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EXAMINER

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FEB 24 2009

CENTRAL REEXAMINATION UNIT

In re Mendez et al
Ex Parte Reexamination Proceeding
Control No. 90/008,397
Filed: December 29, 2006
For: U.S. Patent No. 7,039,679

:
: **DECISION DENYING**
: **AND EXPUNGING**
: **PETITION**
:

This is a decision on the October 8, 2008 third party requester petition entitled "Request for Reconsideration of Decision Dismissing and Expunging Petition Under 37 CFR § 1.182 and/or § 1.183."

The third party requester petition is before the Office of Patent Legal Administration.

SUMMARY

The petition is **granted to the extent** that the October 3, 2008 decisions dismissing and expunging the requester petition have been reconsidered, but is **denied** as to the underlying relief requested.

The third party requester petition paper is an **improper paper**. Because the present petition paper has been scanned into the electronic Image File Wrapper (IFW), the present petition paper is **expunged** from the record by marking it "closed" and "non-public," and will not constitute part of the record of the present reexamination proceeding.¹

This decision is designated as a final agency action under 5 U.S.C. § 704.

BACKGROUND

1. On May 2, 2006, U.S. Patent 7,039,679 ("the '679 patent") issued to Mendez et al.

¹ See MPEP 2267.

2. On December 29, 2006, a request for *ex parte* reexamination was filed by the third party requester, and the resulting reexamination proceeding was assigned control number 90/008,397 (“the ‘8397 proceeding”).
3. On February 9, 2007, an order granting *ex parte* reexamination was mailed by the Office.
4. The proceeding progressed until, on March 14, 2008, a final rejection was mailed by the Office.
5. On April 22, 2008, the patent owner filed a response after final rejection.
6. On June 13, 2008, the patent owner filed a notice of appeal.
7. On June 20, 2008, an advisory action, which addressed the April 22, 2008 patent owner response after final rejection, was mailed by the Office.
8. On June 24, 2008, the examiner conducted an interview with Mr. McKeown, attorney of record for patent owner (“the June 24, 2008 interview”) during which the examiner obtained the patent owner’s authorization for an examiner’s amendment. The examiner summarized the interview on page 2 of the examiner’s amendment which accompanied each of the August 21, 2008 and October 3, 2008 Notices of Intent to Issue a Reexamination Certificate (NIRC), itemized below (as items 10 and 19).
9. On August 13, 2008, the patent owner filed a petition for extension of time under 37 CFR 1.550(c).
10. On August 21, 2008, a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed (“the August 21, 2008 NIRC”) by the Office. The August 21, 2008 NIRC was accompanied by an examiner’s amendment containing an interview summary of the June 24, 2008 interview.
11. On August 30, 2008, a decision granting-in-part the August 13, 2008 patent owner petition for extension of time was mailed by the Office.
12. On September 2, 2008, the third party requester filed a petition entitled “Petition Under 37 CFR § 1.182 and/or § 1.183” to vacate the August 21, 2008 NIRC (“the September 2, 2008 requester petition”).
13. On September 5, 2008, the third party requester filed a petition entitled “Supplement to Petition Under 37 CFR § 1.182 and/or § 1.183” (“the September 5, 2008 supplemental requester petition”).
14. On September 29, 2008, the patent owner filed a petition entitled “Petition under 37 CFR 1.137(b) for Acceptance of Unintentionally Delayed Papers” (“the September 29, 2008 patent owner petition under 37 CFR 1.137(b)”), accompanied by the patent owner’s statement under 37 CFR 1.560(b) of the June 24, 2008 interview.

15. On October 1, 2008, the third party requester filed a petition entitled "Information Supplement to Petition under 37 CFR § 1.183" ("the October 1, 2008 requester petition").
16. On October 2, 2008, a decision granting the September 29, 2008 patent owner petition under 37 CFR 1.137(b) was mailed by the Office.
17. On October 3, 2008, a decision dismissing and expunging the September 2, 2008 requester petition and the September 5, 2008 supplemental requester petition was mailed by the Office.
18. Also on October 3, 2008, a decision dismissing and expunging the October 1, 2008 requester petition was mailed by the Office.
19. Also on October 3, 2008, a Notice of Intent to Issue a Reexamination Certificate (NIRC) was mailed by the Office ("the October 3, 2008 NIRC").
20. On October 8, 2008, the third party requester filed the present petition entitled "Request for Reconsideration of Decision Dismissing and Expunging Petition Under 37 CFR § 1.182 and/or § 1.183," for reconsideration of the October 3, 2008 decisions ("the October 8, 2008 requester request for reconsideration").
21. On October 20, 2008, the third party requester filed a petition entitled "Petition Under 37 CFR § 1.182 and/or 37 CFR § 1.183" ("the October 20, 2008 requester petition").
22. On December 19, 2008, a decision dismissing and expunging the October 20, 2008 requester petition was mailed by the Office.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. 122(c) provides (emphasis added in bold):

PROTEST AND PRE-ISSUANCE OPPOSITION. — The Director shall establish appropriate procedures to ensure that **no protest or other form of pre-issuance opposition** to the grant of a patent on an **application may be initiated after publication of the application** without the express written consent of the applicant.

35 U.S.C. § 303(a) provides, in pertinent part:

Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications.

35 U.S.C § 304 provides:

If, in a determination made under the provisions of subsection 303(a) of this title, the Director finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination will include an order for reexamination of the patent for resolution of the question. The patent owner will be given

a reasonable period, not less than two months from the date a copy of the determination is given or mailed to him, within which he may file a statement on such question, including any amendment to his patent and new claim or claims he may wish to propose, for consideration in the reexamination. If the patent owner files such a statement, he promptly will serve a copy of it on the person who has requested reexamination under the provisions of section 302 of this title. Within a period of two months from the date of service, that person may file and have considered in the reexamination a reply to any statement filed by the patent owner. That person promptly will serve on the patent owner a copy of any reply filed.

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

After the times for filing the statement and reply provided for by section 304 of this title 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. . . All reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office.

37 CFR 1.137(b) provides, in pertinent part:

Unintentional . If the delay in reply by . . . patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive . . . a reexamination prosecution terminated under §§ 1.550(d) . . . 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;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional . . .

37 CFR 1.183 provides:

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. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.291(b) provides, in pertinent part (emphasis added in bold):

The protest will be entered into the record of the **application if . . . except for paragraph (b)(1) of this section, the protest was filed prior to the date the application was published . . .**

- (1) If a protest is accompanied by the written consent of the applicant . . .

37 CFR 1.550(f) provides:

The reexamination requester will be sent copies of Office actions issued during the *ex parte* reexamination proceeding. After filing of a request for *ex parte* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party in the reexamination proceeding in the manner provided by § 1.248. The document must reflect service or the document may be refused consideration by the Office.

37 CFR 1.560 provides:

(a) Interviews in *ex parte* reexamination proceedings pending before the Office between examiners and the owners of such patents or their attorneys or agents of record must be conducted in the Office at such times, within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director. Interviews for the discussion of the patentability of claims in patents involved in *ex parte* reexamination proceedings will not be conducted prior to the first official action. Interviews should be arranged in advance. Requests that reexamination requesters participate in interviews with examiners will not be granted.

(b) In every instance of an interview with an examiner in an *ex parte* reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for response to Office actions as specified in § 1.111. Patent owner's response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.

DECISION

The third party requester requests reconsideration of the October 3, 2008 Office decisions dismissing requester's petitions under 37 CFR 1.183 filed on September 2, 2008, September 5, 2008, and October 1, 2008. The requester has specifically requested relief from the dismissal of the September 2, 2008 petition only. However, as each of the "supplemental" petitions filed on September 5 and October 1 were also dismissed by the Office on October 3, 2008, the present request for reconsideration, filed by the third party requester on October 8, 2008, is taken as a request for reconsideration of all three petitions, i.e., the September 2, 2008, September 5, 2008, and October 1, 2008 requester petitions.

Based on 35 U.S.C. 304, the third party requester's period for reply in an *ex parte* reexamination proceeding statutorily ends: (1) upon expiration of the patent owner's time for filing a statement in response to the order for reexamination – if no such patent owner statement is filed, or (2) upon expiration of the third party requester's time for filing a reply to a patent owner's statement which has been filed (i.e., the expiration of two months from the date of service of the patent owner's statement) or (3) after the third party requester has filed a reply to a patent owner's statement, if a reply is filed. In the present '8397 proceeding, the statutory statement and reply period ended when the patent owner did not file a statement in response to the February 9, 2007 order granting reexamination, and the two month period for doing so expired.

On their face, the third party requester's September 2, 2008, September 5, 2008, and October 1, 2008 petitions were all filed after the statutory statement and reply period ended for the '8397 proceeding. Accordingly, the Office is without statutory authority to consider the substance of the third party requester's September 2, 2008, September 5, 2008, and October 1, 2008 petitions.

The present petition for reconsideration asserts that the *ex parte* reexamination statute does not prohibit the third party requester from filing the September 2, September 5, and October 1, 2008 petitions under 37 CFR 1.183 in this *ex parte* reexamination proceeding. The requester argues that there is no mention in 35 U.S.C. 305 of third party requester submissions, and that 35 U.S.C. 305 states only that reexamination will be conducted according to the procedures established for initial examination under the provisions of sections 132 and 133 of title 35.

This argument is not persuasive, because the statutory procedures established for initial examination, including the procedures under 35 U.S.C. 132 and 133 are *ex parte* procedures. See, e.g., *In re Huang*, 100 F.3d 135, 139, 40 USPQ2d 1685, 1689 (Fed. Cir. 1996) (referring to the “*ex parte* process of examining a patent application”); *Chicago Rawhide Manufacturing Co. v. Crane Packing Co.*, 523 F.2d 452, 458 (7th Cir. 1975) (referring to the “*ex parte* character of the normal Patent Office prosecution” [italics added]). There is nothing in the statute to indicate that procedures under 35 U.S.C. 132 and 133 are open to *inter partes* prosecution in an *ex parte* reexamination.

As stated in the October 3, 2008 decisions, waiver or suspension of the rules to permit entry of the September 2, September 5, and October 1, 2008 requester petitions is not justified in view of the legislation and implementing rules which make reexamination under 35 U.S.C. §§ 302 - 307 an *ex parte* proceeding. See *Syntex (U.S.A.) Inc. v. U.S. Patent and Trademark Office*, 882 F.2d 1570, 1573; 11 USPQ2d 1866, 1868-1869 (Fed. Cir. 1989). In *Syntex*, the Federal Circuit stated:

If reexamination is granted, a third-party requester has the right to reply to any statement submitted by the patent owner in response to the PTO's order granting reexamination (section 304). The statute gives third-party requesters no further, specific right to participate in the reexamination proceeding. Indeed, **the statute specifically prohibits further participation by third-party requesters during reexamination. See 35 U.S.C. § 305 (“[a]fter the times for filing the statement and reply provided for by section 304 of this title have expired, reexamination will be conducted according to the procedures established for initial examination”). Thus, a reexamination is conducted *ex parte* after it is instituted.** [Citations omitted] [Emphasis added in bold].

The *Syntex* opinion cited *In re Etter*, 756 F.2d 852, 859 n.6, 225 USPQ 1, 5-6 n.6 (Fed. Cir. 1985), *cert. denied*, 474 U.S. 828 (1985). In *Etter*, the Federal Circuit stated:

When a third party (whether or not an alleged infringer, and whether or not suit has been filed) is the requestor, that party is heard only on whether “a substantial new question” exists. Absent a “substantial new question”, an alleged infringer cannot “force” a patentee back into the PTO. Contrary to indications in the concurrence, **the reexamination *per se* of the claims is entirely *ex parte***” [Emphasis added in bold].

See also *Boeing Co. v. Commissioner of Patents and Trademarks*, 853 F.2d 878, 881, 7 USPQ2d 1487, 1489 (Fed. Cir. 1988). In *Boeing*, the Federal Circuit stated:

“While [the third party requester] had a right to file a request for reexamination under 35 U.S.C. § 302 and a contingent right to file a reply statement under 35 U.S.C. § 304, [the third party requester] **had no right thereafter to participate in the reexamination process, 35 U.S.C. § 305.**” [Italics in original] [Emphasis added in bold].

The September 2, September 5, and October 1, 2008 requester petitions are clearly an attempt by the third party requester to participate in the *ex parte* reexamination process. In these petitions, the requester requests the Office to:

- (1) vacate an Office action, i.e., the August 21, 2008 Notice of Intent to Issue a Reexamination Certificate (NIRC);

- (2) cancel all of the '679 patent claims;²
- (3) terminate the *ex parte* reexamination proceeding; and
- (4) issue an *ex parte* reexamination certificate reflecting the cancellation of all of the patent claims.³

As pointed out above, there are no provisions in the *ex parte* reexamination statute that permit the third party requester to participate in the *ex parte* reexamination, other than the right to file a request for *ex parte* reexamination under 35 U.S.C. 302 and a reply to the patent owner's statement under 35 U.S.C. 304 (if a patent owner's statement is filed). It is to be noted that it was necessary for Congress to amend the statute in 1999 in order to permit participation in the examination stage (and appeal stage) by the third party requester, and those provisions were only provided for *inter partes* reexamination in the newly created *inter partes* reexamination statute, particularly, in 35 U.S.C. 314(b)(2) and U.S.C. 315(b).⁴ If further participation by the third party requester were applicable to *ex parte* reexamination, then there would have been no need for Congress to expressly provide for such provisions in the *inter partes* reexamination statute. Also, the fact that Congress provided for increased third party requester participation in the *inter partes* reexamination statute via the American Inventors Protection Act (AIPA), signed into law on November 29, 1999,⁵ but did not do so for *ex parte* reexamination,⁶ shows an intent of Congress that third party requester participation in the examination stage is not authorized in *ex parte* reexamination.

The requester urges that justice requires that the rules be waived in order to consider and act on the September 2, September 5, and October 1, 2008 petitions. However, the rules cannot be waived to provide the third party requester the right to file a paper in the examination stage of the '8397 proceeding (during which the petitions have been filed), since such is not authorized by statute. In this respect, the requester stands on a footing no different from any other member of the public who wishes to challenge a procedural action taken by the Office in a proceeding. The patent statute simply does not provide for such intervention. It is observed that the requester's attempt to intervene in an *ex parte* reexamination at this stage of the proceeding (i.e., after the statement and reply stage) is equivalent to the attempt by a third party to intervene in the *ex parte* prosecution of a nonprovisional utility application, where the third party has no legal

² The alleged basis for such cancellation would **only be highly technical procedural omissions**; however, the request to cancel the claims clearly goes to the substance of the proceeding.

³ The requester states, on page 1 of the September 2, 2008 requester petition, that "Third Party Requester Research in Motion Limited hereby petitions the Director pursuant to 37 CFR . . . § 1.183 to vacate the Notice of Intent to Issue Ex Parte Reexamination Certificate mailed August 21, 2008, and to terminate the present reexamination proceeding . . .". The requester also states, on page 8 of the September 2, 2008 requester petition, that ". . . the present reexamination proceeding should have been terminated . . . and a Reexamination Certificate canceling all claims must be issued . . .". See also page 3 of the September 5 and October 1, 2008 requester petitions.

⁴ See, generally, 35 U.S.C. 311-318.

⁵ P.L. No. 106-113, 113 STAT. 1501A-571.

⁶ Compare the provisions of 35 U.S.C. 302-307 of the *ex parte* reexamination statute, with those of the *inter partes* reexamination statute, particularly, 35 U.S.C. 314(b) and 35 U.S.C. 315(b).

standing.⁷ Because the statute does not authorize the requested intervention by the present petitioner, the underlying relief requested in the October 8, 2008 requester request for reconsideration must be denied.

A brief discussion as to the history of reexamination impacts on the intervention requested by the petitioner: To permit a third party requester to participate in an *ex parte* reexamination by requesting the Office to (1) vacate an Office action, (2) cancel all pending patent claims, (3) terminate the proceeding, and (4) issue a reexamination certificate reflecting the cancellation of all of the pending patent claims, is clearly without statutory authority. The Office is required under 35 U.S.C. 305 to conduct reexamination proceedings with special dispatch. To permit third parties to challenge all actions taken by the Office, or all submissions, or the lack thereof, by the patent owner in an *ex parte* reexamination proceeding at any stage in the proceeding would cause unnecessary delay and would be contrary to the Congressional mandate for special dispatch in a proceeding that was legislated to be *ex parte* in the examination stage. The legislative history of the *ex parte* reexamination statute reflects an intent by Congress that the *ex parte* reexamination process would not create new opportunities to harass the patent owner. See, e.g., *Industrial Innovation & Patent & Copyright Law Amendments: Hearings on H.R. 6933, 6934, 3806, & 214 Before the Subcommittee on Courts, Civil Liberties and the Administration of Justice of the House Committee on the Judiciary, 96th Cong., 2nd Sess. 594 (1980)* (statement of Sidney Diamond, Commissioner of Patents & Trademarks, April 24, 1980):

[The proposed *ex parte* reexamination statute] carefully protects patent owners from reexamination proceedings brought for harassment or spite. The possibility of harassing patent holders is a classic criticism of some foreign reexamination systems and we made sure it would not happen here.

To prevent the use of the reexamination process to harass the patent owner, Congress included the requirement that a substantial new question of patentability, based only on patents and printed publications, must be raised by the request. Unauthorized “protest” participation by a third party in an *ex parte* proceeding represents yet another form of harassment of the patent owner. The *inter partes* reexamination statute permits participation of a third party who requested the reexamination in the examination stage (and appeal stage); however, in return for that participation, the *inter partes* reexamination statute attaches estoppel provisions to prevent third party challenges to the patent as to the facts and issues of the reexamination proceeding, once the *inter partes* reexamination process has concluded. See 35 U.S.C. 317. There are no such estoppel provisions in the *ex parte* reexamination statute. To permit the present *ex parte* reexamination requester to intervene at this point (or any other point after requester participation is barred) would permit a circumvention of the *inter partes* reexamination statute, without attachment of the *inter partes* reexamination estoppel provisions. It is to be noted

⁷ The filing of the September 2, September 5, and October 1, 2008 requester petitions cannot be analogized to the filing of a protest by a third party in an application under 35 U.S.C. 122(c) and 37 CFR 1.291, since 35 U.S.C. 122(c) and 37 CFR 1.291 specifically refer to the filing of a protest in an *application*, and a reexamination proceeding is not an application. In addition, 35 U.S.C. 122(c) expressly *prohibits* the filing of a protest *after publication of the application*, without the express consent of the applicant. After the patent has been granted, the application clearly has been published, and there is no new unpublished application to support a protest without consent.

that Congress did not combine *ex parte* reexamination with *inter partes* reexamination to provide one process, but left *ex parte* reexamination in place to continue a direct process without intervention (and resulting delay) from third parties during the examination stage of the proceeding. The present requester must not be permitted to provide such intervention in the present process. To enter and consider the September 2, September 5, and October 1, 2008 petitions, at the stage at which these petitions were filed in this proceeding, would cause significant delay, and would appear to create an opportunity for harassment, both of which Congress intended to prevent in what was legislated to be a direct process with a statutory special dispatch having no exceptions.

For the reasons given above, the October 8, 2008 petition for reconsideration of the October 3, 2008 decisions is **denied** as to the underlying relief requested. Since the petition is not authorized by statute, the third party requester petition paper is an **improper paper**. Accordingly, the present petition paper is **expunged** from the electronic Image File Wrapper (IFW) record by marking it “closed” and “non-public,” and it will not constitute part of the record of the present reexamination proceeding.⁸

Sua Sponte Clarification as to the Propriety of the Office’s Intent to Issue a Reexamination Certificate in this Proceeding

This decision does not treat the substance of the September 2, September 5, and October 1, 2008 petitions. The record is, however, *sua sponte* being clarified to show that the Office’s intent to issue a reexamination certificate in this proceeding is consistent with the statute.

The August 21, 2008 NIRC was vacated by the Office’s October 2, 2008 decision, entitled “Decision Granting Petition Under 37 CFR 1.137(b),” which sets forth that the prosecution of the present reexamination proceeding was terminated due to the failure to timely submit a statement of the substance of the June 24, 2008 interview pursuant to 37 CFR 1.560(b). Revival of a terminated prosecution under 37 CFR 1.137 requires a proper response to the outstanding Office action or notice, unless previously filed. The response that was required in this instance was the written statement of the substance of the interview, and patent owner’s inclusion of that statement with the petition under 37 CFR 1.137 met the “response” requirement for revival.⁹

Also, at the time of revival, the proceeding was in a condition in which all pending claims would be found patentable (i.e., the proceeding was “in condition for allowance”). The proceeding included a final rejection issued March 14, 2008, a response to that rejection filed April 22, 2008, an authorization for an examiner’s amendment given on June 24, 2008, and a written statement of the substance of that interview. These papers were properly of record on July 24, 2008, i.e., prior to termination of the prosecution for failure to file the patent owner interview statement, except for the written statement, which was provided with the petition for revival. Since the authorization for the examiner’s amendment was in effect on the date the proceeding was revived, the response was therefore complete as to that matter.¹⁰ On October 3, 2008, the Office

⁸ See MPEP 2267.

⁹ See page 4 of the December 19, 2008 decision, entitled “Decision Dismissing and Expunging Petition,” under the heading “*Sua Sponte Clarification As to the Propriety of the Issuance of the October 3rd NIRC*”.

¹⁰ *Id.*

issued a NIRC in this reexamination proceeding. The Office possessed jurisdiction to act upon the proceeding by issuing the October 3, 2008 NIRC after revival of the proceeding, in view of the complete response by the patent owner. The October 3, 2008 NIRC issued by the Office was therefore proper.

Furthermore, 37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required “reply” (response – in reexamination) from the due date for the “reply” (response – in reexamination) until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The December 19, 2008 decision, entitled “Decision Dismissing and Expunging Petition,” states that the statement contained in the September 29, 2008 patent owner petition under 37 CFR 1.137(b) is being construed as the statement required by 37 CFR 1.137(b)(3) with respect to *any aspect of the delay in returning this proceeding to pendency*.¹¹ This statement covers *any reason* for the delay. Finally, purely out of an abundance of caution, the December 19, 2008 decision also granted, *nunc pro tunc*, an extension of time (from the expiration of the two-month period for response after the Notice of Appeal was filed) to the extent needed to support the issuance of the October 3, 2008 NIRC.

Additional Comments

1. It was not necessary, under the circumstances of this proceeding, that the August 13, 2008 patent owner petition for extension of time specifically relate to the filing of an appeal brief or to any other specific paper. It is within the Office’s discretion to address a requested extension of time for any reason, or even to grant an extension of time *sua sponte*. The treatment of a request for an extension of time is within the sole discretion of the Office, and is not subject to challenge by a third party.¹² Again, however, as pointed out above, the December 19, 2008 decision granted, *nunc pro tunc*, an extension of time (from the expiration of the two-month period for response after the Notice of Appeal was filed) purely out of an abundance of caution,¹³ to the extent needed to support the issuance of the October 3, 2008 NIRC.

2. It is also not necessary that the “required reply” under 37 CFR 1.137(b)(1) must be an appeal brief, in a proceeding in which a notice of appeal had been filed prior to termination of the

¹¹ *Id.* Patent owner was given a time period of 10 days from the mail date of the December 19, 2008 decision to notify the Office if this is not a correct interpretation of the statement contained in the September 29, 2008 patent owner petition. No response by the patent owner was received within the time period for response to the December 19, 2008 decision. The statement contained in the September 29, 2008 patent owner petition is therefore construed as the statement required by 37 CFR 1.137(b)(3) with respect to any aspect of the delay in returning this proceeding to pendency.

¹² The Office notes that the August 13, 2008 patent owner request for extension of time did not reflect service on August 13, 2008. The patent owner, however, did file a certificate of service for this document on August 14, 2008. 37 CFR 1.550(f) states that the “document must reflect service or the document *may* be refused consideration by the Office” [emphasis added]. There is no requirement that the Office refuse consideration of a document for failure to provide a certificate of service. (See the procedure set forth in MPEP 2266.03, which expressly permits the Office reexamination clerk to telephone the party making the submission to obtain the missing certificate of service, if actual service was made, and if the certificate of service was inadvertently omitted from the submission.) In the present instance, the Office exercised its option to accept the August 13, 2008 patent owner request for extension of time, in view of the facts and circumstances of the present proceeding.

¹³ This was not, however, necessary, since the grant of the September 29, 2008 patent owner petition under 37 CFR 1.137(b) to revive obviated the need for the grant of an extension of time.

prosecution. If the patent owner wishes to revive, the patent owner may either file an appeal brief, or file a response that places the proceeding in a condition for finding all pending claims patentable (i.e., places the proceeding "in condition for allowance"). In the present instance, the authorization of the examiner's amendment on June 24, 2008, placed the case in condition for issuing a NIRC containing the authorized examiner's amendment. To require that reexamination proceedings (that are terminated after a notice of appeal had been filed) must only be revived by filing an appeal brief and by continuing with the appeal, without providing an option to quickly conclude the proceedings by placing the proceeding in condition for allowance (issue of a reexamination certificate), would be contrary to the Congressional mandate for special dispatch in reexamination.¹⁴ In this respect, the response required for revival where a notice of appeal has been filed in a reexamination proceeding is analogous to the reply where a notice of appeal has been filed in a nonprovisional application, to the extent that an appeal brief is not the only reply that satisfies the rule.¹⁵ And, in the present instance, as a result of the authorization of the examiner's amendment on June 24, 2008, the only remaining response required under 37 CFR 1.137(b)(1) to place the proceeding in condition for allowance was the statement under 37 CFR 1.560(b) which accompanied September 29, 2008 patent owner petition under 37 CFR 1.137(b).

3. Regarding any requirement for a written statement under 37 CFR 1.560(b) of the August 12, 2008 "interview", i.e., of the examiner's confirmance on August 12, 2008 that a NIRC would issue - the same information (that a NIRC would issue) was also indicated in the June 24, 2008 interview, during which an examiner's amendment was authorized,¹⁶ and for which a statement under 37 CFR 1.560(b) was provided by the patent owner with the September 29, 2008 petition under 37 CFR 1.137(b) to revive. Further, the patent owner also provided a written statement of the August 12, 2008 "interview" in the August 13, 2008 patent owner petition for extension of time. The technical requirement that the statement under 37 CFR 1.560(b) be filed as a separate part of a response is hereby waived *nunc pro tunc*, to obviate any argument that the revival might somehow be construed to omit, to any extent necessary, the examiner's prior confirmance that a NIRC would issue.

CONCLUSION

1. The petition is **granted to the extent** that the October 3, 2008 decisions dismissing and expunging the requester petition has been reconsidered, but is **denied** as to the underlying relief requested.

¹⁴ See 35 U.S.C. 305.

¹⁵ See MPEP 711.03(c) II A 2(b) and (c). In a nonprovisional application in which a notice of appeal had been filed prior to abandonment, for example, a Request for Continued Examination (RCE), with an appropriate submission, may be filed as the required reply. An RCE, however, cannot be filed in a reexamination proceeding. A required reply in a nonprovisional application that was abandoned for failure to reply to a final Office action, however, may be a reply that *prima facie* places the application in condition for allowance. In a reexamination proceeding in which a notice of appeal has been filed prior to termination, the response required by 37 CFR 1.137(b)(1) may be satisfied by either filing an appeal brief, or by filing a response that places the proceeding in condition for allowance.

¹⁶ The sole purpose of obtaining authorization for an examiner's amendment is to issue a NIRC containing the authorized examiner's amendment. Stated another way, an examiner does not initiate an interview to obtain authorization for an examiner's amendment, unless the examiner intends to issue a NIRC containing the authorized examiner's amendment

2. The petition paper filed by the third party requester on October 8, 2008 is **expunged** from the record as not having an entry right. This will be carried out by closing the petition paper (document) in the Office's Image File Wrapper (IFW) file of the '8397 *ex parte* reexamination proceeding and marking the paper "closed" and "not public."
3. No copy of the petition papers will be maintained of record in the electronic Image File Wrapper (IFW) for the proceeding, or elsewhere in the Office.
4. A copy of this decision will be made of record in the reexamination file.
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:

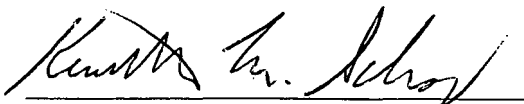
By EFS: Registered users may submit via the electronic filing system EFS-Web, at <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>.

By Mail: Mail Stop *Ex Parte* Reexam
Attn: Central Reexamination Unit
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By Fax: (571) 273-9900

By Hand: Customer Service Window
Attn.: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

7. Any inquiry concerning this decision should be directed to Cynthia L. Nessler, Senior Legal Advisor, at (571) 272-7724, or to Michael Cygan, Legal Advisor, at (571) 272-7700, or in their absence, to the undersigned at (571) 272-7710.



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

February 18, 2009

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