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(For Patent Owner)

In re reissue application of  
Giuseppe Dal Pra'  
Application No. 11/366,984  
Filed: March 2, 2006  
For: U.S. Patent 6,698,567

**MAILED**

**JUL 25 2006**

**CENTRAL REEXAMINATION UNIT**

**DECISION  
SUSPENDING  
ACTION**

The instant reissue application is before the Office of Patent Legal Administration for *sua sponte* consideration as to action to be taken under 37 CFR 1.991 at this time.

**REVIEW OF THE FACTS**

1. U.S. Patent 6,698,567 (the '567 patent) issued to Giuseppe Dal Pra' on March 2, 2004.
2. On June 3, 2004, a request for *inter partes* reexamination of the '567 patent was filed by a third party requester. The resulting reexamination proceeding was assigned control number 95/000,044 (the '044 reexamination proceeding). Shimano, Inc. is identified as the real party in interest for the requester.
3. On July 13, 2004, a notice of the filing of the *inter partes* reexamination was published in the *Official Gazette*.
4. On July 30, 2004, an order granting the *inter partes* reexamination request was mailed for the '044 reexamination proceeding. The order was accompanied by a first Office action.
5. On October 29, 2004, comments by the third party requester, stated to be in response to a patent owner's amendment of September 30, 2004, were received for the '044 proceeding. Office records, however, do not reveal that patent owner's amendment of September 30, 2004, was ever received in the file of the '044 proceeding.
6. On November 2, 2004, an amendment by the patent owner was filed in the '044 proceeding. The November 2, 2004 amendment established the timely filing of the response as of September 30, 2004, in compliance with 37 CFR 1.8.
7. On December 22, 2004, a Notice of Informal or Nonresponsive Amendment was mailed in the '044 proceeding, in response to the November 2, 2004 amendment.

8. On January 24, 2005, an amendment by the patent owner was filed in the '044 proceeding, in response to the December 22, 2004 notice.
9. On February 28, 2005, comments by the third party requester were filed in the '044 proceeding, in response to the January 24, 2005 amendment.
10. On September 1, 2005, a second non-final Office action was mailed for the '044 proceeding.
11. On November 1, 2005, an amendment by the patent owner was filed in the '044 proceeding.
12. On November 17, 2005, a Notice of Informal or Nonresponsive Amendment was mailed in the '044 proceeding, in response to the November 1, 2005 amendment.
13. On November 22, 2005, an amendment by the patent owner was filed in the '044 proceeding, in response to the November 17, 2005 notice.
14. On December 5, 2005, comments by the third party requester were filed in the '044 proceeding, in response to the November 22, 2005 amendment.
15. On March 2, 2006, the patent owner filed a "broadening" reissue application for reissue of the '567 patent, which was assigned application number 11/366,984 (the '984 reissue application). New claims 51-53 (not present in the '567 patent) are provided in the reissue application. No Office action has been mailed for the '984 reissue application.
16. On April 7, 2006, an Action Closing Prosecution was mailed in the '044 proceeding.
17. On May 4, 2006, an amendment by the patent owner was filed in the '044 proceeding. Entry of this amendment is pending the examiner's review.
18. On May 23, 2006, a notice of the filing of the reissue application was published in the *Official Gazette*.
19. On June 1, 2006, comments by the third party requester were filed in the '044 proceeding, in response to the May 4, 2006 amendment.

### CLAIMS OF RECORD

A review of the prosecution history of the '044 reexamination proceeding reveals that new claims 51-78 have been added. Original claims 8, 9, 11-14, 16, 17, 23, 27, 30, 31, 33-35, 37, 39-41, 45, 46, and 48 have been amended. Original claims 26, 29, and 43, as well as new claim 54, have been cancelled.

A review of the '984 reissue file shows that patent owner has added new claims 51-53. No original claims have been amended or cancelled. New claims 51-53, as recited in the reissue application, are not present in the reexamination proceeding.

The claims of the '984 reissue application and the claims of the '044 reexamination proceeding are not identical.

### DECISION

Under 37 CFR 1.991:

If a reissue application and an *inter partes* reexamination proceeding on which an order pursuant to § 1.931 has been mailed are pending concurrently on a patent, a decision may be made to merge the two proceedings or to suspend one of the two proceedings.

The instant reissue application number 11/366,984 and reexamination proceeding control number 95/000,044 are currently pending for the same patent. Since the order has been mailed pursuant to 37 CFR 1.931 for the '044 reexamination proceeding, and since both proceedings have been announced in the *Official Gazette*, a decision under 37 CFR 1.991 is timely.

### The Merger Option

If the instant *inter partes* reexamination and reissue proceedings were to be merged, the merger would permit a third party (the *inter partes* reexamination requester) to comment on the broadened claims of the reissue application, and to participate in the appeal process as to these claims. The reissue and reexamination statutes, however, do not provide this right of third party comment and participation in a reissue application. When Congress legislated the *inter partes* reexamination statute, Congress provided, in 35 U.S.C. 314(a), the following unambiguous limitation:

**“In any *inter partes* reexamination proceeding under this chapter, the patent owner shall be permitted to propose any amendment to the patent and a new claim or claims, **except that no proposed amended or new claim enlarging the scope of the claims of the patent shall be permitted.**”** [Emphasis added]

A decision to merge the '044 reexamination proceeding and the instant '984 reissue application would include, within the merged proceeding, pending claims which are broader than the claims of the issued patent, and any such claims subsequently added. In the instance case, at least some

of the pending claims in the '984 reissue application are broader than the claims of the '044 reexamination proceeding.

The rights of the *inter partes* reexamination requester to comment during a merged proceeding and to participate in the appeal process cannot be annulled, since they are required by statute, i.e., 35 U.S.C. 314(b) and 35 U.S.C. 315(b), respectively. Thus, a merger of the '044 proceeding and the instant '984 reissue application would provide the third party requester with the right to support any Office rejections and to reply to any Office or patent owner reasons for patentability with regard to the newly added broadened claims. Yet, the effect and intent of the *inter partes* reexamination statute (35 U.S.C. 314(a)) is to preclude any third party requester comment and participation as to broadened claims. Since third party requester input as to the broadened claims presented by the '984 reissue application, and Office consideration of that input, is not within the scope of *inter partes* reexamination, nor is it provided for elsewhere by statute, combining the '044 *inter partes* reexamination proceeding with the instant broadening reissue application would run counter to the patent statute.

The main (focal) point here is that third party requester input, and Office consideration of that input, as to the broadened claims *per se* is not within the scope of *inter partes* reexamination, since the *inter partes* reexamination statute precludes this. The merger of the *inter partes* reexamination proceeding with the reissue application would permit and provide for such input and consideration as to the broadened claims of the '984 reissue application, in violation of the statute;<sup>1</sup> thus, a merger of the proceedings would not be appropriate.

Furthermore, grounds of rejection of the patent claims other than those based solely on prior patents and printed publications can be advanced in the reissue proceeding under 35 U.S.C. 251, and again, the patent statute does not confer the reexamination requester with the right to comment on these grounds.

A merger would also fundamentally change the nature of what would otherwise be an *ex parte* reissue proceeding under 35 U.S.C. 251; i.e., what would otherwise be an *ex parte* proceeding as to the broadened claims, in which the full scope of the grounds of rejection can be applied.

In summary, while in other situations it may be beneficial to consolidate reexamination and reissue proceedings within the Office, in this instance, the third party's request for merger would promulgate an interpretation of the patent regulations that violates federal statute.<sup>2</sup>

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<sup>1</sup> Even if broadening claims were not presently included in the reissue application, the applicant/patent owner could provide broadening claims at some future point in the prosecution.

<sup>2</sup> An Office decision to merge would present a position inconsistent with the Congressional mandate of the reexamination statute as set forth above, and thus, it must be rejected. See *Federal Election Comm'n v. Democratic Senatorial Campaign Comm'n*, 454 U.S. 27, 32 (1981) (administrative constructions of statutes must be rejected "that are inconsistent with the statutory mandate or that frustrate the policy that Congress sought to implement") and *Public Employees Retirement System v. Betts*, 492 U.S. 158, 171 (1989) ("[N]o deference is due to an agency interpretation at odds with the plain language of the statute itself.")

### **The Option to Conduct the Proceedings Separately**

It is not appropriate to conduct the examination of the reissue and reexamination proceedings separately, and at the same time, for the '567 patent. The reason for this Office policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the multiple proceedings on behalf of the patent owner. As pointed out above, the claims of the reissue application and the claims of the reexamination proceeding are not identical.

In addition, if the examination of the reissue and reexamination proceedings were conducted separately in this instance, the patent owner could place all of its responsive comments (even those directed to the non-broadened claims) in the reissue application and not in the reexamination proceeding. The third party requester would then be barred from responding in the *inter partes* reexamination proceeding, while the Office would have the benefit of the patent owner's input as to the claims by way of the reissue application. This would run contrary to the intent of the *inter partes* reexamination statute for requester participation.

### **The Suspension Option**

Given that the examination of the instant reissue and reexamination proceedings will not be conducted separately and at the same time, and will not be merged for the reasons stated above, the question remains as to which of the two proceedings should proceed, and which should be suspended.

To answer this question, it is observed that there is a statutory requirement for "special dispatch" in *inter partes* reexamination proceeding (pursuant to 35 U.S.C. 314(c)). Because 35 U.S.C. 314(c) provides the statutory requirement that *inter partes* reexamination proceedings must be conducted with special dispatch, the examination of the reexamination proceeding must take precedence.

Furthermore, in making a decision on whether or not to merge a reissue application and a reexamination proceeding, consideration is given to the status of each proceeding. See MPEP 2686.03.

In this instance, a substantial amount of prosecution has taken place in the reexamination proceeding over the past two years. As set forth in the Action Closing Prosecution of April 7, 2006, claims 1-8, 11, 15, 18-25, 27, 28, 51-53, 55-58, 60, 61, 63-73 and 75-78 are rejected. Claims 9, 10, 12, 14, 16, and 17 are objected to. Original claims 26, 29, and 43, as well as new claim 54, have been cancelled. Claims 13, 30-42, 44-50, 59, 62 and 74 have been indicated by the examiner to be patentable. An amendment after Action Closing Prosecution has been filed by the patent owner on May 4, 2006, and responsive comments by the third party requester were filed on June 1, 2006.

In contrast, the '984 reissue application was not filed until March 2, 2006, and it was not announced in the *Official Gazette* until May 23, 2006. No Office action on the merits has issued for the '984 reissue application.

Thus, a suspension of the reissue proceeding would not result in a delay of a proceeding that has progressed substantially toward its resolution, while a suspension of the reexamination proceeding would.

Finally, the reissue application was filed for the purpose of broadening the patent prior to the expiration of the statutory period for broadening the patent claims; i.e., two years from the patent grant. A suspension of the reissue proceeding will not interfere with that purpose, since the patent owner's right to have the broadened claims considered by the Office will be preserved. At the same time, the broadened claims in the suspended reissue application will be kept beyond the reach of the third party requester's comments.

Based on the above, action in the reissue application is hereby **suspended** pursuant to 37 CFR 1.103(e) in favor of the reexamination proceeding. The reissue application suspension shall remain in effect until the conclusion of the *inter partes* reexamination proceeding control no. 90/000,044 by the issuance of the reexamination certificate.

### **CONCLUSION**

1. Action in the 11/366,984 reissue application is **suspended** pursuant to 37 CFR 1.103(e), until the completion of the *inter partes* reexamination proceeding control number 95/000,044 by the issuance of the reexamination certificate.
2. After the reexamination certificate for the '044 reexamination proceeding has issued, an Office action will be mailed for the reissue application.
3. At the time that a reexamination certificate is issued for the 95/000,044 reexamination proceeding, the patent owner is advised to call the issuance of the certificate to the attention of the Office, and request a resumption of examination of the reissue application. The patent owner may include an amendment of the reissue application claims at that time, if it is deemed appropriate based upon the results of the reexamination proceeding.

4. Telephone inquiries relating to the examination of the reissue proceeding should be directed to the primary examiner, Rodney H. Bonck, at (571) 272-7089.
5. Telephone inquiries relating to this decision should be directed to Cynthia L. Nessler, Legal Advisor, at (571) 272-7724.



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Office of Patent Legal Administration  
Office of Patent Examination Policy

July 18, 2006

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