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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.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

March 27, 2025

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90019328
PATENT NO. : 11116361
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)).



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(For Patent Owner)

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(For Third Party Requester)

In re Dahle et al. :
U.S. Patent No.: 11,116,361 B2 : **DECISION**
Ex Parte Reexamination Proceeding : **ON**
Control No.: 90/019,328 : **PETITION**
Filed: December 11, 2023 :

This decision addresses patent owner’s March 22, 2024 petition entitled “Patent Owner’s Petition for Suspension of the Rules and for Summary Termination of Reexamination, as a Matter of Law, Pursuant to 37 C.F.R. §§ 1.181, 1.182, and 1.183.” This decision also addresses requester’s April 5, 2024 paper entitled “Requester’s Response to Patent Owner’s Petition for Suspension of the Rules and for Summary Termination of Reexamination, as a Matter of Law, Pursuant to 37 C.F.R. §§ 1.181, 1.182, and 1.183.”

Patent owner’s March 22, 2024 petition, requester’s April 5, 2024 opposition, and the record as a whole are before the Office of Patent Legal Administration for consideration.

PERTINENT BACKGROUND

- On September 14, 2021, U.S. Patent Number 11,116,361 B2 (the ’361 patent) issued from Application 17/019,529 to Dahle *et al.* with claims 1-14. According to Office records, the ’361 patent is currently assigned to North Atlantic Imports, LLC (NAI or patent owner).

District Court Proceedings Involving the ’361 Patent

- On June 17, 2022, NAI filed a complaint in the United States District Court for the Northern District of Georgia asserting claims 1-14 of the ’361 patent against A&J Manufacturing, LLC.¹

¹ See *North Atlantic Imports, LLC v. A&J Manufacturing, LLC*, 1:22-cv-02436, Document 1, p. 10 (N.D. Ga., June 17, 2022). On March 20, 2024, NAI filed an unopposed motion to substitute Premier Specialty Brands, LLC for A&J Manufacturing, LLC as the defendant in the case (Document 90), which motion the court granted on April 8, 2024 (Document 94). On July 5, 2024, the case was terminated after notice of settlement (Document 97) and stipulation of dismissal (Document 98).

Present *Ex Parte* Reexamination Proceeding

- On December 11, 2023, A&J Manufacturing, LLC (A&J or requester) deposited a request for *ex parte* reexamination of claims 1-14 of the '361 patent (request). The reexamination proceeding was assigned control number 90/019,328 (present reexamination proceeding) and was accorded a filing date of December 11, 2023. The request raised several grounds alleging that claims 1-14 of the '361 patent are obvious over the cited prior art.²
- On January 23, 2024, reexamination was ordered.³ The Central Reexamination Unit (CRU) Examiner (the examiner) found that each of the grounds in the request raises a substantial new question of patentability (SNQ).⁴
- On March 22, 2024, patent owner filed a petition entitled "Patent Owner's Petition for Suspension of the Rules and for Summary Termination of Reexamination, as a Matter of Law, Pursuant to 37 C.F.R. §§ 1.181, 1.182, and 1.183" (petition).
- On April 5, 2024, requester filed a paper entitled "Requester's Response to Patent Owner's Petition for Suspension of the Rules and for Summary Termination of Reexamination, as a Matter of Law, Pursuant to 37 C.F.R. §§ 1.181, 1.182, and 1.183" (opposition).⁵

STATUS OF THE CLAIMS

The '361 patent issued with claims 1-14. In the present reexamination proceeding, claims 1-14 are subject to reexamination. Claims 1 and 9 are the independent claims.

DECISION

I. Relevant statutes and rules

37 CFR 1.540, in pertinent part, provides:

No submissions other than the statement pursuant to § 1.530 and the reply by the *ex parte* reexamination requester pursuant to § 1.535 will be considered prior to examination.

37 CFR 1.510(b), in pertinent part, provides:

Any request for reexamination must include the following parts:

- *
- *

² See "Request For *Ex Parte* Reexamination of U.S. Patent No. 11,116,361," Dec. 11, 2023, p. 82.

³ See "Order Granting Request for *Ex Parte* Reexamination," Jan. 23, 2024 (order).

⁴ See order, pp. 6-9.

⁵ The opposition appears to have been improperly served by Federal Express and e-mail. See 37 CFR 1.248 (listing proper manners of service). However, given that patent owner would have no opportunity to rebut the arguments set forth in the opposition, the paper is not being denied consideration in this instance. See MPEP § 2267, subsections II and III.

(6) A certification by the third party requester that the statutory estoppel provisions of 35 U.S.C. 315(e)(1) or 35 U.S.C. 325(e)(1) do not prohibit the requester from filing the *ex parte* reexamination request.

35 U.S.C. 315(e)(1) provides:

PROCEEDINGS BEFORE THE OFFICE.—The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under [35 U.S.C.] 318(a), or the real party in interest or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

35 U.S.C. 325(e)(1) provides:

PROCEEDINGS BEFORE THE OFFICE.—The petitioner in a post-grant review of a claim in a patent under this chapter that results in a final written decision under [35 U.S.C.] 328(a), or the real party in interest or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that post-grant review.

II. Patent owner's petition under 37 CFR 1.183 to waive 37 CFR 1.540

Patent owner's petition includes a petition under 37 CFR 1.183 requesting that the Office waive the provisions of 37 CFR 1.540 concerning patent owner filings for consideration of patent owner's petition to terminate the present reexamination proceeding due to requester's alleged improper certification under 37 CFR 1.510(b)(6).⁶

Patent owner's March 22, 2024 petition was filed after the January 23, 2024 order granting *ex parte* reexamination but prior to the issuance of a non-final action on the merits. Permitting patent owner to call attention to potential issues involving requester's certification under 37 CFR 1.510(b)(6), stating that the statutory estoppel provisions of 35 U.S.C. 315(e)(1) and 325(e)(1) do not prohibit requester from filing the request, serves an important purpose in ensuring that the proceeding is statutorily authorized. Accordingly, in view the specific facts and circumstances of the present case, patent owner's petition under 37 CFR 1.183 is **granted**. The provisions set forth in the second sentence of 37 CFR 1.540 are hereby waived to permit entry and consideration of patent owner's March 22, 2024 petition addressing requester's certification under 37 CFR 1.510(b)(6). Patent owner's petition has been entered and considered as set forth in section III of this decision.

Furthermore, requester is permitted to file a paper in opposition to a patent owner petition requesting termination of the present reexamination proceeding, just as the requester is permitted to file a paper in opposition to a patent owner petition to vacate a reexamination order under 35 U.S.C. 304 (and deny reexamination) on the basis that the order is an *ultra vires* action on the part of the Office.⁷ Accordingly, the opposition has been entered and considered to the extent it addresses patent owner's arguments regarding requester's certification under 37 CFR 1.510(b)(6).

⁶ See petition, pp. 7-9.

⁷ See, e.g., Manual of Patent Examining Procedure (MPEP) § 2246, subsection II.

III. Patent owner's petition to terminate the present reexamination proceeding, alleging requester's certification under 37 CFR 1.510(b)(6) is improper

A. Patent owner's arguments in its petition

Requester A&J deposited a certification pursuant to 37 CFR 1.510(b)(6), signed by requester's counsel, Christopher J. Coulson, with the request in the present reexamination proceeding.⁸ Regarding requester's certification, patent owner argues:⁹

The Request identifies A&J as the "Requester," and certifies pursuant to § 1.510(b)(6) that the statutory provisions of 35 U.S.C. § 315(e)(1) and 35 U.S.C. § 325(e)(1) do not prohibit Requester (*i.e.*, A&J) from filing the Request. Yet, the Certificate of Merger (Exhibit A) demonstrates that A&J *ceased to exist* as of December 31, 2022, nearly a full year before the Request and certification pursuant to § 1.510(b)(6) were filed.

Patent owner further argues "where the named Requester does not exist at the time of filing the Request, any such certification is necessarily inaccurate and improper—the Requester does not exist, so there is no legally recognizable entity to make such a certification."¹⁰ Patent owner alleges that "[a] non-surviving entity does not exist in the eyes of the law, and cannot make a request for *ex parte* reexamination, nor make any certifications."¹¹ Patent owner additionally argues:¹²

Although A&J did not exist and thus could not be the requester of the *ex parte* reexamination, the Request was still filed and thus some unidentified individual or entity is the actual and true requester as required under 37 C.F.R. § 1.510(b)(6). The attempted certification provided in the Request fails to satisfy 37 C.F.R. § 1.510(b)(6) with respect to the actual and true requester, because the attempted certification is expressly directed only to A&J and not to the actual and true requester.

Patent owner argues "the attempted certification is improper because it does not extend to any entity that may be the actual and true requester," and "there is nothing in the Request that would warrant *sua sponte* extending the attempted certification under § 1.510(b)(6) to the actual entity or individual that filed the Request (*i.e.*, the true requester)."¹³ Patent owner cites several Office decisions¹⁴ and *Synopsys, Inc. v Matal*¹⁵ to support its argument that, if requester's certification under 37 CFR

⁸ See request, pp. iii, 102 and "Request for *Ex Parte* Reexamination Transmittal Form," Dec. 11, 2024, p. 2 (transmittal form).

⁹ Petition, p. 3 (emphasis original).

¹⁰ Petition, p. 4.

¹¹ Petition, p. 4 (citing *PrimeSource Bldg. Prods., Inc. v. United States*, 494 F. Supp. 3d 1307, 1320-24 (Ct. Int'l Trade 2021)).

¹² Petition, p. 5.

¹³ Petition, p. 6.

¹⁴ "Decision on Petitions," 90/019,069, May 26, 2023 ('069 decision) and "Decision Granting Petition and *Sua Sponte* Vacating *Ex Parte* Reexamination Proceeding," 90/014,292, Feb. 5, 2020 ('292 decision).

¹⁵ 280 F. Supp. 3d 823, 826 (E.D. Va. 2017) (*Synopsys*).

1.510(b)(6) is improper or inaccurate, the Office will vacate the reexamination proceeding.¹⁶ Patent owner concludes by requesting the Office to terminate the present reexamination proceeding.¹⁷

B. Analysis

The purpose of 37 CFR 1.510(b)(6) is to require a third party requester to certify that the statutory estoppel provisions of 35 U.S.C. 315(e)(1) or 35 U.S.C. 325(e)(1) do not prohibit the requester from filing the *ex parte* reexamination request. The Office will not generally look beyond this required certification, unless the Office becomes aware of facts that call the certification into question, in which case, the Office will determine, on a case-by-case basis, whether the request for *ex parte* reexamination is prohibited by statute.¹⁸

In order for requester's certification under 37 CFR 1.510(b)(6) to be improper, requester must have incorrectly certified that the statutory estoppel provisions of 35 U.S.C. 315(e)(1) or 35 U.S.C. 325(e)(1) do not prohibit the requester from filing the *ex parte* reexamination request. Whether estoppel under 35 U.S.C. 315(e)(1), for example, applies to a claim requested to be reexamined on any of the grounds raised in an *ex parte* reexamination proceeding may be analyzed by determining:¹⁹

1. Whether the third party requester of the *ex parte* reexamination proceeding was a petitioner in the *inter partes* review, or was a real party in interest or a privy of the petitioner;
2. Whether the claim(s) of the patent under *inter partes* review are also requested to be reexamined in the *ex parte* reexamination proceeding;
3. Whether the *inter partes* review has resulted in a final written decision pursuant to 35 U.S.C. 318(a); and
4. Whether the ground(s) raised in the *ex parte* reexamination proceeding are the ground(s) that were raised or reasonably could have been raised by the requester during the *inter partes* review.

Patent owner has not, and cannot, show that the estoppel elements of 35 U.S.C. 315(e)(1) or 35 U.S.C. 325(e)(1) are met for a claim requested to be reexamined in the present reexamination proceeding, because Office records indicate that the '361 patent has not been challenged in any *inter partes* review or post-grant review proceeding at the Patent Trial and Appeal Board (PTAB) prior to the filing of the present reexamination proceeding.

The Office's '069 and '292 decisions, relied on by patent owner, vacated the respective reexamination orders because the records showed that there were prior *inter partes* reviews involving the patents at issue in those reexamination proceedings, and that, based on final written decisions in those prior *inter partes* reviews, § 315(e)(1) estoppel attached to the claims challenged by the requesters in those reexamination proceedings.²⁰ The facts and circumstances of the '069 and '292 decisions are

¹⁶ Petition, pp. 2-3.

¹⁷ Petition, p. 9.

¹⁸ See *Changes To Implement Miscellaneous Post Patent Provisions of the Leahy-Smith America Invents Act*, 77 Fed. Reg. 46615, 46622 (Aug. 6, 2012).

¹⁹ The four elements set forth in this decision are found in the language of the statute, 35 U.S.C. 315(e)(1).

²⁰ See '069 decision, pp. 5-10; '292 decision, p. 12-29.

different than those of the present reexamination proceeding, where there were no prior PTAB proceedings involving the '361 patent. Further, patent owner's reliance on *Synopsys* is also inapt. In *Synopsys*, the Office permitted the estopped requester to refile a new *ex parte* reexamination request that was limited to only those claims that the requester was not estopped from challenging.²¹ Here, given that there are no prior PTAB proceedings involving the '361 patent, there is no possible estoppel against *any* party from challenging *any* claims of the '361 patent. For at least this reason, alone, patent owner has not sufficiently shown that requester's 37 CFR 1.510(b)(6) certification is improper.

Furthermore, the record indicates that patent owner was aware that requester continued to do business as A&J in the related district court proceeding through April 2024, as evidenced by *patent owner's own* motion to substitute Premier Specialty Brands, LLC (Premier) for A&J Manufacturing, LLC as the defendant in the case.²² In its motion to the court, patent owner explicitly stated that "Premier succeeded to and possessed all assets, rights, privileges, and powers of A&J, and all liabilities and obligations of A&J, including any that may arise out of the allegations raised by [patent owner] North Atlantic Imports, LLC in the subject lawsuit."²³ Accordingly, patent owner's allegation that "some *unidentified* individual or entity is the actual and true requester" because "A&J did not exist and thus could not be the requester" is not consistent with the record that shows patent owner was aware that Premier succeeded to A&J prior to filing the instant petition. Patent owner has not asserted that it suffered any specific harm, which affected patent owner's ability to participate in the present reexamination proceeding, by requester initially identifying itself in the request as A&J rather than Premier; only that it would need to expend resources moving forward with the reexamination.²⁴ Assuming *arguendo* that patent owner did suffer any harm from requester initially identifying itself as A&J, it is expected that patent owner would have filed a petition alleging requester's 37 CFR 1.510(b)(6) certification was improper immediately after the request was served instead of waiting until two months after the order.

Patent owner's argument that requester's certification under 37 CFR 1.510(b)(6) is improper because it is "expressly directed only to A&J" and "does not extend to any entity that may be the actual and true requester"²⁵ is not persuasive. The certification under 37 CFR 1.510(b)(6) does not require an identification of any real parties in interest behind the request.²⁶ Nonetheless, because the plain language of § 315(e)(1) and § 325(e)(1) states that estoppel may attach to the petitioner or "*the real party in interest or privy of the petitioner*" (emphasis added), the practitioner that filed the request for the present reexamination proceeding, whether they identified the requester as A&J or Premier, certified that the requester was not the real party in interest or privy of any prior *inter partes* review petitioner or post-grant review petitioner that would be estopped.

²¹ *Synopsys*, 280 F. Supp. 3d 823, 827 (E.D. Va. 2017).

²² See *North Atlantic Imports, LLC v. A&J Manufacturing, LLC*, 1:22-cv-02436, Document 90 (N.D. Ga., Mar. 20, 2024). The court granted patent owner's motion on April 8, 2024 (Document 94).

²³ Opposition, Exhibit 1, p. 1-2.

²⁴ Petition, pp. 8-9 (alleging that "[p]ermitting the present reexamination to proceed on the basis of an improper reexamination request would require Patent Owner to expend resources and ultimately risk losing valuable patent rights.").

²⁵ Petition, p. 5-6.

²⁶ See MPEP 2214, subsection I ("The rules do not require *ex parte* reexamination requesters to identify themselves upon the filing of the request under 35 U.S.C. 302. . . . A real party in interest that wishes to remain anonymous when filing a request for reexamination under 37 CFR 1.510 can do so by utilizing the services of a registered practitioner. In such an instance, the registered practitioner submitting a request for reexamination on behalf of the real party in interest would be certifying that the real party in interest was not estopped from filing the request."). Compare 35 U.S.C. 302 (no language requiring a request for reexamination to identify the real parties in interest) with pre-AIA 35 U.S.C. 311(b)(1) (specific language requiring a request for *inter partes* reexamination to identify the real party in interest) and 35 U.S.C. 312(a)(1) (specific language requiring an *inter partes* review petition to identify all real parties in interest).

Finally, as noted in the request, the “certification complies with the requirements of Section 1.510(b)(6) because it was filed by a practitioner.”²⁷ Per MPEP § 2214, subsection I, a registered practitioner submitting a request for reexamination on behalf of a real party in interest would be certifying that the real party in interest was not estopped from filing the request.²⁸ Here, given that there are no prior PTAB proceedings involving the ’361 patent, the practitioner made a compliant certification, whether the real party in interest was A&J or Premier.

IV. Correction of requester’s name

Requester now states that “Premier Specialty Brands, LLC is the real party in interest for the request that resulted in this ex parte reexamination.”²⁹ Requester states that it initially identified itself as A&J as “an administrative convenience in the context of Requester’s ongoing patent dispute with [patent owner]” and “had no deceptive intent or purpose in referring to [A&J].”³⁰ Requester further states that it “informed Patent Owner of the merger of A&J Manufacturing, LLC with Premier Specialty Brands, LLC, and informed Patent Owner that Premier Specialty Brands, LLC was the surviving entity in December 2023.”³¹

As discussed above, whether the real party in interest behind the request was A&J or Premier, the record does not show sufficient facts to call into the question the certification under 37 CFR 1.510(b)(6). Accordingly, in the interest of clarity of the record, and because the *ex parte* reexamination statute does not require identification of the real party in interest nor has patent owner demonstrated that it suffered any harm by requester initially identifying itself as A&J, the Office is permitting *nunc pro tunc* correction of requester’s name to “Premier Specialty Brands, LLC,” as identified by requester in the opposition.³² No correction of requester’s address identified on the transmittal form appears to be required, as the Elgin, Illinois address listed on the transmittal form matches Premier’s address listed on the merger agreement between A&J and Premier.³³

CONCLUSION

1. Patent owner’s March 22, 2024 petition under 37 CFR 1.183 to waive 37 CFR 1.540 for consideration of patent owner’s petition requesting the Office to terminate the present reexamination proceeding is **granted**.
2. Patent owner’s March 22, 2024 petition alleging requester’s 37 CFR 1.510(b)(6) certification is improper and requesting the Office to terminate the present reexamination proceeding is **dismissed**.
3. Requester’s April 5, 2024 opposition has been entered and considered to the extent it addresses issues regarding requester’s 37 CFR 1.510(b)(6) certification.

²⁷ See request, p. ii, 102; transmittal form, pp. 2-3.

²⁸ See MPEP 2214, subsection I (“The certification requirement of 37 CFR 1.510(b)(6), coupled with a party’s 37 CFR 11.18 certification obligations when transacting business before the Office, are considered sufficient to ensure compliance with the *inter partes* review and post grant statutory estoppel requirements.”).

²⁹ Opposition, p. 3.

³⁰ Opposition, p. 12.

³¹ Opposition, p. 10.

³² Opposition, p. 3.

³³ See petition, Exhibit A, p. 2 (“5. The executed plan of merger is on file at the principal place of business of the survivor, which is located at 1400 Toastmaster Dr., Elgin, IL 60120.”).

4. Requester of the present reexamination proceeding is identified as Premier Specialty Brands, LLC.
5. The present reexamination proceeding is being forwarded to the Central Reexamination Unit to continue prosecution.
6. Inquiries concerning this decision should be directed to Steven J. Fulk, Legal Advisor, Office of Patent Legal Administration, at (571) 270-0072, or the undersigned at (571) 272-7717.

/Nicole D. Haines/

Nicole D. Haines
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March 26, 2025