

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC.,
Petitioner,

v.

MOSKOWITZ FAMILY LLC
Patent Owner.

Case No. IPR2025-01598
U.S. Patent No. 9,005,293

DECLARATION OF ROBERT W. BAHR

I, Robert W. Bahr, declare as follows:

I. INTRODUCTION

1. I am submitting this declaration on behalf of Medtronic, Inc. (Medtronic) in connection with a petition for *inter partes* review of U.S. Patent No. 9,005,293 (“the ’293 patent”), which I understand has been submitted to the Patent Trial and Appeal Board of the United States Patent and Trademark Office.

2. I am a partner at the law firm of Maier & Maier PLLC, where I specialize in United States Patent and Trademark Office (USPTO) patent policy, practice, and procedure. My expertise includes USPTO patent policy, practice, and procedures, and advising attorneys and our clients on complex patent prosecution matters.

3. Medtronic has retained me as an expert to investigate the file history of the ’293 patent and provide my expert opinion relating to the examination leading to the ’293 patent. In particular, I have been asked to provide information about the relevant procedures that govern patent application examination, and the applicable rules and guidance provided by the edition of the Manual of Patent Examining

Procedure (“MPEP”) that was in effect during the examination of the application that led to the ’293 patent.¹

4. Based on my experience and knowledge of the relevant procedures governing patent examination, it is my opinion that the file history of the ’293 patent reveals that the search conducted during the examination process failed to uncover pertinent prior art,² namely U.S. Patent Application Publication No. 2010/0305704 to Messerli (Messerli) and U.S. Patent Application Publication No. 2008/0249569 to Waugh et al. (Waugh ’569). The search conducted for the ’293 patent should have uncovered Messerli and Waugh ’569. These references, according to the IPR

¹ All references to the MPEP are to Revision 11.2013 of the Ninth Edition [E9R-11.2013]. In addition, all references to 35 U.S.C. § 102 or 103 are to pre-AIA 35 U.S.C. § 102 or 103.

² I understand that Messerli (Ex. 1005) and Waugh ’569 (Ex. 1006) are asserted to be prior art under 35 U.S.C. § 102(e) in the petition for *inter partes* review (“IPR petition”) of the ’293 patent. For purposes of this declaration, I assume that these references are prior art under 35 U.S.C. § 102(e) that disclose the limitations of the claims as explained in the IPR petition (the “pertinent prior art”).

petition, are prior art under 35 U.S.C. § 102(e) and should have been used to reject the pending claims.

5. The material nature of this search failure is confirmed by the USPTO's findings in continuation applications of the '293 patent. In those later applications, the USPTO rejected subject matter similar to that recited in claim 43 of the '293 patent based on Messerli and Waugh '569.

6. Moreover, the applicant of the '293 patent also contributed to the examiner's failure to uncover Messerli and Waugh '569. Despite knowing about these references for a long time before the '293 patent issued, applicant failed to bring these references to the examiner's attention and facilitate consideration of these references during prosecution of the '293 patent.

II. BACKGROUND AND QUALIFICATIONS

7. I worked at the USPTO for over 38 years. I began my career at the USPTO in September 1984, and was a patent examiner in Examining Group 330 (now Technology Center 3700) until April 1994. Between March 2016 and August 2023, I served as the Deputy Commissioner for Patents responsible for the patent

examination policy area (“Deputy Commissioner for Patent Examination Policy”).³

I also served as the acting Deputy Commissioner for Patent Examination Policy between August of 2015 and March 2016, and from November 2009 until December 2011. Between November 2000 and March 2016, I served as the Senior Patent Counsel to the Deputy Commissioner for Patent Examination Policy (except when I was acting Deputy Commissioner). Between April 1994 and July 2000, I was a Legal Advisor in the Office of Patent Legal Administration (OPLA).

8. I led the implementation of numerous rulemakings while at the USPTO, most notably the patent examination provisions of the Leahy-Smith America Invents Act (AIA), the Patent Law Treaty provisions of the Patent Law Treaties Implementation Act (PLTIA), and the continued examination, patent term adjustment, and eighteen-month publication provisions of the American Inventors Protection Act of 1999 (AIPA). I also provided training to patent examiners on various changes to the patent laws, regulations, and examining procedures, including

³ From 2016 to 2020, this position was titled “Deputy Commissioner for Patent Examination Policy,” and in October 2020 that title changed to “Deputy Commissioner for Patents.” This position was titled “Associate Commissioner for Patent Examination Policy” from 2009 to 2011.

the continued examination, patent term adjustment, and eighteen-month publication provisions of the AIPA.

9. I completed my undergraduate studies at the University of Maryland in 1983 with a Bachelor of Science in Mechanical Engineering. I attended the National Law Center of George Washington University, receiving my Juris Doctor in law with honors in May of 1993. I am a member of the Virginia State Bar and the Bars of the U.S. Court of Appeals for the Federal Circuit (Federal Circuit), and U.S. Supreme Court. I am registered to practice as a patent attorney before the U.S. Patent and Trademark Office.

III. SUMMARY OF THE PROSECUTION AND EXAMINATION OF THE '293 PATENT

10. The '293 patent issued from a patent application filed on May 16, 2011, and assigned application No. 13/108,982. The '293 patent indicates that it is a continuation of application No. 11/842,855, which in turn is a continuation-in-part of application No. 11/536,815, which in turn is a continuation-in-part of application

No. 11/208,644, and which in turn claims priority to provisional application No. 60/670,231 (“the ’231 provisional application”).⁴

11. The USPTO issued a non-final Office action on May 15, 2014, in which the examiner: (1) provisionally rejected claims 26 through 93 (all of then-pending claims) on the basis of nonstatutory obviousness-type double patenting over (a) claims 1 through 31 of copending application No. 12/471,340, (b) claims 1 through 88 of copending application No. 13/418,323, (c) claims 1 through 31 of copending application No. 13/401,829, and (d) claims 1 through 88 of copending application No. 13/418,335; (2) rejected claims 26 through 93 on the basis of nonstatutory obviousness-type double patenting over claims 1 through 31 of U.S. Patent No. 7,972,363; and (3) rejected claims 26 through 93 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,629,998 to Lin (Lin).

⁴ There are a number of applications that claim priority to the ’231 provisional application. For simplicity, the patent applications and patents claiming priority to the ’231 provisional application are referred to as “related” applications, whether or not the application or patent has a parent or child relationship to the ’293 patent.

12. An interview was conducted on June 13, 2014. The examiner summarized the interview of June 13, 2014 as follows:

Applicant's arguments did not overcome the rejectio[n] in the last office action. However, applicant is willing to amend the claims to further define the scre[w]/drill guide tunnel. [A]pplicant will send in the formal amend[ment] and the examiner will conduct an updated search. No agreement was reached.

13. Applicant filed an information disclosure statement (IDS) on August 19, 2014, accompanied by the fee set forth in 37 C.F.R. § 1.17(p).⁵ The IDS of August 19, 2014 cited 39 U.S. patents, 12 U.S. patent application publications, two foreign patent documents, three PCT international search reports, and four non-patent documents. The IDS of August 19, 2014, however, did not cite Messerli or Waugh '569.

14. Applicant responded to the non-final Office action on September 15, 2014. The response canceled claims 26 through 93 and added new claims 94 through

⁵ An IDS submitted after the first Office action on the merits (but before a final Office action or allowance) requires the fee set forth in 37 C.F.R. § 1.17(p) or one of the statements set forth in 37 C.F.R. § 1.97(e). 37 C.F.R. § 1.97(c).

141. Claim 43 of the '293 patent was claim 133 in the response of September 15, 2014,⁶ and reads as follows:

A zero-profile, intervertebral cage sized and configured to be inserted into a disc space between adjacent vertebral bodies and to provide fusion of the adjacent vertebral bodies via biological bone fusion and screw fusion,

the intervertebral cage comprising:

a top wall;

a bottom wall opposite the top wall;

a first sidewall;

a second sidewall opposite the first sidewall, each of the first sidewall and the second sidewall having a surface configured to contact one of the adjacent vertebral bodies when the intervertebral cage is inserted into the disc space,

wherein at least the first sidewall and the second sidewall bound an open space capable of receiving bone filling for the biological bone fusion,

wherein the top wall includes a top surface and a bottom surface opposite the top surface, the top surface configured to have a zero-profile with respect to the adjacent vertebral bodies when the intervertebral cage is inserted into the disc space, and the bottom surface facing the open space; and

an internal screw trajectory guide for guiding a trajectory of a screw through the intervertebral cage, the internal screw trajectory guide having an entry opening and an exit opening, the entry opening formed at least partially in the top surface of the top wall, and the exit opening formed at least partially in a bottom surface of the top wall and at least partially in a side surface of the top wall.

⁶ The IPR petition challenges only claim 43 of the '293 patent. As such, my declaration addresses only claim 43 of the '293 patent. Claim 133 was renumbered as claim 43 for the '293 patent (37 C.F.R. § 1.126).

15. The USPTO issued a final Office action on October 16, 2014, in which the examiner: (1) rejected claims 94 through 103, 106 through 127, and 131 through 140 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 7,442,209 to Michelson (Michelson '209); (2) rejected claims 94 through 103, 106 through 127, and 131 through 140 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,972,019 to Michelson (Michelson '019); (3) rejected claims 94 through 103, 106 through 127, and 131 through 140 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 8,425,607 to Waugh et al. (Waugh '607); (4) rejected claims 104, 105, 128 through 130, and 141 under 35 U.S.C. § 103(a) as unpatentable over Michelson '019 and U.S. Patent No. 7,776,093 to Wolek et al. (Wolek); and (5) rejected claims 104, 105, 128 through 130, and 141 under 35 U.S.C. § 103(a) as unpatentable over Waugh '607 and Wolek.

16. A second interview was conducted on December 15, 2014. The examiner summarized the interview of December 15, 2014 as follows:

Applicant's proposed amendments seem to [o]vercome the cited art. Applicant stated that he will amend[] the claims to recite that "the guide is only or complet[e]ly formed in the top surface of the top wall" that see[m]s to overcome Michelson/Waugh. Applicant will send in the formal amendments and the examiner will conduct an updated search.

17. Applicant submitted a proposed amendment after final on January 16, 2015. Claim 133 as amended in the proposed amendment after final on January 16, 2015 reads as follows with the changes shown using underline and strikethrough:

A zero-profile, intervertebral cage sized and configured to be inserted into a disc space between adjacent vertebral bodies and to provide fusion of the adjacent vertebral bodies via biological bone fusion and screw fusion,

the intervertebral cage comprising:

a top wall;

a bottom wall opposite the top wall;

a first sidewall;

a second sidewall opposite the first sidewall, each of the first sidewall and the second sidewall having a surface configured to contact one of the adjacent vertebral bodies when the intervertebral cage is inserted into the disc space,

wherein at least the first sidewall and the second sidewall bound an open space capable of receiving bone filling for the biological bone fusion,

wherein the top wall includes a top surface and a bottom surface opposite the top surface, the top surface configured to have a zero-profile with respect to the adjacent vertebral bodies when the intervertebral cage is inserted into the disc space, and the bottom surface facing the open space; and

an internal screw trajectory guide for guiding a trajectory of a screw through the intervertebral cage, the internal screw trajectory guide having an internal bore with an entry opening and an exit opening, the internal bore of the entry opening formed only at least partially in the top surface of the top wall, and the internal bore of the exit opening formed at least partially in a bottom surface of the top wall and at least partially in a side surface of the top wall.

18. Applicant argued that these amendments overcome the prior art.

Specifically, Applicant argued that:

In stark contrast to the arrangements in the applied references, the claimed invention provides a unique combination in which an internal screw guide has an internal bore with an entry opening and an exit opening, the entry opening of the internal bore is formed only in a top surface of the top wall, while the exit opening is formed at least partially in a bottom surface of the top wall and at least partially in a side surface of the top wall.

(Ex. 1004, 371.)

19. The USPTO issued a notice of allowance and notice of allowability (notice of allowance) on February 20, 2015.

20. Applicant filed an IDS on March 9, 2015, the date the issue fee was paid (Ex. 1004, pages 396-407). Applicant stated that the IDS of March 9, 2015 cites U.S. patents and U.S. patent application publications from related applications, which “are not believed to add to the art of record” (Ex. 1004, page 396). The IDS of March 9, 2015 specifically cited fifty-five U.S. patents and twenty-five U.S. patent application publications, including Messerli and Waugh ’569 (Ex. 1004, page 398-406). The IDS of March 9, 2015, however, was **not** accompanied by **either** the

fee set forth in 37 C.F.R. § 1.17(p) or one of the statements set forth in 37 C.F.R. § 1.97(e).⁷

21. The USPTO notified applicant that the IDS of March 9, 2015 did not comply with the requirements of 37 C.F.R. § 1.97(d) in a notice issued by the USPTO's Office of Data Management (ODM) on March 16, 2015. Applicant, however, did not correct the IDS. There is no indication in the file history of the '293 patent that the IDS of March 9, 2015 was ever forwarded to examiner for review.

22. The USPTO notified applicant that the application would issue on April 14, 2015 as U.S. Patent No. 9,005,293 in a notice (Issue Notification) issued on March 25, 2015.

IV. USPTO SEARCH SYSTEMS AND GUIDANCE IN THE 2014-2015 TIMEFRAME

23. In 2014-2015, the USPTO provided two desktop search tools for examiners to search U.S. patents and U.S. patent application publications: the Examiner's Automated Search Tool ("EAST") and the Web-based Examiner Search Tool ("WEST"). MPEP § 902.03(e). EAST and WEST each provided examiners

⁷ An IDS submitted after allowance, but on or before payment of the issue fee, requires **both** the fee set forth in 37 C.F.R. § 1.17(p) and one of the statements set forth in 37 C.F.R. § 1.97(e). 37 C.F.R. § 1.97(d).

with access to a common database of U.S. patents and U.S. patent application publications, and each permitted an examiner to view retrieved documents as either images or text.

24. The MPEP provides that a classified search—the traditional search practice of browsing all of the patent documents in one or more classifications—is the appropriate search approach if the subject matter of the invention cannot be accurately described by a text query. MPEP § 904.02(b). The MPEP explains that it is sometimes difficult to express search needs accurately in textual terms, which often occurs in mechanical arts where spatial relationships or shapes of mechanical components constitute important aspects of the claimed invention. MPEP § 904.02. The USPTO instructs examiners that while text query searching remains useful, the traditional search practice of browsing all of the patent documents in one or more classifications (a classified search) will continue to be an important part of the search strategy in these situations. MPEP § 904.02.

25. The USPTO also instructs examiners that U.S. patent application publications are, for purposes of 35 U.S.C. §§ 102(a) and (b), publications as of their publication date, regardless of whether the underlying application is subsequently abandoned or patented. MPEP §§ 901.02 and 901.03. In addition, U.S. patent application publications are prior art under 35 U.S.C. § 102(e) as of the earliest

effective U.S. filing date of the published application. MPEP §§ 901.02 and 901.03. Moreover, patent application publications are usually the first publication of a patent application as patent applications are typically published as patent application publications before they issue as patents. Patent application publications may be the only publication of a patent application as applications abandoned after publication never become patents.

V. THE SEARCHES CONDUCTED BEFORE ALLOWING THE '293 PATENT

26. Claim 43 of the '293 patent (application claim 133) is directed to an intervertebral cage—a mechanical structure—with top and bottom walls, first and second sidewalls, and an internal screw trajectory guide, with the relationship of these elements being defined with respect to each other, and also with respect to vertebral bodies and bone filling that do not form part of the claimed intervertebral cage (*e.g.*, via “configured to” and “capable of” language). This description of the intervertebral cage (top, bottom, and first and second side walls, and their spatial relationships) is not one for which the examiner could rely upon a text query search as the primary search. MPEP § 904.02. In addition, the limitations defining the elements of the intervertebral cage with respect to vertebral bodies and bone filling are functional limitations, and the MPEP indicates that functional limitations need not be expressly disclosed in a reference so long as the reference inherently possesses

or is capable of the claimed function. MPEP § 2114(I). Again, an examiner could not rely upon a text query search for functional limitations that a reference need only inherently possess (*e.g.*, a text query search for a “popcorn” dispenser would not have retrieved the oil can held to be an anticipatory reference in *In re Schreiber*, 128 F.3d 1473 (Fed. Cir. 1997)). For these reasons, a proper search of the ’293 patent (at least as to claim 43 (originally claim 133)) required the traditional search practice of browsing all of the patent documents in the applicable U.S. Patent Classification (USPC) and/or Cooperative Patent Classification (CPC) classifications.⁸

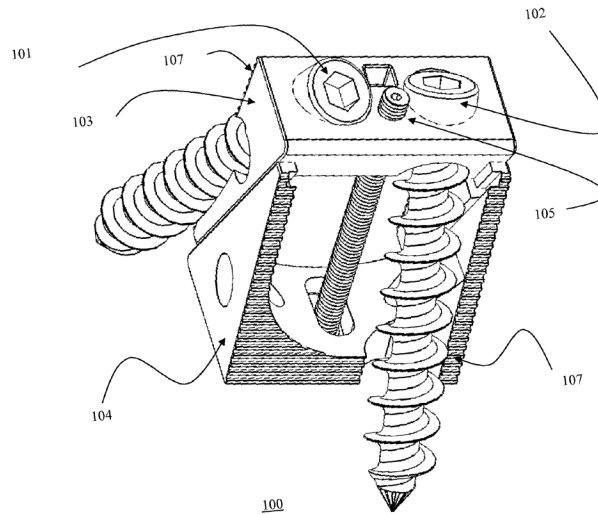
27. Both Messerli and Waugh ’569 are classified in USPC class 632, subclass 17.16 (Ex. 1005, page 1 (Messerli); Ex. 1006, page 1 (Waugh ’569)). The file history of the ’293 patent indicates that the examiner conducted a classified search, as well as a text query (automated) search, prior to the Office actions of May 15, 2014 and October 16, 2014, as well as the notice of allowance of February 20, 2015. The file history of the ’293 patent specifically indicates that the examiner conducted a search of USPC class 632, subclasses 17.11 through 17.16, as well as

⁸ The USPTO began the process of migrating from the U.S. Patent Classification (USPC) system to the Cooperative Patent Classification (CPC) system in 2013.

subgroups of CPC group A61F 2/44, on May 9, 2014, October 10, 2014, and February 9, 2015 (Ex. 1004, pages 198, 348, and 392).

28. The classified search of class 632, subclass 17.16, should have uncovered both Messerli and Waugh '569. As I explain below, the failure to recognize Messerli and Waugh '569 during the classified searches for the '293 patent was not a one-off occurrence of missing one reference, but multiple instances of overlooking pertinent prior art during the classification searches for the '293 patent. As I explain below, overlooking the disclosure in these references was material error given that Messerli and Waugh '569 each disclose the critical limitations of the challenged claim (claim 43) of the '293 patent, according to the IPR petition, as well as USPTO examiners in the examination of related applications.

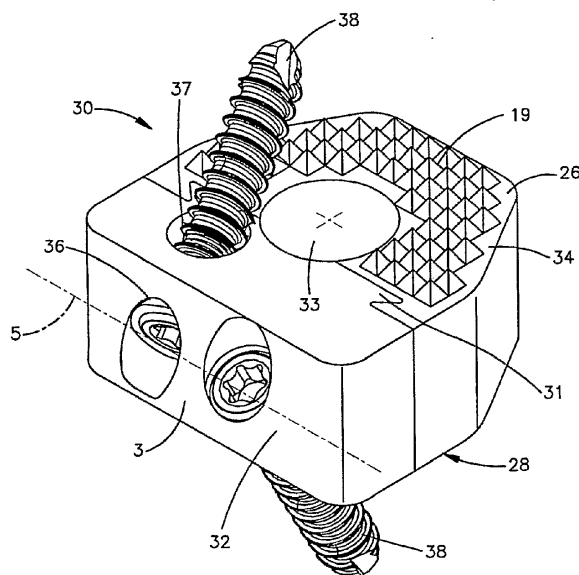
29. Figure 1B of the '293 patent (the figure chosen by the examiner for the front page of the patent) discloses an intervertebral cage with top and bottom walls, first and second sidewalls, and an internal screw trajectory guide.



(Ex. 1001, Cover.)

30. The front page of the Messerli patent application publication also discloses an intervertebral cage with top and bottom walls, first and second sidewalls, and an internal screw trajectory guide, which is strikingly like figure 1B of the '293 patent. This similarity warranted further review of Messerli especially because this front-page figure appears to show, as explained in the IPR petition

(see pages 24 through 26), the claim limitations that applicant argued distinguished its claims over the prior art.



(Ex. 1005, Cover.)

31. In fact, the pertinence of Messerli is confirmed by the USPTO's findings in a related application *based on Messerli's figures*. Specifically, Messerli was applied by the examiner of the '293 patent in related application 13/210,168 (Ex. 1042). The examiner provided a discussion of Messerli in an Office action issued on July 3, 2017 (Ex. 1042, pages 530-540). The examiner specifically stated that:

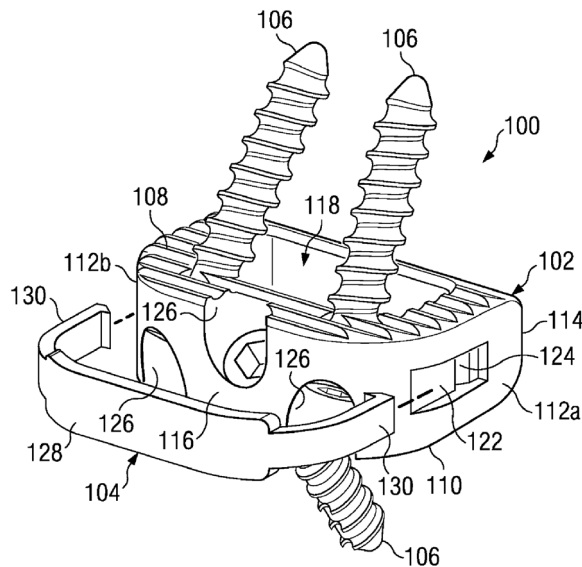
Messerli provides the evidences of the use of a vertebral implant wherein the internal screw guide has an internal bore with the entry opening and the exit opening, as *best*

seen in FIGS., and the entry opening of the internal bore is formed only in the top surface of the top wall, **as best seen in FIGS.**, and the exit opening is formed at least partially in the bottom surface of the top wall and at least partially in the side surface of the top wall, **as best seen in FIGS.**, wherein the internal screw guide further comprises a counterbore formed at least partially in the top surface of the top wall for accommodating a screw head of a screw member, as best seen in FIGS., wherein the entry opening of the internal bore is formed in a lower surface of the counterbore, and wherein the entry opening of the internal bore is formed entirely between all edges of the top wall when viewed from a direction perpendicular to a plane of the top surface, as best seen in FIGS., for allowing the screw to be secure to the appropriate vertebral body.

(Ex. 1042, page 537 (emphases added).) As evident from the underlined and bold portions above, the examiner of the '293 patent himself later found that Messerli's figures disclose the limitations that the applicant argued distinguished the pending claims of the '293 patent from the prior art (*see* Section III).

32. The front page of the Waugh '569 patent application publication also discloses an intervertebral cage with top and bottom walls, first and second sidewalls, and an internal screw trajectory guide, which is strikingly like figure 1B

of the '293 patent. This similarity warranted further review of Waugh '569 especially because this front-page figure appears to show, as explained in the IPR petition (*see* pages 26 through 29), the claim limitations that applicant argued distinguished its claims over the prior art.



(Ex. 1006, Cover.)

33. In fact, the pertinence of Waugh '569 is confirmed by the USPTO's findings in a related application *based on Waugh '569's figures*. Waugh '569 was applied by an examiner different from the examiner of the '293 patent in related application 17/706,873 (Ex. 1043). That examiner provided an extensive

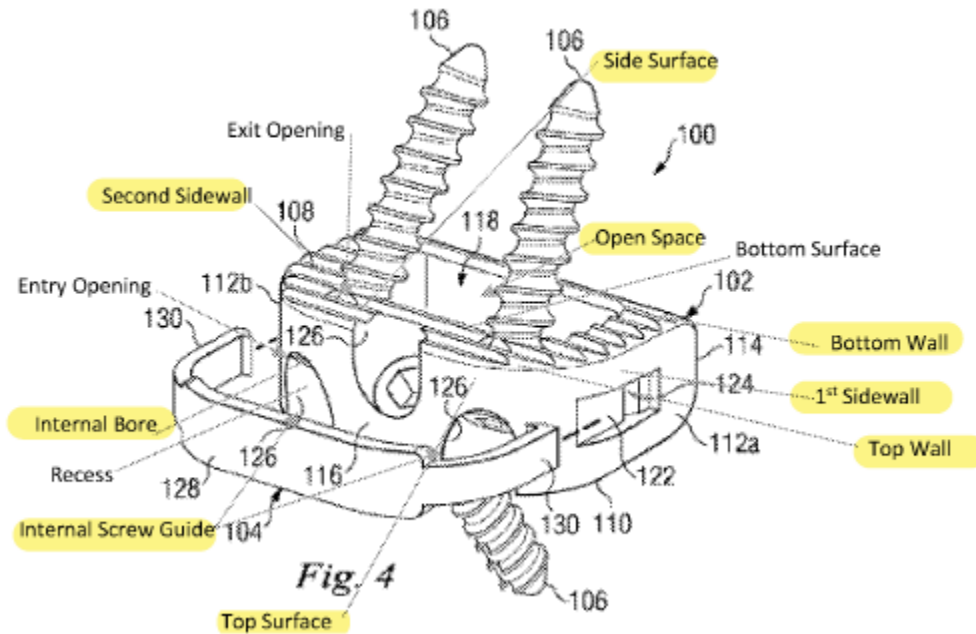
discussion of Waugh '569 in an Office action issued on September 21, 2022 (Ex.

1043, pages 173-188). The examiner specifically stated that Waugh '569 discloses:

an intervertebral implant . . . comprising: a top wall including a top surface and a bottom surface opposite the top surface; a bottom wall opposite the top wall; a first sidewall; a second sidewall opposite the first sidewall, wherein the top wall, bottom wall, first sidewall and second sidewall define an open space capable of receiving bone filling for biological bone fusion; and an internal screw guide having an internal bore and a recess extending into the top surface of the top wall, the internal bore having an entry opening and an exit opening, the entry opening of the internal bore formed at a juncture between the internal bore and the recess, the entry opening of the internal bore formed only in the top surface of the top wall, the recess sized and shaped to accommodate a screw head, and the exit opening formed at least partially in the bottom surface of the top wall and at least partially in a side surface of the top wall.

(Ex. 1043, page 180 (emphases added).) The examiner made these findings based on figure 4 of Waugh '569, which is on the front page of Waugh '569. As evident from the underlined portions above and the annotated figure below, the examiner found that Waugh '569's front-page figure discloses the limitations that the

applicant argued distinguished the pending claims from the prior art (*see* Section III).



(Ex. 1043, page 181 (annotated by the Examiner, highlighted to show relevant claim limitations).)

34. As I explained above, Messerli and Waugh '569 are each classified in both USPC class 623, subclass 17.16 and CPC A63F 2/44. The examiner's classified search of these areas would have (or at least should have) included at least looking at the front page of both Messerli and Waugh '569. Having looked at those front pages, the relevance of both Messerli and Waugh '569 should have been apparent to the examiner, as I explained above. The examiner, however,

failed to recognize and apply either Messerli or Waugh '569 during examination of the '293 patent.

VI. THE NON-COMPLIANCE OF THE INFORMATION DISCLOSURE STATEMENT FILED MARCH 9, 2015

35. The IDS of March 9, 2015 included Messerli and Waugh '569, but this IDS was **not** submitted in compliance with the requirements of 37 C.F.R. § 1.97(d) and was thus not considered by the examiner. Applicant's submission of the IDS of March 9, 2015 in a manner that resulted in its not being forwarded to the examiner for consideration thwarted the last chance for the examiner to consider Messerli and Waugh '569 in the '293 patent.

36. The USPTO admonishes applicants to submit information promptly, stating that an applicant or its representative should submit information early in prosecution (before the first Office action), and not wait until after allowance. MPEP § 2004 (item 12). The USPTO further cautions applicants that potentially material information discovered late in prosecution should be submitted immediately, and that the issue fee having already been paid is no reason or excuse for failing to submit information. MPEP § 2004 (item 12).

37. The IDS rules (37 C.F.R. §§ 1.97 and 1.98) are designed to encourage the submission of information to the USPTO promptly and in a uniform manner, and to provide certainty for the public by defining the requirements for submitting IDSs

so that the USPTO will consider information contained in an IDS before a patent is granted. MPEP § 609. The USPTO, however, advises applicants and their representatives that an IDS filed before the grant of a patent that does not comply with 37 C.F.R. §§ 1.97 and 1.98 will be placed in the file but will not be considered by the USPTO. 37 C.F.R. § 1.97(i) and MPEP § 609.05.

38. To this end, the USPTO provides various avenues for submission and consideration of an IDS even after allowance of an application. For those applicants who can make one of the statements set forth in 37 C.F.R. § 1.97(e),⁹ an applicant may submit the IDS with the fee set forth in 37 C.F.R. § 1.17(p) and one of the

⁹ The statements set forth in 37 C.F.R. § 1.98 are either that: (1) each item of information contained in the IDS was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the IDS; or (2) no item of information contained in the IDS was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the IDS was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of the IDS. MPEP § 609.04(b)(V).

statements set forth in 37 C.F.R. § 1.97(e) (37 C.F.R. § 1.97(d)), and may also submit the IDS even after payment of the issue fee under the Quick Path Information Disclosure Statement (QPIDS) program.¹⁰ An applicant who cannot or does not wish to make one of the statements set forth in 37 C.F.R. § 1.97(e) may file a request for continued prosecution under 37 C.F.R. § 1.114 (RCE) (or continuing application) with a petition under 37 C.F.R. § 1.313(c) to withdraw from issue if after payment of the issue fee to have the IDS considered by the examiner. MPEP § 609.04(b)(III) and (IV). In sum, the USPTO provides avenues for an applicant to have an IDS considered by the examiner any time during prosecution up to patent grant, even for an applicant who cannot make either of the statements set forth in 37 C.F.R. § 1.97(e).

39. The file history of the '293 patent indicates that the USPTO notified applicant on March 16, 2015 that the IDS of March 9, 2015 was non-compliant, which was before an issue date was assigned to the application and four (4) weeks before the '293 patent was ultimately issued. The USPTO's rules permit an applicant to file a petition under 37 C.F.R. § 1.313(c) to withdraw from issue and an RCE (or

¹⁰ *Quick Path Information Disclosure Statement (QPIDS) Pilot Program*, 77 *Fed. Reg.* 27443 (May 10, 2012).

continuing application) to have an IDS considered in this situation. The file history of the '293 patent, however, does not indicate that applicant took any action to submit the information in the IDS of March 9, 2015 in a manner that would result in its consideration by the examiner. Therefore, the IDS of March 9, 2015 was placed in the file of the '293 patent, but the IDS of March 9, 2015—including Messerli and Waugh '569—was not considered by the USPTO (or the examiner) in the '293 patent.

40. Applicant submitted Messerli in related applications (applications Nos. 13/084,543 and 13/741,361) in 2012, and the USPTO cited Waugh '569 to applicant in related applications (applications Nos. 13/418,323 and 13/418,335) in 2013, well more than three months prior to the submission of the IDS of March 9, 2015, as well as prior to even the submission of the IDS of August 19, 2014. The USPTO cautions applicants that they cannot rely upon information being in other related applications as examiners are not expected to retain details of other applications when reviewing a particular application. MPEP § 2001.06(b). Messerli and Waugh '569 being cited in related applications does **not** show awareness of these references on the part of the examiner during examination of the '293 patent, and is **not** a substitute for submitting these reference to the USPTO for the '293 patent.

VII. CONCLUSION

41. The U.S. patent application publications to Messerli and Waugh '569 were not considered by the examiner during the examination of the application resulting in the '293 patent. Messerli and Waugh '569, however, should have been uncovered at least during the examiner's classified search of USPC class 623, subclass 17.16. Moreover, applicant's submission of the IDS of March 9, 2015 in a manner that resulted in its not being forwarded to the examiner for consideration thwarted the last chance for the examiner to consider Messerli and Waugh '569 in the '293 patent.

I hereby declare that all the statements made herein of my own knowledge are true and are the whole truth, and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code

and that such willful false statements may jeopardize the validity of the application
or any patent issued thereon.

Respectfully submitted,



January 8, 2026

Robert W. Bahr