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MAILED
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(Courtesy Copy)

Ex parte Reexamination Proceeding
Control No. 90/010,591
Filed: July 2, 2009
For: U.S. Patent No. 7,139,761

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

Inter Partes Reexamination Proceeding
Control No. 95/001,261
Filed: Nov.13, 2009
For: U.S. Patent No. 7,139,761

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The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should be merged under 37 CFR 1.989 at this time.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,139,761 (the '761 patent) issued to McKibben et al. with the assignee listed as Leader Technologies, Inc. on Nov. 21, 2006, with 35 claims.
2. A request for *ex parte* reexamination of claims 1, 2, 4-16, 21-29, and 31-35 of the '761 patent was filed on July 2, 2009, by a third party requester, and was assigned control number 90/010,591 (the '591 *ex parte* proceeding).
3. On Sept. 25, 2009, *ex parte* reexamination was ordered for claims 1, 2, 4-16, 21-29, and 31-35 of the '761 patent based on the examiner's determination that the July 2, 2009 request raised a substantial new question of patentability affecting these claims.
4. A request for *inter partes* reexamination of claims 1-16, 21, 23-26, 29, and 31-34 of the '761 patent was filed on Nov. 13, 2009, by a third party requester representing Facebook, Inc as the real party in interest. The request was assigned control number 95/001,261 (the '1261 *inter partes* proceeding).
5. On Feb. 9, 2010, *inter partes* reexamination was ordered for claims 1-16, 21, 23-26, 29, and 31-34 of the '761 patent based on the examiner's determination that the Nov. 13, 2009 request raised a substantial new question of patentability affecting these claims.
6. A concurrent litigation styled *Leader Technologies, Inc. v. Facebook, Inc.*, U.S. District Court of Delaware, 1:08cv00862 filed Nov. 19, 2008 involving the '761 patent is presently pending.
7. There has been no Office action in either proceeding, and the time for filing a patent owner's statement pursuant to 37 CFR 1.530 in the '591 *ex parte* proceeding expired after Nov. 25, 2009.¹

DECISION

I. MERGER OF PROCEEDINGS

Reexamination has been ordered in two proceedings for the same claims of the same patent. One of the proceedings (the '1261 proceeding) is an *inter partes* proceeding. Both proceedings are still pending, and have not been terminated. Therefore, consideration of merger pursuant to 37 CFR 1.989 is ripe at this point in time.

37 CFR 1.989 provides:

- (a) If any reexamination is ordered while a prior *inter partes* reexamination proceeding is pending for the same patent and prosecution in the prior *inter partes* reexamination proceeding has not been terminated, a decision may be made to merge

¹ There is no provision for filing a patent owner's statement in *inter partes* reexamination; rather, an Office action is issued prior to any input from the parties.

the two proceedings or to suspend one of the two proceedings. Where merger is ordered, the merged examination will normally result in the issuance of a single reexamination certificate under § 1.997.

(b) An *inter partes* reexamination proceeding filed under § 1.913 which is merged with an *ex parte* reexamination proceeding filed under § 1.510 will result in the merged proceeding being governed by §§ 1.902 through 1.997, except that the rights of any third party requester of the *ex parte* reexamination shall be governed by §§ 1.510 through 1.560.

In accordance with 37 CFR 1.989(a), the 90/010,591 and 95/001,261 proceedings are merged. The merged proceeding will be conducted in accordance with the guidelines and requirements that follow.

II. CONDUCT OF MERGED PROCEEDING

A. Patent owner is required to maintain the same claims (and specification) in both files throughout the merged proceeding. Presently, the claims and the specification are the same in each proceeding.

B. 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, except that the rights of the third party requester of the *ex parte* reexamination are governed by 37 CFR 1.510 through 1.560.

It is noted that reexamination was ordered for claims 1, 2, 4-16, 21-29, and 31-35 of the '761 patent in the '591 proceeding and for claims 1-16, 21, 23-26, 29, and 31-34 of the '761 patent in the '1261 proceeding. The examiner will conduct reexamination in the merged proceeding for claims 1-16, 21-29, and 31-35 of the '761 patent.

C. Papers mailed/filed:

All papers mailed by the Office throughout the merged proceeding will take the form of a single action which applies to both proceedings. All papers issued by the Office, or filed by the patent owner and the third party requester(s), will contain the identifying data for both files and will be physically entered in each reexamination file. All papers filed by the patent owner and the third party requester(s) must consist of a single paper, filed in duplicate, each bearing a signature and identifying data for both files, for entry into each file.

Patent owner and requester(s) are reminded that every paper filed in the merged proceeding subsequent to this decision must be served on the other parties, and every paper filed must reflect that such paper was served on the other parties, pursuant to 37 CFR 1.903. All papers are to be addressed to the Central Reexamination Unit as provided above.

D. Amendments:

The filing of any amendments to the drawings, specification or claims must comply with 37 CFR 1.943, which incorporates the provisions of 37 CFR 1.530, and the guidelines of MPEP § 2666.01, which in turn references the guidelines of MPEP § 2250.

37 CFR 1.121 does not apply to amendments in reexamination. Accordingly, clean copies of the amended claims are not required and are not to be submitted; rather amendments are to be presented via markings pursuant to paragraph 37 CFR 1.530(f), except that a claim should be canceled by a statement canceling the claim, without presentation of the text of the claim.

Pursuant to 37 CFR 1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. *Amendments are not to be made relative to previous amendments.* Thus, for all amendments, all words not appearing in the patent are always underlined, and only words being deleted from the patent appear in brackets.

E. Fees:

Where a paper is filed that requires payment of a fee (*e.g.*, petition fee, excess claims fee, extension of time fee, appeal fee, brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for any patent owner's appellant brief (or that of the *inter partes* reexamination requester) which may be filed, even though the brief relates to merged multiple proceedings, and copies must be filed (as pointed out above) for each file in the merged proceeding.

F. Citation of Patents and Printed Publications:

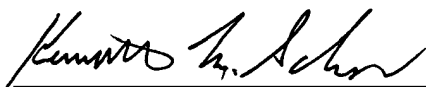
Upon return of the present merged proceeding to the examiner, the examiner will review the files to insure that each file contains identical citations of prior patents and printed publications, and will cite such documents as are necessary as part of the next action in order to place the files in that condition.

III. . CORRESPONDENCE ADDRESS FOR PATENT OWNER

The correspondence address for the patent to be reexamined is the address of the patent owner in the patent file. See MPEP 2222 and 37 CFR 1.33(c). The correspondence address of the '761 patent is not the same as the correspondence address listed in the newly filed power of attorney for patent owner in the *ex parte* request. The desired correspondence address must be corrected **in the patent file** to change the correspondence address in this merged proceeding to that listed in the power of attorney. Additionally, a statement establishing the right of the assignee to take action under 37 CFR 3.73(b) must be filed in the patent file along with the power of attorney, in order to support the power of attorney.

CONCLUSION

1. *Ex parte* Reexamination Control No. 90/010,591 and *inter partes* Reexamination Control No. 95/001,261 are merged into a single proceeding, to be conducted in accordance with the procedure set forth above.
2. Jurisdiction over the merged reexamination files is being forwarded via the Director of the Central Reexamination Unit (CRU) to the examiner.
3. Any questions concerning this communication should be directed to Caroline D. Dennison, Legal Advisor, at 571-272-7729.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

April 22, 2010