

# EXHIBIT I

<b>Notice of Panel Decision from Pre-Appeal Brief Review</b>	<b>Application/Control No.</b>	<b>Applicant(s)/Patent under Reexamination</b>	
	12/211,033	QUY, ROGER J.	
	SHIRLEY JIAN	<b>Art Unit</b>	
		3769	

This is in response to the Pre-Appeal Brief Request for Review filed 28 October 2011.

1.  **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

- The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
- The request does not include reasons why a review is appropriate.
- A proposed amendment is included with the Pre-Appeal Brief request.
- Other: .

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2.  **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

- The panel has determined the status of the claim(s) is as follows:  
 Claim(s) allowed: \_\_\_\_\_.  
 Claim(s) objected to: \_\_\_\_\_.  
 Claim(s) rejected: 1-4 and 6-21.  
 Claim(s) withdrawn from consideration: \_\_\_\_\_.

3.  **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4.  **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) Shirley Jian.

(3) Linda Dvorak.

(2) Sam Yao.

(4) \_\_\_\_\_.

/SHIRLEY JIAN/  
Examiner, Art Unit 3769

/SAM YAO/  
Supervisory Patent Examiner, Art  
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Supervisory Patent Examiner, Art  
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U.S. Patent and Trademark Office

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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) 00125/002005 (2051/14C4)	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>September 28, 2011</u> Signature <u>/Michelle Wolf/</u> Typed or printed name <u>Michelle Wolf</u>	Application Number 12/211,033		Filed September 15, 2008
	First Named Inventor Roger J. Quy		
	Art Unit 3769	Examiner Shirley Xeuying Jian	

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).  
 Note: No more than five (5) pages may be provided.

I am the

- applicant/inventor.
- assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)
- attorney or agent of record. Registration number 37966
- attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

/Mark Wieczorek/  
 Signature  
Mark D. Wieczorek  
 Typed or printed name  
619-818-4615  
 Telephone number  
October 27, 2011  
 Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

\*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
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### REASONS FOR REQUESTING PRE-APPEAL RELIEF

Claims 1–4 and 6–21 are pending and stand rejected as per a Final Office Action dated August 30, 2011. The claims stand rejected under 35 USC 102 (e) as being allegedly anticipated by US Patent No. 6,790,178 to Mault et al. (hereinafter “Mault”). In addition, Claims 1-4, 7-10, 12-16, and 20-21 stand rejected under 35 USC 103(a) as being allegedly unpatentable over US Patent No. 6,059,692 to Hickman (hereinafter “Hickman”) in view of US Patent No. 6,353,839 to King et al. (hereinafter “King”). Finally, Claims 11 and 17–19 stand rejected as being allegedly unpatentable over Hickman in view of King and further in view of US Patent No. 6,524,189 to Rautila (hereinafter “Rautila”). These rejections are discussed in turn, as necessary, below.

Applicant first notes clear errors with regard to Office policy. The Final Office Action initially addressed Applicant’s Response filed June 14, 2011 by alleging that “The applicant’s date of invention for his provisional application 60/172,486 was signed on November 6, 1999; however, the same application was not filed until December 17, 1999. Currently, the effective provisional date for 60/172,486 is December 17, 1999.”

Applicant submits that this statement is clearly erroneous. Applicant is permitted under 37 CFR 1.131 to submit a Declaration to establish invention of the subject matter of the rejected claims prior to the effective date of the reference on which the rejection is based. Applicant alleged and provided evidence proving up a date of invention at least as early as November 6, 1999, i.e., a Declaration under 37 CFR 1.131 to prove a date of invention prior to that of Applicant’s provisional filing date, this date antedating most of the provisional applications to which the Mault reference claimed priority. No substantive issues were raised with regard to this Declaration.

However, in the Final Office Action dated August 30, 2011, the Examiner rejected the Declaration as moot under MPEP 715.05 because “When the reference in question is a non-commonly owned US patent or patent application publication claiming the same invention as applicant and its publication date is less than 1 year prior to the presentation of claims to that invention in the application being examined, applicant's remedy, if any, must be by way of 37 CFR 41.202 instead of 37 CFR 1.131.” ( Page 9).

Applicant submits that this allegation is also clearly erroneous. On this issue in particular, Applicant is submitting these arguments in writing as Applicant was advised to do so upon calling the Office on September 21, 2011 in an attempt to remove this ground of rejection in a more expeditious manner.

Applicant believes MPEP 715.05 is inappropriately applied to the present case because the same deals with a US patent or application which claims the same invention, as defined in 37 CFR 41.203(a), as the Applicant. On the other hand, and pertinent to the present case, MPEP 706.02(b) states that a rejection based on 35 USC 102(e) can be overcome by “(D) filing an affidavit or declaration under 37 CFR 1.131 showing prior invention, if the reference is not a US patent or US patent application publication claiming the same patentable invention as defined in 37 CFR 41.203(a)”. MPEP 715(I)(A) states the same examination guideline of 706.02(b) in an alternative manner.

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