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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,476	07/13/2009	6998537	096001-0108	8496
22428	7590	02/24/2012	EXAMINER	
FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			ART UNIT	PAPER NUMBER

DATE MAILED: 02/24/2012

Please find below and/or attached an Office communication concerning this application or proceeding.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Scott Petty
KING & SPALDING
1180 Peachtree Street, NE
Atlanta, GA 30309-3521

Date: **MAILED**

FEB 24 2012

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95000476

PATENT NO. : 6998537

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.

PTOL-2070(Rev.07-04)



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Foley & Lardner, LLP
Suite 500
3000 K Street, NW
Washington, D.C. 20007

(For Patent Owner)

King & Spalding
1180 Peachtree Street, NE
Atlanta, GA 30309 - 3521

(For Requester)

MAILED

FEB 24 2012

CENTRAL REEXAMINATION UNIT

In re Clark et al
Inter Partes Reexamination Proceeding
Control No. 95/000,476
Filed: July 13, 2009
For: U.S. Patent No.: 6,998,537

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

This is a decision on patent owner's December 8, 2011 petition entitled "Petition for Termination of Reexamination Proceedings Pursuant to 37 C.F.R. § 1.182" (the December 8, 2011 petition to terminate), and on patent owner's February 16, 2012 paper entitled "Supplement to Petition for Termination of Reexamination Proceedings Pursuant to 37 C.F.R. § 1.182" (the February 16, 2012 supplement).

The December 8, 2011 petition to terminate, the February 16, 2012 supplement, 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 95/000,476, filed on December 8, 2011, is **granted**.

Inter partes reexamination proceeding 95/000,476 is hereby **terminated**.

DECISION

The patent owner argues that termination of *inter partes* reexamination proceeding control number 95/000,476 (the '476 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 6,998,537 (the '537 patent), was the subject of a civil action in district court, i.e., *Belden Technologies Inc. v. Superior Essex Communications LP*, Case No. Civ. No. 08-63-SLR (D. Del.). The patent owner submits a copy of a consent judgment, entered by the district court on November 10, 2011, in which the district court stated that "Superior Essex [the defendant/requester of the '476 proceeding] has not sustained its burden of proving the invalidity of any of the asserted claims (1-22) of the '537 Patent [the patent under reexamination]". The court also stated that "[a]ny remaining claims or counterclaims of the parties are dismissed with prejudice", and that "[t]he parties waive their right to appeal or otherwise contest this Consent Final Judgment". Thus, the patent owner has provided sufficient evidence that (1) the requester Superior Essex 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 the claims in suit. The patent owner has also submitted, on February 16, 2012, an amendment cancelling claims 23 and 24, which renders the claims under reexamination to be identical to the patent claims in suit. For these reasons, the above-described elements 1-3 have been shown to be satisfied.

Regarding element 4, the patent owner has submitted a copy of a document entitled "Stipulation and Order Amending Revised Scheduling Order", showing that discovery did not close until August 14, 2009, which was after the July 13, 2009 filing date for the request for reexamination in the present proceeding.¹ This document, in addition to the other evidence submitted by the patent owner with the present petition, provides sufficient evidence that the prior art, and any other issues present in the '476 reexamination proceeding, were either raised or could have been raised by the defendant/requester in the civil action. Thus, element 4 has been shown to be satisfied.

For the reasons given above, patent owner's December 8, 2011 petition under 37 CFR 1.182 to terminate the present *inter partes* reexamination proceeding is **granted**.

Inter partes reexamination proceeding control no. 95/000,476 (the '476 proceeding) is hereby **terminated**.

¹ With the February 16, 2012 supplement to the present petition, the patent owner has also provided evidence that the "Stipulation and Order Amending Revised Scheduling Order" was signed and ordered by the court.

The '476 *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 8, 2011 petition under 37 CFR 1.182 to terminate *inter partes* reexamination proceeding control number 95/000,476 is **granted**.
- The prosecution of the '476 *inter partes* reexamination proceeding is hereby **terminated** and will be concluded.
- The '476 *inter partes* reexamination proceeding is being referred to the Central Reexamination Unit (CRU) for entry of the February 16, 2012 amendment and for further processing to conclude the '476 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