Exhibit 2005

in LG Electronics Inc. v. Mondis Technology Ltd, IPR2015-00938

Decision Instituting *Ex Parte* Reexamination 90/013,388 (mailed Dec. 24, 2014)

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/013,388	11/03/2014	6549970	8739.00109.REX0	1079

37509 7590 12/24/2014

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EXAMINER
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ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
12/24/2014	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.

Transmittal of Communication to Third Party Requester *Inter Partes* Reexamination	Control No.	Patent Under Reexamination	
	90/013,388	6549970	
	Examiner	Art Unit	
	Albert J. Gagliardi	3992	

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

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON, DC 20006

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination prceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

ORDER GRANTING/DENYING REQUEST FOR* INTER PARTES *REEXAMINATION	**Control No.**	**Patent Under Reexamination**
	90/013,388	6549970
	Examiner	**Art Unit**
	Albert J. Gagliardi	3992

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

The request for *inter partes* reexamination has been considered. Identification of the claims, the references relied on, and the rationale supporting the determination are attached.

Attachment(s): ☐ PTO-892 ☒ PTO/SB/08 ☐ Other: _____

1. ☒ The request for *inter partes* reexamination is GRANTED.

☐ An Office action is attached with this order.

☒ An Office action will follow in due course.

2. ☐ The request for *inter partes* reexamination is DENIED.

This decision is not appealable. 35 U.S.C. 312(c). Requester may seek review of a denial by petition to the Director of the USPTO within ONE MONTH from the mailing date hereof. 37 CFR 1.927. EXTENSIONS OF TIME ONLY UNDER 37 CFR 1.183. In due course, a refund under 37 CFR 1.26(c) will be made to requester.

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 Order.

The present application is being examined under the pre-AIA first to invent provisions.

DECISION GRANTING EX PARTE REEXAMINATION

Decision on Request

A substantial new question of patentability affecting claims 1-17, 22, 24, 26 and 29 of US Patent 6,549,970 to Arai *et al.* (hereafter *Arai '970*) is raised by the Third Party request for *ex parte* reexamination.

Principal References Cited in the Request

Schmidt *et al.* – US 5,285,197 (*Schmidt*) *

Moriconi *et al.* – US 5,262,759 (*Moriconi*) *

Pfeiffer *et al.* – US 5,198,644 (*Pfeiffer*)

Takahashi *et al.* – JP 04-37787 (*Takahashi*)

Takui, Satoru – EP 0 498 995 (*Satoru Takui*)

* Old prior art

Issue(s) Raised by Request

Issue 1

The requester alleges (p. 13-14) that *Satoru Takui* alone raises a substantial new question of patentability regarding at least claims 1-4, and 14-17.

Issue 2

The requester alleges (p. 14-15) that *Satoru Takui* alone raises a substantial new question of patentability regarding at least claim 22.

Issue 3

The requester alleges (p. 15-17) that *Schmidt* in combination with *Satoru Takui* raises a substantial new question of patentability regarding at least claims 1-17.

Issue 4

The requester alleges (p. 17-19) that *Schmidt* in combination with *Satoru Takui* raises a substantial new question of patentability regarding at least claim 22.

Issue 5

The requester alleges (p. 19-20) that *Schmidt* in combination with *Pfeiffer* raises a substantial new question of patentability regarding at least claim 22.

Issue 6

The requester alleges (p. 20-21) that *Schmidt* alone raises a substantial new question of patentability regarding at least claims 24, 26 and 29.

Issue 7

The requester alleges (p. 21-23) that *Moriconi* in combination with *Satoru Takui* raises a substantial new question of patentability regarding at least claims 1-17.

Issue 8

The requester alleges (p. 23-24) that *Moriconi* in combination with *Satoru Takui* raises a substantial new question of patentability regarding at least claim 22.

Issue 9

The requester alleges (p. 25-26) that *Moriconi* in combination with *Pfeiffer* raises a substantial new question of patentability regarding at least claim 22.

Issue 10

The requester alleges (p. 26-28) that *Moriconi* in combination with *Takahashi* raises a substantial new question of patentability regarding at least claims 24, 26 and 29.

> **Note:** The substantial new question of patentability regarding Issue 6 is based solely on patents and/or printed publications already cited/considered in an earlier concluded examination of the patent being reexamined.
>
> On November 2, 2002, Public Law 107-273 was enacted. Title III, Subtitle A, Section 13105, part (a) of the Act revised the reexamination statute by adding the following new last sentence to 35 U.S.C. 303(a) and 312(a):
>
> The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office. For any reexamination ordered on or after November 2, 2002, the effective date of the statutory revision, reliance on previously cited/considered art, i.e., "old art," does not necessarily preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on that old art. Rather, determinations on whether a SNQ exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis.
>
> In the present instance, while there are some SNQs based on old art (e.g., *Schmidt* and *Moriconi*), the old art is either being asserted in new combinations (i.e., with *Satoru Takui* or *Pfeiffer*), or being applied to different claims. As such, the existence of an SNQ is not precluded by the fact that these old prior art references were previously cited/considered by the Office.

The Arai '970 Patent

The *Arai '970* patent is generally directed to a display unit with a communication control circuit for enabling bi-directional communication with an externally connected computer, wherein the control circuit may compare identification information previously stored in the display and the computer, and prohibit communication between the computer with respect to the display control. Claims 1, 22, and 24 are representative:

> **Claim 1.** A display unit having a communication control circuit for communicating with an externally

connected computer, wherein said communication control circuit comprises: comparing means for comparing a first identification information which is previously stored in said display unit and a second identification information which is previously stored in said computer and is sent from said computer; and a communication prohibition means for prohibiting communication between said computer with respect to display control of said display unit, when said first and second identification information do not match as a result of the comparison by said comparing means; wherein said communication control circuit enables bi-directional communication with said display unit and said computer.

Claim 22. A method of communicating between a display unit and a video source from which video signals are sent to the display unit for display, the method comprising the steps of: communicating display unit information stored in a memory of the display unit from the display unit to the video source, wherein said

display unit information includes an identification number for uniquely identifying the display unit; and sending a signal from the video source to the display unit, wherein said signal is generated based on the display unit information, wherein information is bi-directionally communicated with the video source and the display unit.

Claim 24. A display unit according to claim 23, further comprising a deflection circuit, wherein the processor generates control signals for the deflection circuit.

Pertinent Prosecution History

Claims 1-17, 22, 24, 26 and 29 are the current[1] claims of the *Arai '970* patent which issued April 15, 2003 from Application No. 09/732,291 filed on December 8, 2000.

The *Arai '970* patent is part of a large family of applications, with a long priority chain that extends back to Application No. 08/190,848, filed February 3, 1994. **The *Arai '970* patent is expired**. The prosecution history chain includes Continuation-in-Part application No. 09/265,363, filed March 10, 1999.

[1] The current claims reflect the status as a result of IP Reexam 95/000,457, though the Certificate was not issued at time of the Order.

During the original prosecution of the 09/732,291 application, the examiner issued a Non-Final action (7/5/2001) in which at least application claims 3, 6, 11 and 17 and 18-35 were considered to contain allowable subject matter. The examiner indicated that the claims were considered allowable because the cited prior art did not fairly suggest a communications control circuit that enable bi-directional communication with the display and computer.

In an Amendment and Response (12/05/2001) applicant amended the claims in accordance with the previous office action such that application claims 1, 2, 4, 5, 7-10, and 12-16 were asserted to be allowable; maintained allowable claims 18-26, and presented new claims 36-39 asserted to be allowable. Previously objected to claims 3, 6, 11 and 17, and allowable claims 27-35 were cancelled.

A first Notice of Allowance (4/22/2002) was issued indicating claims 1-26 (renumbered) as allowed. The examiner reiterated that the claims were considered allowable because the cited prior art did not fairly suggest a communications control circuit that enabled bi-directional communication with the display and computer.

Following a first RCE and Amendment, a second Notice of Allowance (6/28/2002) was issued also indicating claims 1-26 (renumbered) as allowed. Following a second RCE and Amendment (8/5/2002) adding 3 new claims (renumbered as claims 27-29), and another Amendment (9/24/2002) amending original claim 23 (before renumbering), a third Notice of Allowance (10/2/2002) was issued indicating claims 1-29 (renumbered) as allowed.

The *Arai '970* patent is/was the subject of *Inter Partes* reexamination proceeding 95/000,457. As a result of the previous reexamination proceeding and 19-21, 23, 25, 27 and 28,

have been/will be cancelled; and claim 22 has/will be confirmed as patentable. Claims 1-17, 24, 26 and 29 were not subject to the previous reexamination proceeding.

In confirming claim 22 as patentable, the examiner indicated in the Action Closing Prosecution (9/2/2011) that the cited prior art relied upon did not fairly suggest the limitation wherein the display unit information includes an identification number for uniquely identifying the display module (ACP at pages 15-16 and 25-27). At least the *Schmidt* and *Moriconi* references were cited and relied upon in the previous reexamination proceeding, and are considered as "old art" relative to currently requested claim 22.

The *Arai '970* patent was also the subject of court proceeding *Mondis Tech, Ltd v. LG Electronics, Inc., et al.,* 2:07-cv-565-TJW (E.D. Tex) wherein patent claim 18 was finally determined to be invalid.

In addition to the 95/000,457 proceeding, several related patents in the same patent family have been the subject of recent *Inter Partes* reexamination proceedings. These include: Arai *et al.* 7,089,342 (95/000458); Arai *et al.* 6,513,088 (95/000,459); Arai *et al.* 7,475,180 (95/000,480); and Arai *et al.* 7,475,181 (95/000,481). In these related proceedings, the Patent Trial and Appeals Board adopted specific claim constructions for several common terms found in the related patents.[2]

Substantial New Question

In view of the prosecution history, it is considered that for claims 1-17, 22, 24, 26 and 29, the a prior art reference (or combination of references) that teaches or suggests at least a display

[2] A listing of the terms can be found in the 90/013,388 Request at pages 4-7.

unit with a communication control circuit for communicating with an externally connected computer, wherein the communication control circuit is configured to allow for comparing identification information previously stored in the display with identification information previously stored in the computer, and further wherein the a communication control circuit enables bi-directional communication with the display unit and the computer would raises a substantial new question of patentability.

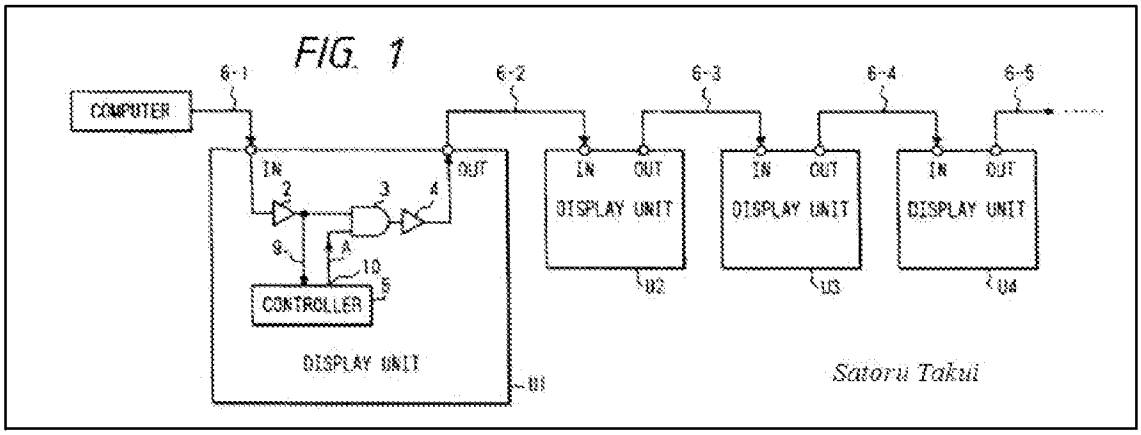
With regard to previously reexamined claim 22, it is considered that the prior art reference or combination of references would also need to teach or suggest at least the additional limitation wherein the information stored in the display includes an identification number for uniquely identifying the display unit in order to raise a substantial new question of patentability.

With regard to claims 24, 26 and 29, it is considered that the prior art reference or combination of references would also need to teach or suggest at least the additional limitation of the display unit including a deflection circuit, wherein the control processor for the display generates control signals for the deflection signal in order to raise a substantial new question of patentability.

Detailed Analysis

Issue 1 – ***Satoru Takui***

The *Satoru Takui* reference is new prior art not previously applied against claims 1-17, 22, 24, 26 or 29.



Satoru Takui teaches or suggests, among other things, a system including at least a display unit (U-1) with a communication control circuit (5) for communicating with an externally connected computer (1), wherein the communication control circuit is configured to allow for comparing identification information previously stored in the display with identification information previously stored in the computer (4:38-5:26; Fig. 5), and further wherein the a communication control circuit enables bi-directional[3] communication with the display unit and the computer (3:8-14). Since this teaching is directly related to subject matter considered as the basis for allowability of patent claims 1-17, a reasonable examiner would consider evaluation of the *Satoru Takui* reference as important in determining the patentability of the claims. As such, it is agreed that the *Satoru Takui* reference (either alone or in combination) raises a substantial new question of patentability with respect to at least claims 1-17 of the *Arai '970* patent.

Issue 2 – *Satoru Takui*

As noted above (Issue 1) the *Satoru Takui* reference is considered sufficient to raise a substantial new question of patentability with respect to at least claims 1-17. In addition, *Satoru*

[3] While the *Satoru Takui* reference appears to specifically show only one-way communication (computer to display), it is well understood in the art that the RS-232-C communication protocol enables bi-directional communication.

Takui teaches or suggests at least the additional limitation wherein the information stored in the display includes an identification number for uniquely identifying the display unit (4:2-9; 4:38-49; 5:12-26; Fig. 5). Since this additional teaching is directly related to subject matter considered as the basis for allowability of patent claim 22, a reasonable examiner would consider evaluation of the *Satoru Takui* reference as important in determining the patentability of the claims. As such, it is agreed that the *Satoru Takui* reference (either alone or in combination) raises a substantial new question of patentability with respect to at least claim 22 of the *Arai '970* patent.

Issue 3 – *Schmidt* and *Satoru Takui*

The *Schmidt* reference is old prior art not previously applied against claims 1-17, 24, 26 or 29. The *Satoru Takui* reference is new prior art.

The *Schmidt* patent teaches or suggests, among other things, a system including at least a display unit (100) with a communication control circuit (106/108) for communicating with an externally connected computer (e.g., 214/218), wherein the communication control circuit is configured to allow for comparing identification information previously stored (112) in the display with identification information previously stored in the computer (4:32-38; 8:59-62), and further wherein the a communication control circuit enables bi-directional communication with the display unit and the computer (8:25-29). The *Satoru Takui* reference also teaches similar limitations (see Issue 1 above). Since these teachings are directly related to subject matter considered as the basis for allowability of patent claims 1-17, a reasonable examiner would consider evaluation of the combination of *Schmidt* and *Satoru Takui* important in determining the patentability of the claims. As such, it is agreed that the *Schmidt* and *Satoru Takui* references

raise a substantial new question of patentability with respect to at least claims 1-17 of the *Arai '970* patent.

Issue 4 – *Schmidt* and *Satoru Takui*

As noted above (Issue 3), the *Schmidt* patent teaches or suggests, among other things, a system including at least a display unit (100) with a communication control circuit (106/108) for communicating with an externally connected computer (e.g., 214/218), wherein the communication control circuit is configured to allow for comparing identification information previously stored (112) in the display with identification information previously stored in the computer (4:32-38; 8:59-62), and further wherein the a communication control circuit enables bi-directional communication with the display unit and the computer (8:25-29). As also noted above, the *Schmidt* and *Satoru Takui* references taken in combination are considered sufficient to raise a substantial new question of patentability with respect to at least claims 1-17.

With specific regard to claim 22, the claim includes limitations similar to those as recited in claim 1, as well as the additional limitation wherein the information stored in the display includes an identification number for uniquely identifying the display unit. *Satoru Takui* teaches or suggests at least the additional limitation wherein the information stored in the display includes an identification number for uniquely identifying the display unit (4:2-9; 4:38-49; 5:12-26; Fig. 5). Since this additional teaching is directly related to subject matter considered as the basis for allowability of patent claim 22, a reasonable examiner would consider evaluation of the *Schmidt* and *Satoru Takui* references as important in determining the patentability of the claims. As such, it is agreed that the *Schmidt* and *Satoru Takui* references raise a substantial new question of patentability with respect to at least claim 22 of the *Arai '970* patent.

Issue 5 – *Schmidt* and *Pfeiffer*

As noted above (Issue 3), the *Schmidt* patent teaches or suggests, among other things, a system including at least a display unit (100) with a communication control circuit (106/108) for communicating with an externally connected computer (e.g., 214, 218), wherein the communication control circuit is configured to allow for comparing identification information previously stored (112) in the display with identification information previously stored in the computer (4:32-38; 8:59-62), and further wherein the a communication control circuit enables bi-directional communication with the display unit and the computer (8:25-29).

In previous *Inter Partes* reexamination proceeding 95/000,457, the *Schmidt* reference was applied as an anticipatory reference against at least claims 23, 25, and 27 (RAN at pages 14 and 17-20), and the rejection was affirmed by the Patent Trial and Appeals Board (Decision at page 18). In that same proceeding, claim 22 (which includes some similar limitations) was affirmed by the examiner because it included the additional limitation wherein the information stored in the display includes an identification number for uniquely identifying the display unit. That is, the examiner took the position that identification information for identifying a "type" of monitor (display unit) is different from an identification number that uniquely identifies a specific monitor (display unit).

The *Pfeiffer* reference is new prior art. The *Pfeiffer* reference is directed to a computer based system for displaying information (product prices) on one or more product price display modules (10). *Pfeiffer* teaches that display modules for a specific product are identified by a UPC product code associated with the particular product. (6:27-28). *Pfeiffer* further teaches that since it might occur that there are multiple display modules associated with any particular

product, an additional sequence number may be appended to the UPC code to form "a complete address" [unique address] for the display module (6:31-40). Since this additional teaching is directly related to subject matter considered as the basis for allowability of patent claim 22, a reasonable examiner would consider evaluation of the *Schmidt* and *Pfeiffer* references as important in determining the patentability of the claims. As such, it is agreed that the *Schmidt* and *Pfeiffer* references raise a substantial new question of patentability with respect to at least claim 22 of the *Arai '970* patent.

Issue 6 – *Schmidt*

As noted above (Issue 5) at least claims 23, 25 and 27-28 were rejected as anticipated by *Schmidt*. Dependent claims 24, 26 and 29 were not subject to the previous reexamination. Claims 24, 26 and 29 recite the additional limitation of a deflection circuit, wherein the control processor generates control signals for the deflection circuit. *Schmidt* discloses that the display (100) includes a CRT unit (120) with control circuitry (124) wherein the control processor (110) provides control signals to the control circuitry via the sweep signal generator (114). As this teaching is the only remaining basis for allowability of claims 24, 26 and 29, a reasonable examiner would consider evaluation of the *Schmidt* references as important in determining the patentability of the claims. As such, it is agreed that the *Schmidt* raises a substantial new question of patentability with respect to at least claim 24, 26 and 29 of the *Arai '970* patent.

Issue 7 – *Moriconi* and *Satoru Takui*

The *Moriconi* is old prior art not previously applied against claims 1-17, 24, 26 or 29. The *Satoru Takui* reference is new prior art.

The *Moriconi* patent teaches or suggests, among other things, a system including at least a display unit (13) with a communication control circuit (47) for communicating with an externally connected computer (11/41), wherein the communication control circuit is configured to allow for comparing identification information previously stored (51) in the display with identification information previously stored in the computer (5:1-30), and further wherein the a communication control circuit enables bi-directional communication with the display unit and the computer (5:21-40). The *Satoru Takui* reference also teaches similar limitations (see Issue 1 above). Since these teachings are directly related to subject matter considered as the basis for allowability of patent claims 1-17, a reasonable examiner would consider evaluation of the combination of *Moriconi* and *Satoru Takui* important in determining the patentability of the claims. As such, it is agreed that the *Moriconi* and *Satoru Takui* references raise a substantial new question of patentability with respect to at least claims 1-17 of the *Arai '970* patent.

Issue 8 – *Moriconi* and *Satoru Takui*

As noted above (Issue 7), the *Moriconi* patent teaches or suggests, among other things, a system including at least a display unit (13) with a communication control circuit (47) for communicating with an externally connected computer (11/41), wherein the communication control circuit is configured to allow for comparing identification information previously stored (51) in the display with identification information previously stored in the computer (5:1-30), and further wherein the a communication control circuit enables bi-directional communication with the display unit and the computer (5:21-40). As also noted above, the *Moriconi* and *Satoru Takui* references taken in combination are considered sufficient to raise a substantial new question of patentability with respect to at least claims 1-17.

With specific regard to claim 22, the claim includes limitations similar to those as recited in claim 1, as well as the additional limitation wherein the information stored in the display includes an identification number for uniquely identifying the display unit. *Satoru Takui* teaches or suggests at least the additional limitation wherein the information stored in the display includes an identification number for uniquely identifying the display unit (4:2-9; 4:38-49; 5:12-26; Fig. 5). Since this additional teaching is directly related to subject matter considered as the basis for allowability of patent claim 22, a reasonable examiner would consider evaluation of the *Schmidt* and *Satoru Takui* references as important in determining the patentability of the claims. As such, it is agreed that the *Moriconi* and *Satoru Takui* references raise a substantial new question of patentability with respect to at least claim 22 of the *Arai '970* patent.

Issue 9 – *Moriconi* and *Pfeiffer*

As noted above (Issue 7), the *Moriconi* patent teaches or suggests, among other things, a system including at least a display unit (13) with a communication control circuit (47) for communicating with an externally connected computer (11/41), wherein the communication control circuit is configured to allow for comparing identification information previously stored (51) in the display with identification information previously stored in the computer (5:1-30), and further wherein the a communication control circuit enables bi-directional communication with the display unit and the computer (5:21-40).

In previous *Inter Partes* reexamination proceeding 95/000,457, the *Moriconi* reference was applied as an anticipatory reference against at least claims 23, 25, and 27 (RAN at pages 6 and 8-10), and the rejection was affirmed by the Patent Trial and Appeals Board (Decision at page 18). In that same proceeding, claim 22 (which includes some similar limitations) was

affirmed by the examiner because it included the additional limitation wherein the information stored in the display includes an identification number for uniquely identifying the display unit. That is, the examiner took the position that identification information for identifying a "type" of monitor (display unit) is different from an identification number that uniquely identifies a specific monitor (display unit).

The *Pfeiffer* reference is new prior art. The *Pfeiffer* reference is directed to a computer based system for displaying information (product prices) on one or more product price display modules (10). *Pfeiffer* teaches that display modules for a specific product are identified by a UPC product code associated with the particular product. (6:27-28). *Pfeiffer* further teaches that since it might occur that there are multiple display modules associated with any particular product, an additional sequence number may be appended to the UPC code to form "a complete address" [unique address] for the display module (6:31-40). Since this additional teaching is directly related to subject matter considered as the basis for allowability of patent claim 22, a reasonable examiner would consider evaluation of the *Moriconi* and *Pfeiffer* references as important in determining the patentability of the claims. As such, it is agreed that the *Moriconi* and *Pfeiffer* references raise a substantial new question of patentability with respect to at least claim 22 of the *Arai '970* patent.

Issue 10 – *Moriconi* and *Takahashi*

As noted above (Issue 9) at least claims 23, 25 and 27-28 were rejected as anticipated by *Moriconi*. Dependent claims 24, 26 and 29 were not subject to the previous reexamination. Claims 24, 26 and 29 recite the additional limitation of a deflection circuit, wherein the control processor generates control signals for the deflection circuit. Unlike *Schmidt* (see Issue 6 above),

Moriconi discloses that the display (13) is a flat panel display for a laptop and notebook computers (1:12-13; 1:59-60). It would be understood by those of ordinary skill in the art that, unlike a CRT-type display, a flat panel display would not include or require a deflection circuit. Since there would appear to be no reason to modify *Moriconi* to include a deflection circuit, a reasonable examiner would not consider evaluation of the *Moriconi* and *Takahashi* references as important in determining the patentability of the claims. As such, it is NOT agreed that *Moriconi* and *Takahashi* raise a substantial new question of patentability with respect to claims 24, 26 and 29 of the *Arai '970* patent.

Conclusion

Extensions of Time

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that *ex parte* reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extensions of time in ex parte reexamination proceedings are provided for in 37 CFR 1.550(c).

Waiver of Right to File Patent Owner Statement

In a reexamination proceeding, Patent Owner may waive the right under 37 C.F.R. 1.530 to file a Patent Owner Statement. The document needs to contain a statement that Patent Owner waives the right under 37 C.F.R. 1.530 to file a Patent Owner Statement and proof of service in the manner provided by 37 C.F.R. 1.248, if the request for reexamination was made by a third party requester, see 37 C.F.R 1.550(f). The Patent Owner may consider using the following statement in a document waiving the right to file a Patent Owner Statement:

Patent Owner waives the right under 37 C.F.R. 1.530 to file a Patent Owner Statement.

Amendment in Reexamination Proceedings

Patent owner is notified that any proposed amendment to the specification and/or claims in this reexamination proceeding must comply with 37 CFR 1.530(d)-(j), must be formally presented pursuant to 37 CFR § 1.52(a) and (b), and must contain any fees required by 37 CFR § 1.20(c). See MPEP § 2250(IV) for examples to assist in the preparation of proper proposed amendments in reexamination proceedings.

Submissions

If the patent owner fails to file a timely and appropriate response to any Office action or any written statement of an interview required under 37 CFR § 1.560(b), the *ex parte* reexamination proceeding will be terminated, and the Director will proceed to issue a certificate under 37 CFR §1.570 in accordance with the last Office action.

Service of Papers

After the filing of a request for reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party (or parties where two or more third party requester proceedings are merged) in the reexamination proceeding in the manner provided in 37 CFR 1.248. See 37 CFR 1.550(f).

Notification of Concurrent Proceedings

The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 6,549,970 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or

proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

All correspondence relating to this ex *parte* reexamination proceeding should be directed:

By Mail to: Mail Stop *Ex Parte* Reexam
Attn: Central Reexamination Unit
Commissioner of Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
Randolph Building
401 Dulany Street
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