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| Transmittal of Communication to Third Party Requester Inter Partes Reexamination | Control No. | Patent Under Reexamination |
| | 95/002,041 | 7634504 |
| | Examiner | Art Unit |
| | DAVID ENGLAND | 3992 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address. --

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

**OFFICE ACTION IN INTER PARTES
REEXAMINATION**

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| Control No. | Patent Under Reexamination |
| 95/002,041 | 7634504 |
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Responsive to the communication(s) filed by:

Patent Owner on _____

Third Party(ies) on 16 July, 2012

RESPONSE TIMES ARE SET TO EXPIRE AS FOLLOWS:

For Patent Owner's Response:

2 MONTH(S) from the mailing date of this action. 37 CFR 1.945. EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.956.

For Third Party Requester's Comments on the Patent Owner Response:

30 DAYS from the date of service of any patent owner's response. 37 CFR 1.947. NO EXTENSIONS OF TIME ARE PERMITTED. 35 U.S.C. 314(b)(2).

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

This action is not an Action Closing Prosecution under 37 CFR 1.949, nor is it a Right of Appeal Notice under 37 CFR 1.953.

PART I. THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892
2. Information Disclosure Citation, PTO/SB/08
3. _____

PART II. SUMMARY OF ACTION:

- 1a. Claims 1-18 are subject to reexamination.
- 1b. Claims _____ are not subject to reexamination.
2. Claims _____ have been canceled.
3. Claims _____ are confirmed. [Unamended patent claims]
4. Claims _____ are patentable. [Amended or new claims]
5. Claims 1-18 are rejected.
6. Claims _____ are objected to.
7. The drawings filed on _____ are acceptable are not acceptable.
8. The drawing correction request filed on _____ is: approved. disapproved.
9. Acknowledgment is made of the claim for priority under 35 U.S.C. 119 (a)-(d). The certified copy has:
 been received. not been received. been filed in Application/Control No 95002041.
10. Other _____

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INTER PARTE REEXAMINATION NON-ACTION CLOSING PROSECUTION

I. INTRODUCTION

This is an *Inter Parte* Reexamination of U.S. Patent No. 7634504, hereinafter '504 Patent. In the attached Order granting the request, the Examiner determined that the third party requester, hereinafter Requester, has shown a reasonable likelihood of prevailing ("RLP") in its proposed rejection of claims 1 – 18 of the '504 Patent in the request filed July, 16, 2012, hereinafter "The Request". Claims 1- 18 will be reexamined. See MPEP 2658(IV)(B).

A. References Cited in this Office Action

1. The prior art patents and/or printed publications, hereinafter "the references", which are listed in form PTO—1449 filed July 16, 2012, have been considered and are relied upon in this Office Action are relisted as follows.

- a. U.S. Patent No. 6851621 to Wacker et al., hereinafter Wacker, issued February 8, 2005.
- b. U.S. Patent No. 5065813 to Berkeley et al., hereinafter Berkeley, issued November 19, 1991.
- c. Slovenian Publication SI 20556 (translated) to Rován, hereinafter Rován, published October 31, 2001. This reference was not specifically cited in the PTO-1449 IDS, but has been supplied, by the Requester and therefore will be cited in a PTO-892 to complete the record.

II. REJECTIONS

A. Relevant Statutes – Claim Rejections

1. *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

B. Detailed Analysis of the Rejection

1. **Claims 1 – 18** are rejected under 35 U.S.C. 102(e) as being anticipated by **Wacker**. This rejection was proposed by the Requester and as analyzed in the accompanied Order as PR1, is

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adopted. See the Request's Claim chart pp. 11 – 30, which is incorporated by reference as to these claims.

2. **Claims 2, 11 and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Wacker** in view of **Rovan**. This rejection was proposed by the Requester and as analyzed in the accompanied Order as PR1, and is adopted with regards to claims 2, 11 and 17. See the Request's Claim chart pp. 11 – 30, which is incorporated by reference as to these claims.

3. **Claims 1 – 3 and 6 – 18** are rejected under 35 U.S.C. 102(b) as being anticipated by **Berkeley**. This rejection was proposed by the Requester and as analyzed in the accompanied Order as PR3, is adopted. See the Request's Claim chart pp. 30 – 46, which is incorporated by reference as to these claims.

4. **Claims 4 and 5** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Berkeley** in view of **Wacker**. This rejection was proposed by the Requester and as analyzed in the accompanied Order as PR4, is adopted. See the Request's Claim chart pp. 30 – 46, which is incorporated by reference as to these claims.

III. CONCLUSION

1. Information Disclosure Statement (IDS)

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The Information Disclosure Statement filed 07/16/2012 is considered on the attached signed sheets.

2. In order to ensure full consideration of any amendments, affidavits or declarations, or other documents as evidence of patentability, such documents must be submitted in response to this Office action. Submissions after the next Office action, which is intended to be a final action, will be governed by the requirements of 37 CFR 1.116, after final rejection and 37 CFR 41.33 after appeal, which will be strictly enforced.

3. Any paper filed with the USPTO, i.e., any submission made, by either the Patent Owner or the Third Party Requester must be served on every other party in the reexamination proceeding, including any other third party requester that is part of the proceeding due to merger of the 'reexamination proceedings. As proof of service, the party submitting the paper to the Office must attach a Certificate of Service to the paper, which sets forth the name and address of the party served and the method of service. Papers filed without the required Certificate of Service may be denied consideration. 37 CFR 1.903; MPEP 2666.06.

4. Any proposed amendment to the specification and/or claims in this reexamination proceeding must comply with 37 CFR 1.530(d)-(j), must be formally presented pursuant to 37 CFR 1.52(a) and (b), and must contain any fees required by 37 CFR 1.20(c). Amendments in an *interpartes* reexamination proceeding are made in the same manner that amendments in an *ex*

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parte reexamination are made. MPEP 2666.01. See MPEP 2250 for guidance as to the manner of making amendments in a reexamination proceeding.

5. Extensions of time under 37 CFR 1.136(a) will not be permitted in *interpartes* reexamination proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to the patent owner in a reexamination proceeding. Additionally, 35 U.S.C. 314(c) requires that *interpartes* reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.937). Patent owner extensions of time in *interpartes* reexamination proceedings are provided for in 37 CFR 1.956. Extensions of time are not available for third party requester comments, because a comment period of 30 days from service of patent owner's response is set by statute. 35 U.S.C. 314(b)(3).

6. The patent owner is reminded of the continuing responsibility under 37 CFR 1.985(a), to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving the '504 patent undergoing reexamination or any related patent throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability, to similarly inform the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP § 2686 and 2686.04.

Service of Papers

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All correspondence related to this Inter Parte reexamination proceeding should be directed:

By EFS: Registered users may submit via the electronic filing system EFS-Web, at <https://efs.uspto.gov/efile/myportal/efs-registered>

By Mail to: Mail Stop Inter Parte Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone numbers for reexamination inquiries:

Reexamination and Amendment practice: (571) 272-7703

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Central Reexamination Unit (CRU): (571) 272-7705

Any inquiry concerning this communication or earlier communications from the examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

/David E. England/
Primary Examiner, Art Unit 3992

Conferees: /r.g.f./
 /d.j.r./