

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION OF:

Net2Phone, Inc. (Patent No. 6,131,121)

Control No.: 90/010,424

Issue Date: October 10, 2000

Title: **POINT-TO-POINT COMPUTER
NETWORK COMMUNICATION UTILITY
DYNAMICALLY ASSIGNED NETWORK
PROTOCOL ADDRESSES**

Attorney Docket: 2655-0186

Group Art Unit: 3992

Examiner: KOSOWSKI, Alexander

Date: July 19, 2010

Confirmation No.: 6648

AMENDMENT AFTER FINAL REJECTION IN A RE-EXAMINATION

Hon. Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated May 17, 2010, the Assignee hereby requests the automatic one-month extension of time proscribed in MPEP 2265 for "a first timely response to an Office Action" after a final rejection in a re-examination and submits:

Amendments beginning on page 2 of this paper; and

Remarks/Arguments beginning on page 4 of this paper.

Re-Examination of Patent No. 6,131,121
Control No.: 90/010,424
Filed: February 24, 2009
Reply to Office Action of May 17, 2010

AMENDMENTS TO THE CLAIMS

Please amend the claims undergoing re-examination as follows:

6. (Twice Amended) A computer program product for use with a computer system capable of executing a first process and connecting to other processes and a server process over a computer network, the computer program product comprising a computer usable medium having computer readable code means embodied in the medium comprising:-

A. program code configured to, following connection of the first process to the computer network, forward to the server process a dynamically assigned network protocol address at which the first process is connected to the computer network;

B. program code configured to query the address server as to whether the second process is connected to the computer network;

C. program code configured to receive a dynamically assigned network protocol address of the second process from the address server, when the second process is connected to the computer network; and

D. program code configured to respond to the network protocol address of the second process, establish a point-to-point communication link with the second process over the computer network.

7. (Twice Amended) A computer data signal embodied in a carrier wave comprising:

A. program code configured to, following connection of a first process to a computer network, forward to a server process a dynamically assigned network protocol address at which the first process is connected to the computer network;

B. program code configured to query the server process as to whether a second process is connected to the computer network;

Re-Examination of Patent No. 6,131,121
Control No.: 90/010,424
Filed: February 24, 2009
Reply to Office Action of May 17, 2010

C. program code configured to receive a dynamically assigned network protocol address of the second process from the server process, when the second process is connected to the computer network; and

D. program code, responsive to the network protocol address of the second process, and configured to establish a point-to-point communication connection with the second process over the computer network.

8. (Twice Amended) An apparatus for use with a computer system, the computer system executing a first process operatively coupled over a computer network to a second process and a directory database server process, the apparatus comprising:

A. program logic configured to, following connection of the first process to the computer network forward to the address server a dynamically assigned network[,] protocol address at which the first process is connected to the computer network;

B. program logic configured to query the address server as to whether the second process is connected to the computer network;

C. program logic configured to receive a dynamically assigned network protocol address of the second process from the address server, when the second process is connected to the computer network; and

D. program logic configured to, in response to the network protocol address of the second process, establish a point-to-point communication link with the second process over the computer network.

Re-Examination of Patent No. 6,131,121
Control No.: 90/010,424
Filed: February 24, 2009
Reply to Office Action of May 17, 2010

REMARKS/ARGUMENTS

Favorable reconsideration of the claims currently undergoing re-examination, in view of the present amendment and in light of the following discussion, is respectfully requested.

STATUS OF THE CLAIMS AND SUPPORT FOR CHANGES TO THE CLAIMS

Claims 6-14 are pending and the subject of this re-examination; claims 1-5 are not subject to re-examination. Claims 6-8 have been amended herewith to explicitly recite what was already inherent -- that the addresses are "dynamically assigned." The claim amendments also remove the previous amendments in light of the fact that the Office Action has provided no weight to the previous changes. Specifically, the Office Action states "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...." No claims have been added or canceled herewith.

The changes to claims 6-8 are supported by claims 6-8 themselves and by col. 6, lines 53-59, which states "When either of processing units 12, 22 logs on to the Internet via a dial-up connection, the respective unit is provided a dynamically allocated IP address by an Internet service provider." Thus, no new matter has been added.

It is respectfully requested that the amendments herein be entered given that the claim changes place claims 6-11 "in better form for consideration on appeal" as specified in 37 C.F.R. 1.116(b)(2) in light of the remarks on dynamic addressing in the Office Action in section 6d. Moreover, the claim changes do not require further consideration and/or search. In fact, the addition of "dynamically assigned" to the amended claims is consistent with the remarks in the previous response which stated "The changes are intended to make more explicit what is believed to be understood already -- that those claims refer to dynamic addressing." The removal of the previous amendments also does not require further consideration and/or search in

Re-Examination of Patent No. 6,131,121
Control No.: 90/010,424
Filed: February 24, 2009
Reply to Office Action of May 17, 2010

light of the Office Action's statement that the previous change "does not affect the claim interpretation...."

RESPONSE TO REJECTIONS

In the outstanding Office Action, one of the previous grounds for rejection was withdrawn, the patentability of claims 12-14 was confirmed, but claims 6-11 were again rejected as follows:

1. Claims 6-11 were alleged to be anticipated by NetBIOS; and
2. Claims 6-14 were alleged to be anticipated by the Etherphone papers.

Both of those rejections are respectfully traversed for the reasons set forth below.

The rejection of Claims 6-11 under 35 U.S.C. 102(b) over NetBIOS

Claims 6-11 are rejected under 35 U.S.C. 102 as being anticipated by NetBIOS. That ground for rejection has been overcome by the amendments to claims 6-8.

Claim 6 has been amended to recite "program code configured to forward to the server process a dynamically assigned network protocol address at which the first process is connected to the computer network following connection of the first process to the computer network." Claim 6 has further been amended to recite "program code configured to receive a dynamically assigned network protocol address of the second process from the server process." Claims 7 and 8 have been amended similarly. Those changes are believed to overcome the outstanding ground for rejection in light of the comments on dynamic addressing in section 6d of the office action which state:

With respect 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.

Re-Examination of Patent No. 6,131,121
Control No.: 90/010,424
Filed: February 24, 2009
Reply to Office Action of May 17, 2010

Accordingly, the patentability of claims 6-11 over NetBIOS should be confirmed.

The rejection of claims 6-11 under 35 U.S.C. 102(b) over the Etherphone papers

Claims 6-11 have been rejected under 35 U.S.C. 102(b) as being anticipated by the Etherphone papers. That ground for rejection has been overcome by the amendments to claims 6-8.

Claim 6 has been amended to recite “program code configured to forward to the server process a dynamically assigned network protocol address at which the first process is connected to the computer network following connection of the first process to the computer network.” Claim 6 has further been amended to recite “program code configured to receive a dynamically assigned network protocol address of the second process from the server process.” Claims 7 and 8 have been amended similarly. Those changes are believed to overcome the outstanding ground for rejection in light of the comments on dynamic addressing in section 6d of the office action which state:

With respect 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.

Accordingly, the patentability of claims 6-11 over the Etherphone papers should be confirmed.

Re-Examination of Patent No. 6,131,121
Control No.: 90/010,424
Filed: February 24, 2009
Reply to Office Action of May 17, 2010

Consequently, in light of the above discussions, the outstanding grounds for rejection are believed to have been overcome and the patentability of the claims subject to re-examination should be indicated as confirmed. An early and favorable action to that effect is respectfully requested.

CHARGE STATEMENT: Deposit Account No. 501860, order no. 2655-0186.	
The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any missing or insufficient fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 (<u>missing or insufficiencies only</u>) now or hereafter relative to this application and the resulting Official Document under Rule 20, or credit any overpayment, to our Accounting/ Order Nos. shown above, for which purpose a <u>duplicate</u> copy of this sheet is attached.	
This CHARGE STATEMENT <u>does not authorize</u> charge of the <u>issue fee</u> until/unless an issue fee transmittal sheet is filed.	
CUSTOMER NUMBER 42624	Respectfully submitted, By: / Michael R. Casey / _____ Michael R. Casey, Ph.D. Registration No.: 40,294
Davidson Berquist Jackson & Gowdey LLP 4300 Wilson Blvd., 7th Floor, Arlington, Virginia 22203 Main: (703) 894-6400 • FAX: (703) 894-6430	