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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER	
SAGER, MARK ALAN	

ART UNIT	PAPER NUMBER
3992	

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

The time period for reply, if any, is set in the attached communication.

Oracle 1107

Transmittal of Communication to Third Party Requester *Inter Partes* Reexamination	Control No.	Patent Under Reexamination	
	95/001,927	7415530	
	Examiner	Art Unit	
	MARK SAGER	3992	

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

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Tracy W. Druce
2nd Reexam Group - Novak Druce & Quigg LLP
1000 Louisiana Street,
Fifty-Third Floor
Houston, TX 77002

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination prceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

Right of Appeal Notice (37 CFR 1.953)	Control No.	Patent Under Reexamination
	95/001,927	7415530
	Examiner	Art Unit
	MARK SAGER	3992

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

Responsive to the communication(s) filed by:
Patent Owner on _____
Third Party(ies) on _____

Patent owner and/or third party requester(s) may file a notice of appeal with respect to any adverse decision with payment of the fee set forth in 37 CFR 41.20(b)(1) within **one-month or thirty-days (whichever is longer)**. See MPEP 2671. In addition, a party may file a notice of **cross** appeal and pay the 37 CFR 41.20(b)(1) fee **within fourteen days of service** of an opposing party's timely filed notice of appeal. See MPEP 2672.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

If no party timely files a notice of appeal, prosecution on the merits of this reexamination proceeding will be concluded, and the Director of the USPTO will proceed to issue and publish a certificate under 37 CFR 1.997 in accordance with this Office action.

The proposed amendment filed _____ ☐ will be entered ☐ will not be entered*

*Reasons for non-entry are given in the body of this notice.

1a. ☒ Claims 1,2,16-21 and 23 are subject to reexamination.
1b. ☒ Claims 3-15 and 22 are not subject to reexamination.
2. ☐ Claims _____ have been cancelled.
3. ☒ Claims 1-2, 16-21 and 23 are confirmed. [Unamended patent claims].
4. ☐ Claims _____ are patentable. [Amended or new claims].
5. ☐ Claims _____ are rejected.
6. ☐ Claims _____ are objected to.
7. ☐ The drawings filed on _____ ☐ are acceptable. ☐ are not acceptable.
8. ☐ The drawing correction request filed on _____ is ☐ approved. ☐ disapproved.
9. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119 (a)-(d) or (f). The certified copy has:
   ☐ been received. ☐ not been received. ☐ been filed in Application/Control No. _____.
10. ☐ Other _____

Attachments

1. ☐ Notice of References Cited by Examiner, PTO-892
2. ☐ Information Disclosure Citation, PTO/SB/08
3. ☐ _____

Reexamination

This reexamination of U.S. Patent 7415530 regarding claims 1-2, 16-21 and 23 continues where no Patent Owner reply was received prior to the expiring of period to respond. Per Order, the claims 1-10 are not subject of this reexamination. Thus, lacking evidence to the contrary, this action reiterates the revised ACP mailed April 3, 2013.

References Cited in Request

Aakre et al., (U.S. Patent No. 4,956,808 (hereinafter Aakre)

Ohkubo et al., U.S. Patent No. 4,593,324 (hereinafter Ohkubo)

Chu et al., U.S. Patent 5,130,430 (hereinafter Chu)

Baker et al., "Lossless Data Compression for Short Duration 3D Frames in Positron Emission Tomography", IEEE, 1994 (hereinafter Baker)

French et al., U.S. Patent 5,794,229 (hereinafter French)

Dye et al., U.S. Patent No. 7,190,284 (hereinafter Dye)

Rejections Proposed in the Request

1. The following 15 rejections were proposed in the Request:

Issue 1: Claims 1, 2, 16, 18-21 and 23 are rendered obvious over Aakre in view of Dye.

Issue 2: Claim 17 is rendered obvious over Aakre in view of Dye and further in view of Baker.

Issue 3: Claims 1, 2, 20, and 21 are rendered obvious over Aakre in view of French.

Issue 4: Claims 16 and 17 are rendered obvious over Aakre in view of French and further in view of Baker.

Issue 5: Claims 18, 19 and 23 are rendered obvious over Aakre in view of French and further in view of Dye.

Issue 6: Claims 1, 2, 16, 18-21 and 23 are rendered obvious over Ohkubo in view of Dye.

Issue 7: Claim 17 is rendered obvious over Ohkubo in view of Dye and further in view of Baker.

Issue 8: Claims 1, 2, 20 and 21 are rendered obvious over Ohkubo in view of French.

Issue 9: Claims 16-18 are rendered obvious over Ohkubo in view of French and further in view of Baker.

Issue 10: Claims 19 and 23 are rendered obvious over Ohkubo in view of French and further in view of Dye.

Issue 11: Claims 1, 2, 16, 18-21 and 23 are rendered obvious over Chu in view of Dye.

Issue 12: Claim 17 is rendered obvious over Chu in view of Dye and further in view of Baker.

Issue 13: Claims 1, 2, 17, 18, 20 and 21 are rendered obvious over Chu in view of French.

Issue 14: Claim 16 is rendered obvious over Chu in view of French and further in view of Baker.

Issue 15: Claims 19 and 23 are rendered obvious over Chu in view of French and further in view of Dye.

3. The proposed rejections in issues 1-15 are not adopted for reasons stated below.

Response to Amendment

4. The Declaration by Dr. James W. Modestino in support of the Patent Owner under 37 CFR 1.132 filed December 21, 2012 is reviewed herein but no weight is attributed in its consideration over the holdings of applied art to overcome the rejection of claims 1-2, 16-21 and 23 based upon Aakre, Ohkubo and Chu as set forth in the last Office action due in part to disparities noted because: although Dr. Modestino states his credentials as an expert in paragraphs 8-13 including its Attachment 1, that his compensation is not dependent on the outcome of that reexamination and in no way effects the substance of his statements in his declaration with no prior affiliation with Realtime (assignee), the Declaration regards the amended claimed invention in reexam 95001922 (hereafter '922) for Patent 7321937 (hereafter '937) per header on cover page and discussion on pages 1-11 that discuss Aakre, Ohkubo and Chu where there is no statements to correlate between the claimed invention discussed for '937 Patent under reexam '922 in the Declaration or in aforementioned Patent Owner filed reply to associate to claims of '530 Patent under reexam '927 herein, so it is speculative as to how the statements in the Declaration for the '937 Patent relate to instant claims of '530 Patent. However, it appears Patent Owner desires statements in the Declaration filed in reexam '922 to be considered herein due to statements in their reply on pages 19, 32 and 43 discussing the Aakre, Ohkubo and Chu. The statements by Dr. Modestino appear to address anticipation of the aforementioned references in the reexam '922 of the '937

Patent; however, there is no anticipation by those references in reexam '927 and the Declaration does not address obviousness towards any combination of references applied in this reexam. It is noteworthy that the Patentee reply footnote on page 19 states "Declaration of Dr. James W. Modestino Under 37 C.F.R. §1.132 filed June 20, 2012 in the reexamination of U.S. Patent 7,321,937, Control No. 95/001,922. The '937 Modestino Declaration is also attached to this response" to thereby suggest that the Declaration filed on December 21, 2012 in this '927 proceeding is the same Declaration filed June 20, 2012 in the '922 proceeding. However, in comparing the two Declarations there are numerous disparities that the Declaration in '927 is the same Declaration as filed in '922 where the disparities include page length of the Declaration in '927 being 12 pages with 46 paragraphs plus 8 redundant paragraphs on pages 10-12 that provide a discussion of Chu, Aakre, Ohkubo, Baker as mentioned in paragraph 4 of the Declaration in '927; while the Declaration in '922 has only 6 pages with 23 paragraphs that only discuss Chu as mentioned in paragraph 4 therein. Another disparity is that paragraph 3 of the Declaration in the '922 proceeding states in part that the expert 'reviewed and am familiar with the Office action mailed April 20, 2012'; however, paragraphs 3 and 4 of the Declaration in the '927 proceeding states in part that the expert 'reviewed and am familiar with the Office action mailed October 18, 2012'. It is further noted that the expert signature page in the Declaration shows a date of June 19, 2012, where the Office action discussed is from October 18, 2012 so it is unclear how temporally a review that was signed on 19 June 2012 may have considered a yet to be filed Office action in October and in light that the Declaration in '922 only reviewed Chu for an Office action that regarded anticipation (see paragraph 15 of the '922 Declaration) but the Declaration

in '927 reviewed not only Chu but also other references (Aakre, Ohkubo and Baker) where these other references were not applied in the '922 proceeding at least at the time of the review of June 19, 2012. Due to these disparities, the Declaration in '927 has been reviewed and considered but is provided no weight; however, the Examiner provides the following analysis of the art against scope of amended claims of '530 Patent herein.

Regarding Aakre, the Request cites facts showing Aakre discloses (abstract, 1:54-59, 1:62-2:4, 2:10-13, 17-21 and 43-47, 3:30-50) a system using tape memory that is coupled to a data compressor as a data accelerator that receives a data stream where the data stored to the tape is compressed to increase data density and reduces the time required to store data on tape that would have been interpreted by an artisan by its plain meaning that Aakre performs storage occurs faster than said data stream is able to be stored on said memory in received form since it reduces the time required to store data on tape resultant from the compression; but, lacking evidence to the contrary, there is insufficient factual evidence that Aakre performs "*said compression and storage* occurs faster than said data stream is able to be stored on said memory device in said received form" (emphasis added) as present in claim 1, "wherein a bandwidth of the received data stream is determined" and "wherein a data rate of the compressed data stream is adjusted, by modifying a system parameter to adjust the data rate of the compressed data stream to make a bandwidth of the compressed data stream compatible with a bandwidth of the memory device" as present in new claim 24, "wherein the data accelerator is configured to append a type descriptor to the first and second compressed data blocks in the compressed data stream, and wherein the type descriptor includes values corresponding to a plurality of encoding techniques that were applied to the compressed data stream" as

present in new claim 25 and "wherein the data accelerator is configured to adjust the data rate of the compressed data stream by adjusting a compression ratio of a lossless encoder" as present in new clam 26.

Regarding Ohkubo, the Request cites facts showing Ohkubo discloses (abstract, 1:54-67, 2:62-63, 2:67-3:8, 3:29-31, 4:10-14 and 22-29) a system having a memory device and data accelerator as its data compression/expansion device coupled to the memory device that receives a data stream to compress the received data stream so the data is inputted and outputted at high speed and the amount of data stored may be five times that in the case where no compression is effected; but lacking evidence to the contrary, there is insufficient factual evidence that Ohkubo performs "*said compression and storage* occurs faster than said data stream is able to be stored on said memory device in said received form" (emphasis added) as present in claim 1, "wherein a bandwidth of the received data stream is determined" and "wherein a data rate of the compressed data stream is adjusted, by modifying a system parameter to adjust the data rate of the compressed data stream to make a bandwidth of the compressed data stream compatible with a bandwidth of the memory device" as present in new claim 24, "wherein the data accelerator is configured to append a type descriptor to the first and second compressed data blocks in the compressed data stream, and wherein the type descriptor includes values corresponding to a plurality of encoding techniques that were applied to the compressed data stream" as present in new claim 25 and "wherein the data accelerator is configured to adjust the data rate of the compressed data stream by adjusting a compression ratio of a lossless encoder" as present in new clam 26.

Regarding Chu, the Request cites facts showing Chu discloses (3:65-68, 4:10-12, 16-20 and 24-38, 6:4-28, 17:3-6, fig 2) a system with a memory device as its hard disk that is coupled to a data accelerator as its integrated chip receives a data stream and compresses the data stream where the encoder circuit is sufficiently fast at performing the necessary encoding operations, the use of the data compression and decoding circuits will be "seamless" in that their performance would not affect the performance of the computer system except that the amount of data that could be stored on the hard disk would be approximately doubled; but, lacking evidence to the contrary, there is insufficient factual evidence that Chu performs "*said compression and storage* occurs faster than said data stream is able to be stored on said memory device in said received form" (emphasis added) as present in claim 1, "wherein a bandwidth of the received data stream is determined" and "wherein a data rate of the compressed data stream is adjusted, by modifying a system parameter to adjust the data rate of the compressed data stream to make a bandwidth of the compressed data stream compatible with a bandwidth of the memory device" as present in new claim 24, "wherein the data accelerator is configured to append a type descriptor to the first and second compressed data blocks in the compressed data stream, and wherein the type descriptor includes values corresponding to a plurality of encoding techniques that were applied to the compressed data stream" as present in new claim 25 and "wherein the data accelerator is configured to adjust the data rate of the compressed data stream by adjusting a compression ratio of a lossless encoder" as present in new clam 26.

Response to Arguments

5. Responsive to aforementioned Patent Owner's reply/arguments, the examiner generally agrees with facts cited in their Reply with review of their expert testimony above regarding applied art for the original claims and newly added claims for reasons stated next. Facts stated in Request are relied on herein. For consistency, the discussion herein follows discussion of applied art in turn as presented in their reply rather than each rejection/issue in turn. For the record, Patentee refers to claim 13 (page 23) is not considered herein since that claim is not reexamined per Decision mailed Aug 31, 2012.

a. Obviousness of Aakre in view of Dye, Baker and/or French for claims 1-2, 16-21 and 23:

Patent Owner: In summary, the Patent Owner argues on pages 9-12 that Aakre and Dye, Baker and/or French fails to disclose each and every element of claim 1 since Aakre fails to teach claimed 'said compression and storage occurs faster than said data stream is able to be stored on said memory device in said received form' and Dye, Baker and French fail to remedy this deficiency. Therefore, Patent Owner requests claim 1-2, 16-21 and 23 to be confirmed and issues 1-5 to be withdrawn.

Examiner: As stated in paragraph 4 above, lacking evidence to the contrary, there is insufficient factual evidence to support Aakre performs 'said compression and storage occurs faster than said data stream is able to be stored on said memory device in said received form' and there is insufficient factual support that Dye, Baker and/or French remedy this deficiency to fail to establish a prima facie case of obviousness. Thus, obviousness of claim 1-2, 16-21 and 23 over Aakre with Dye, Baker and/or French for issues 1-5 are **not adopted**.

b. Obviousness of Aakre in view of Dye, Baker and/or French for claim 24:

Patent Owner: The Patent Owner asserts on pages 18-21 with reference to their Declaration that Aakre and Dye, Baker and/or French fails to disclose each and every element of new claim 24 since Aakre and Dye, Baker and/or French alone or in combination fails to disclose "wherein a bandwidth of the received data stream is determined" and "wherein a data rate of the compressed data stream is adjusted, by modifying a system parameter, to make a bandwidth of the compressed data stream compatible with a bandwidth of the memory device" as present in claim 24 since each of the applied references is silent with regards to this feature. Therefore, Patent Owner requests claim 24 to be allowed.

Examiner: Although not stated by Patentee, claim 24 includes the element(s) lacking in claim 1 by the same applied art noted above and therefore, is patentable at least for reason stated above with regards to claim 1. Further, as stated in paragraph 4 above, lacking evidence to the contrary, there is insufficient factual evidence to support Aakre performs "wherein a bandwidth of the received data stream is determined" and "wherein a data rate of the compressed data stream is adjusted, by modifying a system parameter, to make a bandwidth of the compressed data stream compatible with a bandwidth of the memory device" and there is insufficient factual support that Dye, Baker and/or French remedy this deficiency to fail to establish a prima facie case of obviousness.

c. Obviousness of Ohkubo in view of Dye, Baker and/or French for claims 1-2, 16-21 and 23:

Patent Owner: The Patent Owner alleges on pages 22-25 that Ohkubo fails to disclose the broadest reasonable interpretation of "receiving a data stream" since they allege Ohkubo retrieves data from a memory device that is not by receiving a continuous stream of data elements from a source or sources. The Patent Owner allege the assignee of Ohkubo patent is Fuji Xerox and its input device regards a scanner, fax machine or the like and the Ohkubo patent does not teach or suggest "receiving a stream of data" as this term is defined and used by "530 patent. The Patent Owner alleges no prima facie case of obviousness has been established for Ohkubo and Dye, Baker and/or French alone or in combination regarding "receiving a data stream". Therefore, Patent Owner requests claim 1-2, 16-21 and 23 to be confirmed and issues 6-10 to be withdrawn.

Examiner: The Examiner does not agree with Patent Owner's alleged scope since continuous is not claimed, the Patent Owner failed to act as their own lexicographer in this case and did not present facts to show a 'continuous' data stream was necessarily present so as to be inherent where although a data stream is claimed it is not required for the data stream to be continuous where Patentee failed to sufficiently define the term data stream to provide disclosure to the public of the boundary of the invention in exchange for the rights that a patent grants. However, as noted in paragraph 4, lacking evidence to the contrary, there is insufficient factual evidence to support Ohkubo performs 'said compression and storage occurs faster than said data stream is able to be stored on said memory device in said received form' and there is insufficient factual support that Dye, Baker and/or French remedy this deficiency to fail to establish a prima facie case of obviousness. Thus, obviousness of claim 1-2, 16-21 and 23 over Ohkubo and Dye, Baker and/or French for issues 6-10 are **not adopted**.

d. Obviousness of Ohkubo in view of Dye, Baker and/or French for claim 24:

Patent Owner: The Patent Owner remarks on pages 31-34 with reference to their Declaration that Ohkubo and Dye, Baker and/or French fails to disclose each and every element of new claim 24 since Ohkubo and Dye, Baker and/or French alone or in combination fails to disclose "wherein a bandwidth of the received data stream is determined" and "wherein a data rate of the compressed data stream is adjusted, by modifying a system parameter, to make a bandwidth of the compressed data stream compatible with a bandwidth of the memory device" as present in claim 24 since each of the applied references is silent with regards to this feature. Therefore, Patent Owner requests claim 24 to be allowed.

Examiner: Although not stated by Patentee, claim 24 includes the element lacking in claim 1 by the same applied art noted above and therefore, is patentable at least for reason stated above with regards to claim 1. Further, as stated in paragraph 4 above, lacking evidence to the contrary, there is insufficient factual evidence to support Ohkubo performs "wherein a bandwidth of the received data stream is determined" and "wherein a data rate of the compressed data stream is adjusted, by modifying a system parameter, to make a bandwidth of the compressed data stream compatible with a bandwidth of the memory device" and there is insufficient factual support that Dye, Baker and/or French remedy this deficiency to fail to establish a prima facie case of obviousness.

e. Obviousness of Chu in view of Dye, Baker and/or French for claims 1-2, 16-21 and 23:

Patent Owner: In summary, the Patent Owner argues on pages 34-36 that Chu and Dye, Baker and/or French fails to disclose each and every element of claim 1 since Chu is fundamentally incompatible and thus cannot be combined with the teachings of Dye or French. Therefore, Patent Owner requests claim 1-2, 16-21 and 23 to be confirmed and issues 11-15 to be withdrawn.

Examiner: As stated in paragraph 4 above, lacking evidence to the contrary, there is insufficient factual evidence to support Chu performs 'said compression and storage occurs faster than said data stream is able to be stored on said memory device in said received form' and there is insufficient factual support that Dye, Baker and/or French remedy this deficiency to fail to establish a prima facie case of obviousness. Thus, obviousness of claim 1-2, 16-21 and 23 over Chu with Dye, Baker and/or French for issues 11-15 are **not adopted**.

f. Obviousness of Chu in view of Dye, Baker and/or French for claim 24:

Patent Owner: The Patent Owner asserts on pages 42-45 with reference to their Declaration that Chu and Dye, Baker and/or French fails to disclose each and every element of new claim 24 since Chu and Dye, Baker and/or French alone or in combination fails to disclose "wherein a bandwidth of the received data stream is determined" and "wherein a data rate of the compressed data stream is adjusted, by modifying a system parameter, to make a bandwidth of the compressed data stream compatible with a bandwidth of the memory device" as present in claim 24 since each of the applied references is silent with regards to this feature. Therefore, Patent Owner requests claim 24 to be allowed.

Examiner: Although not stated by Patentee, claim 24 includes the element lacking in claim 1 by the same applied art noted above and therefore, claim 24 is patentable at least for reason stated above with regards to claim 1. Further, as stated in paragraph 4 above, lacking evidence to the contrary, there is insufficient factual evidence to support Chu performs "wherein a bandwidth of the received data stream is determined" and "wherein a data rate of the compressed data stream is adjusted, by modifying a system parameter, to make a bandwidth of the compressed data stream compatible with a bandwidth of the memory device" and there is insufficient factual support that Dye, Baker and/or French remedy this deficiency to fail to establish a prima facie case of obviousness.

g. Aakre, Baker, Chu, Dye, French and Ohkubo do not disclose new features present in claims 25 and 26:

Patent Owner: The Patent Owner alleges with reference to their Declaration on pages 45-49 that Aakre, Baker, Chu, Dye, French and Ohkubo fails to disclose each and every element of new claims 25 and 26 since Aakre, Baker, Chu, Dye, French and Ohkubo do not disclose, teach or suggest a "type descriptor includes values corresponding to a plurality of encoding techniques that were applied to the compressed data stream" as present in new claim 25 and ability "to adjust the data rate of the compressed data stream by adjusting a compression ratio of a lossless encoder" as present in new clam 26. Essentially, Patent Owner asserts the references fail to disclose applying a plurality of encoding techniques to the compressed data stream as present in claim 25

and that the references do not mention the ability to adjust a compression ratio. Therefore, Patent Owner requests claims 25-26 to be allowed.

Examiner: Although not stated by Patentee, claims 25-26 by their dependency upon claim 1 include the element(s) lacking by the same applied art noted above and therefore, claims 25-26 are patentable at least for reason stated above with regards to claim 1. Regarding claim 25, the claim language does not include or require applying a plurality of encoding techniques to the compressed data stream as stated by Patent Owner on pages 45-49 and '530 Patent includes no/null compression encoding, a singular encoding or a plurality of encoding techniques (7:28-32, 9:47-51), so the Examiner does not agree with Patent Owner's alleged scope since the claim language does not include or require applying a plurality of encoding techniques to the compressed data stream, the Patent Owner failed to act as their own lexicographer in this case and did not present facts to show a ' plurality of encoding techniques to the compressed data stream' was necessarily present so as to be inherent where although "wherein the type descriptor includes values corresponding to a plurality of encoding techniques to the compressed data stream is claimed it is not required for the data stream to be compressed by a plurality of encoding techniques", contrarily to Patentee opine the language merely requires a descriptor having a value of a plurality of encoding techniques where Patentee failed to sufficiently/adequately define the term/phrase to provide disclosure to the public of the boundary of the invention in exchange for the rights that a patent grants. Contrary to Patent Owner, the null/no encoding and singular encoding technique regards a plurality of encoding techniques that are applied to the data stream. However, as stated in paragraph 4 above, lacking evidence to the contrary, there is insufficient factual evidence

to support Aakre, Ohkubo and/or Chu performs "wherein the data accelerator is configured to append a type descriptor to the first and second compressed data blocks in the compressed data stream, and wherein the type descriptor includes values corresponding to a plurality of encoding techniques that were applied to the compressed data stream" as present in new claim 25 and "wherein the data accelerator is configured to adjust the data rate of the compressed data stream by adjusting a compression ratio of a lossless encoder" as present in new clam 26. With consideration of the stated scope of claim 25 above, Dye teaches (abstract, 13:52-56, 26:50-27:3, 32:13-15, 35:56-36:4, 38:14-40:3) to store compression mode information in the header and to strip the header for the compression mode to thereby suggest "wherein the data accelerator is configured to append a type descriptor to the first and second compressed data blocks in the compressed data stream, and wherein the type descriptor includes values corresponding to a plurality of encoding techniques that were applied to the compressed data stream"; so the combination of Aakre, Ohkubo and/or Chu with Dye includes the function of claim 25, but claim 25 is patentable as noted above for its dependency to claim 1. Finally, regarding claim 26, there is insufficient factual support that Dye, Baker and/or French remedy the deficiency to fail to establish a prima facie case of obviousness.

Claim Rejections - 35 USC § 102/103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Issue 1

Requester Proposed Rejection (Not Adopted)

7. Claims 1-2, 16, 18-21 and 23 are proposed as being unpatentable over Aakre (U.S. Patent No. 4,956,808) in view of Dye (U.S. Patent No. 7,190,284). This rejection was proposed by the third party requester in their Request is **not adopted** for reasons stated above in paragraphs 4-5.

Issue 2

Requester Proposed Rejection (Not Adopted)

8. Claim 17 is proposed as being unpatentable over Aakre (U.S. Patent No. 4,956,808) in view of Dye (U.S. Patent No. 7,190,284) as applied to claim 1 above, and further in view of Baker. This rejection was proposed by the third party requester in their Request is **not adopted** for reasons stated above in paragraphs 4-5.

Issue 3

Requester Proposed Rejection (Not Adopted)

9. Claims 1-2, 20 and 21 are proposed as being unpatentable over Aakre (U.S. Patent No. 4,956,808) in view of French (U.S. Patent 5,794,229). This rejection was proposed by the third party requester in their Request is **not adopted** for reasons stated above in paragraphs 4-5.

Issue 4

Requester Proposed Rejection (Not Adopted)

10. Claims 16-17 are proposed as being unpatentable over Aakre (U.S. Patent No. 4,956,808) in view of French (U.S. Patent 5,794,229) as applied to claim 1 above, and further in view of Baker. This rejection was proposed by the third party requester in their Request is **not adopted** for reasons stated above in paragraphs 4-5.

Issue 5

Requester Proposed Rejection (Not Adopted)

11. Claims 18-19 and 23 are proposed as being unpatentable over Aakre (U.S. Patent No. 4,956,808) in view of French (U.S. Patent 5,794,229) as applied to claim 1 above, and further in view of Dye (U.S. Patent No. 7,190,284). This rejection was proposed by the third party requester in their Request is **not adopted** for reasons stated above in paragraphs 4-5.

Issue 6

Requester Proposed Rejection (Not Adopted)

12. Claims 1-2, 16, 18-21 and 23 are proposed as being unpatentable over Ohkubo (U.S. Patent No. 4,593,324) in view of Dye (U.S. Patent No. 7,190,284). This rejection was proposed by the third party requester in their Request is **not adopted** for reasons stated above in paragraphs 4-5.

Issue 7

Requester Proposed Rejection (Not Adopted)

13. Claim 17 is proposed as being unpatentable over Ohkubo (U.S. Patent No. 4,593,324) in view of Dye (U.S. Patent No. 7,190,284) as applied to claim 1 above, and further in view of Baker. This rejection was proposed by the third party requester in their Request is **not adopted** for reasons stated above in paragraphs 4-5.

Issue 8

Requester Proposed Rejection (Not Adopted)

14. Claims 1-2, 20 and 21 are proposed as being unpatentable over Ohkubo (U.S. Patent No. 4,593,324) in view of French (U.S. Patent 5,794,229). This rejection was

proposed by the third party requester in their Request is **not adopted** for reasons stated above in paragraphs 4-5.

Issue 9

Requester Proposed Rejection (Not Adopted)

15. Claims 16-18 are proposed as being unpatentable over Ohkubo (U.S. Patent No. 4,593,324) in view of French (U.S. Patent 5,794,229) as applied to claim 1 above, and further in view of Baker. This rejection was proposed by the third party requester in their Request is **not adopted** for reasons stated above in paragraphs 4-5.

Issue 10

Requester Proposed Rejection (Not Adopted)

16. Claims 19 and 23 are proposed as being unpatentable over Ohkubo (U.S. Patent No. 4,593,324) in view of French (U.S. Patent 5,794,229) as applied to claim 1 above, and further in view of Dye (U.S. Patent No. 7,190,284). This rejection was proposed by the third party requester in their Request is **not adopted** for reasons stated above in paragraphs 4-5.

Issue 11

Requester Proposed Rejection (Not Adopted)

17. Claims 1-2, 16, 18-21 and 23 are proposed as being unpatentable over Chu (U.S. Patent 5,130,430) in view of Dye (U.S. Patent No. 7,190,284). This rejection was proposed by the third party requester in their Request is **not adopted** for reasons stated above in paragraphs 4-5.

Issue 12

Requester Proposed Rejection (Not Adopted)

18. Claim 17 is proposed as being unpatentable over Chu (U.S. Patent 5,130,430) in view of Dye (U.S. Patent No. 7,190,284) as applied to claim 1 above, and further in view of Baker. This rejection was proposed by the third party requester in their Request is **not adopted** for reasons stated above in paragraphs 4-5.

Issue 13

Requester Proposed Rejection (Not Adopted)

19. Claims 1-2, 17-18, 20 and 21 are proposed as being unpatentable over Chu (U.S. Patent 5,130,430) in view of French (U.S. Patent 5,794,229). This rejection was proposed by the third party requester in their Request is **not adopted** for reasons stated above in paragraphs 4-5.

Issue 14

Requester Proposed Rejection (Not Adopted)

20. Claim 16 is proposed as being unpatentable over Chu (U.S. Patent 5,130,430) in view of French (U.S. Patent 5,794,229) as applied to claim 1 above, and further in view of Baker. This rejection was proposed by the third party requester in their Request is **not adopted** for reasons stated above in paragraphs 4-5.

Issue 15

Requester Proposed Rejection (Not Adopted)

Claims 19 and 23 are proposed as being unpatentable over Chu (U.S. Patent 5,130,430) in view of French (U.S. Patent 5,794,229) as applied to claim 1 above, and further in view of Dye (U.S. Patent No. 7,190,284). This rejection was proposed by the third party requester in their Request is **not adopted** for reasons stated above in paragraphs 4-5.

Conclusion

21. **This is a RIGHT OF APPEAL NOTICE (RAN)**; see MPEP § 2673.02 and § 2674. The decision in this Office action as to the patentability or unpatentability of any original patent claim, any proposed amended claim and any new claim in this proceeding is a FINAL DECISION.

No amendment can be made in response to the Right of Appeal Notice in an *inter partes* reexamination. 37 CFR 1.953(c). Further, no affidavit or other evidence can be submitted in an *inter partes* reexamination proceeding after the right of appeal notice, except as provided in 37 CFR 1.981 or as permitted by 37 CFR 41.77(b)(1). 37 CFR 1.116(f).

Each party has a **thirty-day or one-month time period, whichever is longer**, to file a notice of appeal. The patent owner may appeal to the Board of Patent Appeals and Interferences with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent by filing a notice of appeal and paying the fee set forth in 37 CFR 41.20(b)(1). The third party requester may appeal to the Board of Patent Appeals and Interferences with respect to any decision favorable to the patentability of any original or proposed amended or new claim of the patent by filing a notice of appeal and paying the fee set forth in 37 CFR 41.20(b)(1).

In addition, a patent owner who has not filed a notice of appeal may file a notice of cross appeal within **fourteen days of service** of a third party requester's timely filed notice of appeal and pay the fee set forth in 37 CFR 41.20(b)(1). A third party requester who has not filed a notice of appeal may file **a notice of cross appeal within fourteen**

days of service of a patent owner's timely filed notice of appeal and pay the fee set forth in 37 CFR 41.20(b)(1).

Any appeal in this proceeding must identify the claim(s) appealed, and must be signed by the patent owner (for a patent owner appeal) or the third party requester (for a third party requester appeal), or their duly authorized attorney or agent.

Any party that does not file a timely notice of appeal or a timely notice of cross appeal will lose the right to appeal from any decision adverse to that party, but will not lose the right to file a respondent brief and fee where it is appropriate for that party to do so. If no party files a timely appeal, the reexamination prosecution will be terminated, and the Director will proceed to issue and publish a certificate under 37 CFR 1.997 in accordance with this Office action.

21. Extensions of time under 37 CFR 1.136(a) will not be permitted in inter partes reexamination proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 314(c) requires that inter partes reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.937). Patent owner extensions of time in inter partes reexamination proceedings are provided for in 37 CFR 1.956. Extensions of time are not available for third party requester comments, because a comment period of 30 days from service of patent owner's response is set by statute. 35 U.S.C. 314(b)(3).

22. The patent owner is reminded of the continuing responsibility under 37 CFR 1.985(a), to apprise the Office of any litigation activity, or other prior or concurrent

proceeding, involving Patent No. 7415530 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP 2686 and 2686.04.

23. **All** correspondence relating to this inter partes reexamination proceeding should be directed:

By Mail to:
Mail Stop Inter Partes Reexam
Attn: Central Reexamination Unit
Commissioner of Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to:
(571) 273-9900
Central Reexamination Unit

By hand:
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:efs.uspto.gov/efile/myportal/efs-registered

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 examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

Signed:

/M. Sager/
Primary Examiner, Art Unit 3992

Conferees: /FOF/

/Woo H. Choi/
Supervisory Patent Reexamination Specialist, Art Unit 3992