

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AIRBUS S.A.S.
Requester and Respondent

v.

FIREPASS CORPORATION
Patent Owner and Appellant

Appeal 2013-008166
Reexamination Control No. 95/001,555
Patent 6,418,752 B2
Technology Center 3900

Before JOHN C. KERINS, DANIEL S. SONG, and
MICHAEL J. FITZPATRICK, *Administrative Patent Judges*.

FITZPATRICK, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appeal 2013-008166
Reexamination Control No. 95/001,555
Patent 6,418,752 B2

Requester Airbus S.A.S. filed, on December 2, 2013, a Request for Rehearing under 37 C.F.R. § 41.52 (hereinafter “Request”) of our Decision mailed October 30, 2013 (“Dec.”) concerning cross-appeals from an *inter partes* reexamination of Patent 6,418,752 B2 (the “’752 Patent”). Patent Owner, FirePASS Corporation, opposes rehearing.

In our Decision, we affirmed the Examiner’s rejection of various claims but reversed the Examiner’s rejection of claims 91-94. Dec. 25. We also dismissed, for lack of jurisdiction, Requester’s cross-appeal from the Examiner’s non-adoption of Requester-proposed rejections of certain claims, including claims 91-94. *Id.* Requester requests rehearing of our dismissal of its cross-appeal with respect to claims 91-94.

The request for rehearing is denied.

ANALYSIS

During the reexamination, Requester proposed the following rejections of claims 91-94, which were added during the reexamination:

claims 91-93 over Kotliar ’652¹ in view of AFWAL 2060²;

claim 94 over Kotliar ’652 in view of AFWAL 2060 and Knight³; and

¹ US 5,799,652 (Sept. 1, 1998).

² Boeing Military Airplane Co., “Vulnerability Methodology and Protective Measures for Aircraft Fire and Explosion Hazards,” Final Report AFWAL-TR-85-2060 (1986).

Appeal 2013-008166
Reexamination Control No. 95/001,555
Patent 6,418,752 B2

claim 94 over Kotliar '652 in view of AFWAL 2060 and knowledge of one of ordinary skill in the art. RAN 25⁴; Req. App. Br. 4.⁵

In response, the Examiner stated: "The proposed rejection [sic, rejections] in view of AFWAL 2060, Knight or Mannatt SAE are not considered as these publications have not raised a substantial new question of patentability." ACP 25⁶; RAN 25.

"Lack of a substantial new question of patentability is not a favorable decision on patentability." *Belkin Int'l, Inc. v. Kappos*, 696 F.3d 1379, 1383 (Fed. Cir. 2012). Relying on this holding, we dismissed the Requester's cross-appeal for lack of jurisdiction. Dec. 24 (also citing 35 U.S.C. §§ 134 (c) and 315(b) (2002); 37 C.F.R. § 41.61(a)(2) (providing review for decisions "favorable to the patentability" of a claim)).

Requester argues that, in dismissing its cross-appeal, we "misapprehended or overlooked" two things. Request 1. The first is that Requester "had the right to appeal a 'decision favorable to the patentability of any . . . new claim,' such as claims 91-94." *Id.* (quoting 35 U.S.C. § 315(b)(1) (2002)). This argument is not persuasive. We expressly acknowledged the statutes, 35 U.S.C. §§ 134 (c) and 315(b) (2002), and rule,

³ Knight, T.C., *et al.*, "The AH-64A Nitrogen Inerting System," AIAA-84-2480 (1991).

⁴ Right of Appeal Notice (May 11, 2012).

⁵ Requester's Cross-Appeal Brief (Aug. 27, 2012).

⁶ Action Closing Prosecution (Jan. 3, 2012).

Appeal 2013-008166
Reexamination Control No. 95/001,555
Patent 6,418,752 B2

37 C.F.R. § 41.61(a)(2), that provide for review of a decision favorable to the patentability of any claim, including new claims. Dec. 24. However, and as we noted, the Examiner stated that he did not consider the proposed rejections due to a lack of a substantial new question of patentability. Dec. 23 (quoting ACP 25; RAN 25). Thus, following *Belkin's* holding that “[l]ack of a substantial new question of patentability is not a favorable decision on patentability,” *Belkin*, 696 F.3d at 1383, we dismissed the cross-appeal. Dec. 24.

Secondly, the Requester argues that we also “misapprehended or overlooked” that “the non-appealability under 35 U.S.C. § 312 of the Director’s determination on the initial reexamination request that certain prior art did not raise a substantial new question of patentability with respect to original claims 1, 2, 4, 7 and 8 did not apply to new claims 91-94.” Request 1.⁷ This argument is also not persuasive. We did not base our dismissal on the Director’s determination on the *initial* reexamination request regarding the art in question. Indeed, we did not even mention 35

⁷ In its Request for Reexamination (p. ii), Requester had proposed rejections of original claims 1, 2, 7, and 8 as anticipated by each of *Kotliar '652*, *AFWAL 2060*, and *Knight*, among other references. The Examiner ordered reexamination, finding that *Kotliar '652* (among other references) presented a substantial new question of patentability, but also finding that *AFWAL 2060* and *Knight* (as well as other references) did not. *See Order Granting Request for Reexamination* (April 18, 2011) 4, 7.

Appeal 2013-008166
Reexamination Control No. 95/001,555
Patent 6,418,752 B2

U.S.C. § 312. Rather, our dismissal was based on the Examiner's statement, in the Action Closing Prosecution as well as the Right of Appeal Notice, that he did not consider the proposed rejections because of a lack of a substantial new question of patentability. *See* Dec. 23 (quoting ACP 25; RAN 25). To the extent that the Examiner (as opposed to the Board) hinged his non-consideration of the proposed rejections of claims 91-94 on the prior determination on the *initial* reexamination request regarding the art in question, and that such action was in error, then the Requester could have sought remedy through a petition. This too was also pointed out in the Decision. Dec. 24 n.12.

DECISION

The request for rehearing is denied.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

DENIED

Appeal 2013-008166
Reexamination Control No. 95/001,555
Patent 6,418,752 B2

cc:

PATENT OWNER:

ORRICK, HERRINGTON & SUTCLIFFE, LLP
IP PROSECUTION DEPARTMENT
2050 Main Street, Suite 1100
IRVINE, CA 92614

THIRD PARTY REQUESTER:

Clifford A. Ulrich
KENYON & KENYON LLP
One Broadway
New York, NY 10004

kis