



94

Edward C. Kwok
MACPHERSON KWOK CHEN & HEID LLP
1762 Technology Drive, Suite 226
San Jose CA 95110

(For Patent Owner)

MAILED

JUN 15 2005

REEXAM UNIT

Donald E. Daybell
ORRICK HERRINGTON & SUTCLIFFE LLP
4 Park Plaza, Suite 1600
Irvine, CA 92614

(For Third Party Requester)

In re Reissue Application of
Karol Doktor
Application No.: 11/152,835
Filed: June 14, 2005
For: U.S. Patent No. 5,826,259

:
:
: DECISION, *SUA SPONTE*,
: TO MERGE
: REISSUE AND
: REEXAMINATION
: PROCEEDINGS

In re Karol Doktor
Reexamination Proceeding
Control No.: 90/007,707
Filed: September 1, 2005
For: U.S. Patent No.: 5,826,259

:
:
:
:
:
:

The above-captioned reissue application and reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.565(d) at this time.

REVIEW OF FACTS

1. U.S. Patent No. 5,826,259 issued on October 20, 1998.
2. An application for reissue, assigned application No. 11/152,835, was filed by the patent owner on June 14, 2005.
3. Notice of the filing of the reissue application was published in the *Official Gazette* on July 26, 2005.
4. A request for reexamination, assigned control No. 90/007,707 (the '7707

reexamination proceeding), was filed by a third party requester on September 1, 2005.

5. Reexamination was ordered for the '7707 reexamination proceeding on September 30, 2005.

A patent owner's statement under 37 CFR 1.530 has not been received in the '7707 reexamination proceeding.

DISCUSSION REGARDING MERGER

Under 37 CFR 1.565(d):

"If a reissue application and an ex parte reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to suspend one of the two proceedings."

As evidenced by the above review of facts, reissue application No. 11/152,835 and reexamination control No. 90/007,707 are currently pending. Since the order to reexamine has been mailed in the reexamination proceeding, a decision under 37 CFR 1.565(d) is timely.

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted separately at the same time as to a particular patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of both proceedings. In making a decision on whether or not to merge the two proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

In order to provide efficient and prompt handling of all proceedings and to prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination proceeding will be merged in accordance with the decision set forth below.

It is to be noted, however, that the grant of merger of a reissue application and an ex parte reexamination proceeding under 37 CFR 1.565(d) is discretionary. *The present merger is not an assurance that, in a future similar situation, merger would be ordered.*

**DECISION MERGING THE REISSUE AND
REEXAMINATION PROCEEDINGS**

I. Merger of Proceedings

The above-captioned reissue and reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in Both Proceedings

1. The patent owner is required to maintain identical amendments in the reissue and reexamination files for purposes of the merged proceeding. The maintenance of identical amendments in both files is required as long as the proceedings remain merged. See 37 CFR 1.565(d).

2. A review of the reexamination file for the proceeding of reexamination control No. 90/007,707 shows that original patent claims 1-18 are present and no claims are added by amendment. A review of reissue application No. 11/152,835 shows that original patent claims 1-18 are present and no claims are added by amendment. Accordingly, the claims are identical in both proceedings.
3. It is noted, however, that the first paragraph of the specification is amended in the reissue application, while not so for the reexamination proceeding. An appropriate housekeeping amendment is required within ONE (1) MONTH of this decision placing the same amendments in both cases, specifically, the above-captioned reissue and reexamination proceedings. The response to the requirement must be limited to placing the same amendments in all cases, and patent owner must not address any issue of patentability in the housekeeping amendment.

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceedings

1. After the appropriate housekeeping amendment (see Part II above) is received, or after the time for same expires, the examiner should promptly prepare an Office action for the merged proceeding.
2. In the event that a housekeeping amendment is not timely submitted, the disclosures in both proceedings should be objected to as being inconsistent for the same underlying patent.
3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. 305 relating to the conduct of *ex parte* reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue-application examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. However, periods of response should be set at TWO (2) months to comply with the statutory requirement for special dispatch in *ex parte* reexamination (35 U.S.C. 305).
4. Each Office action issued by the examiner will take the form of a single action that jointly applies to the reissue application and the reexamination proceeding. Each action will contain identifying data for all of the cases, i.e, the reissue application and the reexamination proceeding, and each action will be entered into the file history for both files (which will be maintained as separate files).
5. Any response by the applicant/patent owner must consist of a single response, with two copies being filed for entry in the two files, with each of the two bearing

a signature. Any such responses must be served on the requester, who will also be sent copies of Office actions.

6. Pursuant to MPEP 2285:

“Amendments should be submitted in accordance with the reissue practice under ... 37 CFR 1.173; see MPEP § 1453.”

Thus, the filing of any amendments to the drawings, specification, or claims must comply with the provisions of 37 CFR 1.173 and the guidelines of MPEP 1453. It is to be noted that 37 CFR 1.121 does not apply to amendments in a reissue application. Accordingly, clean copies of the amended claims are not required, *and such clean copies are not to be submitted*. Instead, pursuant to 37 CFR 1.173(b)(2), amendments are to be presented via markings pursuant to 37 CFR 1.173(d), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.173(g), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the reissue application. *Amendments are not to be made relative to previous amendments*. Thus, for all amendments, all words not appearing in the patent are *always* underlined, and only words being deleted from the patent appear in brackets.

7. Where a paper is filed which requires payment of a fee (e.g., petition fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for patent owner's appellant brief, even though the brief relates to merged multiple proceedings and copies must be filed (as pointed out above) for each file in the merged proceeding.
8. Upon return of the present merged proceeding to the examiner, the examiner will review the files to insure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.
9. If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be concluded by the grant of the reissue patent, and the reissue patent will serve as the certificate under 37 CFR 1.570. See MPEP 2285.
10. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be concluded as follows. The reissue application will be held abandoned, and the merger will be dissolved as to the reissue application. With respect to the reexamination proceeding, the Director will proceed to issue a reexamination certificate under 37 CFR 1.570 in accordance with the last action of the Office, unless further action is clearly

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.