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(For Patent Owner)

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(For Requester)

MAILED

JUN 29 2010

CENTRAL REEXAMINATION UNIT

In re Donachie	:
Reexamination Proceeding	: DECISION DISMISSING
Control No. 90/010,395	: PETITION UNDER
Filed: January 23, 2009	: 37 CFR 1.181, 1.182
For: U.S. Patent No. 5,587,166	: AND 1.183

This is a decision on the August 31, 2009 third party requester petition entitled "PETITION TO THE HONORABLE DIRECTOR OF THE USPTO UNDER 37 CFR 181(a)(3), 1.182 & 1.183 FOR RECONSIDERATION AND WITHDRAWAL OF THE AUGUST 1 and JULY 31, 2009 DECISIONS ON PETITION IN REEXAMINATION CONTROL NOS. 90/010,395 & 90/010,461 AND AN ORDER OF EX PARTE REEXAMINATION OF US PATENT NO. 5,587,166 & REEXAMINATION CERTIFICATE NO. 5,587,166 C1."

The third party requester petition and the present record are before the Office of Patent Legal Administration for consideration.

The third party requester petition is dismissed, and is being expunged, for the reasons set forth below.

FEES

Pursuant to the authorization on page 2 of the petition, deposit account No. 50-2354 has been charged the required \$400 petition fee.

BACKGROUND

1. U.S. Patent No. 5,587,166 (hereinafter, the '166 patent) issued on December 24, 1996.

2. A request for *ex parte* reexamination of the '166 patent was filed on January 23, 2009. The resulting reexamination proceeding was assigned Control No. 90/010,395 (hereinafter, the '395 proceeding). Reexamination was requested for claims 1-3, 8, 10-13 and 16-18 of the '166 patent based upon U.S. Patent 4,346,074 to Gilmour; GB 2202851A; Griffiths, Phil Trans. R. Soc. Lond. B 303, 85-96 (1983); Ungureanu et al, Arch exper Vet med, Leipzig 35 (1981) Mai, 3, s. 437-441; Lessley et al., Veterinary Immunology and Immunopathology, 10 (1985) 279-296; Newman et al, Am J Vet Res, Vol. 43, No. 3, (1982) 417-422; Gilmour et al, Vaccine, Vol. 9, February 1991 (Gilmour 1991); and Donachie et al, FEMS Microbiology Letters, 56 (1988) 271-276.
3. A Notice of Reexamination Request Filing Date for the '395 proceeding was issued on January 29, 2009.
4. An order denying the request for reexamination for claims 1-3, 8, 10-13 and 16-18 in the '395 proceeding was mailed on February 25, 2009.
5. On April 17, 2009, the third party requester filed a petition under 37 CFR §§ 1.181 and 1.182 in the '395 proceeding. The petition requested review of the February 25, 2009 denial of reexamination.
6. On August 1, 2009, the petition for review of the denial of reexamination was denied in a decision issued by the Director of the Central Reexamination Unit (CRU).
7. On August 31, 2009, the third party requester filed the present petition under 37 CFR §§ 1.181, 1.182 and 1.183, requesting withdrawal of the denial of reexamination.

DECISION

The third party requester petitions for supervisory review of the Office's August 1, 2009 decision denying the third party requester's petition under 37 CFR §§ 1.181 and 1.515(c), and of the initial examiner's July 31, 2009 decision denying the reexamination request.¹ It is 37 CFR 181(a)(3) that provides that petition may be taken to the Director "[t]o invoke the supervisory authority of the Director in appropriate circumstances" (emphasis added). In this instance, however, petitioner requests relief under 37 CFR §§ 1.182 and 1.183,² and supervisory review is not the

¹ The third party requester asks "the Director to invoke his supervisory authority, in the present situation that does not appear to be specifically provided for in the regulations, and as justice requires in this extraordinary situation, suspend as necessary any rules which may present an impediment to granting the relief requested, and thereby reconsider and withdraw the August 1 and July 31, 2009 Decisions on Petition in Reexamination Control Nos. 90/010,395 and 90/010,461, respectively, and order of *ex parte* Reexamination of claims 1-3, 8, and 10-13 of US Patent No. 5,587,166 and claims 1-3, 8, 10-13 and 16-18 of Reexam Certificate No. 5,587,166 C1." Paragraph bridging pages 1 and 2 of the reconsideration petition.

² The reconsideration petition states, in the paragraph bridging pages 5 and 6: "As it is an extraordinary situation when the Central Reexamination Unit commits clear errors of law and fact, this Petition asks that to the extent necessary to order *ex parte* Reexamination of Donachie that pursuant to **Rule 183** the Director also suspend any Rules that may present any impediment to granting that relief including, without limitation, suspending or waiving any portion of 37 CFR § 1.515 so as to grant the herein requested relief. Similarly, as appeals from clearly erroneous decisions of the Central Reexamination Unit may not be explicitly provided for in the Rules (see 37 CFR § 1.515(c), the suspension of which is explicitly herein requested), this Petition is also under **Rule 182**, to any extent necessary so that the Director orders *ex parte* Reexamination of Donachie, e.g., pursuant to 37 CFR § 1.520 (which allows the Director to initiate Reexamination proceedings *sua sponte*)." [Emphasis added]

purpose of the provisions of 37 CFR §§ 1.182 and 1.183. Accordingly, the present petition is dismissed³

It is to be noted that this decision is without prejudice to petitioner filing a new request for reexamination that includes any new argument/discussion to show that a new technical teaching is identified in the request for reexamination, and this may include any argument/discussion that has been set forth in the petitions filed in this case.

Improper paper is expunged:

As pointed out, 37 CFR 1.540 provides that “[n]o submissions other than the statement pursuant to § 1.530 and the reply by the *ex parte* reexamination requester pursuant to § 1.535 will be considered prior to examination.” Since the present petition is neither a statement pursuant to 37 CFR 1.530 nor a requester reply pursuant to 37 CFR 1.535, it is not permitted by rule. Therefore, the petition paper requesting supervisory review is an improper paper, and lacks an entry right. In this instance, the petition paper has been scanned into the Image File Wrapper (IFW) and cannot be physically “removed” from the IFW. Therefore, the documents of the petition paper are being expunged by marking the papers “closed” and “non-public.” The papers will remain in the IFW data base, as the system does not allow for purging it, but will not constitute a part of the record in the reexamination proceeding.

It is also to be observed that the petition contains argument over the merits of the proposed rejections. Thus, it contains information that is not needed, and may be considered detrimental to the record.

CONCLUSION

1. The third party requester petition filed on August 31, 2009 is **dismissed**.
2. The third party requester petition paper, including the documents concurrently filed in support thereof, is being **expunged**, by marking the papers “closed” and “non-public.”
3. A copy of the present decision will be made of record in the ‘395 *ex parte* reexamination IFW.

³ It is to be observed that petitioner has filed the present petition under 37 CFR 1.181, and in addition, under 37 CFR 1.182 and/or 1.183. However, 37 CFR 1.4(c) provides that “[s]ince different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.” Pursuant to 37 CFR 1.4(c), different matters raised in a given proceeding must be raised in separate papers. The present petition includes multiple requests: (1) The request under 37 CFR 1.181 for supervisory review of the CRU Director decision is addressed by the Technology Center 1600 Director. (2) The requests for relief that is not provided by the rules under 37 CFR 1.182 and for relief to waive the rules under 37 CFR 1.183 are addressed in the Office of Patent Legal Administration. Thus, the petition fails to comply with 37 CFR 1.4(c). It is also to be observed that the petition was improperly captioned as directed to two proceedings. Each petition should be captioned only as to the proceeding to which it applies.

4. Telephone inquiries related to the present decision should be directed to the undersigned, at 571-272-7710.

Kenneth M. Schor

Kenneth M. Schor
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Office of Patent Legal Administration

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