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EXAMINER

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APR 20 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/006824

PATENT NO. 6,359,022

ART UNI 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).



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CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

In re F. Leo Hickey et al.
Reexamination Proceeding
Control Nos.: 90/006,824
Filed: October 20, 2003
For: U.S. Patent No.: 6,359,022

:
: **DECISION, UPON**
: **RECONSIDERATION,**
: **DENYING PETITION**
: **UNDER 37 CFR 1.183**
: **TO SUSPEND**
: **37 CFR 1.114(e)(5)**
: **AND EXPUNGING**
: **PAPERS**
:
:

In re F. Leo Hickey et al.
Reexamination Proceeding
Control No.: 90/007,619
Filed: July 7, 2005
For: U.S. Patent No.: 6,359,022

This is a decision on the January 19, 2009 patent owner petition entitled "REQUEST FOR RECONSIDERATION OF DECISION ON PETITION UNDER 37 CFR 1.183 TO SUSPEND 37 CFR 1.114(e)(5)."

The petition is before the Office of Patent Legal Administration for decision.

SUMMARY

1. The request for reconsideration is granted to the extent that patent owner's arguments made in the instant request have been considered, and the arguments made in the original November 6, 2008 petition have been again considered.

2. The underlying relief requested in the petition is denied.
3. The papers accompanying the January 19, 2009 petition are improper and are expunged from the record.
4. This decision is designated as a final agency action under 5 U.S.C. § 704.

BACKGROUND

1. U.S. Patent No. 6,359,022 to Hickey *et al.* (the '022 patent) was issued on March 19, 2002.
2. On October 20, 2003, patent owner filed a first request, for *ex parte* reexamination, and it was assigned reexamination control number 90/006,824 (the '6824 proceeding).
3. On January 15, 2004, the Office granted the '6824 reexamination request and ordered reexamination.
4. On July 7, 2005, a second request for reexamination was filed by a third party requester, and it was assigned reexamination control number 90/007,619 (the '7619 proceeding).
5. On September 26, 2005, the Office granted the '7619 reexamination request and ordered reexamination.
6. On February 24, 2006, the Office issued a decision merging the '6824 reexamination proceeding with the '7619 reexamination proceeding (the merged reexamination proceeding).
7. The merged proceeding progressed to the point where the Office's rejection of the claims was appealed, and, on September 24, 2008, the Board issued an order returning the application to the Central Reexamination Unit (CRU) to issue a response to a reconsideration-petition under 37 CFR 1.181 filed May 29, 2008, to designate new grounds of rejection in the examiner's answer in the merged reexamination proceeding.
8. On November 6, 2008, patent owner filed a petition under 37 CFR 1.183 to suspend the provision of 37 CFR 1.114(e)(5) barring its application to reexamination, concurrently with a request for continued examination under 37 CFR 1.114, including an amendment to the claims, in the merged reexamination proceeding.
9. On December 5, 2008, patent owner's November 6, 2008 petition was dismissed by the Office of Patent Legal Administration.

10. On January 19, 2009, patent owner filed the present request for reconsideration of the December 5, 2008 decision dismissing the November 6, 2008 petition, which includes a copy of the papers accompanying the November 6, 2008 petition.
11. On March 12, 2009, the Technology Center Director issued a decision denying the May 29, 2008 reconsideration-petition as to the underlying relief requested.

DECISION DENYING PETITION UPON RECONSIDERATION

I. Pertinent Laws and Regulations

37 CFR 1.114 states, in pertinent part:

(a) If prosecution **in an application** is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth under § 1.17(e) prior to the earliest of:

- (1) Payment of the issue fee, unless a petition under § 1.313 is granted;
- (2) Abandonment of the application; or
- (3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141 or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.

...
(e) **The provisions of this section do not apply to:**

- ...
(5) **A patent under reexamination.**

[Emphasis added in bold]

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

After the times for filing the statement and reply provided for by section 304 of this title [35 U.S.C.S § 304] 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 [35 U.S.C.S §§ 132 and 133]. 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 . . . or in response to a decision adverse to the patentability of a claim of a patent. All reexamination proceedings under this section . . . will be conducted with **special dispatch** within the Office. [Emphasis added]

35 U.S.C. § 132(a) states:

(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the

reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

35 U.S.C. § 132(b), codifying section 4403 of the Intellectual Property and Communications Omnibus Reform Act of 1999, states, in pertinent part:

The Director shall prescribe regulations to provide for the continued examination **of applications** for patent at the request of the applicant. [Emphasis added]

The Intellectual Property and Communications Omnibus Reform Act of 1999, S. 1948. Act Nov. 29, 1999, P.L. 106-113, Div B, § 1000(a)(9), 113 Stat. 1536 (enacting into law § 4405(b) of Subtitle D of Title IV of S. 1948 (113 Stat. 1501A-560), as introduced on Nov. 17, 1999), provides:

(b) Amendments Made by Section 4403: The amendments made by section 4403-(1) shall take effect on the date that is 6 months after the date of the enactment of this Act, and **shall apply to all applications** filed under section 111(a) of title 35, United States Code, on or after June 8, 1995, and all **applications** complying with section 371 of title 35, United States Code, that resulted from international applications filed on or after June 8, 1995 [Emphasis added]

37 CFR 1.183 states, in pertinent part:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is **not a requirement of the statutes** may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. [Emphasis added]

II. Discussion and Analysis - No Legal Authority Provides Continued Examination in Reexamination Proceedings

As pointed out above, on December 5, 2008, a decision dismissing the November 6, 2008 petition under 37 CFR 1.183 to suspend 37 CFR 1.114(e)(5) was mailed. This decision stated that suspending 37 CFR 1.114(e)(5) to permit continued examination of reexaminations would be beyond the reach of 37 CFR 1.183, since 37 CFR 1.183 only permits waiver of regulations and can neither controvert nor create statutory authority. The decision further stated that the 35 U.S.C. § 132(b) authority for continued examination exists only for an application for a patent, as set forth in 35 U.S.C. § 132(b), and that no such authority exists to provide for continued examination of a reexamination proceeding.

In its request for reconsideration of that decision, dated January 19 2009, patent owner argues that continued examination during a reexamination proceeding is authorized by the mandatory language of 35 U.S.C. 305 that “reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.”¹ Patent owner contends that 35 U.S.C. § 132(b), providing for continued examination of applications for patent upon the request of the applicant, is a procedure established for initial examination, and therefore mandates § 132(b) continued examination during reexamination proceedings. Patent owner further contends that Congress showed intent to provide for *ex parte* reexaminations under § 132(b) because the later-enacted *inter partes* statute 35 U.S.C. § 314 referred to 35 U.S.C. § 132 for “initial examination,” rather than referring solely to § 132(a), and because the Office has interpreted 35 U.S.C. § 305 as incorporating the “unavoidable delay” standard of § 133.² Patent owner then concludes that the provision of 37 CFR 1.114(e)(5) excepting patents under reexamination from the provisions of 37 CFR 1.114 is therefore “plainly inconsistent with law,” because the law “requires the USPTO to accept an RCE in reexamination.” Patent owner’s contentions are addressed in the following discussion.

Statutory authority providing for continued examination arises solely from 35 U.S.C. § 132(b), which states that “the Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant.” The language of 35 U.S.C. § 132(b) is directed only to applications; the language of 35 U.S.C. § 132(b) is not directed to reexamination proceedings, which are proceedings carried out in granted patents, and are not applications for patents (not applications to obtain patent grants). Therefore, any authority providing for continued examination of reexamination proceedings must be provided for elsewhere. Requester takes the position that 35 U.S.C. § 305 is the source of such authority, by virtue of the clause stating that “reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.” The discussion below will show that such a position is not supported by either the text or the intent of 35 U.S.C. § 305. The text of 35 U.S.C. § 305 states that the procedures for initial examination set forth in § 132 will apply to reexamination proceedings; no mention of continued examination is made in § 305. As to intent, at the time of the enactment of § 305 in 1980,³ 35 U.S.C. 132 concerned only initial examination (e.g., rejection and response by applicant); i.e., those initial examination procedures now set forth in § 132(a). The intent of enactment of § 305 for *ex parte* reexamination was to provide a speedy alternative to litigation of issued patents, with § 305 explicitly stating that reexamination proceedings are to be conducted with special dispatch, and a lengthy continued full examination for reexamination proceedings on issued patents runs contrary to § 305 (which petitioner is relying on). *Ex parte* reexamination was directed to what is now § 132(a), and there is nothing in the legislative history of the enactment of § 132(b) to indicate that its provision (stated to be

¹ “Request for Reconsideration of Decision on Petition Under 37 CFR § 1.183 to Suspend 37 CFR § 1.114(e)(5)”, hereinafter “Request”, filed 19 January 2009, at 2.

² Patent Owner petition of November 6, 2008, page 9.

³ Amended in 1984 only to substitute “Board of Patent Appeals and Interferences” for “Board of Appeals”.

directed to an application) would be added to reexamination. Further, the enactment of § 132(b), the Intellectual Property and Communications Omnibus Reform Act of 1999, also included an enactment of *inter partes* reexamination, which again statutorily provided for special dispatch for the new *inter partes* reexamination option, while nowhere in the 1999 act or its legislative history is a discussion of lengthening reexamination by inclusion of a request for continued examination. If Congress had wanted to include a lengthy continued full examination for reexamination proceedings, it could have done so at that time, since the enactment also included modifications of *ex parte* reexamination, such as appeal and revival (i.e., reexamination as a whole was looked at by Congress).

The below discussion will show, in some detail, that neither the text of 35 U.S.C. § 132(b) nor its legislative history supports an establishment of § 132(b) continued examination for reexamination proceedings. The plain language of 35 U.S.C. § 132(b) is directed towards applications, not reexaminations. The part of the Act which promulgated § 132(b) is specifically limited only to applications, as set forth in section 4405 of the Act;⁴ therefore, the continued examination provisions are only empowered for applications and not reexamination proceedings. Furthermore, the discussion will show that § 132(b) was enacted, *inter alia*, to provide patent term relief for applicants, which is not applicable to reexamination proceedings. Finally, continuation of prosecution as a matter of right has never been applicable to reexamination proceedings, and extension of continued examination to reexamination proceedings would constitute a substantial change to delay the proceedings, lacking legislative comment.

This textual analysis is borne out by the history of the statute, as explained in the following sections. The discussion below addresses patent owner's further arguments based upon § 133, and based upon the *inter partes* statute § 314, finding such arguments of minimal relevance, and insufficient to overcome the clear text and intent of the reexamination and continued examination statutes.

A. Neither the text nor the intent of 35 U.S.C. § 305 supports continued examination for patent reexamination proceedings.

The text of 35 U.S.C. § 305 contains language that permits patent owner to “propose an amendment to his patent specification or claims, as well as propose a new claim or claims.”⁵ To establish the procedures by which such amendments could be effected, § 305 states that “reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of this title.” [Emphasis added] The text of § 305 lacks any mention of “continued” examination. To the contrary, the text of § 305 explicitly states that reexamination proceedings are to be conducted with special dispatch.

Furthermore, interpreting § 305 to include continued examination would read the term “initial” out of the statute, since such an interpretation would incorporate all features of

⁴ The Intellectual Property and Communications Omnibus Reform Act of 1999, subtitle D – Patent Term Guarantee, 106 P.L. 113.

⁵ *Id.*

examination into § 305. As all terms in a statute must be given meaning,⁶ the term “initial” must limit the reach of § 305. For this reason, the principles of statutory construction do not support any reading of § 305 that would authorize continued examination in reexamination proceedings.

35 U.S.C. § 305 contains a provision authorizing the “initial” examination procedures set forth in 35 U.S.C. § 132 to be used in conducting reexamination. At the time of the enactment of § 305 in 1980,⁷ § 132 concerned only initial examination, i.e., procedures for an applicant for a patent to respond to an initial rejection by the Office with a response that would then be considered by the examiner.⁸ The entirety of § 132 as it existed in 1980 was later amended to become, in its entirety, § 132(a). By its terms alone, section (a) of 35 U.S.C. 132 addresses initial examination of an application; e.g., those procedures for notifying applicant of an initial rejection and for receiving applicant’s response. Section 132(a) has been found not to include continued examination, which may be envisioned as a subsequent procedure after the § 132(a) examination is complete. *See Tafas v. Doll*, No. 2008-1352, slip. op. at 27-28 (Fed. Cir. Mar. 20, 2009).

Looking to its legislative history, 35 U.S.C. § 305 was enacted in 1980 by “An Act to Amend the Patent and Trademark Laws,” which established for the first time procedures for reexamination of issued patents.⁹ The purpose of the Act was to “strengthen[] investor confidence in the certainty of patent rights by creating a system of administrative reexamination of doubtful patents.”¹⁰ Reexamination was designed to “review the efficacy of a patent . . . on the basis of new information” in order to “permit efficient resolution of questions about the validity of issued patents without recourse to expensive and lengthy infringement litigation.”¹¹ Absent in the legislative history of 35 U.S.C. § 305 is any intention to provide continued or extended examination. To the contrary, the expressed desire for efficient resolution, coupled with the explicit provision requiring proceedings to be “conducted with special dispatch,” exhibits intent for rapid and compact reexamination proceedings.¹² Continued examination would therefore be contrary to the expressed intent of the legislature.

The intent of § 305 to establish initial examination procedures is thus fully embodied by § 132(a), which does not provide for any continued examination procedures. Both the text and the legislative history of § 305 lack support for, and are contrary to, an interpretation that provides for continued examination of reexamination of patents.

⁶ *Bailey v. United States*, 516 U.S. 137, 145-46 (1995) (superseded by statute on other grounds).

⁷ Amended in 1984 only to substitute “Board of Patent Appeals and Interferences” for “Board of Appeals”.

⁸ *See* 35 U.S.C. § 132 (1952).

⁹ An Act to Amend the Patent and Trademark Laws, P.L. 96-517, 94 Stat. 3015, Dec. 12, 1980.

¹⁰ H.R. 96-1307, 96th Cong., 2d Sess. (1980).

¹¹ *Id.*

¹² A comprehensive discussion of the statutory mandate for special dispatch can be found in *Ethicon v. Quigg*, 849 F.2d 1422, 7 USPQ2d 1152 (Fed. Cir. 1988).

B. Neither the text nor the intent of 35 U.S.C. § 132(b) supports continued examination for patent reexamination proceedings.

1. The plain language and legislative history of 35 U.S.C. § 132(b) are directed only towards applications, not reexaminations.

Continued examination of applications for patent was first authorized by the enactment of 35 U.S.C. § 132(b), which codified section 4403 of the Intellectual Property and Communications Omnibus Reform Act of 1999. The text of § 132(b) states that regulations for “continued examination of applications for patent” shall be prescribed. [Emphasis added]. The text makes no mention of reexamination proceedings, which are not applications for patent, and accordingly no regulations for § 132(b) continued examination were promulgated for reexamination proceedings. It is to be noted that there were no comments to the § 132(b) continued examination arguing with the Office’s implied interpretation of § 132(b) (contemporaneously with the statute), when regulations for § 132(b) continued examination were promulgated only for applications, and not for reexamination proceedings.

The purpose of section 4403 was stated to be:

to permit an applicant to request that an examiner continue the examination of an application following a notice of "final" rejection by the examiner. New section 132(b) authorizes the Director to prescribe regulations for the continued examination of an **application** notwithstanding a final rejection, at the request of the **applicant**.¹³
(Emphasis added)

The legislative record thus shows that § 132(b) was directed towards “applications” and not reexamination proceedings.

At the time of its enactment in 1999, reexamination had been in place since 1982. Therefore, if the legislation was meant to cover reexamination of patents, Congress would have explicitly written the text of § 132(b) to include reexamination proceedings, rather than restricting § 132(b) to “applications for patent,” especially since reexamination was being looked at in detail and addressed by the same Act, both as to adding a new option for *inter partes* reexamination and revising *ex parte* reexamination. At the very least, Congress could have provided some comment showing an intent to apply § 132(b) to reexamination proceedings. However, neither the text nor the legislative history makes any reference to applying § 132(b) to reexamination proceedings, even though such a reference would be expected. For this reason, the language of the 1999 Act does not support any interpretation authorizing continued examination to reexamination proceedings.

¹³ 145 Cong. Rec. S.14696, 14718 (November 17, 1999) (statement of Sen. Lott).

2. The effective date provisions of the Act promulgating 35 U.S.C. § 132(b) are applicable to applications, but inapplicable to reexaminations of patents.

Section 4405 of the Intellectual Property and Communications Omnibus Reform Act of 1999 set an effective date for the provisions of section 4403 (§ 132(b)). Pursuant to section 4405, § 132(b) applies only to any application filed on or after a certain date. The provision of § 305 enabling reexaminations to be conducted pursuant to § 132 must be read in view of later-enacted section 4405. Since section 4405 states that only applications are subject to § 132(b), and reexamination proceedings are not applications, reexaminations are not subject to § 132(b). Section 4405 clearly expresses the intent of Congress, and the scope of § 132(b), to extend continued examination only to applications.

Contrary to patent owner's analysis at page 10 of the November 6, 2008 petition, the patent owner has not met the provisions for acceptance of an RCE since the reexamination proceeding is not "[an] application[] filed under section 111(a) of title 35, United States Code, on or after June 8, 1995, [or an] application[] complying with section 371 of title 35, United States Code, that resulted from international applications filed on or after June 8, 1995."¹⁴

In contrast, where the effective date provision for § 132(b) applies only to an application-the effective date provision of the Act enabling § 305 states that its provisions apply to "patents then in force or issued thereafter" (emphasis added). The term "patents" was deliberately used by Congress to apply the statute to reexamination proceedings. Since Congress chose to use language in the effective date provision enabling § 132(b) limiting the scope to "applications," the continuing examination provisions of § 132(b) were explicitly and deliberately written so as not to apply to reexamination of patents. Therefore, the 1999 Act, by its plain text, fails to authorize continued examination for reexamination proceedings.

3. 35 U.S.C. § 132(b) was enacted, *inter alia*, to provide patent term relief for applicants, a purpose inapplicable to reexamination of a patent.

35 U.S.C. § 132(b) codified section 4403, which was presented in Subtitle D, entitled the "Patent Term Guarantee Act." A purpose of the subtitle D provisions was stated to be to "compensate patent applicants for certain reductions in patent term that are not the fault of the applicant. . . . Only those who purposely manipulate the system to delay the issuance of their patents will be penalized under subtitle D, a result that the Conferees believe entirely appropriate."¹⁵ For example, section 4402 under subtitle D ensures that applicants' time spent in continued examination as set forth in section 4403 shall not be considered a delay for patent term adjustment purposes.¹⁶ This rationale is clearly

¹⁴ § 4405(b) of Subtitle D of Title IV of S. 1948 (113 Stat. 1501, 1501A560) (1999).

¹⁵ 145 Cong. Rec. S.14696, 14718 (November 17, 1999) (statement of Sen. Lott)

¹⁶ *Id.*; §§ 4402, 4403 of Subtitle D of Title IV of S. 1948 (113 Stat. 1501, 1501A557-1501A560). Note that under § 4402, the Office guarantees a response within 4 months for a reply such as a request for continued

inapplicable to reexamination of issued patents, which are not subject to patent term adjustment due to, e.g., delays in the reexamination process.¹⁷ For this reason also, application of § 132(b) to reexaminations would not further the purpose of the statute and is thus not consistent with the legislative intent.

4. Extension of continued examination to reexamination on the basis of § 132(b) would result in a substantial change in policy with no foundation for such change.

At the time of enactment of § 305, Congress incorporated the language of § 132 to establish the procedures for conducting reexamination. At that time, no provision for continued examination existed, in § 132 or elsewhere. Prosecution of applications could be continued at that time by filing a new continuation application; no analogous statutory provision existed for continuation of reexamination proceedings. In 1997, the Office created a Continuing Prosecution Application practice (i.e., CPA practice) for continuing prosecution via a streamlined process for the filing of a continuing application; no analogous provision was created for reexamination proceedings. In 1999, § 132(b) was enacted, which authorized the Office to prescribe regulations to provide for the continued examination of applications at the request of the applicant. The Office implemented this provision by creating a request for continued examination (RCE) practice in 37 CFR 1.114. RCE practice caused CPA practice to be “largely redundant”, and CPA practice was subsequently eliminated for utility and plant applications in 2003.¹⁸

The history of reexamination practice thus contains no procedure for § 132(b)-like continued examination (adding a complete second iteration to the process, at applicant’s option/choice), either through continuation pursuant to § 120 or through CPA practice, the precursor to RCE practice. Unlike applications, which have historically enjoyed avenues for § 132(b)-like continuation of prosecution, reexaminations have not historically granted patent owners such a statutory or regulatory right. Were § 132(b) to be read as affording such a right to patent owners, this would represent a substantial change in longstanding practice, which could extend the reexamination process indefinitely, at the patent owner’s option. Note that the filing of multiple RCEs in an application works to an applicant’s disadvantage, since the term of the patent from its grant to expiration is shortened based on the “20-years from filing” expiration of the patent. On the other hand, the filing of multiple RCEs in a reexamination proceeding serves only to delay the resolution of the substantial question of patentability in the reexamination proceeding, without any loss of patent term. A patent owner faced with an adverse decision as to patent claims could keep a reexamination proceeding pending indefinitely by the filing of multiple RCEs, if such was (at patent owner’s desire) available. And, *Ethicon v. Quigg*, 849 F.2d 1422, 1426, 7 USPQ2d 1152, 1155 (Fed. Cir. 1988) provides: “Whatever else special dispatch means, it does not admit of an indefinite

examination, as compared to a notification within 14 months for a new application, such as a continuation application.

¹⁷ Patent term adjustment is applied to delays in the issue of an original patent. § 4402 of Subtitle D of Title IV of S. 1948 (113 Stat. 1501, 1501A558) (amending 35 USC 154(b)).

¹⁸ Elimination of Continued Prosecution Application Practice as to Utility and Plant Patent Applications, 68 Fed. Reg. 32376 (May 30, 2003).

suspension of reexamination proceedings pending conclusion of litigation. If it did, one would expect to find some intimation to that effect in the statute, for it would suggest the opposite of the ordinary meaning. But there is none.” It is to be noted that a patent owner in a reexamination proceeding has a limited avenue for seeking further examination for entry of one amendment (or a single evidence submission), as discussed below in Part III of this decision, but that avenue is strictly controlled by the Office to advance prosecution to further the requirement of special dispatch (e.g., by resolving issues on appeal by further limiting the claims or defining terms). A procedure for § 132(b)-like continued examination (adding a complete second iteration to the process, at applicant’s option/choice) was simply never envisioned by Congress, the courts, or the Office.

Where change is legislated by Congress without comment, and a proposed reading of such legislative change could be made to cause substantial change in longstanding practice, such a reading has been held to be unpersuasive.¹⁹ As § 132(b) was enacted well after § 305, Congress is presumed to have known that § 305 would incorporate into reexamination proceedings any procedure for “initial examination” set forth in § 132 as amended. However, the legislative record refers only to finally rejected applications; no mention appears in the record of a desired change in reexamination procedure. There is therefore no indication in the legislative history that § 132(b) was conceived as applicable to reexaminations. The reading of § 132 most consistent with legislative intent is that § 132(a) is directed towards initial examination and that § 132(b) is directed instead towards continued examination. For this reason, the legislative history of § 132(b) does not support the establishment of procedures for the conduct of reexamination proceedings.

C. Patent Owner’s comparisons to §§ 133 and 314 are unpersuasive.

1. The legislative intent of § 314 does not inform the legislative intent of § 132(b).

Patent owner relies upon an argument that Congress showed intent to provide for *ex parte* reexaminations under § 132(b) by using the phrase “initial examination under . . . 132” in the *inter partes* statute 35 U.S.C. § 314.²⁰ However, Congressional intent was stated clearly in the legislative history to provide continued examination for patent applications only. As discussed above, the purpose of the statute was, *inter alia*, to provide patent term reduction relief due to delays in the application prosecution, which is not an issue during the reexamination proceeding. Additionally, the statute authorizes regulations “for the continued examination of an application,” contemplating continued examination only of applications. Where Congressional intent has been expressed in such a full and clear manner, arguments based upon similarities to separately enacted statutes are unpersuasive. It is further noted that § 314, newly provided by the Intellectual Property and Communications Omnibus Reform Act of 1999, statutorily provided for special dispatch for the new *inter partes* reexamination option, while nowhere in the 1999 act or

¹⁹ *Watt v. Alaska*, 451 U.S. 259, 271-73 (U.S. 1981).

²⁰ Patent Owner petition of November 6, 2008, page 9.

its legislative history is a discussion of lengthening reexamination by inclusion of a request for continued examination at a patent owner's option. If Congress had wanted to include a lengthy continued full examination for reexamination proceedings, it could have done so at that time, since the enactment also included modifications of *ex parte* reexamination, such as appeal and revival (i.e., reexamination as a whole was looked at by Congress).

2. The legislative intent of § 133 does not illuminate the legislative intent of § 132(b).

Patent owner's arguments based upon Office incorporation by § 305 of the "unavoidable delay" standard for applications under § 133 are unpersuasive. Patent owner cited *In re Katrapat*, 6 USPQ2d 1863 (Comm'r Pat. 1988), wherein the Office stated that although § 133 could not literally apply to a reexamination proceeding, "since it does not involve an 'application,'" the unavoidable delay standard was intended to be the proper standard in reexamination proceedings.²¹ However, *Katrapat* involved § 133 which, unlike § 132(b), contained the "unavoidable delay" provision at issue at the time § 305 was enacted. Congress enacted § 305 directing reexaminations to follow the procedure of § 133, which at the time of enactment in 1984, contained a single provision having the "unavoidable delay" provision.²² Congress, in 1984, could have had no other intent but to make an "unavoidable delay" provision applicable to reexamination proceedings. However, at that time, § 132 contained no reference to any continued examination, and the intent to apply to reexamination the features of a not-yet-enacted provision cannot be imputed to Congress. Furthermore, Congressional intent at the time of the enactment of § 132(b) was directed, *inter alia*, to patent term fairness, which is inapplicable to reexamination proceedings.

III. An Alternate Remedy Providing Further Examination is Available Through 37 CFR 1.182

While there exists no statutory basis for continued examination in reexamination proceedings as a matter of right (flowing from 35 U.S.C. 305 or elsewhere), patent owners in a reexamination proceeding do have an avenue after final rejection for seeking further examination based on entry of one amendment (or a single evidence submission), as long as the requirement for special dispatch is served. A petition under 37 CFR 1.182 can provide relief for patent owners in an instance where further examination after final rejection, to address a new amendment or evidence would serve to advance prosecution to further the requirement of special dispatch (e.g., by resolving issues on appeal by further limiting the claims or defining terms). This procedure does not, however, permit re-prosecution of the proceedings, nor multiple amendments at patent owner's option, since that would run contrary to the statutory mandate for special dispatch. In the situation presented by the instant request, such a petition procedure may be available, though that option has not yet been pursued by the patent owner.

²¹ *In re Katrapat*, 6 USPQ2d (BNA 1988) 1863.

²² 35 U.S.C. § 133 (1952).

IV. Waiver of 37 CFR 1.114(e)(5) is Inconsistent With the Requirement of 35 U.S.C. § 305

37 CFR 1.183 empowers the Office to waive any requirement of the regulations “which is not a requirement of the statutes.”²³ Patent owner has requested waiver of 37 CFR 1.114(e)(5), which specifically excludes reexamination proceedings from RCE practice. 37 CFR 1.114(e)(5) may be waived only if its provision is not a requirement of the statute.

In an *ex parte* reexamination, after the times for filing the statement and reply provided by 35 U.S.C. § 304 have expired, 35 U.S.C. § 305 requires that proceedings “be conducted according to the procedures established for initial examination set forth in sections 132 and 133 of this title.”²⁴ As discussed above, only the procedures set forth in 35 U.S.C. § 132(a) are directed to “initial examination.” Procedures directed to continued examination would be outside the procedures established for initial examination, and are therefore excluded under § 305.

Continued examination is provided for in 35 U.S.C. § 132(b), which authorizes regulations providing for “the continued examination of applications for patent.” To implement this statutory limitation, the Office promulgated 37 CFR 1.114(e)(5), which specifically excludes reexamination proceedings from RCE practice, because reexamination of a patent is not the examination of an “application for patent.”

37 CFR 1.183 empowers the Office to waive any requirement of the regulations “which is not a requirement of the statutes.” As discussed above, § 305 requires that the procedures for initial examination govern the conduct of reexaminations after the time for filing the statement and reply provided for by 35 U.S.C. § 304. Continued examination, which is not an initial examination procedure authorized by § 305, or independently authorized by another applicable statute, is thus excluded from reexamination proceedings. Therefore, a grant of continued examination via 37 CFR 1.183 for reexamination proceedings would be beyond the scope of the statutory authority of the Office.

Even if the regulation was of the type that is subject to waiver by the Office, waiver would only be granted in “an extraordinary situation, when justice requires.”²⁵ 37 CFR 1.183 is to be used only in an “extraordinary situation,” and such has not been established in this instance. Patent owner’s argument alleging inadequate opportunity to prosecute the currently amended claims such that justice requires reopening of prosecution is not persuasive. The record shows that patent owner has had a full and fair opportunity to prosecute the merged reexamination, including four interviews, consideration of claim amendments and affidavits, and entry of claim amendments filed three days prior to filing

²³ 37 CFR 1.183

²⁴ 35 U.S.C. § 305.

²⁵ 37 CFR 1.183

of an appeal brief. Patent owner's allegations of new grounds of rejections in the examiner's answer are addressed by way of 37 CFR 1.181, not via 37 CFR 1.183. Therefore, the record does not exhibit an "extraordinary situation" as required under 37 CFR 1.183, even if 37 CFR 1.183 were applicable.

Note further that a "full blown" continued reexamination would run contrary to the special dispatch provision of § 305, even if the Office had the option to revoke 37 CFR 1.114(e)(5) and provide continued reexamination by rule. In this instance, patent owner has not shown any "extraordinary" circumstance that could not be asserted by any other reexamination patent owner desiring entry of an amendment after final rejection. If a RCE under 37 CFR 1.114(e) were grantable to the present patent owner in this instance (at patent owner's option), it would likewise be grantable in any like situation, and the special dispatch provision of § 305 would be eviscerated. On the other hand, if patent owner seeks only to materially advance prosecution to further the requirement of special dispatch (e.g., by resolving issues on appeal by further limiting the claims or defining terms), then procedure discussed in section III above is an avenue available to address patent owner concerns, while permitting the Office to control prosecution to further statutory special dispatch.

SUMMARY

In light of the analysis above, there is no statutory authority for filing, in a reexamination proceeding, an RCE in an effort to continue prosecution of the reexamination proceeding, regardless of whether prosecution was closed, or otherwise. Also, the "extraordinary situation, when justice requires" relief required by 37 CFR 1.183 has not been shown, even if the statute did not bar the requested waiver. Accordingly, the RCE filed on November 6, 2008, and resubmitted on January 19, 2009, is not a paper that is enterable in the merged '6824 and '7619 reexamination proceeding, and will be expunged from the file.

In view of the above and the fact situation presented by the record, the petition is denied. Further, the papers of the request for continued examination under 37 CFR 1.114 that accompanied the petition are being expunged as improper papers, not authorized by statute.

CONCLUSION

1. The petition filed January 19, 2009 is granted to the extent that patent owner's arguments made in the instant request are considered, and the arguments made in the November 6, 2008 petition have been again considered, but is denied as to the underlying relief requested.
2. The accompanying papers of the request for continued examination under 37 CFR 1.114 are being expunged as improper papers. The papers are being expunged by

closing them in the IFW file of the present reexamination proceeding, and marking the papers "closed" and "non-public" in the IFW.

3. The present decision is being made of part of the official record (the IFW) for the present proceeding.
4. Jurisdiction over the present *ex parte* reexamination proceeding is being returned to the Central Reexamination Unit (CRU), for appropriate action in due course.
5. This decision is designated as a final agency action under 5 U.S.C. § 704.
6. 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

7. Telephone inquiries related to the present decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700, or in his absence, Pinchus M. Laufer at (571) 272-7726.



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