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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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175872 7590 12/05/2023 NOBLITT & NEWSON, PLLC (Acacia) Daniel J. Noblitt 8777 NORTH GAINEY CENTER DRIVE, STE.175 Scottsdale, AZ 85258			EXAMINER ESCALANTE, OVIDIO	
			ART UNIT 3992	PAPER NUMBER
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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.



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***EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/019,246.

PATENT UNDER REEXAMINATION 8451845.

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)).

Order Granting Request For Ex Parte Reexamination	Control No. 90/019,246	Patent Under Reexamination 8451845	
	Examiner OVIDIO ESCALANTE	Art Unit 3992	AIA (FITF) Status No

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

The request for *ex parte* reexamination filed 09/08/2023 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a)☒ PTO-892, b)☒ PTO/SB/08, c)☐ Other: _____

1. ☒ The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

/MICHAEL FUELLING/ Supervisory Patent Examiner, AU3992	/Ovidio Escalante/ Patent Reexam Spec., AU3992	/MINH DIEU NGUYEN/ Primary Examiner, Art Unit 3992
cc:Requester (if third party requester)		

U.S. Patent and Trademark Office
PTOL-471G(Rev. 01-13)

Office Action in *Ex Parte* Reexamination

Part of Paper No. 20230915

REASONS FOR SUBSTANTIAL NEW QUESTION OF PATENTABILITY DETERMINATION

I. Review of Facts

1. A request for *ex parte* reexamination of claims 1 and 5-8 of U.S. Patent 8,451,845 issued to Boucadair et al. on May 28, 2013 (hereinafter the '845 patent) was filed on September 8, 2023 and assigned control number 90/019, 246 ("the '246 Request").
2. The '845 patent was filed on December 29, 2010 and is based upon U.S. Patent Application No. 13/001,907.
3. On September 13, 2023, the Office mailed a "Notice of Assignment of Reexamination Request" indicating the '246 Request was granted a filing date.

II. Pertinent History of the '845 Patent.

4. The '845 patent was filed as U.S. Patent application No. 13/001,907 ("the '907 application") on December 29, 2009.
5. During prosecution of the '907 application, the Examiner issued a non-final office action which rejected claims 1-10 under 112 1st and 2nd paragraphs.
6. In response to the Non-Final Office Action, the Applicant amended the claims in view of the 112 2nd paragraph rejection by replacing "operator prefix" to "IPv6 prefix" and provided arguments against the 112 1st paragraph rejection.
7. In response, the Examiner issued a Notice of Allowance and provided the following statement:

The following is an examiner's statement of reasons for allowance:

Claims 1 and 7 are allowable over the prior art of record since the cited reference taken individually or in combination fails to particularly disclose identifying an IPv6 destination address constructed by concatenating an operator IPv6 prefix, an IPv4 destination address and a destination port number; if necessary, regularizing at least one of the IPv6 source address and the IPv6 destination address of the data packet by replacing at least one IPv6 address, the replacement process belonging to a group comprising replacement of a constructed address with a native address and replacement of a native address with a constructed address, and modifying the data packet using the regularized address.

IPR Proceeding:

8. On October 1, 2020 an IPR Petition of the '845 Patent was filed. The Petition presented the following ground: Ground 1: Claims 1 and 5-8 are obvious over Ananda, Wetterwald and RFC 4380.
9. On January 26, 2021 the proceeding was terminated prior to institution of trial.

III. The '845 Patent.

10. The '845 Patent is directed to a method of receiving a data packet in an IPv6 Domain connected to an IPv4 domain.

Independent **claim 1** of the '845 patent is repeated below:

A method for receiving an IPv6 data packet in an IPv6 domain connected to an IPv4 domain, said packet comprising an IPv6 destination address and an IPv6 source address, said method being executed in a home gateway adapted to connect a user terminal to said IPv6 domain, and comprising the following steps:

identifying an IPv6 destination address constructed by concatenating an IPv6 prefix, an IPv4 destination address and a destination port number;

if necessary, regularizing at least one of the IPv6 source address and the IPv6 destination address of the data packet by replacing said at least one IPv6 address, the replacement process belonging to a group comprising replacement of a constructed address with a native address and replacement of a native address with a constructed address, and modifying the data packet using the regularized address; and routing the modified data packet to its destination.

IV. Determination of the ‘246 Request

11. Claims 1 and 5-8 of the ‘845 patent will be the basis for deciding whether or not a “substantial new question of patentability” (SNQ) is present. See 37 CFR 1.620(a).

V. Criteria for the ‘246 Request Determination.

12. Whether a substantial new question of patentability (SNQ) affecting claims 1 and 5-8 of the ‘845 patent is raised by the prior art references presented in the ‘246 Request. See 35 U.S.C. 257(a), MPEP §2242

VI. Prior Art References

13. The ‘246 Request requests *ex parte* reexamination in view of the following cited prior art references¹, submitted with the ‘246 Request and re-cited below:

- 1) Huitema US Patent 7,245,622
- 2) Kong et al., “Design and Implementation of IPv6-IPv4 Protocol Translation System Using Dynamic IP Address”.
- 3) Ananda US Patent Pub. 2004/0107287
- 4) Wetterwald US Patent 7,639,686
- 5) RFC 4380, “Teredo: Tunneling IPv6 over UDP through Network Address Translations (NATs), “

¹ The Examiner notes that the Information Disclosure Statement, filed on September 8, 2023 by the Requester is not in compliance with 37 CFR 1.98 for many of the cited documents. As set forth in 37 CFR 1.98, each U.S. Patent and each publication listed must include the publication/issue date. This citations have been crossed out. The Examiner notes that the references which were relied upon for support of SNQ, as set forth in the Request, have been fully considered.

VI.A. Information Disclosure Statement

14. With respect to the Information Disclosure Statement submitted on September 8, 2023 along with the Request for Reexamination, the information cited has been considered as described in the MPEP. Note that MPEP 2256 and 2656 indicate that degree of consideration to be given to such information will be normally limited by the degree to which the party filing the information citation has explained the content and relevance of the information. Information that does not appear to be "patents or printed publications" as identified in 35 U.S.C. 301 or publications which have not been dated as required have been considered to the same extent (unless otherwise noted), but have been lined through and will not be printed on any resulting reexamination certificate.

VII. Prior Art Analysis

15. SNQ standard as set forth in MPEP 2242:

For "a substantial new question of patentability" to be present, it is only necessary that: (A) the prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the (prior art) patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and (B) the same question of patentability as to the claim has not been decided by the Office in an earlier concluded examination or review of the patent, raised to or by the Office in a pending reexamination or supplemental examination of the patent, or decided in a final holding of invalidity (after all appeals) by a federal court in a decision on the merits involving the claim. If a reexamination proceeding was terminated/vacated without resolving the substantial question of patentability question, it can be re-presented in a new reexamination request. It is not necessary that a "*prima facie*" case of unpatentability exist as to the claim in order for "a substantial new question of patentability" to be present as to the claim. Thus, "a substantial new question of patentability" as to a patent claim could be present even if the

examiner would not necessarily reject the claim as either fully anticipated by, or obvious in view of, the prior art patents or printed publications.

In addition, as set forth in MPEP 2216, “[t]he legal standard for ordering ex parte reexamination, as set forth in 35 U.S.C. 303(a), requires a substantial new question of patentability. The substantial new question of patentability may be based on art previously considered by the Office if the reference is presented in a new light or a different way that escaped review during earlier examination.”

The Examiner determines that with several references where relied upon during IPR2020-0169. Specifically, the prior art references, Ananda US Patent Pub. 2004/0107287, Wetterwald et al. US Patent 7,639,686 and RFC 4380 were previously set forth. However, the proceeding was terminated prior institution and therefore, in accordance with MEPP 2242, the Examiner considers this combination to be based on a combination that was not previously considered by the Office.

VIII. Prior Art References Raising a Substantial Question of Patentability

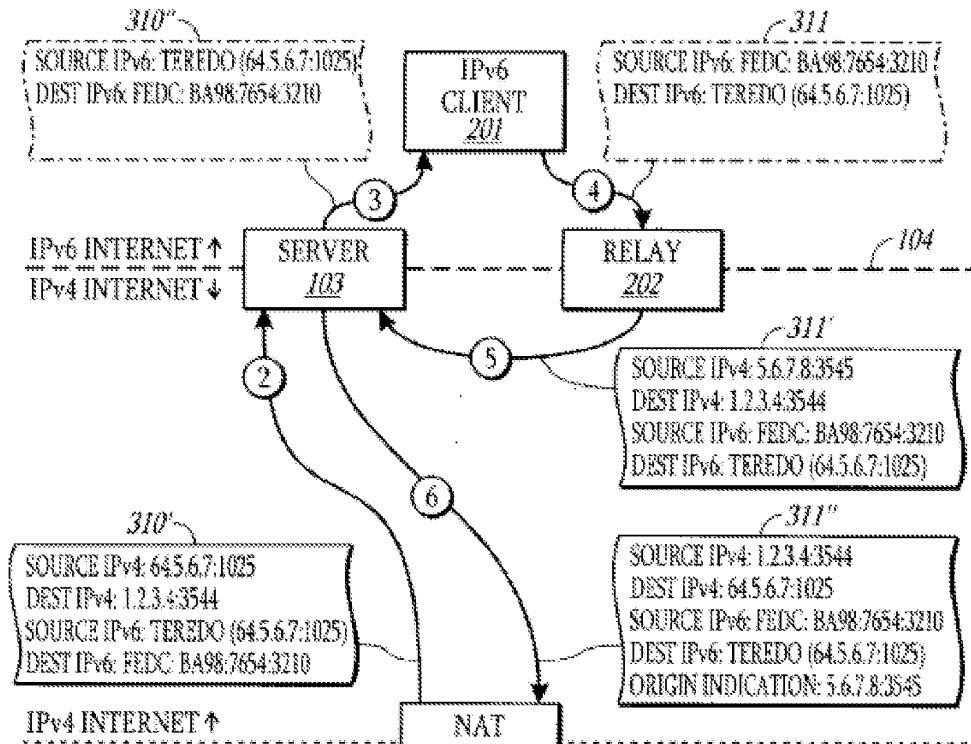
As identified above during the examination of the underlying patent application, the teachings directed to “identifying an IPv6 destination address constructed by concatenating an IPv6 prefix, an IPv4 destination address and a destination port number” or “if necessary, regularizing at least one of the IPv6 source address and the IPv6 destination address of the data packet by replacing said at least one IPv6 address, the replacement process belonging to a group comprising replacement of a constructed address with a native address and replacement of a native address with a constructed address, and modifying the data packet using the regularized address” as recited in claim 1 will be the basis for determining whether the cited references raise a SNQ as to claim 1. As set forth above, during the original prosecution, these limitations were considered important in determining the patentability of the claims over the relied upon prior art.

Grounds 1 and 2 -Huitema

Huitema is directed to a method for receiving an IPv6 data packet in an IPv6 domain connected to an IPv4 domain. See e.g. figure 3A which discloses both an IPv6 Internet domain and an IPv4 Internet domain. See also col. 7, lines 1-9.

With respect to “identifying an IPv6 destination address constructed by concatenating an IPv6 prefix, an IPv4 destination address and a destination port number” the Examiner determines that Huitema discloses relay 202 (see the below cropped version of Fig. 3A) identifying in response 311 an IPv6 destination address (DEST IPv6) constructed by concatenating an IPv6 prefix (TEREDO service prefix), and IPv4 destination address (64.5.6.7) and a destination port number (1025).

Huitema explains that that in Figure 3A (see reference number 311 shown below), “the Source IPv6 address is listed as Teredo (64.5.6.7:1025)...is the same as the address “PREF:102:304::FBFE:BFFA:F9F8’.” See col. 10, lines 31-33. Here, “PREF:102:304” is “the prefix associated with server 103.” See col. 12, lines 49-58.



With respect to below Figure 7, Huitema explains in col. 8, lines 37-61, "...the IPv6 address may have a general structure illustrated in FIG. 7 as data structure 700. A service field 701 identifies that this IPv6 address corresponds to an IPv4 client. For example, in the IPv6 address "PREF:102:304::FBFE:BFFA:F9F8", the "PREF" represents the service field 701. A server IPv4 address field 702 identifies the IPv4 address of the server 103. For example, the "102:304" in the example IPv6 address is the hexadecimal notation of the address of the server 103 (namely, 1.2.3.4).

Huitema (64.5.6.7) is the IPv4 address of IPv4 client 101 (the destination of response 311). In addition as shown in Fig. 3A (above) '1025' is the destination port number which is concatenated with IPv4 destination address 64.5.6.7. See col. 8, lines 6-10, 49-51.

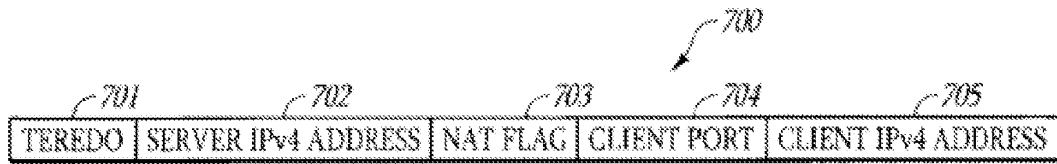


FIG. 7

With respect to “if necessary, regularizing at least one of the IPv6 source address and the IPv6 destination address of the data packet by replacing said at least one IPv6 address, the replacement process belonging to a group comprising replacement of a constructed address with a native address and replacement of a native address with a constructed address, and modifying the data packet using the regularized address”, Huitema discloses that response 311 has an IPv6 format because “all IPv6 messages are represented with intermittent dashed/dotted lines” and thus its header contains IPv6 source and destination addresses. See col 11, lines 3-6. It is noted that modified response 311’ has an IPv4 format because “IPv4 message[s]...are represented with solid lines” and thus has IPv4 source and destination addresses in its header. See col. 11, lines 3-6.

Relay 202 regularizes the IPv6 source address (FEDC:BA98:7654:3210) in the header of IPv6 response 311 by replacing the IPv6 source address with a corresponding IPv4 source address (5.6.7.8:345) in the header of IPv4 response 311’ and moving the IPv6 source address (FEDC:BA98:7654:3210) from the header to the payload in IPv4 response 311’. See col. 12, lines 33-67.

The relay also regularized the IPv6 destination address (TEREDO (64.5.6.7:1025) by replacing the IPv6 destination address in the header of IPv6 response 311 with a corresponding IPv4 destination address (1.2.3.4:3544) in the header of IPv4 response 311’ and moving the IPv6 destination address (TEREDO (64.5.6.7:1025) from the header to the payload in IPv4 response 311’ See col. 12, lines 33-67. See Fig. 6 and col. 9, lines 55-64.

With respect to Figure 4, Huitema discloses replacing the IPv6 addresses in the header of IPv6 response 411 with correspond IPv4 addresses to form IPv4 response 410’. Specifically, Huitema discloses

replacement of a constructing address (TEREDO (64.5.6.7:1025) with a native address (64.5.6.7:1025)
and replacement of a native address (FEDC:BA98:7654:3210) with a constructed address (5.6.7.8:3545).
See col. 14, lines 58-67, col. 15, lines 66 – col. 12, line 12

The Examiner notes that the above citations, which addresses teachings directed with respect to “identifying an IPv6 destination address constructed by concatenating an IPv6 prefix, an IPv4 destination address and a destination port number; if necessary, regularizing at least one of the IPv6 source address and the IPv6 destination address of the data packet by replacing said at least one IPv6 address, the replacement process belonging to a group comprising replacement of a constructed address with a native address and replacement of a native address with a constructed address, and modifying the data packet using the regularized address” were not previously cited during the original prosecution of the underlying patent. In addition, no concluded review of this combination was previously set forth on the record. Accordingly, a reasonable examiner would consider this teaching important in determining the patentability of claims 1 and 5-8.

Accordingly, Huitema raises a Substantial New Question of Patentability.

Grounds 3 and 4 -Kong

Kong is directed to a method for receiving an IPv6 data packet in an IPv6 domain connected to an IPv4 domain. As explained in the abstract, Kong specifically discloses an IPv6-IPv4 protocol translation system for communicating between IPv6 networks and IPv4 networks.

With respect to “identifying an IPv6 destination address constructed by concatenating an IPv6 prefix, an IPv4 destination address and a destination port number” the Examiner determines Figure 3 of Kong shows “[t]he procedure for the inbound session” in which the IPv4 host connects to the IPv6 network-i.e., communication in the opposition direction of Figures 2’s outbound session. In step (9) of the outbound session, the “64 Translator translates the [ConnectIPv6Server]₄ to [ConnectIPv6Server]₆ using the IPv6 address that is created by the concatenation of dummy prefix and IPv4 address.” See page 502.

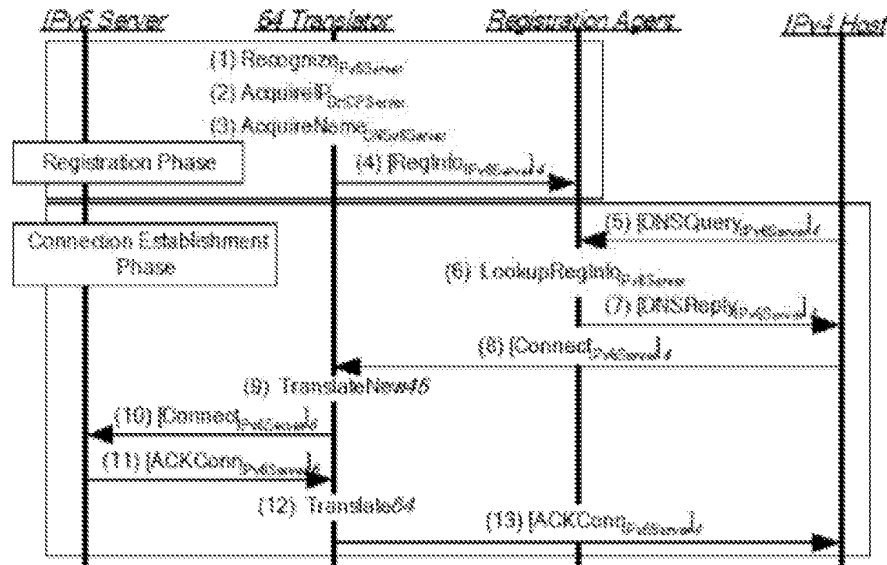


Fig. 3. The procedure of the inbound session

With reference to Table 1 (page 499), Kong discloses that the functions of the 64 Translator includes allocating a port number for each outbound session. See also page 502 which discloses “all outbound and inbound packets can translate with the address/port number using the mapping entries”.

Kong further discloses identifying the IPv6 destination address the [Connect_{IPv6}“Server”]₆ since Kong explains that in the output session, “[t]he 64 Translator creates the mapping entry and translates the [Connect_{IPv6}“Server”]₆ into the [Connect_{IPv4}“Server”]₄ using the mapping entry.” See page 501.

With respect to “if necessary, regularizing at least one of the IPv6 source address and the IPv6 destination address of the data packet by replacing said at least one IPv6 address, the replacement process belonging to a group comprising replacement of a constructed address with a native address and replacement of a native address with a constructed address, and modifying the data packet using the regularized address”, in Table 1, Kong explains that the translation function of the 64 Translator involves, among other things, “translating a protocol header between IPv6 and IPv4”. Kong discloses in step (6), “[t]he 64 Translator creates the mapping entry and translates the [Connect_{IPv4}Server]₆ packet into the [Connect_{IPv4}Server]₄ using the mapping entry. See page 501.

Kong further discloses the Translator replaces the IPv6 destination address with a corresponding IPv4 destination address. See page 501. In addition, the 64 Translator modifies the [Connect_{IPv4Server}]₆ packet into the [Connect_{IPv4Server}]₄ packet by replacing the IPV6 source and destination address in the header of the [Connect_{IPv4Server}]₄ packet with respective IPv4 source and destination addresses in the header of the resulting [Connect_{IPv4Server}]₄ packet.

The Examiner notes that the above citations, which addresses teachings directed with respect to “identifying an IPv6 destination address constructed by concatenating an IPv6 prefix, an IPv4 destination address and a destination port number; if necessary, regularizing at least one of the IPv6 source address and the IPv6 destination address of the data packet by replacing said at least one IPv6 address, the replacement process belonging to a group comprising replacement of a constructed address with a native address and replacement of a native address with a constructed address, and modifying the data packet using the regularized address” were not previously cited during the original prosecution of the underlying patent. In addition, no concluded review of this combination was previously set forth on the record. Accordingly, a reasonable examiner would consider this teaching important in determining the patentability of claims 1, 5-8.

Accordingly, Kong raises a Substantial New Question of Patentability.

Ground 5 -Ananda, Wetterwald, and RFC 4380

Ananda is directed to a method for receiving an IPv6 data packet in an IPv6 domain connected to an IPv4 domain. See e.g. figure 2 which discloses both an IPv6 Internet domain and an IPv4 Internet domain mixed together. See the abstract.

With respect to “identifying an IPv6 destination address constructed by concatenating an IPv6 prefix, an IPv4 destination address and a destination port number” the Examiner determines that Ananda discloses in Figure 4 (step 440), that the IPv6 packet transmitted from CPI 215E includes an IPv6 destination address that is constructed. Ananda states that a “determination 651 is made as to whether the IPv6 data packet contains an IPv4 data packet in its payload.” See paragraph [0113]. Ananda also

describes determining “whether the destination address of the IPv6 data packet is within the multi-protocol subnet.” See paragraph [0114].

With reference to Figure 4B, Ananda discloses that the IPv6 destination address (DA) is constructed by combining a 48-bit IPv6 prefix, and the address of the IPv4 destination address. See paragraph [0104-0108].

Wetterwald teaches in col. 8, lines 24-28 “[i]f desired, the translator 42 also may add IPv6 option headers related to the layer 4 TCP/UDP source and destination ports, as described in detail in RFC 2460.”

RFC 4380 discloses including a destination port number in a constructed IPv6 address. See page 5 section 2.13. The Teredo protocol defines a “Teredo IPv6 address” that includes “the UDP port and IPv4 address at which a client can be reached.”

With respect to “if necessary, regularizing at least one of the IPv6 source address and the IPv6 destination address of the data packet by replacing said at least one IPv6 address, the replacement process belonging to a group comprising replacement of a constructed address with a native address and replacement of a native address with a constructed address, and modifying the data packet using the regularized address”, Ananda also discloses that the CPI 220E, upon receiving the IPv6 packet, replaces the IPv6 destination address in the packet with an IPv4 destination address. See paragraph [0142] The CPI 220E performs this replacement of the IPv6 destination address of the IPv6 packet by decapsulating the IPv6 packet to produce the original IPv4 packet transmitted from the IPv4 host 215B (step 1012 in Fig. 10).

With reference to Figure 3, Ananda discloses that when the CPI 220-E decapsulates the IPv6 packet to produce the IPv4 packet, the IPv4 input handler 322 of the CPI 220I access the CPI 220E’s IPv4 routing table 324 to determine where to route the IPv4 packet.

Fig. 5 of Ananda shows that extract (step 515) an IPv4 data packet from the payload of an IPv6 data packet involves stripping the IPv6 header from the IPv6 header from the IPv6 data packet. It is considered that Stripping the IPv6 header from the packet results in modifying the packet. Replacing the IPOv4 destination address in the decapsulated IPv4 packet with the private IPv4 address of the IPv4 host

220B involves modifying the IPv6 packet with the private IPv4 address of the IPv4 host (“regularized address”) because the destination address of the IPv6 packet would be replaced with the private IPv4 address of the IPv4 host 220B.

Wetterwald, with reference to Fig. 2 discloses that an IPv4 terminal 18a in a first IPv4 domain 12 transmits an IPv4 packet to another IPv4 terminal 22 in a second IPv4 domain 16. See col. 4, lines 60-64, col. 5, lines 9-13 and col. 6, line 3-9. See also Figures 4B, 5 and col. 1, lines 7-14.

Ananda discloses that when the CPI 220E decapsulates the IPv6 packet (step 1012 in Fig. 10) received from the CPI 215E, the CPI 220E replaces the IPv6 destination address with the IPv4 destination address of the IPv4 host 220B. See paragraph [0142]

The Examiner notes that the above citations, which addresses teachings directed with respect to “identifying an IPv6 destination address constructed by concatenating an IPv6 prefix, an IPv4 destination address and a destination port number; if necessary, regularizing at least one of the IPv6 source address and the IPv6 destination address of the data packet by replacing said at least one IPv6 address, the replacement process belonging to a group comprising replacement of a constructed address with a native address and replacement of a native address with a constructed address, and modifying the data packet using the regularized address” were not previously cited during the original prosecution of the underlying patent. In addition, no concluded review of this combination was previously set forth on the record. Accordingly, a reasonable examiner would consider this teaching important in determining the patentability of claims 1, 5-8.

Accordingly, Ananda, Wetterwald and RFC 4380 raise a Substantial New Question of Patentability.

IX. 35 USC 325(d)

35 USC 325(d) states in part that “[i]n determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” Thus, pursuant to the statute, in order for the Director to exercise discretion as to

whether to Order a reexamination proceeding under chapter 30, the request must first be determined to be based on the same or substantially the same prior art or arguments previously were presented to the Office.

A review of the post grant history of '845 patent indicates that the patent was the subject of a single prior post grant Office challenge.

On October 1, 2020, Petitioner Cisco Systems Inc., filed a filed a Petition for *inter partes* review of claims 13-17 and 19-26 of the '845 patent (IPR2017-01299). Petitioner asserted the following grounds as raising a reasonable likelihood in prevailing (RLP):

Ground	Claims	Basis
#1	1 and 5-8	35 U.S.C. § 103 (Pre-AIA) over Ananda, Weiterwald, and RFC4380

On January 26, 2021, the Patent Trial and Appeal Board (PTAB) issued a decision terminating the proceeding prior to institution in view of a joint motion by the parties to terminate the proceeding due to a settlement before institution.

A comparison between the prior art and arguments presented in the instant Request for *ex parte* reexamination of the '845 patent, indicates that the Request is at least in part based on the same prior art that was previously presented to the Office. In particular SNQ ground 5 as indicated above, is based on the same prior art as RLP ground 1 presented in the prior terminated IPR petition. Thus, the threshold under 35 USC 325(d) for the director to exercise discretion in determining whether to Order reexamination has been met.

However, in view of the following facts, the discretion under 35 USC 325(d) to reject the reexamination request will not be exercised: 1) the fact that the prior denied IPR petition was terminated prior to institution based on a joint settlement agreement without the PTAB substantively reviewing the prior art presented in the petition, 2) the fact that there is no evidence that the third party requester (Unified Patents, LLC) is a real party-in-interest to the petitioner for the prior IPR proceeding, and 3) the

fact the reexamination request presents multiple additional grounds which are not based on the same or substantially the same prior art or arguments that were previously presented to the Office.

Accordingly, *ex parte* reexamination is Ordered for the '845 patent, in view of the determination above that SNQ has been raised in the instant Request for Reexamination.

X. Conclusion

12. For the reasons given above, the present request for ex parte reexamination raises a substantial new question affecting claims 1 and 5-8 of the '845 patent.

13. Claims 1 and 5-8 is not subject to a final holding of invalidity by a federal court or by the Office in a previous examination over the same issue.

Extension of Time

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. 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.

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. Notification of Concurrent Proceedings

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. 8,451, 845 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.

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

By EFS: registered users may submit via the electronic filing system EFS-Web, at
<https://efs.uspto.gov/efile/mvportal/efs-registered>.

By Mail to: Mail Stop Ex Parte Reexam
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

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

By hand: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level

401 Dulany Street
Alexandria, VA 22314

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the data of transmission, which is prior to the expiration of the set period of time in the Office action.

Any inquiry by the patent owner concerning this communication or earlier communications from the Legal Advisor or Examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

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