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95/000,227	02/09/2007	6433419	TESSERA 3.5-018CCIHC	6504
530	7590	09/10/2008	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			ART UNIT	PAPER NUMBER

DATE MAILED: 09/10/2008

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



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Date:

**MAILED**

**SEP 10 2008**

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95000227  
PATENT NO. : 6433419  
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

SEP 10 2008

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In re Khandors  
Reexamination Proceeding  
Control No.: 95/000,227  
Filed: February 9, 2007  
For: U.S. Patent No.: 6,433,419

:  
: DECISION  
: DENYING  
: PETITION  
:

This is a decision on the June 6, 2008 patent owner petition paper entitled "RENEWED PETITION TO VACATE FILING DATE FOR FAILURE TO INCLUDE INDENTITY OF REAL PARTY IN INTEREST" ("the renewed petition"). This decision also has considered the third party requester ("requester") opposition petition paper originally filed on June 11, 2008 and subsequently re-submitted on July 21, 2008 entitled "THIRD PARTY REQUESTOR'S PETITION AND OPPOSITION TO PATENT OWNER'S RENEWED PETITION TO VACATE FILING DATE FOR FAILURE TO INCLUDE INDENTITY OF REAL PARTY IN INTEREST" ("the opposition paper").

The renewed petition and the opposition paper are before the Office of Patent Legal Administration for consideration.

Summary:

The patent owner petition paper has been considered as petition under 37 CFR 1.182 and 1.183. The petition is denied with respect to the relief requested therein.

This decision is designated as a final agency action pursuant to 5 U.S.C. § 704.

**FEES**

A single petition fee of \$400.00 pursuant to 37 CFR 1.17(f) will be charged to Deposit Account No. 12-1095 as invited on page 1 of the patent owner petition. Similarly, the

opposition paper will also be treated under 37 CFR 1.182 and 1.183. Accordingly, a single \$400.00 petition fee has been remitted by credit card authorization form attached to the present opposition paper.

### RELEVANT BACKGROUND

1. U.S. Patent No. 6,433,419 (hereinafter, the '419 patent) was issued on August 13, 2002.
2. On February 9, 2007, a request for *inter partes* reexamination of the '419 patent was filed by requester, Silicon Precision Industries Co., Ltd. (hereinafter "Siliconware"<sup>1</sup>) and was assigned control No. 95/000,227 ("the '227 reexamination proceeding").
3. On March 26, 2007, patent owner filed a petition under 37 CFR 1.182 and 1.183 to vacate the filing date in the present reexamination proceeding, or alternatively, to suspend action in the proceeding.
4. Patent owner's March 26, 2007 petition provided that the '419 patent, (along with other related patents), was currently the subject of litigation in *Tessera, Inc. v. Advanced Micro Devices, Inc. et al* (No. 4:05CV04063) in the United States District Court for the Northern District of California. Petitioner patent owner asserted that Siliconware was one of multiple co-defendants in the *Tessera* litigation.<sup>2</sup>
5. On April 16, 2007, the Office issued a "Notice of Time Period to Oppose Petition to Vacate Filing Date in Reexamination Proceeding."
6. On April 17, 2007, requester submitted a paper entitled "Litigation Activity Update under 37 C.F.R. 1.985." On May 7, 2007, patent owner (Tessera, Inc.), submitted a paper entitled "Notice of Prior and Concurrent Proceedings Pursuant to 37 CFR 1.985."
7. On April 23, 2007, the Office issued a "Modified Notice of Time Period to Oppose Petition to Vacate Filing Date in Reexamination Proceeding ... " in which the April 16, 2007 Notice was vacated.
8. On May 4, 2007, the Office issued a decision granting the request for reexamination in the '227 reexamination proceeding. The decision granting the '227 request was not accompanied by the first Office action on the merits, which action was, instead, mailed on June 5, 2007.
9. On May 8, 2007, requester submitted, in response to the Modified Notice, a paper entitled "Third Party Requestor's Petition and Opposition to Patent Owner's Petition to Vacate Filing Date or Suspend *Inter Partes* Reexamination."

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<sup>1</sup> At page 1 of the "Request for *Inter Partes* Reexamination Transmittal Form," Silicon Precision Industries Co., Ltd. was identified as the "real party in interest," pursuant to 37 CFR 1.915(b) and 35 U.S.C. 311(b). At page 1, paragraph 1 of the request papers, Siliconware Precision Industries Co., Ltd. and Siliconware USA, Inc., (collectively "Siliconware"), were identified as the parties requesting reexamination. In the present requester opposition paper, third party requester unambiguously identifies Siliconware Precision Industries Co., Ltd. and Siliconware USA, Inc., (collectively "Siliconware"), as the real party in interest in the present '227 *inter partes* reexamination proceeding. These parties are named defendants in the litigation mention in Fact # 4. The real party in interest is deemed to be as identified in the present opposition paper, and will hereinafter be referred to as "Siliconware."

<sup>2</sup> "Petition to Vacate Filing Date ... or, Alternatively, to Suspend ... Proceeding," March 26, 2007, page 3, footnote 3.

10. On June 8, 2007, the Office issued a decision denying the patent owner petition to vacate the filing date or, in the alternative, to suspend the '227 *inter partes* reexamination proceeding. The decision was designated as a final agency action under 5 U.S.C. § 704.
11. On July 5, 2007, patent owner filed a paper entitled "Request for Reconsideration of Decision Denying Petition to Vacate Filing Date," addressed to the June 8, 2007 Office decision.
12. On September 7, 2007, the Office mailed a decision that granted the July 5, 2007 request for reconsideration only to the extent that the June 8, 2007 decision was reconsidered, but which denied the underlying relief requested in July 5, 2007 request for reconsideration. The September 7, 2007 decision was also designated as a final agency action under 5 U.S.C. § 704. <sup>3</sup>
13. On June 6, 2008, patent owner filed the present renewed petition.
14. On June 11, 2008, requester filed opposition papers opposing the renewed petition, which opposition papers were re-submitted on July 21, 2008. <sup>4</sup>

#### RELEVANT STATUTORY, REGULATORY AND PRACTICE PROVISIONS

35 U.S.C. §§ 311(a) and (b) provide:

(a) IN GENERAL.— Any third-party requester at any time may file a request for *inter partes* reexamination by the Office of a patent on the basis of any prior art cited under the provisions of section 301.

(b) REQUIREMENTS.— The request shall—

(1) be in writing, include the identity of the real party in interest, and be accompanied by payment of an *inter partes* reexamination fee established by the Director under section 41; and

(2) set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested.

35 U.S.C. § 315(c) provides:

CIVIL ACTION.— A third-party requester whose request for an *inter partes* reexamination results in an order under section 313 is estopped from asserting at a later time, in any civil action arising in whole or in part under section 1338 of title 28, the invalidity of any claim finally determined to be valid and patentable on any ground which the third-party requester raised or could have raised during the *inter partes* reexamination proceedings. This subsection does not prevent the assertion of invalidity based on newly discovered prior art unavailable to the third-party

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<sup>3</sup> It is noted that this decision refers to the patent owner's request for reconsideration as having been filed on July 2, 2007. However, that date is the date appearing in the 37 CFR 1.8 certificate of mailing. The actual filing date of the request for reconsideration was July 5, 2007.

<sup>4</sup> The June 11, 2008 opposition paper and the exhibits attached thereto were labeled as being subject to a Protective Order. Further, the copies of these papers that were served on patent owner arrived in an envelope that labeled the content of the envelope as being subject to a Protective Order, and each paper in the envelope was so labeled. In response to an Order to Show Cause promulgated by the Office on July 8, 2008, third party requester filed papers on July 21, 2008 that "de-designated" the documents so that they were no longer submitted as being subject to a Protective Order. The "de-designated" documents were then served on patent owner.

requester and the Patent and Trademark Office at the time of the inter partes reexamination proceedings.

35 U.S.C. § 317 provides:

(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.

(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.

37 CFR 1.105 provides:

(a)(1) In the course of examining or treating a matter in a pending or abandoned application filed under 35 U.S.C. 111 or 371 (including a reissue application), in a patent, or in a reexamination proceeding, the examiner or other Office employee may require the submission, from individuals identified under § 1.56(c), or any assignee, of such information as may be reasonably necessary to properly examine or treat the matter, for example:

(i) *Commercial databases*: The existence of any particularly relevant commercial database known to any of the inventors that could be searched for a particular aspect of the invention.

(ii) *Search*: Whether a search of the prior art was made, and if so, what was searched.

(iii) *Related information*: A copy of any non-patent literature, published application, or patent (U.S. or foreign), by any of the inventors, that relates to the claimed invention.

(iv) *Information used to draft application*: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used to draft the application.

(v) *Information used in invention process*: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(vi) *Improvements*: Where the claimed invention is an improvement, identification of what is being improved.

(vii) *In Use*: Identification of any use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use.

(viii) *Technical information* known to applicant.

Technical information known to applicant concerning the related art, the disclosure, the claimed subject matter, other factual information pertinent to patentability or concerning the accuracy of the examiner's stated interpretation of such items.

(2) Where an assignee has asserted its right to prosecute pursuant to § 3.71(a) of this chapter, matters such as paragraphs (a)(1)(i), (iii), and (vii) of this section may also be applied to such assignee.

(3) Requirements for factual information known to applicant may be presented in any appropriate manner, for example:

(i) A requirement for factual information;

(ii) Interrogatories in the form of specific questions seeking applicant's factual knowledge; or

(iii) Stipulations as to facts with which the applicant may agree or disagree.

(4) Any reply to a requirement for information pursuant to this section that states either that the information required to be submitted is unknown to or is not readily available to the party or parties from which it was requested may be accepted as a complete reply.

(b) The requirement for information of paragraph (a)(1) of this section may be included in an Office action, or sent separately.

(c) A reply, or a failure to reply, to a requirement for information under this section will be governed by §§ 1.135 and 1.136.

37 CFR 1.907 provides:

(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 Director.

(b) Once a final decision has been entered against a party in a civil action arising in whole or in part under 28 U.S.C. 1338 that the party has not sustained its burden of proving invalidity of any patent claim-in-suit, then neither that party nor its privies may thereafter request *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, 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.

(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.

37 CFR 1.913 provides:

Except as provided for in § 1.907, any person other than the patent owner or its privies may, at any time during the period of enforceability of a patent which issued from an original application filed in the United States on or after November 29, 1999, file a request for *inter partes* reexamination by the Office of any claim of the patent on the basis of prior art patents or printed publications cited under § 1.501.

37 CFR 1.915(b)(7), (b)(8) and (d) provide:

(b) A request for *inter partes* reexamination must include the following parts:

(7) A certification by the third party requester that the estoppel provisions of § 1.907 do not prohibit the *inter partes* reexamination.

(8) A statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy.

...

(d) If the *inter partes* request does not include the fee for requesting *inter partes* reexamination required by paragraph (a) of this section and meet all the requirements of paragraph (b) of this section, then the person identified as requesting *inter partes* reexamination will be so notified and will generally be given an opportunity to complete the request within a specified time. Failure to comply with the notice will result in the *inter partes* reexamination request not being granted a filing date, and will result in placement of the request in the patent file as a citation if it complies with the requirements of § 1.501.

37 CFR 1.919(a) provides:

(a) The filing date of a request for *inter partes* reexamination is the date on which the request satisfies all the requirements for the request set forth in § 1.915.

MPEP § 2612 provides, in part:

37 CFR 1.907 defines specific situations where a third party is prohibited from filing a request for an inter partes reexamination. 37 CFR 1.915(b)(7) requires the third party requester to certify that the estoppel provisions of 37 CFR 1.907 do not prohibit the filing of the inter partes reexamination request by the real party in interest (note that it is the real party in interest that is subject to the estoppel provisions and not the party who actually files the request). The certification identified in 37 CFR 1.915(b)(7) will constitute a prima facie showing that the party requesting the inter partes reexamination is not barred from doing so under 37 CFR 1.907. The Office does not intend to look beyond this required certification. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would then need to be addressed. A challenge to the accuracy of the certification must facially establish that the third party requesting the inter partes reexamination is barred from doing so under 37 CFR 1.907. Thus, for example, the challenger cannot rely on an argument that the third party requesting reexamination was, at one point, involved with a party barred under 37 CFR 1.907, and should thus be considered as a real party in interest (and barred from filing the request). Involvement *per se* does not facially establish that the other party is a real party in interest. The fact that a second party may benefit from an earlier reexamination request filed by a first party or a civil action conducted by the first party, or that the second party may have collaborated with the first party in a matter, does not facially evidence the second party was a real party in interest with the first party. With respect to the Office conducting an investigation to uncover whether the second party was a "real party in interest," the statute does not require, nor does it provide the tools, for the Office to investigate such matter. Further, Congress has not provided the Office with subpoena power or discovery tools and has not provided the Office with the ability to conduct hearings for eliciting testimony and cross-examination. The Office has not been authorized to impose punitive sanctions for non-compliance. Such evidentiary tools are, however, available to the courts, which are the appropriate vehicle to make a factual investigation as to the accuracy of the identification of a "real party in interest."

MPEP § 2614 provides, in part:

The reexamination request must identify the real party in interest who is responsible for filing the reexamination request. This information will be used by future parties requesting reexamination of the same patent, in making the certifications required by 37 CFR 1.915(b)(8).

## DECISION

### I. Timeliness of the Renewed Petition

Note is taken that there is an issue of whether the present renewed petition to vacate has been timely filed because 37 CFR 1.181(f) provides, in pertinent part:

"Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable."

The present renewed petition was filed on June 11, 2008, eleven months after the Office mailed a decision denying patent owner's July 5, 2007 request for reconsideration of the Office decision dated June 8, 2007. The Office's decision was designated as final agency action.

In the July 5, 2007 request for reconsideration and in the March 26, 2007 original petition, patent owner argued that the request for *inter partes* reexamination in the '227 proceeding,



as filed, admitted that defendants in the litigation identified in Fact # 4, *supra*, other than Siliconware, had filed reexamination requests.<sup>5</sup> Patent owner also argued that the existence of multiple co-defendants in the litigation, in which the defendants have a common interest and are collaborating to attack the validity of the '419 patent, indicated that the other defendants, should also be named as the real party in interest in the '227 proceeding. Patent owner drew certain inferences based on the timing of the filing of papers in the litigation and the filing of the '227 request for reexamination that patent owner asserted "proved" that the other co-defendants are unnamed real parties in interest in the '227 proceeding, and that the Office had a duty to investigate the matter.<sup>6</sup>

A comparison of the arguments advanced by patent owner in the present renewed petition with the arguments relied upon by prior patent owner in the prior petitions to vacate or suspend the '227 reexamination proceeding shows that patent owner is now relying on information (to establish that the real party in interest was not properly identified in the request for reexamination of that proceeding) that may not have been available for inclusion in the prior petitions to vacate or suspend. Accordingly, the Office deems that the present renewed petition is not untimely filed.<sup>7</sup>

## II. Patent Owner's Case for Vacatur

In the present petition, patent owner asserts that there is now firm evidence that the real party in interest was not properly identified in the '227 request for reexamination. The asserted evidence is:

- a. A declaration of Brian Marucci, Vice President of Business Development and Licensing for patent owner, that discusses a meeting with Juliette Chan, Corporate Counsel for Siliconware Precision and C.B. Chang, Vice President for Sales for Siliconware USA. In this declaration, Mr. Marucci avers that, in conversation, Ms. Chan stated that respondents in Investigation No. 337-TA-605 before the U.S. International Trade Commission<sup>8</sup> would be unhappy with Siliconware if Siliconware stopped participating in the '227 reexamination proceeding because "they would lose control of the reexaminations." Mr. Marucci further avers that Ms. Chan subsequently refused to disclose Siliconware's conversations with third parties regarding the '227 reexamination proceeding.<sup>9</sup>
- b. STMicroelectronics, N.V. ("ST-NV"), co-defendant in the '419 patent litigation, filed an Annual Report with the U.S. Securities and Exchange Commission ("SEC") "at approximately the same time" that the original March 26, 2007 patent owner petition was filed. In that report, ST-NV stated that:

Tessera is claiming<sup>10</sup> that our BGA packages practice certain technology and patents owned by Tessera, and that we are liable for royalties. Trial is currently scheduled for the first quarter of 2008. **We recently filed, together with our co-**

<sup>5</sup> "Petition to Vacate Filing Date ... or, Alternatively, to Suspend ... Proceeding," March 26, 2007, page 3.

<sup>6</sup> *Id.*, at pages 3-11. See also "Request for Reconsideration ...," July 5, 2007.

<sup>7</sup> The Office takes note that patent owner has not timely contested the determination by the Office that neither the March 26, 2007 petition nor the July 5, 2007 request for reconsideration established that the real party in interest had not been properly identified in the '227 request for reexamination, but rather is acting on apparently newly available information.

<sup>8</sup> Patent Owner Complainant in that ITC Investigation which also involves the '419 patent.

<sup>9</sup> Mr. Marucci's declaration is attached to the present renewed petition.

<sup>10</sup> In the '419 patent litigation.

**defendants, a request for reexamination by the United States Patent and Trademark Office of all patents being asserted by Tessera in the lawsuit. [Emphasis supplied by patent owner.]** <sup>11</sup>

Patent owner notes that subsequent to the March 26, 2007 petition to vacate the filing date, later ST-NV SEC filings omitted mention of ST-NV's participation. <sup>12</sup>

- c. Patent owner refers to an annual report by ChipMOS Technologies Bermuda Ltd., that was filed with the SEC, in which it is stated that ChipMOS Taiwan and ChipMOS USA requested reexamination of all Tessera patents being asserted in the '419 patent litigation. <sup>13</sup>
- d. Patent owner also alleges that when it attempted to examine Dr. Richard K. Ulrich, a technical expert hired by Siliconware as to the involvement of unidentified parties in the reexamination proceedings and his communications with such entities, Dr. Ulrich refused to answer on the advice of counsel (who is also counsel in the '227 reexamination proceeding). Patent owner opines that this evidences a joint-defense privilege (joint participation) in the reexamination proceedings.

Patent owner then asserts that there is undisputed evidence of participation and control of the '227 reexamination proceeding by unidentified real parties in interest other than Siliconware, and that requester argues that it need not state the real party in interest accurately. <sup>14</sup> Patent owner concludes that the '227 reexamination proceeding should be dismissed, or in the alternative, that requester should be required to show cause why the petition should not be granted.

### III. Requester's Case Against Vacatur

In the opposition paper, requester argues that the Marucci declaration contains language that is subject to interpretation. Requester also argues that, in the conversation referred to in the Marucci declaration, Ms. Chan told Mr. Marucci that Siliconware solely prepared, filed, paid for and controls the reexamination request for the '419 patent, (*i.e.*, the '227 reexamination proceeding). <sup>15</sup>

Requester asserts that the ST-NV SEC filing was subsequently corrected to point out that ST-NV's co-defendants in the '419 patent litigation, and not ST-NV, had filed reexamination requests for the involved Tessera patents. This argument is supported by a verified statement of Mr. Steven K. Rose, Vice President, Secretary and General Counsel of ST-NV and a copy of page 21 of Form 6-F filed on May 7, 2007, with the SEC. <sup>16</sup>

Requester argues that the 2007 20-F SEC filing by ChipMOS Technologies Bermuda, Ltd. (that states that a co-defendant filed a reexamination request against the '419 patent with the concurrence of ChipMOS Taiwan and ChipMOS USA) does not indicate that ChipMOS filed

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<sup>11</sup> The ST-NV SEC filing is attached to the renewed petition as Exhibit 1.

<sup>12</sup> "Renewed Petition to Vacate ...," June 6, 2008, page 11, footnote 5; See also: Exhibit 4 attached to the renewed petition.

<sup>13</sup> *Id.*, at page 12.

<sup>14</sup> *Id.*, at pages 16-21.

<sup>15</sup> "Third Party Requestor's Petition and Opposition to Patent Owner's Renewed Petition to Vacate ...," Exhibit D.

<sup>16</sup> *Id.*, Exhibit E and Exhibit A attached thereto.

the reexamination request or is in any way a real party in interest. Further, the 2008 20-F SEC filing by ChipMOS Technologies Bermuda, Ltd., states that:

[A] co-defendant in the Tessera lawsuit requested the United States Patent and Trademark Office to reexamine the patentability of each of Tessera's patents that are at issue in the case in the California court.<sup>17</sup>

It is requester's position that the statement means that another co-defendant, not ChipMOS, requested reexamination of the '419 patent, and that even if other co-defendants concurred with or consulted with Siliconware in the filing of the reexamination request, such would not "automatically" make such co-defendants real parties in interest. This follows, according to requester, from the fact there are sixteen co-defendants accused of infringing the same patents, that each defendant would necessarily "have an interest" in the claims of the '419 patent being invalidated, but that such an interest does not make any of such co-defendants a real party in interest or mean that Siliconware was falsely identified as being the (*i.e.*, only) real party in interest.<sup>18</sup>

Requester concludes by noting that with respect to Dr. Ulrich having invoked joint defense privilege, that does constitute a showing that co-defendants in the '419 patent litigation are real parties in interest in the '227 reexamination proceeding. To the extent that Dr. Ulrich is an expert for a defendant in the '419 patent litigation, and that some or all of the other co-defendants have formed a joint defense effort with Siliconware, patent owner has not established that mere status as part of that joint defense effort necessarily means that unidentified co-defendants are directing, controlling or paying for the '227 reexamination proceeding.

#### IV. Patent Owner Has Failed to Establish That Siliconware is Not the Real Party in Interest or That There is Reason to Believe that Unidentified Parties are Also Real Parties in Interest

After consideration of the arguments presented by patent owner and by requester, together with the supporting evidence submitted by these parties and the record as a whole, it is found that patent owner has failed to establish that there is another real party in interest, in addition to Siliconware, for the present reexamination proceeding. Rather, it appears that, as stated in the request papers and as confirmed in the present opposition paper, Siliconware is in fact the real party in interest in the '227 reexamination proceeding.

With respect to the SEC filings of ST-NV and ChipMOS which stated that they and their co-defendants filed reexamination proceedings against the Tessera patents: In view of the clarifications made by ST-NV and ChipMOS in subsequent SEC filings, it is quite reasonable to conclude that their earlier statements in the SEC filings were made in error, and that their later statements represent a correction of the earlier statements. There is no basis for determining that the earlier SEC filings by those entities were accurate, and it is not expected that any additional statements by those entities that would differ from those made in the subsequent SEC filings would be forthcoming.

With respect to the Marucci declaration: Even without consideration of the issue of whether the Marucci declaration constitutes hearsay, (as alleged by requester), it is clear that the Marucci declaration is not dispositive evidence that unidentified co-defendants in the '419

<sup>17</sup> Id., Exhibit F (pages 90-91 of Form 20-F filed June 9, 2008).

<sup>18</sup> Id., at page 6.

patent litigation are real parties in interest. The statement of Ms. Chan relied upon by patent owner may reasonably be interpreted as meaning that requester's co-defendants in the '419 patent litigation would be unhappy if Siliconware ceased to participate as the third party requester in the '227 proceeding, because then "they" (i.e., Siliconware) would be no longer control (i.e., "have input into") that reexamination proceeding, so that there would no longer be a party in the '227 proceeding that was interested in establishing claim unpatentability. Such an interpretation is no less reasonable than that urged by patent owner, in which the word "they" is interpreted to refer to respondents in the ITC proceeding in order to indicate that such respondents would no longer control the reexamination proceeding. Further, in light of the April 7, 2008 declaration filed and the attached e-mail that together constitute Exhibit D of requester's opposition paper, it is clear that Ms. Chan disagrees that such statement was made to be subject to the interpretation urged by patent owner in the present renewed petition; she recalls telling Mr. Marucci that other co-defendants or respondents "might be" worried if Siliconware "abandoned" the *inter partes* reexaminations, because no party would oppose patent owner in that proceeding.<sup>19</sup> Further, Ms. Chan's declaration affirmatively states that she told Mr. Marucci that Siliconware alone prepared, and paid for the preparation and filing of the '227 reexamination proceeding.<sup>20</sup>

With respect to the issues raised by patent owner regarding Dr. Ulrich being advised to claim privilege when patent owner attempted to examine him as to the involvement of "unidentified parties" in the reexamination proceedings: Patent owner has not cited any legal basis for drawing an inference/conclusion based on a claim of privilege. The basis for (considerations behind) a party claiming privilege is protected by law. In addition, it is hardly surprising that counsel would advise Dr. Ulrich to claim "joint-defense" privilege, where such privilege was properly available. Patent owner's "belief" as to the impact of advice to claim such privilege is no more cognizable on the issue of whether there are in fact "unidentified parties" who are actually real parties in interest in the '227 reexamination proceeding than such advice in a criminal matter would equate to an admission of guilt.

A. When The Identification Of The Real Party In Interest Is Not Facially Inaccurate Or Ambiguous, The Office Lacks The Authority And The Tools To Question That Identification

Patent owner believes that because there are a number of co-defendants in the '419 patent litigation, it is possible or likely that at least some of those co-defendants are actively participating in the '227 reexamination proceeding to the extent that they are real parties in interest. Patent owner thus urges that the Office should investigate the issue of whether the real party in interest has been properly identified in the '227 reexamination proceeding or at least require requester to establish why the patent owner petition should not be granted. It is, however, found that there is insufficient evidence presented by patent owner to establish that the '227 reexamination proceeding should be vacated. It is clear that the patent owner is in reality both requesting a remedy without having shown any damage, and requesting the Office to investigate a matter that patent owner bears the burden of establishing, and has not so established. The basis for this will now be discussed.

The arguments presented in the petition for reconsideration fail to establish that the Office has either the authority to question the accuracy of a third party requester's facially accurate

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<sup>19</sup> Id., at Exhibit D.

<sup>20</sup> Id.

and unambiguous identification of the real party in interest in an *inter partes* reexamination proceeding, or the tools to competently conduct an investigation of the matter.

To the extent that patent owner argues that the Office has the ability to investigate the accuracy of the identification of the real party in interest in an *inter partes* reexamination proceeding, or to issue a Show Cause Order requiring the identified real party in interest to confirm that it, and it alone, is the real party in interest, patent owner does not make a persuasive case that the Office is required to do so by either the reexamination statute or the reexamination regulations, when the *inter partes* reexamination as filed, or as subsequently corrected by the requester, contains an unambiguous identification of the identity of the real party in interest.

Patent owner's argument is not persuasive, because it does not reflect the intent of the provisions of 37 CFR 1.915(b)(7) and (b)(8). A certification statement made pursuant to 37 CFR 1.915(b)(7) is a statement by the third party requester to the effect that the third party requester is not itself estopped by the statutory estoppel provisions from filing a request for *inter partes* reexamination of a given patent. The *inter partes* rule making at 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), provides that:

"It should be noted that the Office generally will not have a need to resolve the factual issue of whether or not one party is a privy of another party. Section 1.915(b)(7) requires a third party requester to certify that the estoppel provisions of §1.907 do not prohibit the filing of the *inter partes* reexamination request, and the Office does not intend to look beyond this required certification. It is only in the rare instance where a challenge to the accuracy of the certification is raised by the patent owner, that the question would then need to be addressed."

A substantially identical statement also appears at 65 Fed. Reg. 76756, 76764. These statements establish that the Office will, in the rare instance that it is necessary to do so, "address" the accuracy of a certification that statutory estoppel does not bar the filing of a request for *inter partes* reexamination. However, the rulemaking does not discuss the type or depth of investigation that can and will be undertaken, and does not state or imply that a patent owner may trigger an investigation of the accuracy of the certification merely by advancing an unsupported allegation that the third party requester is estopped from filing a request for *inter partes* reexamination. Aside from the above, a second reexamination proceeding that would be the subject of the above-cited paragraph of the rule making notice has not yet been filed; thus the issue is not ripe for consideration (see discussion in part B. below).

If the issue whether a second reexamination does become ripe for consideration via a second proceeding, the Office would certainly query an *ambiguous or facially inaccurate* 37 CFR 1.915(b)(7) certification statement. A third party making such statement is a party appearing before the Office. Therefore, a third party requester is available to be asked by the Office to clarify or support a 37 CFR 1.915(b)(7) certification statement that is ambiguous or facially inaccurate. Presumably, the third party requester would be able to respond based on facts wholly within its knowledge and possession. The Office would be able to obtain information from the patent owner and the third party requester, and would have no need to obtain information from parties not before the Office by reason of the filing of the request for *inter partes* reexamination. Similarly, where the identification of the real party in interest required by 37 CFR 1.915(b)(8) is ambiguous or facially inaccurate, a third party requester who is before the Office can be queried by the Office, because the record is not clear at that point in time (i.e., the ambiguity causes an issue that is ripe for consideration). Such occurred in the present proceeding, and was addressed by the Office and then

requester.<sup>21</sup> The record in the present '227 *inter partes* reexamination proceeding reveals that third party requester clarified the record in the '227 reexamination proceeding with respect to its identification of the real party in interest, after being put on notice that the identification was facially ambiguous. Since the present record in the '227 reexamination proceeding is not ambiguous as to the identification of the real party in interest (and patent owner has provided no persuasive extrinsic evidence to establish ambiguity), there is no basis to proceed any further in this proceeding as to the matter.

Aside from the inherent ability of the Office to issue an Order to Show Cause directed to a party that is before the Office (which the Office did in this proceeding), patent owner does not point to any regulation that would provide a mechanism for conducting an investigation directed to determining whether parties not before the Office are in fact real parties in interest in an *inter partes* reexamination proceeding. 37 CFR 1.105 was promulgated pursuant to 35 U.S.C. §§ 131 and 132, statutes that relate to the examination of applications and (via incorporation by the reexamination statute) the conduct of reexamination proceedings as to patentability. The regulation was promulgated for the purpose of requiring submission of information material to patentability from persons having a duty under 37 CFR 1.56 to disclose information to the Office that is material to patentability.<sup>22</sup> The identification of the real party in interest has no relationship to the duty to disclose information that is material to patentability (which applies to an applicant for patent and to a patent owner in a reexamination proceeding).<sup>23</sup> With respect to obtaining information from a party who is alleged to be an undisclosed real party in interest in an *inter partes* reexamination proceeding, it is not apparent, how 37 CFR 1.105 could be applied to a party who is not before the Office in that proceeding.

Therefore, it appears that where a patent owner who is a party in an *inter partes* reexamination proceeding believes that an identification of the real party in interest is facially inaccurate, even though it is unambiguous, the courts are the appropriate venue from which the patent owner should seek relief to obtain evidence extrinsic to the record, for incorporation into the record. It is to be noted that there is precedent on the issue of "real party in interest" in the federal courts, on matters ranging from jurisdiction (*e.g.*, presence of diversity or amount of suit)<sup>24</sup> to actions in which the principle is applied to prevent multiple or conflicting lawsuits by persons such as assignees.<sup>25</sup> These examples of court proceedings resolving "real party in interest" issues demonstrate the reason why the Office cannot perform such a function here. Upon obtaining jurisdiction over the parties, courts may order discovery, taking of testimony with cross examination and use of other evidentiary tools, while enforcing compliance with its requirements via its subpoena power and power to impose sanctions. Accordingly, the courts are the forums best equipped to determine who is, and who is not, the "real party in interest" when there is a reason to doubt the third party requester's identification of a party or parties as being the real party in interest in an *inter partes* reexamination proceeding. Further, courts may provide relief, as appropriate, by enjoining the filing of a further *inter partes* reexamination request by the other parties in a civil action. Even if an *inter partes* reexamination request was filed by one

<sup>21</sup> Attention is invited to the "Order to Show Cause" dated February 22, 2008 and to "Decision Denying Petition" dated June 17, 2008 both of record in *inter partes* reexamination proceeding 95/000,166. Attention is also invited to the footnote 1, *supra*.

<sup>22</sup> 65 Fed. Reg. 54604, 54633, (Sept. 8, 2000.)

<sup>23</sup> See 37 CFR 1.933, which refers back to 37 CFR 1.555, which in turn, references 37 CFR 1.105. These regulations do not create a duty to disclose information material to patentability, (or any duty of disclosure), that attaches to a reexamination third party requester.

<sup>24</sup> *Varlotta Construction Corporation v. Carla Development Corporation*, 886 F. Supp 315 (E.D.N.Y. 1995)

<sup>25</sup> *First Hartford Corporation Pension Plan & Trust v. United States*, 194 F.3d 1279 (Fed. Cir. 1999)

of the other parties in the civil action who is barred from requesting *inter partes* reexamination by statutory estoppel, a court could always enjoin participation by that requester in the proceeding and essentially turn the proceeding into an *ex parte* reexamination proceeding, the filing of which does not require identification of "a real party in interest" (35 U.S.C §§ 301 and 302), and is not prohibited by statute or rule, even after an *inter partes* reexamination was filed by the same real party in interest.<sup>26</sup>

A patent owner concerned with the issue of misidentification of the real party in interest in a request for *inter partes* reexamination may immediately seek relief from the alleged erroneous identification of the "real party in interest" via the courts, which possess the tools to investigate and obtain information as to the relationship of the parties to ascertain the veracity of the identified "real party in interest." The present petition is silent as to why patent owner did not approach the appropriate District Court for relief (*e.g.*, an investigation into the matter and an appropriate order); even though this is the third petition on the matter and patent owner has been asked twice to address it, patent owner has remained silent on the matter. Given the emphasis that petitioner patent owner has placed on the importance of the "real party in interest" disclosure requirement, it would appear that patent owner could have immediately sought relief in the appropriate court regarding the identity of the real party in interest. The record does not show that patent owner has done so. Patent owner's argument that it is the Office, not a district court, "that administers the patent statute," is wholly unpersuasive. The Office may consider that it is "the sole agency that administers the patent statute,"<sup>27</sup> and the Office certainly conducts the *inter partes* proceeding; however, it is common knowledge that the federal courts (which are not an agency in the sense used in the *inter partes* reexamination rulemaking) routinely adjudicate matters arising under the patent statute. Further, patent owner should appreciate the difference between conducting a reexamination proceeding, which is the provenance of the Office, and enforcing an estoppel provision of Federal law as a matter of equitable relief. Patent owner has not provided any basis for believing that the district courts lack authority to act as described above.

As a final point in this section of the decision as to the Office lacking the authority to investigate:

The reexamination statute requires, *inter alia*, that a request for *inter partes* reexamination proceeding "shall ... include the identity of the real party in interest..."<sup>28</sup> The *inter partes* reexamination rules require that a request for *inter partes* reexamination include, *inter alia*, "[A] statement identifying the real party in interest to the extent necessary for a subsequent person filing an *inter partes* reexamination request to determine whether that person is a privy."<sup>29</sup> Requester has made it clear that Siliconware is the real party in interest, and that is an identification to a sufficient extent that "a subsequent person filing an *inter partes* reexamination request" can look into its interaction with the identified Siliconware to "determine whether that person is a privy" with the real party in interest that filed the present reexamination. Neither the *inter partes* reexamination statute nor the *inter partes* reexamination rules imposes a duty on the Office to investigate the accuracy of an unambiguous identification of the real party in interest in a third party requester's request for *inter partes* reexamination proceeding.

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<sup>26</sup> If the court makes a finding that the "real party in interest" was misstated, the Office can then take action, if appropriate, based upon the court's findings.

<sup>27</sup> 65 Fed. Reg. 76756, 76759 (Dec. 7, 2000), emphasis added.

<sup>28</sup> 35 U.S.C. § 311(b)(1).

<sup>29</sup> 37 CFR 1.915(b)(8).

In the present '227 *inter partes* reexamination proceeding, the real party in interest is unambiguously identified in the current record.<sup>30</sup> The identification of the real party in interest does not appear to facially inaccurate. The Office will refuse to accord a filing date to a request for *inter partes* reexamination that does not identify the real party in interest, or which provides an identification of the real party in interest that is ambiguous or facially inaccurate. If the Office accords a filing date to a request for *inter partes* reexamination, and later discovers an ambiguity or a facial inaccuracy in the identification of the real party in interest, the Office can, and will, require that a party appearing before it as third party requester in an *inter partes* reexamination proceeding clarify the ambiguity or facial inaccuracy. However, it does not follow that the Office is empowered to conduct an investigation into the identity of the real party in interest when the statement identifying the real in interest in the record of an *inter partes* reexamination proceeding is neither facially inaccurate nor ambiguous. The Office will not conduct an investigation into the accuracy of the identification of the real party interest in the '227 reexamination proceeding, because there is no legal reason to do so, even if the office's ability to do so could be shown (which it has not been, as discussed above).

B. The Office Has No Present Duty To Investigate The Identity Of The Real Party In Interest In The '227 Inter Partes Reexamination Proceeding

It is also to be noted that, in the present '227 reexamination proceeding, patent owner is requesting relief based upon an injury that has not yet occurred, and may never occur, even according to patent owner's view of the situation. Patent owner does not allege that the named real party in interest is itself estopped from filing and participating in the '227 reexamination proceeding. Rather, patent owner's concern must be that patent owner might be harassed by the filing of a subsequent request for *inter partes* reexamination of the '419 patent by a party that should have been identified as a real party in interest in the '227 reexamination proceeding, but was not so identified. Such a hypothetical party, as a real party in interest in the '227 reexamination proceeding, would be subject to a statutory estoppel that could preclude (if the statutory provisions are satisfied) its filing of another *inter partes* reexamination proceeding, or from maintaining the '227 reexamination proceeding if such a party "loses" as a defendant in any '419 patent litigation. While a patent owner is statutorily entitled to be protected from harassment by the filing of a subsequent request for *inter partes* reexamination of the '419 patent by a party who is estopped from filing such a request, the record simply does not show that such a circumstance presently exists as to the '227 reexamination proceeding. No additional requests for *inter partes* reexamination of the '419 patent have been filed by any of Siliconware's co-defendants (or anyone else), so clearly there is presently no cause for concern that a misidentification of the real party in interest has permitted a party subject to statutory estoppel to file an additional request for *inter partes* reexamination of the '419 patent. Accordingly, granting need to consider addressing the relief requested by patent owner in the present '227 *inter partes* reexamination proceeding has not arrived, since patent owner cannot have been injured by the filing of another request for *inter partes* reexamination for the '419 patent that would be barred by statutory estoppel.

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<sup>30</sup> It is to be noted that although the identification of the real party in interest was ambiguous in the various papers comprising the request for reexamination filed by the third party requester in the '227 *inter partes* reexamination proceeding, such ambiguity has been resolved. The identification of the real party in interest in the present opposition paper would applies to this proceeding *nunc pro tunc*, and will allow any subsequent party to draw the necessary conclusions for purposes of 37 CFR 1.907 and statutory estoppel in *inter partes* reexamination.



## V. Synopsis

Rather than having presented clear and undisputed evidence establishing that Siliconware is not the only real party in interest in the '227 reexamination proceeding, the present renewed petition is based on (a) equal measures of evidence that are directly contradicted by evidence of at least equal caliber and weight, and (b) argument supported only by supposition and conjecture on patent owner's part. Accordingly, patent owner has not demonstrated a persuasive basis for the requested relief of vacatur of the filing date of the '227 reexamination proceeding. Therefore, such relief is denied, and this decision is being designated as a within the meaning of 5 U.S.C. § 704.

## ADDITIONAL DISCUSSION

As this decision is designated as a final agency action under 5 U.S.C. § 704, and as two previous decisions on this issue have also been so designated, patent owner is advised that to the extent that patent owner disagrees with the disposition of the issues in this decision, those issues are now at the stage of judicial review - should patent owner desire any further review of those issues. Any further patent owner petition paper directed to the issues decided herein will not be considered unless accompanied by a strong showing of additional facts warranting further review by the Office, together with a certification by patent owner that these additional facts were not known, and could not have been known, at the time that the present patent owner petition was filed. The filing by patent owner of a petition paper directed the issues decided herein that does not include such showing and certification may be construed as being a paper interposed for purposes of delay.

## CONCLUSION

1. The June 6, 2008 patent owner renewed petition is denied.
2. Jurisdiction over this proceeding is being returned to the Central Reexamination Unit for such action as may be appropriate.
3. Telephone inquiries related to this decision should be directed to the undersigned, at (571) 272-7710, or, in his absence, to Stephen Marcus, Senior Legal Advisor, at (571) 272-7743.



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

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