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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,408	10/27/2008	6835887	2202A/529	9553

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EXAMINER

ART UNIT                      PAPER NUMBER

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



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CONTROL NO.	FILING DATE	PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
95/000,408	10/27/08	6835887	2202A/529

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EXAMINER

GAGLIARDI, ALBERT

ART UNIT	PAPER
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05/07/09

**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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(For Patent Owner)

MAILED

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CENTRAL REEXAMINATION UNIT

BROMBERG & SUNSTEIN L.L.P.  
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(For *Inter Partes* Requester)

In re Devecka  
Reissue Application  
Application No. 11/646,617  
Filed: December 28, 2006  
For: U.S. Patent No. 6,835,887

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: **DECISION DISMISSING**  
: **PETITION TO MERGE REISSUE**  
: **AND INTER PARTES**  
: **REEXAMINATION**  
: **PROCEEDINGS**

*Inter Partes* Reexamination Proceeding  
Control No. 95/000,408  
Filed: October 27, 2008  
For: U.S. Patent No. 6,835,887

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This is a decision on the third party requester petition entitled "Petition Under 37 C.F.R. §§1.182, 1.183 and MPEP § 2686.03(V) To Merge Co-Pending *Inter Partes* Reexamination and Reissue Proceedings for U.S. Patent No. 6,835,887" filed January 13, 2009, in *inter partes* reexamination control number 95/000,408, requesting that (1) the reissue application number 11/646,617 and *inter partes* reexamination proceeding control number 95/000,408 be merged, or in the alternative, that the reissue application be stayed, and (2) the requirement of 37 CFR 1.939(b) that no paper shall be filed prior to the initial Office action on the merits of the *inter partes* proceeding be waived to permit consideration of the petition.

Reissue application number 11/646,617 and *inter partes* reexamination control number 95/000,408 are before the Office of Patent Legal Administration for consideration of the petition.

Summary:

- (1) The petition is granted to the extent that 37 CFR 1.939(b) is waived to permit consideration of the instant petition
- (2) The petition is dismissed as to the request that the reissue application number 11/646,617 and *inter partes* reexamination proceeding control number 95/000,408 be merged, or in the alternative, that the reissue application be stayed.
- (3) The prosecution of reissue application number 11/646,617 and *inter partes* reexamination will continue separately, but constrained as set forth hereinbelow.

**FEES**

The petition was not accompanied by the petition fee required under 37 CFR 1.17(f). However, the petition included an authorization to charge any required fees in connection with the petition to be charged to third party requester's deposit account. Accordingly, after mailing of this decision, the \$400.00 petition fee will be charged to third party requester's deposit account No. 19-4972.

**BACKGROUND**

1. U.S. Patent No. 6,835,887 (the '887 patent) issued to John R. Devecka on December 28, 2004.
2. On December 28, 2006, the patent owner filed a "broadening" reissue application based on the '887 patent, which application was assigned application number 11/646,617 (the '617 reissue application). Broadening in the '617 reissue application is present based on at least the replacement of "buttons" by the broader "inputs" in all independent patent claims and the use of "input," "input means" or "input device" in all added independent claims.
3. A request for *inter partes* reexamination of claims 1-9 of the '887 patent was filed on October 27, 2008, by the third party requester, and the request was assigned control number 95/000,408 (the '408 *inter partes* proceeding).
4. On January 9, 2009, *inter partes* reexamination was ordered for claims 1-9 of the '887 patent based on the examiner's determination that the October 27, 2008 request

raised a substantial new question of patentability affecting these claims. The order was not accompanied by an Office action on the patentability of the claims, and no action on the patentability of claims 1-9 has been taken.

5. No action has been taken by the Office on the '617 reissue application.

## DECISION

### I. RELEVANT AUTHORITY

35 U.S.C. § 251 provides:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Director may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

37 CFR 1.171 provides:

An application for reissue must contain the same parts required for an application for an original patent, complying with all the rules relating thereto except as otherwise provided, and in addition, must comply with the requirements of the rules relating to reissue applications.

37 CFR 1.176(a) provides:

A reissue application will be examined in the same manner as a non-reissue, non-provisional application, and will be subject to all the requirements of the rules related to non-reissue applications. Applications for reissue will be acted on by the examiner in advance of other applications.

35 U.S.C. § 314(a) and (c) provide:

(a) IN GENERAL. — Except as otherwise provided in this section, reexamination shall be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133. In any *inter partes* reexamination proceeding under this chapter, the patent owner shall be permitted to propose any amendment to the patent and a new claim or claims, except that no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted.

(c) SPECIAL DISPATCH. – Unless otherwise provided by the Director for good cause, all *inter partes* reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, shall be conducted with special dispatch within the Office.

37 CFR 1.906(b) provides:

Claims in an *inter partes* reexamination proceeding will not be permitted to enlarge the scope of the claims of the patent.

37 CFR 1.937 provides, in part:

(a) All *inter partes* reexamination proceedings, including any appeals to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office, unless the Director makes a determination that there is good cause for suspending the reexamination proceeding.

(b) The *inter partes* reexamination proceeding will be conducted in accordance with §§ 1.104 through 1.116, the sections governing the application examination process, and will result in the issuance of an *inter partes* reexamination certificate under § 1.997, except as otherwise provided.

37 CFR 1.955 provides:

There will be no interviews in an *inter partes* reexamination proceeding which discuss the merits of the proceeding.

37 CFR 1.987 provides:

If a patent in the process of *inter partes* reexamination is or becomes involved in litigation, the Director shall determine whether or not to suspend the *inter partes* reexamination proceeding.

37 CFR 1.991 provides:

If a reissue application and an *inter partes* reexamination proceeding on which an order pursuant to § 1.931 has been mailed are pending concurrently on a patent, a decision may be made to merge the two proceedings or to suspend one of the two proceedings. Where merger of a reissue application and an *inter partes* reexamination proceeding is ordered, the merged proceeding will be conducted in accordance with §§ 1.171 through 1.179, and the patent owner will be required to place and maintain the same claims in the reissue application and the *inter partes* reexamination proceeding during the pendency of the merged proceeding. In a merged proceeding the third party requester may participate to the extent provided under §§ 1.902 through 1.997 and 41.60 through 41.81, except that such participation shall be limited to issues within the scope of *inter partes* reexamination. The examiner's actions and any responses by the patent owner or third party requester in a merged proceeding will apply to both the reissue application and the *inter partes* reexamination proceeding and be physically entered into both files. Any *inter partes* reexamination proceeding merged with a reissue application shall be concluded by the grant of the reissued patent.

MPEP § 2686.03 provides, in part:

The general policy of the Office is that the examination of a reissue application and an *inter partes* reexamination proceeding will not be conducted separately at the same time as to a particular patent. The reason for this policy is to permit timely resolution of both the reissue and the reexamination to the extent possible and to prevent inconsistent, and possibly conflicting, amendments from being

introduced into the two files on behalf of the patent owner. If both a reissue application and a reexamination proceeding are pending concurrently on a patent, a decision will normally be made to merge the reissue application examination and the reexamination or to stay one of the two. See In re Onda, 229 USPQ 235 (Comm'r Pat. 1985). The decision as to whether the reissue application examination and the reexamination proceeding are to be merged, or which of the two (if any) is to be stayed, is made in the Office of Patent Legal Administration (OPLA).

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The decision on whether to merge the reissue application examination and reexamination proceeding, or stay one of them, will be made on a case-by-case basis. The decision to merge, or not to merge, is within the sole discretion of the Office to facilitate/carry out the orderly operation of the Office in addressing the proceedings. The status of the reissue application and the reexamination proceeding will be taken into account in the decision as to whether merger will be ordered, or one of the two proceedings stayed. Where there is "good cause" to stay the reexamination proceeding, the Director may do so pursuant to 35 U.S.C. 314(c).

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In making a decision on whether or not to merge the reissue application examination and the reexamination proceeding, consideration will be given as to whether issues are raised in the reissue application that would not be proper for consideration in reexamination and/or not be proper for comment by the reexamination requester. If such issues are raised, merger would ordinarily not be ordered, and one of the two proceedings stayed. Consideration will also be given to the status of the reissue application examination at the time the order to reexamine the patent pursuant to 37 CFR 1.931 is mailed.

## II. DISCUSSION REGARDING MERGER

As evidenced by the above review of facts, the '617 reissue application and the '408 *inter partes* reexamination proceeding are currently pending. The two proceedings are in their early stages of prosecution. Since reexamination has been ordered pursuant to § 1.931 in the '408 *inter partes* reexamination proceeding, a decision under § 1.991 is timely for consideration as to whether the '617 reissue application and the '408 *inter partes* reexamination proceeding should be merged.

The decision to merge, or not to merge, is made on a case-by-case basis. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of both of the proceedings, i.e., when merger would serve to expedite both proceedings. In this instance, the complexities of a possible merger would result in the proceedings not being expedited via merger. The rights of the *inter partes* reexamination requester to comment during a merged proceeding and to participate in the appeal process cannot be annulled, since they are required by statute, i.e., 35 U.S.C. 314(b) and 35 U.S.C. 315(b), respectively. Thus, a merger of the two proceedings would provide the third party requester with the right to support any Office rejections and to reply to any Office or patent owner reasons for patentability with regard to the newly added broadened claims. Yet, the effect and intent of the *inter partes* reexamination

statute (35 U.S.C. 314(a)) is to preclude any third party requester comment and participation as to broadened claims or other reissue issues not proper for reexamination. In the present instance, and based on the present facts and circumstances, the merger of the proceedings would complicate the merged proceeding to the point where the proceeding progress would be delayed by permitting requester participation. The line between requester participation authorized by statute and requester participation not authorized by statute is a fine line. The returning or expunging of inadvertent unauthorized participation, and the objection to perceived unauthorized participation (which in fact may not be) would result in sufficient delay in this instance, to outweigh the benefit that might be gained by merger. Accordingly, the examination of the reissue and reexamination proceedings will not be merged at this time.

In this regard, it is to be noted that the grant or refusal of merger of reissue and *inter partes* reexamination proceedings under 37 CFR 1.191 is **discretionary**, and in this case, the facts and circumstances are such that the proceedings will not be merged. *However, the present decision not to merge is not an assurance that, in a future similar situation, merger would not be ordered.*

As to suspension of the reissue application, such is also not an option in this case. Initially, it is noted that the '617 reissue application was the first filed proceeding. The '408 *inter partes* reexamination proceeding was filed nearly 22 months after the filing of the '617 reissue application. Further, patent owner has not expressed a willingness to have the reissue application suspended. Accordingly, and based on the present fact situation, the reissue application will not be suspended. Third party requester has requested that the reissue application be stayed if the Office decides that merger is inappropriate. It is noted that third party requester does not have standing to request the Office to stay the reissue application.

As to suspension of the reexamination proceeding, 35 U.S.C. 314(c) statutorily requires "special dispatch," unless the Director determines there is good cause for suspension. In this instance, if at all possible, it is desirable to prevent the delay in resolving the raised statutory new question of patentability while patent owner prosecutes the reissue application, and any continuation reissue applications that may be filed. This can be attained by the conduct of the proceedings conducted separately and at the same time, as will now be discussed.

### **III. CONDUCTING THE REISSUE AND REEXAMINATION PROCEEDINGS SEPARATELY, AND AT THE SAME TIME**

Generally, a reissue application and a concurrently pending reexamination proceeding are not examined separately, and at the same time, for a single patent. Such separate



examination is not conducted in order to prevent inconsistent and possibly conflicting amendments from being introduced into the multiple proceedings on behalf of the patent owner. In this instance, however, the only viable option is separate examination, and such will be carried out. In order to preclude inconsistent and possibly conflicting amendments from being introduced into the two proceedings, the following procedure is imposed for the separate prosecution of the two proceedings:

A. Conduct of '617 reissue application prosecution:

1. Conduct of the '617 reissue application will be carried out as prescribed in MPEP Chapter 1400.
2. All non-broadened claims will be held as withdrawn from consideration in the reissue application, and will be prosecuted in the '408 *inter partes* reexamination which can accommodate the resolution of those claims in light of the prior patents and printed publications.
3. Prosecution of the '617 reissue application will be strictly limited to claims broader than those of the '887 patent.
4. All claim amendments presented in the '617 reissue application prosecution will be for claim broadening amendments and will be solely presented and prosecuted in the reissue application. Any amendment presenting non-broadened claims in the reissue application will be denied entry. In such an instance, if a *bona fide* attempt to reply is made pursuant to 37 CFR 1.135(c), an opportunity to correct the amendment will be provided via a notice.
5. Should the reissue application be placed in condition for allowance, except for the claims held in abeyance, prior to the termination of the '408 *inter partes* reexamination prosecution, patent owner must either: (a) request suspension of the reissue application, or (b) cancel the claims held in abeyance and pay the issue fee. In such a situation, it is suggested applicant consider filing a continuation reissue application containing the patented claims held in abeyance, followed by canceling the claims held in abeyance in the '617 reissue application and payment of the issue fee. Patent owner is cautioned that should the non-broadened claims not be filed in a continuation reissue at this point, the *inter partes* reexamination proceeding will be terminated based on the surrender of the '887 patent upon its reissue as a reissue patent.

If such a continuation reissue application is filed, after it is processed and forwarded to the Technology Center, it would be suspended to await conclusion of the '408 *inter partes* reexamination proceeding. When the *inter partes* reexamination proceeding would be terminated, a conforming amendment would be required in the continuation reissue application, the two proceedings merged, and a second reissue patent would be

issued to the second set of claims, if a 35 U.S.C. 251 error is corrected in the continuation reissue application.<sup>1</sup>

6. Jurisdiction and examination of the '617 reissue will reside in the Technology Center. Prior to the indication of allowance of any claim, the examiner of the '617 reissue application will consult and conference with the examiner of the '408 *inter partes* reexamination proceeding, and may, if desired, also consult with a Legal Advisor from the Office of Patent Legal Administration.

#### B. Conduct of the '408 *inter partes* reexamination proceeding

1. Conduct of the '408 *inter partes* reexamination proceeding will be carried out as prescribed in MPEP Chapter 2600.

2. All non-broadened amendments desired by patent owner will be presented and prosecuted in the '408 *inter partes* reexamination proceeding. Any amendment presenting broadened claims in the reexamination proceeding will be denied entry.

3. If the reexamination proceeding is terminated prior to the conclusion of the reissue prosecution, a reexamination certificate will be issued and the reissue application will be conformed to the results of the certificate by amending the reissue application claims as needed.

4. Jurisdiction and examination of the '408 *inter partes* reexamination proceeding will reside in the Central Reexamination Unit. Prior to the indication of patentability of or confirmation of any claim, the examiner of the '408 *inter partes* reexamination proceeding will consult and conference with the examiner of the '617 reissue application, and may, if desired, also consult with a Legal Advisor of the Office of Patent Legal Administration.

### CONCLUSION

1. The petition is granted to the extent that 37 CFR 1.939(b) is waived to permit consideration of the instant petition.
2. The petition is dismissed as to the request that the reissue application number 11/646,617 and *inter partes* reexamination proceeding control number 95/000,408 be merged, or in the alternative, that the reissue application be stayed.

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<sup>1</sup> If a 35 U.S.C. 251 error is not corrected in the continuation reissue application, the claims in the reissue continuation would be lost.

3. The prosecution of reissue application number 11/646,617 and *inter partes* reexamination will continue separately, but constrained as set forth above.
4. After mailing of this decision, the required \$400.00 petition fee under 37 CFR 1.17(f) will be charged to third party requester's deposit account No. 19-4972 as authorized in the petition.
5. A copy of this decision will be placed in the IFW of the '617 reissue application and the '408 *inter partes* reexamination proceeding.
6. Jurisdiction over the reexamination proceeding is being returned to the Central Reexamination Unit, for preparation of a Office action pursuant to the procedure set forth above.
7. Jurisdiction over the reexamination proceeding is being returned to the Technology Center, in which the reissue application is assigned, for preparation of a Office action pursuant to the procedure set forth above.
6. Any questions concerning this communication should be directed to Jessica Harrison, SPE, Central Reexamination Unit, at 571-272-4449 or Eugenia Jones, Senior Legal Advisor, at 571-272-7727.



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

5-6-09

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