time in this proceeding. While the petition speaks to the considerations of many other proceedings as well as the overall length of the reexaminations if added together before council, concurrent with preparing a response, these are the same considerations of any patent owner in any reexamination proceeding. It is Patent owner who must exercise diligence in responding to the Office action. It is agreed that patent owner needs to be given opportunity to complete all aspects of investigation prior to responding to the Office action in an *inter partes* reexamination proceeding. It is Patent owner who must exercise diligence in responding to Office action. The requirement for reasonably diligent behavior by patent owner includes a reasonable expectation of resource management insofar as expecting a complete Office action on the merits.

It is further noted that the petition raises questions about the need for declatory evidence pursuant to 37 CFR § 1.132. The time needed to gather such evidence does support sufficient cause for a one (1) month extension of time.

The requirement for reasonably diligent behavior by the patent owner includes a reasonable expectation of resource management. Resource management takes into consideration other proceedings before the Office. The petition identifying other concurrent proceedings is noted but is not germane to the issues under consideration as to "sufficient cause" for granting an extension of time.

Per MPEP § 2665 (in-part)

"First requests for extensions of these time periods will be granted for sufficient cause, and for a reasonable time specified-usually 1 month. The reasons stated in the request will be evaluated, and the request will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response or comments within the statutory time period. Second or subsequent requests for extensions of time, or requests for more than one month, will be granted only in extraordinary situations." (emphasis added)

On balance there is "sufficient cause" to grant-in-part the petition for extension of time for a period of one (1) month.

The petition for extension of time is hereby granted-in-part.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,601	04/15/2011	7,653,572	688239-RX1	7426

2292 7590 04/05/2012

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/05/2012

Please find below and/or attached an Office communication concerning this application or proceeding.

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Date: 4-5-12

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
PANITCH SCHWARZE BELISARIO & NADEL LLP
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001601
PATENT NO. : 7653572
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

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CENTRAL REEXAMINATION UNIT

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BIRCH STEWART KOLASCH & BIRCH (For Patent Owner)
PO BOX 747
FALLS CHURCH VA 22040-0747

PANITCH, SCHWARZE BELISARIO & NADEL LLP (For *Inter Partes* Requester)
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103

In re Michael P. Thompson *Inter Partes* Reexamination Proceeding Control No. 95/001,601 Filed: April 15, 2011 For: U.S. Patent No. 7,653,572	**DECISION DISMISSING PETITION**

This is a decision on *inter partes* third party requester's November 14, 2011 petition paper entitled "THIRD PARTY REQUESTER PETITION UNDER 37 C.F.R. § 1.183 TO SUBMIT RESPONSE TO THE PATENT OWNER PETITION UNDER 37 C.F.R. § 1.182 TO RETURN THIRD PARTY REQUESTER'S COMMENTS," which is being taken and a request to enter an opposition to a patent owner petition.

The petition is dismissed as moot. Requester's opposition petition has a right of entry.

REVIEW OF THE RELEVANT FACTS.

1. On January 26, 2010, the Office issued United States Patent Number 7,653,572 (the '572 patent) to Michael P. Thompson.

2. On April 15, 2011, a request for *inter partes* reexamination of the '572 patent was filed by a third party requester and assigned Reexamination Control No. 95/001,601 (the '1601 proceeding).

3. On June 30, 2011, the Office issued an order granting *inter partes* reexamination in the '1601 proceeding. A first Office action on the merits concurrently issued with the order.

4. On September 23, 2011, patent owner timely filed a response to the Office action.[1]

5. On October 24, 2011, third party requester timely filed comments.

6. On October 31, 2011, patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.182 FOR THE OFFICE TO RETURN THIRD PARTY REQUESTER'S COMMENTS AFTER PATENT OWNER'S RESPONSE."

7. On November 14, 2011, third party requester filed the instant petition entitled, "THIRD PARTY REQUESTER PETITION UNDER 37 C.F.R. § 1.183 TO SUBMIT RESPONSE TO THE PATENT OWNER PETITION UNDER 37 C.F.R. § 1.182 TO RETURN THIRD PARTY REQUESTER'S COMMENTS," requesting entry of an opposition.

8. Concurrently on November 14, 2011, third party requester filed an opposition to patent owner's October 31, 2011 petition under 37 CFR 1.182.

DISCUSSION

37 CFR 1.183 provides:

> In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

On October 31, 2011, patent owner filed a petition under 37 CFR 1.182, alleging the requester's October 24, 2011 comments are improper and should be returned. On November 14, 2011, the requester filed an opposition to patent owner's October 31, 2011 petition under 37 CFR 1.182. Concurrently, requester filed the instant petition under 37 CFR 1.183 requesting entry and consideration of the opposition under 37 CFR 1.182. In this instance, requester is opposing the allegations of patent owner regarding the propriety of the October 24, 2011 requester comments. The issues raised by patent owner are not a matter of discretionary relief; the issues raised are whether or not the submission is in compliance with the relevant law, regulations and procedures regarding the conduct of *inter partes* reexamination. The patent owner petition, if granted, would affect the reexamination participation rights of the requester. Therefore, requester is entitled to rebut patent owner's challenge to Office's consideration of information the requester submitted. Accordingly, the petition is dismissed as moot.

CONCLUSION

1. Third party requester's November 14, 2011 petition is dismissed as moot.

[1] Patent owner requested and the Office granted a one month extension of time.

2. Telephone inquiries with regard to this decision should be directed to Joseph Weiss, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7759.

Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

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FITCH EVEN TABIN & FLANNERY
120 SOUTH LASALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

(For Patent Owner)

MAILED

JAN 17 2012

CENTRAL REEXAMINATION UNIT

John T. Callahan, Esq.
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE NW
SUITE 800
WASHINGTON, DC 20037-3213

(Courtesy Copy)

KNOBBE MARTENS OLSON
& BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

(For Third Party Requester)

In re Oota et al.
Reexamination Proceeding
Control No.: 95/001,603
Filing Date: April 15, 2011
For: U.S. Patent No.: 6,914,169

: **DECISION**
: **DISMSSING**
: **PETITION**

The above reexamination proceeding is before the Director of the Central Reexamination Unit, after receipt of a patent owner's petition of November 15, 2011, which is treated as a petition under 37 CFR 1.181 to invoke supervisory authority to not enter the September 9, 2011 requester's comment submission.

The patent owner's petition of November 15, 2011 is dismissed as premature.

SUMMARY OF RELEVANT FACTS

1. U.S. Patent No. 6,914,169 [hereinafter "the '169 patent"] was granted to *Oota et al.* on July 5, 2005.

2. On April 15, 2011, a request for *inter partes* reexamination of the '169 patent was filed by a third party requester. The resulting reexamination proceeding was assigned control number 95/001,603 (the '603 proceeding).

3. On June 10, 2011, the Office issued an order granting *inter partes* reexamination in the '603 proceeding, with an accompanying Office action on the merits.

4. On August 10, 2011, patent owner filed a response to the Office action.

5. On September 9, 2011, the third party requester filed comments, including a declaration under 37 CFR 1.132.

6. On November 15, 2011, the patent owner filed a petition under 37 CFR 1.182 and 1.183, which is treated as a petition under 37 CFR 1.181 invoking supervisory review to not enter the third party requester's comment submission of September 9, 2011.

7. The examiner has not acted on the August 10, 2011 response and the September 9, 2011 comments to date.

DECISION

As pointed out, the patent owner filed a November 15, 2011 combined petition under 37 CFR 1.182 and 1.183 to not enter the third party requester's September 9, 2011 declaration because of noncompliance with 37 CFR 1.947. It is noted that a combined petition under 37 CFR 1.182 and 1.83 is not in compliance with the requirements of 37 CFR 1.4(c). However, because the petition addresses issues that are properly raised under 37 CFR 1.181, the petition is being addressed, in the interest of equity, 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 November 15, 2011 petition. In summary, although the petition contains statements that relief sought is under 37 CFR 1.182 and/or 1.183, the petition is being addressed as a petition under 37 CFR 1.181.

The November 15, 2011 petition, which is treated as a petition under 37 CFR 1.181 to invoke supervisory authority, asserts that the requester's September 9, 2011 declaration should not be entered in the proceeding record. However, there has been no decision by the examiner if the third party requester's declaration and/or comments of September 9, 2011 are in compliance with Office rules and procedures. Accordingly, it is premature to invoke supervisory authority regarding entry of the September 9, 2011 declaration because the examiner has not made her decision. Thus, the patent owner's November 15, 2011 petition is <u>premature</u> and is, accordingly, <u>dismissed</u>.

CONCLUSION

1. The November 15, 2011 patent owner's petition, which is treated as a petition under 37 CFR 1.181, is dismissed as premature.

2. The current patent owner's power of attorney and correspondence address of record is:
   FITCH EVEN TABIN & FLANNERY
   120 SOUTH LASALLE STREET
   SUITE 1600
   CHICAGO, IL 60603-3406
   In the absence of a filing of a change of power of attorney and correspondence address in the patent file, i.e., in application no. 10/276,423, any future correspondence in this reexamination proceeding will be mailed to the patent owner only at the official correspondence address of record in the patent file, application no. 10/276,423, in accordance with 37 CFR 1.33(c) and MPEP 2622.

3. Telephone inquiries related to this decision should be directed Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361.

Irem Yucel, Director
Central Reexamination Unit

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120 SOUTH LASALLE STREET
SUITE 1600
CHICAGO IL 60603-3406

MAILED
FEB 29 2012
OFFICE OF PETITIONS

In re Application of	:	
OOTA, et al	:	
Application No. 10/276,423	:	DECISION ON PETITION
Filed: November 15, 2002	:	TO WITHDRAW
Attorney Docket No. 7388/80030	:	FROM RECORD
	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed February 27, 2012.

The request is **NOT APPROVED**.

The Request cannot be accepted because Petitioner has not complied with current USPTO requirements as set forth in 37 CFR 10.40. In this regard, 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 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 to 37 CFR 10.40(c).

Petitioner has not complied with item (1) of the above-identified certifications.

Further, the reason indicated is not an acceptable reason under 37 CFR 10.40.

The Office, however, has changed the correspondence address to the address indicated below until otherwise properly notified by the applicant.

Copied from 10276423 on 03/20/2012

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-6735.

/Diane C. Goodwyn/
Diane C. Goodwyn
Petitions Examiner
Office of Petitions

cc: YOSHINORI SHIMIZU
C/O SOEI PATENT AND LAW FIRM
MARUNOUCHI MY PLAZA 9TH FLOOR
1-1 MARUNOUCHI 2-CHOME
CHIYODA-KU, TOKYO
100-0005 JAPAN

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,604	04/18/2011	7,499,872 B1	688239-RX	9587

2292 7590 04/05/2012

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/05/2012

Please find below and/or attached an Office communication concerning this application or proceeding.

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
STEPHEN E. MURRAY
PANITCH SCHWARZE BELISARIO & NADEL LLP
ONE COMMERCE SQUARE, 2005 MARKET ST., SUITE 2200
PHILADELPHIA, PA 19103-7086

Date:

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APR 05 2012

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001604
PATENT NO. : 7499872
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 05 2012

CENTRAL REEXAMINATION UNIT

BIRCH STEWART KOLASCH & BIRCH (For Patent Owner)
PO BOX 747
FALLS CHURCH VA 22040-0747

PANITCH, SCHWARZE BELISARIO & NADEL LLP (For *Inter Partes* Requester)
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103

In re Michael P. Thompson
Inter Partes Reexamination Proceeding
Control No. 95/001,604
Filed: April 18, 2011
For: U.S. Patent No. 7,499,872

DECISION DISMISSING PETITION

This is a decision on *inter partes* third party requester's November 14, 2011 petition paper entitled "THIRD PARTY REQUESTER PETITION UNDER 37 C.F.R. § 1.183 TO SUBMIT RESPONSE TO THE PATENT OWNER PETITION UNDER 37 C.F.R. § 1.182 TO RETURN THIRD PARTY REQUESTER'S COMMENTS," which is being taken and a request to enter an opposition to a patent owner petition.

The petition is dismissed as moot. Requester's opposition petition has a right of entry.

REVIEW OF THE RELEVANT FACTS

1. On March 6, 2009, the Office issued United States Patent Number 7,499,872 (the '872 patent) to Michael P. Thompson.

2. On April 18, 2011, a request for *inter partes* reexamination of the '872 patent was filed by a third party requester and assigned Reexamination Control No. 95/001,604 (the '1604 proceeding).

3. On June 30, 2011, the Office issued an order granting *inter partes* reexamination in the '1604 proceeding. A first Office action on the merits concurrently issued with the order.

4. On September 23, 2011, patent owner timely filed a response to the Office action.[1]

5. On October 24, 2011, third party requester timely filed comments.

6. On October 31, 2011, patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.182 FOR THE OFFICE TO RETURN THIRD PARTY REQUESTER'S COMMENTS AFTER PATENT OWNER'S RESPONSE."

7. On November 14, 2011, third party requester filed the instant petition entitled, "THIRD PARTY REQUESTER PETITION UNDER 37 C.F.R. § 1.183 TO SUBMIT RESPONSE TO THE PATENT OWNER PETITION UNDER 37 C.F.R. § 1.182 TO RETURN THIRD PARTY REQUESTER'S COMMENTS," requesting entry of an opposition.

8. Concurrently on November 14, 2011, third party requester filed an opposition to patent owner's October 31, 2011 petition under 37 CFR 1.182.

DISCUSSION

37 CFR 1.183 provides:

> In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

On October 31, 2011, patent owner filed a petition under 37 CFR 1.182, alleging the requester's October 24, 2011 comments are improper and should be returned. On November 14, 2011, the requester filed an opposition to patent owner's October 31, 2011 petition under 37 CFR 1.182. Concurrently, requester filed the instant petition under 37 CFR 1.183 requesting entry and consideration of the opposition under 37 CFR 1.182. In this instance, requester is opposing the allegations of patent owner regarding the propriety of the October 24, 2011 requester comments. The issues raised by patent owner are not a matter of discretionary relief; the issues raised are whether or not the submission is in compliance with the relevant law, regulations and procedures regarding the conduct of *inter partes* reexamination. The patent owner petition, if granted, would affect the reexamination participation rights of the requester. Therefore, requester is entitled to rebut patent owner's challenge to Office's consideration of information the requester submitted. Accordingly, the petition is dismissed as moot.

CONCLUSION

1. Third party requester's November 14, 2011 petition is dismissed as moot.

[1] Patent owner requested and the Office granted a one month extension of time.

2. Telephone inquiries with regard to this decision should be directed to Joseph Weiss, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7759.

Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

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Icon Health & Fitness, Inc. 1500 South 1000 West Logan, UT 84321	: : :	(For Patent Owner)
Kevin P. Moran Michael, Best & Friedrich, LLP 100 E. Wisconsin Ave., Suite 3300 Milwaukee, WI 53202	: : : :	(For Requester)
In re Watterson et al. *Inter Partes* Reexamination Proceeding Control No. 95/001,605 Filed: April 19, 2011 For: U.S. Patent No. 7,645,213	: : : : :	**DECISION ON PETITION UNDER 37 CFR 1.182**

MAILED

APR 16 2012

CENTRAL REEXAMINATION UNIT

This is a decision on a petition filed by the patent owner on March 22, 2012. The petition is entitled "PETITION UNDER 37 CFR § 1.182 to Reopen Prosecution to Revise Examiner's Amendment" (hereinafter "the petition"). This petition is being treated as a petition filed under 37 CFR § 1.181 as a request to the Director to exercise his discretion pursuant to 37 CFR 1.181 and reopen prosecution.

The petition is before the Director of the Central Reexamination Unit.

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated March 22, 2012 is **denied**.

REVIEW OF FACTS

1. U.S. Patent No. 7,645,213 (hereinafter, "the '213 patent") issued on January 12, 2010.

2. On April 19, 2011 a third party requester deposited a request for *inter partes* reexamination for claims 1-20 of the '213 patent, and the resulting reexamination proceeding was assigned Control No. 95/001,605 (hereinafter, "the '605 reexamination proceeding").

3. On June 6, 2011, an order granting the request for reexamination for claims 1-20 of the '213 patent was mailed. The examiner agreed that a substantial new question of patentability (SNQ) was raised for claims 1-20.

4. Also on June 6, 2011, a non-final Office action was mailed rejecting claims 1-20.

5. On August 8, 2011, patent owner filed a response to the non-final Office action. New claims 21-47 were added by amendment.

6. On September 7, 2011, third party requester filed a response to patent owner's August 8, 2011 response.

7. On October 7, 2011, an Action Closing Prosecution (ACP) was mailed. The ACP indicated that claims 1-21 and 23-47 were rejected, but that claim 22 was patentable.

8. On November 7, 2011, patent owner filed a response after ACP. The response proposed to cancel claims 1-3, 7, 9-10, 12-20, 32,33, 36 and 39-41. The response also proposed to amend claims 31, 37 and 38. The response also set forth arguments regarding the application of references against claims 21 and 23-47.

9. On November 9, 2011, patent owner filed an information disclosure statement.

10. On December 7, 2011, third party requester filed a response to patent owner's November 7, 2011 response.

11. On December 15, 2011, a Right of Appeal Notice (RAN) was mailed. The RAN indicated that patent owner's proposed amendment, filed with the November 7, 2011 response, was entered. The RAN also indicated that claims 1-3, 7, 9, 10, 12-20, 32, 33, 36 and 39-41 were canceled, claims 22, 28 and 29 were patentable, and claims 4-6, 8, 11, 21, 23-27, 30, 31, 34, 35, 37, 38 and 42-47 were rejected.

12. Neither patent owner nor third party requester filed a Notice of Appeal before the expiration of the one month or 30-day time period for response set forth in the RAN.

13. On March 2, 2012, a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed. In the NIRC, the examiner canceled all rejected claims pursuant to MPEP 2687. Accordingly, the NIRC indicated that claims 1-27 and 30-47 were canceled and claims 28 and 29 were patentable. The examiner additionally indicated that claim 22 was canceled because, although it contained allowable subject matter, it depended on rejected claim 21.

14. On March 22, 2012, patent owner filed the instant petition, accompanied by an amendment to the claims, proposing to change the dependency of claim 22 (to depend from claim 18 instead of claim 21) and adding limitations from canceled claim 21.

15. On April 3, 2012, the reexamination certificate issued.

DECISION

The patent owner (petitioner) argues that both the ACP and the RAN indicated that claim 22 was allowed and that although claim 22 depended from claim 21, claim 22 was not objected to. Petition at pages 1-2. Patent owner also states that is anticipated that claim 22 would issue in a reexamination certificate. Petition at page 2. Patent owner also argues that since third party requester has not appealed from the allowance of claim 22, the appropriate examiner's amendment would have been to rewrite allowed claim 22 to incorporate the limitations of claim 21. Petition at page 2.

In response to patent owner's arguments, the director finds there are not good and sufficient reasons to reopen prosecution. Upon review of the entire record, it is determined that the examiner appropriately applied Office policies and procedures in canceling claim 22 because it had not been properly amended. MPEP 2687(III) states: "...the examiner is not permitted to telephone the patent owner to obtain authorization to make an amendment. Accordingly, the only times that an examiner's amendment can be made in conjunction with a NIRC are where the patent owner authorization need not be obtained." In the instant situation, the examiner would have needed patent owner's authorization to rewrite claim 22. Furthermore, the examiner properly canceled claim 21, pursuant to MPEP 2687. Claim 21 was newly filed with this reexamination, not an original patent claim. Thus, the procedures governing patented claims (and the permissibility of a dependent claim remaining after cancelation of an independent patented claim) did not apply. Since patent owner did not respond to the RAN and did not file an amendment to claim 22 (to either change its dependency or rewrite it as an independent claim), the examiner properly canceled claim 22. It is also noted that the reexamination certificate for this reexamination proceeding issued on April 3, 2012.

For the reasons set forth above, it is deemed that the examiner followed Office rules and procedures and did not abuse his discretion in canceling claim 22 in the examiner's amendment mailed with the NIRC on March 2, 2012.

Accordingly, good and sufficient reasons to reopen prosecution in the reexamination proceeding have not been provided and the patent owner's petition is **denied**.

CONCLUSION

1. The petition under 37 CFR 1.181 to reopen prosecution is denied.

2. Patent owner is advised that he has the option to file a reissue application pursuant to 35 USC § 251. See also MPEP 1402.

3. Telephone inquiries related to this decision should be directed to Andres Kashnikow, Supervisory Patent Examiner, at (571) 272-4361.

Irem Yucel, Director
Central Reexamination Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,606	04/20/2011	7899704		3087

2292 7590 04/05/2012
BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 04/05/2012

Please find below and/or attached an Office communication concerning this application or proceeding.

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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Date: MAILED
APR 05 2012
CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001606
PATENT NO. : 7899704
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 05 201
CENTRAL REEXAMINATION UNIT

PANITCH, SCHWARZE BELISARIO & NADEL LLP (For *Inter Partes* Requester)
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103

In re Michael P. Thompson
Inter Partes Reexamination Proceeding
Control No. 95/001,606
Filed: April 20, 2011
For: U.S. Patent No. 7,899,704

DECISION DISMISSING PETITION

This is a decision on *inter partes* third party requester's November 14, 2011 petition paper entitled "THIRD PARTY REQUESTER PETITION UNDER 37 C.F.R. § 1.183 TO SUBMIT RESPONSE TO THE PATENT OWNER PETITION UNDER 37 C.F.R. § 1.182 TO RETURN THIRD PARTY REQUESTER'S COMMENTS," which is being taken and a request to enter an opposition to a patent owner petition.

The petition is dismissed as moot. Requester's opposition petition has a right of entry.

REVIEW OF THE RELEVANT FACTS

1. On March 1, 2011, the Office issued United States Patent Number 7,899,704 (the '704 patent) to Michael P. Thompson.

2. On April 20, 2011, a request for *inter partes* reexamination of the '704 patent was filed by a third party requester and assigned Reexamination Control No. 95/001,606 (the '1606 proceeding).

3. On June 30, 2011, the Office issued an order granting *inter partes* reexamination in the '1606 proceeding. A first Office action on the merits concurrently issued with the order.

4. On September 23, 2011, patent owner timely filed a response to the Office action.[1]

5. On October 24, 2011, third party requester timely filed comments.

6. On October 31, 2011, patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.182 FOR THE OFFICE TO RETURN THIRD PARTY REQUESTER'S COMMENTS AFTER PATENT OWNER'S RESPONSE."

7. On November 14, 2011, third party requester filed the instant petition entitled, "THIRD PARTY REQUESTER PETITION UNDER 37 C.F.R. § 1.183 TO SUBMIT RESPONSE TO THE PATENT OWNER PETITION UNDER 37 C.F.R. § 1.182 TO RETURN THIRD PARTY REQUESTER'S COMMENTS," requesting entry of an opposition.

8. Concurrently on November 14, 2011, third party requester filed an opposition to patent owner's October 31, 2011 petition under 37 CFR 1.182.

DISCUSSION

37 CFR 1.183 provides:

> In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

On October 31, 2011, patent owner filed a petition under 37 CFR 1.182, alleging the requester's October 24, 2011 comments are improper and should be returned. On November 14, 2011, the requester filed an opposition to patent owner's October 31, 2011 petition under 37 CFR 1.182. Concurrently, requester filed the instant petition under 37 CFR 1.183 requesting entry and consideration of the opposition under 37 CFR 1.182. In this instance, requester is opposing the allegations of patent owner regarding the propriety of the October 24, 2011 requester comments. The issues raised by patent owner are not a matter of discretionary relief; the issues raised are whether the submission is in compliance with the relevant law, regulations and procedures regarding the conduct of *inter partes* reexamination. The patent owner petition, if granted, would affect the reexamination participation rights of the requester. Therefore, requester is entitled to rebut patent owner's challenge to Office's consideration of information the requester submitted. Accordingly, the petition is dismissed as moot.

CONCLUSION

1. Third party requester's November 14, 2011 petition is dismissed as moot.

[1] Patent owner had requested and the Office granted a one month extension of time.

2. Telephone inquiries with regard to this decision should be directed to Joseph Weiss, Legal Advisor, Office of Patent Legal Administration, at (571) 272-7759.

Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

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STANLEY J. GRADISAR (For Patent Owner)
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CASTLE ROCK, CO 80109

MAILED

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CENTRAL REEXAMINATION UNIT

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HAMILTON DESANCTIS & CHA LLP (For Third Party Requester)
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LAKEWOOD, CO 80228

In re Hawthorne et al.
Reexamination Proceeding
Control No.: 95/001,609
Filing Date: April 21, 2011
For: U.S. Patent No.: 7,462,149

DECISION DISMSSING PETITIONS

The above reexamination proceeding is before the Director of Technology Center (TC) 1600, who oversees the Central Reexamination Unit, after receipt of a patent owner's petition of September 8, 2011, which is treated as a petition under 37 CFR 1.181 to invoke supervisory authority to not enter the August 18, 2011 requester's comments. This decision also addresses a September 23, 2011 opposition, which is treated as a petition under 37 CFR 1.181 to invoke supervisory authority, by the third party requester in response to the September 8, 2011 petition.

The patent owner's petition of September 8, 2011 is dismissed as premature.

The requester's opposition of September 23, 2011 is dismissed as premature.

SUMMARY OF RELEVANT FACTS

1. U.S. Patent No. 7,462,149 [hereinafter "the '149 patent"] was granted to *Hawthorne et al.* on December 9, 2008.

2. On April 21, 2011, a request for *inter partes* reexamination of the '149 patent was filed by a third party requester. The resulting reexamination proceeding was assigned control number 95/001,609 (the '609 proceeding).

3. On May 20, 2011, the Office issued an order granting *inter partes* reexamination in the '609 proceeding, with an accompanying Office action on the merits.

4. On July 20, 2011, patent owner filed a response to the Office action.

5. On July 20, 2011, a revocation of the power of attorney with an appointment of a new power of attorney was filed in the '609 proceeding.

6. On August 3, 2011, the Office mailed notices entitled "NOTICE REGARDING CHANGE OF POWER OF ATTORNEY" and "NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY."

7. On August 18, 2011, the third party requester filed comments, a copy of which was served on patent owner at Lathrop & Gage LLP in Kansas City, Missouri.

8. On September 8, 2011, the patent owner filed a petition under 37 CFR 1.181, 1.182, and 1.183, which is treated as a petition under 37 CFR 1.181 invoking supervisory review to not enter the third party requester's comments of August 18, 2011.

9. On September 23, 2011, third party requester filed an opposition under 37 CFR 1.181, 1.182, and 1.183 to the September 8, 2011 petition, a copy of which was served on patent owner at Lathrop & Gage LLP in Kansas City, Missouri.

10. The examiner has not acted on the July 20, 2011 response and the August 18, 2011 comments to date.

DECISION

As pointed out, the patent owner filed a September 8, 2011 combined petition under 37 CFR 1.181, 1.182, and 1.183 to not enter the third party requester's August 18, 2011 comments. On September 23, 2011, the requester filed a combined opposition petition under 37 CFR 1.181, 1.182, and 1.183 to the September 8, 2011 petition. Although the petitions contain statements that an alternative relief sought is under 37 CFR 1.182 and/or 1.183, the petitions are being decided solely under 37 CFR 1.181. The combined petitions under 37 CFR 1.181, 1.182, and 1.183 are deemed improper because they combine three distinct petitions, which is not compliant

with 37 CFR 1.4. Accordingly, any relief requested under 37 CFR 1.182 and 1.183 is dismissed under 37 CFR 1.4. In summary, this decision solely addresses the issues raised under 37 CFR 1.181.

The September 8, 2011 petition, which is treated as a petition under 37 CFR 1.181 to invoke supervisory authority, asserts that the requester's comment papers should not be entered in the proceeding record. However, there has been no decision by the examiner if the third party requester's comments of August 18, 2011 are in compliance with Office rules and procedures. Accordingly, it is premature to invoke supervisory authority regarding entry or refusal to enter the August 18, 2011 comments because the examiner has not made his decision. Thus, the patent owner's September 8, 2011 petition and the requester's September 23, 2011 opposition are premature and are accordingly dismissed.

POWER OF ATTORNEY & CORRESPONDENCE ADDRESS ISSUES

The power of attorney and change of correspondence address filed July 20, 2011 is ineffective because the July 20, 2011 communication was not filed in the file for the '149 patent. This decision *sua sponte* vacates the August 3, 2011 Notices. See 37 CFR 1.33(c) and MPEP 2622.

The current power of attorney and correspondence address in this reexamination proceeding remains to be Stanley J. Gradisar, 1182 Thatch Circle, Castle Rock, CO 80109. All future Office correspondence will be mailed to the above-mentioned address. As a one time courtesy, a copy is also being mailed to Lathrop & Gage LLP at the address listed in the July 20, 2011 communication.

Patent owner is called upon to file any change of power of attorney and correspondence address in the patent file (Application No. 10/441,940) in order to properly effectuate a change in this reexamination proceeding.

Third party requester relied upon the Office's acceptance of the change in correspondence address in serving copies of the August 18, 2011 comments and the September 23, 2011 opposition petition to the address indicated in the July 20, 2011 communication. As this decision determines that the address indicated in the July 20, 2011 communication is not the correspondence address of record, the third party requester is given one month to serve all papers already filed by the requester in the reexamination proceeding **on or after August 3, 2011** to the official correspondence address of record for this reexamination, as indicated above.

In the absence of a filing of a change of power of attorney and correspondence address in the patent file, i.e., in application no. 10/441,940, any future correspondence in this reexamination proceeding will be mailed to the patent owner only at the official correspondence address of record in the patent file, application no. 10/441,940, in accordance with 37 CFR 1.33(c) and MPEP 2622.

CONCLUSION

1. The September 8, 2011 patent owner's petition, which is treated as a petition under 37 CFR 1.181, is dismissed as premature.

2. The September 23, 2011 requester's opposition petition, which is treated as a petition under 37 CFR 1.181, is dismissed as premature.

3. The **August 3, 2011 Notices are hereby vacated**.

4. The current patent owner's power of attorney and correspondence address of record is:
   STANLEY J. GRADISAR
   1182 THATCH CIRCLE
   CASTLE ROCK, CO 80109

5. **Third party requester is given one month from the mailing date of this decision to serve all papers already filed by the requester in the reexamination proceeding on or after August 3, 2011 to the official correspondence address of record for this reexamination, as indicated above.**

6. Telephone inquiries related to this decision should be directed Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361.

Irem Yucel, Director
Technology Center 1600

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,609	04/21/2011	7462149	BI-004000	5840

30954 7590 01/10/2012

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KANSAS CITY, MO 64108

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/10/2012

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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225 UNION BOULEVARD, SUITE 150
LAKEWOOD, CO 80228

Date: **MAILED**

JAN 1 0 2012

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001609
PATENT NO. : 7462149
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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JAN 1 0 2012

CENTRAL REEXAMINATION UNIT

Michael A. DeSanctis
Hamilton DeSanctis & Cha LLP
Financial Plaza at Union Square
225 Union Boulevard, Suite 150
Lakewood, CO 80228

(For Third Party Requester)

Inter Partes Reexamination Proceeding
Control No. 95/001,609
Filed: April 21, 2011
For: U.S. Patent No. 7,462,149

: **DECISION**
: **DISMISSING**
: **PETITIONS**
: **AS MOOT**

This is a decision on: (1) patent owner's petition entitled "PETITION UNDER 37 C.F.R. § 1.183 AND BRIEF IN SUPPORT OF SAME" (the petition under 37 CFR 1.183), filed on November 22, 2011, requesting that third party requester's August 18, 2011 comments submission be expunged, and (2) third party requester's paper entitled "THIRD PARTY REQUESTER'S RESPONSE IN OPPOSITION TO PATENT OWNER'S PETITION UNDER 37 CFR 1.183" (the opposition), filed on December 12, 2011. The petition under 37 CFR 1.183 and the opposition are before the Office of Patent Legal Administration.

In light of the communication from the Central Reexamination Unit (CRU), mailed on December 12, 2011, expunging third party requester's August 18, 2011 comments submission as improper, the petition under 37 CFR 1.183 and opposition thereto are dismissed as moot.

Any questions concerning this communication should be directed to Nicole D. Haines, Legal Advisor, at 571-272-7717.

Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

01-05-2012

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CENTRAL REEXAMINATION UNIT

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(Patent Owner)

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LAKEWOOD, CO 80228

(For Third Party Requester)

In re Hawthorne et al.
Reexamination Proceeding
Control No.: 95/001,609
Filing Date: April 21, 2011
For: U.S. Patent No.: 7,462,149

: DECISION
: DISMSSING
: PETITIONS

The above reexamination proceeding is before the Director of the Central Reexamination Unit after receipt of a December 21, 2011 patent owner's petition under 37 CFR 1.181 to invoke supervisory authority to not enter the December 13, 2011 requester's comments. This decision also addresses a January 5, 2012 opposition petition, which is treated as a petition under 37 CFR 1.181 to invoke supervisory authority, by the third party requester in response to the December 21, 2011 petition.

The patent owner's petition of December 21, 2011 is dismissed as premature.

The requester's opposition of January 5, 2012 is dismissed as premature.

SUMMARY OF RELEVANT FACTS

1. U.S. Patent No. 7,462,149 [hereinafter "the '149 patent"] was granted to *Hawthorne et al.* on December 9, 2008.

2. On April 21, 2011, a request for *inter partes* reexamination of the '149 patent was filed by a third party requester. The resulting reexamination proceeding was assigned control number 95/001,609 (the '609 proceeding).

3. On May 20, 2011, the Office issued an order granting *inter partes* reexamination in the '609 proceeding, with an accompanying Office action on the merits.

4. On July 20, 2011, patent owner filed a response to the Office action.

5. On July 20, 2011, a revocation of the power of attorney with an appointment of a new power of attorney was filed in the '609 proceeding.

6. On August 3, 2011, the Office mailed notices entitled "NOTICE REGARDING CHANGE OF POWER OF ATTORNEY" and "NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY."

7. On August 18, 2011, the third party requester filed comments, which a copy was served on patent owner at Lathrop & Gage LLP in Kansas City, Missouri.

8. On September 8, 2011, the patent owner filed a petition under 37 CFR 1.181, 1.182, and 1.183, which is treated as a petition under 37 CFR 1.181 invoking supervisory review to not enter the third party requester's comments of August 18, 2011.

9. On September 23, 2011, third party requester filed an opposition under 37 CFR 1.181, 1.182, and 1.183 to the September 8, 2011 petition, which a copy was served on patent owner at Lathrop & Gage LLP in Kansas City, Missouri.

10. On November 15, 2011, the Office mailed a decision dismissing patent owner's September 8, 2011 petition and requester's September 23, 2011 opposition petition as premature. The decision also vacated the August 3, 2011 communications regarding power of attorney.

11. On December 12, 2011, the Office mailed a communication informing the requester that the August 18, 2011 comments were improper and expunged.

12. On December 13, 2011, the third party requester filed replacement comments.

13. On December 21, 2011, the patent owner filed the instant petition under 37 CFR 1.181.

14. On January 5, 2012, the third party requester filed an opposition petition to patent owner's December 21, 2011 petition.

15. The examiner has not acted on the July 20, 2011 response and the December 21, 2011 comments to date.

DECISION

The December 21, 2011 petition under 37 CFR 1.181 to invoke supervisory authority asserts that the requester's replacement comment papers should not be entered in the proceeding record. However, there has been no decision by the examiner if the third party requester's comments of December 13, 2011 are in compliance with Office rules and procedures. Accordingly, it is premature to invoke supervisory authority regarding entry or refusal to enter the December 13, 2011 comments because the examiner has not made his decision. Thus, the patent owner's December 21, 2011 petition and the requester's January 5, 2012 opposition are premature and are accordingly dismissed.

CONCLUSION

1. The December 21, 2011 patent owner's petition, which is treated as a petition under 37 CFR 1.181, is dismissed as premature.

2. The January 5, 2012 requester's opposition petition, which is treated as a petition under 37 CFR 1.181, is dismissed as premature.

3. Telephone inquiries related to this decision should be directed Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361.

Irem Yucel, Director
Central Reexamination Unit

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(For Patent Owner)

MAILED

JAN 10 2012

CENTRAL REEXAMINATION UNIT

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(For Requester)

In re Hawthorne et al.	:	
Reexamination Proceeding	:	DECISION ON PETITION
Control No.: 95/001,610	:	FOR REOPENING
Filed: April 21, 2011	:	PROSECUTION
For: U.S. Patent No.: 7,641,611	:	UNDER 37 CFR 1.181

This is a decision on a petition filed by the patent owner on October 31, 2011 entitled "PETITION UNDER 37 C.F.R. § 1.181 TO REOPEN PROSECUTION AND ENTER SUPPLEMENTAL RESPONSE," and is a request to the Director to exercise his/her discretion pursuant to 37 CFR 1.181 and order a corrected Office action in place of the Action Closing Prosecution (ACP) issued on September 30, 2011. The petition under 37 CFR 1.181 is also a request for the Office to accept and enter a supplemental response filed with the petition.

The petition is before the Director of the Central Reexamination Unit.

The petition under 37 CFR 1.181 to invoke the supervisory authority of the Director dated October 31, 2011 is granted with respect to withdrawing the ACP dated September 30, 2011. The request to accept and enter a supplemental response is dismissed as moot.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,641,611 (hereinafter, the '611 patent) issued on January 5, 2010.

2. A request for *inter partes* reexamination, assigned control No. 95/001,610, was filed by a third party requester on April 21, 2011.

3. *Inter partes* reexamination was ordered for the '610 reexamination proceeding on May 20, 2011. On the same day, a non-final Office action was mailed in the '610 reexamination proceeding.

4. Prosecution advance and on September 30, 2011 the Office issued an Action Closing Prosecution (ACP). The ACP included a rejection of patent claims 1 and 7 and proposed new claims 15-17.

5. On October 31, 2011, the patent owner filed a response to the ACP. The response included arguments and a proposed amendment to proposed new claim 16. On the same day, the patent owner filed the instant petition under 37 CFR 1.181 and a petition under 37 CFR 1.182, which will be decided in a separate decision in due course.

6. On November 30, 2011, the third party requester filed comments.

DECISION

The patent owner (petitioner) states that the ACP dated September 30, 2011 was not in accordance with Office policies because the ACP changed claimed construction on two terms, did not fully address a declaration filed under 37 CFR 1.132, and added new grounds of rejection to unamended patent claims 1 and 7. Therefore, patent owner argues that Office policy states that the patent owner must be given an opportunity to adequately address any change in position adverse to the patent owner's position. The patent owner states that public policy and Office procedures support the patent owner's position that the ACP was improperly issued. Because of these grounds, petitioner requests that the ACP dated September 30, 2011 should be deemed premature and that prosecution should be reopened.

In response to patent owner's arguments for reopening prosecution in this reexamination proceeding, the director finds there are good and sufficient reasons to do so for the reasons set forth below.

Turning to the facts in this proceeding, patent owner is correct that Office policy supports the reopening of prosecution when the examiner decides to modify his or her position that is adverse to the patent owner's position. Specifically, the examiner stated that he modified the rejection of unamended patent claims 1 and 7 in response to patent owner's argument that the situation analyzer and communication server must be separate elements. See the last sentence on page 35 of the ACP. Therefore, based upon the facts in this proceeding, the ACP of September 30, 2011

cannot fairly be said to have given patent owner an adequate opportunity to address the new position prior to the appeal stage.

37 CFR 1.949 states:

> "Upon consideration of the issues a second or subsequent time, or upon a determination of patentability of all claims, the examiner shall issue an Office action treating all claims present in the *inter partes* reexamination, which may be an action closing prosecution. The Office action shall set forth all rejections and determinations not to make a proposed rejection, and the grounds therefor. An Office action will not usually close prosecution if it includes a new ground of rejection which was not previously addressed by the patent owner, unless the new ground was necessitated by an amendment."

As stated above, the ACP dated September 30, 2011 fails to give patent owner an adequate opportunity to address the new position prior to the appeal stage, in accordance with 37 CFR 1.949 and MPEP 2671 *et seq*. Accordingly, good and sufficient reasons to withdraw the ACP dated September 30, 2011 in the reexamination proceeding have been provided and the patent owner's petition, as it relates to withdrawing the ACP dated September 30, 2011, is granted.

Due to the vactur of the September 30, 2011 Office action, patent owner's responses of October 31, 2011 will be closed and returned and the third party requester's comments of November 30, 2011 will be closed and returned. The request in petition under 37 CFR 1.181 to enter the supplemental response to the ACP is rendered moot because the ACP is vacated.

CONCLUSION

1. The petition under 37 CFR 1.181 for reconsideration of the Action Closing Prosecution dated September 30, 2011 is **granted**.

2. The ACP, dated September 30, 2011, is hereby **vacated** and the examiner will issue a **corrected** Office action, in due course, to replace the September 30, 2011 Office action.

3. The patent owner's comments, dated October 31, 2011 and third party requester's papers dated November 30, 2011 will be closed and returned by closing the papers in the proceeding record, and marking the papers nonpublic to expunge it from the record.

4. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361.

Irem Yucel
Director of Central Reexamination Unit

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,610	04/21/2011	7641611	BI-003100	5855

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EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED: 01/17/2012

Please find below and/or attached an Office communication concerning this application or proceeding.

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Date:

MAILED

JAN 17 2012

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001610
PATENT NO. : 7641611
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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JAN 17 2012

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding : **DECISION**
Control No. 95/001,610 : **DISMISSING**
Filed: April 21, 2011 : **PETITION**
For: U.S. Patent No. 7,641,611 : **AS MOOT**

This is a decision on patent owner's October 31, 2011 petition entitled "PETITION UNDER 37 C.F.R. § 1.182 - QUESTIONS NOT SPECIFICALLY PROVIDED FOR" (the petition under 37 CFR 1.182), requesting that the Office reopen and continue prosecution in the instant reexamination proceeding. The petition under 37 CFR 1.182 is before the Office of Patent Legal Administration.

On page one of the petition under 37 CFR 1.182, patent owner states that "[a] petition under 37 C.F.R. § 1.181 is filed concurrently herewith, if that petition is granted, the current petition is moot and need not be decided." In light of the decision issued by the Central Reexamination Unit (CRU) on January 10, 2012, granting patent owner's October 31, 2011 petition under 37 CFR 1.181 and withdrawing the Action Closing Prosecution issued on September 30, 2011, the instant petition under 37 CFR 1.182 is dismissed as moot.

Any questions concerning this communication should be directed to Nicole D. Haines, Legal Advisor, at 571-272-7717.

Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

01-17-2012