

EXHIBIT 1
(Part 2)

EXHIBIT B

**U.S. District Court [LIVE]
 Eastern District of TEXAS LIVE (Texarkana)
 CIVIL DOCKET FOR CASE #: 5:07-cv-00156-DF-CMC**

ESN LLC v. Cisco Systems Inc et al
 Assigned to: Judge David Folsom
 Referred to: Magistrate Judge Caroline Craven
 Cause: 28:1338 Patent Infringement

Date Filed: 10/15/2007
 Jury Demand: Plaintiff
 Nature of Suit: 830 Patent
 Jurisdiction: Federal Question

Plaintiff

ESN LLC

represented by **Eric M. Albritton**
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 Longview, TX 75606
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LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Thomas John Ward, Jr
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 Fax: 903/7572323
 Email: jw@jwfirm.com
ATTORNEY TO BE NOTICED

V.

Defendant

Cisco Systems Inc

Defendant

Cisco-Linksys LLC

Date Filed	#	Docket Text
10/15/2007	1	COMPLAINT against Cisco Systems Inc, Cisco-Linksys LLC (Filing

		fee \$ 350 receipt number 1298562.), filed by ESN LLC. (Attachments: # <u>1</u> Exhibit A - Part 1# <u>2</u> Exhibit A - Part 2# <u>3</u> Exhibit B# <u>4</u> Exhibit C# <u>5</u> Civil Cover Sheet)(Albritton, Eric) (Entered: 10/16/2007)
10/16/2007	<u>2</u>	NOTICE of Attorney Appearance by Thomas John Ward, Jr on behalf of ESN LLC (Ward, Thomas) (Entered: 10/16/2007)

PACER Service Center			
Transaction Receipt			
10/16/2007 09:40:14			
PACER Login:	ajs0093	Client Code:	1000.060
Description:	Docket Report Search Criteria: 5:07-cv-00156-DF-CMC		

EXHIBIT C

JS-44 (Rev. 11/04)

CIVIL COVER SHEET

The JS-44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. (SEE INSTRUCTIONS ON THE REVERSE OF THE FORM.)

<p>I. (a) PLAINTIFFS ESN, LLC</p> <p>(b) County of Residence of Firm Listed Plaintiff _____ (EXCEPT IN U.S. PLAINTIFF CASES)</p> <p>(c) Attorney's (Firm Name, Address, and Telephone Number) Eric M. Albritton, Albritton Law Firm P.O. Box 2649, Longview, Texas 75606 (903) 757-8449</p>	<p>DEFENDANTS CISCO SYSTEMS, INC., and CISCO-LINKSYS, LLC</p> <p>County of Residence of Firm Listed Defendant _____ (IN U.S. PLAINTIFF CASES ONLY)</p> <p>NOTE: IN LAND CONDEMNATION CASES, USE THE LOCATION OF THE LAND INVOLVED.</p> <p>Attorneys (If Known)</p>
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<p>II. BASIS OF JURISDICTION (Place an "X" in One Box Only)</p> <p><input type="checkbox"/> 1 U.S. Government Plaintiff</p> <p><input type="checkbox"/> 2 U.S. Government Defendant</p> <p><input checked="" type="checkbox"/> 3 Federal Question (U.S. Government Not a Party)</p> <p><input type="checkbox"/> 4 Diversity (Indicate Citizenship of Parties in Item III)</p>	<p>III. CITIZENSHIP OF PRINCIPAL PARTIES (Place an "X" in One Box for Plaintiff and One Box for Defendant)</p> <table style="width:100%;"> <tr> <td style="width:50%;">Citizen of This State</td> <td style="width:50%;">Incorporated or Principal Place of Business in This State</td> </tr> <tr> <td>Citizen of Another State</td> <td>Incorporated and Principal Place of Business in Another State</td> </tr> <tr> <td>Citizen or Subject of a Foreign Country</td> <td>Foreign Nation</td> </tr> </table>	Citizen of This State	Incorporated or Principal Place of Business in This State	Citizen of Another State	Incorporated and Principal Place of Business in Another State	Citizen or Subject of a Foreign Country	Foreign Nation
Citizen of This State	Incorporated or Principal Place of Business in This State						
Citizen of Another State	Incorporated and Principal Place of Business in Another State						
Citizen or Subject of a Foreign Country	Foreign Nation						

IV. NATURE OF SUIT (Place an "X" in One Box Only)

<p>CONTRACT</p> <p><input type="checkbox"/> 130 Insurance</p> <p><input type="checkbox"/> 120 Marine</p> <p><input type="checkbox"/> 126 Miller Act</p> <p><input type="checkbox"/> 140 Negotiable Instrument</p> <p><input type="checkbox"/> 150 Recovery of Overpayment & Enforcement of Judgment</p> <p><input type="checkbox"/> 151 Medicare Act</p> <p><input type="checkbox"/> 152 Recovery of Defaulted Student Loans (Excl. Veterans)</p> <p><input type="checkbox"/> 153 Recovery of Overpayment of Veteran's Benefits</p> <p><input type="checkbox"/> 160 Stockholders' Suits</p> <p><input type="checkbox"/> 190 Other Contract</p> <p><input type="checkbox"/> 195 Contract Product Liability</p> <p><input type="checkbox"/> 196 Franchise</p>	<p>TORTS</p> <p>PERSONAL INJURY</p> <p><input type="checkbox"/> 310 Airplane</p> <p><input type="checkbox"/> 315 Airplane Product Liability</p> <p><input type="checkbox"/> 320 Assault, Libel & Slander</p> <p><input type="checkbox"/> 330 Federal Employers' Liability</p> <p><input type="checkbox"/> 340 Marine</p> <p><input type="checkbox"/> 345 Marine Product Liability</p> <p><input type="checkbox"/> 350 Motor Vehicle</p> <p><input type="checkbox"/> 355 Motor Vehicle Product Liability</p> <p><input type="checkbox"/> 360 Other Personal Injury</p>	<p>PERSONAL INJURY</p> <p><input type="checkbox"/> 363 Personal Injury - Med. Malpractice</p> <p><input type="checkbox"/> 365 Personal Injury - Product Liability</p> <p><input type="checkbox"/> 368 Asbestos Personal Injury Product Liability</p> <p>PERSONAL PROPERTY</p> <p><input type="checkbox"/> 370 Other Fraud</p> <p><input type="checkbox"/> 371 Torts in Lending</p> <p><input type="checkbox"/> 380 Other Personal Property Damage</p> <p><input type="checkbox"/> 385 Property Damage Product Liability</p>	<p>WARRANTY/PENALTY</p> <p><input type="checkbox"/> 610 Agriculture</p> <p><input type="checkbox"/> 620 Other Food & Drug</p> <p><input type="checkbox"/> 625 Drug Related Seizure of Property 21 USC 881</p> <p><input type="checkbox"/> 630 Liquor Laws</p> <p><input type="checkbox"/> 640 R.R. & Truck</p> <p><input type="checkbox"/> 650 Airline Regs.</p> <p><input type="checkbox"/> 660 Occupational Safety/Health</p> <p><input type="checkbox"/> 690 Other</p> <p>LABOR</p> <p><input type="checkbox"/> 710 Fair Labor Standards Act</p> <p><input type="checkbox"/> 720 Labor/Mgmt. Relations</p> <p><input type="checkbox"/> 730 Labor/Mgmt. Reporting & Disclosure Act</p> <p><input type="checkbox"/> 740 Railway Labor Act</p> <p><input type="checkbox"/> 790 Other Labor Litigation</p> <p><input checked="" type="checkbox"/> 791 Empl. Res. Inc. Security Act</p>	<p>BANKRUPTCY</p> <p><input type="checkbox"/> 422 Appeal 28 USC 158</p> <p><input type="checkbox"/> 423 Withdrawal 28 USC 157</p> <p>PROPERTY RIGHTS</p> <p><input type="checkbox"/> 820 Copyrights</p> <p><input checked="" type="checkbox"/> 830 Patent</p> <p><input type="checkbox"/> 840 Trademark</p> <p>SOCIAL SECURITY</p> <p><input type="checkbox"/> 861 HIA (1395ff)</p> <p><input type="checkbox"/> 862 DI Act (1922)</p> <p><input type="checkbox"/> 865 DIWC/DIWW (405(g))</p> <p><input type="checkbox"/> 864 SSID Title XVI</p> <p><input type="checkbox"/> 865 RSI (405(g))</p> <p>FEDERAL TAX SUITS</p> <p><input type="checkbox"/> 870 Taxes (U.S. Plaintiff or Defendant)</p> <p><input type="checkbox"/> 871 IRS—Third Party 26 USC 7609</p>	<p>OTHER STATUTES</p> <p><input type="checkbox"/> 400 State Reapportionment</p> <p><input type="checkbox"/> 410 Arbitration</p> <p><input type="checkbox"/> 430 Banks and Banking</p> <p><input type="checkbox"/> 450 Consumer</p> <p><input type="checkbox"/> 460 Depositions</p> <p><input type="checkbox"/> 470 Nuclear Infracture and Compact Organizations</p> <p><input type="checkbox"/> 480 Consumer Credit</p> <p><input type="checkbox"/> 490 Cable/Sat. TV</p> <p><input type="checkbox"/> 810 Selective Service</p> <p><input type="checkbox"/> 850 Securities Commodities/Exchange</p> <p><input type="checkbox"/> 875 Customer Challenge 12 USC 3410</p> <p><input type="checkbox"/> 890 Other Statutory Actions</p> <p><input type="checkbox"/> 891 Agricultural Acts</p> <p><input type="checkbox"/> 892 Economic Stabilization Act</p> <p><input type="checkbox"/> 893 Environmental Matters</p> <p><input type="checkbox"/> 894 Energy Allocation Act</p> <p><input type="checkbox"/> 895 Freedom of Information Act</p> <p><input type="checkbox"/> 900 Appeal of Fee Determination Under Equal Access to Justice</p> <p><input type="checkbox"/> 950 Constitutionality of State Statutes</p>
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V. ORIGIN (Place an "X" in One Box Only)

1 Original Proceeding

2 Removed from State Court

3 Remanded from Appellate Court

4 Reinstated or Reopened

5 Transferred from another district (specify)

6 Multidistrict Litigation

7 Appeal to District Judge from Magistrate Judgment

VI. CAUSE OF ACTION

Cite the U.S. Civil Statute under which you are filing. (Do not cite jurisdictional statutes unless diversity):

28 U.S.C. §§ 1331 and 1332(a)

Brief description of cause: Patent Infringement

VII. REQUESTED IN COMPLAINT:

CHECK IF THIS IS A CLASS ACTION UNDER F.R.C.P. 23

DEMAND \$ _____

CHECK YES only if demanded in complaint: JURY DEMAND: Yes No

VIII. RELATED CASE(S) IF ANY (See instruction 6)

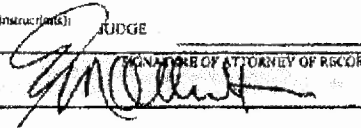
JUDGE _____ DOCKET NUMBER _____

DATE: 10/15/2007

TOR OFFICE USE ONLY

RECEIPT # _____ AMOUNT _____ APPLYING IFP _____ JUDGE _____ MAG. JUDGE _____

SIGNATURE OF ATTORNEY OF RECORD



CISCO.000087

EXHIBIT D



Oct 16, 2007

Patent Office Has Stopped Examining Patents with 25+ Claims

Those of you following your docket through the PTO's PAIR system may note that the Office has begun its 'identification process' of unexamined patents with either (1) more than 25 claims issued or (2) more than 5 independent claims. The docket report shows:

- **Entry:** Flagged for 5/25
- **Status:** "Request for SIR -- Recorded" or "Preexam Flag for 1.75(b) Issues"

According to a telephone conversation with the Office of the Commissioner for Patents, these cases have been pulled from Examiner dockets because they exceed the 5/25 limit and are thus far unexamined. We will be able to do a retrospective in Mid-November to estimate the number of cases impacted by this pre-rule activity. Of course, this appears to be a *de facto* implementation of the new rules prior to the stated November 1 effective date.

- For an example, look at the PAIR data for App. No. 20060294241.
- Thanks to James McEwen and Randall Svihla alerting me to this issue.
- This alert will help many practitioners ensure that they have found all their cases that exceed the new limits. Many attorneys keep no specific records of the number of claims filed. For published cases, Derwent keeps track of the number of claims.
- UPDATE 10/17/07 — App. No. 20060294241 referenced above is no longer 'flagged.'

In other news:

- CAFC Docket: The CAFC heard 13% fewer cases in FY2007 — freeing their docket for additional BPAI appeals. [LINK]
- Preemptive Strike: In another preemptive strike, on October 15th, ESN sued Cisco for infringing Patent No. 7,283,519. Unfortunately, the patent did not issue until the 16th of October. [Link]

Posted by Dennis Crouch | [Permalink](#)

Comments

"Of course, this appears to be a de facto implementation of the new rules prior to the stated November 1 effective date."

Appears to be? What a convenient way to make sure that these applications do not get a first office action prior to November 1st. Hopefully the folks at Kirkland & Ellis can include this *** when they argue for the preliminary injunction.

Posted by: metoo | Oct 16, 2007 at 03:08 PM

I guess this means those silly notices are coming. Why in the world couldn't they just wait for the first RR in the case to complain?

Posted by: me | Oct 16, 2007 at 03:22 PM

Kirkland and Ellis? I hope so too, but the Tafas case supported by Kelley Drye & Warren against the USPTO was the most timely and energetic, preceeding the Kirkland action by almost two months. What took so long? And where is everyone else in this effort to stop a run-away train?

If you review the two actions, you will see that many counts in the Kirkland brief read closely on the Tafas action.

Let's get going before it is too late!!!

Posted by: jwin | Oct 16, 2007 at 04:13 PM

I think bunches of folks are just hoping these go away, but if they don't a bunch of stuff might make it out of the Appeal Board to the Fed. Cir.

Posted by: me | Oct 16, 2007 at 04:23 PM

The Tafas action waived the request for a PI didn't it? Why in the world would they do that? They should re-request the PI with all these changes to the new rules and FAQ's showing that not even the PTO understands them, so how can they be implemented.

Posted by: me | Oct 16, 2007 at 04:24 PM

Interesting; just posted a long reply at <http://emgill.blogspot.com/>

Thanks for the news.

Posted by: Erin-Michael Gill | Oct 16, 2007 at 04:29 PM

Fun fun fun. I filed an app for a client with well over 25 claims almost 4 years ago (not a business method/software app either). No fewer than 6 examiner changes later, with a search done at the beginning of last year, to date no action from the PTO.

I am sure that the PTO efficiency on this app will increase once those claims get whittled down to 25...

Posted by: zed | Oct 16, 2007 at 04:33 PM

So that's what happened to the case I had on my docket that was a CIP of the case I just sent out a first action on... Damn, I was all set to get an easy count since half the claims were covered by the prior art I already had, now I have to wait for it to come back to me... Hmm... if I pull the case up it still shows my name on it as the examiner, I wonder what will happen if I send out a first action on it anyway?

Posted by: MM | Oct 16, 2007 at 04:41 PM

In thinking about this latest outrageous aspect of the "news rules" situation along with the court actions filed to enjoin enforcement, I have been wondering two more fundamental things. First, what is the basis of the "problem" (backlog) the USPTO is trying to solve? Second, what is the best venue for crafting a true solution to this supposed problem (i.e., a solution that does not destroy American innovation just so examiners can have most Fridays off)?

As to the first question, my colleagues and I think the basis of the backlog is the USPTO's unreasonable restriction practice. In trying to drum up more filing fees the Office started restricting to a ridiculous degree and now it has come back to bite the Office in the... you know. A unity of invention practice more in line with Europe's would solve this problem much better than the new rules.

As to the second question, I fear the only option is the slow, expensive crawl of legislation since the USPTO seems enamored with the new rules it doesn't understand itself.

Just a grass-roots thought.

Posted by: bruinjack | Oct 16, 2007 at 04:56 PM

I can fix it. I know the right people. The first year, I would only take a salary to pay the mortgage and bills on my house (I'll get the examiners to feed me because I will be meeting with different groups of them often and ask them to bring apples and other stuff). Make me the Czar (a new position above director and commissioner), complete with sword and tall furry hat. I

CISCO.00002

can do it. It would be an honor.

Posted by: johng | Oct 16, 2007 at 05:13 PM

Johng, why not just dust off your old stamp (assuming you had one) and fall back into the fold? I'm sure you they wouldn't flog you for a week or two just to show you how much they appreciate you going back. They might even pay you a little more than your mortgage and house bills.
...or is it that you really want the furry hat?

Posted by: anon | Oct 16, 2007 at 05:52 PM

Dennis: Do you know whether, by pulling these applications from the examiners' dockets, that these applications will lose their place in line?

Posted by: anonymous | Oct 16, 2007 at 06:21 PM

the furry hat :)

Posted by: johng | Oct 16, 2007 at 06:46 PM

Today they took all of the cases with more than 25 claims off of my docket. The SPE said they will be assigned to a pool temporarily, and then reassigned when the applicants respond to the postcards with the claims they want to keep. The elected restrictions with more than 25 claims awaiting first actions are still on my "regular amended" docket and the continuations with more than 25 claims awaiting first actions are still on my "special new" docket, although theoretically these are subject to the 5/25 rule as well. Whatever...

Posted by: Dave | Oct 16, 2007 at 09:26 PM

As this Kafka-esque experience continues to unfold, the open road starts to sound better all the time: <http://www.drivebigtrucks.com/>

Posted by: C. Springer | Oct 16, 2007 at 09:28 PM

Thanks for the notice...yup, they pulled one of mine, too...which my examiner had a good shot of getting to before 11/1.

Time travel (ie speeding things up) is evidently not a problem for PTO management...when it suits them.

Just one more way of saying "go to h*ll" to us pro se folks.

Damn these people.

Posted by: Steve | Oct 16, 2007 at 11:25 PM

I've just gone through my US docket. Two of my cases have been pulled and now show status as "Preexam Flag for 1.75(b) Issues". (Each has 3 independents and 26-30 total claims.) I have two more that break the 5/25 rule but haven't yet been yanked ... although I'm expecting that to change any day now.

Posted by: CliveFenster | Oct 16, 2007 at 11:33 PM

BTW, my two have been pending for 1.5-2.5 years in TC1700. Based on past experience, the young one was on the brink of an Action, and I'm surprised the older one hadn't already gotten one.

At least I can just drop a claim and get it rolling again. I plan to phone the Examiner tomorrow, and will report back if a flagged application loses its place in the queue.

Posted by: CliveFenster | Oct 16, 2007 at 11:36 PM

It wouldn't matter whether a practitioner kept records of number of independent and dependent claims filed. Rule 37 CFR 1.75(b)(2) recharacterizes certain previously "dependent" claims as "independent." For each case, the number of independent claims will need to be re-counted. A colleague of mine is developing some software to automate the task of re-counting, by flagging those previously-dependent-for-fee-purpose claims that would be recharacterized by the new regs. If interested in seeing a beta copy, send email to information@eliman.com.

Posted by: Gerry Elman | Oct 17, 2007 at 07:24 AM

Roughly 30% of the cases I have pending have been flagged (I use partridge to monitor the status our apps). That differs significantly from the patent office's estimate that less than 10% of the applications will be affected.

Anyone else have such a high number flagged?

Posted by: Antonio | Oct 17, 2007 at 09:33 AM

I have a question for all of you smart folks - I think it's actually related, as well. What impact is the 5/25 rule going to have on patent term adjustment? If I have a pending case as of Nov. 1 with more than 25 claims, am I failing "to engage in reasonable efforts to conclude prosecution" as of November 1? (Quoting 37 CFR 1.704.) Does any PTA get reduced by the number of days from Nov. 1 until the claim count is reduced or an ESD is filed? Or by the number of days from mailing of a notice of non-compliance until I reduce the claim count?

Thoughts?

Posted by: joe frank | Oct 17, 2007 at 09:55 AM

Gerry, for my pending US spreadsheet: I withstood the tedium of re-counting my independents based on the new way of categorizing them.

Posted by: CliveFenster | Oct 17, 2007 at 10:17 AM

"Does any PTA get reduced by the number of days from Nov. 1 until the claim count is reduced or an ESD is filed? Or by the number of days from mailing of a notice of non-compliance until I reduce the claim count?"

Thoughts?"

Apparently new Rule 704(c)(11) only applies to cases filed on or after Nov. 1. From FR 46716:

"The changes to 37 CFR 1.78(a), 1.78(d)(1), 1.495 and 1.704(c)(11) are applicable only to any application, including any continuing application, filed under 35 U.S.C. 111(a) on or after November 1, 2007, or any application entering the national stage after compliance with 35 U.S.C. 371 on or after November 1, 2007."

For cases filed on or after Nov. 1, it appears that all you need to do is file an SRR in compliance with Rule 142 when you file your application containing more than 5/25 claims and you will completely avoid the penalties of new Rule 704(c)(11), regardless of whether the Examiner accepts it or not. (This is question 20 of the NIPRA quiz linked at <http://www.nipra.org/action.html>. Talk about arbitrary and capricious.)

New Rule 704(c)(11) says:

(11) Failure to comply with § 1.75(b), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is the later of the filing date of the amendment resulting in the non-compliance with § 1.75(b), or four months from the filing date of the application in an application under 35 U.S.C. 111(a) or from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in an application which entered the national stage from an international application after compliance with 35 U.S.C. 371, and ending on the date that an examination support document in compliance with § 1.265, an election in reply to a requirement under § 1.142(a), 1.146 or 1.499 resulting in compliance with § 1.75(b), an amendment resulting in compliance with § 1.75(b), or a suggested restriction requirement in compliance with § 1.142(c), was filed;

Note that Rule 75(b) can sneak up on you if you have previously filed related cases (with claims the USPTO will consider indistinct), so filing an SRR even in cases that don't exceed 5/25 themselves may be advisable to defang Rule 704.

Posted by: real anonymous | Oct 17, 2007 at 10:29 AM

David French writes:

"...what is the basis of the "problem" (backlog) the USPTO is trying to solve? Second, what is the best venue for crafting a true solution to this supposed problem (i.e., a solution that does not destroy American Innovation just so examiners can have most Fridays off)?"

The central "problem" is that the examination staff is not processing applications fast enough to keep up. I imagine if you ask the examiners why this is true, they will complain about two things: 1) too many claims in patent applications, and 2) too many citations of prior art. Management has seized on the issue of "too many applications" blaming continuation practice.

I have had examiners complained to me about the number of claims in other applications they are reviewing. I have also seen patents, e.g. a snowstop rail for a roof edge, with over 60 claims six or seven of which were independent. It doesn't take much thought to realize that such patents, once asserted, can be leveraged into an early settlement because of the substantial costs of making even an initial analysis.

Regarding the citation of prior art, we have all seen patents with seemingly endless strings of references. Such patents are also well-positioned to precipitate early settlement discussions. And the filing attorneys know this.

Harry Moatz's concerns reviewed in the Patently-O blog of October 15, 2007 that "Attorneys and agents have a duty of inquiry to ensure that all assertions made to the office must be "legally warranted" and not made for an "improper purpose." and "Practitioners must read each and every paper submitted to the office in its entirety" may understandably have arisen from examiner objections to the number of prior art references being poured into the record by applicants.

The solution? While not a perfect solution, the USPTO should seriously investigate implementing a system of deferred examination.

Not everyone wants a patent to be granted promptly. Many agents and attorneys want to see patents prosecuted because this is how they make their living. But many applicants in the-know would probably elect to have examination of their applications deferred until they find out whether the technology is going to go anywhere.

There are other possible approaches to dealing with excessive claims and excessive prior art citations, but these can be reviewed on a later occasion.

Posted by: [David J. French](#) | [Oct 17, 2007 at 10:53 AM](#)

True deferred examination would be a plus for all, particularly in light of the coming "first to file" system which will drive early filings where the client is unsure of the technologies utility or place in the market.

Posted by: [me](#) | [Oct 17, 2007 at 11:11 AM](#)

Fit of paranoia here. If I decide to preemptively (well before any FAOM) cancel a small handful of less important dependent claims to get back inside the 5/25 box and not lose my place in the queue ... would those cancellations be construed as having been made for reasons relating to patentability?

Posted by: [CliveFenster](#) | [Oct 17, 2007 at 11:13 AM](#)

One of mine has been flagged as well. The "First Office Action" prediction tab in private PAIR has also disappeared

Posted by: [Mark Nowotarski](#) | [Oct 17, 2007 at 11:18 AM](#)

Thanks, real anonymous.

So, it appears that Rule 704 doesn't expressly address the situation where I have a case filed before Nov. 1 with more than 5/25 claims (and which hasn't received an action on the merits). It's interesting that the rule gives a 4-month grace period for new applications. Can we assume that there's a 4-month grace period for existing applications, or do we assume the worst - that I'm forfeiting PTA day-for-day if I delay filing an amendment beyond Nov. 1? Am I right that there's nothing in the rules or statutes to govern this situation other than the general Rule 704 requirement that I engage in "reasonable efforts" to advance prosecution.

You raised another issue that makes me nervous as well. I'm already concerned about the "indistinct claims" weapon that the new rules have created. Are you suggesting that if an Examiner makes an unfounded assertion that my client's two applications include indistinct claims, then I immediately start forfeiting PTA? Wow... Your suggested remedy, filing a SRR in every case, is interesting, as it would indeed seem to eliminate the PTA reduction of 704(c)(11). But that's crazy...

Posted by: [JoeFrank](#) | [Oct 17, 2007 at 11:24 AM](#)

CliveFenster wrote, "I plan to phone the Examiner tomorrow, and will report back if a flagged application loses its place in the queue."

Did you get an answer?

Posted by: [anonymous](#) | [Oct 17, 2007 at 11:35 AM](#)

JoeFrank, I think new Rule 704(c)(11) does not apply to your pending case (see the applicable date in the FR notice). Old Rule 704(c)(11) applies instead which deals with continuations, not ESDs/claim limits.

I think they made a mistake and called the new rule (c)(11) when they might have meant (c)(12). If they really do eliminate old (c)(11), you may be able to file continuations and keep your accrued PTAs from parent cases, but I'm not sure.

Posted by: [real anonymous](#) | [Oct 17, 2007 at 11:42 AM](#)

For the applications that have been pulled -- you will not "lose your place in the backlog"!!!! Everyone seems to be freaking out about this, but if you understood Examiner's workflow and how dockets are managed at the Office you wouldn't be in such a tizzy. As soon as the 5/25 requirements have been met, the application will be placed back on the Examiner's docket.

Examiner's docket's list "regular new" cases and "special new" cases in chronological order and Examiners earn workflow credits for completing an "oldest new" application each bi-week. Therefore, when each application is placed back on the Examiner's docket it is placed right back in the same order as it was pulled from.

Example: You filed your application on 01/01/05. As of 10/01/07 it was the third case down on my docket list of new cases and on 10/15/07 it was pulled for not complying with the 5/25 rule. Applicant promptly takes care of the issue on 12/15/2007 and the case is placed back on my docket as the FIRST or SECOND case listed in my list of new cases, depending of course, if I've completed the other two cases that were before it on my list before the pull date in October.

Every body take a deep breath and chill.

Posted by: [Jessica](#) | [Oct 17, 2007 at 12:10 PM](#)

Anonymous: the (unofficial) response I got matches what Jessica said.

Posted by: [CliveFenster](#) | [Oct 17, 2007 at 12:16 PM](#)

I think things are getting a bit out of control here. I authorized an Examiner a week ago regarding a restriction requirement and elected a group that reduced the number of claims to less than 25. The case was pulled from the Examiner- he does not have access to it anymore.

Posted by: [JN](#) | [Oct 17, 2007 at 12:33 PM](#)

All should file an interpleader action and join GSK on this point alone. Remember that patent term is measured from the priority. Any extra time required to satisfy the 5/25 threshold reduces the term. Please note that they have defacto and ex post facto reduced the term of the patent. In short, the USPTO can use this entire situation to make their backlog look good because for each response to the 1.75(b) notice the upwardly adjustment is downwardly reduced. Taken over 100,000s of patent applications this can be centuries of time . . . time that the USPTO can now not be embarrassed by because of this new trickery to reduce the upward adjustment. This is a taking pure and simple. Just imagine the value of the upwardly term adjustment taken by the USPTO over the totality of patent applications effected. I could approach a trillion dollars. In effect, the USPTO is in the process of eviscerating billions of dollars of tax money that would rightly have to be paid were the upwardly adjustment not reduced by the 1.78 showing.

Is everyone now seeing how efficiency is improved . . . real efficiency is not improved only the appearance of inefficiency . . . inefficiency that would be manifest were the USPTO not allowed to reduce the upwardly PTA by this new chess rule. Personally, I would like the entire world to see the level of efficiency of the Bush controlled USPTO.

You want to know how insidious I believe this is . . . I think there should be investigated whether the upper management of the USPTO deliberately destroyed the efficiency of the USPTO and is now trying to cover-up the inefficiency.

Posted by: [fromthedarkplaces](#) | [Oct 17, 2007 at 01:07 PM](#)

I generally keep within the 20/3, but sometimes clients want extra claims. Occasionally, it has even been justified by the nature of the invention.

If I file a preliminary amendment in cases with lots of claims and cancel excess claims, can I get a refund of the extra claim fees? If so, how?

Posted by: [Dr. Michael Factor](#) | [Oct 17, 2007 at 01:14 PM](#)

I doubt it Dr. Factor. They never refund money after a restriction or when you cancel by way of a preliminary amendment not filed with the application. Consider it another "takings" by the PTO.

Posted by: [johnj](#) | [Oct 17, 2007 at 01:43 PM](#)

Check out Rule 1.26, Refunds, and 1.117, Refund due to cancellation of claim. I'm slogging through them now. Little consolation for my clients that the refunded fees mostly likely will not even cover my fees for the preliminary amendment.

Posted by: [Tom Kulaga](#) | [Oct 17, 2007 at 01:53 PM](#)

It looks like the 5/25 flag has been withdrawn from that application now. Any idea what's up?

Posted by: [PJ](#) | [Oct 17, 2007 at 02:02 PM](#)

The other day, I talked by telephone to an examiner who has misunderstood the new rules and has stopped working on ALL applications that have more than 25 claims, even applications that already have a final rejection.

Posted by: [Monster Movie](#) | [Oct 17, 2007 at 02:03 PM](#)

Tom is right. I was not aware of this newly proposed rule directed specifically to this situation. See pages 46739-46740 of the FR.

Posted by: [johnj](#) | [Oct 17, 2007 at 02:20 PM](#)

Dr. Factor,

I spoke with someone at the Office of Patent Legal Administration earlier today and she indicated that the provisions of the Consolidated Appropriations Act 2005 have been extended (see HJ Res. 52 Sec 117). Interestingly, the extension appears to expire on Nov. 16, 2007. At least until that time you should be able to request a refund for excess claims fees paid on or after Dec. 8, 2004 (under 1.117(a)), as long as the refund request is filed within two months of canceling the claims. I just finished drafting a refund request letter.

Posted by: [NorthoftheBorder](#) | [Oct 17, 2007 at 02:24 PM](#)

CliveFenster wrote:

"If I decide to preemptively (well before any FAOM) cancel a small handful of less important dependent claims to get back inside the 5/25 box and not lose my place in the queue ... would those cancellations be construed as having been made for reasons relating to patentability?"

We are including in a preliminary amendment 'Remarks' the following :

" Applicants have amended the claims to conform to the requirements of 37 C.F.R. § 1.75(b). "

Any comments?

Posted by: [Matt K.](#) | [Oct 17, 2007 at 02:25 PM](#)

In case you have not noticed the "flag" has been miraculously "unflagged" in published application 20060294241. I hope all flags will now be removed.

Posted by: [Abe Hershkovitz](#) | [Oct 17, 2007 at 02:32 PM](#)

woo hoo! the flags are gone! oh wait...I'm not really sure that should make anyone feel better

Posted by: [metoo](#) | [Oct 17, 2007 at 02:36 PM](#)

Matt & Clive,

"... would those cancellations be construed as having been made for reasons relating to patentability?"

If you're only cancelling dependent claims to get within the 5/25 limit, I can't imagine how this could be construed as "relating to patentability." In any case, if we're worried about estoppel under Festo, I believe that Festo is about narrowing amendments. It's possible that canceling a parent claim can be construed as a narrowing amendment, but it would be difficult for the cancellation of a minor dependent claim to be narrowing.

Posted by: [joe frank](#) | [Oct 17, 2007 at 02:41 PM](#)

Matt K, my plan was to not state that the claims were being canceled to place the application in conformance with Rule 75. Rather, I thought I'd just write that claims X-Y were canceled without prejudice to their introduction into the present or other application.

Yeah, I could you could get me to admit in a deposition that I was motivated by the 5/25 rule. But at least equally, I reviewed at the claims (prompted by the pending 5/25 rule) with a critical eye, looking to see if I really needed every claim I'd initially filed and whether canceling some might make the Examiner's job a little easier (a self-serving result for me).

Posted by: [CliveFenster](#) | [Oct 17, 2007 at 02:45 PM](#)

That's "I "guess" you could get me ..."

Ooops.

Posted by: [CliveFenster](#) | [Oct 17, 2007 at 02:48 PM](#)

I have an application that's available through Public PAIR, 10/405,149, filed April 2, 2003, in which I noticed this "flagged" status this morning.

As for an applicant's right to file patently "indistinct" claims, unless claims are of "identical" scope, the PTO's only recourse is to issue an obviousness-type double patenting rejection if the patently indistinct claims are in different applications or patents, which can be overcome by a terminal disclaimer.

Further, having paid the additional claims fees mandated by statute, and the PTO having accepted those fees, it cannot, in any event, refuse to examine claims it previously agreed to examine; the PTO's additional claims fee structure, by statute, compensates the PTO for the additional workload.

Finally, earlier today, the District Court in Alexandria, Virginia, affirmed that the preliminary injunction hearing on GlaxoSmithKline's motion for a TRO/preliminary injunction will be held, as scheduled, on October 26th. The PTO had first agreed to this hearing date, but, after seeing GSK's arguments, wanted a delay, apparently unable to defend the legal validity of its own Rules. More specifically, the DOJ complained that it was overwhelmed by the papers filed by GSK, a private party. As it is, the Rule changes were deliberately written, in 129-page maze in the Federal Register, in a manner that made it difficult for any sane person to understand and thereby challenge. With the PTO's "flagged" status today, it would seem that most patent attorneys now have at least one client with "standing" to challenge at least a portion of the Rule changes.

I would be very surprised if the PTO's Rule changes actually went into effect November 1, 2007, notwithstanding the arrogant pronouncement on its home page that the Rule changes for continuations and claims "will take effect" on November 1. I expect that either the District Court or CAFC will act to prevent the train from being wrecked!

Posted by: [Edwin D. Schindler](#) | [Oct 17, 2007 at 02:56 PM](#)

My "flags" are all still very firmly in place. The Office seems to be flagging those applications with a first office action likely in the next few months (such as my cases for which an action was previously predicted in 1-3 months). Interestingly, my case with a first action predicted in 97 months has not been flagged!!

Posted by: [NorthoftheBorder](#) | [Oct 17, 2007 at 02:59 PM](#)

You mean they only removed the flag from the one posted above? Ha ha ha. How Bush-league!

Posted by: [wiseguy](#) | [Oct 17, 2007 at 03:23 PM](#)

Am I correct in assuming that Festo was the beginning of the end our U.S. patent system as we knew it back then? Hindsight is 20/20 - that's when we should have started to fight back. Under our Constitution, changes of the Festo nature and beyond can only properly come about as a result of legislation, or am I missing something?

Excerpts below from this link:

<http://scientific.thomson.com/free/ipmatters/iplr/8179973/>

"Festo under the spotlight

Festo was a case that held the attention of a constituency comprising not only lawyers but also boardrooms, investors and analysts across the entire world. The fact was that anyone who owned a US patent or had invested in a company that owned a US patent needed to know about Festo and its possible implications.

In Festo, the Supreme Court was asked to decide whether to uphold the ruling of the US's specialist patent court - the Court of Appeals for the Federal Circuit (CAFC) - that the scope for patent owners to allege infringement of their rights under the doctrine of equivalents should be significantly reduced."

<>

The question for today is: "How long will the U.S. exist as we know it?"

I am thinking 2011...

unless we demand Impeachment before it is too late, or unless Mike Bloomberg is elected.

Best regards,

Posted by: Just an ordinary inventor(TM) | [Oct 17, 2007 at 03:39 PM](#)

Edwin D. Schindler -- your comments, which I have copied below, make sense to me. Does anyone disagree???

--As for an applicant's right to file patently "indistinct" claims, unless claims are of "identical" scope, the PTO's only recourse is to issue an obviousness-type double patenting rejection if the patently indistinct claims are in different applications or patents, which can be overcome by a terminal disclaimer.

Further, having paid the additional claims fees mandated by statute, and the PTO having accepted those fees, it cannot, in any event, refuse to examine claims it previously agreed to examine; the PTO's additional claims fee structure, by statute, compensates the PTO for the additional workload. --

Posted by: Curious | [Oct 17, 2007 at 03:34 PM](#)

On an unrelated note, in Pub. No. 20060294241 (the one for which the flag was mysteriously removed), I wonder if the attorney read every page of the references submitted with the IDS - they appear to total about 1500 pages (for the 3 references)

Posted by: metoo | [Oct 17, 2007 at 03:38 PM](#)

"Supreme Court was asked to decide whether to uphold the ruling of the US's specialist patent court - the Court of Appeals for the Federal Circuit (CAFC) - that the scope for patent owners to allege infringement of their rights under the doctrine of equivalents should be significantly reduced."

The question for today is: "How long will the U.S. exist as we know it?" I am thinking 2011...unless we demand Impeachment before it is too late, or unless Mike Bloomberg is elected."

It's already too late. The SCOTUS has already been packed, damage done.

Posted by: bierbelly | [Oct 17, 2007 at 03:51 PM](#)

And just as soon as the flags appeared, they were withdrawn and the cases were put right back in my docket as if nothing happened, with PALM code W525 "WITHDRAW FLAGGED FOR 5/25". Weird.

Posted by: examiner | [Oct 17, 2007 at 03:57 PM](#)

Dear bierbelly,

"It's already too late. The SCOTUS has already been packed, damage done."

Cannot one or more of Supreme be impeached?

manhattanbelly,

a/k/a

Posted by: Just an ordinary inventor(TM) | [Oct 17, 2007 at 04:01 PM](#)

"Am I correct in assuming that Festo was the beginning of the end our U.S. patent system as we knew it back then?"

No. Markman and Festo were the beginnings of a robust patent system that wasn't a complete joke.

Posted by: Malcolm Mooney | [Oct 17, 2007 at 04:05 PM](#)

They sure can be impeached - and the frequency with which Supreme Court justices have been impeached is indicative of the likelihood of it happening any time soon. In other words, ROFL - good luck!

Posted by: metoo | [Oct 17, 2007 at 04:08 PM](#)

"In case you have not noticed the "flag" has been miraculously "unflagged" in published application 20060294241. I hope all flags will now be removed"

It was removed, because of my earlier post. It is evidence of which judicial notice may be taken that would support GSK's takings argument. See my post above.

Posted by: fromthedarkplaces | [Oct 17, 2007 at 04:09 PM](#)

My flags are gone too. First office action predictions are back up.

Posted by: [Mark Nowgatski](#) | [Oct 17, 2007 at 04:12 PM](#)

Hello Malcolm,

Thanks for your comment. I always enjoy your jokes.

PS: I guess we know where your bread is buttered.

Posted by: Just an ordinary inventor(TM) | [Oct 17, 2007 at 04:18 PM](#)

I would be interested to know the first office prediction for some of the applications that have had the flags removed. Mine have not changed.

Posted by: NorthoftheBorder | [Oct 17, 2007 at 04:19 PM](#)

PREDICTION. The USPTO will be CRUSHED by GSK. I don't even think it will be close. I just hope the courts ruling does not totally eviscerate the executive agencies' powers. I mean Judge Hillon is a Reagan appointee. Remember Ronnie's quotes "I want to abolish the department of energy and education." Not a real friendly guy to executive agencies. Well Judge Hillon, I hope that you remember the defender of freedom and the man who defeated communism without firing too many shots when you make your ruling.

Posted by: fromthedarkplaces | [Oct 17, 2007 at 04:21 PM](#)

Dear metoo,

"They sure can be impeached - and the frequency with which Supreme Court justices have been impeached is indicative of the likelihood of it happening any time soon. In other words, ROFL - good luck!"

Maybe if we lope off just one head (via impeachment), the rest will catch the drift? One step at a time is better than standing still for this affront.

PS: I'm a little new to this, what is ROFL?

Posted by: Just an ordinary inventor(TM) | [Oct 17, 2007 at 04:27 PM](#)

Methinks that the USPTO proved Tafas and GSK's cases; a temporary taking is still a taking. Irreparable harm has already occurred. If you follow their actions, it is clear the USPTO is

scrambling; revised guidance, threats by OED, flagged and unflagged status within a day; OMB criticism about planning. All we need is a sex scandal and the who situation will be worthy of a movie script.

Posted by: X-Solo | Oct 17, 2007 at 04:28 PM

ROPL = rolling on the floor laughing...and my apologies for using it, as I did not intend it as a personal criticism.

As for impeachment, it has happened only once in US history - Samuel Chase was impeached by the House, but acquitted by the Senate (and therefore remained on the bench).

Posted by: metoo | Oct 17, 2007 at 04:34 PM

Oh boy this is great!

Posted by: Kent Dorfman | Oct 17, 2007 at 04:38 PM

I have a case whose status states "Non Final Action Counted, Not Yet Mailed" where the non final action was written 4 days prior to the mysterious 5/25 flag appeared (10/12 vs/ 10/16). I will surely be monitoring this one.

Posted by: Reno | Oct 17, 2007 at 04:45 PM

Dear metoo,

Thank you for your kind comment and edification.

Well then, we have the rare opportunity to make history. I don't mean to only joke -- Something Must Be Done!, before we all go to hell in a hen basket or worse. I'm only an ordinary inventor, I cannot do it alone. It will take a team effort. R U with me on this 4 COL...

Posted by: Just an ordinary inventor(TM) | Oct 17, 2007 at 04:49 PM

Some tidbits from briefing in the GSK lawsuit.

From the PTO's unsuccessful request (i.e., whining) to delay the hearing on the PI motion:

"Plaintiffs left the USPTO with merely eight (8) days to file their opposition to the motion, even though (1) the Final Rules implicate extremely complex issues of patent prosecution procedure; (2) the Motion contains hundreds' of pages of exhibits, including an extra legal brief masquerading as an exhibit; and (3) the Motion requires the USPTO to investigate highly technical patent applications in order to assess the validity of Plaintiffs' allegations of "irreparable harm," standing, and ripeness."

GSK's response:

"the Defendants already understand the "extremely complex issues of patent prosecution procedure" implicated by the Final Rules—they wrote them."

and

"The Defendants apparently did not mind that these new rules, which exceed their rulemaking authority, will retroactively affect thousands of pending patent applications, or that they force applicants such as GSK to read, comprehend, and attempt to reorganize their business activities to comply with this sea-change in a mere two months. Thus, it strains credulity that the Defendants now argue that they do not have a sufficient amount of time to respond to an emergency challenge to these rules. In short, the Defendants' unreasonable effective date caused this situation. If Defendants require more time to respond, they should agree to postpone the effective date of the Final Rules."

and

"The Defendants give no cogent reason why they need more time, other than making the conclusory assertion that GSK's motion is "massive" (Docket # 17, Emergency Motion at 1). Most of that "mass" is actually the text of the Final Rules which the Defendants wrote and an exemplar patent (Docket # 14, Exhibit A; Docket # 15, Exhibit B-1)."

How pathetic.

Posted by: metoo | Oct 17, 2007 at 04:56 PM

Is Margaret Peterlin handling the case for the PTO?

Posted by: wiseguy | Oct 17, 2007 at 05:06 PM

USPTO whining:

"5. By noticing the hearing on their Motion for Friday, October 26, Plaintiffs left the USPTO with merely eight (8) days to file their opposition to the motion, even though (1) the Final Rules implicate extremely complex issues of patent prosecution procedure; (2) the Motion contains hundreds' of pages of exhibits, including an extra legal brief masquerading as an exhibit; and (3) the Motion requires the USPTO to investigate highly technical patent 2 applications in order to assess the validity of Plaintiffs' allegations of "irreparable harm," standing, and ripeness.

6. Pursuant to Local Civil Rule 7(F)(1), a party opposing a motion is entitled to eleven (11) days to respond to that motion. Federal Rule of Civil Procedure 6(e) augments that time by an additional three (3) days. Thus, under the applicable rules, the USPTO is entitled to fourteen (14) days -- or until October 29, 2007 -- to respond to Plaintiffs' Motion."

Can USPTO lawyers count?

"Friday, October 26" : "merely eight (8) days"

"[T]he USPTO is entitled to fourteen (14) days -- or until October 29, 2007"

What if they do this sort of counting with our claims??

Posted by: real anonymous | Oct 17, 2007 at 05:22 PM

If I may ... let me succinctly translate GSK's response to the USPTO's whining ... "tough Sh!t. You wrote this cr@p now deal with it."

Posted by: fromthedarkplaces | Oct 17, 2007 at 05:28 PM

"PS: I guess we know where your bread is buttered."

Yeah, it's buttered on the side of the average person that doesn't go around beating people over the head with crap patents. You know: the same side that 99% of Americans butter their bread.

You really are an "ordinary inventor", in the most literal sense of that term.

Posted by: Malcolm Mooney | Oct 17, 2007 at 05:29 PM

One more thing, Mr. Ordinary: I think the new rules stink and I hope that GSK's suit manages to delay their implementation for a long time, if not indefinitely.

On the other hand, the old rules were being abused to the detriment of every citizen except entitles so wealthy and legally well-armed that they are immune from harm in the practical sense.

Of course, the Reaganites and their neocon offspring would argue that what's good for those entities is good for every man, woman, and child in the US.

Not all of us are so braindead, thankfully.

Posted by: Malcolm Mooney | Oct 17, 2007 at 05:36 PM

Besides the PTO itself, is there anyone that has commented favorably on the new rules?

Posted by: metoo | Oct 17, 2007 at 05:48 PM

"What if they do this sort of counting with our claims??"

CISCO.000007

If I understand it properly, Local Rule 7 and FRCP 6 each measures in calendar days; USPTO was whining in business days.

Which means the difference between 26OCT and 29OCT is either six days, three days, or one day, depending on how you count.

Posted by: [Clive Fenster](#) | Oct 17, 2007 at 05:49 PM

Dear Malcolm,

"On the other hand, the old rules were being abused to the detriment of every citizen except entities so wealthy and legally well-armed that they are immune from harm in the practical sense."

Yes, to some limited extent I agree (surprised?), and the abuses under the old rules should have been and were being curtailed (as did, e.g., Fish & Neave in Nevada when they shutdown Lemelson).

That was the remedy all right, not the hyperBS that has been and is being foisted on us faithful practitioners of the legal arts and (in my case) the ordinary inventing arts.

Posted by: [Just an ordinary inventor\(TM\)](#) | Oct 17, 2007 at 05:50 PM

"Which means the difference between 26OCT and 29OCT is either six days, three days, or one day, depending on how you count."

Well, thank you for the clarification... I think. :-)

Posted by: [real anonymous](#) | Oct 17, 2007 at 05:53 PM

While I've been around too long to ever take anything for granted in litigation, particularly patent litigation, I am optimistic with respect to GSK's lawsuit (including the PI motion).

Hopefully, my gut feeling is correct. If so, I also wonder if the GSK case will eventually make it to this page: <http://www.vaed.uscourts.gov/notablecases/index.html> Now that would be a nice irony given the other cases currently listed

Posted by: [metoo](#) | Oct 17, 2007 at 06:12 PM

One last thing, Gene Quinn and John White over at PLI have put out a "call to arms" for those willing to join GSK in the good fight. Since many companies and firms are likely hesitant to put their name out front, Gene is suggesting that anyone with one or more arguments suitable for an amicus brief send the material to him ASAP. Even if you are unable to lend your name, you can help in the cause. Link to PLI's blog site: <http://www.pli.edu/patentcenter/default.asp>

Posted by: [metoo](#) | Oct 17, 2007 at 06:21 PM

Has anyone ever successfully sued the PTO to stop a set of rules from going into effect?

I don't think so.

And, so, I don't foresee that GSK will succeed where others failed.

Posted by: [George](#) | Oct 17, 2007 at 06:31 PM

I can understand the uproar by all of the outside patent attorneys over the new rules, but as an examiner I can tell you that we have been practicing our own version of the 5/25 rule for awhile -- i.e. if an examiner's docket is loaded with new cases (and in light of the production quota system), cases with over about 30 claims tend to sink to the bottom of an examiner's docket and stay there until their SPE is beating down the door for the Office Action (this doesn't happen much), or negative workflow starts to kick in, or there just aren't any other cases on the docket to work on. I'm sure the statistics on this (pendency versus the number of claims in a given application) would confirm my point.

Posted by: [anon examiner](#) | Oct 17, 2007 at 06:33 PM

"i.e. if an examiner's docket is loaded with new cases (and in light of the production quota system), cases with over about 30 claims tend to sink to the bottom of an examiner's docket and stay there until their SPE is beating down the door for the Office Action"

No surprises there! We can all relate.

Posted by: [Malcolm Mooney](#) | Oct 17, 2007 at 06:43 PM

anon examiner: "i.e. if an examiner's docket is loaded with new cases (and in light of the production quota system), cases with over about 30 claims tend to sink to the bottom of an examiner's docket and stay there until their SPE is beating down the door for the Office Action (this doesn't happen much),"

Has the PTO eliminated the "date case in the Art Unit" standard for moving cases that existed when I was there (admittedly a long time ago)?

Posted by: [Alan McDonald](#) | Oct 17, 2007 at 06:59 PM

I have 3 cases that now have the flag for 5/25 withdrawn -- I've reviewed the claims in each, and would be unsurprised to get a restriction in all of those. It may be that they're filtering them for restrictable claims.

Of the ones that the flag was NOT withdrawn, I notice that one says a FOAM was just mailed yesterday, the same day it was flagged.

Posted by: [Matt](#) | Oct 17, 2007 at 07:01 PM

"Has anyone ever successfully sued the PTO to stop a set of rules from going into effect?"

Interesting question. Has anyone every sued the PTO to stop a set of rules period?

Posted by: [Mark Nowotarski](#) | Oct 17, 2007 at 07:05 PM

"Besides the PTO itself, is there anyone that has commented favorably on the new rules?"

Intel commented favorably on the rules as they were originally proposed, along with others in the software electronics industry.

The DOJ also commented favorably.

Posted by: [Mark Nowotarski](#) | Oct 17, 2007 at 07:08 PM

NIPRA sued Rogan twice to make him follow AIPA (both suits were settled, one after Rogan was force to withdraw a presumably false "certification" he made to Congress). The filings (and settlement stipulations) from the suits are still posted at:

<http://www.nipra.org/index.htm>

Posted by: [real anonymous](#) | Oct 17, 2007 at 07:11 PM

Malcolm,

I am surprised you would defend Markman. Festo was overrated, but Markman essentially means claim interpretation is incomplete until the CAFC determination.

Claim interpretation is a matter of fact. And I would rather have a jury that may contain an engineer or two interpreting claim language than a judge with no technical background.

Posted by: [Lionel Hutz](#) | Oct 17, 2007 at 07:31 PM

"Claim interpretation is a matter of fact. And I would rather have a jury that may contain an engineer or two interpreting claim language than a judge with no technical background."

That's priceless, Lionel. You've outdone yourself.

For the most part, judges do a decent job on claim construction. That said, there is still a shocking number of them who "don't get it." Of course, that's not entirely their fault. Behind every crappy claim construction is an crappier brief written by attorneys who should probably be sanctioned for their misrepresentations of the law and facts.

Posted by: [Malcolm Mooney](#) | Oct 17, 2007 at 07:40 PM

Malcolm,

Based upon our past exchanges, I have no idea whether you are being sarcastic and if so, about what.

However, if your first sentence was genuine, then thanks, but I do not believe I said anything particularly profound.

Ideally, I would rather see every district court assigned a "patent" judge or judges that are technically trained. I would prefer my claims interpreted by such judges. However, for better or for worse, I do believe claim interpretation is primarily factual and if a party wants a jury, they should be able to have it.

Posted by: Lionel Hutz | Oct 17, 2007 at 07:49 PM

"Claim interpretation is a matter of fact. And I would rather have a jury that may contain an engineer or two interpreting claim language than a judge with no technical background."

To start with, no fewer than 5 of the current Federal Circuit judges have technical backgrounds, including 2 PhDs. Besides, if you're so worried about the court getting the claim construction wrong, then why don't you define the claim language in the specification as you're allowed to do so???

Posted by: anon | Oct 17, 2007 at 07:50 PM

I agree with Mr. Lionel in so much as claim interpretation should be a question of fact decided by a jury. However, the courts are mindful of the Doctrine of Jury Nullification which was incorporated to American jurisprudence vis-a-vis the 7th Amendment. Were claims interpreted by a jury, they could use the Doctrine of Jury Nullification to award affable patent holder and punish a recalcitrant patent holder. Could you imagine if the Doctrine of Jury Nullification was properly used in the Copyright infringement trial brought by RIAA?

Posted by: fromthedarkplaces | Oct 17, 2007 at 07:51 PM

Gentlemen, now really.... Examiners have simply stopped working on cases that had more than 25 claims some time ago. In fact, our SPEs told us to do so (as if we didn't already know). As far as the Zero Inventory Date cases, it's no bright line rule.

Lets see - I've got a docket of 120 cases (40 of which are new). I can easily get by without working on 10 new cases that have over 25 claims. Oh well.

I do have to say, however, that the PTO's actions have disturbed me here. I have some friends that were actually working on cases with over 25 claims (some of them EVEN COMPLETED, but not counted); but - these cases were pulled right out from our dockets!

I think that a VERY pertinent point was made above. If you file two cases with 20 claims each that are identical, the USPTO is required, by statute, to examine each case. I mean, besides the fact that 120 seems to confer a right of priority with the word "shall", 131 says that the director "shall" cause an examination to be made.

Posted by: anonexaminer | Oct 17, 2007 at 08:07 PM

Anyone with information/comments/case support, etc., which may be helpful to GlaxoSmithKline should direct their comments to GSK's lead counsel, John Desmarais at Kirkland & Ellis. Mr. Desmarais's e-mail is: jdesmarais@kirkland.com, as listed on Kirkland & Ellis's website.

I have e-mailed a few comments, case citations, etc., to Mr. Desmarais since Friday, and Mr. Desmarais seems pleased to receive any thoughtful suggestions that might be of assistance.

I find that Kirkland & Ellis is doing an excellent job on behalf of GSK and will ultimately CRUSH the PTO! The very fact that the DOJ, which represents the PTO, finds itself complaining about the burden of "electronic paper" sent its way by GSK speaks volumes of how GSK's case stacks up. Further, the PTO's decision to "pull" the 37 C.F.R. §1.75(b) "flags" seems to suggest that the PTO might now be on the defensive. It's arrogance is finally catching up with it!

Posted by: Edwin D. Schindler | Oct 17, 2007 at 09:33 PM

"If you file two cases with 20 claims each that are identical, the USPTO is required, by statute, to examine each case. I mean, besides the fact that 120 seems to confer a right of priority with the word "shall", 131 says that the director "shall" cause an examination to be made."

Not under the new rules

Posted by: metoo | Oct 17, 2007 at 09:56 PM

Today I had about twenty 25+ cases put back on my docket. Where are the other 10 that were taken off? ...I don't know. When I looked on PALM, it said "25+ withdrawn" for the cases that were put back. If there is a preliminary injunction forcing the PTO to put the 25+ cases back on the docket, I am not aware of it. The 25+ continuations on my "special new" docket and 25+ elected restrictions on my "regular amended" docket were never touched, even though they would have been subject to the new rules. Our SPE has sent no e-mail to clarify the situation.

Posted by: Dave | Oct 17, 2007 at 10:18 PM

I see from the Docket Sheet in the GSK v. Dudas action that Judge James C. Cachieris, the judge for the Tafas v. Dudas action, has entered an Order consolidating the two cases, which is not surprising, and has now re-scheduled the hearing on GSK's motion for preliminary injunction to the morning of October 31, 2007. The loser on the preliminary injunction motion will have to make a dash to the CAFC that afternoon.

Posted by: Edwin D. Schindler | Oct 17, 2007 at 10:18 PM

"Ideally, I would rather see every district court assigned a "patent" judge or judges that are technically trained. I would prefer my claims interpreted by such judges."

I would prefer that, too.

Posted by: Malcolm Mooney | Oct 17, 2007 at 10:19 PM

CRUSH THE PTO

I like the sound of that. I used to like them, despite the heartaches of prosecution. However, things change. This is now my plea to the gods. But please, spare the examiners.

Posted by: Matt Foley | Oct 17, 2007 at 10:26 PM

An oldie but a goodie:

One dark evening Jon Dudas was on his hands and knees under a street light looking through the grass.

A pedestrian asked what he was looking for.

"The keys to my car," said Jon.

Having some time and feeling helpful, the pedestrian joined Mr. Dudas in his search.

After a while, with no success, the pedestrian asked: "Where were you when you lost your keys?"

"Over there by my car," the Mr. Dudas gestured.

The pedestrian was puzzled. "Why are you looking for them here?"

Jon Dudas explained: "The light's better!"

Posted by: A | Oct 17, 2007 at 10:57 PM

The K & E firm profile for Desmarais (GSK's attorney) includes "P.C." after his name - - what the hell is P.C.???

Posted by: anon | Oct 17, 2007 at 11:05 PM

just an ordinary inventor >> this might be of interest

by John Orange

JUDGE PAUL MICHEL'S TOP TEN DRAFTING TIPS

At the Newport Beach Seminar three eminent Judges from different US Courts gave their views on how Patent practitioners could improve their presentation of claims before their Court. Judge Paul Michel of the CAFC provided a list of ten points that he considered should be followed in preparing patent applications. These tips are produced below, as recorded on the fly and

CISCO.000009

therefore with no guarantee of accuracy:-

- 1 - Make sure there is support for the claims; track the language used in the claim back to the specific description to ensure the same terminology is used.
- 2 - Check whether the term used has an established meaning in the art and whether that meaning is appropriate in the particular circumstances in which it is to be used.
- 3 - Avoid amendment during prosecution!
- 4 - Prosecute the claims for literal, not equivalent, scope.
- 5 - Know the Federal Court case law on construction. Look at the decision as a whole, not just a stray phrase, and read all the cases.
- 6 - Where there is more than one possible meaning for a term, and in the absence of other factors, the customary meaning in the art is more relevant than the ordinary meaning.
- 7 - Dictionaries relevant to the art are a prime source for ascertaining the appropriate meaning of the term.
- 8 - When listing and discussing prior art references, check that the art uses a term in the same manner as in the specification and describe the art using terminology consistent with that used to describe the embodiments.
- 9 - Describe multiple embodiments wherever possible.
- 10 - Avoid creating a prosecution history except where you wish to establish a broader interpretation than might be the customary interpretation.

Posted by: ironicslip | [Oct 17, 2007 at 11:27 PM](#)

"re-scheduled the hearing on GSK's motion for preliminary injunction to the morning of October 31, 2007. The loser on the preliminary injunction motion will have to make a dash to the CAFC that afternoon."

Well even though the hearing is on Oct 31, a decision will not be rendered that day, will it?

Posted by: patent leather | [Oct 17, 2007 at 11:38 PM](#)

It will have to be a ruling from the bench on the 31st in order for the loser to file an emergency appeal at the CAFC the same day.

The 31st will indeed be "trick or treat" for all of us.

Both cases were also consolidated with Judge Cacheris.

Posted by: anon | [Oct 18, 2007 at 12:08 AM](#)

Does anyone know what Judge Cacheris' history is with regard to preliminary injunctions? And can the CAFC really hear an emergency appeal on the same day??? Although I am sure they are reviewing the case now.

Dudas should in the very least suspend enforcement of the rules until the CAFC has heard the "emergency appeal" (if needed).

Posted by: patent leather | [Oct 18, 2007 at 12:38 AM](#)

"Besides the PTO itself, is there anyone that has commented favorably on the new rules?"

Yes, the firms that represent Intel have commented favorably. What a surprise. This should be a tipoff to the USPTO that the rules severely hurt the small guys with less money. But I'm convinced they don't care.

Posted by: patent leather | [Oct 18, 2007 at 01:16 AM](#)

In other news

<http://igdmldg.blogspot.com/2007/10/amazon-one-click-patent-rejected-by-us.html>

The irony, of course, is that this patent smelled worse to the public than anything before or after.

And now it's official: it was a bunch of crap.

Posted by: Malcolm Mooney | [Oct 18, 2007 at 01:29 AM](#)

Anon,

The whole point of my post was that we should not have to wait until the CAFC to be reasonably sure of claim interpretation. The CAFC should only be able to overturn a lower court claim interpretation for clear error or whatever the standard is for matters of fact.

Joe

Posted by: Lionel Hutz | [Oct 18, 2007 at 01:48 AM](#)

Malcolm, while I'm as pleased as you are with the issuance of an OA in the re-exam that says the one-click patent is crap, it (unfortunately) ain't over till it's over. Please let us know when this thing is really dead for good.

Posted by: Prosecutor | [Oct 18, 2007 at 04:38 AM](#)

This is a Charlie Foxtrot. I want some heads and I want them now. I believe we should start with Dudas being removed from Office. Ladies and gentlemen it is time for politics. They messed with the system and now it is time the system messes back. What is happening with that Peterlin case? Her head should roll too for backing this garbage. These GD rules are changing so fast I can't keep up with them. That is and of itself violates due process. Don't the people in the patent office know anything about the Constitution. WE HAVE A RIGHT TO A REPUBLICAN FORM OF GOVERNMENT. You cannot have a republican form of government without the citizens having an opportunity to know what is expected of them. In short anyone who supports the implementation of these rules is simply a fascist.

Posted by: jarjarstinks | [Oct 18, 2007 at 09:19 AM](#)

Charlie, I am too old to serve, but I will pray for you: Our Lady of Divine Retribution, don't fail us now.

Posted by: anonymous | [Oct 18, 2007 at 09:45 AM](#)

Guess what, my cases are no longer flagged as being subject to the 1.75(b) showing. Ya know what. It is time to call the Department of Justice and start having every single employee investigated to see if there is a conspiracy within the agency to violate the laws and regulations of the United States. Are applicants actually being denied patent term by deliberate acts of the USPTO in delaying examination of the application. Perhaps we should talk about retroactively giving each patent the longer of 17 from issue or 20 from priority. He he he he.

Posted by: outhersomewhere | [Oct 18, 2007 at 12:00 PM](#)

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Posted by: outhersomewhere | [Oct 18, 2007 at 12:01 PM](#)

Do you trust the DOJ? It appears the body-snatchers have completed their long term plans at DOJ. It is also apparent they have in all the agencies leading up to the publication of these rules.

Posted by: Mr T | [Oct 18, 2007 at 12:16 PM](#)

I never thought I'd be rooting more for someone other than the Sox in October, but I have to say, GO GSK!

Posted by: Opampman | [Oct 18, 2007 at 12:44 PM](#)

Someone posted a while back a question regarding what the real problem was - the PTO says the problem is the backlog - and asked how can we solve it. Here's an easy answer. Take all of the "lost examining" hours the PTO spent promulgating the rules, responding to comments, traveling on road shows, defending the rules, publishing OG notices and the like, and now defending

litigation, and spend those hours doing their job - Examining applications. The backlog would be gone!

Posted by: patentdood | Oct 18, 2007 at 01:31 PM

AMEN patentdood

Posted by: outheresomewhere | Oct 18, 2007 at 02:16 PM

My two cases also have lost their "Flagged" status and now show merely "Docketed". My voicemails to the Examiners assigned those cases went unanswered.

Posted by: CliveFenster | Oct 18, 2007 at 02:40 PM

Good idea dood, after they are CRUSHED, dust the managers off and send them back to the shoes for a 10 year sentence! It's not too fun in the shoes, ha ha.

Posted by: Mr T | Oct 18, 2007 at 02:56 PM

apparently there was a study done awhile back which determined that if the federal government had not been stealing fees paid to the PTO but instead had given these fees to the PTO and the PTO had spent the money to train and hire new examiners that there would be no backlog. Does anyone have any information on that study? Thanks

Posted by: Curious | Oct 18, 2007 at 03:29 PM

apparently there was a study done awhile back which determined that if the federal government had not been stealing fees paid to the PTO but instead had given these fees to the PTO and the PTO had spent the money to train and hire new examiners that there would be no backlog. Does anyone have any information on that study? Thanks

Posted by: Curious | Oct 18, 2007 at 03:29 PM

One very interesting aspect of the GSK case is the inevitable discovery into the inner workings of the PTO. Given the numerous claims made by GSK, that discovery could be (and should be) wide-ranging. I am certain that it will get very nasty and that some of the information which comes out will be quite embarrassing. Imagine if they track down an examiner that testifies about how he was told to stop examining applications with more than 5/25 claims long before the rules were even published. And the PTO's goofy rules in 37 CFR 104.21 et seq will not help them a bit. I also assume that the PTO is being diligent in maintaining and preserving ALL documents relevant to the new rules, including internal e-mails and the like.

Posted by: metoo | Oct 18, 2007 at 03:33 PM

Where are all the guys who planned to sue the PTO. GSK, Tafas and we need your help. PLEASE join the suit!

Susan Dudley is now looking at the IDS rules, and again David Boundy submitted a letter tearing into the PTO, which must be CRUSHED.

Posted by: Mr T | Oct 18, 2007 at 04:30 PM

Mr. T: "Susan Dudley is now looking at the IDS rules, and again David Boundy submitted a letter tearing into the PTO, which must be CRUSHED."

Will these rules be effective immediately or will there be a waiting period first? Does anyone know? Should we all start going through our files to make sure every reference is submitted now?

Posted by: patent leather | Oct 18, 2007 at 05:10 PM

What's all this about new rules? When did that happen?

Posted by: Malcolm Mooney | Oct 18, 2007 at 05:57 PM

You mean the new IDS rules, Malcolm? There the ones that are now being reviewed by OMB - the ones that no one outside the PTO and OMB have seen - the ones which are presumably similar to the proposed rules the PTO previously published, but I'm sure slightly less draconian than those originally proposed so that the PTO can say with a straight face "see, we listened to all of the comments submitted to us and changed the rules in light of them" - the IDS rules that will be one more nail for the coffin in which our patent system is being systematically and methodically destroyed

Posted by: metoo | Oct 18, 2007 at 06:05 PM

MM: Look over at patent prospector for details.

PL, I think I remember Feb. or March as the projected date.

Posted by: Mr T | Oct 18, 2007 at 06:07 PM

Generally, if you file more than 20 references, expect to prepare an ESD-like document!

I made a flow chart of the proposed rules, and they are bad! and I mean bad bad.

Posted by: Mr T | Oct 18, 2007 at 06:09 PM

IDS rules that require a particular format for presenting known prior art which may be relevant, are, generally speaking, unenforceable: If an applicant/attorney cites to the PTO references that may be material, whether or not the PTO actually considers such references, would not appear to impact on the inventor's or his attorney's duty to disclose under 37 C.F.R. §1.56.

Essentially, if references are cited to the PTO anywhere in the Specification or prosecution history - assuming that such material references are not deliberately "buried," but presented in a manner in which the Examiner should take notice of them - an Examiner is then "on notice" of the potentially material reference(s). If the Examiner chooses to deliberately ignore a reference clearly cited in a prosecution history, because it might not meet the stringent requirements of the PTO, then the solution may simply be to clearly make the reference known to the Examiner and "call it a day." There can be no "equitable conduct," it would seem, if an attorney makes a bona fide effort to draw the Examiner's attention to a particular reference which the Examiner then chooses to ignore, because the manner of "disclosure" is not perfectly compliant with the PTO's ridiculous requirements. At some point, the Patent Bar will simply "cite and forget," thereby avoiding a later finding of inequitable conduct, but refusing to "jump through hoops" by Rules that require applicants and their attorneys to do the work that the PTO was created, and is paid, to do.

An applicant and his attorney have an obligation to cite material references to the PTO, inasmuch as the PTO cannot be expected to uncover any, and all, material references and, if an applicant or his attorney knows of a reference that is material, it is only "fair" and equitable that it be made known to the PTO. Once this obligation is fulfilled, it must not be forgotten that the attorney represents the patent applicant, and not the "public-at-large," which is, legally speaking, the PTO's "client." As attorneys, we should disclose material prior art to the PTO, but we should not be required to "reject" our own clients' claims.

The PTO may choose to implement particularly stringent rules for the disclosure of prior art, however, if there is a lack of compliance, and the PTO refuses to properly consider prior art "thrown in its face," then it is deliberately refusing to perform the statutory function that it was created to carry out.

Posted by: Edwin D. Schindler | Oct 18, 2007 at 10:57 PM

Correction of typo in CAPS: "There can be no "IInequitable conduct," it would seem, if an attorney makes a bona fide effort to draw the Examiner's attention to a particular reference which the Examiner then chooses to ignore, because the manner of "disclosure" is not perfectly compliant with the PTO's ridiculous requirements."

Posted by: Edwin D. Schindler | Oct 18, 2007 at 11:01 PM

Thanks Mr. Schindler. Do you really think this practice would fly? Otherwise, I agree with everything else you said!

Posted by: anonymous | Oct 18, 2007 at 11:11 PM

um, no, it won't fly if the NEW IDS rules are promulgated.

Posted by: metoo | Oct 19, 2007 at 12:02 AM

I just checked the docket. The case was reassigned to a judge named James Cacheris. He overruled the former judge's order to have the hearing on 10-26 and allowed the PTO until 10-31-07 to respond to the PI hearing. He has also consolidated this case with the Doctor's case and set the hearing date for both on the same day.

Posted by: patent fool | Oct 19, 2007 at 12:47 AM

Wikipedia article on James C. Cacheris.

http://en.wikipedia.org/wiki/James_C._Cacheris

Posted by: [Mark Nowotarski](#) | [Oct 19, 2007 at 07:51 AM](#)

Not good - why give the PTO more time whne they should have seen this coming and Tafas was filed long ago?

"CNN Dobbs: 'I spend more time worrying about whether or not the United States can survive the remaining 15 months of his ebbing presidency'..."

Can the Patent Office survive?

Posted by: [me](#) | [Oct 19, 2007 at 09:04 AM](#)

FYI a memo was just issued by the PTO management saying that we are to continue examining cases that exceed 5/25 until Nov. 1. All cases have been put back on examiner's dockets, according to the memo.

-An examiner.

Posted by: [Hecky's: It's the Sauce](#) | [Oct 19, 2007 at 11:35 AM](#)

"CNN Dobbs: 'I spend more time worrying about whether or not the United States can survive the remaining 15 months of his ebbing presidency'..."

LOL. Loud Obbs isn't in love anymore.

Posted by: [Malcolm Mooney](#) | [Oct 19, 2007 at 12:26 PM](#)

Thanks for the link to Judge Cacheris bio. Penn and GW law, must be a smart guy. Smart enough to realize the rules are illegal, I hope.

Has anyone filed a motion for the court to hear an amicus brief?

Posted by: [patent leather](#) | [Oct 20, 2007 at 12:46 AM](#)

"Has anyone filed a motion for the court to hear an amicus brief?"


Do trial courts take amici? I've never heard of this, but I've lived a sheltered life.

Posted by: [Federal Courts](#) | [Oct 21, 2007 at 01:00 AM](#)

EXHIBIT E



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By **Amanda Ernst**

Law360, New York (October 16, 2007) -- Patent holding company ESN LLC has filed a patent infringement suit against [Cisco Systems Inc.](#) and its subsidiary [Linksys](#), claiming infringement of a recently issued patent for voice over Internet protocol technology.

According to a complaint filed Monday in the U.S. District Court for the Eastern District of Texas, the U.S. Patent and Trademark Office issued U.S. Patent Number 7,283,519 to ESN on Oct. 16. The company claims that Cisco and Linksys are selling products that infringe on the '519 patent, including numerous router models and IP telephone systems.

The '519 patent, entitled "Distributed Edge Switching System for Voice-Over-Packet Multiservice Network," describes switching systems that can be used to send voice and other data over a broadband network.

Connecticut-based ESN claims that Cisco and Linksys sell voice and unified communications systems that infringe the '519 patent. The infringing products include various Cisco integrated services routers, the Cisco Unified Communications 500 Series, Linksys' SPA-9000 IP Telephony System and Linksys' SVR-3000 router, the complaint said.

The patent's inventor, Gregory D. Girard, filed an application for the '519 patent in April 2001. The PTO published the application in November 2002 as U.S. Patent Application Publication No. US 2002/0176404, the complaint said. Girard is co-founder of ESN.

ESN notified Cisco and Linksys of the published '404 patent application in August 2006. ESN also sent the defendants "specific notice in writing of certain infringing activities" in June 2007, according to the

complaint.

But regardless of the notices, Cisco and Linksys continued to infringe on the '519 patent, ESN alleged. The rival companies' infringement is therefore willful, ESN said.

Additionally, ESN has asserted that Cisco and Linksys violated the company's provisional rights.

"Cisco and Cisco-Linksys have violated ESN's 'provisional rights' under 35 U.S.C. § 154(d) by making, using, offering for sale, selling and/or importing the invention as claimed in one or more claims of the published '404 application, thereby entitling ESN to a reasonable royalty for such violation from at least Aug. 11, 2006 until the date of the '519 Patent's issuance on Oct. 16, 2007," ESN said in the complaint.

ESN is seeking a permanent injunction against Cisco and Linksys, as well as damages, including disbursements, court costs and attorneys' fees.

Representatives for Cisco did not return requests for comment Monday.

A search of federal dockets revealed that this is the first patent infringement suit filed by ESN.

The patent in this case is U.S. Patent Number. 7,283,519.

ESN is represented in this matter by attorneys from Albritton Law Firm and Ward & Smith Law Firm.

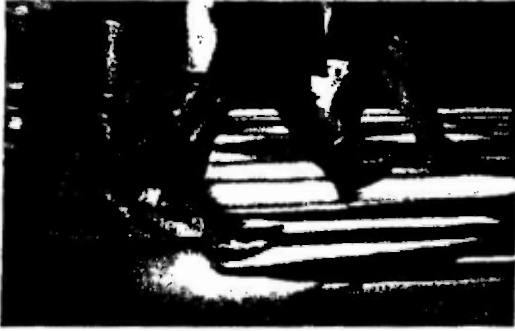
Counsel for Cisco and Linksys could not immediately be identified.

The case is ESN LLC v. Cisco Systems Inc. et al., case number 5:07-cv-00156 in the U.S. District Court for the Eastern District of Texas.

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TODAY'S LAW NEWS



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EXHIBIT F

WEDNESDAY, OCTOBER 17, 2007

Troll Jumps the Gun, Sues Cisco Too Early

Well, I knew the day would come. I'm getting my troll news from [Dennis Crouch](#) now. According to Dennis, a company called ESN sued Cisco for patent infringement on October 15th, while the patent did not issue until October 16th. I looked, and ESN appears to be a shell entity managed by the President and CEO of DirectAdvice, an online financial website. And, yes, he's a lawyer. He clerked for a federal judge in Connecticut, and was an attorney at Day, Berry & Howard. Now he's suing Cisco on behalf of a non-practicing entity.

I asked myself, can ESN do this? I would think that the court would lack subject matter jurisdiction, since ESN owned no property right at the time of the lawsuit, and the passage of time should not cure that. And, in fact, [I was right](#):

A declaratory judgment of "invalidity" or "noninfringement" with respect to Elk's pending patent application would have had no legal meaning or effect. The fact that the patent was about to issue and would have been granted before the court reached the merits of the case is of no moment. Justiciability must be judged as of the time of filing, not as of some indeterminate future date when the court might reach the merits and the patent has issued. We therefore hold that a threat is not sufficient to create a case or controversy unless it is made with respect to a patent that has issued before a complaint is filed. Thus, the district court correctly held that there was no justiciable case or controversy in this case at the time the complaint was filed. GAF contends, however, that the issuance of the '144 patent cured any jurisdictional defect. We disagree. Later events may not create jurisdiction where none existed at the time of filing.

GAF Building Materials Corp. v. Elk Corp. of Texas, 90 F.3d 479, 483 (Fed. Cir. 1996) (citations and quotations omitted).

One other interesting tidbit: Cisco appeared to pick up on this, very quickly. Cisco filed a declaratory judgment action (in Connecticut) yesterday, the day after ESN filed its null complaint. Since Cisco's lawsuit was filed after the patent issued, it should stick in

Patent Troll Tracker

Connecticut.

Perhaps realizing their fatal flaw (as a couple of other bloggers/news items have pointed out), ESN (represented by Chicago firm McAndrews Held & Malloy and local counsel Eric Albritton and T. Johnny Ward) filed an amended complaint in Texarkana today - amending to change absolutely nothing at all, by the way, except the filing date of the complaint. Survey says? XXXXXX (Insert "Family Feud" sound here). Sorry, ESN. You're on your way to New Haven. Wonder how Johnny Ward will play there?

Posted by Rick Frenkel at 7:00 PM 1 comment

Labels: [Cisco](#), [Dennis Crouch](#), [Eric Albritton](#), [ESN](#), [Johnny Ward](#)

EXHIBIT G

PATENT/TRADEMARK

**U.S. District Court [LIVE]
 Eastern District of TEXAS LIVE (Texarkana)
 CIVIL DOCKET FOR CASE #: 5:07-cv-00156-DF-CMC**

ESN LLC v. Cisco Systems Inc et al
 Assigned to: Judge David Folsom
 Referred to: Magistrate Judge Caroline Craven
 Cause: 28:1338 Patent Infringement

Date Filed: 10/15/2007
 Jury Demand: Plaintiff
 Nature of Suit: 830 Patent
 Jurisdiction: Federal Question

Plaintiff

ESN LLC

represented by **Eric M. Albritton**
 Attorney at Law
 PO Box 2649
 Longview, TX 75606
 903/757-8449
 Fax: 19037587397
 Email: ema@emafirm.com
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

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 Longview, TX 75606-1231
 903/757-6400
 Fax: 903/7572323
 Email: jw@jwfirm.com
ATTORNEY TO BE NOTICED

V.

Defendant

Cisco Systems Inc

Defendant

Cisco-Linksys LLC

Date Filed	#	Docket Text
10/16/2007	1	COMPLAINT against Cisco Systems Inc, Cisco-Linksys LLC (Filing fee \$ 350 receipt number 1298562.), filed by ESN LLC. (Attachments: # 1 Exhibit A - Part 1# 2 Exhibit A - Part 2# 3 Exhibit B# 4 Exhibit C# 5 Civil Cover Sheet)(Albritton, Eric) Modified on 10/17/2007 (fnt,). (Entered: 10/16/2007)

CISCO.000242

10/16/2007	2	NOTICE of Attorney Appearance by Thomas John Ward, Jr on behalf of ESN LLC (Ward, Thomas) (Entered: 10/16/2007)
10/17/2007	3	AMENDED COMPLAINT against Cisco Systems Inc, Cisco-Linksys LLC, filed by ESN LLC. (Attachments: # 1 Exhibit A - Part 1# 2 Exhibit A - Part 2# 3 Exhibit B - Part 1# 4 Exhibit B - Part 2# 5 Exhibit C# 6 Exhibit D)(Albritton, Eric) (Entered: 10/17/2007)
10/17/2007	4	Notice of Filing of Patent/Trademark Form (AO 120). AO 120 mailed to the Director of the U.S. Patent and Trademark Office. (Albritton, Eric) (Entered: 10/17/2007)
10/17/2007	5	E-GOV SEALED SUMMONS Issued as to Cisco Systems Inc, Cisco-Linksys LLC. (Attachments: # (1) summons CiscoLinksys)(rml,) (Entered: 10/17/2007)

PACER Service Center			
Transaction Receipt			
10/18/2007 16:32:34			
PACER Login:	ws0474	Client Code:	1000.060
Description:	Docket Report	Search Criteria:	5:07-cv-00156-DF-CMC
Billable Pages:	1	Cost:	0.08

CISCO.000243