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CENTRAL REEXAMINATION UNIT

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In re: Puente et al. :
Inter Partes Reexamination Proceeding : DECISION ON PETITION
Control No.: 95/001,461 : UNDER 37 CFR §§ 1.927 & 1.181
Deposited: October 1, 2010 :
For: U.S. Patent No.: 7,312,762 :

This is a decision on the petition filed by the third party requester on December 20, 2010, entitled "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," [hereinafter "the petition"]. Petitioner, the reexamination requester, seeks review of the Order Granting the Request for *Inter Partes* Reexamination mailed November 19, 2010, which granted the request for claims 12, 14, 15, and 17, but denied the request for reexamination of claims 1, 7, 8, 11, and 21.

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

The petition is granted.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 7,312,762 issued on December 25, 2007.
- A request for *inter partes* reexamination was filed October 1, 2010 and assigned control no. 95/001,461.
- Reexamination was requested of claims 1, 7, 8, 11, 12, 14, 15, 17, and 21. The request was granted in-part in an Order mailed November 19, 2010. The request was granted as to claims 12, 14, 15, and 17, and denied as to claims 1, 7, 8, 11, and 21.
- The instant petition was timely filed on December 20, 2010. The petition requests reconsideration and review of two proposed substantial new questions of patentability denied in the Order: that claims 1, 7, 8, 11, and 21 are obvious over WO528¹ in view of Ke, and that claims 1, 7, 8, 11, and 21 are obvious over WO528 in view of Turner.

DECISION

Standard of Review

37 CFR § 1.927 provides for the filing of a petition under 37 CFR § 1.181 to review an examiner's determination refusing to order *inter partes* reexamination. The CRU Director's review on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination for claims 1, 7, 8, 11, and 21 was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for denying the request.

The Legal Standard for Ordering Reexamination

A review of 35 U.S.C. §§ 311 and 312 reveals that, by statute, *inter partes* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. 35 U.S.C. § 311 requires that a request for *inter partes* reexamination be based upon prior art as set forth in 35 U.S.C. § 301, that is, prior art consisting of patents or printed publications, while 37 CFR 1.915(b)(3) requires that a request for *inter partes* reexamination include "A statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial question of

¹ The terminology follows that presented in the Order. See that action for the precise citations of the references.

patentability is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a “substantial new question of patentability” is present, unless the same question of patentability has already been decided by a final court holding of invalidity after all appeals, or by the Office in an earlier examination or in a reexamination of a patent. That is, the requester must “demonstrate[] that a patent or printed publication that is relied upon in a proposed rejection presents a new, non-cumulative technical teaching that was not previously considered and discussed on the record during the prosecution of the application that resulted in the patent for which reexamination is requested, and during the prosecution of any other prior proceeding involving the patent.” MPEP § 2616. If a substantial new question of patentability is found to be raised, an order granting *inter partes* reexamination of the patent is issued.

Summary of the Prior Prosecution with Respect to the ‘762 Patent

The ‘878 patent contains claims 1-21, of which only claims 1, 7, 8, 11, and 21 are at issue in this Decision. The Director generally agrees² with the examiner’s discussion of the prosecution history in the Order Granting the Request mailed November 19, 2010 at pp. 3-4, and hereby incorporates that discussion by reference to the extent consistent with this Decision. Particularly, as discussed on page 3, it is apparent in the original examination that a reference to Sonoda was found to teach the features of claims 1 and 21 as issued, except for the material added with the addition of new claims—a conducting surface having a multilevel structure. It is also shown, as mentioned in the Order at page 4, that WO528 was discussed in the specification as teaching a multilevel antenna having a multilevel geometry. Applicant further noted in the specification that conducting surfaces could be made in accordance with the multilevel geometry discussed in WO528. Sonoda does not, however, explicitly discuss a loading structure as claimed, but the original examiner stated that this was obvious in Sonoda. This was not mentioned by the reexamination examiner and is an important point as will be discussed below.

Decision on the Request for Reexamination

As applicable here, the Request proposes that a substantial new question of patentability is raised as to claims 1, 7, 8, 11, and 21 based on WO528 in combination with either Ke or Turner. WO528 is used in precisely the same manner as it was discussed in the original specification—to show that conducting surfaces of an antenna could be made having a multilevel structure. Each of Ke and Turner are used in a similar way that Sonoda was used—to show the various limitations of the independent claims other than the conducting surfaces having a multilevel structure.

² Any agreement herein with the examiner is not to suggest that the requisite *de novo* review did not occur.

The teachings of these references do, however, differ from Sonoda. The examiner's denial was premised on the finding of fact that Ke and Turner are cumulative to Sonoda, therefore the consideration of these references with WO528 was cumulative to the implicit consideration of Sonoda with WO528. Upon further review, this is not the case.

In the original examination, Sonoda was applied against certain claims. In doing so, the original examiner stated that while elements 21 a-d of Sonoda were not called a loading structure, the skilled artisan would have found it obvious to consider such elements a loading structure. *See* Non-Final Rejection mailed October 5, 2006, p. 2.

While the original examiner may be correct in that Sonoda's elements 21a-d could be obviously considered a loading structure by the skilled artisan (a point the Director need not decide), this point does alter the analysis. Ke and Turner each explicitly use a loading structure, and apparently teach reasons why a loading structure would be used. One can envision an examiner combining Ke and Turner, with these explicit teachings, with another reference (such as WO528), while determining not to combine Sonoda with the same reference in light of the more vague teachings of Sonoda. For example, while Sonoda's elements may be a loading structure, perhaps the examiner saw no reason to provide such structure in WO528 in light of Sonoda's lack of clear teachings. If that is the case, perhaps the examiner would have made the combination if he had a clearer reference with clearer motivation, such as Ke or Turner.

The Director therefore agrees with the petitioner at the middle paragraph of page 4 of the petition. Ke and Turner, unlike Sonoda, each provide an explicit teaching of a loading structure of an antenna. Each additionally, unlike Sonoda, provides a plausible reasoning as discussed in the request why a loading structure might be advantageous in an antenna. While the original examiner declined to combine Sonoda with WO528, it is not clear *why* that was the case. Given that Ke and Turner provide more explicit teachings relevant to the claims that might better support a combination, the Director does not agree with the reexamination examiner that Ke and Turner are cumulative to Sonoda.

In light of these findings, the combination of either Ke or Turner with WO528 is not cumulative to the implicit combination from the original examination of Sonoda with WO528. The combination of Ke or Turner with WO528 can plausibly be said to show all of the limitations of the relevant claims, including the material missing from the original examination, for the reasons presented in the request. The combinations therefore provide a new, non-cumulative technical teaching not present in the original examination, would have been important to a reasonable examiner, and raise a substantial new question of patentability as to claims 1, 7, 8, 11 and 21. Accordingly, the petition is granted.

Additional Discussion

Under 37 C.F.R. § 1.931(b), “If the order for *inter partes* reexamination resulted from a petition pursuant to § 1.927, the *inter partes* reexamination will ordinarily be conducted by an examiner other than the examiner responsible for the initial determination.” MPEP § 2648 permits the CRU Director to make an exception “Only in exceptional circumstances where no other examiner is available and capable to give a proper examination.” While the MPEP is silent as to any other exceptions, the rule does not prohibit other exceptions in an exceptional situation. The CRU Director finds this to be an exceptional situation.

The ‘762 patent is one of nine patents under reexamination owned by the patent owner. While not all of the patents are directly related, all are related to similar technology, and all are asserted by patent owner in a single copending litigation. Three different third parties have each filed *inter partes* reexamination requests for each of these patents. There are therefore 27 *inter partes* reexamination proceedings that have been filed for these patents.

As of this writing, the current reexamination examiner has issued an Order granting *inter partes* reexamination in 11 of these proceedings, including this proceeding. He has been docketed and begun work on an additional 8 of the proceedings, including two more involving the ‘762 patent. As the examiner is already intimately familiar with all of these cases, with all of their associated factual situations including similar claim terminology, it would be an extreme waste of administrative resources to transfer the case to a new examiner having no familiarity with the patent or the family of cases.

The reasoning behind the rule is likely to prevent any real or perceived bias caused by requiring an examiner to work on a case after having his decision overturned by the Director. Any such bias is deemed to be negligible here. First, the request in this proceeding has already been granted; the examiner would have been required to work on this case regardless of the instant decision. Second, while a specific finding of fact by the examiner has been overturned here (the nature of Ke and Turner being cumulative), this was not a point of emphasis in the request. There is no apparent bias as to what Ke and Turner, (or WO528 for that matter), actually teach—the denial was based not on the reading of the reference teachings, but was based on how those teachings compared to Sonoda. Now that the proposals are a part of the proceeding, there is no reason why the examiner would regard the references any differently than a new examiner.

If this were a sole request of a single patent, there would be no reason to not comply with the ordinary circumstances of section 1.931(b). In light of the above, the facts show this to be an exceptional circumstance such that this section need not be applied. The CRU Director in signing below leaves it to the Supervisory Patent Examiner in his discretion to determine if the proceeding should be kept with the same examiner or reassigned.

CONCLUSION

1. Based on a *de novo* review of the record as a whole, the petition is granted. Accordingly, the request for *inter partes* reexamination of claims 1, 7, 8, 11, and 21 of the '762 patent is granted.
2. The examiner's other findings in the Order that were not mentioned in the petition are not disturbed.
3. The decision is final and non-appealable. See 35 U.S.C. § 312(c) and 37 C.F.R. § 1.927. No further communication on this matter will be acknowledged or considered.
4. Claims 1, 7, 8, 11, 12, 14, 15, 17 and 21 are subject to reexamination in this proceeding. An Office action will follow in due course.
5. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Examiner, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.



Irem Yucel
Director, Central Reexamination Unit