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OFFICE OF PETITIONS

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: For Third Party Requester
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: For Patent Owner
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In re Patent No. 7,394,432
Ku et al.
Issue Date: July 1, 2008
Control No. 95/002,349
Filed: September 14, 2012
Attorney Docket No. 1235-019
Title: Built in Antenna Modular for Portable
Wireless Terminal

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:
: DECISION ON PETITION FOR
: AUTHORIZATION TO FILE
: SECOND REQUEST FOR
: *INTER PARTES*
: REEXAMINATION

This is a decision on third party requester's September 14, 2012 petition entitled "PETITION PURSUANT TO 35 U.S.C. § 317(a) AND 37 C.F.R. § 37 C.F.R. § 1.907(a) FOR AUTHORIZATION TO FILE A SUBSEQUENT REQUEST FOR *INTER PARTES* REEXAMINATION, AND IF NECESSARY, 37 C.F.R. § 1.183.

The fee set forth in 37 CFR 1.17(f) for the third party requester-petitioner is \$400.00, and it was charged to Deposit Account No. 14-1437.

Third Party Requester-Petitioner's petition is before the Office of Patent Legal Administration, Office of Deputy Commissioner for Patent Examination Policy.

Third Party Requester-Petitioner's petition is **DISMISSED** for the reasons set for below.

This decision constitutes notice that, pursuant to 37 CFR 1.915(d), the filing date of September 14, 2012, which was assigned to the request papers for the above-captioned *inter partes* reexamination proceeding is hereby vacated, as the certification that “the estoppel provisions of 37 CFR 1.907 do not prohibit this reexamination” in the reexamination transmittal form is not correct, because the present petition for authorization to file a subsequent request for *inter partes* reexamination has not been granted. Thus, the estoppel provisions of 35 U.S.C. § 317(a) and 37 CFR 1.907(a) do prohibit this reexamination.¹

The proceeding as a whole is hereby vacated, and is being referred to the Central Reexamination Unit, to terminate preprocessing of the request.

Unless otherwise indicated, all citations to 35 U.S.C. Chapter 31 (i.e., 35 U.S.C. §§ 311-318) are to the statute in effect as of the date of deposit of the present *inter partes* reexamination request.

Background

1. U.S. Patent No. 7,394,432 (hereinafter, the ‘432 patent) issued Baliarda et al. on July 1, 2008 with 6 claims.
2. On May 5, 2009, Patent owner filed a suit alleging infringement of the ‘432 patent by Samsung Electronics Co., Ltd. (Third Party Requester-Petitioner), Kyocera Communications Inc., and HTC Corporation and HTC America, Inc. The suit was filed in the U.S. District Court for the Eastern District of Texas, and styled *Fractus, S.A. v. Samsung Electronics CO., Ltd. et al.*, No. 6:09-cv-0203.
3. A first request for *inter partes* reexamination of the ‘432 patent was filed on November 11, 2010, identifying Samsung Electronics Co. Ltd., as the real party in interest. The request was accorded control number 95/001,483 (hereinafter the ‘1483) and the specific claims for which reexamination was requested were 1-3 and 6.
4. A second request for *inter partes* reexamination of the ‘432 patent was filed on December 3, 2010, identifying HTC Corporation and HTC America, Inc. as the real parties in interest. The request was accorded control number 95/001,500 (hereinafter the ‘1500 proceeding) and the specific claims for which reexamination was requested were 1-3 and 6.
5. A third request for *inter partes* reexamination of the ‘432 patent was filed on December 13, 2010, identifying Kyocera Communications, Inc. as the real party in interest. The request was accorded control number 95/000,588 (hereinafter the ‘588 proceeding) and the specific claims for which reexamination was requested were 1-3, and 6.

¹ In initially granting a filing date to the proceeding, the Office interpreted requester’s certification as asserting that (1) the 37 CFR 1.907(b) estoppel does not apply; and (2) that the estoppel of 37 CFR 1.907(a) would not apply in the event that the Director were to authorize the filing of this reexamination request by granting of the concurrently filed petition.

6. The '1483, '1500 and '588 reexamination proceedings were merged into a single proceeding on March 17, 2011.
7. On September 14, 2012, a fourth request for *inter partes* reexamination of the '432 patent was deposited with the Office. The request identified Samsung Electronics Co. Ltd., as the real party in interest. The deposited request was assigned Control No. 95/002,349 (hereinafter the '349 proceeding) and the specific claims for which reexamination was requested were claims 1 and 6. The request included a certification that the estoppel provisions of 37 CFR 1.907 do not prohibit this reexamination.²
8. Concurrently, on September 14, 2012, Third Party Requester-Petitioner Samsung filed a petition seeking Director authorization for the filing of a second *inter partes* reexamination request prior to the issuance and publication of the *inter partes* reexamination certificate in the '2349 reexamination proceeding.³ It is this petition that is the subject of this decision.
9. The Third Party Requester-Petitioner asserts that a reasonable likelihood exists that it will prevail with respect to at least one claim under 37 CFR 1.915(b) based upon the following references: The requester cited the following U.S. patents Yang 6,300,914; Pankinaho 6,140,966; Gangreat 6,133,879; and Yanagisawa 5,995,064 . None of the references formed the basis of any proposed substantial new question or proposed or other rejection in the '1389 reexamination proceedings.
10. On October 3, 2012, a "Notice of *Inter Partes* Reexamination Request Filing Date" was mailed for the '2349 proceeding. The notice assigned the filing date of September 14, 2012 to the request for reexamination.

RELEVANT STATUTES, REGULATIONS, AND EXAMINING PROCEDURE

35 U.S.C. § 317 *Inter partes* reexamination prohibited

(a) Order for Reexamination. Notwithstanding any provision of this chapter, once an order for *inter partes* reexamination of a patent has been issued under section 313, neither the third-party requester nor its privies, may file a subsequent request for *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued and published under section 316, unless authorized by the Director.

(Emphasis added.)

² See previous footnote

³ The '1483 *inter partes* reexamination proceeding filed by Samsung Electronics Ltd. is still pending, and thus, by statute, the filing of the present second *inter partes* reexamination proceeding by requester Samsung Electronics Ltd is prohibited without the authorization of the Director. See 35 U.S.C. § 317(a).

(b) FINAL DECISION. 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 or if a final decision in an *inter partes* reexamination proceeding instituted by a third-party requester is favorable to the patentability of any original or proposed amended or new claim of the patent, 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, notwithstanding any other provision of this chapter. 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.

§ 1.907 *Inter partes* reexamination prohibited.

(a) Once an order to reexamine has been issued under § 1.931, neither the third party requester, nor its privies, may file a subsequent request for *inter partes* reexamination of the patent until an *inter partes* reexamination certificate is issued under § 1.997, unless authorized by the Commissioner.

(c) If a final decision in an *inter partes* reexamination proceeding instituted by a third party requester is favorable to patentability of any original, proposed amended, or new claims of the patent, then neither that party nor its privies may thereafter request *inter partes* reexamination of any such patent claims on the basis of issues which that party, or its privies, raised or could have raised in such *inter partes* reexamination proceeding.

MPEP § 2640 Decision on Request (emphasis added in bold)

II. SECOND OR SUBSEQUENT REQUEST FILED DURING REEXAMINATION

Where an ordered *inter partes* reexamination is pending, and an *inter partes* reexamination request is subsequently filed, the prohibition provision of 37 CFR 1.907(a) must be borne in mind. Once an order for *inter partes* reexamination has been issued, neither the third party requester of the *inter partes reexamination*, nor its privies, may file a subsequent request for *inter partes* reexamination of the same patent until an *inter partes* reexamination certificate has been issued, unless expressly authorized by the Director of the Office. Note that 37 CFR 1.907(a) tracks the statutory provision of 35 U.S.C. 317(a). A petition for such express authorization is a **request for extraordinary relief** and will not be granted where there is a more conventional avenue to accomplish the same purpose and provide relief analogous to

that requested. See also *Cantello v. Rasmussen*, 220 USPQ 664 (Comm'r Pat. 1982) for the principle that extraordinary relief will not normally be considered if the rules provide an avenue for obtaining the relief sought.

DECISION

I. Third Party Requester's Petition of September 14, 2012

Third Party Requester-Petitioner is seeking that the Director, in his discretion pursuant to 35 U.S.C. § 317(a), authorize the Third Party Requester-Petitioner to file a second request "for *inter partes* reexamination for claims 1 and 6 of U.S. Patent No. 7,394,432 B2" prior to the issuance and publication of an *inter partes* certificate in the '1483 *inter partes* reexamination proceeding.⁴ Third Party Requester-Petitioner asserts that due to the America Invents Act (hereinafter referred to as "AIA"), as of September 16, 2012, requester can no longer seek, as a matter of right, any *inter partes* relief concerning the patentability of the claims of the '208 patent.

Petitioner notes that the AIA eliminated new *inter partes* reexamination filings on/after September 16, 2012, and that the AIA provides that "[a]n *inter partes* review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date the petitioner is served with a complaint alleging infringement of the patent." 35 U.S.C. § 315(a) (effective September 16, 2012). Petitioner points out that because it was served with a complaint of infringement of the '208 patent more than one year ago, it may not file a petition for *inter partes* review.⁵ Accordingly, petitioner asserts that without relief through this petition to permit a second *inter partes* reexamination, it "will not have any avenue for a further *inter partes* challenge to the patentability of the '208 Patent."⁶

Petitioner contends that justice dictates that it be allowed to file this additional *inter partes* reexamination request, because none of the four references relied upon were part of the existing reexamination proceedings and two of the references were only recently discovered.⁷

Third Party Requester-Petitioner asserts that a petitioner who discovers prior art subsequent to the filing the ordered *inter partes* reexamination proceeding has only three alternatives to bring new proposed rejections before the Office prior to September 16, 2012. The alternatives asserted are the following:

1. Initiate an *ex parte* reexamination of the patent;

⁴ The undersigned notes that the deposited *inter partes* reexamination request seeks reexamination of claims 1 and

6. The petition is treated as a request for authorization for the entire *inter partes* reexamination request.

⁵ Petition at 1.

⁶ Id.

⁷ Petition at 8.

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