UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,424	02/24/2009	6131121	2655-0186	6648

42624 7590 05/17/2010

DAVIDSON BERQUIST JACKSON & GOWDEY LLP
4300 WILSON BLVD., 7TH FLOOR
ARLINGTON, VA 22203

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 05/17/2010

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

PTO-90C (Rev. 10/03)

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

DO NOT USE IN PALM PRINTER

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Blakely Sokoloff Taylor & Zafman LLP

1279 Oakmead Parkway

Sunnyvale, CA 94085-4040

MAILED

MAY 17 2010

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/010,424*.

PATENT NO. *6131121*.

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)).

PTOL-465 (Rev.07-04)

Office Action in Ex Parte Reexamination	Control No. 90/010,424	Patent Under Reexamination 6131121	
	Examiner ALEXANDER J. KOSOWSKI	Art Unit 3992	

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

a☒ Responsive to the communication(s) filed on *25 November 2009* . b☒ This action is made FINAL.
c☐ A statement under 37 CFR 1.530 has not been received from the patent owner.

A shortened statutory period for response to this action is set to expire *2* month(s) from the mailing date of this letter. Failure to respond within the period for response will result in termination of the proceeding and issuance of an *ex parte* reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).** If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☒ Information Disclosure Statement, PTO/SB/08.
3. ☐ Interview Summary, PTO-474.
4. ☐ ____

Part II SUMMARY OF ACTION

1a. ☒ Claims *6-14* are subject to reexamination.
1b. ☐ Claims *1-5* are not subject to reexamination.
2. ☐ Claims ___have been canceled in the present reexamination proceeding.
3. ☒ Claims *12-14* are patentable and/or confirmed.
4. ☒ Claims *6-11* are rejected.
5. ☐ Claims ___a___ re objected to.
6. ☐ The drawings, filed on ___are acceptable.
7. ☐ The proposed drawing correction, filed on ___has been (7a) ☐ approved (7b)☐ disapproved.
8. ☐ 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
   1☐ been received.
   2☐ not been received.
   3☐ been filed in Application No. ____
   4☐ been filed in reexamination Control No. ____
   5☐ been received by the International Bureau in PCT application No. ____
   * See the attached detailed Office action for a list of the certified copies not received.
9. ☐ Since the proceeding appears to be in condition for issuance of an *ex parte* reexamination certificate except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte* Quayle, 1935 C.D. 11, 453 O.G. 213.
10. ☐ Other: ____

cc: Requester (if third party requester)

DETAILED ACTION

1) This Office action addresses claims 6-14 of United States Patent Number 6,131,121 (Mattaway et al), for which it has been determined in the Order Granting Ex Parte Reexamination (hereafter the "Order") mailed 3/11/09 that a substantial new question of patentability was raised in the Request for *Ex Parte* reexamination filed on 2/24/09 (hereafter the "Request"). Claims 1-5 are not subject to reexamination. This is a final office action in response to the amendment filed 11/25/09. The rejection of claims 6-11 are maintained below. Claims 12-14 are confirmed below.

IDS

2) With regard to the IDS's filed 12/16/09, 12/21/09, 1/26/10, 2/24/10, 3/5/10, 5/6/10:

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.

Claim Rejection Paragraphs

3) ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Issue 1

4) Claims 6-11 are rejected under 35 U.S.C. 102(b) as being unpatentable by NetBIOS (See claim mapping in Request pages 28-49, incorporated by reference).

Issue 2

5) Claims 6-11 are rejected under 35 U.S.C. 102(b) as being unpatentable by Etherphone (See claim mapping in Request pages 62-80, incorporated by reference).

Response to Arguments

6) In response to the amendment filed 11/25/09, some rejections are sustained as noted above, and others have been withdrawn. 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) Withdrawn rejections

e) Maintained rejections

a) The amendment submitted 11/25/09 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 and amendments, 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 11/25/09, as well as the declaration of expert Mayer-Patel, examiner withdraws the rejections of claims 12-14. Examiner finds the presented arguments to be persuasive.

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 notes that a similar argument applies to Etherphone as to NetBIOS, namely that combining the system with dynamic addressing would create new, non obvious obstacles to overcome.

A reasons for confirmation for the claims discussed above will follow in a subsequent office action.

e) The rejection of claims 6-11, as amended, are maintained in view of NetBIOS and Etherphone. Examiner notes that although claims 6-8 have been amended, the amendments simply move existing claim limitations to a slightly different position in the claims. This does not affect the claim interpretation, and therefore the cited claim mappings in the rejection above still apply.

With regard to the rejection of claims 6-11 under NetBIOS, maintained above:

Examiner first notes that claims 6-11 do not require any dynamic addressing limitations, unlike claims 12-14. Claim 6 recites, for example "forward to the server process a network protocol address...following connection of the first process to the computer network". This claim language implies that the computer may already have an IP address before connecting to

the server. Examiner notes, for example, that claim 12 requires *receiving* a network protocol address "following connection to a computer network". Examiner notes that the original rejection was meant to be a rejection under 35 U.S.C. 102(b), despite PO attempting to argue a rejection under 35 U.S.C. 103(a) which was not made. Therefore, any arguments directed towards a combination with RFC 1531 do not apply to claims 6-11.

PO argues that NetBIOS does not teach "program code configured to query the address server as to whether the second process is connected to the computer network". PO argues that having an "active name" is not synonymous with "being connected to the computer network", and that an "active name" simply refers to "a name that has been registered and that has not yet been de-registered". Examiner first notes that the claims recite "whether the second process is connected", and under a broadest reasonable interpretation, this limitation could simply mean that a user is registered with the system. In addition, examiner notes that PO's specification at col. 5 lines 39-44 teaches that the on-line status information may not always be current, and may be updated, for example, only every 24 hours based on operator configuration. Assuming a user being "connected" is comparable to that user being "on-line", then the database of NetBIOS which contains active name information, reads on the claims, whether or not the user data is current.

PO also argues that NetBIOS does not teach "that an acquired IP address can be reasonably relied upon by a requesting end-node to confirm that an end-node associated with a sought name is, in fact, 'connected to the computer network'". However, examiner notes that the claims only require connecting to a "process", not necessarily to a particular name.

With regard to the rejection of claims 6-11 under Etherphone, maintained above:

PO argues that no citation has been made regarding a query being sent to an address server. Examiner notes that given a broadest reasonable interpretation, an address server is merely a server that can hold a database of addresses. The term does not specifically require the server to perform DHCP functionality. Zelleweger1, page 3, clearly teaches the use of remote procedure calls to a server for establishing connections between two parties, which reads on the claimed limitation.

PO also argues that Figure 3 of Zelleweger1 "does not show that the cited database includes the claimed "network protocol address". In response, examiner notes that Figure 3 references a user interface aspect of Etherphone. This is separate from the hardware workings of the system. Swinehart1, page 4, clearly teaches that the "voice control server manages voice switching by sending to each Etherphone or service the network addresses of the other participants". Therefore, the database contains the required network protocol addresses.

Therefore, the current arguments regarding claims 6-11 are not persuasive, and the rejections above are maintained.

Conclusion

THIS ACTION IS MADE FINAL.

Extensions of time under 37 CFR 1.136(a) do not apply in reexamination proceedings. The provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Further, in 35 U.S.C. 305 and in 37 CFR 1.550(a), it is required that reexamination proceedings "will be conducted with special dispatch within the Office."

Extensions of time in reexamination proceedings are provided for in 37 CFR 1.550(c). A request for extension of time must be filed on or before the day on which a response to this action is due, and it must be accompanied by the petition fee set forth in 37 CFR 1.17(g). The mere filing of a request will not effect any extension of time. An extension of time will be granted only for sufficient cause, and for a reasonable time specified.

The filing of a timely first response to this final rejection will be construed as including a request to extend the shortened statutory period for an additional month, which will be granted even if previous extensions have been granted. In no event however, will the statutory period for response expire later than SIX MONTHS from the mailing date of the final action. See MPEP § 2265.

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