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GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			NGUYEN, LINH M	
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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.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VICOR CORPORATION,
Requester,

v.

SYNQOR, INC.,
Patent Owner.

Appeal 2014-007587
Reexamination Control 95/001,637
Patent 7,272,021 B2
Technology Center 3900

Before JAMES T. MOORE, STEPHEN C. SIU, and
DENISE M. POTHIER, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*

DECISION ON REQUEST FOR REHEARING

Appeal 2014-007587
Reexamination Control 95/001,637
Patent 7,272,021 B2

Patent Owner requests rehearing (Patent Owner’s Request for Rehearing, dated March 20, 2019, “Req. Reh’g.”) of our Decision on Remand entered February 20, 2019 (“Decision”), in which we maintained our affirmance of the Examiner’s rejection of the following claims of U.S. Patent 7,272,021 B2 (“the ’021 patent”): claims 1, 9, 15, 21, 24, 26, 31, 39, 45, and 47 under 35 U.S.C. § 102(b) as anticipated by Steigerwald ’090, claims 22, 23, 25, and 27–30 under 35 U.S.C. § 103(a) over Steigerwald ’090 and the knowledge of one of ordinary skill in the art, claim 49 under 35 U.S.C. § 103(a) over Steigerwald ’090 and Pressman, and claim 50 under 35 U.S.C. § 103(a) over Steigerwald ’090, Pressman, and APA. Decision 9.

Patent Owner now informs us that the ’021 patent “expired in January 2018, well before the Board issued its February 20, 2019 Decision on Remand,” that “claims 49 and 50 . . . were newly added during the reexamination proceeding,” and, as such, claims 49 and 50 should be canceled. Req. Reh’g. 1, 3–4. We agree with Patent Owner.

We also note, under the circumstances and in accordance with the affirmance by the Federal Circuit of Rejections I¹ and II,² that claims 1, 9, 15, 21–31, 39, 45, and 47 should also be canceled.

¹ Claims 1, 9, 15, 21, 24, 26, 31, 39, 45, and 47 are anticipated by Steigerwald ’090. *Vicor Corp v. Synqor, Inc.*, 869 F.3d 1309, 1319, 1324 (Fed Cir. 2017).

² Claims 22, 23, 25, and 27-30 are obvious over Steigerwald ’090 in view of the knowledge of a person skilled in the art. *Vicor Corp v. Synqor, Inc.*, 869 F.3d 1309, 1319, 1326 (Fed Cir. 2017).

Patent Owner argues that “[t]he Board’s Decision on Remand should be vacated” because Patent Owner was supposedly not given “an opportunity to submit briefing.” Req. Reh’g. 1. We disagree with Patent Owner for at least the reasons set forth by Requester. Requester Comments to Patent Owner Rehearing Request (3PR Comments) 5–7.

In addition to those reasons, which we adopt, Patent Owner does not explain persuasively why an alleged lack of opportunity to file a brief would necessitate vacating our previous decision. More importantly, we are not persuaded by Patent Owner’s argument (provided in Patent Owner’s briefing) at least because Patent Owner has been given an opportunity to brief the issue and has, in fact, filed a response (i.e., Patent Owner’s Request for Rehearing).

Patent Owner does not adequately explain how the filing of the present request for rehearing does not constitute an opportunity to file a brief explaining what, if anything, the panel overlooked. For at least this additional reason and given that Patent Owner has filed a brief, we cannot agree with Patent Owner that Patent Owner did not have an opportunity to file a brief, even assuming that whether or not Patent Owner had an opportunity to file a brief is somehow pertinent to the question of whether our previous decision should be vacated or not.

Patent Owner does not provide alternative reasons as to why the drastic step of vacating our previous decision would be necessary. Furthermore, we agree with Requester that Patent Owner has not provided a sufficient reason to vacate our previous decision. 3PR Comments 3–5.

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Thus, we grant Patent Owner's request for rehearing to the extent that we remand this matter to the Examiner to issue a Reexamination Certificate. All other aspects of the Decision remain unchanged.

GRANTED-IN-PART