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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,261	11/13/2009	7,139,761 B2	LT10002-RXM	5286

74877 7590 05/15/2012

King and Spalding LLP
1700 Pennsylvania Ave, NW
Suite 200
Washington, DC 20006

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 05/15/2012

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



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,591	07/02/2009	7,139,761	LTI0001-RXM	6253

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MAILED

Date: **MAY 15 2012**

CENTRAL REEXAMINATION UNIT

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
COOLEY LLP
ATTN: PATENT GROUP
777- 6th STREET, N.W. SUITE 1100
WASHINGTON, DC 20001

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90010591
PATENT NO. : 7139761
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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Date:

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MAILED

MAY 15 2012

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

CENTRAL REEXAMINATION UNIT

REEXAMINATION CONTROL NO. : 95001261

PATENT NO. : 7139761

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.



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(For Patent Owner)

MAILED
MAY 15 2012
CENTRAL REEXAMINATION UNIT

Cooley, LLP
777 6th Street, NW
Suite 1100
Washington, DC 20001

(For *inter partes* Requester)

White & Case, LLP
Patent Department
1155 Avenue of the Americas
New York, NY 10036

(For *ex parte* Requester)

In re McKibben et al.
Inter partes Reexamination Proceeding
Control No.: 95/001,261
Filed: November 13, 2009
For: U.S. Patent No. 7,139,761

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: DECISION
: DISSOLVING
: MERGER OF
: REEXAMINATION
: PROCEEDINGS

In re McKibben et al.
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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The above-captioned reexamination proceedings are before the Office of Patent Legal Administration for *sua sponte* consideration of whether the proceedings should continue to be administratively merged at this time.

The merger of the above-captioned proceedings is dissolved, for the reasons set forth below.

REVIEW OF FACTS

1. On November 21, 2006, the Office issued U.S. Patent No. 7,139,761 (the '761 patent) to McKibben *et al.*
2. On July 2, 2009, a request for *ex parte* reexamination of claims 1, 2, 4-16, 21-29, and 31-35 of the '761 patent was filed by third party requester. The request was assigned Control No. 90/010,591 (the '10591 proceeding).
3. On September 25, 2009, the Office issued an order granting the '10591 request for *ex parte* reexamination of claims 1, 2, 4-16, 21-29, and 31-35 of the '761 patent.
4. On November 13, 2009, a request for *inter partes* reexamination of claims 1-16, 21, 23-26, 29, and 31-34 of the '761 patent was filed by a third party requester representing Facebook, Inc. as the real party in interest. The request was assigned Control No. 95/001,261 (the '1261 proceeding).
5. On February 9, 2010, the Office issued an order granting the '1261 request for *inter partes* reexamination of claims 1-16, 21, 23-26, 29, and 31-34 of the '761 patent.
6. On April 26, 2010, the Office, *sua sponte*, issued a decision merging the '10591 and '1261 proceedings. The decision stated that "[t]he examiner will conduct reexamination in the merged proceeding for claims 1-16, 21-29, and 31-35 of the '761 patent."
7. On May 21, 2010, the Office issued a non-final action on claims 1-16, 21, 23-26, 29, and 31-34 in the merged proceeding. The non-final action addressed only the claims, and the proposed rejections of those claims, set forth in the *inter partes* request. None of the issues for which the '10591 *ex parte* request was granted were addressed in that action.
8. On September 8, 2010, patent owner filed a response to the non-final Office action; no claim amendments were submitted.
9. On November 2, 2010, third party *inter partes* requester filed comments responsive to the September 8, 2010 patent owner response and the May 21, 2010 Office action. The comments noted that the non-final Office action "did not address the four SNQs and several prior art references that were presented in the *ex parte* request that were not separately reflected in the *inter partes* request."¹ A further Office action addressing those SNQs was requested by the *inter partes* requester.
10. On December 2, 2010, the Office issued an Action Closing Prosecution (ACP) in the merged proceeding, confirming claims 1-16, 21-26, 29, and 31-34. The ACP states that "the additional SNQs of the *Ex Parte* will not be separately addressed."

¹ Comments at 3.

11. On January 6, 2011, the Office issued a Right of Appeal Notice.
12. On February 4, 2011, *inter partes* requester filed a notice of appeal.
13. On April 4, 2011, *inter partes* requester filed an appellant's brief.
14. On May 4, 2011, patent owner filed a respondent's brief.
15. On September 28, 2011, the Office issued an examiner's answer.
16. On October 28, 2011, *inter partes* requester filed a rebuttal brief.
17. On January 26, 2012, the proceeding was docketed to the Board of Patent Appeals and Interferences.
18. On April 17, 2012, the proceeding was remanded to the examiner for further consideration.

DECISION

I. Dissolution of the merger of the two Reexamination Proceedings.

Reexamination of the '761 patent has been ordered in the '10591 *ex parte* proceeding and in the '1261 *inter partes* proceeding, and the proceedings have been merged. The issue to be decided is whether the merger of the above-captioned *ex parte* and *inter partes* reexamination proceedings will be retained in this instance, where only the issues in the *inter partes* proceeding have been addressed, and those issues have been developed through briefing for an appeal.

As an initial matter, there is no legal requirement for the Office to merge two pending reexamination proceedings. Rather, the determination whether to merge two reexamination proceedings is an act reserved to the discretion of the Office. (See 37 CFR 1.565(c), 37 CFR 1.989(a), MPEP 2686.01 (I),² MPEP 2686.01 (IV),³ MPEP 2283,⁴ and MPEP 2286.⁵)

² "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.'"

³ "The instances where the Office may, or may not, merge an ongoing reexamination proceeding with a subsequent reexamination proceeding, are addressed on a case-by-case basis."

⁴ "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. 305 to conduct reexamination with 'special dispatch.'"

⁵ "[T]he 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 with 'special dispatch.'"

First, the statute is silent as to the procedural housekeeping issue of merger. Second, the relevant regulation makes it clear that the Office has discretion when deciding whether or not to merge an *ex parte* reexamination proceeding with an *inter partes* reexamination proceeding. See 37 CFR 1.989(a).⁶ Third, while the MPEP does state the Office will “normally” merge two reexaminations, this general policy does not address the various possible permutations that may occur with regard to any specific set of cases eligible for merger. Finally, the MPEP also notes that the decision to merge is within the “sole discretion” of the Office to facilitate/carry out the statutory mandate to conduct reexamination proceedings with special dispatch.⁷ Therefore, while the Office retains the authority to merge, it is permissible for the Office to not merge proceedings, where special dispatch can be equally or better served absent merger. In summary, merge/non-merge determinations are made by the Office on a case-by-case basis, so that special dispatch can be achieved in view of the individual facts and circumstances of each proceeding.^{8,9}

At this juncture, it is noted that although the above-captioned proceedings have been merged throughout prosecution, none of the issues in the *ex parte* proceeding have been addressed at any time during the prosecution. This was noted both by *inter partes* requester in the requester’s comments to the initial Office action, and by the Office in the action closing prosecution (ACP). The question of whether continued administrative merger is appropriate is therefore undertaken at this time.

At this stage, prosecution of all of the issues in the *inter partes* request has reached a stage in which the examiner has confirmed all of the claims for which the *inter partes* request was ordered. The *inter partes* requester has appealed that decision, and briefs have been filed by both parties and addressed by an examiner’s answer. *Inter partes* requester has further filed a rebuttal brief. The proceeding has been docketed to the Board of Patent Appeals and Interferences, and then remanded back to the examiner.

Although the issues raised by the *inter partes* request have been fully addressed in the proceeding, none of the *ex parte* issues have been addressed by the Office in this merged proceeding. Since the *ex parte* issues have not been addressed, and the *inter partes* issues advanced, the proceeding may appropriately be viewed from the standpoint of two independent proceedings at different stages of prosecution. The MPEP discusses the decision of merger of two proceedings as the operation of the Office in best conducting both proceedings with special dispatch:

⁶ “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 the two proceedings or to suspend one of the two proceedings. . . .” (Emphasis added).

⁷ *Id.*

⁸ See “Revisions and Technical Corrections Affecting Requirements for *Ex Parte* and *Inter Partes* Reexamination,” 72 Fed. Reg. 18892 (April 16, 2007-final rule) at 18901, where it states - “As was pointed out in the Notice of proposed Rule Making, there are instances where the Office does not merge (consolidate) an ongoing *ex parte* reexamination with a subsequent reexamination or reissue proceeding, which are addressed on a case-by case basis.”

⁹ “[T]he ability to decide the question of whether to merge/consolidate based on the merits of a particular fact pattern must be, and is, reserved to the Office.” *Id.* at 18902.

Pursuant to 35 U.S.C. 314(c), “[u]nless otherwise provided by the Director for good cause, all inter partes reexamination proceedings under this section...shall be conducted with special dispatch within the Office.” This statutory provision is grounded on the need for certainty and finality as to the question of patentability raised by the request for reexamination. Thus, if a second request for reexamination will unduly delay the first reexamination proceeding, the two proceedings generally will not be merged. If the Office were to merge the two proceedings, the first reexamination proceeding would need to be withdrawn from its place in the process, thus delaying, instead of advancing, prosecution. This would run contrary to the statutory “special dispatch” requirement of 35 U.S.C. 314 and its intent. On the other hand, if the Office does not merge, the first reexamination proceeding can be concluded, and any substantial new question of patentability raised by the second reexamination request can be resolved in the second proceeding, with no delay resulting.

In the present proceeding, the *ex parte* issues have not yet been addressed.¹⁰ To address those issues at this time in a merged proceeding would unduly delay the issues fully examined in the *inter partes* request. Based upon the specific facts and circumstances of the reexamination proceedings on the ‘761 patent, the Office has decided that continued merger would not be the best alternative in this instance.

Accordingly, the merger is dissolved and the two proceedings revert to independent prosecution.

The Office retains the right to merge the present proceedings or to suspend one (or more) of the proceedings for a limited time at a later date, should circumstances change such that the situation warrants such action.

II. Effect of the Dissolution of merger.

A. Inter Partes Reexamination Proceeding 95/001,261

The ‘1261 *inter partes* proceeding will be returned to the Board of Patent Appeals and Interferences for further action, and will contain all papers filed in the ‘1261 proceeding prior to merger, and all papers filed in the merged proceeding.

B. Ex Parte Reexamination Proceeding 90/010,591

Although all papers were placed in both files and carried both proceeding numbers, substantive prosecution was not carried out as merged despite the decision on merger. The issues raised in the order granting the ‘10591 *ex parte* proceeding have yet to be addressed on the merits. Accordingly, the now severed ‘10591 proceeding will be returned to the examiner for further action to resolve the SNQs for which *ex parte* reexamination was ordered.

To the extent that the Office actions were designated as actions in the ‘10591 proceeding, they are hereby **vacated**. All papers filed after the previous merger decision will be closed. Patent

¹⁰ As a result, claims 22, 27, 28, and 35 for which *inter partes* reexamination was not requested have not been addressed at all.

Ex parte Reexamination Control No. 90/010,591

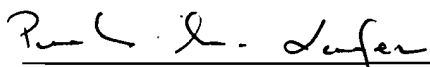
owner may refile any of the IDS and evidence submissions filed subsequent to the merger that patent owner wishes to have included and considered in the '10591 proceeding.

C. Consequences of Issuance of Reexamination Certificate in a single proceeding

If a reexamination certificate issues, concluding one of the two proceedings, patent owner is required pursuant to 37 CFR §§ 1.565(a) and 1.985(a) to file a notice of concurrent proceedings (See MPEP §§ 2282 and 2686) in the still pending proceeding, informing the Office of the issuance and publication of the reexamination certificate. Additionally, patent owner is required to submit an amendment paper, making all necessary amendments to the still pending proceeding, such that the still pending proceeding is consistent with all changes implemented by the issued reexamination certificate in the concluded proceeding.

CONCLUSION

1. The merger of the above-captioned proceedings is dissolved and the proceedings are reconstituted as separate proceedings.
2. The '10365 *ex parte* proceeding, which has not received a first Office action on the merits, will proceed, *nunc pro tunc*, with the issuance of a first Office action on the merits in that proceeding. The prior actions and papers filed subsequent to the merger decision will be closed in that proceeding.
3. The '1261 proceeding, which has been fully briefed, is being returned to the Board of Patent Appeals and Interferences.
4. If a reexamination certificate issues, concluding one of the two proceedings, patent owner is required pursuant to 37 CFR §§ 1.565(a) and 1.985(a) to file a notice of concurrent proceedings (See MPEP §§ 2282 and 2686) in the still pending proceeding, informing the Office of the issuance and publication of the reexamination certificate in the still pending proceeding. Additionally, patent owner is required to submit an amendment paper, making all necessary amendments to the still pending proceeding, such that the still pending proceeding is consistent with all changes implemented by the issued reexamination certificate in the concluded proceeding.
5. Telephone inquiries related to the present decision should be directed to Michael Cygan, Legal Advisor, at 571-272-7700.



Pinchus M. Laufer
Senior Legal Advisor
Office of Patent Legal Administration

May 14, 2012