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EDEL, SHAPIRO & FINNAN, LLC
9801 Washingtonian Blvd.
Suite 750
Gaithersburg, MD 20878

EXAMINER

MENEFEE, JAMES A

ART UNIT PAPER NUMBER

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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
NOVAK DRUCE & QUIGG, LLP
(NDQ REEXAMINATION GROUP)
1000 LOUISIANA STREET, FIFTY-THIRD FLOOR
HOUSTON, TX 77002

Date:

MAILED

AUG 05 2014

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95001390
PATENT NO. : 7015868
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.: 95/001,390
Filed: July 2, 2010
For: U.S. Patent No. 7,015,868

: **DECISION GRANTING**
: **PETITION TO TERMINATE**
: **INTER PARTES REEXAMINATION**
: **PROCEEDING**

This is a decision on patent owner's petition filed on April 3, 2014 and entitled "Petition to Terminate *Inter Partes* Reexamination" (patent owner's April 3, 2014 petition).

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

SUMMARY

Patent owner's April 3, 2014 petition under 37 C.F.R. § 1.182 to terminate *inter partes* reexamination proceeding 95/001,390 is **granted**.

Prosecution of *inter partes* reexamination proceeding 95/001,390 is hereby **terminated**.

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/001,390 (the '1390 proceeding) is required by pre-AIA 35 U.S.C. 317(b),¹ which provides, in pertinent part (emphasis added):

¹ 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-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.

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. 7,015,868 (the '868 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, 2012,² 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.³ 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.

² See Exhibit O-3, which is attached to the present petition.

³ 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 26 and 35 of the '868 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",⁴ which states that the patent owner asserted, at trial, claims 26 and 35 of the '868 patent,⁵ 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;"⁶ and
- 3) a redacted copy of the jury verdict form, dated May 23, 2011.⁷

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 26 and 35 of the '868 patent.

Office records reveal, however, that claims 1, 3, 6, 12, 14, 23, 26, and 32-35 of the '868 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 filed a statutory disclaimer disclaiming claims 1, 3, 6, 12, 14, 23, and 32-34 in the file of the '868 patent.⁸ Thus, only claims 26 and 35 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 26 and 35 of the '868 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

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

⁵ See the June 28, 2012 "Memorandum Opinion and Order" at 2.

⁶ *Id* at 27.

⁷ See Exhibit O-2, which is attached to the present petition. The jury verdict form provides evidence that claims 26 and 35 of the '868 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.

⁸ The statutory disclaimer was filed on September 10, 2013 in application number 10/963,080, which became the '868 patent.

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