

Reexam Petition Decision - Denied

2-17-2012

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/011,267	10/06/2010	6195662	110529RX	5085
14958	7590	02/17/2012	EXAMINER	
Scott M. Daniels, Westerman, Hattori, Daniels & Adrian LLP 1250 Connecticut Avenue, NW. Ste. 700 Suite 1500 Washington, DC 20036			ART UNIT	PAPER NUMBER

DATE MAILED: 02/17/2012

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



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Date:

MAILED

FEB 09 2002

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90011267

PATENT NO. : 6195662

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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FEB 17 2012
CENTRAL REEXAMINATION UNIT

JOHN V. BIERNACKI, ESQ. : (For Third Party
JONES DAYS : Requester)
901 LAKESIDE AVENUE :
CLEVELAND, OH 44114 :

In re: Ellis et al. :
Ex Parte Reexamination Proceeding : DECISION ON PETITION
Control No.: 90/011,267 : UNDER 37 CFR § 1.181
Deposited: October 6, 2010 :
For: U.S. Patent No.: 6,195,662 :

This is a decision on a petition filed by the patent owner on August 23, 2011 entitled "PETITION UNDER 37 C.F.R. 1.181 REGARDING EXAMINER'S REFUSAL TO WITHDRAW FINALITY OF REJECTION IN *EX PARTE* REEXAMINATION OF U.S. PATENT NO. 6,195,662" [hereinafter "the petition"], and is a request to the Director to exercise his discretion pursuant to 37 CFR § 1.181 to withdraw the finality of the Office action mailed May 12, 2011.

The petition is before the Assistant Deputy Commissioner for Patent Operations, who is acting in a capacity to oversee the Central Reexamination Unit. The petition is denied.

REVIEW OF RELEVANT FACTS

- U.S. Patent No. 6,195,662 issued on February 27, 2001.
- A request for *ex parte* reexamination was filed on October 6, 2010 and assigned control no. 90/011,267.
- *Ex parte* reexamination was ordered and prosecution progressed until a final Office action was mailed on May 12, 2011.
- Patent owner filed a response on May 23, 2011 including substitute declarations.
- The examiner issued an Advisory Action on June 7, 2011.
- Patent owner filed an after final response on July 12, 2011.
- The examiner issued an advisory action on August 11, 2011.
- On August 23, 2011, patent owner filed the instant petition.

STATUTES, REGULATIONS, AND PATENT EXAMINING PROCEDURES

MPEP § 706.07(a) Final Rejection, When Proper on Second Action (in part)

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). Where information is submitted in an information disclosure statement during the period set forth in 37 CFR 1.97(c) with a fee, the examiner may use the information submitted, e.g., a printed publication or evidence of public use, and make the next Office action final whether or not the claims have been amended, provided that no other new ground of rejection which was not necessitated by amendment to the claims is introduced by the examiner. See MPEP § 609.04(b). Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent

owner in spite of the fact that other claims may have been amended to require newly cited art. Where information is submitted in a reply to a requirement under 37 CFR 1.105, the examiner may NOT make the next Office action relying on that art final unless all instances of the application of such art are necessitated by amendment.

DECISION

Patent owner [“petitioner”] argues that the final Office action issued May 12, 2011 [“Final Action”] is improper and should be reissued as a non-final action. Petitioner apparently has two separate concerns with the examiner’s actions—that the examiner did not give the patent owner a fair opportunity to substantively respond to the final rejection, and that the final rejection included, as characterized by petitioner, new grounds of rejection.

Unfairness Concerning Failure to Address Declarations¹

In the first Office action, the examiner applied two rejections: anticipation by DBMS Copy Pus [“DBMS”], and obviousness over DAISy in view of DBMS. With its first response of March 7, 2011, the patent owner filed several declarations—one by Gregory and several by Rudd. The Gregory Declaration claimed that DAISy is not a prior art printed publication. The Rudd Declarations claimed that the references lack a “data bug” (Exh. A), that DBMS does not operate in a multiple computer system environment (Exh. B), that DBMS is not enabling (Exh. C), and that the references cannot be combined due to teaching away or inoperability (Exhs. D & E).

In the Final Action, the examiner maintained both rejections and refused to consider the declarations, stating they were non-compliant with formal requirements. Final Action pp. 3-4. She stated the Gregory Declaration was given no consideration; she stated the opinions set forth in the declarations related to patent owner’s arguments would be addressed. *Id.* The examiner did address arguments as to the references teaching a data bug, pp. 6-7, DBMS operating in a multiple computer environment and whether that is claimed, pp. 7-8, enablement of DBMS, pp. 8-9, and whether the combination of references teach away, pp. 9-11, or are inoperable, pp. 11-12. The examiner therefore addressed the issues presented by the Rudd Declarations.

Patent owner filed substitute declarations on May 23, 2011, complying with the examiner’s formal requirements. In that filing patent owner stated that it discussed the situation with the examiner and that they agreed that the examiner would substantively consider the new declarations and issue an advisory action based on that consideration. They agreed that the

¹ It is not entirely clear whether the petitioner is relying on this argument as a basis for removal of the finality of the Final Action. It is, quite frankly, unclear why petitioner even discussed this issue, as the complained of actions have resulted in withdrawal of one of the rejections, and it appears that the examiner did exactly what she said she would do. But in any case, to the extent petitioner alleges improper examiner actions as to this issue, it will be addressed.

patent owner would then be permitted to respond to the advisory action to substantively respond to any rejections then remaining. Patent owner further stated that it did not agree that the original declaration were non-compliant, but nonetheless filed the substitute declarations to avoid any unnecessary dispute.

The examiner then issued an advisory action on June 7, 2011, considering the declarations and agreeing that DAISy is not available as prior art. Accordingly, the obviousness rejection based on DAISy was withdrawn. The examiner stated that the issues of the Rudd Declarations as to DBMS were effectively presented and responded to in the Final Action, and she referenced that action. The examiner additionally stated that the Rudd Declarations concerning DAISy were moot and were not further addressed.

Patent owner responded on July 12, 2011, claiming that the Final Action was improper as including new grounds of rejection, presenting new arguments as to DBMS, and presenting a new Rudd Declaration. Patent owner filed a supplemental response on August 10, 2011, allegedly based on "new Federal Circuit authority." This response cited a new decision that the patent owner alleges applies to the facts of this case.

The examiner issued another advisory action on August 11, 2011. The examiner stated that the response of July 12th and accompanying Rudd Declaration were entered but were not persuasive, and the "[c]laim rejections are maintained as per Final Office Action (05/12/2011) for reasons of record therein." Presumably the examiner meant only the DBMS anticipation rejection was maintained, and the withdrawal of DAISy remained as in the June 7th Advisory Action.

Now, patent owner complains of the "injustice" of these acts. Yet, the examiner, in the Final Action, discussed the issues presented in the Rudd Declarations; the examiner permitted substitute declarations to be filed on May 23rd, after the final rejection. The examiner withdrew a rejection because of the substitute declarations, therefore she clearly considered them. The examiner permitted for entry a second after-final response and an additional after-final declaration with that second response.² This even though patent owner's only showing under 37 CFR § 1.116 was an allegation of new grounds of rejection, a point that as discussed *infra* is not persuasive.

Additionally, the examiner did exactly what patent owner said that they agreed to in its May 23rd submission. Again, she considered the substitute declarations, then issued an advisory action.

² It is of no moment that patent owner "reserved the right," when filing the May 23rd substitute declarations, to file an additional substantive response. It is not up to the patent owner to determine the number and type of responses that it may file after a final rejection, particularly as its second after final response included new evidence subject to 37 CFR § 1.116(e). This type of submission is not entered as a matter of right, therefore patent owner had no rights to reserve. This underscores the lack of injustice in the examiner's acts, as she was not required to enter this submission.

Patent owner responded to the advisory action with a substantive response, explaining why it believed the examiner had erred. This response included a declaration, i.e. additional evidence whose entry is subject to 37 CFR § 1.116. The examiner entered all of these responses and declarations. The examiner did everything that patent owner says they agreed upon. The examiner did more than was required by the regulations.

Patent owner says that the examiner merely paid “lip service” to the declarations in the Final Action. Even “lip service” is more consideration than she needed to give, as the declarations were deemed non-compliant.³ In any case, the examiner addressed the very issues presented in all of the Rudd Declarations and responded to those issues in the Final Action. She did not consider the Gregory Declaration because it was not properly of record; there is nothing improper with not considering evidence that was not properly made of record.

Patent owner’s only possible complaint as to any unfairness is the fact that the action was made final to begin with, though as we will see that also was not improper. Accordingly, any argument as to unfairness is unpersuasive and not a reason to remove finality.

New Grounds

Petitioner alleges the Final Action was improper as it included new grounds of rejection. While both the first Office action and the Final Action relied upon anticipation by DBMS, petitioner argues there is a new ground because the examiner (1) relied upon a new fact to support her definition of “data bag”, (2) provided a new theory as to what part of the prior art met the data bag, and (3) provided a new theory as to why DBMS operates in a “multiple computer system environment.” The ultimate criterion of whether a rejection is considered “new” is whether the patent owner has had fair opportunity to react to the thrust of the rejection. *In re Leithem*, 100 USPQ2d 1155, 1158 (Fed. Cir. 2011) (referring to new grounds issued by the Board, a different but analogous situation).

Pages 2-16 of the Final Action are a response to patent owner’s previous submission, including a response to patent owner’s arguments against the rejections. On page 17 of the Final Action, the examiner stated “Examiner maintains the rejections of claims 1-11 and 14-19. Rejections are incorporated by reference from Non Final Action 01/07/2011.” Clearly, in that sense, the rejections are the same as those presented previously, as they are explicitly incorporated by reference. Petitioner argues, however, that the examiner’s response to arguments set forth new grounds of rejection.

³ Patent owner apparently disputed this, but it never petitioned this issue. While the Director agrees that it is good for parties to resolve disputes with the examiner if possible, rather than resorting to petitions, if the examiner keeps important evidence out of the record that can be a case-changing issue. If a party believes that act is improper, it would be wise to petition that issue, rather than complain of that fact later and potentially lose the chance to have that evidence entered.

As to arguments (1) and (2), petitioner relies upon the following paragraph of the Final Action as showing the examiner relied upon new facts and theories:

Examiner asserts that a 'data bag' is fairly construed as a buffer or file type of software structure (i.e., record or database) that is described as containing data and definitions of the data. However, the term is broadened by way of the '662 Specification teaching at 8: 63-67, "...specific terms...are used in a generic and descriptive manner only and not for purposed of limitation..." Notably, the '662 Specification does not narrowly define the 'definitions of the data.' DBMS Copy Plus teaches 'record' transferring from the input database (p. 4, i.e., data is stored in record format). An example given at p. 8 of DBMS Copy Plus shows an input data base (data bag for storing imported data) with a .rxd extension, as an indication of the Reflex file format of the data (definition of the data). Also see p. 58, "The extension must be the pseudo extension associated with the particular software system the file is written in." Records with related extensions, required by DBMS Copy Plus, are used in a manner analogous to an import data bag/export data bag, where the extensions fairly teach a 'definition of the data.'

Final Action pp. 6-7.

Petitioner states that the reliance on the language at the end of the specification (col. 8 ll. 63-67) is a reliance on a new fact, i.e. argument (1). It is apparent, however, that the examiner's citation to this part of the specification was merely for rebuttal of the patent owner's argument that it acted as its own lexicographer to define "data bag" in the specification. The examiner's citation to the specification was merely to say "you did not precisely define data bag because you left it open to broader terms." Mere rebuttal of a patent owner's argument is not a new ground of rejection, otherwise nearly every final rejection would include a new ground. Argument (1) is therefore unpersuasive.

Petitioner states the examiner's reliance on an input data base as the claimed "data bag" is a new theory of how the prior art meets the claim, i.e. argument (2). Upon careful consideration the theory of the rejection has not changed at all, therefore this argument is unpersuasive.

The third party requester (and the examiner, via incorporating the third party's arguments) alleged the claimed "data bags" were met by the DBMS memory data structures that receive rows of data from a database, and that receive filtered data after a rule is applied. See Request pp. 21; 34-36. The Request, however, also appears to refer to records as data bags. The "select statement" was said by the requester to "evaluate[] all rows imported into memory (an input data bag)." Request p. 35; First Action at p. 5. Thus, it would seem that the thing that the select statement "evaluates" is what the third party calls a data bag. But DBMS also says the select statement "evaluates each record in the input database." See Request p. 35; DBMS p. 90. An

example is shown as well—the 40,000 dollar employee example—where it is said that `employee.rxd` is input, and `badbucks.ssd` is output. *Id.* In other words, it evaluates each record in the database “`employee.rxd`” and outputs any records that return true to “`badbucks.ssd`.”

So, the third party/examiner said that the select statement evaluates all rows imported to memory (an input data bag). The reference also says, as explicitly quoted and cited by the third party/examiner, the select statement evaluates each record in an input database. Thus, it seems the third party/examiner said, or at least implied, that the records in the input database are a data bag. These records would seem to be the “rows imported into memory” as the records are what is actually input and evaluated.

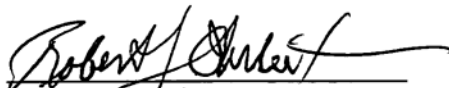
In light of this, the examiner said not present a new ground of rejection in the Final Action. While the patent owner characterizes the first action as applying the “buffers” to the data bags, and the Final Action as referring instead to records or databases, this is not correct. It was patent owner who limited its discussion to the “buffers” of DBMS in its response, not the examiner in the first action. The request referred to the item evaluated by the select statement as the input data bag, and the records of the input database are what are to be evaluated. The paragraph of the Final Action quoted above merely refers to the input database and the records of that database as the input data bag. This is not a new theory. Perhaps it is an extension of the prior theory, but if that is the case it is an extension that necessarily flows from what was said in the request and is therefore still the same theory. The patent owner had a full and fair opportunity to respond to this theory as it is no more than what was presented in the Request and incorporated by reference into the first Office action. The citations to pp. 8 and 53 of DBMS do not change this result, given that these pages were explicitly cited in the original rejection. Argument (2) is therefore unpersuasive.

As to (3), petitioner argues that the examiner, for the first time in the Final Action, relied on MS-DOS 2.1 or higher to support the rejection. It is abundantly clear that this statement by the examiner is merely rebuttal and is not in any way a part of the examiner’s rejection. The context, which petitioner unhelpfully omitted when quoting the Final Action, clearly shows that the examiner was merely rebutting the patent owner’s statements in its previous response. In patent owner’s March 7 response at page 11, it argued that DBMS system requirements include only a reference to MS-DOS 2.1, without any indication of network connectivity. The examiner’s mention of MS-DOS 2.1 or higher was merely pointing out to the patent owner that it was not correct in stating that DBMS refers only to MS-DOS 2.1, but that it also says “or higher.” Apparently patent owner believes that it can say whatever it likes in a response, and if the examiner corrects it then that constitutes a new ground of rejection. It is clear that the examiner is not in any way “relying” on MS-DOS 2.1 or higher as a part of the rejection. This is therefore not some new thrust of the rejection to which patent owner has not had an opportunity to respond. Argument (3) is unpersuasive.

Accordingly, for the above reasons the Director finds no new ground of rejection in the Final Action. It was not improper or unfair to issue a final Office action, and the petition is denied.

CONCLUSION

1. The petition filed August 23, 2011 is denied. The finality of the May 12, 2011 action is not disturbed.
2. Telephone inquiries related to this decision should be directed to Mark Reinhart, Supervisory Patent Reexamination Specialist, at (571) 272-1611 or in his absence to the undersigned at (571) 272-0700.



Robert J. Oberleitner,
Assistant Deputy Commissioner for Patent Operations and
Acting Director, Central Reexamination Unit