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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/013,740	05/18/2016	8155012	31AE-226116	1868

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HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

EXAMINER
CRAVER, CHARLES R

ART UNIT	PAPER NUMBER
3992	

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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.

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SHEPPARD, MULLIN, RICHTER & HAMPTON LLP
379 LYTTON AVENUE
PALO ALTO, CA 94301

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/013,740*.

PATENT NO. *8155012*.

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)).

ADVISORY ACTION

I. Summary

In the instant 90/013,740 Reexamination of US Pat 8,155,012 ("the '012 Patent"), claims 1-148 are under reexamination in light of the Order Granting Reexamination mailed 6/21/2016 in response to the Request for reexamination filed 4/27/2016 by the Third Party Requestor. **Claims 1-148 stand finally rejected**.

II. Notice Regarding Certain Reexamination Issues

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

The Patent Owner is reminded of the continuing responsibility under 37 CFR 1.985 to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 8,155,012 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP § 2686 and 2686.04.

Any paper filed by either the patent owner or the third party requester ***must be served*** on the other party in the reexamination proceeding in the manner provided by 37 CFR 1.248. See 37 CFR 1.903 and MPEP 2666.06.

Pending Proceedings

The instant '012 Patent is currently the subject of two pending Inter Partes Reviews before the Patent Trial and Appeal Board. See IPR2016-01389 and IPR2017-00790. These two are currently joined. Two other Inter Partes Reviews are no longer pending, however such are noted as part of the prosecution history of the instant patent. See IPR2016-00983 and IPR2016-01425.

III. Affidavit/Declaration

Patent Owner files, concurrent with his Remarks, Declarations by John Austermann III and Albert McGilvra, under 37 CFR 1.132.

> (e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under §1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 but before or on the same date of filing an appeal (§ 41.31 or § 41.61of this title), may be admitted *upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented*.
>
> 37 CFR 1.116, Amendments and affidavits or other evidence after final action and prior to appeal (emphasis added).

Patent Owner here asserts that these Declarations are in response to the Final Action mailed 2/16/2017, arguing first that the Office presented construction of certain claim terms in the Final Action, and second that an after Final interview of 5/3/2017 provided 'technical interpretations' as to the invention. Response at 6-7.

First, the Final Action of 2/16/2017 did not change the construction of claim terms in the instant claims as they apply in the rejection. In his 12/8/2016 Response to the

Non-Final Action mailed 9/8/2016, Patent Owner argued various claim terms, and in the Final Rejection in response thereto the Examiner presented arguments in opposition in part noting the pre-existing record of claim interpretation present in the prosecution history of the instant patent. The Office did not change the construction of claim terms as applied in the rejection, nor did the ground of rejection change, and it is noted that the aforementioned arguments by the Examiner did not differ from those presented in the Request.

Second, the while Patent Owner may have intended the Interview of 5/3/2017 to clarify certain issues regarding the claims and the prior art, the Examiner did not in the Interview present any new or different interpretation of the references or claim terms as they apply in the rejection. It is noted here that while Patent Owner asserts that he did not have the benefit of an interview, in his original 3/24/2017 Request for Extension of Time he made no mention of needing an interview to clarify any issues with the Office; rather Patent Owner merely requested additional time to continue to prepare his written response. Later, Patent Owner petitioned for and was granted another extension of time for the purposes of an interview; Patent Owner failed to provide, for the Interview, any written statement of the issues to be discussed as required by Office policy.

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