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PATENT AGENT
ALLEN C. YUN, PH.D.

September 7, 2000

VIA TELEFACSIMILE

Mr. M. Gocho
PATENT SERVICE CORPORATION
Baba Building 3rd Floor
12-10, Takadanobaba 4-Chome
Shinjuku-ku, Tokyo, 160
JAPAN

Re: Infringement and Validity Study and Opinion
Re: U.S. Patent No. 5,897,168

Dear Mr. Gocho:

We are in receipt of your letter of September 1, 2000. Unfortunately, we cannot spend a substantial amount of time explaining our thoughts with respect to your questions in view of the fact that you are only asking for a personal answer and not an official legal opinion and that you want this answer free of charge. Please recall that we have already advised you that we have spent time on this project for which we did not bill. You will understand that we cannot stay in business for long if we spend substantial amounts of time reading complicated letters and giving legal opinions free of charge. Nevertheless, in view of your personal request to me, we will advise you as follows.

You asked whether we agree that, if claim 1 is invalid from Nishiyama, claim 11 must also be invalid. We agree with this proposition. If Nishiyama can be made without a core in its die-casting operation due to its Z-profile shape, then it anticipates claim 11 if it anticipates claim 1. We noticed that the shape shown in Figure 7b includes a Z-shape as well as a C-shape. However, this C-shape does not extend around the top and, therefore, it appears possible to produce this complex shape without cores in light of your explanation.

As to Figure 1(d) of the client's invention, please bear in mind that it does not matter what is the subject matter of the client's invention. It only matters what the client has done in determining whether or not such claim infringes. What the client's invention is is irrelevant to infringement. Infringment is determined by the client's product and the method of making that product without regard to any concepts of invention. If the lateral slide die which forms the holes for

bolts or nuts can be considered a core, then claim 11 is not infringed.

As to claim 12, we agree with your last statement, i.e., that claim 12 has a clear relation with the Z-profile frame as in claim 1 because the "multiplicity of forms" can be made in the Z-profiled frame using the additional lateral slides.

We agree that rules require that everything in the claims must be shown in the drawings. However, we are not certain that such a minor error will require the invalidation of such a claim. Furthermore, this is not an issue that can be decided by reexamination. Reexamination can only be based on new prior art references and not on 35 USC 112 or other formal issues, such as the correspondence of the claims to the drawings.

We agree that reexamination can be used to invalidate claim 1 and the various subclaims in view of Nishiyama, in light of our opinion. However, we usually do not recommend reexamination in order to invalidate claims of a third party because the reexamination requestor has no further input into the proceeding after the initial stage of the reexamination. Thus, the patentee may be able to talk its way into having the examiner grant a reexamination certificate and this will only make the patent stronger in the event of litigation. The new *inter* partes reexamination procedure is not available for this patent in view of the effective date provisions of the new law. If we have a strong position for invalidity, it is usually better to save these arguments for litigation where all of the arguments will be *inter partes*, rather than submitting it to reexamination where patentability will be decided *ex parte* between the patentee and the examiner. There is no other way to effectively invalidate the claims of the '168 patent other than as a defense to an infringement action or in a declaratory judgment action after the client has been charged with infringement by the patentee.

We hope that these comments answer your questions as best we understand them. Please do not ask any further questions unless you are able to charge your clients for our services in rendering the answers. We will do this once, but no more. We hope you understand.

Sincerely,

Roger L. Browdy

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Enclosure
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Confirmation Report – Memory Send

Time : Sep-07-2000 12:04pm
Tel line : 2027373528
Name : BROWDY NEIMARK

Job number	:	351
Date	:	Sep-07 12:01pm
To	:	011813336259504
Document pages	:	002
Start time	:	Sep-07 12:03pm
End time	:	Sep-07 12:04pm
Pages sent	:	002
Status	:	OK

Job number : 351 *** SEND SUCCESSFUL ***

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