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95/001,914 02/29/2012 7,932,923 4079-0101 RXM 1269

6449 7590 02/13/2013
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| EXAMINER |
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HUGHES, DEANDRA M

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02/13/2013

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.



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Date:

MAILED

FEB 13 2013

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95001914
PATENT NO. : 7932923
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.



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(For Patent Owner)

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CENTRAL REEXAMINATION UNIT

In re Lipton et al
Inter Partes Reexamination Proceeding
Control No. 95/001,914
Filed: February 29, 2012
For: U.S. Patent No.: 7,932,923

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

This is a decision on patent owner’s December 3, 2012 petition entitled “Petition to Terminate Reexamination Proceeding under 35 U.S.C. § 317(b) and 37 CFR §§ 1.182, 1.907(b)”, which is taken as a petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding (patent owner’s December 3, 2012 petition to terminate).

Patent owner’s December 3, 2012 petition to terminate, and the record as a whole, are before the Office of Patent Legal Administration for consideration.

SUMMARY

Patent owner’s petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/001,914 is **granted**.

Prosecution of *inter partes* reexamination proceeding 95/001,914 is hereby **terminated**.

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/001,914 (the ‘1914 proceeding) is required by 35 U.S.C. 317(b), which provides, in pertinent part (emphasis added):

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 . . . an *inter partes* reexamination requested by that party or its privies on the basis of . . . issues [which that party or its privies raised or could have raised in such civil action] may not thereafter be maintained by the Office . . .

The Office analyzes whether a reexamination proceeding must be terminated pursuant to 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.

The patent owner informs the Office that the patent under reexamination, U.S. Patent No. 7,932,923 (the '923 patent), was the subject of a civil action in district court, i.e., *ObjectVideo, Inc., v. Robert Bosch GmbH, et al*, Civil Action No. 3:11cv217 (E.D. Va.) (the litigation). The patent owner submits, with the present petition, a copy of the district court's "Stipulation and Order of Dismissal". The order, which was signed by the court on November 13, 2012, states that "[t]he parties further stipulate and request that the Court order that the Bosch Defendants, namely Robert Bosch GmbH and Bosch Security Systems, Inc., have not sustained their burden of proving the invalidity of . . . any of the claims 1-41 of U.S. Patent No. 7,932,923", and that "[t]his Order is a final and non-appealable decision". Office records reveal that Bosch Security Systems, Inc., is the requester of the present *inter partes* reexamination proceeding. Thus, the patent owner has provided sufficient evidence that (1) the requester was a party to the litigation, (2) the district court's decision was final, and (3) the court determined that the requester/defendant had not sustained its burden of proving the invalidity of any claim of the '923 patent, i.e., any of claims 1-41, which include all of the claims under reexamination. For these reasons, elements 1-3 have been shown to have been satisfied.

The patent owner also submits, with the present petition, a copy of the district court's docket for the litigation. The court's docket provides evidence that the litigation, at the time of the court's November 13, 2012 order, was at a sufficiently early stage that the requester could have raised in the civil action any issues that have been raised in the present reexamination proceeding. For this reason, element 4 has been shown to have been satisfied.

For the reasons given above, patent owner's December 3, 2012 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **granted**.

Prosecution of *inter partes* reexamination proceeding control no. 95/001,914 (the '1914 proceeding) is hereby **terminated**.

The '1914 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for conclusion of that proceeding. The CRU will mail the present decision, and process the reexamination file to update the Image File Wrapper (IFW) records for this proceeding. The file will be assigned an 822 status. A copy of the PALM "Application Number Information" screen and the "Contents" screen will be printed, the printed copy will be annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy will then be scanned into Image File Wrapper (IFW) using the miscellaneous letter document code.

CONCLUSION

- Patent owner's December 3, 2012 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/001,914 is **granted**.

- The prosecution of the '1914 *inter partes* reexamination proceeding is hereby **terminated** and will be concluded.
- The '1914 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for further processing to conclude the '1914 proceeding, as set forth in this decision.
- Any inquiry concerning this communication should be directed to the undersigned at (571) 272-7724.

/Cynthia L. Nessler/
Cynthia L. Nessler
Senior Legal Advisor
Office of Patent Legal Administration

2 12 2013