

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re reexam of: U.S. Patent 7,312,762
to
PUENTE *et al.*
Reexam Control No.: 95/001,461
Filed: October 1, 2010
For: **Loaded Antenna**

Confirmation No.: 1170
Art Unit: 3992
Examiner: MENEFEE, James A.
Atty. Docket: 3008.004REX0

**PATENT OWNER PETITION UNDER 37 C.F.R. § 1.182 TO VACATE DECISION ON
SAMSUNG'S PETITION UNDER 37 C.F.R. §§ 1.927 AND 1.181.**

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

Dear Sir:

Pursuant to 37 C.F.R. § 1.182, patent owner, Fractus, S.A., ("Fractus") respectfully petitions the Director to vacate its January 21, 2011 Decision on Petition Under 37 C.F.R. §§ 1.927 & 1.181 (the "Decision"), ordering reexamination of claims 1, 7, 8, 11, and 21 of U.S. Patent 7,312,762 ("the '762 patent"), for which the Office previously determined there were no substantial new questions of patentability ("SNQs"). Fractus respectfully asserts that the Decision was an *ultra vires* act by the Office that was not authorized by and is contrary to the Office's Rules and the MPEP.

The petition fee under 37 C.F.R. § 1.17(f) is filed electronically herewith.

FACTUAL BACKGROUND

On October 1, 2010, third party Samsung requested *inter partes* reexamination of the '762 patent. On November 19, 2010, the Office granted Samsung's request, finding SNQs as to the patent's claims 12, 14-15, and 17. The

Office, however, determined that Samsung's request did not raise SNQs as to claims 1, 7, 8, 11, and 21. Samsung then petitioned the Director under 37 C.F.R. §§ 1.927 and 1.181 to reconsider and review the reexamination decision that there were no SNQs as to claims 1, 7, 8, 11, and 21. On January 21, 2011, the Office issued the Decision, granting Samsung's petition and ordering that reexamination also proceed with respect to claims 1, 7, 8, 11, and 21.

ARGUMENT

A. OVERVIEW

The Office should vacate the Decision and deny Samsung's petition. The Office has no authority to reconsider a decision determining that no SNQ was raised by a reexamination request. Rule 1.927 does not authorize the Office's action here. Rule 1.927 only purports to authorize the Office to review a decision on a reexamination request where there was a "determination refusing to order inter partes reexamination." 37 C.F.R. §1.927. But here the Office found SNQs as to claims 12, 14-15, and 17 of the '762 patent and ordered that reexamination of the patent proceed. The rule does not authorize the Office to treat a reexamination request as several discrete requests on a claim-by-claim basis, as it did here.

B. 37 C.F.R. § 1.927 DOES NOT AUTHORIZE THE OFFICE'S DECISION.

Rule 1.927—the Rule cited by the Office in the Decision as the basis for its authority—does not apply to the facts here. Rule § 1.927 purports to allow third-party requesters to seek review by petition to the Director where there is an examiner "determination refusing to order *inter partes* reexamination." Here, there was no such refusal: reexamination was ordered; and SNQs were found as to claims 12, 14-15, and 17. Nothing in the language of the Rule permits requesters to petition where only a subset of proposed SNQs are denied. That is, the Rule permits review only where the reexamination request is denied in its entirety, *i.e.*, there is a "*determination refusing to order inter partes reexamination.*" The relevant triggering event for review under Rule 1.927 is the denial of an entire request, not the denial of some, but not all, SNQs within a request.

The language of the other rules governing *inter partes* reexamination supports the conclusion. Rule 1.931 states: “If a substantial new question of patentability is found, the determination will include an order for inter partes reexamination of the patent for resolution of the question.” (emphasis added) It is only where all proposed SNQs are denied that there is a refusal to order reexamination: if there are no SNQs, the request will be denied. 37 C.F.R. § 1.923 (“If the examiner determines that no substantial new question of patentability is present, the examiner shall refuse the request and shall not order *inter partes* reexamination.”).¹ Here, the *inter partes* reexamination was in fact originally ordered with adopted SNQ. Since the reexam was ordered, Rule 1.927 does not apply.

The MPEP supports this view. It provides an example of a granted *inter partes* reexamination that is directly on point. MPEP 2647.01. That example ordered reexamination for claims 1-3 but denied the SNQ as to claim 4. Yet, the MPEP states this a *granted* request and does not make any claim-by-claim distinction that the request was granted as to some claims but denied as to the other. Indeed, the MPEP’s only example of a denied request is where every proposed SNQ was denied. *Id.* Notably, the Office’s form for ordering or denying reexamination requests also supports this conclusion. *See* Exhibit A, Form PTO-2603. If a single SNQ is found, the examiner is to check the box indicating “The request for inter partes reexamination is GRANTED” on form PTOL-2603, even if one of the proposed SNQs is not found. MPEP 2647.01. Further, form PTOL-2603 only authorizes a third-party requester to seek review under 37 C.F.R. §1.927 when the request is denied and the second box is checked, a box that is only checked where there are every proposed SNQ is denied.

Here, because the Office originally found SNQs were raised and ordered *inter partes* reexamination of the ’762 patent, 37 C.F.R. § 1.927 simply does not apply. The Office should vacate the Decision and deny Samsung’s petition.

¹ Instructively, it is only where all SNQs are denied that the requester is entitled to a refund of its fee. 37 C.F.R. § 1.925.

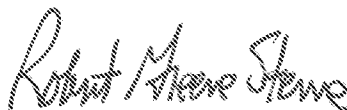
Conclusion

Based on the foregoing, Fractus respectfully submits that the current circumstances represent good cause under 37 C.F.R. § 1.182 for the Office to vacate the Decision as an *ultra vires* act and deny Samsung's petition seeking the Director's review of claims 1, 7, 8, 11, and 21 of the '762 patent.

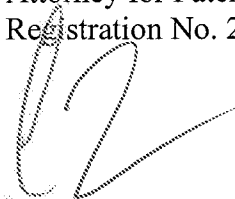
It is respectfully requested that, if the Office should deny this Petition, the Office not expunge this Petition from the record in order to preserve the record for an appropriate appeal or other review.

Respectfully submitted,

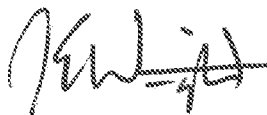
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