



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/013,302	07/21/2014	6,542,076 B1		2538

7590 09/08/2014
RAYMOND A. JOAO ESQ.
122 BELLEVUE PLACE
YONKERS, NY 10703

EXAMINER

REICHLER, KARIN M

ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
09/08/2014	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.



DO NOT USE IN PALM PRINTER

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

KENYON & KENYON LLP

ONE BROADWAY

NEW YORK, NY 10004

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/013,302.

PATENT NO. 6,542,076 B1 E.

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)).

DECISION ON REQUEST FOR *EX PARTE* REEXAMINATION

Third Party requester submitted a request for reexamination with a filing date of July 21, 2014, requesting reexamination of claim 3 of US Patent 6,542,076 (hereinafter also referred to as '076). A substantial new question of patentability affecting claim 3 of '076 is raised by the request for *ex parte* reexamination. Accordingly, claim 3 will be reexamined.

Extensions of Time

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extension of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

Notification of Concurrent Proceedings

The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a), to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 6,542,076 throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

Amendment in Reexamination Proceedings

Patent owner is notified that any proposed amendment to the specification and/or claims in this reexamination proceeding must comply with 37 CFR 1.530(d)-(j), must be formally

Art Unit: 3992

presented pursuant to 37 CFR 1.52(a) and (b), and must contain any fees required by 37 CFR 1.20(c). See also discussion *infra*, i.e. *Other Matters*

Submissions

In order to insure full consideration of any amendments, affidavits or declarations or other documents as evidence of patentability, such documents must be submitted in response to the first Office action on the merits (which does not result in a close of prosecution).

Submissions after the second Office action on the merits, which is intended to be a final action, will be governed by the requirements of 37 CFR 1.116, after final rejection and by 37 CFR 41.33 after appeal, which will be strictly enforced.

Waiver of Right to File Patent Owner Statement

In a reexamination proceeding, Patent Owner may waive the right under 37 C.F.R. 1.530 to file a Patent Owner Statement. The document needs to contain a statement that Patent Owner waives the right under 37 C.F.R. 1.530 to file a Patent Owner Statement and proof of service in the manner provided by 37 C.F.R. 1.248, if the request for reexamination was made by a third party requester, see 37 C.F.R. 1.550(f). The Patent Owner may consider using the following statement in a document waiving the right to file a Patent Owner Statement:

WAIVER OF RIGHT TO FILE PATENT OWNER STATEMENT

Patent Owner waives the right under 37 C.F.R. 1.530 to file a Patent Owner Statement.

Art Unit: 3992

The Interview Summary dated August 4, 2014 indicates that USPTO personnel were unable to reach the patent owner, i.e. the patent owner did not agree to waive its right to file a patent owner statement under 35 U.S.C. 304 in the event the reexamination request is granted.

Service of Papers

After filing of a request for *ex parte* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party (or parties where two or more third party requester proceedings are merged) in the reexamination proceeding in the manner provided in 37 CFR 1.248. The document must reflect service or the document may be refused consideration by the Office. See 37 CFR 1.550(f).

References Asserted as Raising a Substantial New Question

The asserted substantial new question of patentability (SNQP) regarding claim 3 of the '076 Patent is based upon the following references:

(1) U.S. Patent 5,070,320 to Ramono, filed June 12, 1989 and issued December 3, 1991 (hereinafter also referred to as '320 or Ramono '320).

(2) U.S. Patent 6,072,402 to Kniffin, filed January 9, 1992 and issued June 6, 2000 (hereinafter also referred to as '402 or Kniffin '402).

(3) U.S. Patent 5,113,427 to **Ryoichi** et al, filed August 24, 1990 and issued May 12, 1992 (hereinafter also referred to as '**427** or **Ryoichi** '427).

(4) U.S. Patent 5,276,728 to **Pagliarioli** et al, filed November 6, 1991 and issued January 4, 1994 (hereinafter also referred to as '**728** or **Pagliarioli** '728).

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.