

EXHIBIT 1004:

10/31/2012 DECISION ON PETITION IN *INTER PARTES*

REEXAMINATION 95/001,973

Munchkin, Inc. & Toys "R" Us, Inc.: 1004



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,973	04/20/2012	D634,439 S	047122/416892	3482
28083	7590	10/31/2012	EXAMINER	
Goldberg Cohen LLP 1350 Avenue of the Americas 4th Floor New York, NY 10019			TUTTLE, CATHERINE A	
			ART UNIT	PAPER NUMBER
			2912	
			MAIL DATE	DELIVERY MODE
			10/31/2012	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)



UNITED STATES PATENT AND TRADEMARK OFFICE

---

Commissioner for Patents  
United States Patents and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

ALSTON & BIRD LLP  
BANK OF AMERICA PLAZA  
101 SOUTH TRYON STREET, SUITE 4000  
CHARLOTTE, NC 28280-4000

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 95001973

PATENT NO. : D634439

ART UNIT : 2900

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

---



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

Goldberg Cohen LLP  
1350 Avenue of the Americas  
4th Floor  
New York NY 10019

(For Patent Owner)

ALSTON & BIRD LLP  
BANK OF AMERICA PLAZA  
101 SOUTH TRYON STREET, SUITE 4000  
CHARLOTTE, NC 28280-4000

(For Third Party Requester)

*In re Hakim*

*Inter Partes* Reexamination Proceeding  
Control No. 95/001,973  
Filed: April 20, 2012  
For: U.S. Patent No. D634,439

: DECISION ON  
: PETITION UNDER  
: 37 CFR 1.181 &  
: 1.927

The third party requester, on August 13, 2012, filed a petition to the Director under 37 CFR § 1.181 for review of Denial Request for Inter Partes Reexamination of U.S. Patent No. D634,439 (hereinafter the petition). The Central Reexamination Unit has delegated this petition to the design technology center. The petition is before the Director of Technology Center 2900. Petitioner, the reexamination requester, seeks review of the Order Denying Request for Inter Partes Reexamination mailed July 13, 2012.

The petition is GRANTED to the extent that reexamination is granted for the claim of U.S. Patent No. D634,439.

## REVIEW OF FACTS

1. U.S. Patent No. D634,439 (hereinafter, the '439 patent) issued on March 15, 2011.
2. A request for *inter partes* reexamination was filed on April 20, 2012 for the single claim of the '439 patent by real parties in interest, Munchkin, Inc. and TOYS "R" US, Inc. The reexamination proceeding was assigned Control.No. 95/001,973.
3. A determination denying the request for reexamination of the claim of the '439 patent was mailed on July 13, 2012 in the 95/001,973 proceeding.
4. The instant petition was filed on August 13, 2012.

### Petitioner's Grounds in Support of the Requested Relief

Petitioner argues the 7/13/2012 USPTO Order is erroneous at least because: (a) it applies an improper standard for determining priority; (b) it makes incorrect factual and legal determinations when judging priority; and (c) it improperly fails to denote prior art as "primary" references.

## DECISION

### I. Standard of Review

35 USC 312(c) and 37 CFR 1.927 provide for the filing of a petition to review an examiner's determination refusing to order *inter partes* reexamination. The TC 2900 Director's review on petition is *de novo*. Therefore, the review will determine whether the examiner's refusal to order reexamination for the claim was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner's rationale for the denial of the request to order reexamination for the claim of the '439 patent or with every aspect of petitioner's support of the request for relief.

### II. Relevant Regulations for *Inter Partes* Reexamination

37 C.F.R. § 1.913 states in part:

- (a) Except as provided for in § 1.907 and in paragraph (b) of this section, any person other than the patent owner or its privies may, at any time during the period of enforceability of a patent which issued from an original application filed in the United States on or after November 29,

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.