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**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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# *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/011,982*.

PATENT NO. *7634228*.

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)).

**ADVISORY ACTION**

***Response to Arguments***

**A. Priority Date Determination**

1. Re: The Office must give Deference to final Federal Court decisions

*(see Patent Owner's 3/13/2013 remarks, pp. 16-19)*

Patent Owner argues that both the Federal Circuit (*In re Baxter*) and the MPEP (§ 2259) support the contention that the USPTO "must give deference to final Federal Circuit Court decisions." However, neither *Baxter* nor the MPEP appear to hold that absolute deference is mandatory. Baxter expressly recognizes the incongruence of standards of proof at the judicial and administrative levels:

> This case thus illustrates the distinction between a reexamination and a district court proceeding. In *Fresenius,* we upheld the district court's grant of judgment as a matter of law because the patent challenger failed to meet its burden to prove invalidity by clear and convincing evidence . . .
>
> In contrast, during the reexamination, the examiner sufficiently identified the [facts] such that a reasonable person might accept that evidence to support a finding [of unpatentability] under a preponderance of the evidence standard of proof.

See *Baxter*, 678 F.3d at 1364-1365.

In this reexamination proceeding, the different results at the district court and the agency can be attributed to the differing standards of proof and not an improper re-ordering of the relative primacy between the two entities. At trial, the challenger to the '228 patent did not establish, with clear and convincing evidence, that the claims are invalid under § 112 for lack of

written support. On the other hand, in the instant reexamination proceeding it was found that based on preponderance of the evidence the claims lack the requisite written support in the parent application to provide a benefit of priority under § 120. That is, the facts tending to show that the parent application does not support the claims under § 112 are evident here by preponderance, but they did not rise to the level of clear and convincing at trial.

Contrary to Patent Owner's assertion, it has not been mandated that where, as here, the courts have ruled in favor of a patentee on the issue of patentability, that such a ruling must be followed by the PTO. Rather, it is recognized that "[l]est it be feared that we are erroneously elevating a decision by the PTO over a decision by a federal district court . . . using the same presentations and arguments, even with a more lenient standard of proof, the PTO ideally should not arrive at a different conclusion," *Id.* at 1365 (emphasis added). Admittedly, the different results at the judicial and agency levels are not the "ideal" disposition of the issues, but nonetheless, it is a natural by-product of the differing evidentiary requirements. MPEP § 2259 also stops short of mandating deference and instead adopts the equivocal language, "collateral estoppel may be applied in reexamination" (emphasis added).

Accordingly, Patent Owner's assertion of mandated judicial deference in this circumstance is unpersuasive.

2. Re: The Claims of the '228 Patent are similar to the claims of the '833 Patent, which have been recognized as having a priority date of March 28, 2000 by the Office and a final Federal Court decision

*(see Patent Owner's 3/13/2013 remarks, pp. 19-20)*

Patent Owner argues that previous determinations made by the Office during the examination of a patent application should be binding on the reexamination of related patents having similar claims. This argument is not persuasive. The purpose of reexamination is to determine the patentability of an issued patent on the basis of a proper request. Where the § 120 priority issue of the claims has been directly settled during the initial examination of the patent, a reexamination of that issue is precluded. See *In re NTP, Inc.*, Appeal No. 2010-1277, slip op. at 15-19 (Fed. Cir. 8/1/2011). However, there is no legal basis for the conclusion that agency determinations made in respect to a set of claims in one examination proceeding bar reexamination of the same underlying issues in respect to similar claims of another issued patent when the issues were not squarely addressed in the initial examination.

Patent Owner also argues that the judicial determinations made in respect to the '228 should be binding on the Office. This argument is unpersuasive for the reasons given above in section A.1, namely that judicial holdings are not binding on the Office due to the different evidentiary burdens at the court and agency levels.

3. Re: The decision by an Examiner during prosecution is binding on the Office during a subsequent prosecution

*(see Patent Owner's 3/13/2013 remarks, pp. 20-22)*

Patent Owner argues that since the Examiner "necessarily considered § 112 written description support," this issue is foreclosed from further consideration in the reexamination

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