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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/019,423	02/21/2024	9539167	21687.068H-US-RE	6237
26359 7590 04/16/2024 MAYNARD NEXSEN PC (Birmingham) 1901 Sixth Avenue North Suite 1700 Birmingham, AL 35203			EXAMINER DAWSON, GLENN K	
			ART UNIT 3993	PAPER NUMBER
			MAIL DATE 04/16/2024	DELIVERY MODE 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. 90/019,423 .

PATENT UNDER REEXAMINATION 9539167 .

ART UNIT 3993 .

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)).

<b>Order Denying Request For Ex Parte Reexamination</b>	<b>Control No.</b> 90/019,423	<b>Patent Under Reexamination</b> 9539167	
	<b>Examiner</b> GLENN K DAWSON	<b>Art Unit</b> 3993	<b>AIA (FITF) Status</b> Yes

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

The request for *ex parte* reexamination filed 02/21/2024 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: \_\_\_\_\_

The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 ( c ) will be made to requester:

- a) ☐ by Treasury check or,
- b) ☒ by credit to Deposit Account No. 503545 , or
- c) ☐ by credit to a credit card account, unless otherwise notified (35 U.S.C.303(c)).

/GLENN K DAWSON/ Primary Examiner, Art Unit 3993	/SBM/ Primary Examiner Art Unit 3993	/EILEEN D LILLIS/ SPRS, Art Unit 3993
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cc: Requester ( if third party requester )

## **REEXAMINATION OFFICE ACTION**

### ***Notice of Pre-AIA or AIA Status***

The present application, filed on or after March 16, 2013, is being examined under the first inventor to file provisions of the AIA.

### ***Notification of Concurrent 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. 9,539,167 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.

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 U.S.C. 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).

***Previous Examinations of the '167 patent***

In the previous examination of Application Serial No. 12/930,573 which matured into the '167 patent, claims 1-14 were originally rejected on art under 102 using Nichols-6,449,788, Prien-2,052,656, Baerwalde-2005/0085749, and under 103 using Baerwalde, Nichols and Olsen-523,679. Following an amendment on 12-23-2013 the claims were rejected under 102 using Nichols, Doherty-6,764,456, Prien, and under 103 using Doherty, Nichols and Olsen. An RCE was filed on 06-05-2014. Rejections using Langer-2001/0009043, Nichols, Olsen, Riley-2005/0177946, Davis-6,692,416, Banks-2005/0177946 followed in later office actions. Ultimately, the examiner in the '573 application found the claims allowable and at the time of allowance the examiner provided the following examiner's reasons for allowance of the claims: "Applicants amendments to indicate "a two piece therapeutic, fitness, and sports enhancement device consisting of: a first piece including an entirely cylindrically shaped core made of closed cell foam, plastic, or rubber and having a diameter of about 3 inches to about 15 inches; and a second piece including an overlay about the cylindrically shaped core, the overlay made of closed cell foam, plastic, or rubber, including a plurality of shaped projections extending from the overlay",

additionally overcomes the prior art of Langer (US 20010009043) since although Langer teaches that the solid core and outer layer is made of foam, Langer teaches that the foam is an open cell foam. Applicants limitation of the first and second piece made of closed cell foam, plastic, or rubber is critical over the open cell foam of Langer such that the materials as indicated would provide higher resistance to compression suitable for extending into soft tissue of a user, whereas modification of the open cell foam of Langer to be closed cell, plastic, or rubber would provide more resistance to compression than desired by the device of Langer which could result in pressure ulcers not desired by the device of Langer.

Through the course of prosecution, the Office is convinced in Applicants assertion that the device consisting of a first piece solid core and a second piece overlay about the first piece having a plurality of shaped projections extending from the overlay, the materials closed cell foam, plastic, or rubber, and diameter of 3 inches to about 15 inches as indicated by Applicant are all critical to the functions of supporting a user standing on or is on the device without falling off and enhance mobilization of soft tissue and optimize body core strength and balance training”.

On 11-30-2020 3PR Ron Johnson Engineering, Inc. filed a request for reexamination (90/014,621) of the ‘167 patent based on Bajette-

Art Unit: 3993

1,958,936, Pecora-2002/0193714, Ryan-6,419,650, Perez-2006/0142677, Quick-7,108,646, Westwood-2003/0100417, Hedges-6,990,699, OTP- product catalog 2004, Doherty-6,764,456, Schmitt-5,675,850, McKay- 5,558,625, Simmons-4,648,387, Holmberg-D257,883, and Sawtelle- 1,519,631. During prosecution the following references were added to rejections by the examiner: Wang-DE 20119764 U1, Iyomasa-4,109,649, and Wisnieski-4,191,178 and a Declaration by Mr. Bradley Wilson was previously submitted by Patent Owner and was considered by the examiner. The rejections were ultimately appealed to the PTAB where the Board reversed the examiner's rejections and the Reexamination claims were allowed.

***Present Reexamination 90/019,423***

On 02-26-2024 3PR Ron Johnson Engineering, Inc. filed a second Request for Reexamination on the '167 patent, citing the below Exhibits for the purpose of establishing a SNQP with respect to claims 1-31 of the '167 patent.

***Prior Art Relied Upon in the Request as Raising an SNQP***

Exhibit Q- German Patent DE 20119764 to Wang.  
Exhibit R- U.S. Pat. No. 6,419,650 to Ryan.  
Exhibit S- U.S. Patent No. 4,109,649 to Iyomasa.  
Exhibit T- U.S. Patent No. 4,191,178 to Wisnieski.

***Proposed Substantial New Questions of Patentability***

- 1. The Request asserts that Wang, Ryan and Iyomasa raise a SNQP with respect to claims 1-31 of the '167 patent.**
- 2. The Request asserts that Wang, Ryan and Wisnieski raise a SNQP with respect to claims 1-31 of the '167 patent.**

## **2242 Criteria for Deciding Request Filed under 35 U.S.C. 302 [R-10.2019]**

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### **I. SUBSTANTIAL NEW QUESTION OF PATENTABILITY**

The presence or absence of "a substantial new question of patentability" determines whether or not reexamination is ordered. The meaning and scope of the term "a substantial new question of patentability" is not defined in the statute and must be developed to some extent on a case-by-case basis, using the case law to provide guidance as will be discussed in this section.

If the prior art patents and printed publications raise a substantial question of patentability of at least one claim of the patent, then a substantial new question of patentability as to the claim is present, unless the same question of patentability has already been: (A) decided in a final holding of invalidity by a federal court in a decision on the merits involving the claim, after all appeals; (B) decided in an earlier concluded examination or review of the patent by the Office; or (C) raised to or by the Office in a pending reexamination or supplemental examination of the patent. If the request for reexamination includes issues involving **35 U.S.C. 325(d)**, the examiner must bring such issues to the attention of the appropriate SPRS or the Director of the CRU. Inquiries from the public regarding the treatment of issues involving **35 U.S.C. 325(d)** in *ex parte* reexaminations should be referred to OPLA.

An earlier concluded examination or review of the patent is: (A) the original examination of the application which matured into the patent; (B) the examination of the patent in a reissue application that has resulted in a reissue of the patent; (C) the examination of the patent in an earlier concluded reexamination or supplemental examination; (D) the review of the patent in an earlier concluded trial by the Patent Trial and Appeal Board, such as a post-grant review, *inter partes* review, or covered business method review of the patent; or (E) any other contested Office proceeding which has been concluded and which involved the patent. The answer to the question of whether a "substantial new question of patentability" exists, and therefore whether reexamination may be had, is decided by the examiner, and the examiner's determination may be reconsidered:

- (a) If reexamination is denied – as set forth in **MPEP § 2248**.
- (b) If reexamination is granted – as set forth in **MPEP § 2246, subsection II**.

A prior art patent or printed publication raises a substantial question of patentability where there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and/or publications would be considered important, then the examiner should find "a substantial new question of patentability" unless the same question of patentability has already been decided as to the claim in a final holding of invalidity by a federal court or by the Office in an earlier concluded examination or review of the patent, or unless the same question of



patentability has been raised to or by the Office in a pending reexamination or supplemental examination of the patent. For example, the same question of patentability may have already been decided by the Office where the examiner finds the additional (newly provided) prior art patents or printed publications are merely cumulative to similar prior art already fully considered by the Office in an earlier concluded examination or review of the claim.

For "a substantial new question of patentability" to be present, it is only necessary that: (A) the prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the (prior art) patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and (B) the same question of patentability as to the claim has not been decided by the Office in an earlier concluded examination or review of the patent, raised to or by the Office in a pending reexamination or supplemental examination of the patent, or decided in a final holding of invalidity (after all appeals) by a federal court in a decision on the merits involving the claim. If a reexamination proceeding was terminated/vacated without resolving the substantial question of patentability question, it can be re-presented in a new reexamination request. It is not necessary that a "*prima facie*" case of unpatentability exist as to the claim in order for "a substantial new question of patentability" to be present as to the claim. Thus, "a substantial new question of patentability" as to a patent claim could be present even if the examiner would not necessarily reject the claim as either fully anticipated by, or obvious in view of, the prior art patents or printed publications. As to the importance of the difference between "a substantial new question of patentability" and a "*prima facie*" case of unpatentability see generally *In re Etter*, 756 F.2d 852, 857 n.5, 225 USPQ 1, 4 n.5 (Fed. Cir. 1985).

Note that the clarification of the legal standard for determining obviousness under **35 U.S.C. 103** in *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. 398, 82 USPQ2d 1385 (2007) does not alter the legal standard for determining whether a substantial new question of patentability exists. See the discussion in **MPEP § 2216**.

Where a second or subsequent request for reexamination of a patent is made before the conclusion of an earlier filed reexamination proceeding pending (ongoing) for that patent, the second or subsequent request for reexamination may provide information raising a substantial new question of patentability with respect to any new or amended claim which has been proposed under **37 CFR 1.530(d)** in the ongoing pending reexamination proceeding. However, in order for the second or subsequent request for reexamination to be granted, the second or subsequent requester must independently provide a substantial new question of patentability which is **different from** that raised in the pending reexamination for **the claims in effect at the time of the determination**. The decision on the second or subsequent request is based on the claims in effect at the time of the determination (**37 CFR 1.515(a)**). Thus, the second or subsequent request must be directed to the claims of the patent, as modified by any disclaimer, or by any reexamination certificate that has issued as of the time of the determination. If a "different" substantial new question of patentability is not provided by the second or subsequent request for the claims in effect at the time of the determination, the second or subsequent request for reexamination must be denied since the Office is only authorized by statute to grant a reexamination proceeding based on a substantial new question of patentability "affecting any claim of the patent." See **35 U.S.C. 303**. Accordingly, there must be at least one substantial new question of patentability established for the existing claims in the patent in order to grant reexamination.

Once the second or subsequent request has provided a "different" substantial new question of patentability based on the claims in effect at the time of the determination, the second or subsequent request for reexamination may also provide information directed to any proposed new or amended claim in the pending reexamination, to permit examination of the entire patent package. The information directed to a proposed new or amended claim in the pending reexamination is addressed during the later filed reexamination (where a substantial new question is raised in the later reexamination for the existing claims in the patent), in order to permit examination of the entire patent package. When a proper basis for the subsequent reexamination is established, it would be a waste of resources to prevent addressing the proposed new or amended claims, by requiring parties to wait until the certificate issues for the proposed new or amended claims, and only then to file a new reexamination request challenging the claims as revised via the certificate. This also prevents a patent owner from simply amending all the claims in some nominal fashion to preclude a subsequent reexamination request during the pendency of the reexamination proceeding.

## **II. POLICY IN SPECIFIC SITUATIONS**

In order to further clarify the meaning of "a substantial new question of patentability" certain situations are outlined below which, if present, should be considered when making a decision as to whether or not "a substantial new question of patentability" is present. Any issues involving **35 U.S.C. 325(d)** raised in the request must be referred to the examiner's SPRS or the director of the CRU. Any questions from the public regarding procedures in regard to issues involving **35 U.S.C. 325(d)** should be referred to the Office of Patent Legal Administration (OPLA).

### **A. Prior Favorable Decisions by the U.S. Patent and Trademark Office (Office) on the Same or Substantially Identical Prior Art in Relation to the Same Patent**

A "substantial new question of patentability" is not raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier concluded examination or review of the patent) the same question of patentability as to a patent claim favorable to the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

In deciding whether to grant a request for reexamination of a patent, the examiner should check the patent's file history to ascertain whether any of the prior art now advanced by requester was previously cited/considered in an earlier concluded examination or review of the patent or has been raised to or by the Office in a pending reexamination or supplemental examination of the patent. For the sake of expediency, such art is referred to as "old art" throughout, since the term "old art" was coined by the Federal Circuit in its decision of *In re Hiniker*, 150 F.3d 1362, 1365-66, 47 USPQ2d 1523, 1526 (Fed. Cir. 1998).

In a decision to order reexamination made on or after November 2, 2002, reliance on old art does not necessarily preclude the existence of a substantial new question of patentability that is based exclusively on that old art. See Public Law 107-273, 116 Stat. 1758, 1899-1906 (2002), which expanded the scope of what qualifies for a substantial new question of patentability upon which a reexamination may be based. Determinations on whether a substantial new question of patentability exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis. For example, a substantial new question of patentability may be based solely on old art where the old art is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier examination(s), in view of a material new argument or interpretation presented in the request. Such material new argument or interpretation may be based solely on claim scope of the patent being reexamined.

When it is determined that a substantial new question of patentability based solely on old art is raised, form paragraph **22.01.01** should be included in the order for reexamination.

### **B. Prior Adverse Decisions by the Office on the Same or Substantially Identical Prior Art in the Same Patent**

A prior decision adverse to the patentability of a claim of a patent by the Office based upon prior art patents or printed publications would usually mean that "a substantially new question of patentability" is present. Such an adverse decision by the Office could, for example, arise from a reissue application which was abandoned after rejection of the claim and without disclaiming the patent claim.

### **C. Prior Adverse Reissue Application Final Decision by the Director of the USPTO or the Board Based Upon Grounds Other Than Patents or Printed Publications**

Any prior adverse final decision by the Director of the USPTO or the Patent Trial and Appeal Board or Board of Patent Appeals and Interferences (Board), on an application seeking to reissue the same patent on which

reexamination is requested will be considered by the examiner when determining whether or not a "substantial new question of patentability" is present. However, to the extent that such prior adverse final decision was based upon grounds other than patents or printed publications, the prior adverse final decision will not be a basis for determining whether or not a "substantial new question of patentability" is present.

***D. Prior Favorable or Adverse Decisions on the Same or Substantially Identical Prior Art Patents or Printed Publications in Other Cases not Involving the Patent***

While the Office would consider decisions involving substantially identical patents or printed publications in determining whether a "substantial new question of patentability" is raised, the weight to be given such decisions will depend upon the circumstances.

**Substantial New Question Of Patentability Analysis**

No substantial new question of patentability is raised by the request for reexamination and prior art cited therein for the reasons set forth below:

It is not agreed that Wang, Ryan and Iyomasa raise a SNQP with respect to claims 1-31.

It is not agreed that Wang, Ryan and Wisnieski raise a SNQP with respect to claims 1-31 of the '167 patent.

Wang, Ryan, Iyomasa and Wisnieski are considered "old art" having been previously cited, considered and applied during the previous –'621 reexamination of the '167 patent (See MPEP 2242 IIA). Thus, proposed SNQP #1 and #2 are based solely on "old art". While reliance on "old art" does not necessarily preclude the existence of a substantial new question of patentability that is based exclusively on that old art, in order to raise an SNQ , the old art must be first presented in a new light, or in a different

way, as compared with its use in the earlier examinations based on a material new argument or interpretation presented in the request.

In the instant Request, 3PR does not cite to any new teachings or new interpretation of teachings presented in the “old art” that they argue were not considered by the Examiner during the prior examination or reexamination of the ‘167 patent. Rather 3PR cites to exhibits C, D, E, F, I and O, which represents 37 CFR 1.501(a)(2) Patent Owner statements as to claim scope made both in Federal District Court and before the Office. 3PR asserts these patent owner statements presents the “old art” asserted in the SNQPs above in new light and different way than they were considered in the prior reexamination proceeding in view of Patent Owner admissions as to claim scope.

On pages 4-7 of the Request, 3PR asserts:

“In particular, in light of the contents of Exhibits C-F, I, and O, which are ‘statements of the patent owner filed in a proceeding before a Federal court or the Office in which the patent owner took a position on the scope of any claim of a particular patent’ (35 U.S.C. § 301(a)(2), a substantial new question of patentability is raised in application of this new knowledge to Exhibits Q-T because the Patent Owner’s prior statements (Exhibits C-F, I and O) provide additional relevant information that the PTAB did not have when deciding the ‘621 reexamination”. “Patent Owner’s pleadings and infringement contentions cast new light on the scope of Patent Owner’s claims, revealing new and non-cumulative technological teachings of Exhibits Q-T that were not previously considered by the USPTO”. “The Patent Owner’s own pleadings and infringement contentions are thus evidence contrary to the PTAB’s holding, raising substantial new questions of patentability in view of the prior art”.

While Patent Owner statements submitted under 37 CFR 1.501(a)(2) as to claim scope can only be used in the examination phase of a reexamination once the Request for Reexamination has already been granted, they may not be used to determine whether the prior art raises a SNQP in Ordering reexamination (See MPEP 2258 F1 and G, and 37 CFR 1.552). Accordingly, Exhibits C, D, E, F, I and O (Patent Owner statements), which are not prior art patents or prior art printed publications and may not be used in the Request to establish an SNQP with respect to claims 1-31 of the '167 patent.

As stated above, Wang, Ryan, Iyomasa and Wisnieski are "old" art having been previously cited and applied against the claims in the 1<sup>st</sup> reexamination 90/014,621. According to 3PR, it is only when viewing the "old" art of exhibits Q-T through the lens of Patent Owner's own admissions in the other cited Exhibits, is a SNQP supposedly raised. However, as explained above Patent Owner's statements and admissions as to claim scope submitted under 37 CFR 1.501(a)(2) are not to be given consideration in the Request determination.

Accordingly, the asserted SNQPs based solely on the "old" art of Wang, Ryan, Iyomasa and Wisnieski are not being presented here in a new, different light and is only offered to show exactly what it showed in the



first reexamination. Thus, the Request does not present any new, non-cumulative technological teaching with respect to the cited prior art that was not considered in the earlier examination reexamination, and therefore the Request does not raise a SNQP with respect to claims 1-31 of the '167 patent.

### ***Conclusion***

For the reasons given above, the references cited by 3PR fail to raise a substantial new question of patentability with respect to claims 1-31 of the '167 patent.

Accordingly, claims 1-31 of the '167 patent will **not** be reexamined.

### ***Correspondence***

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

By mail to: 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 to: (571) 273-9900  
Central Reexamination Unit

By hand: Customer Service Window

Randolph Building  
401 Dulaney Street  
Alexandria, VA 22314

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<https://patentcenter.uspto.gov>. For more information about Patent Center, please visit <https://www.uspto.gov/patents/apply/patent-center>, and for information about filing in DOCX format, please visit

<https://www.uspto.gov/patents/docx>. 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. Any inquiry concerning this communication or earlier communications from the Reexamination Legal Advisor or Examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GLENN K DAWSON whose telephone number is (571)272-4694. The examiner can normally be reached on M-F 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Eileen Lillis can be reached at 571-272-6928.

Signed: /GLENN K DAWSON/  
Glenn K. Dawson  
Patent Reexamination Specialist, Art Unit 3993

Conferees: /SBM/  
Sarah B. McPartlin  
Primary Examiner, AU 3993

/EILEEN D LILLIS/  
SPRS, Art Unit 3993