



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 95/001,482 | 11/11/2010 | 7,397,431 | 0690.0004L | 6101 |

27896 7590 08/05/2014
EDELL, SHAPIRO & FINNAN, LLC
9801 Washingtonian Blvd.
Suite 750
Gaithersburg, MD 20878

EXAMINER

NGUYEN, LINH M

ART UNIT PAPER NUMBER

3992

MAIL DATE DELIVERY MODE

08/05/2014

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.



THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date:

NOVAK DRUCE & QUIGG LLP
1000 LOUISIANA STREET
53rd. FLOOR
HOUSTON, TX 77002

MAILED

AUG 05 2014

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95001482

PATENT NO. : 7397431

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.

Edell, Shapiro, & Finnan, LLC
9801 Washingtonian Blvd.
Suite 750
Gaithersburg, MD 20878

(For Patent Owner)

MAILED**AUG 05 2014**Novak, Druce & Quigg, LLP
(NDQ Reexamination Group)
1000 Louisiana Street
Fifty-third Floor
Houston, TX 77002

(For Third Party Requester)

CENTRAL REEXAMINATION UNIT*Inter Partes* Reexamination Proceeding
Control No.: 95/001,482
Filed: November 11, 2010
For: U.S. Patent No. 7,397,431: **DECISION GRANTING**
: **PETITION TO TERMINATE**
: **INTER PARTES REEXAMINATION**
: **PROCEEDING**

This is a decision on patent owner's petition filed on April 4, 2014 and entitled "Petition to Terminate *Inter Partes* Reexamination" (patent owner's April 4, 2014 petition).

This decision also addresses patent owner's "Supplement to Patent Owner's Petition to Terminate of April 3, 2014,"¹ filed on June 3, 2014 (patent owner's June 3, 2014 supplement).

Patent owner's April 4, 2014 petition, patent owner's June 3, 2014 supplement, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner's April 4, 2014 petition under 37 C.F.R. § 1.182 to terminate *inter partes* reexamination proceeding 95/001,482 is **granted**.

Prosecution of *inter partes* reexamination proceeding 95/001,482 is hereby **terminated**.

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/001,482 (the '1482 proceeding) is required by pre-AIA 35 U.S.C. 317(b),² which provides, in pertinent part (emphasis added):

¹ Although the patent owner refers to the date of the petition to terminate as April 3, 2014, Office records reveal that the date of receipt of patent owner's petition is April 4, 2014.

² Congress, when enacting the America Invents Act (AIA), replaced the provisions for *inter partes* reexamination with provisions for a new procedure, *inter partes* review. Congress amended the provisions of 35 U.S.C. 317 to only apply to *inter partes* review proceedings, which, by definition, are filed on or after September 16, 2012 (post-

Once a **final decision** has been entered against a party in a civil action arising in whole or in part under section 1338 of title 28, that the party has not sustained its burden of proving the invalidity of any patent claim in suit . . . then neither that party nor its privies may thereafter request an inter partes reexamination of any such patent claim on the basis of issues which that party or its privies raised or could have raised in such civil action or inter partes reexamination proceeding, and an inter partes reexamination requested by that party or its privies on the basis of such issues may not thereafter be maintained by the Office . . . This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

The Office analyzes whether a reexamination proceeding must be terminated pursuant to pre-AIA 35 U.S.C. 317(b) by determining:

1. Whether the third party requester was a party to the litigation;
2. Whether the decision is final, i.e., after all appeals;
3. Whether the court decided that the requester/party had not sustained its burden of proving the invalidity of any claim in suit of the patent, which claim is also under reexamination; and
4. Whether the issues raised in the reexamination proceeding are the same as issues that were raised, or are issues that could have been raised, by the requester in the civil action.

Element 1 Has Been Shown to Have Been Satisfied

The patent owner, Fractus, S.A. (Fractus), has informed the Office that the patent under reexamination, U.S. Patent No. 7,397,431 (the '431 patent), was the subject of a civil action styled *Fractus, S.A. v. Samsung Electronics, Co., Ltd. et al.*, Civil Action No. 6:09-cv-00203 (E. D. Tex.) (the litigation). The patent owner submits, with the present petition, a series of court documents, including a copy of the district court's "Final Judgment", dated June 28, 2012,³ which shows that the requester Samsung Electronics Co. Ltd. (Samsung) is a party to the litigation. Accordingly, element 1 has been shown to have been satisfied.

Element 2 Has Been Sufficiently Shown to Have Been Satisfied

The patent owner states that an appeal of the district court's June 28, 2012 judgment to the Court of Appeals for the Federal Circuit (CAFC) was filed. The appeal was later dismissed on March 28, 2014. As evidence, the patent owner submits a copy of the March 28, 2014 CAFC order dismissing the appeal, and a copy of the formal mandate issued by the CAFC.⁴ Patent owner's evidence sufficiently shows that the district court's judgment is final, i.e., after all appeals. Accordingly, element 2 has been shown to have been satisfied.

AIA 35 U.S.C. 317). Congress also specified that the provisions of the *inter partes* reexamination statute which were in effect prior to September 16, 2012, including the provisions of 35 U.S.C. 317(b) (pre-AIA 35 U.S.C. 317(b)), remain applicable to *inter partes* reexamination proceedings, which were only permitted to be filed before September 16, 2012.

³ See Exhibit O-3, which is attached to the present petition.

⁴ See Exhibits O-8 and O-9, which are attached to the present petition.

Element 3 Has Been Sufficiently Shown to Have Been Satisfied

The patent owner states that the jury determined, and the district court held, that claims 14 and 30 of the '431 patent were not invalid. As evidence, the patent owner submits:

- 1) the district court's June 28, 2012 judgment, which states that "[t]he '868, '208, '431, and '432 Patents are valid and enforceable";
- 2) the district court's June 28, 2012 "Memorandum Opinion and Order",⁵ which states that the patent owner asserted, at trial, claims 14 and 30 of the '431 patent,⁶ and which further states that "[t]he jury reasonably found that Samsung failed to prove by clear and convincing evidence that the MLV Patents [the '868, '208, '431, and '432 Patents] are anticipated by the Cohen Patent," and that "[t]he jury reasonably concluded that Samsung failed to prove by clear and convincing evidence that the MLV Patents are obvious in view of the Cohen Patent;"⁷ and
- 3) a redacted copy of the jury verdict form, dated May 23, 2011.⁸

Patent owner's evidence, taken together, is sufficient to show that the court held that the requester Samsung did not sustain its burden of proving the invalidity of claims 14 and 30 of the '431 patent.

Office records reveal, however, that claims 1, 4, 5, 7, 8, 12-14, 17, 21, 22, 24-27, 29-31 of the '431 patent are under reexamination in the present proceeding. To ensure that the claims of the present proceeding are identical to the claims asserted in the litigation, the patent owner has filed a statutory disclaimer disclaiming claims 1, 4, 5, 7, 8, 12, 13, 17, 21, 22, 24-27, 29 and 31 in the file of the '431 patent.⁹ Thus, only claims 14 and 30 remain under reexamination in the present proceeding.

Accordingly, element 3 has been shown to have been satisfied.

Element 4 Has Been Shown to Have Been Satisfied

The evidence of record shows that any issues raised with respect to claims 14 and 30 of the '431 patent either were raised or could have been raised in the litigation.

The last sentence of pre-AIA 35 U.S.C. 317(b) permits "the assertion of invalidity [by the requester] based on newly discovered prior art unavailable to the third party requester". See the

⁵ See Exhibit O-4, which is attached to the present petition.

⁶ See the June 28, 2012 "Memorandum Opinion and Order", page 2.

⁷ *Id.*, pages 27 and 29.

⁸ See Exhibit O-2, which is attached to the present petition. The jury verdict form provides evidence that claims 14 and 30 of the '431 patent were before the jury. However, the jury's determinations on the issue of the invalidity of the asserted claims, due to anticipation or obviousness, are unclear. The jury's determinations on page 3 of the form, which is the pertinent portion of the verdict form, are partially illegible.

⁹ The statutory disclaimer was filed on September 10, 2013 in application number 11/179,257, which became the '431 patent.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.