UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.
Requester

v.

LEADER TECHNOLOGIES, INC.
Patent Owner

Appeal 2014-000788
Reexamination Control 95/001,261
Patent 7,139,761 B2
Technology Center 3900

Before JAMES T. MOORE, STEPHEN C. SIU and

SIU, Administrative Patent Judge.

DECISION
Examiner’s Determination under 37 C.F.R. § 41.77(d)
37 C.F.R. § 41.77(f)
In an earlier Decision, 2012-009270, mailed October 17, 2012 ("Decision"), the Board reversed the Examiner’s decision favorable to the patentability of claims 2-3, 5-6, 8, 10, 12-15, 24, 26, 29, 33, and 34 of US Patent No. 7,139,761 B2 (the "’761 patent"). Decision 12. In particular, we reversed the Examiner’s decision not to reject claims 2-3, 5-6, 8, 10, 12-15, 24, 26, 29, 33, and 34 over prior art. Our reversal of the Examiner’s decision in connection with the prior art rejections of claims 2-3, 5-6, 8, 10, 12-15, 24, 26, 29, 33, and 34 was designated new grounds of rejection pursuant to 37 C.F.R. § 41.77(b).

Patent Owner, Leader Technologies, Inc., elected to reopen prosecution and submitted amendments affecting claims 2-3, 5-6, 8, 10, 12-15, 24, 26, 29, 33, and 34. Patent Owner argued that the newly presented amendments pursuant to 37 C.F.R. § 41.77(b) distinguished claims 2-3, 5-6, 8, 10, 12-15, 24, 26, 29, 33, and 34 over the rejections that were applied to those claims (see, e.g., PO Request 15-21). Requester, Pacebook, Inc., filed comments pursuant to 37 C.F.R. § 41.77(c) in response to Patent Owner’s request to reopen prosecution. In Requester’s comments ("3PR Resp."), Requester proposed new rejections in response to Patent Owner’s claim amendments. Specifically, Requester proposed the following rejections:

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1 See Patent Owner’s “Request to Reopen Prosecution Under 35 C.F.R. 41.77(b)(1)” filed November 16, 2012 (“PO Request to Reopen Prosecution” or “PO Request”).

2 See Requester’s “Third Party Requester’s Comments on the Patent Owner’s Amendment and Request to Reopen Prosecution in Inter Partes Reexamination” filed December 17, 2012 (“3PR Resp.”).
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Claims 2-3, 8, 10, 12, 24, 33, and 34 under 35 U.S.C. § 314(a) as impermissibly broadening the scope of the claims;
Claims 2-3, 5-6, 8, 10, 12-15, 24, 26, 29, 33 and 34 under 35 U.S.C. § 112, 1st paragraph for failing to satisfy the written description requirement;
Claim 2 as anticipated by Hess;
Claims 2-3, 5-6, 8, 10, 12-15, 26, 29, and 33 as obvious over Hess and Dourish;
Claims 24 and 34 as obvious over Hess, Dourish, and Hill;
Claims 2-3, 5-6, 8, 10, 12-14, 26, 29, and 33 as anticipated by Swartz;
Claims 3, 24, and 34 as obvious over Swartz and Hill;
and
Claim 15 as obvious over Swartz and Fox.

3PR First Resp. 6-48.

In accordance with 37 C.F.R. § 41.77(d), the Examiner adopts each of Requester’s proposed rejections.3

Pursuant to 37 C.F.R. § 41.77(e), both Patent Owner and Requester submitted responses to the Examiner’s Determination.4 Patent Owner also submitted new claim amendments affecting claims 2-3, 5-6, 8, 10, 12-15, 24, 26, 29, 33, and 34.

3 See “Determination under 37 CFR § 41.77(d)” mailed April 29, 2013 (“Examiner’s Determination” or “Ex’r Determ.”).

Pursuant to 37 C.F.R. § 41.77(f), the proceeding has been returned to the Board so that we may reconsider the matter and issue a new decision.

In response to Examiner’s determination of unpatentability of each of claims 2-3, 5-6, 8, 10, 12-15, 24, 26, 29, 33, and 34 (Examiner’s Determination), Patent Owner does not argue patentability of claims 2-3, 5-6, 8, 10, 12-15, 24, 26, 29, 33, or 34 as amended pursuant to 37 C.F.R. § 41.77(b) and presented in the “PO Request to Reopen Prosecution” dated November 16, 2012. In other words, Patent Owner does not demonstrate persuasively that the Examiner erred in adopting the rejections (noted above) of claims 2-3, 5-6, 8, 10, 12-15, 24, 26, 29, 33, or 34, as amended in Patent Owner’s request to reopen prosecution pursuant to 37 C.F.R. § 41.77(b).

Patent Owner proposes new amendments to each of claims 2-3, 5-6, 8, 10, 12-15, 24, 26, 29, 33, and 34 (PO Resp. to Exr’s Determination, pp. 2-9) under 37 C.F.R. § 41.77(e) and argues that the claim amendments presented should be entered pursuant to 37 C.F.R. § 1.116(b)(3) (PO Response to Examiner’s Determination, pp. 10-11). 37 C.F.R. § 1.116(b)(3) states that “[a]fter a final rejection . . . in an inter partes reexamination . . . but before or on the same date of filing an appeal . . . [a]n amendment touching the merits of the . . . patent under reexamination may be admitted . . .” Notably, 37 C.F.R. § 1.116(b)(3) permits entry of new claim amendments in an inter partes reexamination “before or on the same date of filing an appeal.” In the present case, Patent Owner presents new claim amendments after the date of filing the appeal. Therefore, we disagree with Patent Owner that 37 C.F.R. § 1.116(b)(3) applies to the present case.
Also, 37 C.F.R. § 41.77(e) states that in response to the Examiner’s determination pursuant to 37 C.F.R. § 41.77(d), Patent Owner may “submit comments in response to the examiner’s determination” but does not appear to permit Patent Owner to also submit new claim amendments in response to the Examiner’s determination. Nor does Patent Owner provide an adequate showing that 37 C.F.R. § 41.77(e) permits the entry of new claim amendments after the Examiner’s determination pursuant to 37 C.F.R. § 41.77(d). Therefore, Patent Owner’s proposed claim amendments submitted with Patent Owner’s response to the Examiner’s Determination (i.e., pursuant to 37 C.F.R. § 41.77(e)) are not entered.

In reviewing the Examiner’s Determination, we do not discern any cause to conclude that the determinations conveyed therein, and as summarized above, are incorrect. Accordingly, after due consideration of the record before us, we are not persuaded of error in the Examiner’s determinations.

CONCLUSION

The Examiner’s determination that each of Requester’s proposed rejections of claims 2-3, 5-6, 8, 10, 12-15, 24, 26, 29, 33, and 34 should be adopted is affirmed.

AFFIRMED

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

The time period for reply, if any, is set in the attached communication.