

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re *Inter Partes* Reexamination of:

David W. BARRY *et al.*

Control No.: 95/001,088

Patent in Reexamination: 6,188,988

Group Art Unit: 3992

Filed: March 10, 2000

Examiner: Deandra M. Hughes

For: SYSTEMS, METHODS, AND
COMPUTER PROGRAM
PRODUCTS FOR GUIDING
THE SELECTION OF
THERAPEUTIC TREATMENT
REGIMENS

**PETITION UNDER 37 C.F.R. § 1.182 FOR RELIEF NOT OTHERWISE PROVIDED
FOR UNDER THE RULES – REQUEST FOR REFUSAL OF CONSIDERATION OF
REQUESTER’S IMPROPER ARGUMENTS**

MAIL STOP *INTER PARTES* REEXAM
ATTN: CENTRAL REEXAMINATION UNIT
COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

Pursuant to 37 C.F.R. § 1.182, the Patent Owner, Advanced Biological Laboratories, S.A. (hereinafter, “Patent Owner”), hereby petitions the United States Patent and Trademark Office (“USPTO”) for relief not otherwise provided for under the rules. Specifically, Patent Owner requests that the Board of Patent Appeals and Interferences refuse consideration of improper arguments advanced by third-party requester Dr. Robert Shafer (“Requester”) in the appellant’s brief filed on April 2, 2010 (“Appeal Brief”), said arguments relating to rejections that were not previously proposed by Requester in the above-identified *inter partes* reexamination of U.S. Patent No. 6,188,988 (“the ‘988 Patent”).

Patent Owner also files herewith (i) an accompanying Petition under 37 C.F.R. § 1.182 requesting that the Director refuse consideration of the Appeal Brief as untimely, and dismiss the pending appeal of the above-identified *inter partes* reexamination for Requester’s failure to file an appellant’s brief within the time allowed under 37 C.F.R. § 41.66(a); and (ii) a Petition under

37 C.F.R. § 1.183 to request waiver of the prohibition of an extension of time for filing a respondent's brief under 37 C.F.R. § 41.66(b), and to request an extension of the period for the Patent Owner to file a respondent's brief until 30 days after a decision on the present Petition under § 1.182 and/or the accompanying Petition under § 1.182 is reached. Patent Owner understands that if the accompanying Petition under § 1.182 is granted, the present Petition under § 1.182 will be rendered moot.

STATEMENT OF FACTS

1. On October 10, 2008, Requester filed a request in the USPTO for *inter partes* reexamination of the '988 Patent ("Request for Reexamination"), proposing 14 rejections over various combinations of a total of 14 cited references. Request for Reexamination, pages 1-12.
2. On January 7, 2009, the Examiner issued an Order Granting Reexamination.
3. The Order Granting Reexamination found that only one of Requester's proposed rejections – that the '988 Patent was allegedly unpatentable over the *Shortliffe* reference in view of the *Perry* reference – raised a substantial new question of patentability (SNQ). Order Granting Reexamination, page 7.
4. On March 19, 2009, a Decision to Merge Reexamination Proceedings was issued, merging the pending *inter partes* reexamination with concurrent *ex parte* reexamination 90/009,213.
5. On June 11, 2009, the Examiner issued an Action Closing Prosecution, confirming the patentability of all claims of the '988 Patent.
6. The Action Closing Prosecution noted that, in *ex parte* reexamination 90/009,213, an SNQ had been raised by the *Siepmann* reference also cited in the above-identified *inter partes* reexamination. Action Closing Prosecution, page 2.
7. In resolving the split, the Examiner stated that the claims of the '988 Patent would be reexamined for patentability over only the following proposed rejections:
 - a. Anticipation by *Siepmann* (as proposed by Requester);
 - b. Obviousness over *Shortliffe* in view of *Perry* (as proposed by Requester);
 - c. Anticipation or obviousness over the *MYCIN* reference (as proposed by the *ex parte* third-party requester); and

- d. Anticipation or obviousness over *Siepmann* (as proposed by the *ex parte* third-party requester).

Action Closing Prosecution, pages 2-3.

8. On December 22, 2009, the Examiner issued a Right of Appeal Notice (RAN), confirming the patentability of all claims of the '988 Patent.
9. On January 21, 2010, Requester filed a Notice of Appeal. The Notice of Appeal expressly stated Requester's intent to appeal not only the grounds for rejection proposed by Requester, but also those proposed by the *ex parte* third-party requester. Notice of Appeal, pages 1-2.
10. On April 2, 2010, Requester filed the Appeal Brief.
11. The Appeal Brief argues that the claims of the '988 Patent are unpatentable (i) in light of *Shortliffe* alone or in combination with *Perry*; (ii) in light of *MYCIN*; and (iii) in light of *Siepmann* alone or in combination with the *Degoulet* reference. Appeal Brief, pages 6-43.

REMARKS

Patent Owner seeks relief under 37 C.F.R. § 1.182 to have Requester's arguments in the Appeal Brief related to rejections that were not previously proposed by Requester in the above-identified *inter partes* reexamination of the '988 Patent be refused consideration by the Board of Patent Appeals and Interferences. In particular, Requester at no point proposed any rejections based on the *MYCIN* reference cited by the *ex parte* third-party requester, and, thus, Requester has no right to appeal the Examiner's determination not to reject any claims of the '988 Patent over *MYCIN*.

Requester asserts in his Notice of Appeal that “[n]othing in the Patent Statutes or the Code of Federal Regulations prohibits an *inter partes* requester in a merged proceeding from appealing ‘*any* final decision favorable to the patentability of any original or proposed amended or new claim of the patent.’” Notice of Appeal, page 2 (quoting 35 U.S.C. § 315(b)(1)) (emphasis in original). Section 315(b)(1), however, specifically relates to an appeal that may be taken by “[a] third-party requester.” 35 U.S.C. § 315(b). Patent Owner respectfully submits that, under the common-sense reading of Section 315(b), a party may be considered a “third-party requester” in an *inter partes* reexamination only with respect to the rejections actually

requested by that party, based on the references cited by that party. For instance, it is indisputable that, prior to the merger of *ex parte* reexamination 90/009,213 and the above-identified *inter partes* reexamination, Requester would have been considered a “third-party requester” only with respect to the rejections proposed in Requester’s request for *inter partes* reexamination, and would not have been considered a third-party requester of any of the proposed rejections in co-pending reexamination 90/009,213. The merger of the reexamination proceedings did nothing to alter that fact, as Requester can point to no statutory or regulatory provisions expressly granting the *inter partes* third-party requester rights as a “co-requester” in the co-pending *ex parte* reexamination as a result of the merger. Moreover, this reading of Section 315(b) is completely consistent with the Manual of Patent Examining Procedure (MPEP), which instructs that “[a] notice of appeal by a third party requester must identify each rejection *that was previously proposed by that third party requester* which the third party requester intends to contest.” MPEP § 2674 (emphasis in original).

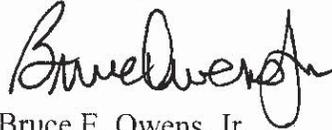
In the present appeal of the merged reexaminations, therefore, Requester can be considered a “third-party requester” only with respect to the rejections that Requester himself proposed in his Request for Reexamination. Accordingly, because Requester never based his request for reexamination of the claims of the ‘988 Patent on the *MYCIN* reference, Requester is not now properly considered a “third-party requester” under Section 315 with respect to the proposed rejections based on *MYCIN*. For at least these foregoing reasons, Requester’s arguments in the Appeal Brief with respect to *MYCIN* should be refused consideration.

CONCLUSION

The Director is hereby authorized to charge the undersigned's Deposit Account No. 50-0220 for the amount of \$400 in accordance with 37 C.F.R. §§ 1.182 and 1.17(f). If any other fee is due, please charge such fee occasioned by this Petition to the undersigned's Deposit Account No. 50-0220.

April 12, 2010

Respectfully submitted,



Bruce E. Owens, Jr.
USPTO Registration No. 58,685
MYERS BIGEL SIBLEY & SAJOVEC, P.A.
P.O. Box 37428
Raleigh, North Carolina 27627
Telephone: (919) 854-1400
Facsimile: (919) 854-1401

CERTIFICATE OF SERVICE

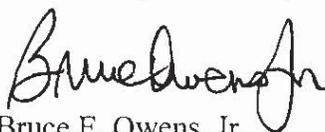
I hereby certify that on April 12, 2010, I served a true and correct copy of the foregoing **PETITION UNDER 37 C.F.R. § 1.182 FOR RELIEF NOT OTHERWISE PROVIDED FOR UNDER THE RULES – REQUEST FOR REFUSAL OF CONSIDERATION OF REQUESTER’S IMPROPER ARGUMENTS** via U.S. First Class Mail to the *Ex Parte* Requester and the *Inter Partes* Requester as follows:

Ex Parte Requester Charles Allen, Esq.
 Goodman, Allen, & Filetti PLLC
 4501 Highwoods Parkway, Suite 210
 Glen Allen, VA 23060

Inter Partes Requester Jonathan D. Loeb
 Dechert LLP
 2440 W. El Camino Real, 7th Floor
 Mountain View, CA 94040

April 12, 2010

Respectfully submitted,



Bruce E. Owens, Jr.
USPTO Registration No. 58,685
MYERS BIGEL SIBLEY & SAJOVEC, P.A.
P.O. Box 37428
Raleigh, North Carolina 27627
Telephone: (919) 854-1400
Facsimile: (919) 854-1401