UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
16/660,615	10/22/2019	Jonathan S. Steuer	10004-2000105	5870

51417 7590 12/17/2024
Maschoff Brennan Gilmore Israelsen & Mauriel LLP
1389 Center Drive, Suite 300
Park City, UT 84098

EXAMINER
DAVIS, CHENEA

ART UNIT	PAPER NUMBER
2421	

NOTIFICATION DATE	DELIVERY MODE
12/17/2024	ELECTRONIC

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.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@mabr.com
mkwdocket@mabr.com

AMR EX. 2101
SAMSUNG v AMR
IPR2024-01350

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Inventors: Steuer et al.	:	
Application No. 16/660,615	:	Decision on Petitions
Filing Date: October 22, 2019	:	
Patent No. 10,719,848	:	
Issue Date: July 21, 2020	:	
Attorney Docket No. 10004-20000105	:	

This is a decision on a petition under 37 C.F.R. § 1.78 filed November 22, 2024. This is also a decision on a petition under 37 C.F.R. § 1.182 filed November 22, 2024, which requests expedited consideration of the petition under 37 C.F.R. § 1.78.

The petition under 37 C.F.R. § 1.78 is **dismissed**.

The petition under 37 C.F.R. § 1.182 is **granted**.

A renewed petition under 37 C.F.R. § 1.78 may be filed in response to this decision. The instant petition includes the required petition fee. Therefore, the renewed petition does not need to include a petition fee. The renewed petition should be titled "Renewed Petition under 37 C.F.R. § 1.78."

The following benefit claims are relevant to this decision:

Benefit Claim	Application No.	Relationship[1]	Prior Application No.
(1)	16660615	CON	16403204
(2)	16403204	DIV	14175811
(3)	14175811	CON	13914870
(4)	13914870	CON	12954604
(5)	12954604	DIV	11139330
(6)	11139330	CLM	60574836
(7)	14175811	DIV	12283353
(8)	12283353	DIV	11139330
(9)	11139330	CLM	60574836

The application was filed with an application data sheet ("ADS") including benefit claims (1)-(6) set forth above on October 22, 2019.

[1] With respect to the relationship identified for each benefit claim, CON = "continuation of", CIP = "continuation in part of", DIV = "divisional of", and CLM = "claims the benefit of".

This application issued as a patent on July 21, 2020.

The petition under 37 C.F.R. § 1.78 and a corrected ADS seeking to add a benefit chain were filed on November 22, 2024. The new benefit chain consists of benefit claims (7)-(9).

A petition under 37 C.F.R. §§ 1.78(c) and 1.78(e) must be accompanied by:

(1) The reference required by 35 U.S.C. § 119(e) and 37 C.F.R. § 1.78(a)(3) to the prior filed provisional application(s) and required by 35 U.S.C. § 120 and 37 C.F.R. § 1.78(d)(2) to the nonprovisional application(s);
(2) The petition fee set forth in 37 C.F.R. § 1.17(m); and
(3) A statement that the entire delay between the date the claims were due under 37 C.F.R. §§ 1.78(a)(4) and 1.78(d)(3) and the date the claims were filed was unintentional.

The petition includes the required petition fee and an adequate statement of delay.[2] However, the petition cannot be granted because benefit claims (3)-(9) are improper and because the Office is requesting additional information concerning the delay in the submission of benefit claims (7)-(9).

Discussion of Benefit Claims (3)-(6)

The applicant seeks to have the benefit information of record consist of benefit claims (1)-(9).

In order for a nonprovisional application to claim the benefit of a prior nonprovisional application, the filing fee must have been paid in the prior application during the pendency of the prior application. *See* 37 C.F.R. § 1.78(d)(1)(iii). A review of the record for Application No. 13/914,870 indicates the application became abandoned because the filing fee and several other items were not timely filed in response to a Notice to File Missing Parts. In other words, the filing fee was not paid during the pendency of the application. Therefore, benefit claim (3), as well as the following benefit claims in the same chain, are improper.

Any renewed petition filed in response to this decision must satisfy the one of the following requirements:

(1) The renewed petition must include a corrected ADS deleting benefit claims (3)-(6) or a statement that the filing fee *and* a new request for a certificate of correction removing the benefits claims from the patent; or
(2) The renewed petition must state the filing fee and a grantable petition under 37 C.F.R. § 1.137(a) have been filed in Application No. 13/914,870.

[2] 37 C.F.R. § 1.78(c) requires the submission of a statement that the entire delay between the date the claim was due under 37 C.F.R. § 1.78(a)(4) and the date the claim was filed was unintentional. 37 C.F.R. § 1.78(e) requires the submission of a statement that the entire delay between the date the claim was due under 37 C.F.R. § 1.78(d)(3) and the date the claim was filed was unintentional. The statement of delay in the petition is being construed as the statements required under 37 C.F.R. §§ 1.78(c) and 1.78(e). If this is not a correct reading of the statement appearing in the petition, petitioner should promptly notify the Office.

Discussion of Benefit Claims (7)-(9)

When a benefit claim is based on a chain of applications, the benefit claim must make a reference to the first (earliest) application and every intermediate application and every intermediate application must make a reference to the first (earliest) application and every application after the first application and before such intermediate application. *See Encyclopaedia Brittanica, Inc., v. Alpine Elecs. of Am., Inc.,* 609 F.3d 1345 (Fed. Cir. 2010). For example, if an applicant wishes for an application to have the following benefit claim: "this application is a continuation of Application No. C, filed ---, which is a continuation of Application No. B, filed ---, which claims the benefit of provisional Application No. A, filed ---," then Application No. C must have a reference to Application No. B and provisional Application No. A, and Application No. B must have a reference to provisional Application No. A.

A review of the record in this case indicates appropriate references were not made in all of the intermediate applications. For example, Application No. 14/175,811 does not currently include benefit claims (7)-(9). The Office acknowledges petitions to add the benefit claims have been filed in the intermediate applications. However, a decision dismissing each petition has been, is being, or will shortly be issued.

With respect to the statement of delay in the petition, the Office may require additional information concerning the period of delay in the submission of untimely benefit claims under 37 C.F.R. § 1.78. *See* 37 C.F.R. §§ 1.78(c)(3) and 1.78(e)(3).

The Office has issued a notice clarifying circumstances that will warrant the Office requesting additional information beyond a statement of unintentional delay.[3] The notice states,

> [The] USPTO will require additional information ...when a petition to accept a delayed priority claim or benefit claim is filed more than two years after the date the priority or benefit claim was due.... Section 711.03(c) of the Manual of Patent Examining Procedure (MPEP) discusses the ''unintentional'' delay standard with respect to petitions to revive an abandoned application, but its discussion of the ''unintentional'' delay is generally applicable to any petition under the ''unintentional'' delay standard... An applicant or patentee cannot meet the ''unintentional delay'' standard in 37 C.F.R. 1.55(e), 1.78(c) and (e), 1.137(a), or 1.378(b) if the entire delay is not unintentional. See MPEP 711.03(c), subsections II.C. through F.[4]

The instant petition was filed on November 22, 2024, which is more than two years after the expiration of the time periods to file the benefit claim. Therefore, the Office is requesting additional information concerning the delay in the submission of the benefit claims.

---

[3] Clarification of the Practice for Requiring Additional Information in Petitions Filed in Patent Applications and Patents Based on Unintentional Delay, 85 Fed. Reg. 12222 (March 2, 2020).
[4] *Id.* at 12223.

Provisional Application No. 60/574,836 discloses subject matter, which is not disclosed in any of the nonprovisional applications listed above if one ignores matter incorporated by reference. The specifications filed for all of the nonprovisional applications, except for Application No. 11/139,330, include language incorporating by reference the contents of the provisional application. The specification filed for Application No. 11/139,330 does *not* include language incorporating by reference the contents of the provisional application.

The petition refers to petitions for *inter partes* review ("IPR") filed by a third party. The IPR petitions appear to assert Application No. 11/139,330 does not disclose or incorporate by reference some of the subject matter disclosed in the provisional application.

The petition indicates, prior to reviewing and analyzing the IPR petitions, both the patentee and patent practitioner Michael Mauriel believed all of the nonprovisional applications directly or indirectly claiming the benefit of the provisional application were able to rely on the disclosure of the provisional application for "written description support."

A declaration by Mauriel stating, "[I]t had also been my intention, and always my belief" that the nonprovisional applications could rely on the disclosure of the provisional application "based on its incorporation-by-reference into each of those applications."[5]

A non-final Office action issued on January 14, 2015, and a final Office action issued on April 4, 2017, in Application No. 14/175,811 and at least one Office action issued in Application No. 12/954,604 identify subject matter that the Office action argues is not disclosed in Application No. 11/139,330 without explicitly addressing whether the subject matter is disclosed in the provisional application. Any renewed petition should indicate the extent to which, if any, the subject matter referenced in the applicable portions of the Office actions falls within both of the following criteria:

(1) The information is not disclosed in Application No. 11/139,330; and
(2) The information is disclosed in the provisional application.

If any of the subject matter satisfies both criteria, the renewed petition should address the reasons such a fact did not cause the applicant or Mauriel to recognize Application No. 11/139,330 did not disclose or incorporate by reference some of the subject matter disclosed in the provisional application.

Further correspondence with respect to this matter may be submitted as follows:

By Internet: A request for reconsideration may be filed electronically using Patent Center.[6]

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

[5] Declaration, paragraph 5.
[6] General information concerning Patent Center can be found at https://www.uspto.gov/patents/apply/patent-center.

By facsimile: (571) 273-8300
Attn: Office of Petitions

By hand: United States Patent and Trademark Office
Customer Service Window, Mail Stop Petitions
Knox building, Room 1D80
501 Dulany Street
Alexandria, VA 22314

Telephone inquiries regarding this communication should be directed to Attorney Advisor Steven Brantley at (571) 272-3203.

/Charles Steven Brantley/

Charles Steven Brantley
Attorney Advisor
Office of Petitions