CRITICAL CONSTITUTIONAL MATTERS FOR THE HOUSE OVERSIGHT COMMITTEE

ADDENDUM TO "FEDERAL COURTS ARE CODDLING A PROVEN INFRINGER, SEP. 28, 2012"

Prepared Nov. 6, 2012

ABUSE OF PATENT REEXAMINATION LAWS FOR THE PURPOSES OF ADMINISTRATIVE (POLITICAL) BULLYING, BUSINESS HARASSMENT, ECONOMIC DISSIPATION, DISMANTLING OF PATENT LAW, AND DISCOURAGING SMALL INVENTORS FROM PROTECTING THEIR PATENT RIGHTS

Federal Circuit permits the Patent Office to ignore judicial rulings on patent validity, and appears to be allied with big infringers and their law firms in a surreptitious war against small inventors

Ref: U.S. Patent Office Reexamination Control:
Leader Technologies/Facebook - Serial No. 95/001,261
(16193.112001) (LTI0001-RXM2)

Patent "reexamination" has become a primary weapon of big infringers (big companies with large legal budgets) to harass small inventors so that they cannot enjoy the fruits of their creative labors. The U.S Patent Office badgers small inventors into abandoning their patent rights. The average person on the street believes a patent to be a definitive property right granted by the U.S. Constitution Article I Section 8. However, the reality today is that a validly issued U.S. patent is little more than a target on a small inventor's back to help big infringers better aim their well-funded arsenal of "lawfare" weapons.[1]

[1] Christi Scott Bartman. "Lawfare: Use of the Definition of Aggressive War by the Soviet and Russian Governments." Dissertation, Aug. 2009. Bowling Green State University.

Practically speaking, for small inventors a U.S. patent award is little more than an invitation to a life of legal harassment and frustration. Litigation costs have skyrocketed because of the nuanced sophistry that now paralyzes patent litigation. The federal courts appear to lack the will to stop the nonsense, allowing big infringers to escape what should be their day of reckoning with small inventors. Still another little-known weapon in the infringer's arsenal is the "reexamination" request.

PATENT REEXAMINATION: BIG INFRINGER'S INFLUENCE-PEDDLING PLAYGROUND

Reexaminations are essentially an application to the Patent Office by a third party who asks the Patent Office to reexamine the Patent Office's own decision to issue a patent, ostensibly for issues like error; fraud (also called "inequitable conduct"); "statutory bars" like on-sale and public disclosure bar; and experimental use. In the hands of honest brokers, reexaminations can correct obvious error, but reexams have largely been hijacked by unscrupulous law firms and their big infringing clients.

Intellectual property law commentator Kevin E. Noonan, Ph.D. says reexaminations were intended to help prevent litigation, not create more: "Congress clearly intended for re-examination to provide an alternative to costly litigation, not an adjunct, and there is little evidence that Congress contemplated the uses to which re-examination is put today (inter partes as well as ex parte)."[2]

Reexaminations have become a tactical and strategic club used by the unscrupulous to beat down one's opponent in costs and time. This tactic is a twisted irony, since the infringer is often using funds from the ill-gotten gains of the infringed patent to fight the true inventor. It is also a waste of taxpayer's money.

The other unseemly part of the reexamination process is that it can be requested *over and over again*—resulting in large legal costs, opportunity cost losses for inventors trying to bring products and services to market, and critical time-to-market delays at a time when the U.S. economy demands growth for jobs and expansion.

[2] Kevin E. Noonan. "In re Baxter International, Inc. (Fed. Cir. 2012)." *PatentDocs*, May 17, 2012.

Perhaps of more concern today is the frequency with which the Patent Office, in concert with the Federal Circuit, is *ignoring* legal precedent by stubbornly refusing to protect constitutional rights and court decisions on patents that have already been litigated. For example, even when the definition of an important word in a patent is adjudicated in a patent case, the Patent Office may *ignore* that decision and force the patent holder to reargue the definition in front of the patent examiner. That examiner is free to *unilaterally* overrule the court decision as an *administrative* decision within the Patent Office. This process forces great expense, time and hassle on the patentee who must then argue the same points *over and over* again *ad infinitum*. This unilateral authority of the examiner also opens the door to administrative influence-peddling at the Patent Office.

For example, Federal Circuit Judges Alan D. Lourie and Kimberly A. Moore recently declared the authority of federal courts in patent claims construction *subservient* to the U.S. Patent Office in *In re. Baxter*. This nakedly political decision prompted an alarmed dissenting Judge Pauline Newman to write:

> "No authority, no theory, no law or history, permits administrative nullification of a final judicial decision. No concept of government authorizes an administrative agency to override or disregard the final judgment of a court. Judicial rulings are not advisory; they are obligatory." [3]

A growing chorus of Federal Circuit critics[4] are crying foul and saying that this court, begun with lofty intentions in 1982, has lost its

[3] See May 17, 2012 *ex parte* reexamination of U.S. Patent No. 5,247,434 under Reexamination Control No. 90/007,751 and *In re Baxter International, Inc.* (Fed. Cir. 2012) where the Patent Office invalidated patent claims already adjudged valid. Remarkably, two of the three Federal Circuit judges in *In re Baxter* were **Judges Alan D. Lourie** and **Kimberly A. Moore** (also judges in *Leader v. Facebook*) who affirmed this questionable U.S. Patent Office outcome, just as they ignored the Supreme Court's *Pfaff* test in *Leader v. Facebook*; *See* also Kevin E. Noonan, *supra*.

[4] Rooklidge, William C.; Weil, Matthew F. "Judicial Hyperactivity: The Federal Circuit's Discomfort with Its Appellate Role." Univ. of California, Berkley, 15 Berk. Tech. L.J. 725 (2000); *See* also Ted L. Field. "Judicial Hyperactivity in the Federal Circuit: an Empirical Study." Univ. of San. Fran. Law Review, Vol. 46, 2012, SSRN ID 1990014.

way, as exemplified in the *Leader v. Facebook* judicial ethics scandal.[5]

LEADER TECHNOLOGIES' PATENT – FACEBOOK WANTS FOUR BITES AT THE SAME PRIOR ART APPLE

In *Leader v. Facebook*,[6] Facebook has applied for and lost two patent reexaminations of U.S. Patent No. 7,139,761. *See* Appendixes 2-5 herein. Not satisfied, Facebook is going for reexam number three. *See* Appendix 6. The remarkable thing about this third application is that Facebook is now receiving the overt cooperation of the Board of Patent Appeals which has just ordered the reexamination *over the objection of their own examiner*. *See* Fig. 1. Also notable is the prior art being cited for reexamination is the *same* prior art that Facebook lost on at trial, in reexamination #1 and in reexamination #2.

No reasonable person can believe that Facebook's contentions regarding the cited prior art can be anything but stale and worn out, and yet the Board itself supports a *fourth* bite at that apple—first the examination of their contentions at trial, then two reexaminations, this effectively making the fourth attempt using the same prior art arguments.

UNDUE INFLUENCE ON USPTO ADMINISTRATIVE JUDGES AND EXAMINERS?

Any member of the public may log in and view the Patent Examiner's Leader Technologies "wrapper" using this procedure: Log in at http://portal.uspto.gov/external/portal/pair; enter the CAPTCHA information and select Continue; select the "Application Number" radio button (the default), type "95/001,261" in the text box, select Continue. *See* also the current wrapper in Appendix 5.

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[5] Donna Kline. "Hijinks At The High Court." *Donna Kline Now!* Jul. 27, 2012; "Judicial 'Hyperactivity' at the Federal Circuit." Aug. 8, 2012; "Federal Circuit Violates Leader Technologies' Constitutional Rights." Sep. 1, 2012; "Cover-up In Process at the Federal Circuit?" Sep. 17, 2012; "The Leader v. Facebook Judicial Scandal Widens." Oct. 22, 2012.

[6] *Leader Technologies, Inc., v. Facebook, Inc.*, 08-cv-862-JJF-LPS (D.Del. 2008); *Leader Tech v. Facebook*, Case No. 2011-1366 (Fed. Cir.) and USPTO Reexamination Control No. *95/001,261*.

What circumstances motivated this fourth bite at a very sour Facebook prior art apple? Are the following USPTO principals in this *Leader v. Facebook* scandal participants or victims?

The Administrative Patent Judges in this case are:

1. Allen R. MacDonald, Technology Center 3900
2. Stephen C. Siu
3. Meredith C. Petravick

The Patent Examiners are:

1. Deandra M. Hughes, Art Unit 3992
2. Christina Y. Leung
3. Daniel J. Ryman

It is unlikely that Examiner Deandra Hughes will hear any new arguments from Facebook. However, armed with the fresh-grown *In re. Baxter* authority, will Examiner Hughes play along, or will she and her colleagues do the right thing and *refuse* to succumb to the evident political games? Will she be coerced into invalidating Leader's claims based upon the lower "preponderance of evidence" standard? With *In re. Baxter* confusion reigns at the U.S. Patent Office. In confusion there is profit? One should be reminded that the *Leader v. Facebook* Judges Alan D. Lourie and Kimberly A. Moore will *benefit financially* from decisions favorable to Facebook since they hold stock in Facebook.

FEDERAL AGENCIES ARE WARRING AGAINST INVENTORS IN SUPPORT OF BIG INFRINGERS? IS THIS THE DEATH KNELL FOR AMERICAN INNOVATION?

On Apr. 17, 2012 the USPTO Director Kappos ordered an unprecedented remand of Leader's patent into a second reexamination without providing instructions to the Examiner. USPTO experts had never seen such an action and were baffled. **Note that this occurred just *one month before* Facebook's IPO on May 18, 2012**. On May 17, 2012 *In re. Baxter* Judge Alan D. Lourie and Judge Kimberly A. Moore allowed the U.S. Patent Office to ignore a court decision on validity and the USPTO then invalidated the very same patent

declared valid by the court in an administrative action. Then on July 17, 2012 these same judges denied Leader's request for a rehearing, ignoring the Supreme Court *Pfaff*-test precedent, ignoring their Facebook stockholdings and other conflicts of interest, and ignoring their own precedent. It appears evident that this Federal Circuit court was fully intent on giving Facebook what they wanted no matter what American laws needed to be ignored. On Sep. 11, 2012, The Federal Circuit Bar Association filed a request that attempted to absolve Judges Lourie and Moore of conflicts of interest, even after *amicus curiae* Dr. Lakshmi Arunachalam, former director of network architecture at Sun Microsystems, filed a motion showing that both judges had undisclosed investments in Facebook.[7]

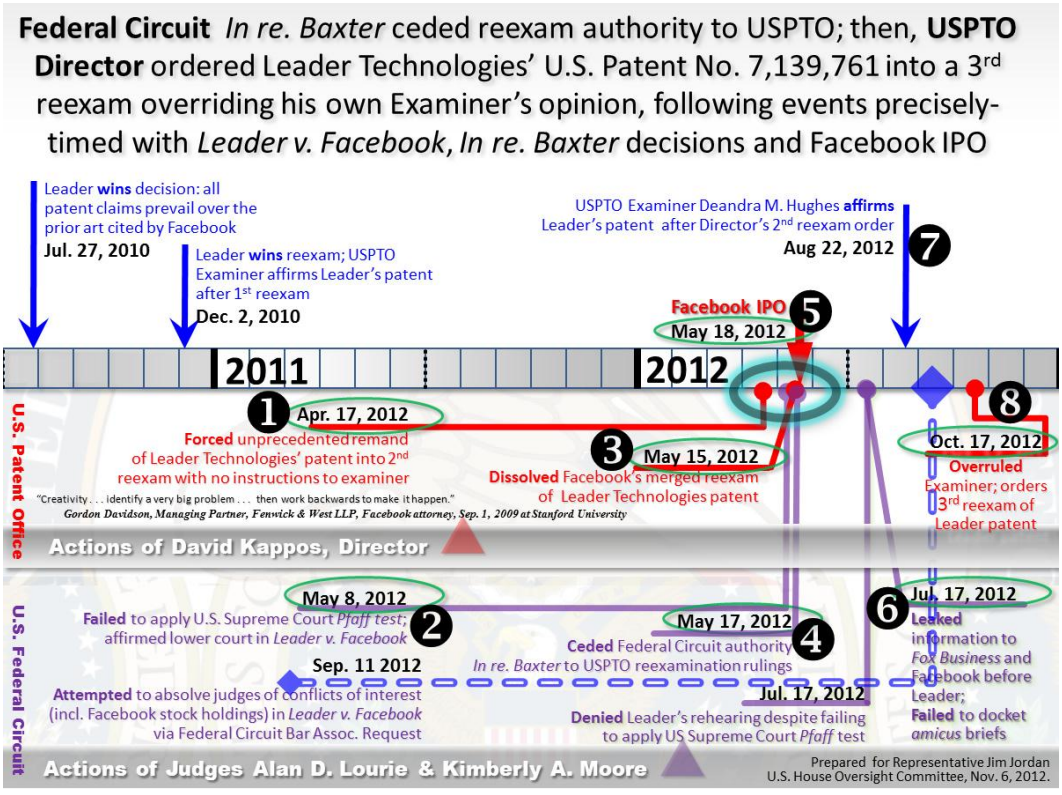

Fig. 1 – Timeline of events involving Federal Circuit Judges Alan D. Lourie and Kimberly A. Moore, shows circumstances that suggest coordination of anti-patent and anti-inventor priorities between them and U.S. Patent Office Director David Kappos, a political appointee. Judges Lourie and Moore comprised 2/3rds of the *Leader v. Facebook* panel that failed to apply the U.S. Supreme Court *Pfaff* test.

[7] Renewed Motion for Leave To File *Amicus Curiae* Lakshmi Arunachalam, Ph.D. Brief, Jul. 27, 2010; *See* also Response to Request of Federal Circuit Bar Association's Request for Reissue Re. *Leader v. Facebook*, Case No. 2011-1366 (Fed. Cir.) by Lakshmi Arunachalam, Ph.D., Sep. 17, 2012.

The judges both hold stock in Facebook and stand to benefit financially from rulings favorable to Facebook. The judges failed to recuse themselves after their Facebook holdings were first made public on July 27, 2012 in the Renewed Motion of *Amicus Curiae* Lakshmi Arunachalam, Ph.D. *Fn.* 7; Appendix 1.

COORDINATED POLITICAL AGENDA?

The possibility of a coordinated agenda between Federal Circuit Judges Moore and Lourie and the USPTO Director Kappos is signaled by the timing of the Federal Circuit *In re. Baxter* decision (**May 17**) and the USPTO's unprecedented paperwork filed just two days prior (**May 15**) that *unmerged* previously merged reexaminations of Leader's patent, and set the stage for the USPTO's next move on Oct. 17, 2012. A week earlier (**May 8**) the Federal Circuit had failed to overturn the *Leader v. Facebook* jury.

On Oct. 17, 2012 the Board of Patent Appeals, in another unprecedented move, ordered Leader's patent into Reexamination #3—even over the objection of the examiner. With the Federal Circuit's *In re Baxter* decision in hand, the Patent Office now has everything needed to invalidate Leader's patent in an administrative action—regardless of what any federal court, including the U.S. Supreme Court, would decide on appeal. Such moves would financially benefit Judges Alan D. Lourie and Kimberly A. Moore. In addition, Facebook's law firms (Fenwick LLP, Orrick LLP, Gibson LLP), the Federal Circuit Clerk of Court Jan Horbaly, one of Facebook's largest investors (Microsoft) and the U.S. Patent Office are all "leaders" of The Federal Circuit Bar Association. This group of Federal Circuit insiders appears to be pursuing an anti-patent, anti-inventor agenda of mammoth proportions. *See* Appendix 4.

IN RE. BAXTER INSPIRES INFLUENCE-PEDDLING AT THE USPTO; LEADER'S PATENT IS *TARGETED* FOR ADMINISTRATIVE INVALIDATION BY THE FEDERAL CIRCUIT AND THE U.S. PATENT OFFICE?

The only avenue of appeal for a patentee who believes he is being mistreated by the *Patent Office* is the *Federal Circuit*. Since it now appears from the *In re. Baxter* decision that Federal Circuit Judges Alan D. Lourie and Kimberly A. Moore are working to affirm the Patent Office's authority to *overrule federal courts*, the patentee is

caught in a vice of injustice promulgated by the unelected and unaccountable.

Experienced attorneys say this latest *Leader v. Facebook* U.S. Patent Office action can only be political, because they have never before seen or experienced such egregious conduct from the Patent Office. Some knowledgeable observers say that what Facebook cannot win on the merits, they will attempt to purchase, cajole or coerce. Indeed, such tactics are well-known to Facebook's Russian partners at DST, aka Digital Sky Technologies, where judicial corruption is an accepted way of life. Arguably, the circumstances described herein reveal similar corruption in America.

The evident tactic with reexamination #3 will be to purchase or cajole the Examiner Deandra Hughes into invalidating Leader's claims using administrative powers to overrule judicial decisions. This forces Leader to appeal such a decision to the Federal Circuit which appears to be comfortably in Facebook's attorneys' pockets. *See In re. Baxter*, fn. 2.

FENWICK & WEST LLP FIRST REPRESENTED LEADER TECHNOLOGIES IN 2001-2003, BUT NOW FINDS LEADER'S PATENT PROFESSIONALLY EMBARRASSING AND WANTS IT TO GO AWAY?

Facebook's securities and patent attorney, Fenwick & West LLP, began representing Facebook without first seeking a waiver of conflicts of interest from Leader Technologies.[8] Fenwick & West LLP is a member of the "Leaders Circle" at the Federal Circuit and has a potentially big problem that this *In re. Baxter*-empowerment of the Patent Office appears to be trying to solve.

Fenwick & West LLP has filed some 700 patents for Facebook since about 2009, according to the Facebook S-1 filing with the U.S. Securities and Exchange Commission. However, it is believed that Fenwick has not identified Leader's patent as a "prior art reference" in any of Facebook's patents as they did in earlier Marc Andreessen

[8] Duties to Former Clients. Rule 1.9(a), Model Rules of Professional Conduct. American Bar Association ("A lawyer who has formerly represented a client in a matter shall not thereafter represent another person in the same or a substantially related matter in which that person's interests are materially adverse to the interests of the former client unless the former client gives informed consent, confirmed in writing").

patents.[9] Fenwick was Leader Technologies' attorney in 2001-2003, so they cannot claim they did not know about Leader's inventions. Therefore, unless Fenwick can *destroy* Leader's patent, they may have serious disclosure problems, not only with the U.S. Patent Office, but also with the U.S. Securities and Exchange Commission, since none of these liabilities were disclosed to prospective investors prior to the Facebook IPO.[10] Hardly appropriate conduct for a company's former counsel.

Lines of inquiry for the Committee include evaluating whether the reexamination process itself is out of control, and evaluating the efficacy of a lower burden of proof for *inter partes* reexaminations than would otherwise be applied at trial. The Committee should also inquire about the influence-peddling evident by the trigger of a fourth examination of Facebook's same—now stale—alleged prior art claims. An additional line of inquiry is the apparent misuse of the patent reexamination process by big infringers and their predatory law firms, and its detrimental effects on small inventors and American innovation.

The small inventor can only conclude that he is wasting his time in filing a patent if it can be endlessly reexamined by a Patent Office that is able to overrule the courts. If a patent that has been examined and affirmed offers no protection, then the inventor loses his motivation to invent. Why should he waste his labors on an invention that can be brazenly stolen with the connivance of the court system and the U.S. Patent Office?

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* * *

[9] U.S. Patent No. 7,756,945 Andreessen et al; U.S. Patent No. 7,603,352 Vassallo & Andreessen

[10] Donna Kline. "Proof Fenwick & West LLP did not disclose Leader as prior art to Facebook." *Donna Kline Now!* Mar. 29, 2012; *See* also Deirdre Bolton. "Facebook IPO Shows Extreme Corruption, McNamee Says." *Bloomberg TV*, Jul. 12, 2012.

See also Briefings of Representative Jim Jordan:

Sep. 28, 2012—"Federal courts are coddling a proven infringer."

Oct. 19, 2012—"American and Russian Opportunists Undermining U.S. Sovereignty and Corrupting U.S. Financial and Judicial Systems."

Oct. 25, 2012—"Working Summary: Revitalize and Expand Moral and Ethical Principles Embodied in the Business Judgment Rule."

Available from **Americans For Innovation and Against Intellectual Property Theft**
http://www.scribd/amer4innov
http://americans4innovation.blogspot.com

November 6, 2012

OPINION NOTICE: This document should be considered one person's opinion and the information herein should not be relied upon without suitable independent verification.

BIBLIOGRAPHY

1. Briefing to Rep. Jim Jordan. "American and Russian Opportunists Undermining U.S. Sovereignty and Corrupting U.S. Financial and Judicial Systems." Oct. 19, 2012 <http://www.scribd.com/doc/110575673/Briefing-for-Representative-Jim-Jordan-OH-HOUSE-OVERSIGHT-COMMITTEE-American-and-Russian-Opportunists-Undermining-U-S-Sovereignty-and-Corruptin>.

2. Briefing to Rep. Jim Jordan. "Federal courts are coddling a proven infringer." Sep. 28, 2012 <http://www.scribd.com/doc/107866373/Briefing-for-Representative-Jim-Jordan-OH-House-Judiciary-Committee-re-Leader-v-Facebook-Sep-28-2012>.

3. Briefing to Rep. Jim Jordan. "Working Summary: Revitalize and Expand Moral and Ethical Principles Embodied in the Business Judgment Rule." Oct. 25, 2012 <http://www.scribd.com/doc/111167350/Working-Summary-Revitalize-and-Expand-Moral-and-Ethical-Principles-Embodied-in-the-Business-Judgment-Rule-Prepared-for-Representative-Jim-Jordan>.

4. Christi Scott Bartman. "Lawfare: Use of the Definition of Aggressive War by the Soviet and Russian Governments." Dissertation, Aug. 2009. Bowling Green State University <http://www.scribd.com/doc/112077638/Bartman-Christi-Scott-LAWFARE-Use-of-the-Definition-of-Aggressive-War-by-the-Soviet-and-Russian-Governments-BGSU-Aug-2009>.

5. Deirdre Bolton. "Facebook IPO Shows Extreme Corruption, McNamee Says." *Bloomberg TV*, Jul. 12, 2012 <http://www.bloomberg.com/video/facebook-ipo-shows-extreme-corruption-mcnamee-says-BLhoC6ayQFOFXSwaBaYAfQ.html>.

6. Donna Kline. "Cover-up In Process at the Federal Circuit?" *Donna Kline Now!* Sep. 17, 2012 <http://donnaklinenow.com/investigation/cover-up-in-process-at-the-federal-circuit>.

7. Donna Kline. "Federal Circuit Violates Leader Technologies' Constitutional Rights." *Donna Kline Now!* Sep. 1, 2012 <http://donnaklinenow.com/investigation/federal-circuit-violates-leader-technologies-constitutional-rights>.

8. Donna Kline. "Hijinks At The High Court." *Donna Kline Now!* Jul. 27, 2012 <http://donnaklinenow.com/investigation/hijinks-at-the-high-court>.

9. Donna Kline. "Judicial 'Hyperactivity' at the Federal Circuit." *Donna Kline Now!* Aug. 8, 2012 <http://donnaklinenow.com/investigation/judicial-hyperactivity-at-the-federal-circuit>.

10. Donna Kline. "Proof Fenwick & West LLP did not disclose Leader as prior art to Facebook." *Donna Kline Now!* Mar. 29, 2012 <http://donnaklinenow.com/investigation/proof-fenwick-west-llp-did-not-disclose-leader-as-prior-art-to-facebook>.

11. Donna Kline. "The Leader v. Facebook Judicial Scandal Widens." *Donna Kline Now!* Oct. 22, 2012 <http://donnaklinenow.com/investigation/the-leader-v-facebook-judicial-scandal-widens>.

12. Duties to Former Clients. Rule 1.9(a), Model Rules of Professional Conduct. American Bar Association ("A lawyer who has formerly represented a client in a matter shall not thereafter represent another person in the same or a substantially related matter in which that person's interests are materially adverse to the interests of the former client unless the former client gives informed consent, confirmed in writing") <http://www.americanbar.org/groups/professional_responsibility/publications/model_rules_of_professional_conduct/rule_1_9_duties_of_former_clients.html>.

13. *In re Baxter International, Inc.* (Fed. Cir. 2012) <http://www.cafc.uscourts.gov/images/stories/opinions-orders/11-1073.pdf>.

14. Kevin E. Noonan. "In re Baxter International, Inc. (Fed. Cir. 2012)." *PatentDocs*, May 17, 2012 <http://www.patentdocs.org/2012/05/in-re-baxter-international-inc-fed-cir-2012.html>.

15. *Leader Tech v. Facebook*, Case No. 2011-1366 (Fed. Cir.).

16. *Leader Technologies, Inc., v. Facebook, Inc.*, 08-cv-862-JJF-LPS (D.Del. 2008).

17. Renewed Motion for Leave To File *Amicus Curiae* Lakshmi Arunachalam, Ph.D. Brief, Re. *Leader v. Facebook*, Case No. 2011-1366 (Fed. Cir.) by Lakshmi Arunachalam, Ph.D., Jul. 27, 2010.

18. Response to Request of Federal Circuit Bar Association's Request for Reissue Re. *Leader v. Facebook*, Case No. 2011-1366 (Fed. Cir.) by Lakshmi Arunachalam, Ph.D., Sep. 17, 2012.

19. Rooklidge, William C.; Weil, Matthew F. "Judicial Hyperactivity: The Federal Circuit's Discomfort with Its Appellate Role." Univ. of California, Berkley, 15 Berk. Tech. L.J. 725 (2000) <http://www.scribd.com/doc/102080793/Judicial-Hyperactivity-The-Federal-Circuit-s-Discomfort-with-its-Appellate-Role-William-C-Rooklidge-and-Matthew-F-Weil-2000>.

20. Ted L. Field. "Judicial Hyperactivity in the Federal Circuit: an Empirical Study." Univ. of San. Fran. Law Review, Vol. 46, 2012, SSRN ID 1990014 <http://www.scribd.com/doc/102085649/Judicial-Hyperactivity-in-the-Federal-Circuit-an-Empirical-Study-by-Ted-L-Field-Univ-of-San-Fran-Law-Review-Vol-46-2012-SSRN-ID-1990014>.

21. U.S. Patent No. 7,603,352 Vassallo & Andreessen <http://www.scribd.com/doc/86515684/USPTO-Patent-Wrapper-for-Andreessen-Vassallo-U-S-No-7-603-352-Fenwick-and-West-LLP-Mar-23-2012>.

22. U.S. Patent No. 7,756,945 Andreessen et al <http://www.scribd.com/doc/86535812/USPTO-Patent-Wrapper-for-Andreessen-U-S-No-7-756-945-Fenwick-and-West-LLP-Mar-23-2012>.

23. USPTO PAIR Portal <http://portal.uspto.gov/external/portal/pair>.

INDEX

APPENDIX 1

Timeline of events addressed in this briefing; *See* also Fig. 1.

Federal Circuit *In re. Baxter* ceded reexam authority to USPTO; then, **USPTO Director** ordered Leader Technologies' U.S. Patent No. 7,139,761 into a 3rd reexam overriding his own Examiner's opinion, following events precisely-timed with *Leader v. Facebook*, *In re. Baxter* decisions and Facebook IPO

Leader **wins** decision: all patent claims prevail over the prior art cited by Facebook
Jul. 27, 2010

Leader **wins** reexam; USPTO Examiner affirms Leader's patent after 1st reexam
Dec. 2, 2010

USPTO Examiner Deandra M. Hughes **affirms** Leader's patent after Director's 2nd reexam order
Aug 22, 2012 7

Facebook IPO 5
May 18, 2012

2011 **2012**

U.S. Patent Office

1 **Apr. 17, 2012**
Forced unprecedented remand of Leader Technologies' patent into 2nd reexam with no instructions to examiner

"Creativity . . . identify a very big problem . . . then work backwards to make it happen."
Gordon Davidson, Managing Partner, Fenwick & West LLP, Facebook attorney, Sep. 1, 2009 at Stanford University

3 **May 15, 2012**
Dissolved Facebook's merged reexam of Leader Technologies patent

8 **Oct. 17, 2012**
Overruled Examiner; orders 3rd reexam of Leader patent

Actions of David Kappos, Director

U.S. Federal Circuit

May 8, 2012 2
Failed to apply U.S. Supreme Court *Pfaff test*; affirmed lower court in *Leader v. Facebook*

May 17, 2012 4
Ceded Federal Circuit authority *In re. Baxter* to USPTO reexamination rulings

Jul. 17, 2012 6
Leaked information to *Fox Business* and Facebook before Leader; **Failed** to docket *amicus* briefs

Sep. 11 2012
Attempted to absolve judges of conflicts of interest (incl. Facebook stock holdings) in *Leader v. Facebook* via Federal Circuit Bar Assoc. Request

Jul. 17, 2012
Denied Leader's rehearing despite failing to apply US Supreme Court *Pfaff* test

Actions of Judges Alan D. Lourie & Kimberly A. Moore

Prepared for Representative Jim Jordan
U.S. House Oversight Committee, Nov. 6, 2012.

APPENDIX 2

Leader Technologies confirmation of all claims examined in Reexamination #1

Dec. 2, 2010

ACTION CLOSING PROSECUTION (37 CFR 1.949)	Control No.	Patent Under Reexamination	
	95/001,261 and 90/010,591	7,139,761 B2 ET AL.	
	Examiner	Art Unit	
	Deandra M. Hughes	3992	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address. --

Responsive to the communication(s) filed by:
Patent Owner on 8 September 2010
Third Party(ies) on 2 November 2010

Patent owner may once file a submission under 37 CFR 1.951(a) within 1 month(s) from the mailing date of this Office action. Where a submission is filed, third party requester may file responsive comments under 37 CFR 1.951(b) within 30-days (not extendable- 35 U.S.C. § 314(b)(2)) from the date of service of the initial submission on the requester. **Appeal cannot be taken from this action.** Appeal can only be taken from a Right of Appeal Notice under 37 CFR 1.953.

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 this Office action.

PART I. THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892
2. ☒ Information Disclosure Citation, PTO/SB/08
3. ☐ _____

PART II. SUMMARY OF ACTION:

1a. ☒ Claims 1-16,21-26,29 and 31-34 are subject to reexamination.
1b. ☐ Claims _____ are not subject to reexamination.
2. ☐ Claims _____ have been canceled.
3. ☒ Claims 1-16, 21-26, 29, and 31-34 are confirmed. [Unamended patent claims]
4. ☐ Claims _____ are patentable. [Amended or new claims]
5. ☐ Claims _____ are rejected.
6. ☐ Claims _____ are objected to.
7. ☐ The drawings filed on _____ ☐ are acceptable ☐ are not acceptable.
8 ☐ The drawing correction request filed on _____ is: ☐ approved. ☐ disapproved.
9 ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119 (a)-(d). The certified copy has: ☐ been received. ☐ not been received. ☐ been filed in Application/Control No _____
10. ☐ Other _____

APPENDIX 3

USPTO Director remand without instructions to the Examiner
Reexamination #2

Apr. 17, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

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

74877 7590 04/17/2012

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

EXAMINER	
HUGHES, DEANDRA M	

ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
04/17/2012	PAPER

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.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

LEADER
Patent Owner and Respondent

v.

FACEBOOK, INC
Requestor and Appellant

Appeal 2012-003975
Reexamination Control Nos. 95/001,261 & 90/010,591
United States Patent 7,139,761 B1
Technology Center 3900

Before KIMBERLY R. JORDAN, *Division 1 Support Administrator.*

ORDER REMANDING APPEAL TO EXAMINER

The Office of the Group Director of Technology Center 3900, on behalf of the Director of the United States Patent and Trademark Office (USPTO), has requested that the application be remanded to the examiner for further consideration.

Accordingly, it is hereby ORDERED that the application is remanded to the Examiner for further consideration.

cc:

Patent Owner
King and Spalding, LLP
170 Pennsylvania Ave., NW
Suite 200
Washington, DC 20006

Third Party Requester (95/001,261):
Cooley, LLP
777 6th Street, N.W.
Suite 1100
Washington, DC 20001

Third Party Requester (90/010,591):
White & Case, LLP
Patent Department
1155 Avenue of the Americas
New York, NY 10036

APPENDIX 4

Leader Technologies confirmation of all claims examined in Reexamination #2

Aug. 22, 2012

Notice of Intent to Issue Ex Parte Reexamination Certificate	Control No.	Patent Under Reexamination
	90/010,591	7,139,761
	Examiner	Art Unit
	DEANDRA M. HUGHES	3992

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

1. ☒ Prosecution on the merits is (or remains) closed in this *ex parte* reexamination proceeding. This proceeding is subject to reopening at the initiative of the Office or upon petition. *Cf.* 37 CFR 1.313(a). A Certificate will be issued in view of
   (a) ☐ Patent owner's communication(s) filed: _____.
   (b) ☐ Patent owner's failure to file an appropriate timely response to the Office action mailed: _____.
   (c) ☐ Patent owner's failure to timely file an Appeal Brief (37 CFR 41.31).
   (d) ☒ The decision on appeal by the ☐ Board of Patent Appeals and Interferences ☒ Court dated 5/8/12
   (e) ☒ Other: *Decision to Sever Proceedings 95/001,261 and 90/010,591 mailed 5/15/12*.
2. The Reexamination Certificate will indicate the following:
   (a) Change in the Specification: ☐ Yes ☒ No
   (b) Change in the Drawing(s): ☐ Yes ☒ No
   (c) Status of the Claim(s):
      (1) Patent claim(s) confirmed: *2,5,6,8,10,12-15,22,24,26-29 and 33-35*.
      (2) Patent claim(s) amended (including dependent on amended claim(s)): _____
      (3) Patent claim(s) canceled: _____.
      (4) Newly presented claim(s) patentable: _____.
      (5) Newly presented canceled claims: _____.
      (6) Patent claim(s) ☐ previously ☐ currently disclaimed: _____
      (7) Patent claim(s) not subject to reexamination: 1,3,4,7,9,11,16-21,23,25 and 30-32.
3. ☒ Note the attached statement of reasons for patentability and/or confirmation. Any comments considered necessary by patent owner regarding reasons for patentability and/or confirmation must be submitted promptly to avoid processing delays. Such submission(s) should be labeled: "Comments On Statement of Reasons for Patentability and/or Confirmation."
4. ☐ Note attached NOTICE OF REFERENCES CITED (PTO-892).
5. ☒ Note attached LIST OF REFERENCES CITED (PTO/SB/08 or PTO/SB/08 substitute).
6. ☐ The drawing correction request filed on _____ is: ☐ approved ☐ disapproved.
7. ☐ Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
   a)☐ All b)☐ Some* c)☐ None of the certified copies have
   ☐ been received.
   ☐ not been received.
   ☐ been filed in Application No. _____.
   ☐ been filed in reexamination Control No. _____.
   ☐ been received by the International Bureau in PCT Application No. _____.

   * Certified copies not received: _____.
8. ☐ Note attached Examiner's Amendment.
9. ☐ Note attached Interview Summary (PTO-474).
10. ☒ Other: *Regarding item 2(c)(7) above, claims 3, 17-20, and 30 were not requested for reexamination. Claims 1, 4, 7, 9, 11, 16, 21, 23, 25, and 31-32 were held invalid under the 102(b) on-sale bar in a final Federal Court Decision and as such, is no longer under reexamination in this proceeding.*

All correspondence relating to this reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

/DEANDRA M HUGHES/
Primary Examiner, Art Unit 3992

cc: Requester (if third party requester)

APPENDIX 5

U.S. Patent Office Examiner's Wrapper as of Nov. 5, 2012

Leader Technologies, Inc. – U.S. Patent No. 7,139,761

Application No. 95/001,261

First initiated Nov. 13, 2009

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95/001,261 — **DYNAMIC ASSOCIATION OF ELECTRONICALLY STORED INFORMATION WITH ITERATIVE WORKFLOW CHANGES** — **LTI0002-RXM**

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Bibliographic Data

Application Number:	95/001,261	Customer Number:	-
Filing or 371 (c) Date:	11-13-2009	Status:	Board of Appeals Decision Rendered
Application Type:	Re-Examination	Status Date:	10-17-2012
Examiner Name:	HUGHES, DEANDRA M	Location:	ELECTRONIC
Group Art Unit:	3992	Location Date:	-
Confirmation Number:	5286	Earliest Publication No:	-
Attorney Docket Number:	LTI0002-RXM	Earliest Publication Date:	-
Class / Subclass:	707/100	Patent Number:	-
First Named Inventor:	7,139,761 B2	Issue Date of Patent:	-

Title of Invention:	DYNAMIC ASSOCIATION OF ELECTRONICALLY STORED INFORMATION WITH ITERATIVE WORKFLOW CHANGES

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06-14-2012	AP_DK_M	Appeal Docketing Notice	PROSECUTION	2	
05-16-2012	NTC.CONCPROC	Notice of concurrent proceedings / decisions	PROSECUTION	1	
05-16-2012	RXNOCA	Reexam Notice of Court Action	PROSECUTION	15	
05-16-2012	RXC/SR	Reexam Certificate of Service	PROSECUTION	1	
05-16-2012	N417	EFS Acknowledgment Receipt	PROSECUTION	2	
05-15-2012	RXMRXD	Decision Denying Merger of Reexam Proceedings	PROSECUTION	10	
04-17-2012	APAR	Administrative Remand to Examiner	PROSECUTION	3	
01-26-2012	AP_DK_M	Appeal Docketing Notice	PROSECUTION	3	
11-04-2011	RBNE	Reply Brief Noted - Patent Board	PROSECUTION	3	
10-28-2011	XI.RBBR	Rebuttal Brief - Requester	PROSECUTION	12	
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05-04-2011	AF/D	Rule 130, 131 or 132 Affidavits	PROSECUTION	40	
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05-04-2011	AF/D	Rule 130, 131 or 132 Affidavits	PROSECUTION	32	
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05-04-2011	AF/D	Rule 130, 131 or 132 Affidavits	PROSECUTION	19	
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05-04-2011	AF/D	Rule 130, 131 or 132 Affidavits	PROSECUTION	6	
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04-04-2011	RXAF/DR	Reexam - Affidavit/Decl /Exhibit Filed by 3rd Party	PROSECUTION	30	
04-04-2011	RXAF/DR	Reexam - Affidavit/Decl /Exhibit Filed by 3rd Party	PROSECUTION	10	
04-04-2011	RXAF/DR	Reexam - Affidavit/Decl /Exhibit Filed by 3rd Party	PROSECUTION	24	
04-04-2011	RXAF/DR	Reexam - Affidavit/Decl /Exhibit Filed by 3rd Party	PROSECUTION	16	
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12-02-2010	XI.ACP	Action Closing Prosecution (nonfinal)	PROSECUTION	69	
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09-08-2010	REM	Applicant Arguments/Remarks Made in an Amendment	PROSECUTION	40	
09-08-2010	AF/D	Rule 130, 131 or 132 Affidavits	PROSECUTION	62	
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09-08-2010	N417	EFS Acknowledgment Receipt	PROSECUTION	2	
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08-24-2010	NPL	Non Patent Literature	PRIOR ART	12	
08-24-2010	NPL	Non Patent Literature	PRIOR ART	14	
08-24-2010	NPL	Non Patent Literature	PRIOR ART	68	
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08-24-2010	N417	EFS Acknowledgment Receipt	PRIOR ART	3	
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08-23-2010	FOR	Foreign Reference	PROSECUTION	68	
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08-23-2010	FOR	Foreign Reference	PROSECUTION	124	

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08-23-2010	TRAN.LET	Transmittal Letter	PROSECUTION	2	
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08-23-2010	NPL	Non Patent Literature	PRIOR ART	85	
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08-23-2010	NPL	Non Patent Literature	PRIOR ART	3	
08-23-2010	NPL	Non Patent Literature	PRIOR ART	4	
08-23-2010	NPL	Non Patent Literature	PRIOR ART	3	
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08-23-2010	NPL	Non Patent Literature	PRIOR ART	3	
08-23-2010	NPL	Non Patent Literature	PRIOR ART	3	
08-23-2010	NPL	Non Patent Literature	PRIOR ART	3	
08-23-2010	NPL	Non Patent Literature	PRIOR ART	12	
08-23-2010	N417	EFS Acknowledgment Receipt	PRIOR ART	3	
08-23-2010	NPL	Non Patent Literature	PRIOR ART	145	
08-23-2010	NPL	Non Patent Literature	PRIOR ART	174	
08-23-2010	NPL	Non Patent Literature	PRIOR ART	13	
08-23-2010	NPL	Non Patent Literature	PRIOR ART	27	
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08-23-2010	NPL	Non Patent Literature	PRIOR ART	3	
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08-23-2010	NPL	Non Patent Literature	PRIOR ART	3	
08-23-2010	NPL	Non Patent Literature	PRIOR ART	11	
08-23-2010	N417	EFS Acknowledgment Receipt	PRIOR ART	3	
08-23-2010	NPL	Non Patent Literature	PRIOR ART	8	
08-23-2010	NPL	Non Patent Literature	PRIOR ART	18	
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08-23-2010	NPL	Non Patent Literature	PRIOR ART	14	
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08-23-2010	NPL	Non Patent Literature	PRIOR ART	27	
08-23-2010	NPL	Non Patent Literature	PRIOR ART	26	
08-23-2010	NPL	Non Patent Literature	PRIOR ART	23	
08-23-2010	N417	EFS Acknowledgment Receipt	PRIOR ART	4	
07-08-2010	RXRQ/T	Reexam Request for Extension of Time	PROSECUTION	5	
07-08-2010	RXC/SR	Reexam Certificate of Service	PROSECUTION	2	
07-08-2010	N417	EFS Acknowledgment Receipt	PROSECUTION	2	
05-21-2010	RXR.NF	Reexam - Non-Final Action	PROSECUTION	56	
05-21-2010	RXFILJKT	Paper Reexam File Jacket is scanned	PROSECUTION	1	
05-18-2010	R3.73B	Assignee showing of ownership per 37 CFR 3.73.	PROSECUTION	1	
05-18-2010	PA..	Power of Attorney	PROSECUTION	1	
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05-03-2010	1449	List of References cited by applicant and considered by examiner	PRIOR ART	1	
04-26-2010	RXMRRX	Decision Merging Reexam and Reissue Proceedings -- Reexam Request	PROSECUTION	5	
02-09-2010	RXREXO	Determination -- Reexam Ordered	PROSECUTION	11	

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11-18-2009	RXNREQFD	Notice of reexamination request filing date	PROSECUTION	1	
11-18-2009	RXTTLRPT	Title Report	PROSECUTION	1	
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11-13-2009	RXPATENT	Copy of patent for which reexamination is requested	PROSECUTION	32	
11-13-2009	NPL	Non Patent Literature	PROSECUTION	20	
11-13-2009	NPL	Non Patent Literature	PROSECUTION	15	
11-13-2009	FOR	Foreign Reference	PROSECUTION	10	
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11-13-2009	NPL	Non Patent Literature	PROSECUTION	31	
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11-13-2009	NPL	Non Patent Literature	PROSECUTION	17	
11-13-2009	NPL	Non Patent Literature	PROSECUTION	105	
11-13-2009	NPL	Non Patent Literature	PROSECUTION	101	
11-13-2009	WFEE	Fee Worksheet (SB06)	PROSECUTION	2	
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95/001,261 DYNAMIC ASSOCIATION OF ELECTRONICALLY STORED INFORMATION WITH ITERATIVE WORKFLOW CHANGES **LTI0002-RXM**

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Reference Forms

Mail Room Date	Document Code	Document Description	Page Count	PDF
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12-02-2010	1449	List of References cited by applicant and considered by examiner	22	
12-02-2010	1449	List of References cited by applicant and considered by examiner	1	
09-08-2010	IDS	Information Disclosure Statement (IDS) Form (SB08)	1	
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05-03-2010	1449	List of References cited by applicant and considered by examiner	1	
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09-08-2010	NPL	Non Patent Literature	65	☐
08-24-2010	NPL	Non Patent Literature	22	☐
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08-23-2010	NPL	Non Patent Literature	10	☐
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08-23-2010	NPL	Non Patent Literature	14	☐
08-23-2010	NPL	Non Patent Literature	11	☐
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08-23-2010	NPL	Non Patent Literature	3	☐
08-23-2010	NPL	Non Patent Literature	11	☐
08-23-2010	NPL	Non Patent Literature	12	☐
08-23-2010	NPL	Non Patent Literature	7	☐
08-23-2010	NPL	Non Patent Literature	10	☐
08-23-2010	NPL	Non Patent Literature	3	☐
08-23-2010	NPL	Non Patent Literature	7	☐
08-23-2010	NPL	Non Patent Literature	85	☐
08-23-2010	NPL	Non Patent Literature	5	☐

08-23-2010	NPL	Non Patent Literature	3	☐
08-23-2010	NPL	Non Patent Literature	4	☐
08-23-2010	NPL	Non Patent Literature	3	☐
08-23-2010	NPL	Non Patent Literature	7	☐
08-23-2010	NPL	Non Patent Literature	3	☐
08-23-2010	NPL	Non Patent Literature	3	☐
08-23-2010	NPL	Non Patent Literature	3	☐
08-23-2010	NPL	Non Patent Literature	12	☐
08-23-2010	FOR	Foreign Reference	57	☐
08-23-2010	FOR	Foreign Reference	68	☐
08-23-2010	FOR	Foreign Reference	70	☐
08-23-2010	FOR	Foreign Reference	58	☐
08-23-2010	FOR	Foreign Reference	55	☐
08-23-2010	FOR	Foreign Reference	9	☐
08-23-2010	FOR	Foreign Reference	124	☐
08-23-2010	NPL	Non Patent Literature	19	☐
08-23-2010	NPL	Non Patent Literature	10	☐
08-23-2010	NPL	Non Patent Literature	10	☐
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11-13-2009	NPL	Non Patent Literature	20	☐
11-13-2009	NPL	Non Patent Literature	15	☐
11-13-2009	FOR	Foreign Reference	10	☐
11-13-2009	NPL	Non Patent Literature	31	☐
11-13-2009	NPL	Non Patent Literature	17	☐
11-13-2009	NPL	Non Patent Literature	11	☐
11-13-2009	NPL	Non Patent Literature	17	☐
11-13-2009	NPL	Non Patent Literature	105	☐
11-13-2009	NPL	Non Patent Literature	101	☐

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Date	Transaction Description
10-17-2012	Mail BPAI Decision on Appeal - Reversed
10-17-2012	BPAI Decision - Examiner Reversed
06-14-2012	Docketing Notice Mailed to Appellant
06-13-2012	Assignment of Appeal Number
06-13-2012	Appeal Awaiting BPAI Docketing
05-29-2012	Appealed Case awaiting BPAI Decision
05-16-2012	Certificate of Service
05-16-2012	Notice of Court Action
05-16-2012	RX - Concurrent Proceedings Notice
05-15-2012	Appealed Case awaiting BPAI Decision
05-15-2012	RX - Decision Denying Merger of Reexam Proceedings
04-23-2012	Ready for Examiner Action after RAN
04-17-2012	Administrator Remand to the Examiner by BPAI
01-26-2012	Docketing Notice Mailed to Appellant
01-25-2012	Assignment of Appeal Number
01-20-2012	Appeal Awaiting BPAI Docketing
01-11-2012	Appealed Case awaiting BPAI Decision
11-04-2011	RX - Reply Brief Noted by examiner
11-04-2011	Requester Rebuttal Brief Review by CRU Complete
11-03-2011	Ready for Examiner Action after Examiners Answer
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10-31-2011	Requester Rebuttal Brief Review by CRU Complete
09-28-2011	RX - Examiners Answer
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04-04-2011	Requester Appellants Brief Review by CRU Complete
02-04-2011	Certificate of Service
02-04-2011	Notice of Appeal- Requester
01-11-2011	Certificate of Service
01-11-2011	Reexam - Change in Power of Attorney (May Include Associate POA) for Third Party Requester
01-06-2011	RX - Inter Partes Right of Appeal Notice
12-02-2010	RX - Inter Partes Action Closing Prosecution
08-23-2010	Information Disclosure Statement considered
09-08-2010	Information Disclosure Statement considered
11-05-2010	Reexam Litigation Search Conducted
11-03-2010	Ready for Examiner Action after Nonfinal
11-02-2010	Certificate of Service
11-02-2010	Third Party Requester Comments after Non-final Action
10-18-2010	RX - Improper Letter Destroyed
09-08-2010	Information Disclosure Statement (IDS) Filed
09-08-2010	Affidavit(s), Declaration(s) and/or Exhibit(s) Filed
09-08-2010	Affidavit(s), Declaration(s) and/or Exhibit(s) Filed
09-08-2010	Response after non-final action - owner - timely
09-08-2010	Certificate of Service
09-08-2010	Information Disclosure Statement Filed

08-23-2010	Information Disclosure Statement (IDS) Filed
08-23-2010	Certificate of Service
08-23-2010	Information Disclosure Statement Filed
08-26-2010	RX - Notice of Defective Paper
08-23-2010	Certificate of Service
08-23-2010	Affidavit(s), Declaration(s) and/or Exhibit(s) Filed
08-23-2010	Affidavit(s), Declaration(s) and/or Exhibit(s) Filed
08-23-2010	Response after non-final action - owner - timely
07-08-2010	Certificate of Service
07-08-2010	Request for Extension of Time
05-21-2010	RX - Inter Partes Non-Final Office Action
05-18-2010	Change in Power of Attorney (May Include Associate POA)
04-26-2010	RX - Decision Merging Proceedings
02-09-2010	RX - Inter Partes Reexam Order - Granted
11-13-2009	Information Disclosure Statement considered
01-26-2010	Notice of Reexam Published in Official Gazette
11-25-2009	Case docketed to examiner
11-25-2009	Case Docketed to Examiner in GAU
11-20-2009	Reexam Litigation Search Conducted
11-18-2009	Reexamination Formalities Notice Mailed
11-18-2009	Reexamination Formalities Notice Mailed
11-18-2009	Completion of pre-processing - released to TC
11-18-2009	Notice of assignment of reexamination request
11-18-2009	Notice of reexamination request filing date
11-13-2009	Information Disclosure Statement Filed
11-13-2009	Reexamination requested by third party requester
11-13-2009	Information Disclosure Statement (IDS) Filed
11-13-2009	Receipt of Original Inter Partes Reexam Request

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APPENDIX 6

Board of Appeals reversal of Examiner ordering Reexamination #3

Oct. 17, 2012

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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	LTI0002-RXM	5286

74877 7590 10/17/2012

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

EXAMINER	
HUGHES, DEANDRA M	
ART UNIT	**PAPER NUMBER**
3992	

MAIL DATE	DELIVERY MODE
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.
Requester and Appellant

v.

LEADER TECHNOLOGIES, INC.
Patent Owner and Respondent

Appeal 2012-009270
Reexamination Control 95/001,261
Patent 7,139,761 B2
Technology Center 3900

Before ALLEN R. MACDONALD, STEPHEN C. SIU, and MEREDITH C. PETRAVICK, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*

DECISION ON APPEAL

Third Party Requester and Appellant Facebook, Inc. appeals under 35 U.S.C. §§ 134(c) and 315(b) the Examiner's decision not to reject claims 2, 3, 5, 6, 8, 10, 12-15, 24, 26, 29, 33, and 34 over various prior art references.[1] We have jurisdiction under 35 U.S.C. §§ 134(c) and 315(b).

STATEMENT OF THE CASE

This proceeding (Reexamination Proceeding 95/001,261) arose from a request by Facebook, Inc. for an inter partes reexamination of U.S. Patent 7,139,761 B2, titled "Dynamic Association of Electronically Stored Information with Iterative Workflow Changes," and issued to Michael T. McKibben and Jeffrey R. Lamb on November 21, 2006 (the '761 patent). Claims 1-16, 21, 23-26, 29, and 31-34 were subject to inter partes reexamination (see, e.g., Request for *Inter Partes* Reexamination, dated November 13, 2009, pp. 5-6).

Appellant and Requester Facebook, Inc. also filed a separate request for ex parte reexamination of claims 1, 2, 4-16, 21-29, and 31-35 of the '761 patent (Reexamination Proceeding 90/010,591) (see, e.g., Request for *Ex Parte* Reexamination, dated July 2, 2009, pp. 9-10), which was subsequently merged with inter partes reexamination proceeding 95/001,261 (see Decision, *Sua Sponte*, to Merge Reexamination Proceedings, dated April 26, 2010).

In a Decision Dissolving Merger of Reexamination Proceedings dated May 15, 2012, the merger of ex parte reexamination proceeding 90/010,591

[1] As described below, claims 1, 4, 7, 9, 11, 16, 21-23, 25, 27, 28, 31, 32, and 35 are not subject to appeal in this inter partes reexamination proceeding.

and inter partes reexamination proceeding 95/001,261 was dissolved and each of the proceedings was reconstituted as a separate proceeding.

In view of the dissolution of ex parte reexamination proceeding 90/010,591 and inter partes reexamination proceeding 95/001,261, the current appeal is directed solely to claims subject to reexamination in inter partes reexamination proceeding 95/001,261 (i.e., claims 1-16, 21, 23-26, 29, and 31-34) and does not include issues pertaining to claims reexamined in ex parte reexamination proceeding 90/010,591 (e.g., issues pertaining to claims 22, 27, 28, and 35).

The '761 patent describes a data management tool (col. 3, l. 17). Claim 2 (which depends from Claim 1) on appeal reads as follows:

1. A computer-implemented network-based system that facilitates management of data, comprising:

a computer-implemented context component of the network-based system for capturing context information associated with user-defined data created by user interaction of a user in a first context of the network-based system, the context component dynamically storing the context information in metadata associated with the user-defined data, the user-defined data and metadata stored on a storage component of the network-based system; and

a computer implemented tracking component of the network-based system for tracking a change of the user from the first context to a second context of the network-based system and dynamically updating the stored metadata based on the change, wherein the user accesses the data from the second context.

2. The system of claim 1, the context component is associated with a workspace, which is a collection of data and application functionality related to the user-defined data.

The Examiner confirms patentability of the claims over the following proposed rejections:

Claims 1-13, 16, 21, 23-26, 29, and 31-34 under § 102(b) as anticipated by Christopher K. Hess and Roy H. Campbell, "A Context File System for Ubiquitous Computing Environments," July 2002 ("Hess").

Claims 1-15, 21, 23-26, 29, and 31-34 under § 102(b) as anticipated by EP 1087306A2, March 28, 2001 ("Hubert").

Claims 1, 2, 4-15, 21, 23-26, 29, and 32-34 under § 102(b) as anticipated by iManage DeskSite 6.0, User Reference Manual, 1999 ("iManage").

Claims 1-16, 21, 23-26, 29, and 31-34 under § 103(a) as unpatentable over Hess and U.S. Patent 6,430,575 B1, August 6, 2002 ("Dourish").

Claims 9-15, 21, 23-26, and 31-34 under § 103(a) as unpatentable over Hess and Microsoft Corporation, "Computer Dictionary," 3rd Edition, 1997 ("Microsoft").

Claim 16 under § 103(a) as unpatentable over Hubert and U.S. Patent No. 6,434,403 B1, August 13, 2002 ("Ausems").

Claims 1-15, 21, 23-26, 29, and 31-34 under § 103(a) as unpatentable over Hubert and U.S. Patent Publication No. 2003/0120660 A1, June, 26, 2003 ("Maritzen").

Claim 3 under § 102(b) as anticipated by U.S. Patent No. 6,236,994 B1, May 22, 2001 ("Swartz").

Claims 1, 2, 4-16, 21, 23-26, 29, 31, and 33 under § 103(a) as unpatentable over Hess and Maritzen.

Judicial Proceedings

We are informed that the '761 Patent was the subject of litigation styled "*LEADER TECHNOLOGIES, INC. v. FACEBOOK, INC.,* Case No. 1:08-CV-00862 LPS, filed in the U.S. District Court for the District of Delaware (App. Br. 1), in which the jury found each asserted claim (i.e., claims 1, 4, 7, 9, 11, 16, 21, 23, 25, 31, and 32) invalid under 35 U.S.C. §102(b) as being on sale and in public use more than one year before the priority date to which it was entitled.

A Decision affirming the District Court's final judgment of the invalidity of claims 1, 4, 7, 9, 11, 16, 21, 23, 25, 31, and 32 under 35 U.S.C. § 102(b) was issued by the United States Court of Appeals for the Federal Circuit on May 8, 2012 (No. 2011-1366).[2]

ISSUE

Did the Examiner err in refusing to reject claims 2, 3, 5, 6, 8, 10, 12-15, 24, 26, 29, 33, and 34?

[2] In view of the final judgment of invalidity of claims 1, 4, 7, 9, 11, 16, 21, 23, 25, 31, and 32 by the United States Court of Appeals for the Federal Circuit, we will not consider issues of invalidity in this appeal pertaining to these claims. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1429 (Fed. Cir. 1988)("if a court finds a patent invalid, and that decision is either upheld on appeal or not appealed, the PTO may discontinue its reexamination"). Claims subject to this appeal are therefore claims 2, 3, 5, 6, 8, 10, 12-15, 24, 26, 29, 33, and 34.

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted).

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

"The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007).

ANALYSIS

Ex parte reexamination proceeding 90/010,591

Appellant argues that "[t]he Examiner did not address the four SNQs and several prior art references that were presented in the *Ex Parte* Request" (App. Br. 8). This issue is moot because, as indicated above, the merger of ex parte reexamination proceeding 90/010,591 and inter partes reexamination proceeding 95/001,261 was dissolved (see Decision Dissolving Merger of Reexamination Proceedings dated May 15, 2012).

Hess Reference

The Examiner refuses to adopt the proposed rejection of claims 2, 3, 5, 6, and 8 as anticipated by Hess. The Examiner states that Hess "does not disclose computer implemented tracking of this physical movement of the user" (Action Closing Prosecution 46-47) because, according to the Examiner, Hess merely discloses that "the context is set manually (*pg. 10, 2nd ¶*)" (Action Closing Prosecution 47). Claim 2, which depends from claim 1, recites a component "for tracking a change of the user from the first context to a second context." Hence, the Examiner appears to take the following position:

1) Claim 2 requires setting the context in a *non-manual* fashion.
2) Hess fails to disclose setting the context in a non-manual fashion (in contradistinction with this "requirement" of claim 2).
3) Therefore (and as a consequence of Hess failing to disclose setting a context non-manually), Hess fails to disclose tracking movement of the user.

We do not agree with the Examiner. First, the Examiner does not indicate how claim 2 requires setting the context in a "non-manual" fashion (point 1 above). Instead, claim 2 appears to merely recite "capturing context information," storing context information in metadata," and "updating the stored metadata" but does not appear to require that any of these activities are performed "non-manually" (or, presumably, "automatically"). Since the Examiner has not demonstrated that claim 2 requires setting the context non-manually (or "automatically"), we cannot agree with the Examiner of the relevance to claim 2 of whether Hess fails to disclose setting the context non-manually/automatically or not (point 2 above).

Even assuming that claim 2 requires that context information is captured "automatically" as the Examiner appears to assume, Hess discloses "the physical location of the user triggers the automatic configuration of the user's environment" (Request for Inter Partes Reexamination dated November 13, 2009, p. 14, citing Hess, § 1, page 4). Since a user's location or "context" is automatically configured (i.e., captured or updated) in Hess, we disagree with the Examiner's statement that Hess fails to disclose that context information is captured or updated "automatically" at least because Hess explicitly discloses that the context is configured automatically.

Second, still assuming that claim 2 requires setting the context in a non-manual or automatic fashion and further assuming that Hess fails to disclose the "automatic" feature as the Examiner appears to assume, the Examiner does not demonstrate how such a finding indicates that Hess also fails to disclose "tracking movement of the user" (point 3 above) since whether "capturing context information" is performed manually or automatically does not appear to impact the separate action of tracking a user.

As Appellant points out, Hess discloses that "[u]sers can move between spaces and their environment (i.e., applications, state, data, etc.) can move with them" (Request for Inter Partes Reexamination dated November 13, 2009, p. 31, citing Hess, § 1, page 3) and "personal mount points may be . . . automatically retrieved from a home server and merged into the current environment" (App. Br. 10; Hess, p. 5, § 2.1). The Examiner has not demonstrated a difference between these disclosures in Hess, for example, and "tracking a change of the user" as recited in claim 2. We do not

independently identify any differences because in both cases, the user's location is being tracked.

The Examiner also states that Hess fails to disclose a "component" for capturing context information and a "component" for tracking a user because "the mount server [of Hess] cannot be both the claimed context component and the claimed tracking component" (see, e.g., Action Closing Prosecution 47). However, as Appellant points out, "'components' can reside within a single computer or single program" (App. Br. 12, citing the '761 patent at col. 5, ll. 54-65). Hess discloses a server computer that one of ordinary skill in the art would have understood to execute computer algorithms with "components" for performing the disclosed functions of, for example, capturing context information (i.e., "the automatic configuration of the user's environment" (Hess, § 1, page 4)) and tracking a change of the user (e.g., "[u]sers can move between spaces and their environment (i.e., applications, state, data, etc.) can move with them" (Hess, § 1, page 3)).

We disagree with the Examiner that the "mount server" of Hess cannot contain a component for capturing context information and a component for tracking a user because, as described above, Hess discloses each of these functions being performed by a computer system. One of ordinary skill in the art would have understood that if the computer system of Hess performs specific functions, then the computer system of Hess contains "components" that perform the specified functions because otherwise, the specified functions would not be performed as disclosed by Hess.

The Examiner also refuses to adopt the rejection of claims 2, 3, 5, 6, and 8 as obvious over the combination of Hess and Dourish because, according to the Examiner, the proposed rejection "makes the conclusion [of obviousness] . . . without pointing to any specific teachings as to how this combination meets the claim limitations" (Action Closing Prosecution 47). With the exception of the issues already discussed above, the Examiner does not point to any additional specific elements that the combination of Hess and Dourish does not disclose or suggest. In addition, Appellant/Requester appears to provide sufficient reasons with supporting factual underpinnings to support the conclusion that the combination would have been obvious.[3] The Examiner does not point out any specific flaws in Appellant's/ Requester's rationale. In the absence of any specifically identified flaws in Appellant's rationale, we cannot agree with the Examiner.

The Examiner provides the same rationale(s) for refusing to adopt the rejection under 35 U.S.C. § 102(b) of claims 10, 12, and 13 as anticipated by

[3] Appellant states, for example, that "[i]t would also have been obvious to one of ordinary skill in the art to combine Hess and Dourish to provide the systems and methods claimed in claims 1-16, 21, 23-26, 29, 31-34. Both Hess and Dourish provide solutions to the same problems purportedly addressed in the '761 patent, which would lead a skilled artisan to look to both references for possible solutions to the problem. Both Hess and Dourish describe techniques for managing and organizing a user's data (including through using stored metadata), and both references disclose the ability of a user to move to a new context, workspace, or user environment in which the user accesses that data. A person of ordinary skill in the art could easily have combined the elements of both systems by known methods, with no change in their respective functions and yielding nothing more than results which would have been predictable at the time the '761 patent was filed" (Request for *Inter Partes* Reexamination dated November 13, 2009, p. 138)

Hess and the rejection under 35 U.S.C. § 103(a) of claims 10, 12-15, 24, 26, 29, 33, and 34 as unpatentable over Hess and Dourish and does not provide additional reasons for not adopting the rejection of claims 10, 12-15, 24, 26, 33, and 34 as unpatentable over Hess and Microsoft. We disagree with the Examiner's refusal to adopt the rejection of claims 10, 12-15, 24, 26, 29, 33, and 34 for at least the reasons set forth above.

Respondent agrees with the Examiner that "'the mount server [of Hess] cannot be both the claimed context component and the claimed tracking component'," that Hess fails to disclose "the '761 Patent's 'tracking component'," and that there is no discussion of "***how*** combining Hess and Dourish renders any claim obvious" (Respondent Br. 6). We disagree with Respondent for at least the reasons set forth above.

The Examiner erred in refusing to maintain the rejection of claims under 35 U.S.C. § 102(b) as anticipated by Hess; claims 2, 3, 5, 6, 8, 10, 12-15, 24, 26, 29, 33, and 34 under 35 U.S.C. § 103(a) as unpatentable over Hess and Dourish; and claims 10, 12-15, 24, 26, 33 and 34 under 35 U.S.C. § 103(a) as unpatentable over Hess and Microsoft.

Hubert, iManage, and Swartz references

Affirmance of the rejection for the above-referenced claims based on Hess renders it unnecessary to reach the propriety of the Examiner's decision to refuse to adopt the rejection of those claims on a different basis. *Cf. In re Gleave*, 560 F.3d 1331, 1338 (Fed. Cir. 2009). As such, we need not decide the propriety of the Examiner's refusal to adopt the additional proposed rejections of those claims over Hess, Hubert, iManage,

or Swartz, alone or in combination with any of Ausems, Maritzen, or Microsoft.

CONCLUSION

Issues pertaining to the propriety of proposed rejections in the corresponding ex parte reexamination proceeding are moot and not properly subject to appeal for review by the Board.

The Examiner erred in refusing to reject claims 2, 3, 5, 6, 8, 10, 12-15, 24, 26, 29, 33, and 34.

DECISION

We reverse the Examiner's decision not to maintain the rejection of claims 2, 3, 5, 6, 8, 10, 12, and 13 under 35 U.S.C. § 102(b) as anticipated by Hess; claims 2, 3, 5, 6, 8, 10, 12-15, 24, 26, 29, 33, and 34 under 35 U.S.C. § 103(a) as unpatentable over Hess and Dourish; and claims 10, 12-15, 24, 26, 33 and 34 under 35 U.S.C. § 103(a) as unpatentable over Hess and Microsoft.

Pursuant to 37 C.F.R. § 41.77(a), the above-noted reversal constitutes a new ground of rejection and is hereby designated as such. Section 41.77(b) provides that "[a] new ground of rejection . . . shall not be considered final for judicial review." That section also provides that Patent Owner, WITHIN ONE MONTH FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal proceeding as to the rejected claims:

> (1) *Reopen prosecution.* The owner may file a response requesting reopening of prosecution before the examiner. Such a response must be either an amendment of the claims so rejected or new evidence relating to the claims so rejected, or both.
>
> (2) *Request rehearing.* The owner may request that the proceeding be reheard under § 41.79 by the Board upon the same record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

In accordance with 37 C.F.R. § 41.79(a)(1), the "[p]arties to the appeal may file a request for rehearing of the decision within one month of the date of: . . . [t]he original decision of the Board under § 41.77(a)." A request for rehearing must be in compliance with 37 C.F.R. § 41.79(b). Comments in opposition to the request and additional requests for rehearing must be in accordance with 37 C.F.R. § 41.79(c) & (d), respectively. Under 37 C.F.R. § 41.79(e), the times for requesting rehearing under paragraph (a) of this section, for requesting further rehearing under paragraph (d) of this section, and for submitting comments under paragraph (c) of this section may not be extended.

An appeal to the United States Court of Appeals for the Federal Circuit under 35 U.S.C. §§ 141-144 and 315 and 37 C.F.R. § 1.983 for an *inter partes* reexamination proceeding "commenced" on or after November 2, 2002 may not be taken "until all parties' rights to request rehearing have been exhausted, at which time the decision of the Board is final and

appealable by any party to the appeal to the Board." 37 C.F.R. § 41.81. *See also* MPEP § 2682 (8th ed., Rev. 8, July 2010).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REVERSED
37 C.F.R. § 41.77(b)

PATENT OWNER:

KING AND SPALDING LLP
1700 PENNSYLVANIA AVE, NW
SUITE 200
WASHINGTON, DC 20006

THIRD PARTY REQUESTER:

COOLEY GODWARD KRONISH LLP
777 6TH STREET, NW
SUITE 1100
WASHINGTON, DC 20001