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ORRICK, HERRINGTON & SUTCLIFFE, LLP
IP PROSECUTION DEPARTMENT
2050 Main Street, Suite 1100
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EXAMINER

HOTALING, JOHN M

ART UNIT PAPER NUMBER

3992

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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.



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/012,869.

PATENT NO. 8217902.

ART UNIT 3992.

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)).

| | | |
|--|--------------------|-----------------------------------|
| Order Granting / Denying Request For Ex Parte Reexamination | Control No. | Patent Under Reexamination |
| | 90/012,869 | 8217902 |
| | Examiner | Art Unit |
| | JOHN HOTALING | 3992 |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The request for *ex parte* reexamination filed 17 May 2013 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a) PTO-892, b) PTO/SB/08, c) Other: _____

1. The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 (c) will be made to requester:

- a) by Treasury check or,
b) by credit to Deposit Account No. _____, or
c) by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

| | | |
|---|--|--|
| //John M Hotaling II// Primary Examiner, Art Unit 3992 | | |
|---|--|--|

cc:Requester (if third party requester)

ORDER GRANTING EX PARTE REEXAMINATION

A substantial new question of patentability affecting claims 1-68 of United States Patent Number 8,217,902 issued to Chang et al. is raised by the request for *ex parte* reexamination.

References Asserted by Requester as Raising Substantial New Question of Patentability

1. Japanese Published Patent Application No. 60-75927 ("Fujitsu") and corresponding English translation of the JP 75927 application (including Abstract)
2. U.S. Patent No. 6,137,427 to Ronald Binstead ("Binstead")
3. U.S. Patent Application Publication 2005/0030048 to Robert Bolender et al. ("Bolender")
4. Published UK Patent Application GB 2 168 816 A to Andrew Lambert ("Lambert")
5. Japanese Published Patent Application No. 61-84729 ("Honeywell") and corresponding English translation of the JP 84729 application (including Abstract)
6. U.S. Patent No. 5,374,787 to Robert Miller et al. ("Miller")

Summary of Prosecution History

Claims 1-68 are requested for reexamination and are the current claims in the Chang et al (US 8,217,902) Patent that issued July 10, 2012 from application 11/842,747 filed August 21, 2007 currently assigned to TPK Touch Solutions Inc.

Art Unit: 3992

In the non-final rejection of June 25, 2010 the examiner rejected claims 1-10 using the rejections below.

Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Seely et al. (US 6,188,391).

Claims 2-4 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seely et al. (US 6,188,391) in view of Hsu et al. (US 7,030,860).

Claims 5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seely et al. (US 6,188,391) in view of Mulligan et al. (US 2004/0119701).

The applicant replied by amending the original claims and adding claims 11-45 in a September 20, 2010 response. Subsequent to that response an interview was held on October 8, 2010 which resulted in further amendments to the claims being submitted by the applicant on October 12, 2010.

The examiner issued a final rejection on December 21, 2010 using the rejections below

Claims 1-4, 6-9, 11-14, 16-20, 22-28, 30-38 and 40-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Bolender (US 2005/0030048).

Claims 5, 10, 15, 21,29 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bolender et al. (US 2005/0030048) in view of Mulligan et al. (US 2004/0119701).

On February 22, 2011 the applicant made an after final amendment which amended claims 17, 25, 35, and 44 to be rewritten in independent form and added claims 46-68.

The examiner responded with an advisory action stating that the new limitation "formed on a rigid substrate" raises new issues that would require further consideration.

The examiner additionally maintained his position with respect to Bolender.

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