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95/000,190	11/17/2006	6496216	199-0179RX	6427

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SUITE 600  
HOUSTON, TX 77070

EXAMINER
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ESCALANTE, OVIDIO

ART UNIT	PAPER NUMBER
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3992

MAIL DATE	DELIVERY MODE
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02/11/2009

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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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
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Date:

**MAILED**

**FEB 11 2009**

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95000190  
PATENT NO. : 6496216  
TECHNOLOGY CENTER : 3999  
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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MAILED

FEB 11 2009

CENTRAL REEXAMINATION UNIT

In re Feder et al.  
*Inter Partes* Reexamination Proceeding  
Control No. 95/000,190  
Filed: November 17, 2006  
For: U.S. Patent No. 6,496,216

:  
: DECISION  
: TERMINATING  
: REEXAMINATION  
:

This is a decision on the November 21, 2008 patent owner paper titled "Petition to Reconsider Decision on Petition to Terminate *Inter Partes* Reexamination."

On September 30, 2008, in response to patent owner's July 24, 2008 response to an order to show cause, the Office mailed a decision granting-in-part the April 29, 2008 patent owner petition titled "PETITION TO TERMINATE INTER PARTES REEXAMINATION PURSUANT TO 35 U.S.C. § 317(b) AND 37 C.F.R. § 1.907(b)," (the "Petition"). That decision terminated reexamination of claims 1, 16-18, 20-22, and 40, thereby limiting further prosecution, in the '190 proceeding, to claims 2-15, 19, and 23-39.

The petition paper, and *inter partes* reexamination control number 95/000,190 are before the Office of Patent Legal Administration.

For the reasons set forth below, the patent owner petition to terminate the present reexamination proceeding is granted.

BACKGROUND

1. U.S. patent No. 6,496,216 ("the '216 patent") issued to Meir Feder et al. on December 17, 2002, with 40 claims, and it is currently assigned to Polycom, Inc. ("Polycom").
2. On November 15, 2005, patent owner Polycom filed suit against Codian, Ltd. and Codian, Inc. ("Codian") for infringement of the '216 patent in the United States District Court for the Eastern District of Texas.<sup>1</sup>

<sup>1</sup> *Polycom, Inc. et al. v. Codian Ltd. et al.*, No. 2:05cv520 DF (E.D. Texas November 15, 2005).

3. On November 17, 2006, a request for *inter partes* reexamination of the '216 patent, assigned control No. 95/000,190 (the '190 reexamination"), was filed by a third party requester on behalf of real party in interest Codian, Inc. (the "requester").
4. On February 3, 2007, the Office issued an order granting the request for *inter partes* reexamination for claims 1-40 of the '216 patent.
5. On February 14, 2008, a Consent Judgment was entered in the District Court litigation, in which Consent Judgment Codian agreed that the '216 patent is valid and enforceable, and all claims and counterclaims asserted by each party were dismissed *with prejudice*.
6. On April 29, 2008, a petition entitled "PETITION TO TERMINATE *INTER PARTES* REEXAMINATION PURSUANT TO 35 U.S.C. § 317(b) AND 37 C.F.R. § 1.907(b)" was filed by patent owner Polycom.
7. On June 24, 2008, the Office mailed a decision dismissing the April 29, 2008 petition and containing a show cause order to the parties with respect to termination and/or limitation of the '190 proceeding.
8. On July 24, 2008, the patent owner filed a response (to the June 24, 2008 decision) providing a showing of cause for the requested termination and renewing its requested termination of the '190 proceeding.
9. The third party requester has not filed a response to the June 24, 2008 show cause order.
10. On September 30, 2008, the Office mailed a decision terminating reexamination of claims 1, 16-18, 20-22, and 40, and limiting further prosecution and examination in the '190 proceeding to claims 2-15, 19, and 23-39.
11. On November 21, 2008, patent owner filed the present petition requesting reconsideration of the decision of September 30, 2008, and renewing its request for complete termination of the '190 proceeding.
12. The third party requester has not filed a response to the September 30, 2008 decision, nor has third party requester filed an opposition to patent owner's petition of November 21, 2008.
13. On February 4, 2009, a request for change of correspondence address of the third party requester was filed. This request was not signed by the representative of record or the requester real party in interest. Accordingly, it is not effective. However, a courtesy copy of this decision is being sent to the correspondence address requested therein and noted below.

## DECISION

### I. Patent Owner's Position

Patent owner contends that the estoppel provisions of 35 U.S.C. § 317(b) attach to the entire reexamination proceeding and the Office must not maintain the present reexamination proceeding, because of a Consent Judgment entered February 14, 2008, in the concurrent litigation between the same parties, which Consent Judgment became final by the absence of any appeal to the Federal Circuit within 30 days. Specifically, it is patent owner's position that Codian's counterclaim of invalidity of the patent coupled with the consent judgment in which Codian consented that each of the enumerated patents is valid and enforceable establishes all the requisites for the estoppel provisions of 35 U.S.C. § 317(b) to apply to each claim of the patents in suit.

### II. Analysis and Findings

(i) The previous decision found:

[I]nsofar as the burden of proving invalidity of any claim in suit devolved upon Codian, Codian has not sustained its burden. Further, as noted above, patent owner has established that this order has matured into a final decision. What then remains to be established is whether Codian had the burden of proving invalidity with respect to each patent claim for which patent owner requests termination.<sup>2</sup>

(ii) Involved Claims

The order to show cause issued by the Office operated under the assumption that only claims 1, 16-18, 20-22, and 40 were asserted against Codian, and that if a claim was not asserted against a defendant, then the defendant had no cause to attack the validity of the unasserted claim.

Patent owner now explains (with reference to Codian's response and counterclaims) that the record of the litigation evidences that all claims were asserted against Codian, and that Codian challenged the validity of the patents in their entirety. The limitation to the aforementioned claims was an artifact of a limitation, imposed by the presiding judge, as to the number of claims that could be dealt with in detail in the trial phase of the civil litigation.

### IV. Decision

35 U.S.C. § 317(b) provides (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 neither that party nor its privies may thereafter request an inter partes reexamination of any**

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<sup>2</sup> Decision mailed September 30, 2008 at page 6. See the decision at pages 5-6 for the detailed analysis.

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....”

In light of the specific facts and circumstances of this proceeding, including a review of the litigation history of the district court case, patent owner’s position that all claims of the ‘216 patent qualify as “claims in suit” for purposes of applying 35 U.S.C. § 317(b) is being accepted.

Accordingly, based on 35 U.S.C. § 317(b), proceeding further with the present *inter partes* reexamination is barred as to all claims in the ‘216 patent.

The petition to terminate the ‘190 reexamination proceeding is therefore granted.

Jurisdiction over the ‘190 inter partes reexamination proceeding is being forwarded to the Central Reexamination Unit (CRU) for conclusion of the 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.

#### V. Additional Discussion

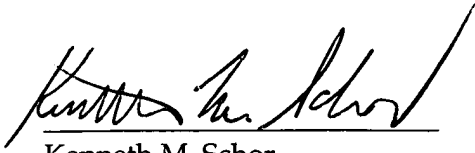
Termination of this proceeding due to the estoppel provisions of 35 U.S.C. § 317(b) is not a resolution on the merits of any substantial new question of patentability that gave rise to the ‘190 proceeding nor is it a determination of the patentability of any of the claims over the rejections of record (whether adopted or non-adopted) in the proceeding.

Accordingly, an *ex parte* reexamination request by any party based upon any substantial new question of patentability (SNQ) raised in this proceeding would not be precluded, i.e., such an could form the basis for instituting a further *ex parte* reexamination. Likewise, any SNQ raised in this proceeding would not be precluded in an *inter partes* reexamination request by a party not subject to the estoppel provisions of 35 U.S.C. § 317(b) and could form the basis for instituting a further *inter partes* reexamination.

### CONCLUSION

1. The patent owner petition to terminate the ‘190 reexamination proceeding is granted.
2. The prosecution of the ‘190 inter partes reexamination proceeding is hereby terminated, and the ‘190 proceeding will be concluded.
3. Jurisdiction over the ‘190 reexamination proceeding is being returned to the Central Reexamination Unit (CRU) for further processing to conclude the ‘190 proceeding, as set forth above.

4. Telephone inquiries related to this decision should be directed to Pinchus M. Laufer, Legal Advisor, at (571) 272-7726, or in his absence, to the undersigned at (571) 272-7710.



Kenneth M. Schor  
Senior Legal Advisor  
Office of Patent Legal Administration

02-10-09

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