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CENTRAL REEXAMINATION UNIT

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(For Requester)

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In re Gallem et al.

Reexamination Proceeding

Control No. 95/001,216

Request Deposited: August 3, 2009

For: U.S. Patent No. 7,562,656

:
: DECISION *SUA SPONTE*
: VACATING *INTER PARTES*
: REEXAMINATION
: FILING DATE

The *inter partes* reexamination request papers deposited on August 3, 2009, are before the Office of Patent Legal Administration for consideration of whether to vacate the assigned filing date for failure to comply with the provisions of 37 CFR 1.915.

This decision constitutes notice that, pursuant to 37 CFR 1.915(d), **the filing date** of August 3, 2009, which was assigned to the request papers for the above-captioned *inter partes* reexamination proceeding is hereby **vacated**, because the papers fail to comply with the filing date requirements for an *inter partes* reexamination proceeding set forth in 37 CFR 1.915(b).

See MPEP 2627, Part B.1, MPEP 2614, and MPEP 2617, Part I.

In order to obtain a filing date for the request papers, the requester must, within **thirty (30) days** of the mailing date of this decision, file a response to this decision which remedies the defects set forth in this decision and makes the request papers compliant with the requirements of 37 CFR 1.915.

REVIEW OF FACTS

1. U.S. Patent No. 7,562,656 (hereinafter, the '656 patent) issued to Gallem et al. on July 21, 2009.
2. On August 3, 2009, a third party deposited a request for *inter partes* reexamination of claims 1-39 and 51 of the '656 patent. The deposited reexamination request was assigned Control No. 95/001,216 (hereinafter, the '216 proceeding).
3. On August 26, 2009, a "Notice of *Inter Partes* Reexamination Request Filing Date" was mailed for the '216 proceeding. The notice assigned the filing date of August 3, 2009, to the request for reexamination.

DECISION

Pursuant to 37 CFR 1.915(b), any request for *inter partes* reexamination must include:

- “(1)An identification of the patent by patent number and every claim for which reexamination is requested.
- (2) A citation of the patents and printed publications which are presented to provide a substantial new question of patentability.
- (3) A statement pointing out each substantial new question of patentability based on the cited patents and printed publications, and a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested.
- (4) A copy of every patent or printed publication relied upon or referred to in paragraphs (b)(1) through (3) of this section, accompanied by an English language translation of all the necessary and pertinent parts of any non-English language document.
- (5) A copy of the entire patent including the front face, drawings, and specification/claims (in double column format) for which reexamination is requested, and a copy of any disclaimer, certificate of correction, or reexamination certificate issued in the patent. All copies must have each page plainly written on only one side of a sheet of paper.
- (6) A certification by the third party requester that a copy of the request has been served in its entirety on the patent owner at the address provided for in § 1.33(c). The name and address of the party served must be indicated. If service was not possible, a duplicate copy of the request must be supplied to the Office.
- (7) A certification by the third party requester that the estoppel provisions of § 1.907 do not prohibit the *inter partes* reexamination.
- (8) A statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy.”

Upon further review of the request papers, the request is found not to be compliant with 37 CFR 1.915(b). Specifically, the request is not compliant with 37 CFR 1.915(b)(3), which requires “[a] statement pointing out each substantial new question of patentability based on the cited patents and printed publications, and a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested.”

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Discussion:

Under 35 U.S.C. 312 and 313, the Office must determine whether "a substantial new question of patentability" affecting any claim of the patent has been raised by the request for reexamination. To implement these statutory provisions, 37 CFR 1.915(b)(3) requires that the request include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications...." See MPEP 2617. Accordingly, it is mandatory that the request clearly set forth in detail the specifics of what the third party requester considers the "substantial new question of patentability" to be. A request must point out how any questions of patentability raised are substantially different from those raised in the previous examination of the patent before the Office. See MPEP 2616.¹

Under 35 U.S.C. 311, in a request for *inter partes* reexamination of a patent, the requester must "set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested." Under 35 U.S.C. 315, the patent owner in an *inter partes* reexamination proceeding has an appeal right "with respect to any decision adverse to the patentability of" the patent claims, and the reexamination requester has an appeal right "with respect to any final decision favorable to the patentability of" the patent claims. Accordingly, the requester must explain the pertinency and manner of applying cited prior art to every requested claim, for each proffered substantial new question of patentability, in terms of a proposed ground of rejecting the claims to which the substantial new question of patentability is directed.

For proposed obviousness rejections, requester **must provide** at least one basis for combining the cited references, and a statement of why the claim(s) under reexamination would have been obvious over the proposed reference combination.² Preferably, the requester should quote the pertinent teachings in the reference, referencing each quote by page, column and line number, and any relevant figure numbers. The explanation **must not** lump together the proposed rejections or proposed combinations of references. See MPEP 2617.

¹ MPEP 2616 points out that: "It is not sufficient that a request for reexamination merely proposes one or more rejections of a patent claim or claims as a basis for reexamination. It must first be demonstrated that a patent or printed publication that is relied upon in a proposed rejection presents a new, non-cumulative technological teaching that was not previously considered and discussed on the record during the prosecution of the application that resulted in the patent for which reexamination is requested, and during the prosecution of any other prior proceeding involving the patent for which reexamination is requested." [Emphasis added] The legislative history of the reexamination statute also provides that: "Section I provides for a system of administrative reexamination of patents within the patent office. This new procedure will permit any party to petition the patent office to review the efficacy of a patent, subsequent to its issuance, on the basis of new information about preexisting technology which may have escaped review at the time of the initial examination of the patent application." H.R. Rep. No. 96-1307, 96th Cong., 2d Sess. 3 (1980), reprinted in 1980 U.S.C.C.A.N. 6460, 6461, 6462.

² 35 U.S.C. 311(b) states in pertinent part:

"(b) REQUIREMENTS.- The request shall-

(2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested. ..."

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I. The request is incomplete as to compliance with 37 CFR 1.915(b)(3) for the following reason:

The request is not clear as to the proposed rejections that are being set forth, because it fails to provide a clear identification and explanation of the proposed rejections, due to the lumping together of multiple proposed rejections.

Specifically, the request lumps together multiple distinct proposed rejections, identified under subheadings 9-12 on pages 57-69 of the request, and provides a single explanation for these multiple distinct proposed rejections. For example, the proposed rejection, identified under subheading 10, is stated as:

"Claims 5-8, 10-11, 20-23, 27-29, and 31-32 of the '656 patent are unpatentable under 35 U.S.C. § 103(a) over Puderbaugh (US 6,026,807) and Foley (US 5,645,049), Sabo (US 5,501,214) or Daleiden (US 5,109,840) in view of Smith, Schmidt or Sladek."

See page 64 of the request. The above-quoted statement identifies multiple, distinct proposed rejections. For example, the following proposed rejections are identified by the above-quoted statement:

1. Claims 5-8, 10-11, 20-23, 27-29, and 31-32 of the '656 patent are unpatentable under 35 U.S.C. § 103(a) over Puderbaugh (US 6,026,807) and Foley (US 5,645,049) in view of Smith;
2. Claims 5-8, 10-11, 20-23, 27-29, and 31-32 of the '656 patent are unpatentable under 35 U.S.C. § 103(a) over Puderbaugh (US 6,026,807) and Foley (US 5,645,049) in view of Schmidt;
3. Claims 5-8, 10-11, 20-23, 27-29, and 31-32 of the '656 patent are unpatentable under 35 U.S.C. § 103(a) over Puderbaugh (US 6,026,807) and Foley (US 5,645,049) in view of Sladek;
4. Claims 5-8, 10-11, 20-23, 27-29, and 31-32 of the '656 patent are unpatentable under 35 U.S.C. § 103(a) over Puderbaugh (US 6,026,807) and Sabo (US 5,501,214) in view of Smith;
5. Claims 5-8, 10-11, 20-23, 27-29, and 31-32 of the '656 patent are unpatentable under 35 U.S.C. § 103(a) over Puderbaugh (US 6,026,807) and Sabo (US 5,501,214) in view of Schmidt;
6. Claims 5-8, 10-11, 20-23, 27-29, and 31-32 of the '656 patent are unpatentable under 35 U.S.C. § 103(a) over Puderbaugh (US 6,026,807) and Sabo (US 5,501,214) in view of Sladek;
7. Claims 5-8, 10-11, 20-23, 27-29, and 31-32 of the '656 patent are unpatentable under 35 U.S.C. § 103(a) over Puderbaugh (US 6,026,807) and Daleiden (US 5,109,840) in view of Smith;
8. Claims 5-8, 10-11, 20-23, 27-29, and 31-32 of the '656 patent are unpatentable under 35 U.S.C. § 103(a) over Puderbaugh (US 6,026,807) and Daleiden (US 5,109,840) in view of Schmidt; and
9. Claims 5-8, 10-11, 20-23, 27-29, and 31-32 of the '656 patent are unpatentable under 35 U.S.C. § 103(a) over Puderbaugh (US 6,026,807) and Daleiden (US 5,109,840) in view of Sladek.

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Thus, the request fails to clearly and separately identify each proposed rejection.

Furthermore, the request only provides a single combined explanation for these multiple distinct proposed rejections. See, e.g., pages 64-67. Therefore, all of the proposed rejections set forth on page 64 of the request are supported by only a single explanation. Similarly, proposed rejections identified under subheading 9 (pages 57-63 of the request), proposed rejections identified under subheading 11 (pages 67-68 of the request), and proposed rejections identified under subheading 12 (pages 68-69 of the request) lump together the identification and explanation of multiple, distinct proposed rejections.

In addition, because of the lumping together of the identification of multiple distinct proposed rejections and the corresponding detailed explanations, the explanations provided for the obviousness proposed rejections are unclear as to what claim limitations the primary reference teaches, what claim limitations are not taught by the primary reference, what claim limitations are taught by the secondary reference, and why it would have been obvious to the skilled artisan to make the stated combination. For example, the explanation for proposed rejection 10 on pages 64-67 lists the relevant teachings in each cited reference for each claim limitation, but does not provide any clear explanation of which teachings are combined and how the teachings are combined to result in the claimed invention. When references are combined in a proposed rejection, the references must be explicitly set forth and applied under 35 U.S.C. 103(a), and the detailed explanation must provide proposed rejections that make the required showing under 35 U.S.C. 103(a). See MPEP 2617. Therefore, the requester has not provided a detailed explanation of how the references apply to every claim '656 patent in *each* of the proposed rejections.

The requester should choose the most relevant proposed rejections, and clearly identify and explain them. The requester should withdraw any remaining proposed rejections which are not clearly and separately identified, and for each of which a separate detailed explanation has not been provided. The requester cannot lump together multiple identifications and explanations of different proposed rejections, and expect the Office to guess at which references are to be combined, the manner they are to be combined, and how each reference contributes to the combination what it may be asserted to contribute.

Accordingly, the requester has not provided a detailed explanation of how the references apply to every claim '656 patent in *each* of the proposed rejections.

As a result of the above-mentioned defects, the request fails to provide a "statement pointing out each substantial new question of patentability based on the cited patents and printed publications, and a detailed explanation of the pertinency and manner of applying the patents and printed publications to every claim for which reexamination is requested," as is required by 37 CFR 1.915(b)(3).

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Each substantial new question of patentability (SNQ) asserted to be raised and proposed ground of rejection must be identified separately.³ The patent claims applying to each identified SNQ and proposed rejection must be listed. Then, for each identified proposed rejection, the request must explain how the cited documents identified for that proposed rejection are applied to meet/teach the claim limitations for each listed claim, to thus establish the identified proposed rejection.

If the requester were permitted to omit an identification of each SNQ and an explanation of how such documents cited in the request are applied to the patent claims, an undue burden would be placed on the Office to address each document in the determination on the request, without an explanation of the relevance to the patent claims. Accordingly, such an omission is prohibited by law.

Other issue:

The request contains text that is extremely small and is effectively illegible and not reproducible. See, e.g., page 13 of the request. 37 CFR 1.52(a) (1) states that submissions must be legible and presented in a form having sufficient clarity and contrast between the paper and writing to allow for direct reproduction and be sufficiently clear for electronic capture by use of digital imaging and optical character recognition (OCR). Any corrected request should be filed in a font size no smaller than 12-point and should be one-and-a-half or double-spaced.

REQUESTER'S RECOURSE

In view of the August 26, 2009 "Notice of Reexamination Request Filing Date" mailed for the '216 proceeding, the requester is given one opportunity to correct the request.⁴

I. Requester's Response

Requester has the option to respond to this identification of defects in the request papers by applying the appropriate option(s) set forth below:

³ "Shot-gun" statements, or lumping of multiple SNQ/rejection permutations together is **not permitted**. See MPEP 2617.

⁴ MPEP 2627, part B.1, states (emphasis added): "After a filing date and control number are assigned to the request papers, the examiner reviews the request to decide whether to grant or deny reexamination. If, in the process of reviewing the request, the examiner notes a non-compliance item not earlier recognized, the examiner will forward a memo to his/her CRU Supervisory Patent Examiner (SPE) detailing any such non-compliance item(s)... Upon confirmation of the existence of any such non-compliant item(s), OPLA will issue a decision vacating the assigned reexamination filing date. In OPLA's decision, the requester will be notified of the non-compliant item(s) **and given time to correct the non-compliance**. ... [A]bsent extraordinary circumstances, requester will only be **given one opportunity to correct the non-compliant item(s)** identified in the Decision Vacating Filing Date."

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- 1) Providing an explanation of the manner and pertinence of applying each cited document to the patent claims for which reexamination is requested, as required by 37 CFR 1.915(b)(3). For each identified proposed rejection, the request must explain how the cited documents identified for that proposed rejection are applied to meet/teach the claim limitations for each listed claim, to thus establish the identified proposed rejection. Where references are applied in combination, **each combination must be individually identified**, and for each separately identified combination of references, **the basis for forming that combination must be supplied for each claim** to which the identified combination is being applied.
- 2) Explicitly withdrawing any document for which such an explanation is not to be provided for the patent claims, and submitting a new listing confined to the documents for which a discussion required by 37 CFR 1.915(b)(3) has been provided via the request papers. As to any of the documents withdrawn, if reexamination is ultimately ordered, the patent owner may, in accordance with MPEP 2280, submit an Information Disclosure Statement (IDS) in compliance with 37 CFR 1.555 "within two months of the date of the order granting reexamination, or as soon thereafter as possible."
- 3) Explicitly withdrawing the request to reexamine any patent claim for which the requisite identification of the SNQ and explanation of proposed rejection are not provided, and replacing the presently-of-record listing (in the deposited request) of the claims for which reexamination is requested - with a new listing of claims for which reexamination is requested, the new identification *being confined to those claims for which the discussion required by 37 CFR 1.915(b)(3) is provided*.
- 4) Withdrawing any proposed combination or application of a sole reference for which an explanation as required by 37 CFR 1.915(b)(3) is not provided, by replacing the presently-of-record identification of the SNQ and explanation of proposed rejection with *a new identification of the SNQ and explanation of proposed rejection*, the new identification and explanation *being confined to those claims for which the discussion required by 37 CFR 1.915(b)(3) is provided*.
- 5) Addressing the other issue concerning the small font size used in the request by filing a corrected request with font size no smaller than 12-point and text that is one-and-a-half or double-spaced.

The requester is reminded that the corrected request (including all supporting documents such as the listing of references, copies of the references, appendices, etc...) must be served on the patent owner at the current correspondence address under 37 CFR 1.33(a) **in the patent record at the time the corrected request is filed**, or alternatively, if such service cannot be made, providing an explanation of the efforts taken to provide service and why those efforts were not successful, and a second copy of the request papers. See MPEP 2614 for more information regarding service.

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II. Time Period for Response

In order to obtain a filing date for the request papers, the requester must, within thirty (30) days of the mailing date of this decision, file a response to this decision which makes the request papers filing date compliant. The response may be supplied as either a corrected request, or a submission of only the missing information.

The response may be mailed to the Central Reexamination Unit (CRU), attn: "Box *Inter Partes* Reexam" at the USPTO address indicated below, or hand carried to the CRU at the address indicated below. A replacement statement and explanation under 37 CFR 1.915(b)(3) must not be facsimile transmitted. It is strongly suggested that any response be followed up by a telephone call to the Central Reexamination Unit at (571) 272-7705, as soon as possible.

The requester has one opportunity to make the request papers filing date compliant. If the response to this decision fails to cure the defect(s) identified in this decision or adds a new defect, then processing of the request papers will be terminated, and the request papers will either be discarded or treated as a prior art citation under 37 CFR 1.501, at the Office's option.

If the request papers are made filing date compliant, the date of the receipt of the response will be the filing date of the reexamination proceeding.

CONCLUSION

1. The filing date assigned to the request papers for *inter partes* reexamination proceeding Control No. 95/001,216 is hereby vacated for failure of the request papers to comply with the filing date requirements for an *inter partes* reexamination proceeding, as set forth in 37 CFR 1.915(b)(3).
2. In order to obtain a filing date for the request papers, the requester must, within thirty (30) days of the mailing date of this decision, file a response to this decision which makes the request papers filing-date compliant, pursuant to the guidelines set forth above.
3. The requester is being provided with only one opportunity to make the request papers filing-date compliant. *If the response to this decision fails to cure the defects identified in this decision, or adds a new defect, processing of the request papers will be terminated*, and the request papers will either be discarded or treated as a prior art citation under 37 CFR 1.501, at the Office's option. If the request papers are made filing date compliant, then the date of the receipt of the response will be the filing date of the reexamination proceeding.

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4. Jurisdiction over the present *inter partes* reexamination request papers is being retained in the Office of Patent Legal Administration pending response to this decision, or the expiration of time to respond.

5. Any response to this decision should be directed to:

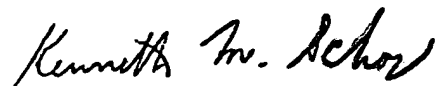
By EFS: Registered users may submit the response via the electronic filing system EFS-Web, at:
<https://portal.uspto.gov/authenticate/authenticateuserlocalepf.html>

By Mail: Mail Stop "Inter Partes Reexam"
Attn: Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

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

It is strongly suggested that any such response be followed up by a telephone call to the Central Reexamination Unit at (571) 272-7705, as soon as possible, to ensure receipt and processing.

6. Telephone inquiries related to this decision should be directed to Andy Kashnikow, Supervisory Patent Examiner, at (571) 272-4361, or Jeanne Clark at (571) 272-7714, or in their absence, to Legal Advisors, Cynthia Nessler at (571) 272-7724, or Pinchus M. Laufer at (571) 272-7726.



Kenneth M Schor
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