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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,621 - 906/1011	05/16/2011	7,241,034		1240

92045 7590 02/23/2012

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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 02/23/2012

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
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Date: 2-23-12

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95001621 \* 90/011011  
PATENT NO. : 7241034  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3992

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.

PTOL-2070(Rev.07-04)



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(For Patent Owner)

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(For the '1621 Requester)

*In re Smith et al.*  
*Ex Parte* Reexamination Proceeding  
Control No.: 90/011,011  
Filed: July 10, 2010  
For: U.S. Patent No. 7,241,034

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:  
: **DECISION**  
: **SUA SPONTE**  
: **TO MERGE**  
: **REEXAMINATION**  
: **PROCEEDINGS**

*In re Smith et al.*  
*Inter Partes* Reexamination Proceeding  
Control No.: 95/001,621  
Filed: May 16, 2011  
For: U.S. Patent No.: 7,241,034

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The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration on merging the above proceedings.

*Ex parte* reexamination proceeding No. 90/011,011 and *inter partes* reexamination proceeding No. 95/001,621 **are merged** into a single proceeding.

**BACKGROUND**

1. On July 10, 2007, United States Patent Number 7,241,034 (“the ‘034 patent”) issued to Smith *et al.* with 5 claims.
2. On July 10, 2010, patent owner filed a request for *ex parte* reexamination of claims 1 and 3 of the ‘034 patent, which was assigned control number 90/011,011 (“the ‘11011 proceeding”).<sup>1</sup>
3. On August 12, 2010, *ex parte* reexamination of claims 1 and 3 of the ‘034 patent was granted in the ‘11011 reexamination proceeding.
4. On October 12, 2010, the time period for submission of a patent owner’s statement under 37 CFR 1.530(b) expired.

<sup>1</sup> Patent owner originally deposited a request on May 25, 2010 that was found incomplete by the Office and was subsequently supplemented until found sufficient to grant a filing date of July 10, 2010.

5. On January 12, 2011, the Office issued a non-final rejection in the '11011 proceeding.
6. On January 18, 2011, patent owner timely filed an informal/non-responsive amendment after an Office action.
7. On February 16, 2011, patent owner timely filed a substitute amendment, which amended claims 1-5 and added new claims 6-45.
8. On May 16, 2011, a request for *inter partes* reexamination of claims 1-5 of the '034 patent was filed by a third party requester, which was assigned Reexamination Control No. 95/001,621 ("the '1621 proceeding"). The request identified Volkswagen Group of America, Inc. ("the 1621 requester") as the real party in interest.
9. On June 23, 2011, *inter partes* reexamination of claims 1-5 of the '034 patent was granted in the '1621 proceeding.
10. On January 18, 2012, the Office issued a Notice of Defective Paper in the '11011 proceeding requesting correction of the February 16, 2011 substitute amendment.
11. On February 2, 2012, patent owner timely filed a second substitute amendment, which amended claims 1-5 and added new claims 6-41.
12. To date, no Office action has issued in the '1621 proceeding.

## DECISION

### I. MERGER OF PROCEEDINGS

Reexamination has been ordered in the above-captioned two proceedings for overlapping claims of the same patent. One of the proceedings (the '11011 proceeding) is an *ex parte* proceeding. The other proceeding (the '1621 proceeding) is an *inter partes* proceeding. Both proceedings are still pending, and have not been terminated. The time period for filing a patent owner statement under 37 CFR 1.530 in the *ex parte* proceeding has expired. Therefore, consideration of merger is ripe at this point in time.

MPEP 2686.01 points out:

Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, the proceedings will be merged where the Office (in its discretion) deems it appropriate to do so, to facilitate the orderly handling of the proceedings. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. 314(c) to conduct reexamination proceedings with "special dispatch."

In this instance, based upon the record as a whole, it is found, based on the facts as they exist at present, that merger of the proceedings should facilitate the orderly handling of the proceedings with special dispatch. Accordingly, the 90/011,011 and 95/001,621 proceedings **are hereby merged**. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

## II. THE SAME CLAIMS MUST BE MAINTAINED IN BOTH PROCEEDINGS

Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. An amendment accompanied the patent owner's statement in the '11011 *ex parte* reexamination proceeding. Originally issued claims 1-5 have all been amended and new claims 6-41 have been added in the '11011 *ex parte* proceeding, while the claims in the '1621 *inter partes* proceeding have not been so amended. Thus, the claims are not currently the same in both proceeding files. An Office action requiring an amendment placing the claims of both proceedings in identical form is being issued concurrently with this decision. Patent owner must respond to the Office action in accordance with the procedure provided in 37 CFR 1.111. The *inter partes* third party requester will then have an opportunity to comment on patent owner's response in accordance with the procedures in 37 CFR 1.947.

The patent owner is required to maintain the same claims (and specification) in both files *throughout the merged proceeding*.

## III. CONDUCT OF MERGED PROCEEDING

### A. Governing regulations for the merged proceeding:

The present decision merges an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. Pursuant to 37 CFR 1.989(b), the merged proceeding is governed by 37 CFR 1.902 through 1.997.

### B. *Inter partes* Third Party Requester Participation:

#### 1. Comment rights:

The *inter partes* requester can comment pursuant to 35 U.S.C. 314(b)(2).<sup>2</sup> First, an *inter partes* requester's right to comment is contingent upon the patent owner responding to, or commenting on, an Office action. Second, the *inter partes* requester's right to comment is limited to issues raised in either the Office action or the patent owner's response to the action. Finally, the *inter partes* requester's comments must be submitted within 30 days from the date of service of the patent owner's response. An *inter partes* requester does not have a right to comment on any issue raised outside the confines of the statute, e.g. issues raised in a previous Office action (but

<sup>2</sup> Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the *inter partes* third-party requester shall have one opportunity to file written comments addressing issues raised by the action of the Office or the patent owner's response thereto, if those written comments are received by the Office within 30 days after the date of service of the patent owner's response.

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