

EXHIBIT D



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2283 Multiple Copending - 2200 Citation of Prior Art and Ex Parte Reexamination of Patents

2283 Multiple Copending *Ex Parte* Reexamination Proceedings [R-7]

37 CFR 1.565 Concurrent Office proceedings which include an ex parte reexamination proceeding.

(c) **>If *ex parte* reexamination is ordered while a prior *ex parte* reexamination proceeding is pending and prosecution in the prior *ex parte* reexamination proceeding has not been terminated, the *ex parte* reexamination proceedings will usually be merged and result in the issuance and publication of a single certificate under § [1.570](#). For merger of *inter partes* reexamination proceedings, see § [1.989](#)(a). For merger of *ex parte* reexamination and *inter partes* reexamination proceedings, see § [1.989](#)(b).<

This section discusses multiple copending reexamination requests which are filed on the same patent, where none of the requests is an *inter partes* request. If one of the multiple copending reexamination requests is an *inter partes* request, see MPEP § [2686.01](#).

In order for a second or subsequent request for *ex parte* reexamination to be granted, a substantial new question of patentability must be raised by the art (patents and/or printed publications) cited in the second or subsequent request for reexamination. MPEP § [2240](#) provides a discussion as to whether a substantial new question of patentability is raised by the prior art cited in a second or subsequent request for reexamination filed while a reexamination proceeding is pending.

If the second or subsequent request is granted, the decision on whether or not to combine the proceedings will be made by the Central Reexamination Unit (CRU) Director where the reexamination is pending. The CRU Director may delegate this to the **>CRU Supervisory Patent Examiner (SPE)<. No decision on combining the reexaminations should be made until reexamination is actually ordered in the later filed request for reexamination.

I. PROCEEDINGS MERGED

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Where a second request for reexamination is filed and reexamination is ordered, and a first reexamination proceeding is pending, 37 CFR **1.565(c)** provides that the proceedings will usually be merged. However, a decision not to merge is within the sole discretion of the Office to facilitate/carry out the statutory mandate of 35 U.S.C. **305** to conduct reexamination proceedings with "special dispatch."

Where a second request for reexamination is filed while a first reexamination proceeding is pending, the second request is decided based on the claims in effect at the time of the determination (see 37 CFR **1.515(a)**), and if reexamination is ordered, the patent owner and the second requester are given an opportunity to file a statement and reply, respectively. It is then considered whether the proceedings will, or will not, be merged. If the proceedings are merged, the prosecution will then continue at the most advanced point possible for the first proceeding. It should be noted that if a final rejection has been issued in the first proceeding, prosecution will be ordinarily be reopened where any of the new patents or printed publications presented in the second request are applied to the merged proceeding in a new ground of rejection.

The patent owner will be provided with an opportunity to respond to any new rejection in a merged reexamination proceeding prior to the action being made final. See **MPEP § 2271**. If the reexamination proceedings are merged, a single certificate will be issued based upon the merged proceedings, **37 CFR 1.565(c)**.

II. WHEN PROCEEDING IS SUSPENDED

It may also be desirable in certain situations to suspend a proceeding for a short and specified period of time. For example, a suspension of a first reexamination proceeding may be issued to allow time for the patent owner's statement and the requester's reply in a second proceeding prior to merging. Further, after the second proceeding *has been ordered*, it may be desirable to suspend the second proceeding where the first proceeding is presently on appeal before a Federal court to await the court's decision prior to merging. A suspension will only be granted in extraordinary instances, because of the statutory requirements that examination proceed with "special dispatch." The express written approval of the CRU or Technology Center (TC) Director must be obtained. Suspension will not be granted when there is an outstanding Office action.

III. MERGER OF REEXAMINATIONS

The following guidelines should be observed when two requests for reexamination directed to a single patent have been filed.

The second request (i.e., Request 2) should be processed as quickly as possible and assigned to the same examiner to whom the first request (i.e., Request 1) is assigned. Request 2 should be decided immediately without waiting the usual period (e.g., for submission of art). If Request 2 is denied, *ex parte* prosecution of Request 1 should continue. If Request 2 is granted, the order in the second proceeding should be mailed immediately. The two requests should be held in storage until the patent owner's statement and any reply by the requester have been received in Request 2, or until the time for filing same expires. Then, the CRU Director or the CRU Director's delegate will prepare a decision whether to merge the two proceedings.

A decision by the CRU Director to merge the reexamination proceedings should include a

requirement that the patent owner maintain identical claims in both files. It will further require that responses by the patent owner, and any other paper filed in the merged proceeding, must consist of a single response, addressed to both files, filed in duplicate, each bearing a signature and containing identifying data for both files, for entry in both files. The decision will point out that both files will be maintained as separate complete files. Where the claims are not the same in both files, the decision of merger will indicate at its conclusion that the patent owner is given 1 month to provide an amendment to make the claims the same in each file. Where the claims are already the same in both files, the decision will indicate at its conclusion that an Office action will be mailed in due course, and that the patent owner need not take any action at present. The decision of merger will be mailed immediately.

Where the merger decision indicates that an Office action will follow, the merged proceeding is returned to the examiner immediately after the decision to issue an Office action. Where the merger decision indicates that the patent owner is given 1 month to provide an amendment to make the claims the same in each file (identical amendments to be placed in all files), the **CRU** will await submission of the amendment or the expiration of the time to submit the amendment. After the amendment is received and processed by the technical support staff or the time for submitting the amendment expires, the merged proceeding will be returned to the examiner to issue an Office action.

Once the merged proceeding is returned to the examiner for issuance of an Office action, the examiner should prepare an Office action at the most advanced point possible for the first proceeding. Thus, if the first proceeding is ready for a final rejection and the second proceeding does not provide any new information which would call for a new ground of rejection, the examiner should issue a final rejection for the merged proceeding using the guidelines for the prosecution stage set forth below.

If the *ex parte* prosecution stage has not yet begun in Request 1 when Request 2 is received, Request 1 should be processed to the point where it is ready for *ex parte* prosecution. Then, Request 1 is normally held until Request 2 is granted and is ready for *ex parte* action following the statement and reply. Thereafter, the two proceedings would be merged. However, if Request 2 is denied, there would be no merger and prosecution will be carried out solely on Request 1. Note that Request 2 should be determined on its own merits and should not rely on nor refer to the decision issued in Request 1.

In the event that an amendment to make the claims the same in each file is required by the merger decision (identical amendments to be placed in all files) but is not timely submitted, any claim that does not contain identical text in all of the merged proceedings should be rejected under 35 U.S.C. **112**, second paragraph, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention.

IV. THE PROSECUTION STAGE, AFTER MERGER

>Where merger is ordered, the patent owner is required to maintain identical amendments in the merged reexamination files for purposes of the merged proceeding. The maintenance of identical amendments in the files is required as long as the reexamination proceedings remain merged. Where identical amendments are not present in the reexamination files at the time merger is ordered, the patent owner will be required to submit an appropriate "housekeeping" amendment placing the same amendments in the proceedings. This may be accomplished by amending one or more of the proceedings, as appropriate. The patent owner must not address any issue of patentability in the housekeeping amendment. In the event that an amendment to make the claims the same

in each file is required by the merger decision (identical amendments to be placed in all files) but is not timely submitted, any claim that does not contain identical text in all of the merged proceedings should be rejected under 35 U.S.C. [112](#), paragraph 2, as being indefinite as to the content of the claim, and thus failing to particularly point out the invention.<

When prosecution is appropriate in merged proceedings, a single combined examiner's action will be prepared. Each action will contain the control number of the two proceedings on every page. A single action cover form (having both control numbers penned in at the top) will be provided by the examiner to the clerical staff. The clerical staff will copy the action cover form, and then use the PALM printer to print the appropriate data (A) on the original for the first request and (B) on the copy for the second request. Each requester will receive a copy of the action and both action cover forms, with the transmission form PTOL-465 placed on top of the package. The patent owner will get a copy of both action cover forms and the action itself.

When a "Notice Of Intent To Issue *Ex Parte* Reexamination Certificate" (NIRC) is appropriate, plural notices will be printed. Both reexamination files will then be processed. The TC or the CRU should prepare the file of the concurrent proceedings in the manner specified in [MPEP § 2287](#) before release to Office of *>Data Management<.

The above guidelines should be extended to those situations where more than two requests for reexamination are filed for a single patent.

V. PROCEEDINGS NOT MERGED

Pursuant to 35 U.S.C. [305](#), "[a]ll reexamination proceedings under this section will be conducted with special dispatch within the Office." This statutory provision is grounded on the need for certainty and finality as to the question of patentability raised by the request for reexamination. Thus, if a second request for reexamination **>will unduly delay< the first reexamination proceeding, the two proceedings generally will not be merged. If the Office were to merge the two *>proceedings<, the first reexamination proceeding would need to be withdrawn from its **>place in the process,< thus delaying, instead of advancing, prosecution. This would run contrary to the statutory "special dispatch" requirement of 35 U.S.C. [305](#) and its intent. On the other hand, if the Office does not merge, the first reexamination proceeding can be concluded, and any substantial new question of patentability raised by the second reexamination request can be resolved in the second proceeding, with no delay resulting. The second request is then considered based on the claims in the patent as indicated in the issued reexamination certificate, rather than the original claims of the patent. However, the Office always retains the authority to merge because in some instances, it may be more efficient to merge the two proceedings, which would foster "special dispatch.">The instances where the Office may, or may not, merge an ongoing reexamination proceeding with a subsequent reexamination proceeding, are addressed on a case-by-case basis.<

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For processing of the second reexamination proceeding, see [MPEP § 2295](#).

VI. FEES IN MERGED PROCEEDINGS

Where the proceedings have been merged and a paper is filed which requires payment of a fee (e.g., excess claim fee, fee for request for extension of time, petition fee, appeal fee,

brief fee, oral hearing fee), only a single fee need be paid. For example, only one fee need be paid for an appeal brief even though the brief relates to merged multiple proceedings and copies must be filed for each file in the merged proceeding.

VII. PETITION TO MERGE MULTIPLE COPENDING REEXAMINATION PROCEEDINGS

No petition to merge multiple reexamination proceedings is necessary since the Office will generally, *sua sponte*, make a decision as to whether or not it is appropriate to merge the multiple reexamination proceedings. If any petition to merge the proceedings is filed prior to the determination ([37 CFR 1.515](#)) and order to reexamine ([37 CFR 1.525](#)) on the second request, it will not be considered but will be returned to the party submitting the same by the CRU Director. The decision returning such a premature petition will be made of record in both reexamination files, but no copy of the petition will be retained by the Office. See [MPEP § 2267](#).

While the patent owner can file a petition to merge the proceedings at any time after the order to reexamine ([37 CFR 1.525](#)) on the second request, the better practice is to include any such petition with the patent owner's statement under [37 CFR 1.530](#), in the event the CRU Director has not acted prior to that date to merge the multiple reexamination proceedings. If the requester of any of the multiple reexamination proceedings is not the patent owner, that party may petition to merge the proceedings as a part of a reply pursuant to [37 CFR 1.535](#) in the event the CRU Director has not acted prior to that date to merge the multiple proceedings. A petition to merge the multiple proceedings which is filed by a party other than the patent owner or one of the requesters of the reexamination will not be considered but will be returned to that party by the CRU Director as being improper under [37 CFR 1.550\(g\)](#).

All decisions on the merits of petitions to merge multiple reexamination proceedings will be made by the CRU Director (or to the CRU [SPE](#), if the CRU Director delegates it to him or her).

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