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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,332	01/08/2008	7,228,383	321264US91RX	1059

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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 04/15/2010

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



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MAILED

APR 15 2010

CENTRAL REEXAMINATION UNIT

DECISION
DENYING
PETITION

In re Reexamination proceeding 95/000,332

Filed JANUARY 8, 2008

For: SYSTEM AND METHOD FOR PROGRESSIVE AND HIERARCHICAL CACHING

For: U.S. Patent No.: 7,228,383

This is a decision on patent owner's petition filed October 8, 2009 under 37 CFR 1.181(a)(3) requesting that the Director exercise his supervisory authority and overturn the September 29, 2009 decision of the Director of the Central Reexamination Unit (CRU Director), which denied patent owner's request to strike third party requester's May 27, 2009 comments under 37 CFR 1.947.

The petition to overturn the September 29, 2009 decision of the CRU Director is granted to the extent that the prior decision has been fully reconsidered, and is denied as to the underlying relief requested.

This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review.

BACKGROUND

1. On 08 January 2008, a request for reexamination of U.S. Patent 7,228,383 was filed, and the request was assigned control number 95/000,332 (the '0332 proceeding).
2. On 06 February 2009, a non-final Office action was mailed for the '0332 proceeding, setting a two month period for response by patent owner.
3. On 06 April 2009, a response to the non-final Office action was filed by patent owner.
4. On 20 April 2009 a Notice of Defective Paper in *Inter-Partes* Reexamination was mailed to patent owner notifying patent owner that the 06 April 2009 response was defective. The defect identified in this paper was (paraphrasing) the use of strikeout rather than bracketing to identify subject matter removed from a patent claim. Patent owner was given 30 days or one month to respond to the Notice. On page 2 of the Notice (see the electronic record), the third party requester was informed that "[p]rior 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."
5. On 29 April 2009,¹ the patent owner submitted a corrected response to the non-final Office action of 06 February 2009. In the 29 April 2009 submission, on page 1 of the "Supplemental amendment...", the submission is described as a "response to the *Inter Partes* Reexamination Communication dated April 20, 2009."
6. On 27 May 2009, the requester submitted comments after the patent owner's response of 29 April 2009.
7. On 17 June 2009, the patent owner submitted a petition under 37 CFR 1.181 requesting that the Director exercise his supervisory authority to strike the third party response of 27 May 2009 as non-compliant for being untimely.
8. On 09 September 2009, the 17 June 2009 petition was denied by the CRU Director.

¹ The electronic record shows a submission on 27 April 2009 and a submission on 29 April 2009 from the patent owner. The instant petition, on page 2, indicates that a telephone call was made to correct defects in the paper of 27 April 2009, resulting in the compliant submission of 29 April 2009.

9. On 08 October 2009, the patent owner submitted the present petition requesting reconsideration of the CRU Director's decision of 09 September 2009.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

35 U.S.C. § 314(b)(2) states:

Each time that the patent owner files a response to an action on the merits from the Patent and Trademark Office, the 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.

37 CFR 1.181 states, in part:

- (a) Petition may be taken to the Director:
- (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
 - (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and
 - (3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

37 CFR 1.947 states:

Comments by third party requester to patent owner's response in *inter partes* reexamination

Each time the patent owner files a response to an Office action on the merits pursuant to § 1.945, a third party requester may once file written comments within a period of 30 days from the date of service of the patent owner's response. These comments shall be limited to issues raised by the Office action or the patent owner's response. The time for submitting comments by the third party requester may not be extended. For the purpose of filing the written comments by the third party requester, the comments will be considered as

having been received in the Office as of the date of deposit specified in the certificate under § 1.8.

MPEP 2262 states, in part:

The time periods for response and comments for the various stages of an *inter partes* reexamination proceeding are as follows:

...(B) After an Office letter indicating that a response by the patent owner is not proper.

After an Office letter indicates that a response filed by the patent owner is not completely responsive to a prior Office action (i.e., an incomplete response), the patent owner is required to complete the response within the time period set in the Office letter. 37 CFR 1.957(d). A time period of 30 days or one month (whichever is longer) is normally set. Any third party requester comments on a supplemental patent owner response that completes the initial response must be filed within 30 days from the date of service of the patent owner's supplemental response on the third party requester.

MPEP 2666.60 states, in part:

After the patent owner or the third party requester has provided a submission directed solely to correcting the defect, the other party is not permitted to comment on the submission correcting the defect, since the submission correcting the defect is directed to form and does not go to the merits of the case. This would be the case, for example, where the failure to provide a signature or a certificate of service is corrected, or where a permanent copy is submitted to replace an "easily erasable" paper that was originally submitted.

In the case of correcting a defective amendment, however, other issues come into play. Where for example, new claims 10-20 are improperly presented in a patent owner response (e.g., not properly underlined), they generally will not be entered and form PTOL-2069 (Box 4) will be used to notify the patent owner of the need to correct this defect. Until the defect is corrected, claims 10-20 do not yet exist in the proceeding for the third party requester to comment on. Likewise, any argument that was directed to such claims is not truly ripe for the third party requester comment. After the patent owner corrects the defect, claims 10-20 come into existence in the proceeding, and the argument presented by the patent owner becomes relevant. At this point, the third party requester has a right to provide comments in response to the patent owner's argument, whether or not the argument that was included in the original patent owner submission is re-presented with the paper correcting the defect. Thus, any third party requester

comments submitted either in response to the patent owner's initial paper (presenting the informal claims) or in response to the patent owner's supplemental paper (correcting the informality) will be considered by the examiner.

OPINION

Petitioner (Patent Owner) seeks intervention by the Director to reverse the CRU Director's decision of 29 September, 2009, on the grounds that, by statute (35 U.S.C. § 314(b)(2)), the third party response requester's 27 May 2009 comments paper was required to have been filed 30 days from the patent owner's initial (non-compliant) response of 06 April 2009, rather than 30 days from the patent owner's corrected response of 29 April 2009. Accordingly, petitioner seeks expungement of third-party requester's 27 May 2009 comments paper.

For the Director to intervene, petitioner must show that the 29 September, 2009 decision by the CRU Director was made in clear error. Petitioner has not provided a showing of clear error. A petition under 37 CFR 1.181, requesting that the Director of the USPTO exercise his or her supervisory authority and vacate the examiner's decision, will not be entertained except where there is a showing of clear error. See *Ex parte Hartley*, 1908 C.D. 224, 136 O.G. 1767 (Comm'r Pat. 1908). The CRU Director's ultimate decision is entitled to an administrative presumption of correctness in the absence of a convincing showing of clear error. A review of the record indicates that the CRU Director did not abuse his discretion, or act in an arbitrary and capricious manner, in the petition decision of February 5, 2008. The record establishes that the CRU Director had a reasonable basis to support his findings and conclusion.

Both the record of this proceeding and Office policy on this matter are clear that the third party requester was permitted to file its comments submission under 37 CFR 1.947 within 30 days from Patent Owner's corrected response.

(1) Page 2 (transmittal) of the electronic record of the 20 April 2009 "Notice re Defective Paper in *Inter Partes* Reexamination" states that third-party requester may once file comments each time the Patent Owner responds to "this communication" (i.e. the Notice).

(2) MPEP 2666.60, third paragraph, directly addresses the situation where a defective amendment has been filed, and patent owner is notified of same:

In the case of correcting a defective amendment, however, other issues come into play. Where for example, new claims 10-20 are improperly presented in a patent owner response (e.g., not properly underlined), they generally will not

be entered and form PTOL-2069 (Box 4) will be used to notify the patent owner of the need to correct this defect. Until the defect is corrected, claims 10-20 do not yet exist in the proceeding for the third party requester to comment on. Likewise, any argument that was directed to such claims is not truly ripe for the third party requester comment. **After the patent owner corrects the defect, claims 10-20 come into existence in the proceeding, and the argument presented by the patent owner becomes relevant. At this point, the third party requester has a right to provide comments in response to the patent owner's argument, whether or not the argument that was included in the original patent owner submission is re-presented with the paper correcting the defect. Thus, any third party requester comments submitted either in response to the patent owner's initial paper (presenting the informal claims) or in response to the patent owner's supplemental paper (correcting the informality) will be considered by the examiner.** (emphasis added)

Petitioner makes reference to the second paragraph of MPEP 2666.60 (petition of 08 October 2009, page 3, bottom; page 5, second block quote; page 6, lines 14 and 21) but has not taken note of the third paragraph where a defective amendment requires correction, which squarely addresses the present situation.

In the present situation, the flaw in the paper of 06 April 2009 was a defective amendment. Accordingly, the time for the third party requester to respond was 30 days from the date of the correction of the defect.

Since the decision of the CRU Director was in compliance with Office policy, the petition under 37 CFR 1.181 is denied.

DECISION

1. The petition is granted only to the extent that the decision of the CRU Director of 29 September 2009 has been reconsidered, but is denied with respect to making any change therein. The petition is **denied as to the relief requested**.
2. A review of the record indicates that the CRU Director acted in accord with stated Office policy in denying the petition of 17 June 2009.
3. This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02.

3. Any further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450

4. Jurisdiction over the proceeding is transferred to the Central Reexamination Unit (CRU)
5. Telephone inquiries concerning this decision should be directed to Kenneth M. Schor, Senior Legal Advisor, at (571) 272-7710.



Robert W. Bahr
Acting Associate Commissioner for
Patent Examination Policy

3-25-10
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