

Order Granting / Denying Request For Ex Parte Reexamination	Control No. 90/011,607	Patent Under Reexamination 6057221	
	Examiner JOHN HEYMAN	Art Unit 3992	

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

The request for *ex parte* reexamination filed 30 March 2011 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)).

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cc:Requester (if third party requester)

Decision Granting Ex Parte Reexamination

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 03/30/2011 was filed after the mailing date of the instant Reexam Application on 03/30/2011. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

Preliminary Matters

The proposed amendment adding claims and changing others in the Request for Reexamination herein will be addressed upon an action on the merits being made. Only the claims issued in the base patent are discussed in this Order.

Substantial New Questions of Patentability

Substantial new questions of patentability affecting Claims 1-21 of the base patent are raised by the Request for ex parte reexamination based on the following references:

U.S. Patents:

- * Lee et al., U.S. Patent No. 5,608,257 (hereinafter "Lee");
- * Lou et al., U.S. Patent No. 5,729,042 (hereinafter "Lou");
- * McClure et al., U.S. Patent No. 4,826,785 (hereinafter "McClure");
- * Nishimura et al., U.S. Patent No. 5,872,389 (hereinafter "Nishimura").

Foreign Patent Publications and Non-Patent Literature Documents:

- * Koyou, Japan Pat. Appl. Publ. No. 8-213465, published Aug. 20, 1996, and corresponding Non-Patent Literature Document (hereinafter "NPL"), Cite No. 1 (hereinafter "Koyou");

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* Matsumoto, Japan Pat. Appl. Pubi. No. 6-104338, published @r. 15, 1994, and corresponding NPL, Cite No. 3 (hereinafter "Matsumoto"); and

* Wada et. al., Japan Pat. Appl. Publ. No. 6-244285, published Sep. 2, 1994, and corresponding NPL, Cite No. 2 (hereinafter "Wada").

Of the above seven references, only Lee was cited during the prosecution of application of the base patent. The Patent Owner Requester stated however, that the Patentees do not necessarily agree with the characterization (by the Examiner on page 4, para. 4 of the '808 Application). That is, that "the cut-link pad has a simple continuous shape having no projections extending away therefrom (patentees maintain that the cut-link pad can have additional parts or a relatively complex structure) or (2) the shape of the cut-link pad was incorporated into the independent claim(s)". That "the disclosure of Lee may not have been completely considered by the Examiner". And, that "depending on whether a cut-link pad can have a complex structure and include regions having a narrow neck as described by Lee, a reasonable examiner might consider these disclosures important in determining whether or not claim is patentable". This, it is argued in the Request pages 15 and 16, as being contrary to the disclosure of the base patent which provides otherwise.

Prosecution History

The base patent to Bernstein et al (US patent 6,057,221) hereinafter base patent '221 or Bernstein '221, stems from US patent Application 08/825,808 (Application '808). A detailed prosecution history is provided on pages 4-7 of the Request, which remarks are incorporated herein by reference. A Notice of Allowance was issued on 12/08/1999

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in the referred to base Application '808 in which the following reasons for allowance were given:

"the prior art either singly or in combination fails to anticipate or render obvious the limitations of,

...directing a laser upon an electrically-conductive cut-link pad conductively bonded between a first electrically-conductive line and a second electrically-conductive line on a substrate, the cut-link pad having substantially less thermal resistance per unit length than each of the first and second lines, wherein the width of the cut-link pad is at least ten percent greater than the width of each of the first and second electrically-conductive lines.

As stated in the office action of paper # 8, by incorporating the shape of the cut-link pad into the independent claim, said claim would be allowable".

Thus, a substantial new question (SNQ) of patentability exists where any prior art uncovered shows or discloses the shape of the cut-link pad having; (1) substantially less thermal resistance per unit length than each of the first and second lines, and (2), wherein the width of the cut-link pad is at least ten percent greater than the width of the first and second electrically-conductive lines. It is asserted by the Requester that the prior art cited above provides such teachings.

Requester's Position

The Requester has requested reexamination of Claims 1-21 of base patent '221 as follows:

1. Reexamination of Claims 1-2, 6-9, 11, 13-16, and 19-21 is requested in view of Nishimura.
2. Reexamination of Claims 1 and 6-8 is requested in view of Wada.
3. Reexamination of Claim 1 is requested in view of Matsumoto.
4. Reexamination of Claim 1 is requested in view of Lee.

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5. Reexamination of Claims 1, 3-4 and 11 is requested in view of Koyou.
6. Reexamination of Claims 10, 17-18 and 21 is requested in view of Nishimura and Koyou.
7. Reexamination of Claims 10, 16 and 21 is requested in view of Nishimura and Wada.
8. Reexamination of Claims 12-13 and 19 is requested in view of Wada and McClure.
9. Reexamination of Claims 12-15 and 19 is requested in view of Wada and Lou.
10. Reexamination of Claim 12 is requested in view of Nishimura and McClure.
11. Reexamination of Claim 12 is requested in view of Nishimura and Lou.
12. Reexamination of Claims 17-18 is requested in view of Koyou and McClure.
13. Reexamination of Claims 17-18 is requested in view of Koyou and Lou.
14. Reexamination of Claim 21 is requested in view of Wada, McClure and Koyou.
15. Reexamination of Claim 21 is requested in view of Wada, Lou and Koyou.

Analysis of the SNQs asserted by the Requester

Issue 1 regarding Nishimura and Claims 1-2, 6-9, 11, 13-16 and 19-21

It is **agreed**, as stated on pages 7-13 of the Request, incorporated herein by reference, that Nishimura discloses that the width of first a portion 2a is greater than the width of second portion 2b, and therefore, that the first portion 2a would have less thermal resistance than the second portion 2b. As such teachings were not present during the prior examination of base patent '221 and were found important to the patentability of the claims, a reasonable examiner would consider these teachings important in determining whether or not Claims 1-2, 6-9, 11, 13-16 and 19-21 are

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