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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,416	11/10/2008	6496827	30016/365908	8328

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PATTON BOGGS LLP
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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 02/26/2009

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



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Date:

MAILED

FEB 26 2003

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95000416

PATENT NO. : 6496827

TECHNOLOGY CENTER : 3999

ART UNIT : 3992

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

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

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

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



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(For Patent Owner)

MAILED

FEB 26 2009

CENTRAL REEXAMINATION UNIT

(For Requester)

JOHN S. PRATT, ESQ
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET
ATLANTA, GA 30309

In re Kozam et alia :
Reexamination Proceeding :
Control No. 95/000,416 :
Request Deposited: November 10, 2008 :
For: U.S. Patent No. 6,496,827 :

This is a decision on the December 22, 2008 third party requester "PETITION TO DIRECTOR REQUESTING WITHDRAWAL OF DECISION *SUA SPONTE* VACATING *INTER PARTES* REEXAMINATION FILING DATE" and the December 23, 2008 "SUPPLEMENT TO DECEMBER 22, 2008 PETITION TO DIRECTOR REQUESTING WITHDRAWAL OF DECISION *SUA SPONTE* VACATING *INTER PARTES* REEXAMINATION FILING DATE".

The petition, the supplemental petition, and *inter partes* reexamination control number 95/000,416 are before the Office of Patent Legal Administration.

The petition to withdraw the decision vacating the filing date is considered pursuant to 37 CFR § 1.181(a)(3). As the filing date of a national stage of an application filed in accordance with the Patent Cooperation Treaty ("PCT") is the international filing date, U.S. patent 6,496,827 was filed prior to November 29, 1999 and is not subject to *inter partes* reexamination. Accordingly, the petition is **denied** for the reasons set forth in detail below. The decision is designated as a final agency action under 5 U.S.C. § 704.

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REVIEW OF FACTS

1. U.S. Patent No. 6,496,827 (hereinafter, the '827 patent), issued to Kozam *et al*, on December 17, 2002 from application number 09/423,378, an application that entered the national stage under 35 U.S.C. § 371 on January 28, 2000 after having been filed under the Patent Cooperation Treaty on May 12, 1998 as international application number PCT/US98/09590.
2. On November 10, 2008, a third party submitted a request for *inter partes* reexamination of the '827 patent. The request was assigned Control No. 95/000,416 (hereinafter, the '416 proceeding).
3. On November 19, 2008, a "Notice of *Inter Partes* Reexamination Request Filing Date" was mailed for the '416 proceeding. The notice assigned the filing date of November 10, 2008, to the request for reexamination.
4. On December 19, 2008, the office mailed a "DECISION SUA SPONTE VACATING INTER PARTES REEXAMINATION FILING DATE" terminating the '416 proceeding.
5. On December 22, 2008, third party requester filed a "PETITION TO DIRECTOR REQUESTING WITHDRAWAL OF DECISION SUA SPONTE VACATING INTER PARTES REEXAMINATION FILING DATE". This paper is the subject of the instant decision.
6. On December 23, 2008, third party requester filed a "SUPPLEMENT TO DECEMBER 22, 2008 PETITION TO DIRECTOR REQUESTING WITHDRAWAL OF DECISION SUA SPONTE VACATING INTER PARTES REEXAMINATION FILING DATE". This supplemental paper is also addressed in this decision.
7. On December 23, 2008, Patent owner filed papers entitled "PETITION TO DISMISS QUINTILES' PETITION TO DIRECTOR REQUESTING WITHDRAWAL OF DECISION SUA SPONTE VACATING INTER PARTES REEXAMINATION FILING DATE" and "PETITION TO DISMISS QUINTILES' PETITION TO DIRECTOR REQUESTING WITHDRAWAL OF DECISION SUA SPONTE VACATING INTER PARTES REEXAMINATION FILING DATE". This paper is being addressed in a separate decision.
8. On January 6, 2009 third party requester filed a paper entitled "SECOND SUPPLEMENT TO DECEMBER 22, 2008 PETITION TO DIRECTOR REQUESTING WITHDRAWAL OF DECISION SUA SPONTE VACATING INTER PARTES REEXAMINATION FILING DATE". This paper is being addressed in a separate decision.

DECISION

I. The December 19, 2008 Decision Vacating the Filing Date

As pointed out above, on December 19, 2008, the Office mailed a decision vacating the filing date of the '416 *inter partes* reexamination proceeding. The decision found that the '827 patent, which issued from an application that entered the national stage under 35 U.S.C. § 371 on January 28, 2000 after having been filed under the Patent Cooperation Treaty on May 12, 1998, was filed prior to November 29, 1999 and is not subject to *inter partes* reexamination. Specifically, the decision¹ stated:

The U.S. filing date of a patent application based on an international stage Patent Cooperation Treaty application that successfully enters the national stage in the United States is, by virtue of 35 § U.S.C. 363, the filing date of the international application and not the date of entry into the national stage. See: MPEP §§ 1893 and 1893.03(b).

As set forth in 37 CFR 1.913 and as stated in MPEP § 2609, the *inter partes* reexamination statute and rules permit any third party requester to request *inter partes* reexamination of a patent which issued from an original application that was filed on or after November 29, 1999.

Since the filing date of the application that matured into the '827 patent is before November 29, 1999, the '827 patent is not eligible for *inter partes* reexamination.

II. Third Party Requester's Position

Third party requester filed submissions on December 22 and 23, 2008 requesting withdrawal of the December 19, 2008 decision vacating the filing date of the '416 proceeding.

Requester's position is that a national stage application is an "original" application as of the filing date of the paperwork for entry into the national stage. Thus, the filing date of the national stage governs eligibility for *inter partes* reexamination. Accordingly, as the '378 application entered the national stage after November 29, 1999, the '827 patent is eligible for *inter partes* reexamination and the reexamination filing date should be reinstated.²

¹ "Decision *Sua Sponte* Vacating *Inter Partes* Reexamination Filing Date" mailed December 19, 2008 at page 4.

² Petition dated December 22, 2008 at page 4

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A. Requester contends that the filing date is established by national stage entry

Requester contends ³ that the date that applicant commences the national stage by meeting the requirements of 35 U.S.C. § 371 (c) (1), (2), and (4) controls the eligibility for *inter partes* reexamination. Requester cites one sentence in MPEP § 2611 emphasizing “and the national stage phase of international applications” and equates the date the national stage phase is entered by meeting the requirements of 35 U.S.C. § 371 (c) (1), (2), and (4) as “the critical date...when the ‘national stage phase’ is filed.”

Requester also cites 35 U.S.C. § 363 emphasizing “shall have the effect” in the language “[a]n international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office...” ⁴ and notes that 35 U.S.C. §§ 119(a) and 120(a) employ the same language (“shall have the effect”).

Thus, requester contends that 35 U.S.C. § 363 establishes

that the national stage application shall have the effect of the international application, but does not establish that the actual filing date of the national stage phase application is the filing date of the international application for all purposes including eligibility for *inter partes* reexamination, just as, analogously, 35 U.S.C. § 120 does not establish that the filing date of a continuation application is the filing date of the parent application for all purposes. ⁵

Requester acknowledges that MPEP § 1893.03(b) states that “[f]or most legal purposes, the filing date is the PCT international filing date.” However, requester points out that MPEP § 1893.03(b) also states that there are non-limiting examples of exceptions to the general rule (one example being that patent term adjustment is measured from the date the national stage phase commenced).

B. Requester contends that the USPTO has a practice of granting *inter partes* Reexamination Requests under comparable facts

Requester asserts that the USPTO has already granted *inter partes* reexamination requests with a similar fact pattern regarding the dates (i.e., the international application was filed before November 29, 1999 and the national stage phase was entered after November 29, 1999). Specifically, requester identifies three *inter partes* reexaminations in a similar position and argues that these instances have “established

³ Petition dated December 22, 2008 at pages 4-5

⁴ 35 U.S.C. § 363

⁵ Petition dated December 22, 2008 at page 5

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practice of determining *inter partes* reexamination eligibility based on national stage phase date".⁶

C. Requester contends that Federal Circuit Law supports the eligibility of the '827 patent for *inter partes* reexamination

Requester cites to *Cooper Techs. Co. v. Dudas*, 536 F.3d 1330 (Fed. Cir. 2008), in which the Federal Circuit held that a patent that issued from a continuation application filed after November 29, 1999, which claimed priority to an application filed prior to November 29, 1999, was eligible for *inter partes* reexamination.

Requester argues that "[t]his is analogous to the situation here because it is not the priority date of the application or effective date for prior art purposes that determines whether the patent is eligible for *inter partes* reexamination; rather, it is the actual filing date."⁷

III. Analysis and Findings

Summary

This decision ultimately turns on whether the international filing date of a PCT application that enters the national stage under 35 U.S.C. § 371 is a filing date or a priority date. That is, requester is arguing that 35 U.S.C. § 363 only provides for a benefit claim to the international filing date, but does not establish an actual filing date of the national stage application.⁸ Requester's position appears to be predicated on the assumption that a national stage filing is an application separate from the international application (PCT), and is related to the PCT by a claim for priority. However, as explained below, the national stage is actually entry into a separate stage in the international application and the filing date of the national stage filing is the international filing date of the PCT application. That is, the national stage is not claiming benefit of an earlier filing date by way of a priority claim to the PCT, but the national stage application filing date is the date that the PCT was filed.

The remainder of section III will supply the reasoning for the Office's position and respond to requester's arguments.

⁶ Petition dated December 22, 2008 at page 7 and Supplemental Petition dated December 23, 2008 at pages 1-2.

⁷ Petition dated December 22, 2008 at page 8

⁸ See section IIA above.

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A. The international filing date of a PCT application is also the U.S. filing date for the corresponding national stage application

As stated in the decision of December 19, 2008:

PCT applications are deposited with an international Receiving Office, and may, after the international stage, enter the national stage whereby the application becomes an application for a national patent in each of one or more countries selected by the applicant. The U.S. filing date of a patent application based on an international stage Patent Cooperation Treaty application that successfully enters the national stage in the United States is, by virtue of 35 § U.S.C. 363, the filing date of the international application and not the date of entry into the national stage. See MPEP §§ 1893 and 1893.03(b).⁹

A.1 Broadcast Innovation

The Court of Appeals for the Federal Circuit has addressed the issue of the filing date of a national stage entry of a PCT application. In *Broadcast Innovation v. Charter Communication*, the Federal Circuit held that “under 35 U.S.C. § 363, the international filing date of a PCT application is also the U.S. filing date for the corresponding national stage application.”¹⁰

In *Broadcast Innovation*, the defendant in an infringement suit contested the validity of U.S. Patent No. 6,076,094 (the '094 patent) based on prior art that antedated the earliest claimed priority date.

The '094 patent states:

This application is a divisional of U.S. patent application Ser. No. 09/054,896, filed Apr. 3, 1998, now patented as *U.S. Pat. No. 5,999,934*, which is a continuation of U.S. patent application Ser. No. 08/436,336, filed Jul. 18, 1995, now patented as *U.S. Pat. No. 5,737,595*.

The statement of priority did not, however, include PCT application PCT/AU/93/00607, which was filed on November 26, 1993. The PCT application “entered the national stage”¹¹ in the United States on July 18, 1995 as national stage application no. 08/436,336 (the '336 application). The '336 national stage application eventually matured into *U.S. Patent No. 5,737,595* (the '595 patent).¹² Significantly, the '094 patent does not make reference to the PCT application.

⁹ “Decision *Sua Sponte Vacating Inter Partes* Reexamination Filing Date” mailed December 19, 2008 at page 4.

¹⁰ *Broadcast Innovation v. Charter Communications*, 420 F.3d 1364, 1368 (Fed. Cir. 2005)

¹¹ This is the language used by 35 U.S.C. 371(e)

¹² *Broadcast Innovation v. Charter Communications*, 420 F.3d 1364, 1366 (Fed. Cir. 2005).

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Stated another way, the '094 patent included a specific reference to its predecessors, the '934 patent and the '595 patent, but did not include a specific reference to the PCT application on its cover or in its specification. Thus, the issue before the Federal Circuit was a question of law – what is the priority date of the '094 patent in the absence of a specific reference to the PCT application.

The district court had found that the absence of the specific reference to the earlier PCT in the '094 patent constituted a failure to meet the requirements for benefit of filing date afforded under 35 U.S.C. § 120, and accordingly held the priority date of the '094 patent to be July 18, 1995 – the date of entry into the national stage as application 08/436,336. Accordingly, the publication of the PCT document on June 9, 1994 was found to be prior art available against the '094 patent claims under 35 U.S.C. 102(b), resulting in claim invalidity.

The Federal Circuit reversed the district court's invalidity holding, "[b]ecause this court finds the '094 patent is at least entitled to a priority date of November 26, 1993, which is prior to June 9, 1994." ¹³ Specifically, the court stated:

As previously mentioned, the applicant filed the '595 patent on July 18, 1995, as the U.S. national stage application of the original PCT application. However, July 18, 1995 is not the "U.S. filing date" of the '595 patent. Specifically, under 35 U.S.C. § 363, **the international filing date of a PCT application is also the U.S. filing date for the corresponding national stage application. 35 U.S.C. § 363 (1984) [Emphasis added];** ¹⁴

Thus, the Federal Circuit has specifically addressed the issue at hand, and it has held that the international filing date and the U.S. filing date are one and the same. Following that reasoning here requires the denial of requester's petition.

A.2 Response to Requester's Arguments with respect to Filing Date

Regarding requester's argument that the language of 35 U.S.C. § 363 "does not establish that the actual filing date of the national stage phase application is the filing date of the international application for all purposes including eligibility for *inter partes* reexamination," ¹⁵ it is noted that 35 U.S.C. § 363 states that "[a]n international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office" and PCT Article 11 (referenced in 35 U.S.C. § 363) states "an international filing date shall have the effect of a regular national application in each designated State as of the international filing date, which date shall

¹³ *Broadcast Innovation v. Charter Communications*, 420 F.3d 1364, 1368 (Fed. Cir. 2005).

¹⁴ *Broadcast Innovation v. Charter Communications*, 420 F.3d 1364, 1368 (Fed. Cir. 2005).

¹⁵ Petition dated December 22, 2008 at page 5

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be considered to be the actual filing date in each designated State” except as identified in Article 64(4). Article 64(4) relates to the prior art date of a reference (e.g. the 35 U.S.C. § 102(e) date), an exception that is not relevant here.

It is understood that 35 U.S.C. § 363 does not establish this filing date for “all” purposes. 35 U.S.C. § 363 expressly states one exception (i.e. “except as otherwise provided in section 102(e) of this title”). Requester notes that another exception is listed in MPEP § 1893.03(b) regarding patent term adjustment under 35 U.S.C. § 154. The only exceptions noted by requester or the MPEP are exceptions that are explicit in other sections of Title 35. See, e.g., § 154(b)(1)(A)(i)(II). Although requester alludes to the possibility that there may be other exceptions because the statute, rules, and MPEP do not treat the exceptions as a closed set, the argument fails to point out why requester believes there should be another exception to permit eligibility for *inter partes* reexamination based on the date the national stage phase commences rather than the filing date of the international application. And, as pointed out above, the Federal Circuit has held in *Broadcast Innovation* that the present set of facts does not provide another exception.

Regarding the portion of the sentence from MPEP § 2611 quoted by requester,¹⁶ the sentence does not state that the date the national stage is entered should be considered the filing date. The sentence states that national stage phase applications are eligible for *inter partes* reexamination. The entire list (i.e. “utility, plant and design applications, including first filed applications, continuations, divisionals, continuations-in-part, continued prosecution applications (CPAs) and the national stage phase of international applications”) encompasses the eligible applications but says nothing about whether the national stage entry date is analogous to a filing date.

Requester points out¹⁷ that MPEP § 1893.03(b) uses the phrase “actual filing date” with respect to the date the national stage commenced. However, the phrase is set off with quotation marks to emphasize its unusual and unconventional usage. If the MPEP had intended to imply that commencement of the national stage phase was the actual filing date, the quotation marks would not have been used. The passage cited by requester explains that the date the national stage commenced is not an actual filing date, but for purposes of patent term adjustment, the guarantee of prompt Patent and Trademark Office responses (from 35 U.S.C. § 154 (b)(1)(A)) runs only from the date the national stage commenced. It should be noted that 35 U.S.C. § 154 uses the longer, legally correct phrase “the date on which an international application fulfilled the requirements of section 371 of this title” as opposed to “actual filing date.” Finally, it is to be noted that the actual patent term set forth in 35 U.S.C. § 154 (a)(2) runs from the international filing date, and not from the date the national stage commenced. See also MPEP § 2701. “A patent granted on an international application filed on or after June 8, 1995 and which enters the national stage under 35 U.S.C. § 371 will have a term which ends twenty years from the filing date of the international application.”

¹⁶ Petition dated December 22, 2008, sentence bridging pages 4-5

¹⁷ Petition dated December 22, 2008 at page 6

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Finally, January 28, 2000, was actually the national phase entry date of a PCT international application filed nearly two years earlier, not the filing date of the application. This is reflected on the face of the '827 patent, which shows a PCT filing date of May 12, 1998. The § 371 compliance date, of January 28, 2000, is not cited as a filing date but rather as "§ 371(c)(1), (2), (4) Date".

B. The Office has not established a practice of granting *inter partes* Reexamination Requests under comparable facts

Regarding the instances where the Office ordered *inter partes* reexamination with a similar fact pattern, third party requester's position that this creates a binding "established practice" is not accepted. Rather, a review of the prosecution history of the three identified proceedings indicates that this issue simply was never addressed in those proceedings. Thus, this is an issue of first impression.

C. Federal Circuit Law supports the non-eligibility of the '827 patent for *inter partes* reexamination

Regarding requester's point that *Cooper Techs. v. Dudas, supra.* provides that eligibility for *inter partes* reexamination depends on the filing date rather than the priority date, requester is correct that the filing date rather than priority date is the determining factor. However, the Federal Circuit has held that for an application that enters the national stage under 35 U.S.C. 371, the U.S. filing date is the international filing date as explained above.¹⁸

Note that *Cooper* addresses whether a continuing application filed under 35 U.S.C. § 111 and claiming benefit of a prior application under 35 U.S.C. § 120 was an "original application" within the meaning of section 4608 of the American Inventors Protection Act. Although, *Cooper* could, by analogy, be relied on to show that a national stage application under 35 U.S.C. § 371 is an "original application," that is not relevant to the disposition of this petition, since the filing date of this "original application" is the date of the international filing under the PCT.

D. Result

The international filing date is the filing date of the national stage "original application" as required by 35 U.S.C. § 363. Within the meaning of the Intellectual Property and Communications Omnibus Reform Act of 1999, Title IV, subtitle F, Section 4608, the "original application filed in the United States" that resulted in the '827 patent (for which reexamination is requested) was filed on May 12, 1998. Since the filing date of the

¹⁸ *Broadcast Innovation v. Charter Communications*, 420 F.3d 1364 (Fed. Cir. 2005).

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application that matured into the '827 patent is before November 29, 1999, the '827 patent is not eligible for *inter partes* reexamination.

IV. Decision

International application number PCT/US98/09590 was filed on May 12, 1998. As set forth in 37 CFR § 1.913 and as stated in MPEP § 2609; the *inter partes* reexamination statute and rules permit any third party requester to request *inter partes* reexamination of a patent which issued from an original application that was filed on or after November 29, 1999. Specifically, Title IV, subtitle F, Section 4608 (Effective Date) of the "Intellectual Property and Communications Omnibus Reform Act of 1999" provides that:

Subtitle F shall take effect on the date of the enactment and shall apply to any patent that issues from an original application filed in the United States on or after that date, except that the amendments made by section 4605(a) shall take effect one year from the date of enactment.

The '827 patent issued from the national stage of international application PCT/US98/09590. Since the filing date of the application that matured into the '827 patent is before November 29, 1999, the '827 patent is not eligible for *inter partes* reexamination, and conducting an *inter partes* reexamination of the '827 patent would be an *ultra vires* act on the part of the Office.

CONCLUSION

1. The petition under 37 CFR 1.181 and 1.927 is **denied**. Third party requester's requested relief to restore the November 10, 2008 reexamination filing date will not be granted.
2. This decision is designated as a final agency action under 5 U.S.C. § 704.
3. The proceeding is hereby forwarded to the Central Reexamination Unit for termination of pre-processing. The request papers were filed by EFS-WEB, and thus, they appear in the electronic Image File Wrapper (IFW). Since the request is not eligible for *inter partes* reexamination, the request papers will be marked "closed" and "non-public," and will not constitute part of the public record. A refund of the \$8,800 reexamination filing fee will be made to requester in due course.

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4. Any further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450

5. Telephone inquiries related to this decision should be directed to Kenneth M. Schor, Senior Legal Advisor, at (571) 272-7710 or Pinchus M. Laufer, Legal Advisor at (571) 272-7726.



Robert A. Clarke, Director
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy