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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,375	12/31/2008	6202649	004859.00063	9970

22907 7590 10/01/2010

BANNER & WITCOFF, LTD.
1100 13th STREET, N.W.
SUITE 1200
WASHINGTON, DC 20005-4051

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 10/01/2010

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
Chicago, IL 60610

Date:
MAILED

OCT 01 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90009375
PATENT NO. : 6202649
ART UNIT : 3991

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**

OCT 01 2010

Brinks Hofer Gilson & Lione
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Chicago, IL 60610

CENTRAL REEXAMINATION UNIT
(For Third Party Requester)

In re Williams et al.
Ex Parte Reexamination Proceeding
Control No. 90/009375
Request Deposited: December 31, 2008
For: U.S. Patent No. 6,202,649

: DECISION ON PETITION
: TO REOPEN
: REEXAMINATION
: PROCEEDING
:

This is a decision on the May 14, 2010 "Petition to reopen reexamination proceeding" and the May 17 "Supplemental petition to reopen reexamination proceeding".

The petition is before the Director of the Central Reexamination Unit for reconsideration.

For the reasons set forth below, the petition is **GRANTED IN PART**.

BACKGROUND

1. On September 11, 2009, a non-final action was mailed in this proceeding.
2. On October 22, 2009, an in-person interview was held with Examiners Jones, Ponnaluri and Brumback and Patent Owner's representatives Hoscheit, Rivard, McMillan and Lee.
3. According to the petition, a proposed agenda was faxed to Examiner Brumback on October 21, 2009.¹

¹ It is noted that MPEP 2281 indicates that patent owner must file an informal written statement of the issues to be discussed at the interview at least three days prior to the interview. The facsimile transmission is understood to be the document attached to the petition of May 14, 2010. In view of the history of this case, the examiner should adhere to the three-day requirement in this proceeding and any related proceedings.

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4. This interview was memorialized on the part of the USPTO by the interview summary of 10/22/2009.

5. Patent Owner responded to the non-final rejection on November 10, 2009. That communication included the following statement:

The courtesy extended by Examiners Brumback, Ponnelluri and Jones at the interview of October 22, 2009 is gratefully acknowledged. That interview was attended by Mr. Paul Rivard, Mr. Richard McMillan, Dr. Richard J. Lee, as well as the undersigned on behalf of the patentee. The matters discussed at the interview are reflected in the Outline for Interview Summary (previously made of record), as well as in following comments in response to the Office Action. Claim 41 of U.S. Patent 6,425,401 ("the '401 patent") is presently under reexamination.

6. No Brief Outline for Interview is present in the electronic record until the petition of May 12, 2010.

7. On May 12, 2010, a Notice of Intent to Issue a Reexamination Certificate was mailed, indicating that the proceeding was terminated due to failure to file a summary of the interview as required by 37 CFR 1.550(d) and 1.560(b).

DECISION

Initially, it is noted that the petition of May 12, 2010 seeks review in the alternative.

37 CFR 1.4(c) states:

Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

The petition has been treated under 37 CFR 1.181 as a petition to reopen prosecution.

To the extent that Patent Owner "alternatively petitions" for revival due to unintentional delay, said request is **dismissed** under 37 CFR 1.4(c) since that different matter is considered by a different branch or section of the office.

37 CFR 1.550(d) states:

If the patent owner fails to file a timely and appropriate response to any Office action or any written statement of an interview required under § 1.560(b), the prosecution in the ex parte reexamination proceeding will be a terminated prosecution, and the Director will proceed to issue and publish a certificate concluding the reexamination proceeding under § 1.570 in accordance with the last action of the Office.

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37 CFR 1.560(b) states:

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.

MPEP 2281 states, in part:

If the examiner agrees to grant the interview, the patent owner must file, at least three (3) working days prior to the interview, an informal written statement of the issues to be discussed at the interview, and an informal copy of any proposed claims to be discussed, unless examiner waives this requirement. The copy of these materials is to be submitted by facsimile transmission (FAX) directly to the examiner or hand-carried to the examiner so as to avoid the possibility of delay in matching the materials with the file. The informal copies that are considered by the examiner will be made of record in the reexamination proceeding as an attachment to the Interview Summary form PTOL-474 completed by the examiner after the interview. These preliminary steps are for the purpose of providing structure to the interview so as to facilitate the statutory mandate for special dispatch.

...

In every instance of an interview with the examiner, a patent owner's statement of the interview, including a complete written statement of the reasons presented at the interview as warranting favorable action, must be filed by the patent owner.

MPEP 2281 makes clear that the “informal written statement of the issues **to be discussed**” and the “complete written statement of the reasons **presented**” (emphasis added) are different documents with different purposes. It is conceptually possible that an interview would consist of patent owner representatives simply reading the “informal written statement” to the examiners and leaving; such does not appear to be contemplated.

In the response to the non-final rejection, Patent Owner refers to the “informal written statement” and the interview itself, but gives no other summary of the interview.

It is noted that the “informal written statement” is quite detailed and at least some of the items discussed in the contemporaneous interview summary are clearly within the “informal written statement”. For example, “the processes by which TSNA's were formed were not completely understood” in the examiner's interview summary is adequately described by page 7 of the “informal written statement” discussion of the contribution from bacteria to the formation of

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TSNA being unclear. However, other items – such as the discussion of wet bulb methods and the litigation documents – do not appear to be documented.

Rule 560 and MPEP 2281 require an after-the-fact summary of the interview. In the typical case, an agenda prepared before the fact is not sufficient to capture all that is discussed. To the extent that an “informal written statement” captures all that was discussed, a copy of that document might be sufficient.

In order to resolve this issue, the Notice of Intent to Issue a Reexamination Certificate of May 12, 2010 is **vacated**; however, no finding is made on whether the proceeding is terminated as described in 37 CFR 1.550(d).

Based on the record, the document attached to the petition of May 14, 2010 was the “informal written statement” and was submitted before the interview on October 21, 2009. The examiner’s interview summary record of October 22, 2009 was prepared after the interview and given to patent owner’s representative. To the extent that the examiner’s interview summary contained no information not already in the “informal written statement”, it may have been reasonable for the patent owner to simply submit a copy of the “informal written statement”.

Patent owner is given a period of 30 days to either (a) show where **each** item in the examiner’s interview summary is described in the “informal written statement” and/or (b) file a petition for revival for unintentional/unavoidable delay together with an appropriate interview summary. In the event no response is filed, the NIRC will be reissued and the proceeding returned to publications.

In view of the above, the petition is **GRANTED-IN-PART**.

CONCLUSION

1. Patent Owner’s May 14, 2010 petition is **GRANTED-IN-PART**.
2. Patent owner is given a period of 30 days to (a) show where **each** item in the examiner’s interview summary is described in the “informal written statement” and/or (b) file a petition for revival for unintentional/unavoidable delay together with an appropriate interview summary. In the event no sufficient response is filed, the NIRC will be reissued and the proceeding returned to publications.
3. Prosecution is not reopened at this time.
4. **All** correspondence relating to this *inter partes* reexamination proceeding should be directed:

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

By Mail to: Mail Stop *Inter Partes* Reexam
Attn: 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

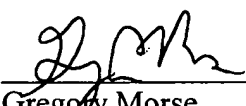
By hand: Customer Service Window
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Alexandria, VA 22314

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

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.

3. This decision is not a final agency decision and is without prejudice to a request for reconsideration or higher-level review.

4. Telephone inquiries related to this decision should be directed to Jessica Harrison, at (571) 272-4449 or, in her absence, to the undersigned.



Gregory Morse
Director, Center Reexamination Unit