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CENTRAL REEXAMINATION UNIT

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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 *2/24/09* . 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 ___are patentable and/or confirmed.
4. ☒ Claims *6-14* 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.

IDS

2) With regard to the IDS filed 6/11/09:

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. MPEP § 609 (Eighth Edition, Rev. 5, August 2006).

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.

With regard to the IDS's filed 8/11/09 and 8/12/09:

These IDS's have been given due consideration. However, 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.

Rejections

3) The following three rejections are utilized by the examiner below, referencing the proposed prior art listed on pages 4-6 of the Request:

Issue 1: Claims 6-14 in view of NetBIOS and RFC 1531

Issue 2: Claims 6-14 in view of Etherphone, Vin and RFC 1531

Issue 3: Claims 6-14 in view of VocalChat and RFC 1531

Claim Rejection Paragraphs

4) ***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.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Issue 1

5) 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).

6) Claims 12-14 are are rejected under 35 U.S.C. 103(a) as being unpatentable by NetBIOS, further in view of RFC 1531.

Referring to **(Claims 12-14)**, NetBIOS teaches a computer data signal, a method of establishing a point-to-point communication, and an apparatus for use with a computer system (NetBIOS, pg. 357, 359, 371, whereby the system is implemented in networking software on personal computers and is used for connecting processes directly over a network) comprising:

transmitting to a server process, a network protocol address (NetBIOS, pg. 367, 385, 388, 461-464, whereby a node must register with a NBNS by transmitting an identifier and current network address);

transmitting, to the server process, a query as to whether a second process is connected to the computer network (NetBIOS, pg. 377, 388-389, 440, 464-465, whereby an end node sends a query to the NBNS to determine if another end node is connected);

receiving a network protocol address of the second process from the server process, when the second process is connected to the computer network (NetBIOS, pg. 377, 389-394, 446 whereby the NBNS maintains addresses of only active nodes and returns the information regarding the queried node); and

responsive to the network protocol address of the second process, for establishing a point-to-point communication link between the first process and the second process over the computer

network (NetBIOS, pg. 361, 397-400, whereby once a queried node's address is found, a directed point-to-point communication is established of the network).

In addition, NetBIOS teaches the use of TCP/IP (NetBIOS, pg. 356-357). However, NetBIOS does not explicitly teach that the network protocol address is received by a first process following connection to a computer network.

RFC 1531 teaches dynamically assigning IP addresses on a TCP/IP network by an Internet access server (RFC 1531, Section 2.2).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to utilize dynamically assigned IP addresses from Internet access servers in the invention taught by NetBIOS above since this allows for automatic reuse of an address that is no longer needed by the host to which it was assigned (RFC 1531, Pg. 2), and since examiner notes the use of dynamic IP address assignment in a TCP/IP network are old and well known in the art, and are useful to eliminate the burdensome task of manually assigning IP addresses for all networked computers.

Issue 2

7) Examiner notes the following will represent the Etherphone references utilized for the rejection below (All considered a single reference as published together):

"Zellweger 1": An Overview of the Etherphone System and its Applications

"Swinehart 1": Telephone Management in the Etherphone System

"Terry": Managing Stored Voice in the Etherphone System

"Swinehart 2": System Support Requirements for Multi-media Workstations

"Zellweger 2": Active Paths through Multimedia Documents

8) 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).

9) Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable by Etherphone, further in view of Vin, further in view of RFC 1531

Referring to **(Claims 12-14)**, Etherphone teaches a computer data signal, a method of establishing a point-to-point communication, and an apparatus for use with a computer system (Zellweger 1, pg. 1-2, Swinehart 2, pg. 1, Terry, pg. 4, whereby Etherphone functionality is implemented in networking software run on computer and used to connect remote users via a network) comprising:

transmitting to a server process, a network protocol address (Swinehart 1, pg. 2, 4, Zellweger 1, pg. 5, Terry, pg. 3, whereby a voice control server receives network address of a connected process);

transmitting, to the server process, a query as to whether a second process is connected to the computer network (Zellweger 1, pg. 3, 5, Swinehart 1, pg. 2, 4, whereby a query is sent to a server to determine the location and logged in status of a second Etherphone);

receiving a network protocol address of the second process from the server process, when the second process is connected to the computer network (Swinehart 1, pg. 4, whereby a workstation receives the network address of a second workstation from Voice Control Server when the second workstation is connected to the server); and

responsive to the network protocol address of the second process, for establishing a point-to-point communication link between the first process and the second process over the computer network (Swinehart 1, pg. 4, Zellweger 1, pg. 2, Swinehart 2, pg. 1, whereby once network addresses are known, voice datagrams are transmitted directly among participants, bypassing the control server).

However, Etherphone does not explicitly teach that the network protocol address is received by a first process following connection to a computer network.

Vin teaches an Etherphone implementation whereby Internet communications and IP addresses are used (Vin, page 77 and Figure 5).

RFC 1531 teaches dynamically assigning IP addresses on a TCP/IP network by an Internet access server (RFC 1531, Section 2.2).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to utilize the computer program product taught by Etherphone above in an Internet based system utilizing dynamically assigned IP addresses from Internet access servers as taught by Vin and RFC 1531 since Etherphone was intended for use in multiple networks and communication protocols (Terry, page 3), since Vin and Etherphone both describe the same Etherphone system, since examiner notes that Internet and IP address-based networks are old and well known in the art and would be a natural extension from an ethernet-based system, since dynamic allocation of IP addresses allows for automatic reuse of an address that is no longer needed by the host to which it was assigned (RFC 1531, Pg. 2), and since examiner notes the use of dynamic IP address assignment in a TCP/IP network are old and well known in the art, and

are useful to eliminate the burdensome task of manually assigning IP addresses for all networked computers.

Issue 3

10) Examiner notes the following will represent the VocalChat references utilized for the rejection below:

"User's Guide": VocalChat User's Guide, Version 2.0

"Readme": VocalChat Readme File, Version 2.02

"Networking Information": VocalChat 1.01 Networking Information

"Help File": VocalChat Information, Version 2.02

"Troubleshooting Help File": VocalChat Troubleshooting Help File, Version 2.02

11) Claims 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable by VocalChat (See claim mapping in Request pages 90-110, incorporated by reference).

In addition, examiner notes that it would have been obvious to one skilled in the art at the time the invention was made to combine all five VocalChat References utilized above since they all describe a VocalChat system which shares numerous common features including a central server to store addresses and VocalChat client software and which all interoperate in the same basic manner

12) Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable by the combination of all five VocalChat references listed above (hereafter "VocalChat References"), further in view of RFC 1531.

Referring to **(Claims 12-14)**, VocalChat teaches a computer data signal, a method of establishing a point-to-point communication, and an apparatus for use with a computer system (User's Guide, pg. 5, 7-8, Help File, pg. 2, whereby VocalChat is implemented as a program on a computer, and utilized to connect computers on a network) comprising:

transmitting to a server process, a network protocol address (User's Guide, pg. 5, Network Information, pg. 2, 10, Help File, pg. 28, whereby a connection to a server is made to register current network protocol addresses);

transmitting, to the server process, a query as to whether a second process is connected to the computer network (Help File, pg. 2, 22, 26, Network Information, pg. 10, whereby a client query to a server is used to locate users on the network);

receiving a network protocol address of the second process from the server process, when the second process is connected to the computer network (Help File, pg. 2, 22, whereby VocalChat receives information from the connection file through the network of unique users registered); and

responsive to the network protocol address of the second process, for establishing a point-to-point communication link between the first process and the second process over the computer network (Help File, pg. 17, User Guide, pg. 2, whereby user-to-user access over a network is established once network addresses are known).

In addition, VocalChat teaches the use of TCP/IP (Troubleshooting Help File, pg. 28). However, VocalChat does not explicitly teach that the network protocol address is received by a first process following connection to a computer network..

RFC 1531 teaches dynamically assigning IP addresses on a TCP/IP network by an Internet access server (RFC 1531, Section 2.2).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine all five VocalChat References utilized above since they all describe a VocalChat system which shares numerous common features including a central server to store addresses and VocalChat client software and which all interoperate in the same basic manner. In addition it would have been obvious to utilize dynamically assigned IP addresses from Internet access servers in the invention taught by VocalChat above since this allows for automatic reuse of an address that is no longer needed by the host to which it was assigned (RFC 1531, Pg. 2), and since examiner notes the use of dynamic IP address assignment in a TCP/IP network are old and well known in the art, and are useful to eliminate the burdensome task of manually assigning IP addresses for all networked computers.

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

CMC
ESK