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Date:

MAILED

DEC 12 2013

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95000659
PATENT NO. : 6629163
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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,659	02/13/2012	6629163	159291-0025(163)	6219

7590 12/12/2013
HEIM, PAYNE & CHORUSH, LLP
600 TRAVIS STREET
SUITE 6710
HOUSTON, TX 77002

EXAMINER

AHMED, SALMAN

ART UNIT PAPER NUMBER

3992

MAIL DATE DELIVERY MODE

12/12/2013

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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(For Patent Owner)

MAILED

DEC 12 2013

CENTRAL REEXAMINATION UNIT

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(For Third Party Requester)

In re Balassanian
Reexamination Proceeding
Control No. 95/000,659
Request Deposited: February 13, 2012
For: U.S. Patent No. 6,629,163

: *SUA SPONTE*
: DECISION
: VACATING *INTER PARTES*
: REEXAMINATION
: PROCEEDING

This decision constitutes notice that the above-captioned *inter partes* reexamination proceeding is hereby **vacated**, because every claim (e.g., claims 1, 15, and 35) for which reexamination was requested has been held invalid by a final court decision. For this reason, the **proceeding as a whole is hereby vacated**.

Art Unit: 3992

REVIEW OF FACTS

1. U.S. Patent No. 6,629,163 (hereinafter, the '163 patent) was issued to Balassanian on September 30, 2003.
2. On February 13, 2012, a third party deposited a request for *inter partes* reexamination of claims 1, 15, and 35 of the '163 patent, made pursuant to 37 CFR 1.915. The deposited reexamination request was assigned Control No. 95/000,659 (hereinafter, the '659 proceeding).
3. On February 24, 2012, a "Notice of *Inter Partes* Reexamination Request Filing Date" was mailed for the '659 proceeding. The notice assigned the filing date of February 13, 2012 to the request for reexamination.
4. On April 3, 2012, an order granting reexamination and a non-final Office action were mailed in the '659 proceeding.
5. On June 4, 2012, the patent owner filed a response to the Office action. No claims amendments were filed.
6. On July 9, 2012, the requester filed comments. The comments were not compliant. Corrected comments were filed on August 30, 2012.
7. Prosecution continued and on August 16, 2013, an Office action, which rejected claims 1, 15, and 35, was mailed.
8. On October 2, 2013, the patent owner notified the Office that claims 1, 15, and 35 of the '163 patent were determined to be invalid by a final decision in the district court in the Northern District of California. See *Implicit Networks Inc. v. F5 Networks Inc./ Implicit Networks Inc. v. Juniper Networks Inc.*, 3:10 CV 3365/4234, "Order Granting Defendant's Motions for Summary Judgment" (dated March 13, 2013) (hereinafter "Summary Judgment Order"). The patent owner also notified the Office that the appeals to the U.S. Court of Appeals for the Federal Circuit were dismissed.

DECISION

This is a *sua sponte* decision that the '659 reexamination is vacated in accordance with the policies set forth in MPEP 2686.

MPEP 2686, IV explains, in part:

"Upon the issuance of a final holding of invalidity or unenforceability, the claims held invalid or unenforceable will be withdrawn from consideration in the reexamination. The reexamination will continue as to any remaining claims. If all of the claims being examined are finally held invalid or unenforceable, the **reexamination will be vacated by the CRU Director ... and the reexamination prosecution will be terminated.**" (Emphasis added in bold).

Art Unit: 3992

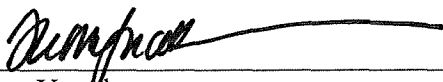
As pointed out above, claims 1, 15, and 35 of the '163 patent have been held invalid by a Summary Judgment Order by the U.S. District Court for the Northern District of California. See the 30-page October 2, 2013 paper. Although the Summary Judgment Order was appealed to the U.S. Court of Appeals for the Federal Circuit, the appeal was dismissed on June 17, 2013 (see the Order in appeal nos. 2013-1328 & 2013-1441) or June 20, 2013 (see the Order in appeal no. 2013-1327). See also two-page documents submitted October 2, 2013. As a result of the dismissal of the appeals, claims 1, 15, and 35 of the '163 patent, which are the only claims for which reexamination was ordered, have been held invalid by a final court decision.

Accordingly, the filing date that was granted for the '659 proceeding is hereby vacated. Furthermore, **any papers** (e.g., the order, Office actions, responses, or comments) of the record previously issued by the Office for the proceeding, by the patent owner or by the requester, **and the proceeding, as a whole, are hereby vacated**. Prosecution in this proceeding is terminated.

The requester's papers, the patent owner's papers, and previously issued Office communications were scanned into the electronic Image File Wrapper (IFW) to create a record. Since the proceeding is vacated, all papers and previously issued Office communications will be marked "closed" and "non-public," and will not constitute part of the public record. The present decision will, however, remain open to the public, to provide a record of the action being taken.

CONCLUSION

1. The filing date assigned to the February 13, 2012 request papers, any papers of the record as a result of the request, and *inter partes* reexamination proceeding Control No. 95/000,659, as a whole, are hereby vacated.
2. The papers of the IFW record will be marked "closed" and "non-public," and will not constitute part of the public record. The present decision will, however, remain open to the public.
3. The vacated *inter partes* reexamination proceeding is hereby referred to the Central Reexamination Unit, where the proceeding will be processed to mark its file history papers "closed" and "non-public."
5. Telephone inquiries related to this decision should be directed to Daniel Ryman, Supervisory Patent Examiner, at (571) 272-3152 or in his absence to the undersigned at (571) 272-0700.



Irem Yucel
Director, Central Reexamination Unit