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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/010,421 | 02/24/2009 | 6,701,365 | 2655-0187 | 6411 |

42624 7590 05/11/2010

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| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |

DATE MAILED: 05/11/2010

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

PTO-90C (Rev. 10/03)

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CENTRAL REEXAMINATION UNIT

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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# *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/010,421*.

PATENT NO. *6,701,365*.

ART UNIT *3992*.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

| Notice of Intent to Issue Ex Parte Reexamination Certificate | Control No. | Patent Under Reexamination | |
|---|---|---|---|
| | 90/010,421 | 6,701,365 | |
| | Examiner | Art Unit | |
| | ALEXANDER J. KOSOWSKI | 3992 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

1. ☒ Prosecution on the merits is (or remains) closed in this *ex parte* reexamination proceeding. This proceeding is subject to reopening at the initiative of the Office or upon petition. *Cf.* 37 CFR 1.313(a). A Certificate will be issued in view of
   - (a) ☒ Patent owner's communication(s) filed: *16 November 2009*.
   - (b) ☐ Patent owner's late response filed: _____.
   - (c) ☐ Patent owner's failure to file an appropriate response to the Office action mailed: _____.
   - (d) ☐ Patent owner's failure to timely file an Appeal Brief (37 CFR 41.31).
   - (e) ☐ Other: _____.

   Status of *Ex Parte* Reexamination:
   - (f) Change in the Specification: ☐ Yes ☒ No
   - (g) Change in the Drawing(s): ☐ Yes ☒ No
   - (h) Status of the Claim(s):
     - (1) Patent claim(s) confirmed: *1-3*.
     - (2) Patent claim(s) amended (including dependent on amended claim(s)): _____
     - (3) Patent claim(s) cancelled: _____.
     - (4) Newly presented claim(s) patentable: _____.
     - (5) Newly presented cancelled claims: _____.

2. ☒ Note the attached statement of reasons for patentability and/or confirmation. Any comments considered necessary by patent owner regarding reasons for patentability and/or confirmation must be submitted promptly to avoid processing delays. Such submission(s) should be labeled: "Comments On Statement of Reasons for Patentability and/or Confirmation."

3. ☐ Note attached NOTICE OF REFERENCES CITED (PTO-892).

4. ☒ Note attached LIST OF REFERENCES CITED (PTO/SB/08).

5. ☐ The drawing correction request filed on _____ is: ☐ approved ☐ disapproved.

6. ☐ Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
   a)☐ All b)☐ Some* c)☐ None of the certified copies have
   - ☐ been received.
   - ☐ not been received.
   - ☐ been filed in Application No. _____.
   - ☐ been filed in reexamination Control No. _____.
   - ☐ been received by the International Bureau in PCT Application No. _____.

   * Certified copies not received: _____.

7. ☐ Note attached Examiner's Amendment.

8. ☐ Note attached Interview Summary (PTO-474).

9. ☐ Other: _____.

| | | |
|---|---|---|
| | | |

cc: Requester (if third party requester)

## DETAILED ACTION

1) This Office action addresses claims 1-3 of United States Patent Number 6,701,365 (Hutton et al), for which it has been determined in the Order Granting Ex Parte Reexamination (hereafter the "Order") mailed 3/13/09 that a substantial new question of patentability was raised in the Request for *Ex Parte* reexamination filed on 2/24/09 (hereafter the "Request"). This action is in response to the request for reconsideration filed 11/16/09. Claims 1-3 are now confirmed.

### *IDS*

2) With regard to the IDS's filed 12/11/09, 12/16/09, 1/26/10, 2/24/10, 3/5/10, 5/6/10; 8/11/09, 8/12/09 esc

Where the IDS citations are submitted but not described, the examiner is only responsible for cursorily reviewing the references. The initials of the examiner on the PTO-1449 indicate only that degree of review unless the reference is either applied against the claims, or discussed by the examiner as pertinent art of interest, in a subsequent office action. See Guidelines for Reexamination of Cases in View of In re Portola Packaging, Inc., 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997), 64 FR at 15347, 1223 Off. Gaz. Pat. Office at 125 (response to comment 6).

Consideration by the examiner of the information submitted in an IDS means that the examiner will consider the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner placed adjacent to the citations on the PTO-1449 or PTO/SB/08A and 08B or its equivalent mean that the information has been considered by the examiner to the extent noted above.

Regarding IDS submissions MPEP 2256 recites the following: "Where patents, publications, and other such items of information are submitted by a party (patent owner or requester) in compliance with the requirements of the rules, the requisite degree of consideration to be given to such information will be normally limited by the degree to which the party filing the information citation has explained the content and relevance of the information."

Accordingly, the IDS submissions have been considered by the Examiner only with the scope required by MPEP 2256, unless otherwise noted.

In addition, that which are not either prior art patents or prior art printed publications have been crossed out so as not to appear reprinted on the front page of the patent.

***General Response***

7) In response to the request for reconsideration filed 11/16/09, the following aspects of the current prosecution will be addressed as noted below:

a) VocalChat are not printed publications.

b) The 1.132 Declaration

c) Objective evidence of non-obviousness

d) Confirmed claims

a) The request for reconsideration submitted 11/16/09 includes arguments that the VocalChat references are not printed publications. The Patent Owner (PO) cites exhibit K of the Request (the declaration of Alon Cohen) as the only evidence provided by PO that the VocalChat references are printed publications. Examiner notes that the Alon Cohen declaration fails to comply with 37 C.F.R. 1.68, including not setting forth in the body of the declaration that all statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true. Therefore, PO's arguments questioning the declaration as well as whether printed publication status has been established as set forth under statute are found persuasive. Examiner therefore withdraws all rejections utilizing the VocalChat references.

b) Examiner notes that all evidence presented has been considered in its entirety, including both PO's arguments, including secondary considerations, as well as the 1.132 Declaration submitted by expert Ketan Mayer-Patel.

c) Examiner notes that PO's arguments regarding objective evidence of non-obviousness, including commercial success and failure of others have been considered, however no nexus has been provided between the claimed invention and the submitted evidence as required by at least MPEP 716.03. Therefore, this evidence is not found persuasive.

d) In light of PO's arguments filed 11/16/09, as well as the declaration of expert Mayer-Patel, examiner withdraws the rejections of claims 1-3. Examiner finds the presented arguments to be persuasive. Claims 1-3 are thereby confirmed as explained below.

With regard to the NetBios rejection, examiner agrees with declarant Mayer-Patel that bringing dynamic addressing into a NetBIOS type system would create a new set of obstacles that would need to be solved that are not obvious in view of the combination of references.

With regard to the rejection under Etherphone, examiner agrees with declarant Mayer-Patel that the Etherphone system would encounter many problems when adapted to a dynamic addressing requirement, and the combination of references would not render obvious a solution to these problems.

A reasons for confirmation for claims 1-3 is below.

**STATEMENT OF REASONS FOR PATENTABILITY AND/OR CONFIRMATION**

2) Claims 1-3 are confirmed.

The following is an examiner's statement of reasons for confirmation of the claims found patentable in this reexamination proceeding:

Referring to claim 1, the claim is confirmed over the prior art that was explained in the request and determined to raise a substantial new question of patentability in the order granting reexamination and over the prior art that was applied and discussed by the examiner in the present reexamination proceeding because that prior art does not explicitly teach a computer program product for use with a server operatively coupled over a computer network to a plurality of processes comprising program code configured to receive the current network protocol address of one of the processes coupled to the network, the network protocol address being received by said one of the processes from an Internet access server, in combination with the remaining elements or features of the claimed invention.

Referring to claim 2, the claim is confirmed over the prior art that was explained in the request and determined to raise a substantial new question of patentability in the order granting reexamination and over the prior art that was applied and discussed by the examiner in the present reexamination proceeding because that prior art does not explicitly teach a computer data signal embodied in a carrier wave comprising program code configured to receive a current network protocol address of a process coupled to a computer network, the network protocol address being received by the process from an Internet access server, in combination with the remaining elements or features of the claimed invention.

Referring to claim 3, the claim is confirmed over the prior art that was explained in the request and determined to raise a substantial new question of patentability in the order granting reexamination and over the prior art that was applied and discussed by the examiner in the present reexamination proceeding because that prior art does not explicitly teach a method in a computer system operatively coupled over a computer network to a plurality of processes

comprising receiving the current network protocol address of a process coupled to the network, the network protocol address being received by the process from an Internet access server, in combination with the remaining elements or features of the claimed invention.

***Conclusion***

All correspondence relating to this ex parte reexamination proceeding should be directed as follows:

By U.S. Postal Service Mail to:

Mail Stop Ex Parte Reexam
ATTN: Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to:

(571) 273-9900
Central Reexamination Unit

By hand to:

Customer Service Window
Randolph Building
401 Dulany St.
Alexandria, VA 22314

By EFS-Web:

Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at

https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html

EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

Any inquiry concerning this communication or earlier communications from the Reexamination Legal Advisor or Examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

/Alexander J Kosowski/

Primary Examiner, Art Unit 3992

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ESK