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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,143	08/03/2006	5926237	8733.059.61	6948

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MCKENNA LONG & ALDRIDGE LLP
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/15/2009

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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11921 FREEDOM DRIVE,
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Date:

MAILED

MAY 15 2009

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90008143
PATENT NO. : 5926237
ART UNIT : 3900

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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(For Patent Owner)

MAILED

MAY 15 2009

CENTRAL REEXAMINATION UNIT

BRUCE K. LAGERMAN
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(For Requester)

In re Yun et al.
Ex Parte Reexamination Proceeding
Control No. 90/008,143
Filed: August 3, 2006
For: U.S. Patent No. 5,926,237

DECISION
DISMISSING PETITION
UNDER 1.182

This is a decision on the April 30, 2009 patent owner petition entitled "PETITION UNDER 37 CFR § 1.182 REQUEST FOR CONTINUED REEXAMINATION."

The patent owner petition is before the Office of Patent Legal Administration.

The petition is **dismissed**.

BACKGROUND

- On August 3, 2006, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/008,143 ("the '161 proceeding").

- Prosecution progressed until, on February 2, 2009, patent owner filed a timely response, including declaration and exhibits, to a final Office action that was issued by the Office on October 31, 2008.

- On March 16, 2009, an advisory action was mailed by the Office, refusing entry of the earlier submitted declaration and exhibits, and setting a time period for response to run 6 months from the date of the final Office action.

- On April 30, 2009, patent owner filed a notice of appeal and a response entitled "REQUEST FOR RECONSIDERATION," requesting entry and consideration of the declaration, exhibits, and entirety of the response filed February 2, 2009.

- On April 30, 2009, patent owner also filed a petition entitled "PETITION UNDER 37 CFR 1.181," requesting entry and consideration of the declaration, exhibits, and entirety of the response filed February 2, 2009.

- On April 30, 2009, the patent owner also filed the instant petition entitled "PETITION UNDER 37 CFR § 1.182 REQUEST FOR CONTINUED REEXAMINATION," requesting continued prosecution of the reexamination, including entry and consideration of the declaration, exhibits, and entirety of the response filed February 2, 2009.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

37 CFR 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 CFR 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.

DECISION

A Petition Under 37 CFR 1.182 Will Not Be Granted Where Another Rule Applies

In March of 2005, the Office issued a 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."[1] Notice was provided therein that a patent owner could file a petition under 37 CFR 1.182 requesting continued prosecution on the merits in the reexamination proceeding **to seek entry of an amendment and/or evidence that was denied entry** after an action closing prosecution in an *inter partes* reexamination proceeding.

[1] 1292 *Off. Gaz. Pat. Office* 20, March 1, 2005.

In this instance, the patent owner has concurrently pursued alternative relief via a 37 CFR 1.181 petition to request entry of the declaration, exhibits, and entirety of the response filed February 2, 2009. Since the concurrently filed April 30, 2009 petition under 37 CFR 1.181 to request entry of the amendment and response filed on October 30, 2008 has not yet been decided, the February 2, 2009 submission cannot be considered to have been denied entry after a final rejection, for the purpose of filing a §1.182 petition to request continued reexamination. Accordingly, the present § 1.182 petition to request continued reexamination filed to seek entry of the February 2, 2009 submission filed after final rejection is premature, and is dismissed as such.

In addition, the relief requested in the petition under 37 CFR 1.182 would be moot, should relief be granted under 37 CFR 1.181. Since the entry of the February 2, 2009 submission is currently in the process of being addressed through 37 CFR 1.181, consideration of this situation under 37 CFR 1.182 would be premature. Patent owner retains the option of filing a renewed petition under 37 CFR 1.182, if at some future date relief has not been granted under 37 CFR 1.181 or through another section. Until such time, the issue is not ripe for consideration by the Office under 37 CFR 1.182.

In view of the above, the petition is **dismissed** as premature.

Additional discussion:

The April 30, 2009, patent owner petition is filed under 37 CFR 1.182 requesting continued prosecution for entry and consideration of the declaration, exhibits, and entirety of the response filed February 2, 2009. 37 CFR 1.182 addresses only those situations not otherwise provided for in the regulations. Where a situation exists such that relief is specifically provided for elsewhere in the regulations, 37 CFR 1.182 is, according to the terms of that regulation, not an appropriate mechanism for relief. Here, the petition under 37 CFR 1.182 shares a common statement of facts upon which relief is requested with the concurrently filed petition under 37 CFR 1.181 (pages 2 and 3 of each petition). Both petitions allege that the evidence of secondary considerations has not been given the proper consideration, and that the evidence and declaration submitted on February 2nd was not entered or considered. The instant petition under 37 CFR 1.182 further alleges that sufficient reasons for the Examiner's rejection were not given in the advisory action mailed March 16, 2009. Each of the allegations made in the instant 37 CFR 1.182 petition addresses alleged impropriety as to the final Office action and the advisory action. While such allegations of impropriety of an Office action are properly addressed under 37 CFR 1.181, they are not the basis for a petition requesting continued examination under 37 CFR 1.182. If a petition requesting continued examination under 37 CFR 1.182 is subsequently filed, it should focus on how entry of the February 3, 2009 submission would further the prosecution of the reexamination proceeding, by reducing issues, to define the issues for appeal, or the issuance of a reexamination certificate, and why it was not apparent until the issuance of the final rejection that the specifics of the February 3, 2009 submission would do so.

CONCLUSION

- The petition is **dismissed**.
- A copy of this decision will be made of record in the reexamination file.
- The Central Reexamination Unit will consider the April 30, 2009 petition under 37 CFR 1.181 in due course.
- Any inquiry concerning this decision should be directed to Michael Cygan, Legal Advisor, at (571) 272-7700, or in his absence, Pinchus M. Laufer at (571) 272-7726.

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