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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,037	04/10/2008	7162458	8332.001.458	7186

7590 03/18/2010

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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 03/18/2010

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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MAILED

MAR 18 2010

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NUMBER 95/001,037.

PATENT NUMBER 7,162,458.

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.



CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/001,037	04/10/08	7162458	8332.001.458

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EXAMINER

GRAHAM, MATTHEW

ART UNIT PAPER

3993

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.

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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MAR 18 2010

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CENTRAL REEXAMINATION UNIT

In re William J. Flanagan et al.
Inter Partes Reexamination Proceeding
Control No. 95/001,037
Filed: April 10, 2008
For: U.S. Patent No. 7,162,458

:
: **DECISION**
: **DISMISSING**
: **PETITION UNDER**
: **37 CFR 1.137(b)**

This is a decision on the September 25, 2009 patent owner petition under 37 CFR 1.137(b) to accept patent owner's late Response After Action Closing Prosecution in the above-identified reexamination proceeding ("the September 25, 2009 patent owner petition").

Third party requester filed Third Party Requestor's Opposition To Patent Owner's Petition For Entry Of Late Papers For Revival Of Reexamination Proceeding on October 25, 2009 ("the October 25, 2009 third party requester opposition petition").

Both the September 25, 2009 patent owner petition and the October 25, 2009 third party requester opposition petition are before the Office of Patent Legal Administration (OPLA) for consideration. In this instance, the October 25, 2009 third party requester opposition petition is being considered, since it does not challenge the merits of whether the requirements of 37 CFR 1.137(b) have been met. Instead, the opposition petition challenges the jurisdictional basis for granting a 1.137(b) petition on the present facts.

Patent owner has been charged the petition fee of \$1,620.00 set forth in 37 CFR 1.17(m) for the September 25, 2009 patent owner petition. In accordance with the authorization at page 2 of the October 25, 2009 third party requester opposition petition, third party requester has been charged the petition fee of \$400.00 set forth in

37 CFR 1.17(f) for the October 25, 2009 third party requester opposition petition, which is being treated as a petition under 37 CFR 1.182.

The September 25, 2009 patent owner petition is **dismissed**.

STATUTES, LEGISLATIVE HISTORY, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 41(a)(7), as amended by the AIPA of 1999 to include reexamination, provides (emphasis added):

REVIVAL FEES. — On filing each petition for the revival of an unintentionally abandoned application for a patent, for the unintentionally delayed payment of the fee for issuing each patent, or for an unintentionally delayed **response** by the patent owner in any reexamination proceeding, \$1,500, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be \$500.

The legislative history on the 1999 AIPA amendment to 35 U.S.C. 41(a)(7) provides (emphasis added):

Sec. 4605. Conforming amendments

Section 4605 makes the following conforming amendments to the Patent Act:

A patent owner must pay a fee of \$1,210 for each petition in connection with an unintentionally abandoned application, delayed payment, or delayed **response** by the patent owner during any reexamination.

[145 Cong. Rec. S14,708, 14,720 (1999) (daily ed. Nov. 17, 1999)]

As to unavoidable delay, 35 U.S.C. 133 provides (emphasis added):

Upon **failure of the applicant to prosecute** the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

37 CFR 1.137. Revival of abandoned application, terminated reexamination proceeding, or lapsed patent.

(a) *Unavoidable*. If the delay in **reply by** applicant or **patent owner** was unavoidable, a petition may be filed pursuant to this paragraph **to revive** an abandoned application, **a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or**

limited under § 1.957(c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

(1) The **reply required** to the outstanding Office action or notice, unless previously filed;

*

*

*

(b) *Unintentional*. If the delay in **reply by** applicant or **patent owner** was unintentional, a petition may be filed pursuant to this paragraph **to revive** an abandoned application, **a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c)**, or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

(1) The **reply required** to the outstanding Office action or notice, unless previously filed;

[Bold and italicized emphasis added; italicized emphasis in the original.]

37 CFR 1.951. Options after Office action closing prosecution in *inter partes* reexamination.

(a) After an Office action closing prosecution in an *inter partes* reexamination, the patent owner may once file **comments** limited to the issues raised in the Office action closing prosecution. The **comments can include a proposed amendment to the claims**, which amendment will be subject to the criteria of § 1.116 as to whether or not it shall be admitted. The comments must be filed within the time set for response in the Office action closing prosecution.

[Bold and italicized emphasis added; italicized emphasis in the original.]

37 CFR 1.957. Failure to file a timely, appropriate or complete response or comment in *inter partes* reexamination.

*

(b) If no claims are found patentable, and the patent owner fails to file **a timely and appropriate response** in an *inter partes* reexamination proceeding, the prosecution in the reexamination proceeding will be a terminated prosecution and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.997 in accordance with the last action of the Office.

(c) If claims are found patentable and the patent owner fails to file **a timely and appropriate response** to any Office action in an *inter partes* reexamination proceeding, further prosecution will be limited to the claims found patentable at the time of the failure to respond, and to any claims added thereafter which do not expand the scope of the claims which were found patentable at that time.

[Bold and italicized emphasis added; italicized emphasis in the original.]

37 CFR 1.958. Petition to *revive inter partes* reexamination prosecution terminated for lack of patent owner response.

(a) If ***a response*** by the patent owner is not timely filed in the Office, the delay in filing such response may be excused if it is shown to the satisfaction of the Director that the delay was unavoidable. A grantable petition to accept an unavoidably delayed ***response*** must be filed in compliance with § 1.137(a).

(b) Any ***response*** by the patent owner not timely filed in the Office may be accepted if the delay was unintentional. A grantable petition to accept an unintentionally delayed ***response*** must be filed in compliance with § 1.137(b).

[Emphasis added.]

MPEP 2672, part II provides (emphasis added):

The patent owner ***submission under 37 CFR 1.951(a) of comments and/or proposed amendment*** must be filed within the time period set for response to the ACP. Normally, the ACP will set a period of 30 days or one month (whichever is longer) from the mailing date of the ACP.

An extension of the time period for filing the patent owner's submission under 37 CFR 1.951(a) may be requested under 37 CFR 1.956. The time period may not, however, be extended to run past 6 months from the date of the ACP.

MPEP 2672, part V is titled Patent Owner Does Not Make Submission After ACP and provides (emphasis added):

If the patent owner ***does not timely file comments and/or a proposed amendment pursuant to 37 CFR 1.951(a)***, then the third party requester is precluded from filing comments under 37 CFR 1.951(b). Accordingly, ***a Right of Appeal Notice (RAN) will be issued*** where the time for filing the patent owner comments and/or amendment has expired and no patent owner paper containing comments and/or amendment has been received. It should be noted that ***where the patent owner chooses not to file a submission pursuant to 37 CFR 1.951(a), no rights of appeal are lost.***

DECISION

The Petition Under 37 CFR 1.137(b) is Dismissed

On July 31, 2009, the Office issued an Action Closing Prosecution (37 CFR 1.949) ("the July 31, 2009 ACP") in the instant reexamination proceeding. The July 31, 2009 ACP

set a one month period for patent owner to file a submission pursuant to 37 CFR 1.951(a). Patent owner, however, did not file a 1.951(a) submission within the one month period. Instead, patent owner's Response After Action Closing Prosecution was filed on September 25, 2009, together with the September 25, 2009 patent owner petition under 37 CFR 1.137(b).

37 CFR 1.958(b) provides that an *inter partes* reexamination prosecution **terminated** for the lack of a patent owner **response** may be revived by filing a petition in compliance with 37 CFR 1.137(b), if patent owner's delay in filing the **response** was unintentional.

However, the instant reexamination proceeding is **not terminated**. In this regard, MPEP 2672, part V, states that "where the patent owner chooses not to file a submission pursuant to 37 CFR 1.951(a), no rights of appeal are lost." Accordingly, the consequences of 37 CFR 1.957(b) and (c) do not apply where the patent owner does not file a timely 1.951(a) submission. Thus, the present reexamination proceeding is not terminated as to any of the claims based on patent owner's failure to file a timely 1.951(a) submission after the July 31, 2009 ACP, and 37 CFR §§ 1.958(b) and 1.137 do not apply to this situation.

In addition, patent owner's September 25, 2009 Response After Action Closing Prosecution is **not a response**. 37 CFR 1.951(a) states that after an ACP, the patent owner may once file **comments**, which may include a proposed amendment to the claims, limited to the issues raised in the ACP. Therefore, patent owner's September 25, 2009 Response After Action Closing Prosecution is properly a "comment" on the July 31, 2009 ACP, despite it being designated as a "response" by patent owner.

In view of the above, no regulatory or statutory provision supports the availability of 1.137 for relief as to late comments filed pursuant to 1.951(a) after an *inter partes* reexamination action closing prosecution.

For the foregoing reasons, the September 25, 2009 patent owner petition is **dismissed**.

A 37 CFR 1.183 petition would be the only vehicle for relief possible here, if the fact-situation met the standard of 1.183 for relief. However, to obtain relief, the situation would need to be shown to be "an extraordinary situation, when justice requires, any requirement of the regulations ... which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee...subject to such other requirements as may be imposed."

CONCLUSION

1. The September 25, 2009 patent owner petition under 37 CFR 1.137(b) to accept patent owner's unintentionally delayed Response After Action Closing Prosecution is **dismissed**.
2. Given that the September 25, 2009 patent owner petition is being dismissed, patent owner's September 25, 2009 Response After Action Closing Prosecution and third party requester's October 25, 2009 Third Party Requestor's Comments Under 37 CFR § 1.951 To Patent Owner's Response Of September 25, 2009 are not being considered, and these papers have been sealed by closing them in the Image File Wrapper (IFW) for the '1037 *inter partes* reexamination proceeding and marking them "not public." They will not constitute part of the record of the present reexamination proceeding.
3. A copy of this decision will be made of record in the '1037 reexamination file.
4. Jurisdiction over the present reexamination proceeding is being forwarded to the Central Reexamination Unit.
5. Any inquiry concerning this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.



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