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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/019,836	01/31/2025	9338140	G0930.70004US00	8270

204356 7590 04/16/2025
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EXAMINER	
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ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
04/16/2025	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/019,836* .

PATENT UNDER REEXAMINATION *9338140* .

ART UNIT *3992* .

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

PTOL-465 (Rev.07-04)

Order Granting Request For Ex Parte Reexamination	Control No.	Patent Under Reexamination	
	90/019,836	9338140	
	Examiner	**Art Unit**	**AIA (FITF) Status**
	JACOB C COPPOLA	3992	No

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The request for *ex parte* reexamination filed 01/31/2025 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a)☐ PTO-892, b)☐ PTO/SB/08, c)☐ Other: ____

1. ☑ The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

/JACOB C. COPPOLA/
Primary Examiner, Art Unit 3992

cc:Requester (if third party requester)

ORDER GRANTING REEXAMINATION OF U.S. PATENT 9,338,140

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1. ACKNOWLEDGEMENT OF REQUEST FOR REEXAMINATION

An *ex parte* request for reexamination (“Request”) of claims 1–10 of U.S. Patent No. 9,338,140 (“‘140 Patent”) was received on 31 January 2025, based on the following prior art patents and/or publications:

a) U.S. Patent Application Publication 2004/0143733 (EX1007, “Ophir”);

b) U.S. Patent Application Publication 2001/0053221 (EX1008, “Takeda”);

c) U.S. Patent No. 7,506,187 (EX1108, “Maddock”);

d) U.S. Patent No. 5,568,629 (EX1112, “Gentry”);

e) International Application Publication WO 2001/022322 (EX1005, "Dickinson"); and

f) Jay. J. Wylie et al., *Survivable Information Storage Systems*, COMPUTER, 33(8), 61–68 (2000) (EX1111, "Wylie").

2. PROSECUTION HISTORY OF THE '140 PATENT

The '140 Patent issued on 10 May 2016, from U.S. Application No. 13/468,383 ("'383 Application"), filed on 10 May 2012, claiming earliest priority to U.S. Provisional Application No. 60/622,146, filed on 25 October 2004.

During prosecution of the '383 Application, the examiner in charge of prosecuting the '383 Application ("examiner of record") mailed a non-final Office action on 07 July 2015 ("2015 July Non-Final Action"), in which the examiner of record rejected claims 14–28[1] as obvious over at least Dickinson. See IFW of the 383 Application, 2015 July Non-Final Action at pp. 3–10.

In response to the 2015 July Non-Final Action, Applicant filed a response on 07 December 2015 ("2015 December Response"), which included remarks and claim amendments. In their remarks, Applicant argued "Dickinson does not teach or suggest <u>including with each of the plurality of shares data indicative of the at least one session key used to secure the data set</u>, as claimed." See IFW of the 383 Application, 2015 December Response at pp. 6–7 (emphasis in original).

Subsequently, the examiner of record allowed all pending claims 14–30 (which were renumbered as patent claims 1–17), stating "Claims 14-30 are allowed. No reason for allowance

[1] Claims 1–13 were previously cancelled. See IFW of the '383 Application, claims filed on 20 May 2013.

is needed as the record is clear in light of applicant's arguments and claims amendments submitted on 12/07/2015." See IFW of the '383 Application, Notice of Allowability mailed on 10 March 2016.

3. TERMINATED INTER PARTES REVIEW (GOOGLE IPR)

The '140 Patent was involved in an *inter partes* review ("IPR") proceeding. See IPR proceeding no. 2024-00213 ("Google IPR"). Particularly, a petition for *inter partes* review of the '140 Patent was filed on 27 November 2023 (see paper no. 2; "Google Petition") by Google LLC ("Petitioner"). The Google IPR was denied institution by the PTAB on 06 June 2024 (see paper no. 8; "Decision to Deny Institution").

The Google Petition included four proposed grounds of rejection for claims 1–10, as shown in the following chart.

Ground #	Claim(s) Challenged	35 USC §	Prior Art
1	1–6, 8, 10	103	Ophir, Takeda
2	7	103	Ophir, Takeda, Birrell
3	9	103	Ophir, Takeda, Dickinson
4	1–10	103	Dickinson, Takeda

First, in its Decision to Deny Institution, and with respect to Grounds #1–3, the PTAB concluded that there is no reasonable likelihood of showing obviousness because "Petitioner has not shown a reasonable likelihood that Takeda discloses or suggests storing data on physically separable storage devices." Decision to Deny Institution at p. 15.

Second, in its Decision to Deny Institution, and with respect to Ground #4, the PTAB concluded that there is no reasonable likelihood of showing obviousness because Dickinson does

not teach “hiding the physical locations of the shares from the client device.” Decision to Deny Institution at, e.g., p. 18.

Because the Google IPR was denied institution, the Google IPR is not an earlier concluded review of the ‘140 Patent. Accordingly, none of the prior art cited in the Google IPR would be considered “old art” simply because it was cited in the Google IPR.

4. SUBSTANTIAL NEW QUESTION OF PATENTABILITY

Based on the analysis below, the Examiner concludes that a substantial new question of patentability affecting claims 1–10 of the ‘140 Patent is raised by the Request.

The Request alleges the following substantial new questions of patentability (SNQs) based on the above-identified prior art:

SNQ 1—Ophir, Takeda, and Maddock and/or Gentry for claims 1–8 and 10 (see Request, pp. 6 and 8–9; see also Request at § V.);

SNQ 2—Ophir, Takeda, Maddock and/or Gentry, and Dickinson for claim 9 (see Request, pp. 6 and 8–9; see also Request at § VI.);

SNQ 3—Ophir, Wylie, and Takeda for claims 1–5, 7–8, and 10 (see Request, pp. 6 and 9; see also Request at § VII.); and

SNQ 4—Ophir, Takeda, and Dickinson for claims 1–10 (see Request, pp. 6 and 9–10; see also Request at § VIII.).

For the reasons that follow in sections 4.1. – 4.4., the Request to reexamine claims 1–10 on the basis of SNQs 1–4 is **GRANTED**.

Furthermore, at the discretion of the Examiner, claims 11–17 will also be subject to reexamination on the basis of SNQs 1–4.

4.1. SNQ 1—Ophir, Takeda, and Maddock and/or Gentry

Prior art publication of Takeda, which is directed to a ciphering apparatus and ciphering method, is identified by the Request as allegedly teaching the limitations that previously distinguished the claims from the cited prior art during the initial examination. Specifically, the Request shows that the prior art of Takeda discloses (and/or teaches), among other things, "include with each of the plurality of shares data indicative of the at least one session key used to secure the dataset," as recited by claim 1. See Request, pp. 115–116. Therefore, the Request establishes that Takeda would have been considered important in determining the patentability of claim 1, i.e., Takeda provides a new technological teaching coinciding with, or at least related to, the limitations that previously rendered the claims patentable over the prior art in the original prosecution of the '140 Patent.

Therefore, since a reasonable examiner would consider the teachings of Takeda to be important in determining the patentability of claim 1, and because Takeda was not previously considered during the initial examination nor decided upon in the Google IPR proceeding, it alone raises a substantial new question of patentability for patented independent claim 1 and, therefore, its dependent claims (i.e., claims 2–10).

Moreover, Maddock and/or Gentry is identified by the Request as allegedly teaching the limitations that previously distinguished the claims from the cited prior art in the Google IPR. In particular, Maddock and/or Gentry is used in the Request to teach "a plurality of physical storage devices" (Request at, e.g., pp. 24, 55, and 57) upon which "shares" can be stored by a RAID controller spreading the shares or data blocks across the plurality of physical storage devices. See

Request at pp. 25 and 55–61. Moreover, the Request proposes applying the teachings of Maddock and/or Gentry to the "shares" of Ophir/Takeda (Request at, e.g., §§ V.E.1.–2.). In other words, the Request shows that the prior art of Maddock and/or Gentry at least discloses (and/or teaches) "storing data on physically separable storage devices," i.e., the limitation that the PTAB found to be missing from Takeda in denying institution of the Google IPR (see above section titled "TERMINATED INTER PARTES REVIEW (GOOGLE IPR)").

Therefore, since a reasonable examiner would also consider the teachings of Maddock and/or Gentry to be important in determining the patentability of claim 1, and because Maddock and/or Gentry was not previously considered during the initial examination nor in the Google IPR, the new prior art of Maddock and/or Gentry (in combination with the new art of Ophir and Takeda) also raises a substantial new question of patentability for patented independent claim 1 and, therefore, its dependent claims (i.e., claims 2–10).

The Examiner finds the analysis in this section similarly applies to the other independent claim (i.e., claim 11) and its dependent claims (i.e., claims 12–17). Therefore, the Examiner finds that the new prior art combination raises a substantial new question of patentability for patented claims 1–17.

4.2. SNQ 2—Ophir, Takeda, Maddock and/or Gentry, and Dickinson

As determined in the previous section, the prior art reference combination of Ophir, Takeda, and Maddock and/or Gentry raises a substantial new question of patentability for patented claims 1–17. Therefore, for the same reasons as above, the prior art reference combination of Ophir, Takeda, Maddock and/or Gentry, and Dickinson also raises a substantial new question of patentability for claim 9.

4.3. SNQ 3—Ophir, Wylie, and Takeda

As noted above with respect to SNQ 1, since a reasonable examiner would consider the teachings of Takeda to be important in determining the patentability of claim 1, and because Takeda was not previously considered during the initial examination nor decided upon in the Google IPR proceeding, it alone raises a substantial new question of patentability for patented independent claim 1 and, therefore, its dependent claims (i.e., claims 2–10).

Moreover, Wylie is identified by the Request as allegedly teaching the limitations that previously distinguished the claims from the cited prior art in the Google IPR. In particular, Wylie is used to teach a thresholding agent to generate shares of encrypted data and to disperse the shares across a plurality of physical storage devices (Request at pp. 109–110 and § VII.A.). Moreover, the Request proposes applying the teachings of Wylie to the "plurality of physical storage devices" of Ophir (Request at, e.g., p. 110). In other words, the Request shows that the prior art of Wylie alone (and in combination with Ophir) at least discloses (and/or teaches) "storing data on physically separable storage devices," i.e., the limitation that the PTAB found to be missing from Takeda in denying institution of the Google IPR (see above section titled "TERMINATED INTER PARTES REVIEW (GOOGLE IPR)").

Therefore, since a reasonable examiner would also consider the teachings of Wylie to be important in determining the patentability of claim 1, and because Wylie was not previously considered during the initial examination nor in the Google IPR, the new prior art of Wylie (in combination with the new art of Ophir and Takeda) also raises a substantial new question of patentability for patented independent claim 1 and, therefore, its dependent claims (i.e., claims 2–10).

The Examiner finds the analysis in this section similarly applies to the other independent claim (i.e., claim 11) and its dependent claims (i.e., claims 12–17). Therefore, the Examiner finds

that the new prior art combination raises a substantial new question of patentability for patented claims 1–17.

4.4. SNQ 4—Ophir, Takeda, and Dickinson

As noted above with respect to SNQ 1, since a reasonable examiner would consider the teachings of Takeda to be important in determining the patentability of claim 1, and because Takeda was not previously considered during the initial examination nor decided upon in the Google IPR proceeding, it alone raises a substantial new question of patentability for patented independent claim 1 and, therefore, its dependent claims (i.e., claims 2–10).

Moreover, Ophir and Dickinson is identified by the Request as allegedly teaching the limitations that previously distinguished the claims from the cited prior art in the Google IPR. In particular, Ophir is used in the Request to teach "a plurality of physical storage devices"[2] (Request at, e.g., p. 129, "Ophir's plurality of storage devices 411, 413 and 415"). Dickinson is also used in the Request to teach "a plurality of physical storage devices," e.g., D1–D4 of fig. 7 (Request at p. 125) and for teaching "splitting sensitive data and distributing it to different ones of the data storage facilities" (Request at p. 125). The Request also proposes to apply Dickinson's teachings to Ophir's storage devices (Request at, e.g., 129). In other words, the Request shows that the prior art of Ophir and Dickinson at least discloses (and/or teaches) "storing data on physically separable storage devices," i.e., the limitation that the PTAB found to be missing from Takeda in denying institution of the Google IPR (see above section titled "TERMINATED INTER PARTES REVIEW (GOOGLE IPR)"). The Examiner finds that the

[2] The PTAB never addressed whether Ophir taught this limitation, but instead merely noted "[t]he Petition does not suggest that Ophir teaches storing shares among different physical storage devices." Decision to Deny Institution at p. 15.

Request's use of Ophir and Dickinson is a new argument never presented during the prosecution of the '383 Application nor the Google IPR.

Therefore, since a reasonable examiner would also consider the teachings of Ophir and Dickinson to be important in determining the patentability of claim 1, and because Ophir and Dickinson *as presented and argued in the Request* was not previously considered during the initial examination nor in the Google IPR, it too raises a substantial new question of patentability for patented independent claim 1 and, therefore, its dependent claims (i.e., claims 2–10).

The Examiner finds the analysis in this section similarly applies to the other independent claim (i.e., claim 11) and its dependent claims (i.e., claims 12–17). Therefore, the Examiner finds that the new prior art combination raises a substantial new question of patentability for patented claims 1–17.

5. 35 USC § 325(d)

On March 20, 2025, Patent Owner filed a petition under 37 CFR. § 1.183 requesting waiver of the provisions of 37 CFR § 1.515(a) and § 1.540 and under 37 CFR § 1.182 to reject the request for reexamination under 35 USC 325(d).

On April 3, 2025, Third Party Requester filed an opposition to Patent Owner's petition under 37 CFR § 1.182 to reject the request for reexamination under 35 USC § 325(d).

On April 7, 2025, the Office issued a decision granting Patent Owner's March 20, 2025, 37 CFR § 1.183 petition, which waived the rules to the extent necessary to permit entry and consideration of patent owner's March 20, 2025, 37 CFR § 1.182 petition and Third Party Requester's arguments in their April 3, 2025 Opposition. The decision specifically stated that

the CRU would consider these arguments in making its determination on the request in the present reexamination proceeding.

In light of the April 7, 2025 petition decision, the discussion below takes into consideration the § 325(d) information presented in Patent Owner's March 20, 2025, 37 CFR § 1.182 petition and Third Party Requester's April 3, 2025 Opposition. Per the April 7, 2025 decision, this Order will not consider any arguments by Third Party Requester or Patent Owner directed to the patentability of the claims.

35 USC § 325(d) states in part that "[i]n determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office." Thus, in order for the Director to exercise discretion as to whether to Order a reexamination proceeding under chapter 30, the request must first be determined to be based on the same or substantially the same prior art or arguments that previously were presented to the Office.

A review of the post grant history of the '140 Patent indicates that the patent was the subject of a single Office post grant challenge filed prior to the filing of the filing of the instant *ex parte* reexamination request (90/019,836).

On November 27, 2023, Petitioner Google Inc., also the Requester in this proceeding, filed a petition (IPR2024-00213) for *inter partes* review of claims 1–10 of the '140 Patent which asserted the following grounds as raising a reasonable likelihood of prevailing (RLP):

RLP Ground	Claims	Basis	References
#1	1–6, 8, 10	35 USC 103	Ophir, Takeda
#2	7	35 USC 103	Ophir, Takeda, Birrell
#3	9	35 USC 103	Ophir, Takeda, Dickinson
#4	1–10	35 USC 103	Dickinson, Takeda

In a Decision Denying Institution mailed on June 6, 2024, the Patent Trial and Appeal Board (PTAB) denied institution of the proceeding finding the petitioner did not establish a reasonable likelihood of prevailing with respect to any challenged claims. Denial at 20. With respect to Takeda, the PTAB found that "We determine that Takeda does not teach or suggest storing this data in at least two separate media, at least two separate storage devices, or at least one of each." Denial at 15. Regarding Ophir, the PTAB found that "The Petition does not suggest that Ophir teaches storing shares among different physical storage devices. As the Petition itself notes, Ophir seems to use a single 'mediator [to] provide[] secure virtual storage to data clients.'" *Id.* Regarding Dickinson, the PTAB found that "While the cited disclosure from Dickinson mentions 'cryptographic keys,' we see nothing in this disclosure about hiding the physical locations of the shares from the client device." Denial at 18. On July 8, 2024, Petitioner filed a Request for Rehearing of the June 6, 2024 Decision Denying Institution. On July 30, 2024, in a Decision Denying Petitioner's Request on Rehearing, the PTAB stated: "Petitioner has not carried its burden of demonstrating that the Decision denying institution of *inter partes* review of challenged claims 1-10 of the '140 patent misapprehended or overlooked any relevant matters of that the Board abused its discretion." Rehearing Denial at 10-11.

A comparison between the current request (90/019,836) and the single prior post grant challenge to the '140 patent (IPR2024-00213) indicates that the current request is based, in part, on the same or substantially the same prior art or arguments that were previously presented to the Office. Thus, the statutory threshold pursuant to 35 USC 325§ (d) to permit the Director to exercise to discretion to reject the instant reexamination request is met.

As stated above, the current reexamination request asserts the following grounds as raising an SNQ to the claims of the ‘140 patent:

SNQ Ground	Claims	Basis	References
#1	1–8, 10	35 USC 103	Ophir, Takeda, RAID (Maddock and/or Gentry)
#2	9	35 USC 103	Ophir, Takeda, RAID, Dickinson
#3	1–5, 7–8, 10	35 USC 103	Ophir, Wylie, Takeda
#4	1–10	35 USC 103	Ophir, Takeda, Dickinson

As an initial matter, SNQ 4 is identical to RLP 3 in IPR 2024-00213 citing the combination of Ophir, Takeda and Dickinson. However, a review of IPR2024-00213 indicates that the PTAB did not fully evaluate the combination of Ophir, Takeda and Dickinson, instead stating that Petitioner’s challenges to dependent claim 9 in RLP 3 relied on the purported obviousness of claim 1 and for the reasons give for claim 1, the PTAB determined that Petition had failed to demonstrate a reasonable likelihood of prevailing with respect to RLP 3. Denial at 16. Furthermore, as noted above, the Examiner determined that the Request shows that the prior art of Ophir and Dickinson at least discloses (and/or teaches) “storing data on physically separable storage devices,” i.e., the limitation that the PTAB found to be missing from Takeda in denying institution of IPR2024-00213. In addition, SNQs 1-3 in the Request are not based on identical grounds asserted in the prior IPR petition and the arguments in the Request relate to the new prior art combinations. A review of newly presented RAID (Maddock and Gentry) and Wylie prior art references indicates that these references have a different disclosure and are not cumulative to any of the references presented in the prior IPR petition. As noted above by the Examiner, the Request shows that the prior art of Maddock and/or Gentry at least discloses (and/or teaches) “storing data on physically separable storage devices,” i.e., the limitation that

the PTAB found to be missing from Takeda in denying institution of IPR2024-00213. Furthermore, as noted above by the Examiner, the Request shows that the prior art of Wylie alone (and in combination with Ophir) at least discloses (and/or teaches) "storing data on physically separable storage devices," i.e., the limitation that the PTAB found to be missing from Takeda in denying institution of IPR2024-00213. Accordingly, the Examiner as delegated by the Director declines to exercise discretion to reject this Request.

Patent Owner's March 20, 2025 Petition

In Patent Owner's March 20, 2025 petition, Patent Owner asserts that each of the references upon which the third-party requester relies (the RAID references of Maddock and/or Gentry and Wylie) are the same as, substantially similar to or otherwise cumulative of references disclosed and/or considered during the original prosecution of the '140 patent. Petition at 1. Patent Owner also argues that the third-party requester has used the PTAB's decision in IPR2024-00213 as a roadmap for its request and makes no attempt to show that the RAID and Wylie references add anything beyond what has previously been presented to and considered by the Office during the prosecution of the '140 patent. Petition at 2. Patent Owner also argues that no matter which standard the Office applies – 1) the Office's guidance in *Advanced Bionics/Becton*, 2) the Federal Circuit's decision in *Vivint*, or 3) the Office's guidance in *Ariosa* – the Office should deny the request. *Id.*

Regarding the RAID references and Wylie, it is first noted that reexamination is designed to allow the Office to revisit technical teachings it overlooked in the original examination or in another proceeding. 35 U.S.C. § 303(a) provides that "[t]he existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office." Further, the section of the

statute, 35 U.S.C. § 304, that requires the Director to order reexamination when an SNQ affecting any claim of a patent is raised by a request, is separate and distinct from the last sentence of 35 U.S.C. § 325(d). An argument regarding whether the art relied on in the request is cumulative goes to whether the Examiner properly found an SNQ. In the present case, the Examiner analyzed the original prosecution of the '140 patent and found that the proposed grounds challenging the claims raise an SNQ as to claims 1-20. To the extent Patent Owner is challenging the Examiner's SNQ findings, the issue of whether the examiner properly found an SNQ is a separately petitionable matter.[3]

Regarding the Third Party Requester using the PTAB's decision in IPR2024-00213 as a roadmap, this argument is not persuasive. Assuming, *arguendo*, that Third Party Requester attempted to use the prior IPR decision as a roadmap for the request as Patent Owner asserts, the specific discretion provided at 35 U.S.C. § 325(d) does not address those concerns. In the context of IPRs, the USPTO has addressed concerns regarding using IPR petitions to cure deficiencies identified in a previously filed IPR petition under the broad institution discretion afforded by the AIA to those proceedings at 35 U.S.C. § 314(a).[4] The 35 U.S.C. § 314(a) provisions applicable to the *inter partes* review process do not apply to *ex parte* reexamination. Patent Owner's request for the Office to exercise authority under 35 U.S.C. § 314(a) to deny this

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[3] *See* MPEP § 2246, subsection II.

[4] *See, General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper No. 19, Section II.B.4.i (PTAB Sept. 6, 2017) (precedential), p. 17 (In discussing *General Plastic* "factor 3" (*i.e.*, whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition) the PTAB states, "The absence of any restrictions on follow-on petitions would allow petitioners the opportunity to strategically stage their prior art and arguments in multiple petitions, using our decisions as a roadmap, until a ground is found that results in the grant of review.").

reexamination request cannot be granted because that statutory authority does not apply to reexamination.

Regarding the application of the standards set forth in *Advanced Bionics/Becton*, these arguments are not persuasive. An *ex parte* reexamination proceeding is not a trial proceeding. The *Becton* factors were specifically formulated to apply to AIA trial proceedings, not to *ex parte* reexamination proceedings. The PTAB's Trial Practice Guide expressly states, in reference to the *Becton* factors (emphasis added):

> The above-listed factors are considered by the Board when determining whether to institute a trial. When determining whether to order *ex parte* reexamination, however, the Office may not necessarily consider these factors. **An *ex parte* reexamination proceeding is not a trial proceeding, and the considerations with respect to issues involving 35 U.S.C. § 325(d) may differ due to the different nature of an *ex parte* reexamination proceeding.**

However, even if the Office were to consider the *Advanced Bionics/Becton* factors in this instance, the *Advanced Bionics* framework is not satisfied under the facts and circumstances of this case and therefore does not support an exercise of the Office's discretion under the permissive language of § 325(d). The two-part framework of *Advanced Bionics* includes: (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of the first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. Here, as set forth above, the Examiner determined that neither the art nor the arguments advanced in the request are the same or substantially the same as those previously presented to the Office in the IPR petition. Therefore, part (1) of *Advanced Bionics* is not satisfied in this

instance and an exercise of discretion under § 325(d) would not be warranted, even absent any showing of error under part of the framework.

Regarding the application of *Vivint*, Patent Owner's expansive interpretation of *Vivint* is contrary to the Federal Circuit's own characterization of its ruling in *Vivint* as "narrow" and "limited."[5] Unlike *Vivint*, there are no prior proceedings involving the '140 patent that were denied under § 325(d). Rather, there was only one prior IPR filed on the '140 patent, which was denied institution on the merits. Although the present reexamination proceeding is requester's second attempt at challenging claims of the '140 patent, unlike the fact pattern in *Vivint*, there was no finding that third party requester's prior IPR petition was undesirable, incremental or abusive.

Regarding the application of *Ariosa*, this argument is not persuasive. Unlike the five challenges to the patent in *Ariosa*, in the instant request, the Third Party Requester has filed a single IPR petition followed by a single reexamination request. Furthermore, as noted above, the Third Party Requester has provided an explanation in the request as to how the RAID references and Wylie are proposed to address the features that the PTAB found were lacking from the prior art in IPR 2024-00213. The Third Party Requester, in the instant request, did not delay in filing the reexamination request.[6] Finally, IPR2024-00213 was not instituted.

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[5] *Vivint*, 14 F.4th at 1354 (stating, "Our holding today is narrow. Section 325(d) applies to both IPR petitions and requests for *ex parte* reexamination. Thus, the Patent Office, when applying § 325(d), cannot deny institution of IPR based on abusive filing practices then grant a nearly identical reexamination request that is even more abusive."). *See, e.g.*, *In re Knauf Insulation, Inc.*, No. 22-166, 2022 WL 17098755, at *2 (Fed. Cir. Nov. 22, 2022) (limiting *Vivint* to its facts).

[6] The instant reexamination request was filed on January 31, 2025. The decision on rehearding from the PTAB was mailed on July 30, 2024.

In view of the facts set forth above, the Examiner as delegated by the Director has declined to exercise discretion to reject this Request.

Accordingly, the Request to reexamine claims 1-10 of the '140 patent is GRANTED in view of the determination above that the Request raises a substantial new question of patentability (SNQ) as to the requested claims.

6. PATENT OWNER STATEMENT (OPTIONAL)

In response to this Order for Reexamination, the Patent Owner is given a two (2) month period to file an optional Patent Owner Statement in accordance with 37 CFR § 1.530(b) and (c). The Patent Owner Statement must clearly point out why the patent claims are believed to be patentable, considering the cited prior art patents or printed publications alone or in any reasonable combination. In addition, the Patent Owner may utilize the Patent Owner Statement to introduce amendments. A copy of the Patent Owner Statement must be served on the Third Party Requester. See MPEP § 2249.

If a Patent Owner Statement is timely filed and served on the Third Party Requester, the Third Party is given the opportunity to reply within two (2) months from the date of service in accordance with 37 CFR § 1.535. The reply need not be limited to the issues raised in the Patent Owner Statement and may include additional prior art patents and printed publications as well as any issue appropriate for reexamination. A copy of the reply must be served on the Patent Owner. If no Patent Owner Statement is filed, no reply is permitted from the Third Party Requester. See MPEP § 2251.

7. WAIVER OF RIGHT TO FILE PATENT OWNER STATEMENT

In a reexamination proceeding, Patent Owner may waive the right under 37 CFR § 1.530 to file a Patent Owner Statement for the purposes of expediting prosecution; see MPEP § 2249. The document should contain a statement that Patent Owner waives the right under 37 CFR § 1.530 to file a Patent Owner Statement and proof of service in the manner provided by 37 CFR § 1.248, if the request for reexamination was made by a third party requester; see 37 CFR § 1.550(f). The Patent Owner may consider using the following statement in a document waiving the right to file a Patent Owner Statement:

WAIVER OF RIGHT TO FILE PATENT OWNER STATEMENT

Patent Owner hereby waives the right under 37 CFR § 1.530 to file a Patent Owner Statement.

8. NOTICE OF OTHER PROCEEDINGS

The Patent Owner is reminded of the continuing responsibility under 37 CFR § 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 9,338,140 throughout the course of this reexamination proceeding. The Third Party Requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

9. NOTICE RE PATENT OWNER'S CORRESPONDENCE ADDRESS

37 CFR § 1.33(c) states:

> (c) All notices, official letters, and other communications for the patent owner or owners in a reexamination or supplemental examination proceeding will be directed to the correspondence address in the patent file.

The correspondence address for any pending reexamination proceeding not having the same correspondence address as that of the patent is, by way of this revision to 37 CFR § 1.33(c), automatically changed to that of the patent file as of the effective date.

This change is effective for any reexamination proceeding which is pending before the Office as of May 16, 2007, including the present reexamination proceeding, and to any reexamination proceeding which is filed after that date.

Parties are to take this change into account when filing papers, and direct communications accordingly.

In the event the patent owner's correspondence address listed in the papers (record) for the present proceeding is different from the correspondence address of the patent, it is strongly encouraged that the patent owner affirmatively file a Notification of Change of Correspondence Address in the reexamination proceeding and/or the patent (depending on which address patent owner desires), to conform the address of the proceeding with that of the patent and to clarify the record as to which address should be used for correspondence.

Telephone Numbers for reexamination inquiries:

Reexamination	(571) 272-7703
Central Reexam Unit (CRU)	(571) 272-7705

10. CONCLUSION

Extensions of time under 37 CFR § 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR § 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 USC § 305 requires that *ex parte* reexamination proceedings "will be conducted with special dispatch" (37 CFR § 1.550(a)). Extensions of time in *ex parte* reexamination proceedings are provided for in 37 CFR § 1.550(c).

All correspondence relating to this *ex parte* reexamination proceeding should be directed:

Electronically: Registered users may submit via Patent Center at https://patentcenter.uspto.gov/.

By Mail: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By Fax: (571) 273-9900
Central Reexamination Unit

By hand: Customer Service Window
Knox Building
501 Dulany Street
Alexandria, VA 22314

For Patent Center transmissions, 37 CFR § 1.8(a)(1)(i)(C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR § 1.6(a)(4) , and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

Any inquiry concerning this communication should be directed to Jacob C. Coppola at (571) 270-3922. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew J. Fischer can be reached at (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-9900.

Information regarding the status of this proceeding may be obtained from the USPTO's Patent Center. To file and manage patent submissions in Patent Center, visit: https://patentcenter.uspto.gov. Visit https://www.uspto.gov/patents/apply/patent-center for more information about Patent Center and https://www.uspto.gov/patents/docx for information about filing in DOCX format. For additional questions, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative, call (800) 786-9199 (in USA or Canada) or (571) 272-1000.

General inquiries may also be directed to the Central Reexamination Unit customer service line at (571) 272-7705.

/JACOB C. COPPOLA/
Primary Examiner, Art Unit 3992

Conferees:

/YUZHEN GE/
Primary Examiner, Art Unit 3992

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Supervisory Patent Reexamination Specialist, Art Unit 3992