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JAN 29 2009

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(For Third Party Requester) CENTRAL REEXAMINATION UNIT

<i>In re Moon et al.</i>	:	
<i>Inter Partes</i> Reexamination Proceeding	:	DECISION
Control No.: 95/000,278	:	GRANTING
Request Deposited: July 12, 2007	:	PETITION
For: U.S. Patent No. 7,065,417	:	

This is a decision on the January 9, 2009, petition entitled "JOINT PETITION UNDER 37 C.F.R. §§ 1.182 AND/OR 1.183 TO RETURN ERRONEOUS IDS WITHOUT ENTRY INTO THE RECORD AND RELEASE TO THE THIRD PARTY REQUESTER" (the petition), requesting non-entry and return of highly confidential, protected documents, which were inadvertently submitted by patent owner to the Office in an information disclosure statement (IDS) on December 31, 2008.

Because the rules do not specifically provide for the non-entry and return of the inadvertently submitted documents, the petition will be treated as a petition under 37 CFR 1.182. The petition is before the Office of Patent Legal Administration for consideration.

The petition fee of \$400.00 pursuant to 37 CFR 1.17(f) for the petition under 37 CFR 1.182 was charged to third party requester's credit card, as authorized on page three of the petition.

REVIEW OF RELEVANT FACTS

1. U.S. Patent No. 7,065,417 (the '417 patent) issued to Moon *et al.* on June 20, 2006.
2. On July 12, 2007, a third party requester filed a request for *inter partes* reexamination, which proceeding was assigned Control No. 95/000,278 (the '278 proceeding).
3. On September 28, 2007, the Office mailed an Order granting the request for *inter partes* reexamination.

Control No. 95/000,278

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4. The '417 patent is the subject of litigation styled *Texas MP3 Technologies, Ltd. v. Samsung Electronics Co., Ltd.*, Civil Action No. 2:07-CV-052-TJW (E.D. Tex.) (hereinafter "Texas MP3 Technologies-Samsung litigation.")
5. On July 23, 2008, a "PROTECTIVE ORDER REGARDING THE DISCLOSURE AND USE OF DISCOVERY MATERIALS" (the protective order) was issued in the Texas MP3 Technologies-Samsung litigation.
6. On December 31, 2008, patent owner submitted for the '278 proceeding an IDS containing documents clearly marked highly confidential and subject to the protective order in the Texas MP3 Technologies-Samsung litigation.
7. On January 9, 2009, patent owner and third party requester filed the instant petition entitled "JOINT PETITION UNDER 37 C.F.R. §§ 1.182 AND/OR 1.183 TO RETURN ERRONEOUS IDS WITHOUT ENTRY INTO THE RECORD AND RELEASE TO THE THIRD PARTY REQUESTER," requesting non-entry and return/release to third party requester of the protected materials submitted in the December 31, 2008 IDS.

DECISION

In the petition, patent owner and third party requester (the parties) assert that patent owner inadvertently submitted to the Office the December 31, 2008 IDS, which includes documents clearly marked highly confidential,¹ such documents having been submitted contrary to the protective order issued by the District Court for the Eastern District of Texas in the Texas MP3 Technologies-Samsung litigation. The parties further assert that public disclosure of these documents would result in irreparable harm to the third party requester.² Accordingly, the parties have agreed to file a joint petition requesting that these documents not be entered into the record of the '278 proceeding to avoid public disclosure thereof. The parties have further agreed to have third party requester's courier retrieve the protected materials from the Office.³

A review of the record of the '278 proceeding reveals that the December 31, 2008 IDS and accompanying protected documents have not been scanned into the image file wrapper (IFW) of the '278 proceeding. In view of the irreparable harm to third party requester that would be caused by public disclosure of these protected documents, and in view of the facts and circumstances pertaining to the instant petition for non-entry of the December 31, 2008 IDS and accompanying documents into the IFW of the '278 proceeding, the petition is granted, and third party requester is required to retrieve the December 31, 2008 IDS and accompanying documents from the Office.

¹ See petition at page 2 (indicating the documents are marked "Highly Confidential – Outside Attorney's Eyes Only").

² See petition at page 1.

³ See petition at page 2.

ADDITIONAL DISCUSSION

This decision does not relieve patent owner of the duty to disclose to the Office information patent owner is aware of which is material to patentability pursuant to 37 CFR 1.555, regardless of whether the "material" information can be classified as a trade secret, or as proprietary material, or whether it is subject to a protective order.⁴ MPEP § 724 sets forth procedures designed to enable the Office to ensure as complete a patent file wrapper as possible insofar as "material" information is concerned, while preventing unnecessary public disclosure of trade secrets, proprietary material, and protective order material. Also, such information can be redacted to the extent deemed appropriate to satisfy the duty to disclose.

CONCLUSION

1. Patent owner's and third party requester's joint petition under 37 CFR 1.182 is granted. The December 31, 2008 IDS and accompanying documents will not be entered into the IFW of the '278 proceeding.
2. Third party requester is required to retrieve the December 31, 2008 IDS and accompanying documents from the Office by contacting Kenneth M. Schor, Senior Legal Advisor, at 571-272-7710, or in his absence, Nicole Dretar, Legal Advisor, at 571-272-7717, to arrange a date and time for pick-up by third party requester's courier.
3. Jurisdiction over the '278 proceeding is being returned to the Central Reexamination Unit (CRU).
4. Any questions concerning this communication should be directed to Kenneth M. Schor, Senior Legal Advisor, at 571-272-7710.



Robert A. Clarke
Director
Office of Patent Legal Administration

01-27-09

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⁴ See MPEP § 724



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
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SUITE 1000 WEST TOWER
WASHINGTON, DC 20005

Date:
MAILED

JAN 29 2009

CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95000278
PATENT NO. : 7065417
TECHNOLOGY CENTER : 3999
ART UNIT : 3900

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)



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,278	07/12/2007	7065417	026115.0101 XIUS	3408

32376 7590 01/29/2009

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EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED: 01/29/2009

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