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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,206	08/19/2009	7272021	36856.1613	6964

24197 7590 04/19/2011
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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 04/19/2011

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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**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NUMBER 95/001,206.

PATENT NUMBER 7272021.

TECHNOLOGY CENTER 3999.

ART UNIT 3992.

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.



MAILED

APR 19 2011

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In re: Schlecht et al.
Inter Partes Reexamination Proceeding : DECISION ON PETITION
Control No.: 95/001,206 : UNDER 37 CFR § 1.181
Deposited: August 19, 2009
For: U.S. Patent No.: 7,272,021

This is a decision on a petition filed by the patent owner on August 31, 2010 entitled:
“PETITION UNDER 37 C.F.R.. § 1.181 TO STRIKE THIRD PARTY REQUESTER’S
AUGUST 23, 2010 COMMENTS” [hereinafter “the Petition”].

The petition is a request to the Director to exercise his supervisory authority pursuant to 37 CFR
§ 1.181 to strike the allegedly improper comments from the record.

The petition is before the Director of the Central Reexamination Unit. The petition is denied.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,272,021 issued on September 18, 2007.
- A request for *inter partes* reexamination was filed on August 19, 2009 and assigned control no. 95/001,206.
- *Inter partes* reexamination was ordered on October 15, 2009 and a non-final rejection was mailed on March 5, 2010.
- On June 10, 2010, patent owner filed a paper responding to the Office action. The certificate of service states it was served on the third party on June 7. The paper was longer than permitted by rule, but was filed with a petition to waive the page limit.
- On August 11, 2010, the Office of Patent Legal Administration issued a decision granting the petition and waiving the page limit, thereby making the response a complete and compliant response. The decision stated the third party had 30 days from the decision date to file comments.
- On August 23, 2010, the third party submitted comments.
- On August 31, 2010, patent owner filed the instant petition.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

35 U.S.C. § 314 Conduct of inter partes reexamination proceedings (in part)

(b) RESPONSE. —

* * *

(2) Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

37 C.F.R. § 1.943 Requirements of responses, written comments, and briefs in *inter partes* reexamination (in part)

(b) Responses by the patent owner and written comments by the third party requester shall not exceed 50 pages in length, excluding amendments, appendices of claims, and reference materials such as prior art references.

MPEP § 2666.05 Third Party Comments After Patent Owner Response (in part)**I. TIMELINESS**

A third party requester may once file written comments on any patent owner response to an Office action, during the examination stage of an *inter partes* reexamination proceeding. The third party requester comments must be filed within a period of 30 days from the date of service of the patent owner's response on the third party requester. 37 CFR 1.947. . . . If the third party requester comments are filed after 30 days from the date of service of the patent owner's response on the third party requester, the comments will not be considered. See 37 CFR 1.957(a).

The following special circumstance is to be noted. In unique circumstances, it may happen that a patent owner files a response to an Office action and the page length of the response exceeds the page length set by 37 CFR 1.943(b). Accompanying the response is a petition under 37 CFR 1.183 requesting waiver of the 37 CFR 1.943(b) requirement. Until such a 37 CFR 1.183 petition to waive the page length is granted, or a page length compliant response is filed (if the 37 CFR 1.183 petition is not granted), the patent owner response is incomplete. Pursuant to MPEP § 2666.40, "[a]fter the owner completes the response, the examiner will wait two months from the date of service of the patent owner's completion of the response, and then take up the case for action, since the 30 days for the third party requester comments on the response as completed will have expired by that time. The third party requester may file comments on the response as completed . . . The response as completed is treated as a new response on-the-merits to the Office action; thus, the third party requester is entitled to file comments and has 30 days to do so." Based on the above, at the time the 37 CFR 1.183 petition is granted, the patent owner response becomes complete with its content being set in place, and the requester has 30 days from the date of the decision granting the 37 CFR 1.183 petition to file a comment paper pursuant to 37 CFR 1.947.

DECISION

Patent owner [“petitioner”] argues that the third party requester’s comments filed August 23, 2010 are improper because they were not timely filed. Petitioner argues that the statute requires comments to be filed within 30 days of service of the owner’s response. Service is the only triggering event in the statute starting the 30 day time period, not the time of a response becoming complete or compliant, therefore it was improper for the Office to grant 30 days from the date of the decision waiving the page limit. The MPEP is not law, and cannot contravene the clear and unambiguous language of the statute. As service was performed June 7th, and the comments were not received until August 23rd, they were not timely, says petitioner.

These arguments are not persuasive. While it is true that the triggering event in the statute is “service,” it is also true that the service must be of a “patent owner’s response.” The term “response” is not defined in the statute, but it is implicit that the term refers only to properly compliant responses. It does not make sense for statutory requirements to be triggered by the filing of something that, on its face, is improper. Furthermore, as “response” is not defined, it is left to the Office as the agency administering the statute to interpret and define the term. As codified in the regulations, 37 CFR § 1.943 states that “Responses by the patent owner . . . shall not exceed 50 pages in length.” A “response” is therefore interpreted and defined by the Office at least as a paper that does not exceed 50 pages in length. As Congress failed to define “response” in the statute, the Office is free to interpret and further define the term in its regulations.

Thus, at the time the paper was filed, at the time of service, the paper was not a “response” within the meaning of the statute, and therefore the time period was not yet triggered. Only after the Office waived the page limit requirement, in effect altering its definition in this case, did there exist a patent owner’s response. While service was made earlier, it was not effected until the waiver of the page limit because it was not until that date that there was a patent owner’s response. The effective date of “service of the patent owner’s response” under 35 U.S.C. § 314(b)(2) was therefore the date of the decision waiving the page limit requirement, and it was proper for the Office to grant 30 days from that date for the filing of comments.

Petitioner has not shown that the Office’s interpretation is unreasonable, and as shown above the statute is not clear and unambiguous in petitioner’s favor. The Director sees no need to alter the Office’s interpretation of the statute in this situation, which is already explicitly set forth in MPEP 2666.05 as quoted above, and the present situation is directly in accord with the MPEP. The entry of the comments paper is therefore in accord with Office policy. Accordingly, the petition is denied.

CONCLUSION

1. The petition filed August 31, 2010 is denied. The third party comments filed August 23, 2010 are not expunged from the record.
2. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.



Irem Yuçel
Director, Central Reexamination Unit