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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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95/001,745	09/07/2011	7229597	04119.000400.36	4882
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13872 7590 08/13/2013
 Servilla Whitney LLC (Reexaminations)
 33 Wood Avenue South
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 Iselin, NJ 08830

EXAMINER

LOPEZ, CARLOS N

ART UNIT	PAPER NUMBER
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3991

MAIL DATE	DELIVERY MODE
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08/13/2013

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.

Transmittal of Communication to Third Party Requester <i>Inter Partes</i> Reexamination	Control No.	Patent Under Reexamination	
	95/001,745	7229597	
	Examiner	Art Unit	
	CARLOS LOPEZ	3991	

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

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

FITZPATRICK CELLA HARPER & SCINTO
1290 Avenue of the Americas
New York, NY 10104-3800

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

Right of Appeal Notice (37 CFR 1.953)	Control No.	Patent Under Reexamination
	95/001,745	7229597
	Examiner	Art Unit
	CARLOS LOPEZ	3991

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

Responsive to the communication(s) filed by:
 Patent Owner on 16 October, 2012
 Third Party(ies) on 15 November, 2012

Patent owner and/or third party requester(s) may file a notice of appeal with respect to any adverse decision with payment of the fee set forth in 37 CFR 41.20(b)(1) within **one-month or thirty-days (whichever is longer)**. See MPEP 2671. In addition, a party may file a notice of **cross** appeal and pay the 37 CFR 41.20(b)(1) fee **within fourteen days of service** of an opposing party's timely filed notice of appeal. See MPEP 2672.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

If no party timely files a notice of appeal, prosecution on the merits of this reexamination proceeding will be concluded, and the Director of the USPTO will proceed to issue and publish a certificate under 37 CFR 1.997 in accordance with this Office action.

The proposed amendment filed 16 October, 2012 will be entered will not be entered*

*Reasons for non-entry are given in the body of this notice.

- 1a. Claims 1-15 are subject to reexamination.
- 1b. Claims _____ are not subject to reexamination.
2. Claims _____ have been cancelled.
3. Claims _____ are confirmed. [Unamended patent claims].
4. Claims _____ are patentable. [Amended or new claims].
5. Claims 1-15 are rejected.
6. Claims _____ are objected to.
7. The drawings filed on _____ are acceptable. are not acceptable.
8. The drawing correction request filed on _____ is approved. disapproved.
9. Acknowledgment is made of the claim for priority under 35 U.S.C. 119 (a)-(d) or (f). The certified copy has:
 been received. not been received. been filed in Application/Control No. _____.
10. Other _____

Attachments

1. Notice of References Cited by Examiner, PTO-892
2. Information Disclosure Citation, PTO/SB/08
3. _____

***Inter Partes Reexamination
Right of appeal Notice***

Procedural History

A request for inter partes reexamination of claims 1-15 of United States Patent Number 7, 229, 597 to Patchett et al.al (hereinafter "the '597 Patent"), was filed by a third party requester on September 7, 2011. An order granting the reexamination request and a first office action on the merits were mailed on 11/30/11. Patent Owner timely filed a response on 2/8/12. Subsequently, Third Party Requester filed its response on 3/9/12 and petitioned to waive the page limit of C.F.R 1.943(b). The Petition was granted on 8/14/12. An action closing prosecution (ACP) was mailed on 8/16/12. An extension of time was filed by the patent owner on 8/24/12 and was granted on 8/31/12. The patent owner filed a response to the ACP ("PO ACP response") on 10/16/12 and petitioned to waive the page limit of C.F.R 1.943(b). The patent owner's petition to waive the page limit was granted on 2/20/13. The third party filed comments to patent owner response to the ACP ("Third party ACP response") on 11/15/12 along with a petition waive the page limit. Third party's petition to waive the page limit was dismissed on 2/20/13 as being unnecessary.

Patent Owner's Amendment after ACP

The Patent Owner's amendment filed on 10/16/12 will not be entered for the reasons that follow.

An amendment after ACP "will be subject to the criteria of § 1.116 as to whether or not it shall be admitted." See 37 C.F.R. 1.951 (a). 37 C.F.R § 1.116 (b) states the following:

- (1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
- (2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
- (3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

The amendment by the patent owner filed after ACP proposes, among other things, to insert the phrases "slurry loaded washcoat," and "including a zeolite and a base metal component."

As to 1.116 (b) (1), the proposed amendment does not cancel any claims or is complying with any requirements expressed in the previous office action.

As 1.116 (b) (2), the proposed amendment does not place the rejected claims in better form for consideration on appeal because the amendment would necessitate new grounds of rejections under 35 U.S.C 112 1st and 2nd paragraph, which would also necessitate that prosecution be re-opened contrary to the statutory requirement that inter partes reexamination be conducted with special dispatch within the office.

Specifically, according to the patent owner the phrase "slurry loaded washcoat" provides a "washcoat partially or fully fills the pores" of the filter wall. See PO ACP response at page 14. However, this structural feature of partial or fully filled pores is not disclose in the specification in such a way as to reasonably convey to one skilled in the

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