



UNITED STATES PATENT AND TRADEMARK OFFICE

SEP 13 2005

COMMISSIONER FOR PATENTS

Mr. Jed Margolin
3570 Pleasant Echo Drive
San Jose, CA 95148-1916

Dear Mr. Margolin:

Thank you for the letter addressed to Commissioner Doll in which you express concern over the prosecution of your application 09/947,801. Your letter has been forwarded to me for response.

A member of my staff has thoroughly examined the prosecution history of your application and can find no evidence of abuse on the part of the United States Patent and Trademark Office (USPTO).

In your letter, you state that the examiner did not respond to your arguments in his Final Rejection. However, a review of the final rejection mailed 6/15/05 shows that the examiner addressed your arguments on pages 2-6.

You also believe that the Final Rejection was procedurally improper because it is your position that the examiner instituted a new rejection. Comparing the rejection as made in the Non-Final Rejection mailed 1/26/05 and the Final Rejection mailed 6/15/05, the two are verbatim identical. Not only is the rejection verbatim, but in rebutting your arguments, the examiner set forth no new line of rationale or interpretation different than that set forth in the Non-Final Rejection mailed 1/26/05. Therefore, there is no new rejection and the second rejection was properly made final in accordance with the Manual of Patent Examining Procedure (MPEP) Chapter 700, section 706.07(a). Procedurally, the examiner is following current USPTO Rules & Regulations as set forth in the MPEP.

On behalf of the USPTO, please allow me apologize for any difficulties you may have experienced in contacting Supervisor Dharia and Group Director Harvey with regard to this application. We make every effort to respond to all telephone calls within 24 hours of their receipt. A member of my staff contacted both Supervisor Dharia and Group Director Harvey on your behalf. They are willing to discuss this application with you in the future. You can reach Supervisor Dharia at (571) 272-3880 and Group Director Harvey at (571) 272-3896.

Regarding the rejection in your application over the Ellis reference, it would appear as if you and the examiner have reached an impasse. You express displeasure that your only option at this point is to take the application through the appeal process.

However, the Office has instituted a new process whereby examiners' rejections can be reviewed in a pre-appeal brief conference and before it is necessary to file an appeal brief. The conference

will include a Supervisory Patent Examiner. The new process was set forth in an Official Gazette Notice on July 12, 2005. The information found below is taken from the Official Gazette.

This new program offers applicants an avenue to request that a panel of examiners formally review the legal and factual basis of the rejections in their application prior to the filing of an appeal brief. Effective immediately, the USPTO is offering applicants an optional procedure to review the examiner's rejection prior to the actual filing of an appeal brief. The program is intended to spare applicants the added time and expense of preparing an appeal brief if a panel review determines an application is not in condition for appeal.

The goals of the program are (1) to identify the presence or absence of clearly improper rejections based upon error(s) in facts, or (2) to identify the omission or presence of essential elements required to establish a prima facie rejection.

2. Conditions Necessary to Request a Panel Review:

- Applicant must file a notice of appeal in compliance with 37 CFR 41.31.*
- Applicant must file the request with the filing of a notice of appeal and before the filing of an appeal brief.*

3. Content of Request:

a. File the request and accompanying arguments in a separate paper entitled, "Pre-Appeal Brief Request for Review". A sample request form has been created and is available on the USPTO Internet Website, on the forms page, as PTO/SB/33.

b. In five (5) or less total pages, provide a succinct, concise and focused set of arguments for which the review is being requested.

c. File the request with the notice of appeal.

d. Address the notice of appeal and the request to

- Mail Stop AF*
- Commissioner for Patents*
- P.O. Box 1450*
- Alexandria, VA 22313-1450*

- Fax the notice of appeal and the request to the Central FAX Number (now 571 273-8300)

- Hand carry the notice of appeal and the request to the

*USPTO Customer Service Window, ATTN: Mail Stop AF
Randolph Building
401 Dulany Street*

Alexandria, VA 22314

e. No after-final or proposed amendments may accompany the request.

A request that fails to comply with the above noted submission requirements may be dismissed.

4. Content of Remarks or Arguments:

The request should specify-

- clear errors in the examiner's rejections; or
- the examiner's omissions of one or more essential elements needed for a prima facie rejection.

For example, the request should concisely point out that a limitation is not met by a reference or the examiner failed to show proper motivation for making a modification in an obviousness rejection (35 U.S.C. 103). Applicants are encouraged to refer to arguments already of record rather than repeating them in the request. This may be done by simply referring to a prior submission by paper number and the relevant portions thereof (e.g., see paper number 3 at pages 4 to 6). However, references such as "see the arguments of record" or "see paper number X" are not helpful and will just obfuscate the real issues for review.

The request may not be more than five (5) pages total and the remarks should be drafted with the expectation that for a clear error in fact or other deficiency, a long detailed explanation is not needed. Requests are limited to appealable, not petitionable matters.

Any actual issues lacking factual basis, including interpretations of the prior art teachings or claim scope as contrasted with clear error in facts, are appropriate for the traditional appeal process and submission of the appeal brief. For grounds where a clear issue on proper interpretation exists, applicant is advised to proceed to appeal with the timely filing of the appeal brief. This program is not intended to be, and is not, an alternative for filing an appeal.

5. USPTO Consideration of the Request:

Upon receipt of a properly filed request, a Technology Center Art Unit supervisor will designate a panel of examiners experienced in the field of technology to review the applicant's remarks and the examiner's rejections. The panel will include at least a supervisor and the examiner of record. The applicant will not be permitted to attend the review and no interviews will be granted prior to issuance of the panel's decision.

The panel members will review the rejection(s) identified by applicant in the request. They will also review the application and the appropriate evidence in support of the rejections to the extent necessary. The panel will then decide if an issue for appeal is, in fact, present in the record. The Office should mail a decision within 45 days of receipt of a properly filed request.

6. Format of Panel Decision:

After the review is complete, the Office will mail a decision on the status of the application. The decision will state one of the following:

- *Finding 1: The application remains under appeal because there is at least one actual issue for appeal.*
- *Finding 2: Prosecution on the merits is reopened and an appropriate Office communication will follow in due course. In appropriate circumstances, a proposed amendment may accompany the panel's decision proposing changes that, if accepted, may result in an indication of allowability for the contested claim(s).*
- *Finding 3: The application is allowed on the existing claims and prosecution remains closed.*
- *Finding 4: The request fails to comply with the submission requirements and is dismissed.*

The decision will summarize the status of the pending claims (still rejected, withdrawn rejections, objected to or allowable claims).

A decision by a pre-appeal brief conference panel to withdraw the rejections of any or all of the claims on appeal is not a decision by a panel of the Board of Patent Appeals and Interferences, and, as such, would not result in any patent term extension of adjustment under 35 U.S.C. Sec. 154(b) (37 CFR 1.701(a)(3) and 1.702(e)).

The decision will not contain any additional grounds of rejection or any restatement of previously made rejections. Such matters will be addressed, as appropriate, in the Examiner's Answer.

7. Time Periods Before/After a Panel Decision:

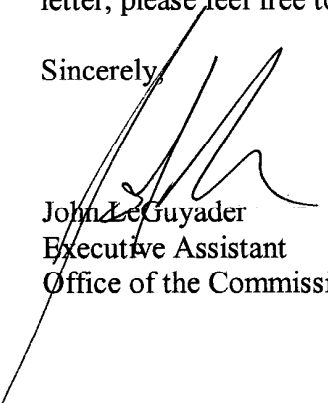
- *The request must be filed with the filing of a notice of appeal and before the filing of the appeal brief. No extensions of time are available for filing the request for review.*
- *The time period for filing an appeal brief will be reset to be one month from mailing of the decision on the request, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of the decision on the request or the receipt date of the notice of appeal, as applicable. To the extent that any existing USPTO rule is inconsistent with this pilot program, the rule is waived until regulations directed to pre-appeal brief conferences are promulgated, or the pilot program is ended. For example, if a request for a pre-appeal brief conference is filed with a notice of appeal, the time period set in 37 CFR 41.37(a)(1) is waived so that an appeal will not stand dismissed if an appeal brief is not filed within two months of the filing date of a notice of appeal, but is filed within one month of the decision on the request.*

Applicant's period for filing the appeal brief or other appropriate response ends on the mailing date of a panel decision that indicates all claims are allowed or that prosecution is reopened.

Please note that any request for a pre-appeal brief conference must be made at the time the Notice of Appeal is submitted. Currently, there is no fee associated with this program.

I hope that this letter has addressed your concerns. If you have any questions specific to this letter, please feel free to contact me at (571) 272-8800.

Sincerely,



John LeGuyader
Executive Assistant
Office of the Commissioner for Patents

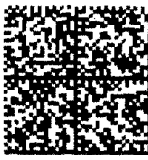
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Received Saturday
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