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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 08/21/2009

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



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Washington, D.C. 2005

(For Patent Owner)

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AUG 21 2009
CENTRAL REEXAMINATION UNIT

Morrison & Foerster, LLP
555 West Fifth Street, Suite 3500
Los Angeles, CA 90013

(For Requester)

In re Barton et al. :
Reexamination Proceeding : DECISION ON PETITION
Control No.: 90/009,329 : UNDER 37 CFR 1.181
Filed: November 10, 2008 :
For: U.S. Patent No. 6,233,389 :

This is a decision on a petition filed by the patent owner on May 27, 2009 and third-party requester's opposition thereto. The petition is entitled "PETITION OF PATENT OWNER UNDER 35 USC §§ 1.181, 182 and/or 37 CFR 1.183..." [hereinafter "the petition"] and the opposition is titled "OPPOSITION TO PATENT OWNER'S PETITION TO VACATE..." [hereinafter "the opposition"]. The petition is treated as a petition under 37 CFR § 1.181 to invoke the supervisory authority of the director.

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

The petition is dismissed with respect to vacating the order under 37 CFR § 1.181.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 6,233,389 issued on May 15, 2001.
2. A request for *ex parte* reexamination of that patent, Control No. 90/007,750 ("the '750 proceeding"), was filed by a third party requester on October 17, 2005.
3. In the '750 proceeding, a substantial new question of patentability was found with respect to U.S. Patent 6,304,714 to Krause et al. (Order of December 15, 2005).

4. In the '750 proceeding, U.S. Patent 6,018,612 to Thomason et al. was cited along with many other references in an information disclosure statement on March 7, 2006. The citation was later initialed by the examiner.
5. The present request for reexamination ("the '329 proceeding") was filed November 10, 2008. Reexamination of Claims 31 and 61 was requested in light of the Krause and Thomason patents.
6. The electronic record of the '750 proceeding indicates that a certificate confirming the patentability of Claims 1-61 issued on November 11, 2008.
7. On January 7, 2009, reexamination was ordered in the '329 proceeding. A substantial new question of patentability was found with respect to a combination of the Krause and Thomason patents (page 2).
8. The petition was filed by patent owner on May 27, 2009.
9. The opposition was filed by third-party requester on June 10, 2009.

DECISION

The present petition asks the USPTO to vacate the order of January 7, 2009. An order granting reexamination is not a final agency action but is a determination that proceedings are to begin. See *Heinl v. Godici*, 143 F. Supp. 2d 593, 597 (observing that the decision to grant reexamination "is an intermediate, indeed initial, step in the agency process to resolve the question of the validity of a patent", and confirming that such a decision is not subject to judicial review.)

Because this is ultimately an appealable issue, rather than an issue that is appropriately resolved by petition. Patent owner's proper recourse now is through response to any action on the merits.

Nonetheless, taken as a request for supervisory review, patent owner has not demonstrated error by the examiner.

The Thomason reference, while cited in the '750 proceeding, was not discussed by the examiner in that proceeding. In 2002, 35 USC § 303 was amended to read "The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office" (emphasis added). In the facts of the '329 proceeding, the Thomason reference was previously cited to the office along with

roughly 200 other documents, but not discussed by the examiner¹. This is highlighted on page 2 of the opposition to this petition.

Patent owner asserts that “Statements such as those made by Primary Examiners Harvey and Escalante when allowing claims over cited references must be taken objectively, at their face value: that they considered all portions of the cited references they said were considered, and that they determined that those references do not invalidate the claims for the expressly stated reasons. In other words, examiners should not be forced to discuss in detail every single cited reference by name.” While Patent Owner has demonstrated that the references were considered by the Office, that alone fails to prohibit reexamination given section 303’s express language that such prior consideration does not preclude the existence of a substantial new question.

Previously, the rule set forth in *In re Portola Packaging* might have forbidden a reexamination under these circumstances.

“Therefore, it must be presumed that the original examiner considered the Faulstich and Hunter patents, both alone and in combination with each other and with all of the other cited references, before allowing the original claims... Whether the earlier examination was correct or not, reexamination of the same claims in light of the same references does not raise a substantial new question of patentability, which is the statutory criterion for reexamination.” (*In re Portola Packaging*, 110 F.3d 786)

However, the 2002 amendment to 35 USC § 303 reflected a deliberate decision by Congress to overrule this decision. As such, a second reexamination may be ordered on references previously cited and/or considered. This change was discussed in *In re Swanson*.

Thus, under § 303(a) as amended, a reference may present a substantial new question even if the examiner considered or cited a reference for one purpose in earlier proceedings. Nothing in the statute creates an exception to this rule for references considered in the context of a rejection of prior claims. Indeed, such an exception would overwhelm the rule and thwart a central purpose of the amendment, to overrule *In re Portola Packaging*. In that case, as here, the issue was whether a piece of prior art relied on for a prior rejection could nevertheless create a new question of patentability sufficient to warrant a reexamination. (*In re Swanson*, 540 F. 3d 1368 (Fed. Cir. 2008))

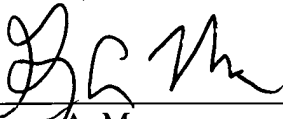
As the order granting reexamination identifies what feature was not found in the ‘750 reexamination (page 4), where those elements are shown in the Thomason reference (page 6), and concludes that this feature would be important to a reasonable examiner (page 8), and as the 2002 amendment to 35 USC § 303 makes clear that references already of record may be used to find that a substantial new question of patentability is present, the decision of the examiner has not been shown to be in error.

¹ A review of the record of the ‘750 proceeding did not reveal any specific discussion of Thomason. If such a discussion exists it should be brought to the attention of the Office in a request for reconsideration of this petition.

Accordingly, the petition is dismissed.

CONCLUSION

1. The petition, taken as a petition under 37 CFR 1.181, is dismissed.
2. Telephone inquiries related to this decision should be directed to Jessica Harrison, Supervisory Patent Examiner, at (571) 272-4449 or in her absence to the undersigned at (571) 272-3838.
3. This decision is without prejudice to a request for reconsideration or higher-level review. See MPEP 1002.02.



Gregory A. Morse

Director

Central Reexamination Unit