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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/011,719	06/11/2011	7672499	985-P-4REEX	2068

41230 7590 07/25/2011

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CHICAGO, IL 60606

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 07/25/2011

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



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

SETH M. REISS, AAL

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/011,719.

PATENT NO. 7672499.

ART UNIT 3992.

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)).

Order Granting / Denying Request For Ex Parte Reexamination	Control No. 90/011,719	Patent Under Reexamination 7672499	
	Examiner COLIN LAROSE	Art Unit 3992	

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

The request for *ex parte* reexamination filed 11 June 2011 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a) PTO-892, b) PTO/SB/08, c) Other: _____

1. The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 (c) will be made to requester:

- a) by Treasury check or,
b) by credit to Deposit Account No. _____, or
c) by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

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cc:Requester (if third party requester)

ORDER GRANTING REEXAMINATION OF U.S. PATENT 7,672,499

Request for Reexamination

1. An *ex parte* request for reexamination (hereinafter "Request") of claims 1-110 was received on 6/11/2011 based on the following prior art patents and/or publications:

U.S. Patent 5,692,067 ("Raterman '067");

U.S. Patent 5,966,456 ("Jones");

U.S. Patent 6,028,951 ("Raterman '951");

U.S. Patent 6,351,551 ("Munro"); and

U.S. Patent 6,459,806 ("Raterman '806").

Prosecution History of the '499 Patent

2. The Request's summary of the prosecution history of the '499 patent appears to be substantially correct (see Request, pp. 15-24). Notably, in neither the original examination of the '499 patent nor the subsequent reexamination of the '499 patent were double patenting issues specifically addressed by the examiners. In the initial examination (i.e., application serial no. 10/163,757), the issue of double patenting was apparently discussed during a personal interview conducted on 7/15/2009. In the summary of the interview dated 7/24/2009, the examiner noted that the Patent Owner's representatives "explained that the proposed independent claims do not raise double patenting issues with related applicants' [sic] patents (see attachments). No agreement was reached."

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Also, there appears to have been no restriction requirements by the examiners in any of the above-cited patents directly related to the claims of the '499 patent that would necessarily preclude double patenting issues from being addressed with respect to the claims of the '499 patent.

Substantial New Question of Patentability

3. The Request alleges the following substantial new questions of patentability (SNQs) based on the above-identified prior art:

- SNQ 1** Claims 1-19, 21-36, 55-56, 58-73 and 75-87 of the '499 Patent are Unpatentable on the Ground of Nonstatutory Obviousness-type Double Patenting Over Claims 3-13 of Cummins' U.S. Patent No. 6,028,951 in View of Claims 30-33 of Cummins' U.S. Patent No. 5,692,067 and in Further View of Claims 10 and 20- 22 of Cummins' U.S. Patent 6,351,551 and Claims 40-48, 59 and 91 of Cummins' U.S. Patent 6,459,806.
- SNQ 2:** Claims 37-54 and 88-110 of the '499 Patent are Unpatentable on the Ground of Nonstatutory Obviousness-type Double Patenting Over Claims 3-13 of Cummins' U.S. Patent No. 6,028,951 in View of Claims 1-5 of Cummins' U.S. Patent No. 5,692,067 and in Further View of Claims 10 and 20-22 of Cummins' U.S. Patent No. 6,351,551 and Claims 1-15, 132 and 120 of Cummins' U.S. Patent 6,459,806.
- SNQ 3:** Claims 20, 57 and 74 of the '499 Patent are Unpatentable on the Ground of Nonstatutory Obviousness-type Double Patenting Over Claims 3-13 of Cummins' U.S. Patent No. 6,028,951 in View of Claims 30-33 of Cummins' U.S. Patent No. 5,692,067 and in Further View of Claim 10 of Cummins' U.S. Patent 6,351,551 and Claims 16 – 17 of Cummins's U.S. Patent 5,966,456

4. The above SNQs are based solely on patents and/or printed publications already cited/considered in an earlier concluded examination of the patent being reexamined. On November 2, 2002, Public Law 107-273 was enacted. Title III, Subtitle A, Section 13105, part (a) of the Act revised the reexamination statute by adding the following new last sentence to 35 U.S.C. 303(a) and 312(a):

“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.”

For any reexamination ordered on or after November 2, 2002, the effective date of the statutory revision, reliance on previously cited/considered art, i.e., “old art,” does not necessarily preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on that old art. Rather, determinations on whether a SNQ exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis.

In the present instance, there exists a SNQ based solely on the previously-cited prior art patents assigned to the Patent Owner. The Request alleges that the claims of the '499 patent are obvious variants of the claims found in the above-cited and commonly-assigned patents. That is, the Request asserts that a substantial new question of patentability exists because the issue of double patenting has not been considered for the claims of the '499 patent with respect to the claims of the above-cited prior-issued patents commonly assigned to the Patent Owner.

Double patenting is an appropriate issue for reexamination and may form the basis of a substantial new question of patentability (see MPEP § 2258(I)(D)). The Request demonstrates

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that the claims of the above-cited prior art patents were at least similar enough to those of the '499 patent to raise a substantial new question of patentability as to whether the claims of the '499 patent are patentably distinct and do not constitute an improper timewise extension. See Request, pp. 67-87. It is agreed that the Request raises a new question of patentability based on non-statutory double patenting issues that have not been previously addressed on the record. The examiner of the initial examination proceeding did putatively consider the issue of double patenting, generally speaking, based on the comments by the Patent Owner's representatives during the 7/15/2009 interview, however, there is no indication whether and to what extent the examiner considered the claims of any of the five prior art patents cited by the Request with respect to the claims of the '499 patent. Accordingly, such "old art" is cast in a new light and is presented by the Request as raising new issues that affect the patentability of the claims.

5. The Request to reexamine claims 1-110 is **GRANTED**.

Patent Owner Statement (Optional)

6. In response to this Order for Reexamination, the Patent Owner is given a two (2) month period to file an optional Patent Owner Statement in accordance with 37 C.F.R. 1.530(b) and (c). The Patent Owner Statement must clearly point out why the patent claims are believed to be patentable, considering the cited prior art patents or printed publications alone or in any reasonable combination. In addition, the Patent Owner may utilize the Patent Owner Statement

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to introduce amendments. A copy of the Patent Owner Statement must be served on the Third Party Requester. See MPEP § 2249.

If a Patent Owner Statement is timely filed and served on the Third Party Requester, the Third Party is given the opportunity to reply within two (2) months from the date of service in accordance with 37 C.F.R. 1.535. The reply need not be limited to the issues raised in the Patent Owner Statement and may include additional prior art patents and printed publications as well as any issue appropriate for reexamination. A copy of the reply must be served on the Patent Owner. If no Patent Owner Statement is filed, no reply is permitted from the Third Party Requester. See MPEP § 2251.

Waiver of Right to File Patent Owner Statement

7. In a reexamination proceeding, Patent Owner may waive the right under 37 C.F.R. 1.530 to file a Patent Owner Statement for the purposes of expediting prosecution; see MPEP § 2249. The document should contain a statement that Patent Owner waives the right under 37 C.F.R. 1.530 to file a Patent Owner Statement and proof of service in the manner provided by 37 C.F.R. 1.248, if the request for reexamination was made by a third party requester; see 37 C.F.R. 1.550(f). The Patent Owner may consider using the following statement in a document waiving the right to file a Patent Owner Statement:

WAIVER OF RIGHT TO FILE PATENT OWNER STATEMENT

Patent Owner hereby waives the right under 37 C.F.R. 1.530 to file a Patent Owner Statement.

Notice of Other Proceedings

8. The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 7,672,499 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

Conclusion

9. Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extensions of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c). See MPEP § 2265.

All correspondence relating to this *ex parte* reexamination proceeding should be directed:

By Mail to: Mail Stop *Ex Parte* 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
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By EFS: Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at

<https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are “soft scanned” (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the “soft scanning” process is complete.

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) state that correspondence (except for a request for reexamination and a corrected replacement request for reexamination) will be considered timely if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) it 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.

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Any inquiry concerning this communication should be directed to Colin LaRose at (571) 272-7423.

/Colin LaRose/
Primary Examiner
Art Unit 3992

Conferees:

Two handwritten signatures in black ink. The top signature is a cursive name, possibly 'John', and the bottom signature is a more stylized cursive name, possibly 'APR'.