

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re *Inter Partes* Reexamination of:

Sanz et al.

Patent No.: 7,312,762

Filed: April 13, 2004

For: Loaded Antenna

Control No.: 95/001,461

Confirmation No.: 1170

Art Unit: 3992

Examiner: James A. Menefee

Mail Stop *Inter Partes* Reexamination
ATTN: Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION UNDER 37 CFR §§ 1.927 AND 1.181 FOR SUPERVISORY REVIEW OF
REFUSAL TO ORDER REEXAMINATION FOR CLAIMS 1, 7-8, 11 AND 21**

Dear Sir:

In response to the “Order Granting/Denying Request for Inter Parte Reexamination” mailed on November 19, 2010, in which the Office granted reexamination for claims 12, 14-15 and 17 of U.S. Patent 7,312,762 (“the ‘762 patent), but denied reexamination for claims 1, 7-8, 11 and 21 of the ‘762 patent, Requester now petitions under 37 C.F.R. §§ 1.927 and 1.181 for supervisory review of that portion of the Order in which the Examiner refused to order reexamination of claims 1, 7-8, 11 and 21.

The Examiner’s refusal to grant reexamination for claims 1, 7-8, 11 and 21 is based on a finding by the Examiner that the substantial new questions of patentability (“SNQ”) raised for these claims are cumulative to issues overcome during the original prosecution. However, the Requester raised at least three new and previously unconsidered arguments that render the SNQs to be non-cumulative. The new and non-cumulative arguments include:

1) the applicant made a false statement regarding the inventorship of WO528 during the prosecution of the ‘762 patent;

2) the reexamination request provides explicit reasons to combine and includes citations to both Ke and Turner to support the combinations whereas the prosecution is silent regarding reasons to combine; and

3) the Patent Owner has asserted infringement allegations that define claim terms more broadly than in the original prosecution.

As discussed in detail below, the Examiner's finding that the SNQs are cumulative is improper and therefore the Examiner's decision refusing to order reexamination as to these claims should be vacated.

Please charge any necessary fee or credit any overpayment pursuant to 37 CFR § 1.16 or 1.17 to the Novak Druce Deposit Account No. 14-1437.

I. PERTINENT FACTS

1. A request for *inter partes* reexamination of claims 1, 7-8, 11, 14-15, 17 and 21 of U.S. Patent No. 7,213,762 ("the '762 patent") was filed on October 1, 2010, and was assigned reexamination control number 90/001,461 ("the '1461 reexamination proceeding")
2. An Order Granting/Denying Request for Inter Partes Reexamination was mailed November 19, 2010 in which reexamination was granted for claims 12, 14-15 and 17 but refused reexamination for claims 1, 7-8, 11 and 21

II. ISSUES TO BE DECIDED

1. Is the SNQ proposed in the '762 reexamination request that claims 1, 7-8, 11, and 21 are obvious over WO528 in view of Ke cumulative to issues raised in the prosecution of the '762 patent?
2. Is the SNQ proposed in the '762 reexamination request that claims 1, 7-8, 11, and 21 are obvious over WO528 in view of Turner cumulative to issues raised in the prosecution of the '762 patent?

III. ARGUMENT

A. Petition Under 37 C.F.R. §§ 1.927 and 1.181 is Proper

37 CFR §1.927 is titled "Petition to review refusal to order inter partes reexamination" and provides that:

The third party requester may seek review by a petition to the Director under § 1.181 within one month of the mailing date of the examiner's determination refusing to order inter partes reexamination. Any such petition must comply with § 1.181(b). If no petition is timely filed or if the decision on petition affirms that

no substantial new question of patentability has been raised, the determination shall be final and nonappealable.

Requester has timely presented this petition, because the Examiner's Order refusing *inter partes* reexamination of claims 1, 7-8, 11, and 21 is dated November 19, 2010, and the petition has been filed within one month of that date (December 19 falling on a Sunday).

MPEP § 2648 provides that "Except for the limited ultra vires exception described in MPEP § 2646, no petition may be filed requesting review of a decision granting a request for reexamination even if the decision grants the request as to a specific claim for reasons other than those advanced by the third party requester." This language is understood to mean that if reexamination is granted for a particular claim based on fewer than all of the SNQs presented for that claim, that a reexamination requester may not then petition for review of the examiner's refusal to adopt some of the SNQs for that claim.

However, in the present reexamination proceeding, the Examiner has held that the request fails to establish any SNQ for claims 1, 7-8, 11, and 21 of the '762 patent. Therefore, reexamination of those claims has been completely refused. The Examiner's acceptance of the SNQs presented for claims 12, 14-15 and 17 of the '762 patent does not limit Requester's right to petition for review of the Examiner's complete refusal to grant reexamination for claims 1, 7-8, 11, and 21.

B. The Combinations of WO528 in View of Ke or WO528 in View of Turner are Not Cumulative to Issues Considered in the Prosecution of the '762 Patent

The reexamination Examiner contends that Ke and Turner are cumulative of the Sonoda reference that was cited in a rejection by the Examiner in the prosecution of the '762 patent because the same features alleged missing in Sonoda are also missing in Ke and Turner. Order at 6-7. The prosecution Examiner allowed the claims after the applicant argued that "Sonoda failed to disclose the conducting surface being a multilevel structure as claimed, or the loading structure being a space-filling curve as claimed." *Id.* at 6.

The reexamination Examiner then argues that the only issue then is if the prosecution Examiner had previously considered Sonoda in view of WO528. *Id.* at 7. Although the prosecution Examiner never considered such a combination on the record, the reexamination Examiner concludes that the prosecution Examiner would have implicitly considered the combination due to the fact that WO528 was cited in the specification:

While the examiner never discussed such a combination, its consideration is implicit in the record in light of the examiner's duty to read and understand the specification, including applicant's explicit discussion of these references, and due to the fact that all of the limitations were clearly present in the art of record. By allowing the claims it is apparent that the examiner answered the question of patentability by declining to combine Sonoda with the WO references.

Id. at 9.

However, the reexamination Examiner's reasoning is improper. It assumes what the prosecution Examiner was thinking without any statements on the record to support that assumption. In fact, it is likely that the prosecution Examiner believed that WO528 did not qualify as prior art to the '762 patent based on the false statement that WO528 was "another patent of the present inventors." '762 patent at 2:20-22. As Samsung pointed out in its request for reexamination, this statement in the '762 patent is untrue as WO528 actually lists several inventors not listed on the '762 patent. '762 Reexamination Request at page 13-14. Therefore, the reexamination request provides the new and unconsidered evidence that WO528 is in fact by a different inventive entity and therefore prior art to the '762 patent.

In addition, it is possible that the prosecution Examiner did not believe that Sonoda had an antenna architecture that led itself to be modified by the teachings of WO528. Once again, Samsung pointed out specific teachings from both Ke and Turner as evidence of why they would be combined with the teachings of WO528. '762 Reexamination Request at page 14 and 19 (citing Ke at Abstract; 2:12-25; and 3:8-12) and page 15 and 23 (citing Turner at Abstract and 2:13-30). None of these citations from Ke or Turner or the express reasons to combine provided by the Requester were considered during the original prosecution. Without any statements on the record on why Sonoda and WO528 were not combined, it is improper to assume that Ke and Turner could not be combined with WO528.

Finally, Samsung submitted the Patent Owner's very broad infringement allegations that were not considered during the original prosecution. '762 Reexamination Request at Exhibit OTH-B and pages 11-12. These contentions are admissions by the Patent Owner regarding its belief on the scope of the claims and appear to be broader than the scope argued in prosecution. An Examiner would have likely decided such admissions would be important in determining the patentability of the claims. Therefore, even if the combination of Ke and Turner with WO528 were similar to the arguments raised in the prosecution, these references are presented in a new light based on the infringement contentions. See MPEP § 2642(II)(A).

IV. CONCLUSION

Requester has demonstrated the Examiner's refusal to order reexamination for claims 1, 7-8, 11 and 21 of the '762 patent is based upon a misunderstanding of the position taken by the Examiner in the previous prosecution. Based on the record, the prosecution Examiner was not aware that the claimed inventorship of WO528 was false, was not aware of the express reasons to combine with Ke or Turner, and was not aware of how broadly the Patent Owner was reading the claims. It is improper for the reexamination Examiner to assume what the prosecution Examiner was thinking when the record is devoid of any discussion regarding the points raised above.

Therefore, the reexamination Examiner's finding that the SNQs of WO528 in view of Ke and WO528 in view of Turner are cumulative of arguments raised in the prosecution is not supported and the reexamination Examiner's decision to refuse to grant reexamination based on this finding should be vacated.

Please charge any necessary fee or credit any overpayment pursuant to 37 CFR § 1.16 or 1.17 to the Novak Druce Deposit Account No. 14-1437.

Respectfully submitted,

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