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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,278	09/16/2008	5394140	347236US	8689

22850 7590 06/25/2010

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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 06/25/2010

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



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EXAMINER

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*Motorola*, No. 3:08-CV-0284-G (N.D. Tex. 2008) pending resolution of specified reexamination proceedings was granted.

4. On September 22, 2009, the Office granted a petition for extension of time filed by patent owner on September 9, 2009, thereby extending the period for response to the final Office action to October 23, 2009.
5. On October 23, 2009, patent owner filed a submission for the purpose of responding to the final Office action, including a 37 C.F.R. § 1.132 affidavit by Mr. John Friend.
6. On December 16, 2009, an advisory Office action was mailed by the Office, refusing entry of the Friend affidavit submitted on October 23, 2009 as failing to have a right of entry under 37 C.F.R. § 1.116, because there were not good and sufficient reasons why the declaration was necessary and not presented earlier. The action set a time period for response to the final Office action to run 6 months from the date of the final Office action.
7. On December 24, 2009, patent owner filed a petition entitled "PETITION UNDER 37 C.F.R. § 1.182 FOR CONTINUED REEXAMINATION," requesting continued prosecution of the reexamination, including entry and consideration of the Friend affidavit filed on October 23, 2009, and refused entry on December 16, 2009.
8. On January 25, 2010, a Notice of Appeal was filed by patent owner.
9. On March 11, 2010, the Office mailed a decision dismissing patent owner's December 24, 2009 petition for continued reexamination.
10. On March 17, 2010, patent owner filed the instant petition requesting reconsideration of the March 11, 2010 Office decision dismissing patent owner's December 24, 2009 petition for continued reexamination.

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

### **37 C.F.R. § 1.182 provides:**

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

**37 C.F.R. § 1.181 provides, in pertinent part:**

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

**35 U.S.C. § 305 provides, in pertinent part:**

After the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title. In any reexamination proceeding under this chapter, the patent owner will be permitted to propose any amendment to his patent and a new claim or claims thereto, in order to distinguish the invention as claimed from the prior art cited under the provisions of section 301 of this title, or in response to a decision adverse to the patentability of a claim of a patent. No proposed amended or new claim enlarging the scope of a claim of the patent will be permitted in a reexamination proceeding under this chapter. All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with **special dispatch** within the Office. (emphasis added)

**37 C.F.R. § 1.525(a) provides, in pertinent part:**

If a substantial new question of patentability is found pursuant to § 1.515 or § 1.520, the determination will include an order for *ex parte* reexamination of the patent for **resolution of the question**. (emphasis added)

## DECISION

The instant March 17, 2010 patent owner paper sets forth a request for reconsideration of the March 11, 2010 dismissal of patent owner's December 24, 2009 petition requesting continued prosecution for entry and consideration of an affidavit under § 1.132 addressing construction of means-plus-function claims. Relief is requested under the § 1.182 petition procedure set forth as a transitional procedure in a March 1, 2005 Office Notice titled "Notice of Changes in Requirement for a Substantial New Question of Patentability for a Second or Subsequent Request for Reexamination While an Earlier Filed Reexamination is Pending."<sup>1</sup> Notice was provided therein that, until a continued reexamination procedure would be implemented by the Office, a patent owner could file a petition under 37 C.F.R. § 1.182 requesting continued prosecution on the merits in an *ex parte* reexamination proceeding to seek entry of an amendment and/or evidence that was denied entry after a final rejection in the proceeding. A

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

procedure for continued reexamination was never in-fact implemented by the Office, and was never issued as a proposed rule making notice; however, the transitional statement of the Notice was never withdrawn.

By filing a § 1.182 petition, as discussed in the Notice, the patent owner could obtain continued prosecution on the merits in the reexamination proceeding, including entry of the amendment and/or evidence that was denied entry after a final rejection in an *ex parte* reexamination proceeding. This petition will be referred to herein as “the § 1.182 petition.”

The § 1.182 petition must further the prosecution of the reexamination proceeding, rather than delay it, and must provide a submission toward that end. Accordingly, the patent owner must make a *bona fide* effort, in the submission accompanying the § 1.182 petition, to define the issues for appeal, or the issuance of a reexamination certificate, since this is a key factor in reducing pendency of a reexamination proceeding. It thus follows that the petition is to make a showing of the manner in which the entry of the submission would act to overcome a rejection or satisfy a requirement of form such that the issues in the proceeding are better defined for appeal or issuance of a reexamination certificate. Furthermore, the showing in a petition for continuation of the reexamination prosecution is to identify the issue that the submission is intended to address, and explain how the issue arose at a point of the prosecution (here, the final Office action) such that patent owner had no earlier opportunity to address the issue. The above showings are critical in the *ex parte* reexamination setting, where 35 U.S.C. § 305 unequivocally mandates that reexamination proceedings must be conducted “with special dispatch within the Office.”<sup>2</sup> If a patent owner desires a remedy not provided by rule to obtain entry of a submission in a reexamination proceeding and thereby delay the proceeding, equity requires that a petition for such remedy must balance that delay with a showing that patent owner supported the Office’s unequivocal statutory mandate to carry out an *ex parte* reexamination proceeding with special dispatch.

Patent owner, in its petition of December 24, 2009, alleged that entry of the October 23, 2009 Friend declaration is a *bona fide* attempt to advance prosecution as entry would “lead to a proper interpretation of the claims’ true scope” and provide an interpretation of the claims prior to the Board’s review, thereby satisfying special dispatch.<sup>3</sup> However, this petition was dismissed because patent owner failed to show that the declaration was submitted to address an issue that only arose for the first time in the final Office action or in the advisory Office action, and thereby satisfy the requirement that the reexamination be conducted with special dispatch within the

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<sup>2</sup> In *Ethicon v. Quigg*, 849 F.2d 1422 (Fed. Cir. 1988), the Federal Circuit pointed out that:

“Special dispatch” is not defined in the statute. However, “a fundamental canon of statutory construction is that, unless otherwise defined, words will be interpreted as taking their ordinary, contemporary, common meaning.” *Perrin v. United States*, 444 U.S. 37, 42, 62 L. Ed. 2d 199, 100 S. Ct. 311 (1979); see *LSI Computer Systems, Inc. v. United States Int’l Trade Comm’n*, 832 F.2d 588, 590, 4 USPQ2d 1705, 1707 (Fed.Cir. 1987). 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’ throughout their pendency” in the office, and provides for an accelerated schedule. MPEP § 2261. (*Ethicon*, at 1426.)

<sup>3</sup> Petition of December 24, 2009, at 4-5.

Office. Additionally, patent owner failed to show that entry of the declaration would act to define the issues for appeal, or further the issuance of a reexamination certificate, rather than raise new issues.

In the instant request for reconsideration of the March 1, 2010 decision dismissing the petition for continued reexamination, patent owner argues that (1) the Office first stated in the December 16, 2009 advisory action that “Patent Holder has for the first time invoked 35 U.S.C. § 112 sixth paragraph after final action,”<sup>4</sup> and (2) that the proceeding would be furthered because the declaration would supplement the factual record, prevent a remand by the Board of Appeals, and advance prosecution by necessarily distinguishing the claims from the art.<sup>5</sup>

Patent owner’s argument is not persuasive, since, in the present situation, the proffered declaration addresses an issue of claim construction that arose early in the reexamination proceeding. This will now be discussed:

Patent owner alleges that the declaration is necessary to provide proper evidence of non-equivalence relevant to means-plus-function limitations in the claims under rejection. These claims have not been amended during the prosecution, and are in the identical form those of the ‘140 patent under reexamination. The examiner rejected the claims at issue in the Office action of April 10, 2009, and repeated the rejection in the final Office action of July 23, 2009. Patent owner does not allege that the grounds of rejection have changed, or that the final Office action raised any new relevant issue. Rather, patent owner alleges that the examiner has never “analyzed, in a means-plus-function sense, the equivalent structures of the art,” and “has not met the burden of providing a *prima facie* case of structural equivalence for any means-plus-function claim limitation.”<sup>6</sup> The Friend declaration proposed to be entered by patent owner is stated to address a matter of equivalence in a means-plus-function claim, and patent owner cites to MPEP 2184 for the fact that § 1.132 affidavits may be used to rebut an “inference of equivalence.”<sup>7</sup> The petition, however, fails to point out which statements of equivalency, made by the examiner, are being rebutted by arguments supported by the Friend declaration – and why such statements were not earlier addressed by a timely evidence preparation and submission. Also, if patent owner believes, as is stated in the instant petition, that the examiner never “analyzed, in a means-plus-function sense, the equivalent structures of the art,”<sup>8</sup> then there exists no matter of equivalence to be rebutted by proffered declaration.

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<sup>4</sup> Reconsideration Petition at 7.

<sup>5</sup> Reconsideration Petition at 7-10. The petition addresses analysis in the March 11, 2010 Office decision concerning the weight to be accorded the Friend declaration. However, as discussed below, this factor is not dispositive to the grant of patent owner’s desired relief, and has been omitted in this decision.

<sup>6</sup> Reconsideration Petition at 6-7.

<sup>7</sup> MPEP 2184 [emphasis added] provides that “[w]here, however, the specification is silent as to what constitutes equivalents and the examiner has made out a *prima facie* case of equivalence, the burden is placed upon the applicant to show that a prior art element which performs the claimed function is not an equivalent of the structure, material, or acts disclosed in the specification . . . If the applicant disagrees with the inference of equivalence drawn from a prior art reference, the applicant may provide reasons why the applicant believes the prior art element should not be considered an equivalent to the specific structure, material or acts disclosed in the specification. Such reasons may include, but are not limited to:

(C) 37 CFR 1.132 affidavit evidence of facts tending to show nonequivalence.”

<sup>8</sup> Reconsideration Petition at 6-7.

The proposed declaration submission is not in response to any newly raised issues; rather, the declaration would address issues that have been present since the first Office action.<sup>9</sup> To the extent that the Friend declaration addresses whether the claimed and prior art structures are the same, patent owner has already once addressed the examiner's position on the means-plus-function claim limitations, e.g., the Office action's statement that "Breedon disclose[s] . . . a storage means (108) in patent owner's June 16, 2010 response to the April 10, 2009 Office action."<sup>10</sup> Patent owner's argument in the petition for continued reexamination is that the examiner has never properly treated the claims, and patent owner requires a further opportunity to provide evidence that the examiner has never properly treated the claims. However, it is undeniable that the rejections have not changed since the initial Office action of April 10, 2009. And, accordingly, any issues relating to the examiner's analysis of the originally existing and unamended means-plus-function limitations in the patent claims arose at a point of the prosecution such that patent owner had an opportunity to address (or at least begin preparation to address) the issues prior to the final Office action.

Patent owner thus does not present reasons, nor does the history of the proceedings show, how the issues that the submission addresses arose at a point of the prosecution such that patent owner had no earlier opportunity to address the issues. Patent owner thus failed to submit such evidence at the earliest possible point of the prosecution, despite the clear notice in MPEP 2272 that evidence submissions should be filed before final action and despite the Office's statutory mandate for special dispatch in reexamination.

Based on the facts in this proceeding, reopening of prosecution would delay the resolution of the substantial new questions of patentability raised by the request for reexamination contrary to the statutory mandate that the Office proceed towards resolution with special dispatch. As a final point, a cursory review of the substance of patent owner's declaration reveals that it amounts to nothing more than arguments, which arguments could be presented in patent owner's brief without delaying the proceeding.

In view of the above and the facts and circumstances presented by the present record, the petition is denied.

## CONCLUSION

1. The petition requesting reconsideration of the March 11, 2010 decision is granted to the extent that the prior decision has been fully reconsidered, and is denied as to the underlying relief requested.

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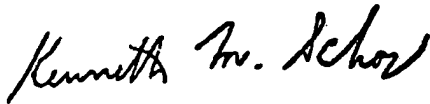
<sup>9</sup> With respect to petitioner's contention that the advisory action occasioned the Friend declaration, patent owner has not contended that the declarations proposed for entry address any issue not first raised in the initial Office action of April 10, 2009.

<sup>10</sup> Patent owner's remarks of June 10, 2009.



2. This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02.
3. Patent owner's time to file an Appeal Brief was set to expire on June 26, 2010, in the Office decision of May 19, 2010. The time to file an Appeal Brief is hereby extended to run fifteen (15) days from the mailing date of this decision.
4. Jurisdiction over the reexamination proceeding is being forwarded to the Central Reexamination Unit.
5. Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700.
6. Any further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop  
Commissioner for Patents  
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Kenneth M. Schor  
Senior Legal Advisor  
Office of Patent Legal Administration

June 8, 2010  
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