



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,489	07/20/2009	6304975	159291-0011(975)	8274

6449 7590 04/15/2010

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

EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED: 04/15/2010

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



UNITED STATES PATENT AND TRADEMARK OFFICE

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

DO NOT USE IN PALM PRINTER

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

IRELL & MANELLA LLP
1800 AVENUE OF THE STARS
SUITE 900
LOS ANGELES, CA 90067

MAILED
APR 15 2010
CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95000489
PATENT NO. : 6304975
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
www.uspto.gov

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

(For Patent Owner)

IRELL & MANELLA LLP
1800 AVENUE OF THE STARS SUITE 900
LOS ANGELES, CA 90067

(For Third Party Requester)

MAILED

APR 15 2010

CENTRAL REEXAMINATION UNIT

Inter Partes Reexamination Proceeding
Control No. 95/000,489
Filed: July 20, 2009
For: U.S. Patent No. 6,304,975

: **DECISION**
: **DISMISSING**
: **PETITION AND**
: **EXPUNGING**
: **IMPROPER PAPER**

This is a decision on third party requester's February 5, 2010 petition paper entitled "PETITION REGARDING ESR'S SUBMISSION IN VIOLATION OF 37 C.F.R. § 1.943" (the petition under 37 CFR 1.182/1.183).

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

A petition fee of \$400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.182/1.183 is being charged to requester's deposit account, as authorized on page 6 of requester's petition.

The third party requester petition under 37 CFR 1.182/1.183 is dismissed, for the reasons set forth herein.

BACKGROUND

1. On October 15, 2001, United States Patent No. 6,304,975 (the '975 patent) issued to Shipley.
2. On July 20, 2009, a request for *inter partes* reexamination of the '975 patent was filed by a third party requester. The request was assigned Reexamination Control No. 95/000,489 (the '489 proceeding).
3. On August 28, 2009, *inter partes* reexamination was ordered in the '489 proceeding.
4. On September 29, 2009, a non-final Office action was mailed in the '489 proceeding.

5. On January 29, 2010, patent owner filed a petition entitled "PETITION FOR WAIVER OF PAGE LIMIT UNDER 37 C.F.R. § 1.183" (petition under 37 CFR 1.183), concurrently with a patent owner response to the September 29, 2009 Office Action.¹ This petition is being decided by a separate decision being issued concurrently with the present decision.
6. On February 5, 2010, requester filed a petition entitled "PETITION REGARDING ESR'S SUBMISSION IN VIOLATION OF 37 C.F.R. § 1.943" (petition under 37 CFR 1.182/1.183). This petition is the subject of the present decision.

DECISION

I. Relevant Authority

37 CFR 1.4 provides (in-part):

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

37 CFR 1.181 provides (in-part):

(a) Petition may be taken to the Director:

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

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

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

37 CFR 1.182 provides:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing.

Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

¹ The Office granted a 1-month extension of time for patent owner's response on October 30, 2009 and another 1-month extension of time for patent owner's response on December 2, 2009.

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.

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 1.947 provides:

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

II. Third Party Requester Petition Under 37 CFR 1.182/1.183

In the February 5, 2010 petition under 37 CFR 1.182/1.183, third party requester petitions for the following relief: (1) that patent owner's January 29, 2010 response be denied entry for failure to comply with 37 CFR 1.943(b), (2) that patent owner's January 29, 2010 petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) be denied, and (3) waiver under 37 CFR 1.183 "to the extent deemed necessary" to provide an entry right for its petition under 37 CFR 1.182.²

² Petition under 37 CFR 1.182/1.183 at page 1.

A. Requester's February 5, 2010 Petition Under 37 CFR 1.182/1.183

Third party requester's request that patent owner's January 29, 2010 response be denied entry for failure to comply with 37 CFR 1.943(b), although it is filed as part of the petition under 37 CFR 1.182, is a petition under 37 CFR 1.181 from the Central Reexamination Unit (CRU) posting of the response in the electronic Image File Wrapper (IFW) for the present proceeding; this is a matter that would be decided by the Central Reexamination Unit (CRU). Third party requester's request that patent owner's January 29, 2010 petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) be denied is considered a petition under 37 CFR 1.182, which is a matter that would ordinarily be decided by the Office of Patent Legal Administration (OPLA). Accordingly, third party requester's February 5, 2010 petition under 37 CFR 1.182/1.183 is dismissed under 37 CFR 1.4(c), as each distinct subject must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects that are considered by different areas of the Office.

B. Requester Comments Not Permitted for Procedural Matters in *Inter Partes* Reexamination

Additionally, for the reasons set forth below, the February 5, 2010 third party requester petition under 37 CFR 1.182, requesting that patent owner's January 29, 2010 petition under 37 CFR 1.183 for waiver of 37 CFR 1.943(b) be denied, does not have a right of entry in the '489 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. This right is implemented by 37 CFR 1.947, which provides that a third party requester may once file written comments within 30 days from the date of service of a patent owner's response to an Office action on the merits pursuant to 37 CFR 1.945. Patent owner's January 29, 2010 petition under 37 CFR 1.183, requesting suspension of 37 CFR 1.943(b) for waiver of page limit, however, is not a "response" to an Office action on the merits. 35 U.S.C. § 314(b)(2) does not provide any right for the third party requester to file comments on a patent owner's petition under 37 CFR 1.183 for suspension of the rules.

A third party requester's opposition paper in response to a patent owner's petition for waiver of the page limit set out in 37 CFR 1.943(b) is not a paper that is permitted by the statute governing *inter partes* reexamination proceedings, and accordingly was not provided for (i.e., was not permitted) in the regulations that implemented the *inter partes* reexamination statute. Furthermore, third party requester's petition under 37 CFR 1.183 requesting entry of the concurrently filed petition under 37 CFR 1.182 has not been granted as detailed below. Third party requester's February 5, 2010 petition under 37 CFR 1.182 filed in opposition to patent owner's petition under 37 CFR 1.183, therefore, is not enterable into the record.

Pursuant to 37 CFR 1.939(a), "[i]f an unauthorized paper is filed by any party at any time during the *inter partes* reexamination proceeding it will not be considered and may be returned." For the reasons discussed above, third party requester's February 5, 2010 petition under 37 CFR

1.182 filed in opposition to patent owner's January 29, 2010 petition under 37 CFR 1.183 does not have a right of entry into the record of the '489 proceeding and, as such, is not an authorized paper. Because third party requester's February 5, 2010 petition under 37 CFR 1.182 has been scanned into the electronic Image File Wrapper (IFW), the paper is being expunged by marking it "closed" and "non-public" in the IFW, and will not constitute part of the record of the '489 proceeding. See MPEP 2267.

C. The Office Lacks Statutory Authority to Consider the Substance of Requester's Petition

As noted above, on February 5, 2010, third party requester filed a petition under 37 CFR 1.183 requesting waiver of the rules for entry of its petition under 37 CFR 1.182 filed in opposition to patent owner's January 29, 2010 petition under 37 CFR 1.183. However, the rules cannot be waived to provide the third party requester the right to file a paper at the present stage in the '489 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.

Whether a patent owner's petition under 37 CFR 1.183 for suspension of the rules is grantable is an issue that goes to procedure and a showing of equities, rather than to the merits. While enactment of the *inter partes* reexamination statute was for the purpose of expanding a third party requester's participation in the merits of the proceeding, there is no indication whatsoever in the legislative history of the *inter partes* reexamination statute that the requester was granted any right to challenge the granting of a petition under 1.183 for suspension of the rules in an *inter partes* reexamination proceeding. Such a right was not provided in the enactment of the *inter partes* reexamination statute (or in any of its precursor bills), and there is no evidence to indicate that enacting such a right was ever contemplated by Congress.

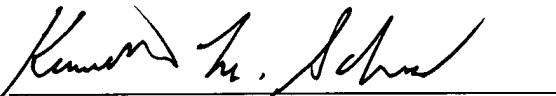
37 CFR 1.183 permits waiver of the regulations in an extraordinary situation when justice requires. Requester's February 5, 2010 petition, however, seeks to waive a requirement set forth in 35 U.S.C. § 314(b)(2), which allows requester comments only in response to a patent owner's response on the merits. Accordingly, the Office is without statutory authority to consider the substance of third party requester's February 5, 2010 petition paper. In this respect, third party requester stands on a footing no different from any other member of the public who wishes to challenge a procedural action taken by the Office in a proceeding. The patent statute simply does not provide for such intervention.

CONCLUSION

1. Third party requester's February 5, 2010 petition under 37 CFR 1.182/183 is dismissed.
2. Third party requester's February 5, 2010 petition under 37 CFR 1.182 filed in opposition to patent owner's January 29, 2010 petition under 37 CFR 1.183 does not have a right of entry

into the record of the '489 proceeding and, as such, is not an authorized paper. Because third party requester's February 5, 2010 petition under 37 CFR 1.182 has been scanned into the electronic Image File Wrapper (IFW), the paper is being expunged by marking it "closed" and "non-public" in the IFW, and will not constitute part of the record of the '489 proceeding.

3. Jurisdiction for the '489 reexamination proceeding is returned to the Central Reexamination Unit (CRU).
4. Any questions concerning this communication should be directed to Nicole Dretar, Legal Advisor, at (571) 272-7717.



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

4-14-10
Kimprop/opposition