Banner & Witcoff clients Skype Technologies and RTX Telecom win inter partes reexaminations

March 11, 2014

On March 3, 2014, the U.S. Patent and Trademark Office (Office) issued a final decision in two inter partes reexaminations initiated by firm clients Skype Technologies S.A. and RTX Telecom A/S. The decisions, which were issued by the Office's Patent Trial and Appeal Board, reaffirmed Skype Technologies and RTX Telecom's positions asserted in its briefs and at oral argument that each and every claim of U.S. Pat. Nos. 7,139,371 & 7,016,481 is invalid.

Skype Technologies and RTX Telecom requested reexaminations of the patents, which are directed towards a VoIP telephony device, after the patent owner filed a federal lawsuit alleging infringement. During the reexamination, Skype and RTX successfully demonstrated the invalidity of the claims based upon prior invention by others. Through briefing and oral arguments, Skype and RTX also demonstrated that the claims should not be entitled to an earlier filing date and that certain claims failed to comply with the written description requirement and did not distinctly claim the subject matter that was regarded as the invention.

Skype Technologies and RTX Telecom were represented in the federal litigation by Timothy C. Meece, Jason S. Shull and Shawn P. Gorman of Banner & Witcoff's Chicago office. Shawn P. Gorman and Jason S. Shull, along with Bradley C. Wright of Banner & Witcoff's D.C. office, also represented Skype Technologies and RTX Telecom in the inter partes reexamination as well as the appeal of the reexamination to the Patent Trial and Appeal Board.

Posted: March 11, 2014