



UNITED STATES PATENT AND TRADEMARK OFFICE

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July 14, 2009

VIA HAND DELIVERY

Jan Horbaly
Clerk
United States Court of Appeals for the Federal Circuit
717 Madison Place, N.W.
Washington, D.C.

Re: *Cooper Cameron Corp. v. SAFOCO, Inc.*, Nos. 2009-1435, -N072

Dear Mr. Horbaly:

The Director of the United States Patent and Trademark Office (USPTO) believes the Court incorrectly captioned the first of the above-identified appeals.¹ This appeal is the first of its kind, *i.e.*, from a decision of the USPTO's Board of Patent Appeal and Interferences involving an *inter partes* reexamination. While the agency would not normally be a party in an *inter partes* case, for example, an interference proceeding, the *inter partes* reexamination statutory scheme, 35 U.S.C. § 311-318, requires the USPTO to be a party to an appeal from *any* reexamination.

Brought by the third-party requestor Cooper Cameron Corporation, this appeal is specifically provided for in 35 U.S.C. § 315(b)(1). According to that section, such an appeal is conducted under the provisions of 35 U.S.C. § 143. Section 143, which also applies to normal *ex parte* appeals from the USPTO, is the provision that requires the USPTO to participate in an appeal from the Board to this Court. 35 U.S.C. § 143 (“[T]he Director shall submit to the court in writing the grounds for the decision of the Patent and Trademark Office, addressing all the issues involved in the appeal.”). Critical to this appeal is that section 143 specifies that the requirement of USPTO involvement applies to “any *ex parte* case or any reexamination case.” (emphasis added) In other words, the Director is a party to this appeal, just as in an *ex parte* appeal. Section 143, meanwhile, does not require the Director’s participation in an appeal from

¹The second identified appeal, 2009-N072, is an appeal from the same Board decision involving reexamination of a different U.S. Patent. Although that appeal has not yet been docketed, it involves the same parties, and the USPTO anticipates that this Court will treat the two appeals similarly. Therefore, the USPTO is providing a copy of this letter to the Court in both cases.

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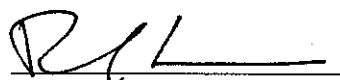
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an *inter partes* interference proceeding, which is neither an “*ex parte* case” nor “any reexamination case.”

Finally, the Director further notes that section 315(a)(1) also provides that the patent owner “may be a party to any appeal taken by a third-party requestor under subsection (b).” (emphasis added) Thus, section 315(a)(1) allows the patent owner to participate in this appeal, but does not require that participation.

For the foregoing reasons, the Director respectfully requests that the Court correct the official caption to reflect USPTO’s participation as a party in this appeal.

Respectfully,



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