

Client Alert: Debunking Conventional Wisdom –
You CAN End *Inter Partes* Reexamination

The following pages are the following documents (page numbers at page bottom):

Page 1 - A PTO CRU examiner's Right of Appeal Notice excerpted to show the reexamination was not maintained as to original claims. See page

Page 4 - The federal court Final Decision and Order Pursuant to Stipulation which provided for the decision in the Right of Appeal Notice.

The Notice does not maintain reexamination as to original claims, but does maintain reexamination as to new claims added during reexamination. The proceeding is expected to result in a Reexamination Certificate.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,437	02/03/2009	7174661	051291.00218	8842

22908 7590 05/06/2010
BANNER & WITCOFF, LTD.
TEN SOUTH WACKER DRIVE
SUITE 3000
CHICAGO, IL 60606

RECEIVED

MAY 13 2010

BANNER & WITCOFF
DOCKETING DEPT.

EXAMINER

FOSTER, JIMMY G

ART UNIT	PAPER NUMBER
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3993

MAIL DATE	DELIVERY MODE
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05/06/2010

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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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

Date:

MAILED

MAY 06 2010

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000437
PATENT NO. : 7174661
TECHNOLOGY CENTER : 3999
ART UNIT : 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

PTOL-2070(Rev.07-04)

Art Unit: 3993

Effect of Final Decision and Order by U.S. District Court regarding the Patent Claims

A Decision and Order has been rendered on March 8, 2010 by the U.S. District Court for the Northern District of California, stating:

Pursuant to joint motion and stipulation of the Plaintiff, ESCO Corporation and Defendant, Berkeley Forge & Tool, Inc., which includes the stipulation that this final decision should be entered, this Court enters this final decision that Berkeley Forge & Tool, Inc. has not sustained its burden of proving the invalidity of any patent claim of U.S. Patent No. 7,171,771 or U.S. Patent No. 7,174,661. This action is dismissed with prejudice. This decision is an Order of the Court which is final, enforceable and not appealable.

(see NPL (03/12/2010)). Accordingly reexamination in this proceeding is not being maintained for patent claims 1-44; thus, claims 1-44 are no longer subject to reexamination in this proceeding.

Amendments after ACP

The amendments after ACP, filed November 25, 2009 (see RXPET. (11/25/2010)) and March 12, 2010 (see XI.A... (03/12/2010)), are entered for examination and are considered in this Right of Appeal Notice (RAN).

Claim Status

Claims Not Subject to Reexamination in this Proceeding: 1-44

Claims Examined and Allowed: 51-60, 62, 64-71, 74, 75, 77, 78, 82, 84 and 86

Canceled Claims: 45-50, 61, 63, 72, 73, 76, 79-81, 83 and 85


Rejected Claims: None

ESCO CORPORATION)	
an Oregon corporation,)	
)	
Plaintiff,)	Case No. CV 09-1635 SBA
)	
v.)	FINAL DECISION AND ORDER
)	PURSUANT TO STIPULATION
BERKELEY FORGE & TOOL, INC.,)	
a California Corporation,)	
)	
Defendant.)	
)	

Pursuant to joint motion and stipulation of the Plaintiff, ESCO Corporation and Defendant, Berkeley Forge & Tool, Inc., which includes the stipulation that this final decision should be entered, this Court enters this final decision that Berkeley Forge & Tool, Inc. has not sustained its burden of proving the invalidity of any patent claim of U.S. Patent No. 7,171, 771 or U.S. Patent No. 7,174,661. This action is dismissed with prejudice. This decision is an Order of the Court which is final, enforceable and not appealable.

IT IS SO ORDERED.

Dated: March 8, 2010

By: 
The Honorable Sandra B. Armstrong
United States District Court Judge