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EXAMINER

BASEHOAR, ADAM L

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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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**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/013,016.

PATENT NO. 7647633.

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)).



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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

Application Number: 90/013,016  
Filing Date: October 07, 2013  
Appellant(s): 7647633

\_\_\_\_\_  
Dawn-Marie Bey (Reg. No. 44,442)  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the Appeal Brief filed 08/24/2015.

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### **(1) Grounds of Rejection to be Reviewed on Appeal**

Every ground of rejection set forth in the Office action dated 05/22/2015 (hereafter the “Final Action”) from which the appeal is taken is being maintained by the Examiner except for the grounds of rejection (if any) listed under the subheading “WITHDRAWN REJECTIONS.” New grounds of rejection (if any) are provided under the subheading “NEW GROUNDS OF REJECTION.”

### **(2) Response to Argument**

Appellant’s arguments filed 08/24/2015 have been fully considered but they are not persuasive.

#### **A. Substantial New Question of Patentability (SNQ) Determination**

Appellant generally argues (Appeal Brief: pp. 11-13) that both Ji and Golan, among other references, were either explicitly or inherently considered by Primary Examiner Revak during the prosecution of the Edery ‘633 patent. Appellant argues that both Ji and Golan are not new and are the exact same references that were differentiated in the background of the Edery ‘633 specification and considered and cited by the Office during the examination of the Edery ‘633 patent. Thus, Appellant alleges there is strong evidence against the finding of a SNQ in light of the Ji and Golan references.

The Examiner respectfully disagrees with the Appellant and notes that the Appeal Brief does not “clearly present the issue and arguments regarding the examiner’s SNQ determination

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under a separate heading and identify the communication in which the patent owner first requested reconsideration before the examiner” as suggested by MPEP §2274(VI). Additionally, the SNQ Determinations are not listed in Section IV of the Appeal Brief. However, if the SNQ Determinations are in fact appealed to the Board, Appellant’s arguments are not found to be persuasive for the reasons stated in the Final Action. Said reasons are reproduced below:

As noted in the Order (see: Order, pp. 10-13), “The existence of a substantially new question of patentability is not specifically precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.” Similarly, in relation to the use of the same or substantially identical prior art previously cited/considered during prior examination, MPEP §2242(II)(A) states that “Determinations on whether a substantial new question of patentability exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis. For example, a substantial new question of patentability may be based solely on old art where the old art is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier examination(s), in view of a material new argument or interpretation presented in the request. Such material new argument or interpretation may be based solely on claim scope of the patent being reexamined.” In the instant case, the Order specifically determined that Ji and Golan in combination with Ji each presented substantial new questions of patentability in light of the prosecution history of the Edery ‘633 patent.

Regarding the Ji reference, it was noted in the Order that Ji was cited by the prior examiner and was generally described in the “Background Of The Invention” section of the Edery ‘633 patent (see: Order, p. 3). However, it was further noted that the prosecution history

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