

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted today via the Office electronic filing system (EFS-Web) in accordance with 37 CFR §1.6 (a)(4).

Date: March 11, 2011

Signature: /Lance A. Smith/
Printed Name: Lance A. Smith

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re *Inter Partes* Reexamination of:

Baliarda 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

**THIRD PARTY REQUESTER'S OPPOSITION UNDER 37 CFR §§ 1.182 AND 1.183 TO
PATENT OWNER'S PETITION TO VACATE DIRECTOR'S DECISION**

Dear Sir:

Third Party Requester and the Real Party in Interest, Samsung Electronics Co. Ltd ("Requester" or "Samsung"), opposes the "Patent Owner's Petition Under 37 C.F.R. § 1.182 to Vacate Decision on Samsung's Petition Under 37 C.F.R. §§ 1.927 and 1.182" filed on February 14, 2011 ("Patent Owner Petition to Vacate Director's Decision"). As discussed further below, Patent Owner's assertion that the Director's decision is contrary to the Office's Rules and the MPEP is incorrect. As set forth in Samsung's December 20, 2010 petition, the Rules and Regulations expressly permit the type of relief granted by the Director's January 21, 2011 decision ("Director's Decision").

It is requested that this opposition paper be considered pursuant to 37 CFR § 1.182 and, if necessary, under 37 CFR § 1.183. If any fees are required, please charge the required fees to Novak Druce and Quigg deposit account no. 14-1437.

I. PERTINENT FACTS

1. October 1, 2010 - 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 and assigned reexamination control number 90/001,461 (“the ‘1461 reexamination proceeding”).
2. November 19, 2010 - An Order Granting/Denying Request for Inter Partes Reexamination was mailed in which reexamination was granted for claims 12, 14-15 and 17 but refused reexamination for claims 1, 7-8, 11 and 21.
3. December 20, 2010 - Requester Samsung filed a petition for reconsideration of the denial to reexamine claims 1, 7-8, 11 and 21.
4. January 21, 2011 – The Director of the Central Reexamination Unit issued a decision reversing the denial and granted reexamination of claims 1, 7-8, 11 and 21.
3. February 14, 2011 - Patent Owner Fractus filed a petition to vacate the January 21, 2011 Director’s Decision.

II. ARGUMENT

The Patent Owner argues that the Office does not have the power to address a petition for reconsideration under 37 C.F.R. § 1.927 when a reexamination order results in “denial of some, but not all, SNQs within a request.” *See* Patent Owner Petition to Vacate Director’s Decision 2 (emphasis removed). Patent Owner argues that other Rules support its assertion that a reexamination order occurs when any SNQ is adopted while a denial occurs when all SNQs are not adopted. *Id* at 3.

Initially, Requester notes that the Office has specifically agreed with an interpretation of 37 C.F.R. § 1.927 that permits a petition to be filed when there is no SNQ adopted for a claim requested to be reexamined even if SNQs are adopted for other claims. For example, a recent presentation given by Kenneth Schor, PTO Senior Legal Advisor, states with regards to 37 C.F.R. § 1.927 petitions:

- Not a proper petition when reexamination granted on all the requested claims, even though the examiner determined that some relied-upon art did not raise an SNQ. Can file another reexamination request on that art, if desired.
- Is a proper petition when reexamination granted on less than all the requested claims. Can petition from denial of reexamination as to claims for which reexamination was denied.

See Exhibit A, Excerpt of Ken Schor PTO Presentation at 17.¹ As set forth by Ken Schor, the Office's position is that a 37 C.F.R. § 1.927 petition is proper to contest a finding where reexamination was granted on some, but not all claims as in the instant proceeding. The Office's interpretation of 37 C.F.R. § 1.927 is "controlling unless plainly erroneous or inconsistent with the regulation." *Auer v. Robbins*, 519 U.S. 452, 461, 117 S.Ct. 905 (1997) (internal quotation marks and citation omitted).

The Rules cited by the Patent Owner do not show the Office's interpretation is "plainly erroneous or inconsistent with the regulations." All of the rules cited by Patent Owner are directed to when an Examiner should order reexamination, but do not address if 37 C.F.R. § 1.927 applies to refusing the entire reexamination request or if it applies to refusing reexamination of some claims. At most, the Patent Owner's citations might mean that 37 C.F.R. § 1.927 is ambiguous, but even if so this is precisely when *Auer* deference is given to an agency's interpretation of its regulations. *Christensen v. Harris Co.*, 529 U.S. 576, 588, 120 S.Ct. 1655 (2000) (giving *Auer* deference "when the language of the regulation is ambiguous").

III. Conclusion

The Patent Owner has not shown that the Office's interpretation of 37 C.F.R. § 1.927 is plainly erroneous or inconsistent. Therefore, the Office should deny the Patent Owner's Petition to Vacate Director's Decision.

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,

/Tracy W. Druce/
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Donald J. Quigg
Reg. No. 16,030
Tracy W. Druce
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James P. Murphy

¹ Kenneth Schor, "Petition Practice in Patent Reexamination from a USPTO Perspective", presented at PLI Seminar – Reissue & Reexamination Strategies and Tactics with Concurrent Litigation 2011 on January 10, 2011 and February 4, 2011.

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EXHIBIT A

PLI Seminar - Reissue & Reexamination Strategies and Tactics with Concurrent Litigation 2011

- January 10, 2011

- February 4, 2011

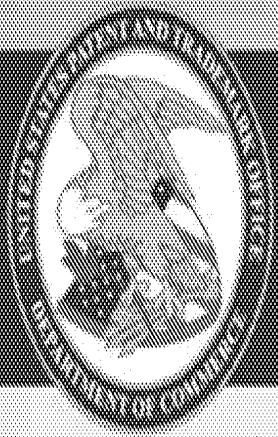
Petition Practice in Patent Reexamination From a USPTO Perspective



Kenneth M. Schor

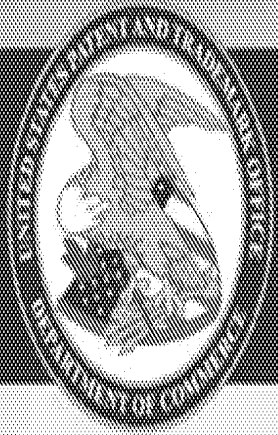
Senior Legal Advisor

Office of the Associate Commissioner for
Patent Examination Policy



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General discussion (1 of 11)

- A petition is:
 - “A written address...for the exercise of...authority in the redress of some wrong, or the grant of some ... privilege....
 - “A formal written request addressed to some governmental agency.”
- Black's Law Dictionary, 6th Ed. p.1145, published 1990



General discussion (2 of 11)

➤ BASICS

- A petition should include :
 - A statement of the type of relief requested and the authorizing provision of the rules, statute, etc..
 - A statement of the facts.
 - An identification of the points that are to be reviewed.
 - The fee, where required, to avoid summary dismissal.
 - It is recommended that a petition include a general authorization to charge deposit account, in case relief can be granted only based on a regulation requiring a higher fee than submitted.
- Each distinct subject in a separate paper- 37 CFR 1.4(c).
- 37 CFR 1.181(f) – Generally, two months to file petition.



General discussion (3 of 11)

- In reexamination, especially *inter partes* reexamination, petition practice has the potential to unduly delay the proceeding, in order to achieve resolution of all petitions:
 - 1. Multiple petitions are filed to obtain one type of relief.
 - Ex. 1: To obtain entry of amendment after final rejection, petitions filed at same time to:
 - A. Challenge propriety of rejection (37 CFR 1.181).
 - B. Challenge propriety of non-entry (37 CFR 1.181).
 - C. Waive 37 CFR 1.116 and enter amendment.
 - 2. Petitions are filed under multiple grounds to obtain the same type of relief.
 - Ex. Single petition “under 37 CFR 1.181 – 1.183.



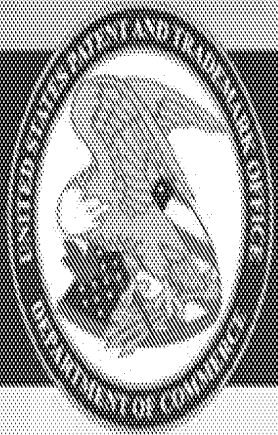
General discussion (4 of 11)

- Items 1 and 2 are addressed in MPEP 2209 & 2609:
 - Parties are cautioned against using so-called “litigation tactics.”
 - Parties are advised to avoid multiple submissions (e.g., reply to an opposition and a sur-reply) directed to a single issue of relief.
 - It is expected that parties will adhere to 37 CFR 11.18(b) throughout the course of a reexamination proceeding – reasonable basis for filing, not for delay.
- If relief needed, file one petition at a time directed to one avenue of relief, and wait for a decision.
 - Doing otherwise results in delay and may obscure the issues, so that you do not get the relief you intended to ask for.



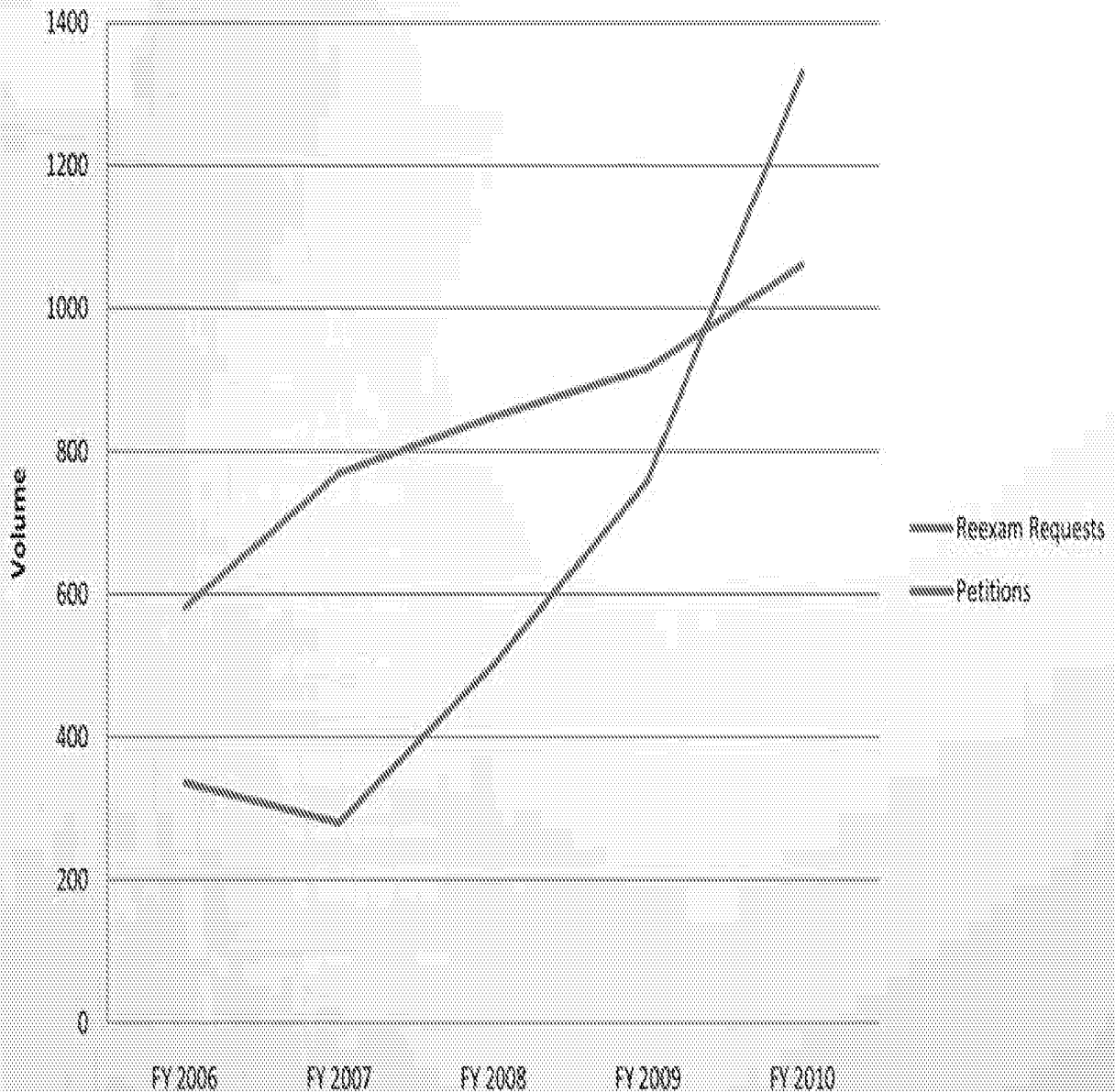
General discussion (5 of 11)

- In spite of the MPEP caution to parties against using “litigation tactics,” parties have used petition practice as a motions practice resulting in a dramatic upswing of petitions. The result has been -
 - A) Proceedings have been delayed by the need to address this dramatic increase in petitions, despite the Office’s statutory mandate for special dispatch in reexamination (35 U.S.C. 305, 35 U.S.C. 314(c)).
 - B) There is an undue drain on staff resources, to address these petitions, which disrupts not only the reexamination proceeding, but also the general duties of the deciding officials.
- The following 3 charts show the increase in petition filings, that has resulted from the petitions practice being used as a motions practice, in comparison to reexam filings and pending reexams.



General discussion (6 of 11)

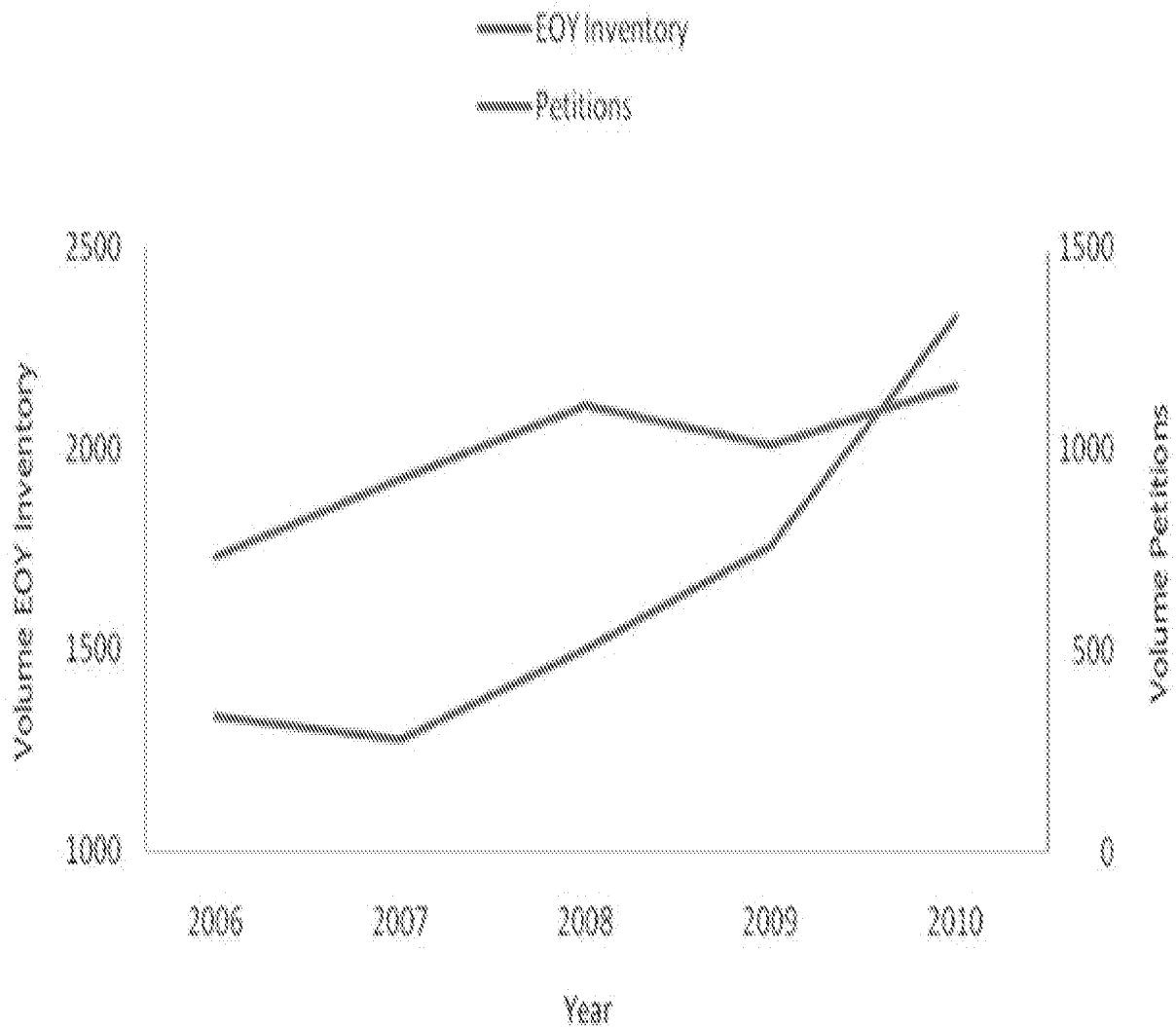
Reexam Requests vs Petitions FY 2006 through FY 2010





General discussion (7 of 11)

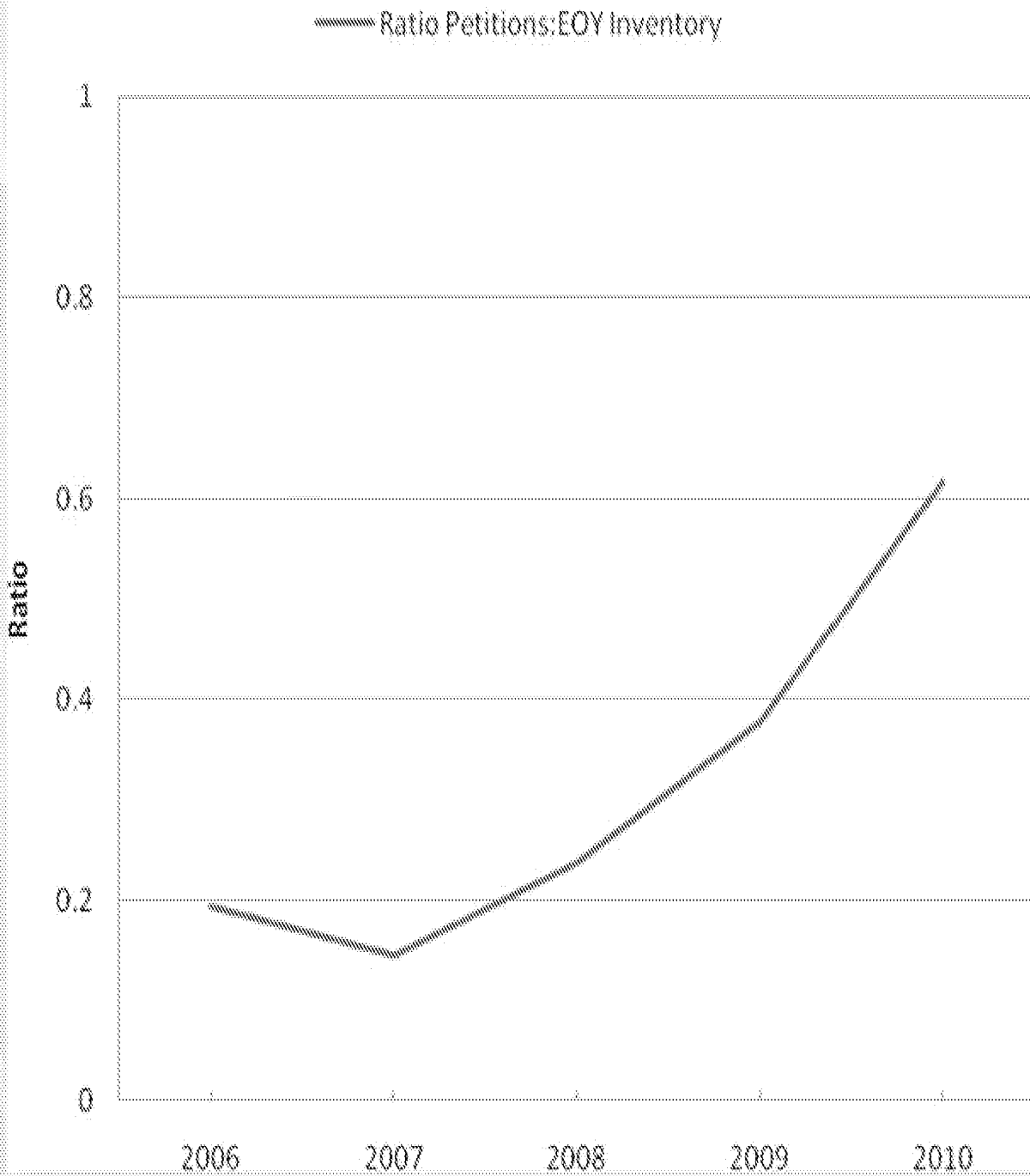
Rexam EOY Inventories vs Petitions Years 2006 through 2010





General discussion (8 of 11)

Ratio FY Petitions:EOY Inventory





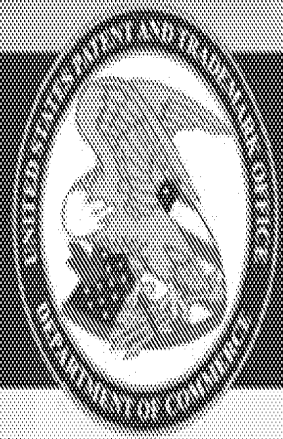
General discussion (9 of 11)

- The 1st chart shows an exponential-like increase in the number of reexamination petitions from 2006 to 2010 as compared to reexamination filings. At this point, the petition filing rate is exceeding the reexamination filing rate – a historical first.
- The 2nd chart shows that the number of reexamination proceedings pending from 2006 to 2010 has remained essentially level, such that an increase in pendency is not responsible for the increase in petitions.
- The Y axes shows reexam inventory on the left side and petition filings on the right, set in the same relative scale, so the comparative rate change is evident.
- The 3rd chart shows the information of the 2nd chart in a more dramatic fashion –has been a continual increase in the ratio of petitions per reexamination from 2006 to 2010 of greater than 0.4.



General discussion (10 of 11)

- To address the shown increase in the number of reexamination petitions shown in the charts, the Office will be taking greater notice of whether a reasonable basis exists for filing petitions. The Office will be looking for:
 - Multiple concurrent petitions for an item of requested relief, or multiple alternative grounds for one item of requested relief.
 - Unjustified multiple iterations of petitions for an item of relief.
 - Petitions to resolve issues which are appealable, not petitionable.
 - Frivolous petitions, that may delay and may unnecessarily complicate matters.



General discussion (11 of 1)

- In such situations, where a party fails to adhere to 37 CFR 11.18(b), despite the cautions in the MPEP, the parties may very well be referred to the Office of Enrollment and Discipline (OED).
- The following presentation is directed to providing guidance as to what the Office is looking for, where a party feels that a legitimate basis for relief exists. Following the guidance in this presentation will:
 - Help you get relief faster when it is appropriate, and understand why relief is not appropriate when it is not.
 - Help reduce the drain on Office resources.
 - Reduce reexamination pendency, in accordance with the Office's statutory mandate for special dispatch in reexamination.



Types Of Petitions Commonly Filed - Introduction

- The following slides address:
 - Various reexamination related petitions which are available, for different types of relief.
 - Basic guidance for presentation of the petitions.

- Please note, however, that each petition & type of relief requested may have some unique nuances; therefore, each petition is addressed on a case-by-case basis.



Types Of Petitions Commonly Filed - To Review Examiner Denial of Reexamination (1 of 2)

- Requesting Review of Refusal to Order Reexamination:
 - Petition under 37 CFR 1.515(c) or 37 CFR 1.927 must be filed within ONE month of the mail date of the examiner's determination refusing to grant reexamination.
 - Although decision is rendered *de novo*, the submission of additional evidence is not permissible.
 - Must rely on record for which denial of reexamination issued.
 - If new evidence is necessary, then a new request may be submitted.



Types Of Petitions Commonly Filed - To Review Examiner Denial of Reexamination (2 of 2)

- Must demonstrate that relied-upon art presents a new, non-cumulative technological teaching that was not previously considered and discussed on the record during the prosecution of the patent.
 - Do not assert an error in terms of injustice or prejudice.
 - Focus on the facts and evidence of record in the request as the basis of the arguments.
- Not a proper petition when reexamination granted on all the requested claims, even though the examiner determined that some relied-upon art did not raise an SNQ. Can file another reexamination request on that art, if desired.
- Is a proper petition when reexamination granted on less than all the requested claims. Can petition from denial of reexamination as to claims for which reexamination was denied.



Types Of Petitions Commonly Filed - Requesting an Extension of Time (1 of 2)

- To request extension of time, petition filed under 37 CFR 1.550(c) (*ex parte* reexam), or 37 CFR 1.956 (*inter partes* reexam).
- Extensions of time not automatically granted
 - The mere filing of the request will not effectuate an extension.
- Can file up to the last day of the response period, but it is not recommended to wait until the last day.
 - If petition for extension of time is not granted, the reexamination proceeding will become terminated.



Types Of Petitions Commonly Filed - Requesting an Extension of Time (2 of 2)

- Petition for extension must include:
 - (A) A statement of what action the patent owner has taken to provide a response; must be to-date as of the date the request for extension is submitted.
 - Must provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the Office action within the statutory time period
 - (B) Why, in spite of the action taken thus far, the requested additional time is needed.
- The circumstances must be beyond the petitioner's control, in order to be considered circumstances which truly preclude a timely filing by petitioner.
 - Examples not beyond petitioner control: A change in patent owner's representation, or prior commitments of patent owner's representative. Both indicate a decision made by the patent owner or representative, affecting the ability to promptly respond.



Types Of Petitions Commonly Filed - Requesting Supervisory Review or Reconsideration

- For supervisory review, or reconsideration of a decision, must petition 37 CFR 1.181. Petition must -
 - Be filed within 2 months from mail date of action or notice from which relief is requested - 37 CFR 1.181(f).
 - Specifically articulate the error, e.g., improper finality of action.
 - Specifically cite where in the record the error occurred, e.g., cite to the pages of the Office action.
 - Explain why the action taken constitutes an error.
 - Do not argue substance of a rejection as an "error"
 - That issue is appealable, not petitionable.
 - Do not ask for equitable relief (waiver), e.g., based on injustice or prejudice.



Types of petitions commonly filed - Petition to strike opposing party's paper

- Petition to strike opposing party's paper should only be considered when a paper that was placed in the record is improper. It should be filed as a 37 CFR 1.181 petition for supervisory review to expunge the improper paper.
- Clearly, and with specificity, state why the opposing party's paper was improperly entered.
 - Cite the applicable rule and MPEP policy guidance that precludes entry.
 - Explain why the rule or policy is applicable.
 - Refrain from inflammatory rhetoric and issues not relevant to reexamination, e.g., allegations of unethical conduct.



Types Of Petitions Commonly Filed - Petition for suspension (waiver) of a rule

- Petition for suspension of a rule is filed under 37 CFR 1.183,
 - Must explain why the circumstances are extraordinary.
 - Imposing of the operation of the rule must create an unjust result, to request waiver of the rule.
 - Will not be granted if there is another avenue to obtain relief.
 - True, even if waiver avenue more advantageous to party.
 - Should not request waiver of rules when supervisory review is desired, e.g.:
 - Petitions to strike a party-opponent's submission.
 - Petitions to withdraw finality as premature.
 - Cannot be granted if waiver of the rule is contrary to law.
 - Note that sometimes rules track statutory language, so check before filing petition.
 - Should be filed as soon as action resulting in need for waiver is issued.



Types Of Petitions Commonly Filed – Petition for Suspension of Page Limit Rule (1 of 4)

- Additional information for petitions to waive the page limit requirements of 37 CFR 1.943(b) & (c) (*inter partes* reexam).
- Request must explain (1) extraordinary circumstances preventing compliance with page limit requirements, (2) how compliance was attempted, (3) what precluded compliance.
 - Including a proposed non-compliant response permits the Office to see that the party has economized, and why the requested length is being requested.
 - Petitions dependent upon a condition, such as “if the Office determines that the page limit is exceeded,” will ordinarily not be addressed on the merits.
- Petitions are decided on case-by-case basis, dependent on individual facts.



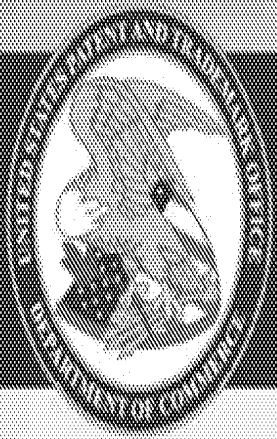
Types Of Petitions Commonly Filed - Petition for Suspension of Page Limit Rule (2 of 4)

- Waiver will not be granted for documents of unduly small font size or type, reduced margins, and single line spacing.
 - Exceptions: Claim charts, tables of contents, forms, qualifications of expert, copies of court documents or reference materials may be single-spaced.
- Listing of claims, amendments to claims or specification, table of contents, etc. are usually excluded from the relevant regulatory page limit requirement.



Types Of Petitions Commonly Filed - Petition for Suspension of Page Limit Rule (3 of 4)

- The Office analyzes whether the document, e.g., a declaration, provides:
 - Factual evidence, i.e., evidence of technological facts (which is not counted), or
 - In actuality, arguments of counsel (which is counted).
- Any page that contains a legal argument will result in the entire page counting against the relevant regulatory page limit requirement.



Types Of Petitions Commonly Filed - Requesting Suspension of Page Limit Rule (4 of 4)

- Examples of affidavits or declarations that, if free of attorney argument, would not count toward the 50-page limit:
 - Swearing behind the filing date of a reference.
 - Establishing the date of a printed publication.
 - Providing a technical explanation or technical definition of terms of art used by a reference.
 - Providing comparative test results and a scientific, or technological, analysis of the results (see, e.g., MPEP 716.02).
 - Establishing commercial success.
 - Establishing long-felt need.
 - Establishing failure of others to do.
 - Establishing skepticism of experts.
 - Establishing copying by others.



Types Of Petitions Commonly Filed - Petition under 37 CFR 1.182

- Petition under 37 CFR 1.182 is filed only to request relief not specifically provided for in the rules.
 - No relevant rule exists that governs the circumstance.
 - Examples:
 - “Good cause” suspension of *inter partes* reexamination proceeding.
 - Rarely granted – see MPEP 2686.04 V (especially part (E)).
 - Requesting Termination of a Reexamination Proceeding
 - See next slide.
- Do not file petitions that are contrary to law; for example:
 - Petitioning OPLA to take jurisdiction to prevent action by the CRU is a *de facto* petition to stay the proceeding, which is contrary to the statutory mandate of special dispatch of 35 U.S.C. 305 and 35 U.S.C. 314(c).



Types Of Petitions Commonly Filed -

Petition for termination of IP reexamination proceeding

- A petition requesting termination of an *inter partes* reexamination proceeding pursuant to 35 U.S.C. 317(b) is filed under 37 CFR 1.182.
- Petition must show that:
 - The requester was a party in the civil action in which requester has not sustained its burden of proving the invalidity of any patent claim in suit, specifying which patent and which claims (a court stipulated order must state this).
 - That the decision against the party-in-the-civil-action/requester is "final," i.e., that all appeals have been exhausted, or the time for same has expired.
 - That all the claims under reexamination were in suit; and
 - That all the art applied in the reexamination was art that the requester "raised or could have raised" (§ 317(b) language) in the earlier, concluded civil action.



Types Of Petitions Commonly Filed - Revival of terminated proceeding (1 of 2)

- Requesting revival of a reexamination proceeding or acceptance of late paper.
 - Usually filed under 37 CFR 1.137 (b) – for revival/acceptance due to “unintentional” delay.
 - 37 CFR 1.550(e) (*ex parte* reexamination) and 37 CFR 1.958 (*inter partes* reexamination), both provide that the request may be made via a petition that complies with 37 CFR 1.137(b).
- Requirements:
 - Required response to Office communication, unless it was previously filed.
 - Petition fee provided in § 1.17(m).
 - Petition must include the “unintentional” statement set forth in § 1.137(b)(3). No other statement will be accepted.
 - Use of PTO/SB/64 is therefore recommended.



Types Of Petitions Commonly Filed - Revival of terminated proceeding (2 of 2)

- Additional explanations and details are not necessary, unless requested, usually just the “unintentional” statement.
- The petition to revive or accept late paper is not to be combined with any other requests for relief.
- Available only to patent owner. Even in *inter partes* reexamination proceeding, requester has no right to file it.
- In *ex parte* reexamination proceeding, after a final Office action has been issued, if response required with the petition does not place proceeding in condition to issue reexamination certificate, file Notice of Appeal as the proposed response, to avoid having to file a renewed petition for revival or acceptance of late paper.



Types Of Petitions Commonly Filed -

Petitions *re* proprietary/protected information (1 of 3)

- Where proprietary information is “owned” ** by the party submitting it, such information is to be -
 - Submitted under seal.
 - Accompanied on filing by a petition under § 1.59(b) to expunge any document of the information that the Office subsequently determines not to be material to patentability.
- A failure to submit the information in the proper manner is deemed a waiver of the confidential nature of the information, absent a strong showing to the contrary.

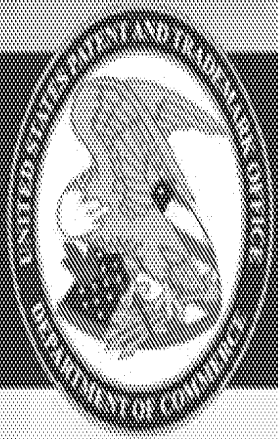
** “Owned” as used here denotes the entity having the authority (right) to prevent/permit dissemination of the subject information.



Types Of Petitions Commonly Filed -

Petitions *re* proprietary/protected information (2 of 3)

- Where proprietary information is not "owned" by the party submitting it, and such proprietary nature is known to the submitting party, such information is to be -
 - Submitted under seal.
 - Accompanied on filing by a petition under § 1.59(b) to expunge any document of the information that the Office subsequently determines not to be material to patentability.
 - Accompanied on filing by either:
 - ----A certification that the party filing the information in the reexamination proceeding has, prior to filing the information, informed the court of its intention to submit the information to the Office in a proceeding that will open the information to unlimited public access, if found to be material to patentability, and that the court has approved such submission, or
 - ---- A copy of the consent by the entity whose information is being submitted waiving the confidentiality and protection of the protective order for the information.



Types Of Petitions Commonly Filed -

Petitions *re* proprietary/protected information (3 of 3)

- Where proprietary information is not “owned” by party submitting it, and such proprietary nature is not known to the submitting party -
 - Petition under § 1.59 (b) may be filed by party to the proceeding, or by owner of the proprietary information, to expunge it from the record prior to Office’s review of that information.
- The petition must be accompanied by:
 - (1) A copy of the protective order issued by the court, or the court order limiting access to the information,
 - (2) An explanation of where in the court documents the information to be expunged is covered, and why the identified language covers the information, and
 - (3) A verified statement (declaration or affidavit) by the party submitting the petition, supporting the request to expunge the information.



Types Of Petitions Commonly Filed - To vacate reexamination grant (1 of 2)

- Petition requesting that Grant for Reexamination be vacated.
 - Must be filed within TWO months of the mail date of the Order granting reexamination.
- Can be filed where:
 - Order is facially not based upon prior art patents or printed publications.
 - Reexamination is prohibited under 37 CFR 1.907.
 - All claims of the patent were held to be invalid by a final decision of a Federal Court in a civil action under 28 U.S.C. 1338 - after all appeals are exhausted, or the time for same has expired.
 - Reexamination was ordered for the wrong patent.
 - Reexamination was ordered based on a duplicate copy of the request.



Types Of Petitions Commonly Filed - To vacate reexamination grant (2 of 2)

- Argument as to non-existence of any substantial new question of patentability.
 - For ex parte reexamination, see Clarification on the Procedure for Seeking Review of a Finding of a Substantial New Question of Patentability in *Ex Parte* Reexamination Proceedings - 75 FR 36357, June 25, 2010.
 - Must preserve right to argue the point by requesting reconsideration before examiner (e.g., in a patent owner's statement under 37 CFR 1.530 or in a patent owner's response under 37 CFR 1.111) (if ordered on or after June 25, 2010).
 - Issue is subject to review by appeal to Board, not by petition.
 - For inter partes reexamination, If reexamination is granted, the decision that a reference raises a SNQ is final and non-appealable by the patent owner. See 35 U.S.C. 312(c).



When Petition of Other Party May Be Properly Opposed (1 of 4)

- In limited circumstances, party B may oppose a Party A petition – (1) when party A petitions to take away a right of party B, or (2) to support the Office's right to take action that has been contested by Party A.
- Examples:
- Ex. 1 – Requester may oppose a patent owner petition under 37 CFR 1.181 to vacate the filing date of requester's reexamination.
 - PO argues that one or more of the filing date requirements of 37 CFR 1.510 or 1.915 have not been complied with.
 - 3PR can argue why the requirement was in fact complied with.



When Petition of Other Party May Be Properly Opposed (2 of 4)

- Examples of when may oppose (continued):
 - Requester may oppose a patent owner petition under 37 CFR 1.181 to withdraw final Office action issued by the Office.
 - Requester may support the action taken by the Office, since Office has unequivocal right to enforce its rules & practice; and requester can explain why the Office acted within its right.



When Petition of Other Party May Be Properly Opposed (3 of 4)

- Party B may not oppose party A's petition seeking relief that is within the discretion of the Office, or party A's petition seeking relief that does not take away a right of party B."
- Examples:
 - Petition under 37 CFR 1.183 to waive page length requirement of 37 CFR 1.943(b) or (c).
 - Petition under 37 CFR 1.550(c) or 1.956 for an extension of time.
 - Petition under 37 CFR 1.182/1.183 to reopen prosecution.
 - Petition under 37 CFR 1.182/1.183 for entry of an amendment after final rejection or ACP.
 - Petition under 37 CFR 1.137 for revival of a terminated prosecution (accept delayed response).



When Petition of Other Party May Be Properly Opposed (4 of 4)

- Party A may not file a petition opposing Party B's opposition petition.
 - In MPEP 2209 & 2609 - Parties are advised that multiple submissions, such as reply to paper opposing a petition and sur-reply directed to such a reply, are not provided for in the regulations or examining procedures governing reexamination. It is expected that the parties will adhere to provisions of 37 CFR 11.18(b) throughout the course of a reexamination proceeding.
 - MPEP 2667 I. B.4. - There must be a limitation on party iterations of input, especially given the statutory mandate for special dispatch in reexamination.



Reexam Petitions Best Practices

- Avoid the need for petitions (1 of 2)

- Submit a comprehensive, concise and compliant request to minimize the need for petitions.
- A high quality request will minimize the occurrence of petitionable issues during prosecution of the reexamination proceeding. Be sure to include:
 - A statement pointing out each substantial new question of patentability (SNQ) based on the cited patents and publications.
 - - A detailed explanation of how all of the cited documents are applied to the claims for which reexamination is requested.
 - For each identified SNQ, the request must explain how all of the cited documents identified for that SNQ are applied to meet/teach the claim limitations. All limitations of the claim must be addressed.



Reexam Petitions Best Practices

- Avoid the need for petitions (2 of 2)

- Keep powers of attorney and correspondence addresses current and consistent in both the reexamination proceeding and the patent's file history.
- Keep all comments submitted in accord with the scope of reexamination and do not include issues of misconduct, inequitable conduct, and patentability issues not based upon patents and printed publications.
- Use Office forms, which are kept up to date and compliant with all relevant rules.



Reexam Petitions Best Practices – The petition itself (1 of 3)

- Petitioner must select the appropriate rule under which relief is being requested.
 - Citation to an inappropriate rule may result in delay until the petition gets routed to the correct decision maker.
- Do not simply attempt to cover “all the bases” and caption multiple petition rules. This will cause confusion and delay in the routing of the petition to the correct decision maker.
- Caption the petition and cite the appropriate rule.
 - Failing to caption the petition slows down the process to identify the paper as a petition and route it to the correct decision maker.



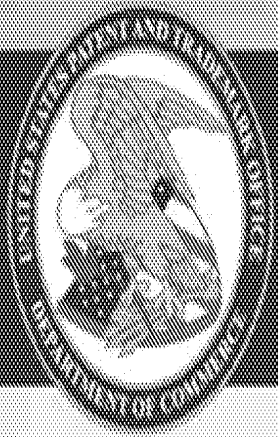
Reexam Petitions Best Practices – The petition itself (2 of 3)

- Analyze the relevant facts and circumstances as to whether they meet the appropriate standard for the relief requested.
- Petitions under 37 CFR 1.181 require that the perceived specific error be identified and explained. Arguing injustice and prejudice is not relevant to the procedural error that occurred during the proceeding.
- Petitions under 37 CFR 1.182 require that there truly be no other rule or vehicle for appropriate relief. Often issues under 37 CFR 1.181 are petitioned under 37 CFR 1.182, while 37 CFR 1.181 provides the rule for relief.
- Petitions under 37 CFR 1.183 require a showing of extraordinary circumstances, where justice requires waiver of the rule. Treating waiver of the rule as a *pro forma* exercise and providing little or no equitable showing is contrary to the rule and its purpose.



Reexam Petitions Best Practices – The petition itself (3 of 3)

- Untimely, Improper or inappropriate petitions:
 - As reexaminations are under a statutory mandate of special dispatch, the time limits for filing are strictly followed. The majority of petitions have a two month filing time period, but some have shorter filing time periods (e.g., opposition petition - within two weeks of service).
 - Filing a petition on multiple issues for multiple forms of relief, or relief in the alternative, or one petition for multiple cases - is improper and not in accordance with the rules. See 37 CFR 1.4 (b) and (c).
 - Filing “conditional” or “premature” petitions is inappropriate, and should not be done.
 - The triggering condition or basis for relief may never occur, and the issues are undeveloped and not ripe for consideration at the time the petition is filed. Such petitions are contrary to statutory “special dispatch.”



Thank You



U.S. Patent & Trademark Office

Office of the Associate Commissioner for
Patent Examination Policy

Office of Patent Legal Administration