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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/013,148	02/10/2014	6174237	16904.0001USRX	8158

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EXAMINER	
DOERRLER, WILLIAM CHARLES	
ART UNIT	**PAPER NUMBER**
3993	

MAIL DATE	DELIVERY MODE
03/21/2014	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.

Order Granting / Denying Request For Ex Parte Reexamination	Control No.	Patent Under Reexamination
	90/013,148	6174237
	Examiner	Art Unit
	WILLIAM DOERRLER	3993

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The request for *ex parte* reexamination filed *10 February 2014* has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a)☐ PTO-892, b)☒ PTO/SB/08, c)☐ Other: _____

1. ☐ The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. ☒ The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 (c) will be made to requester:

a) ☐ by Treasury check or,

b) ☒ by credit to Deposit Account No. *13-2725*, or

c) ☐ by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

/WILLIAM DOERRLER/ Primary Examiner, Art Unit 3993		

cc:Requester (if third party requester)

The present application is being examined under the pre-AIA first to invent provisions.

DECISION ON REQUEST FOR REEXAMINATION

No substantial new question of patentability is raised by the request for reexamination and prior art cited therein for the reasons set forth below.

A substantial new question of patentability affecting claim 1 of United States Patent Number 6,174,237 is not raised by the request for *ex parte* reexamination.

Brief Summary of the Previous Examination

The '237 patent issued with 19 claims on January 16, 2001. The '237 patent issued from application 09/316,840, which was filed on May 21, 1999, with 19 claims. After an amendment clarifying the potential games, the application was allowed on July 31, 2000. The Notice of Allowability included the following reasons for allowance:

The prior art of record does not anticipate nor make obvious a method of playing a game of (s)kill tournament having a qualifying round and a playoff round, and played over an interactive computer system, said interactive computer system having a host computer system, a plurality of terminals computers and compatible software, said method comprising the steps of : playing a game of skill in a qualifying round between a single player and a host computer; evaluating the results of said qualifying round to

determine if said player qualifies to be classified within a qualifying performance level taken from said plurality of performance levels; distributing to said player a performance level award, said performance level award being dependent upon the specific performance level obtained; playing a game of skill in a playoff round between said player and the host computer simultaneously along with other players, wherein each player has been classified within a qualifying performance level; evaluating the results of said playoff round to determine a tournament winner and subsequently ranking of players; and distributing tournament award to tournament participants."

Substantial New Question

The Patent owner requested reexamination of claim 1 of U.S. Patent No. 6,174,237 (hereinafter "the '237 patent) based upon the following proposed rejection:

A. Claim 1 of the '237 patent is unpatentable under 35 USC 102(b) as anticipated by PCT document WO97/39811 to Walker (hereinafter "Walker").

A discussion of the prior art reference now follows:

Walker is a Patent Cooperation Treaty (PCT) document that was not considered during the original examination, and is prior art under 35 U.S.C. 102(b) due to its October 30, 1997 publication date being more than one year earlier than the May 21, 1999 filing of the '237 patent.

Discussion of the SNQ based on Walker

It is NOT agreed that Walker raises a substantial new question of patentability regarding claim 1 as set forth in the request for reexamination on pages 9-14. Patent owner (hereinafter "PO") is correct that while proposed amendments can be submitted with the request, the request must be decided on the wording of the patent claims in effect at the time of filing. See MPEP 2221. While Walker was not cited during the original prosecution of the '237 patent, a currently pending *inter partes* review (IPR) presents an anticipation rejection of claim 1 relying on Walker. The analysis supplied in the current request supporting the anticipation rejection based on Walker relies entirely upon the analysis presented at the Patent Trial and Appeal Board (PTAB) in IPR2013-00289. While the examiner agrees that Walker presents a substantial question of patentability, the fact that the exact question is currently being considered by the PTAB means that the question cannot be considered new.

On November 2, 2002, Public Law 107-273 was enacted. Title III, Subtitle A, Section 13105, part (a) of the Act revised the reexamination statute by adding the following new last sentence to 35 U.S.C. 303(a) and 312(a):

"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."

For any reexamination ordered on or after November 2, 2002, the effective date of the statutory revision, reliance on previously cited/considered art, i.e., "old art," does not necessarily preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on that old art. Rather, determinations on whether a SNQ exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis.

In the present instance, a SNQ does not exist based solely on Walker. A discussion of the specifics now follows:

The 2002 Act did not negate the statutory requirement for a substantial new question of patentability that requires raising new questions about pre-existing technology. This requires the "old art" to provide a "new light" in which to read the reference in question as compared to the earlier presentation of the reference. In the instant case, the proposed Walker rejection is directly taken from the IPR proceeding without any new teaching, material new argument or interpretation. While a proposed rejection based on Walker could provide a substantial question of patentability, in the instant case there is no change from the question of patentability that has already been considered by the Office (IPR2013-00289). The OG Notice of March 1, 2005 entitled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending" (hereinafter "the 2005 Notice") stated that due to multiple filings based on the same question of patentability causing reexaminations to lose their ability for "special dispatch" as required by 35 U.S.C. 305, "(i)f the old prior art cited (in

the second or subsequent request) raises only the same issues that were raised to initiate the pending reexamination proceeding, the second or subsequent request will be denied." As PO has stated in the request that only the same issues that have already been raised in the pending IPR are relied upon in the current request, to grant the current request would be counter to published Office policy. It cannot be said that the art in the present request is non-cumulative to art already considered by the Office, as the identical art is applied in the identical manner.

PO cites in the request *Idle Free Systems, Inc. v. Bergstrom, Inc.* Case IPR2012-00027, in which the Board stated, "[A] patent owner may file a request for ex parte reexamination, relying on the Board's conclusion of a petitioner's having shown reasonable likelihood of success on certain alleged grounds of unpatentability as raising a substantial new question of unpatentability." In fact in IPR2013-00289, the ongoing *inter partes* review of the '237 patent in question, the Board wrote, "The Board directed attention to prior Board decisions which suggest that a Patent Owner may pursue new claims in another type of proceeding before the Office during the trial." The statement from Idle Free appears to be contrary to established Office policy (as detailed above). Further, the statement is inaccurate at least to the extent that it implies that any finding of RLP perforce raises a substantial new question of patentability. However, unlike RLP, the SNQ standard requires that the question be new. Thus, it is possible for an RLP to be raised without meeting the SNQ standard. Further, the statement from *Idle Free* above appears to imply that the same grounds of unpatentability can be used for any number of reexaminations, which is counter to Office policy as published in the

2005 Notice. The second statement that PO can pursue new claims in "another type of proceeding" appears to more correctly be applied to reissue proceedings. Patent owner is attempting to add new, more specific claims to the patent. This appears to be an admission by PO that the patent is erroneous in that patentee claimed "more or less than he had right to claim in the patent", in accordance with 35 U.S.C. 251. This is in agreement with *In re Tanaka* (640 F.3d 1246. 1251, 98 USPQ2d 1331, 1334 (Fed. Cir. 2011), which found an error under 35 U.S.C. 251 may be based upon the addition of a claim or claims that is/are narrower in scope than the existing patent claims, without any narrowing of the existing patent claims.

Conclusion

The request has not established a substantial new question of patentability for claim 1. Accordingly, the request for reexamination is **DENIED.**

The requester is advised that review of this decision may be sought by way of a petition filed under 37 CFR 1.515(c) within a month of the mailing date of this communication. See MPEP 2248 for more information.

Please mail any communications to:

Attn: Mail Stop "Ex Parte Reexam"
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Please FAX any communications to:

(571) 273-9900
Central Reexamination Unit

Please hand-deliver any communications to:

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

Any inquiry concerning this communication or earlier communications from the Examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.
Signed:

/William C. Doerrler/

William C. Doerrler
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Conferee: /ple/

Conferee: /AK/