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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,639	08/12/2011	7222078	13557-105161.R1	3851

70646 7590 09/28/2011
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EXAMINER

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ART UNIT PAPER NUMBER

3992

MAIL DATE DELIVERY MODE

09/28/2011

PAPER

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.



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MAILED
Date:
SEP 28 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000639
PATENT NO. : 7222078
TECHNOLOGY CENTER : 3999
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 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.

Transmittal of Communication to Third Party Requester Inter Partes Reexamination	Control No.	Patent Under Reexamination
	95/000,639	7222078
	Examiner	Art Unit
	LUKE S. WASSUM	3992

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

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**ORDER GRANTING/DENYING
REQUEST FOR INTER PARTES
REEXAMINATION**

Control No.	Patent Under Reexamination
95/000,639	7222078
Examiner	Art Unit
LUKE S. WASSUM	3992

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

The request for *inter partes* reexamination has been considered. Identification of the claims, the references relied on, and the rationale supporting the determination are attached.

Attachment(s): PTO-892 PTO/SB/08 Other: PTO-1449

1. The request for *inter partes* reexamination is GRANTED.

An Office action is attached with this order.

An Office action will follow in due course.

2. The request for *inter partes* reexamination is DENIED.

This decision is not appealable. 35 U.S.C. 312(c). Requester may seek review of a denial by petition to the Director of the USPTO within ONE MONTH from the mailing date hereof. 37 CFR 1.927. EXTENSIONS OF TIME ONLY UNDER 37 CFR 1.183. In due course, a refund under 37 CFR 1.26(c) will be made to requester.

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 Order.

DECISION GRANTING INTER PARTES REEXAMINATION

A substantial new question of patentability affecting claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of U.S. Patent Number 7,222,078 is raised by the request for *inter partes* reexamination filed 12 August 2011. Claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 are subject to reexamination.

Prosecution History

U.S. Patent 7,222,078 ("the '078 patent") issued on 22 May 2007, from application number 10/734,201, filed 10 December 2003. The patent is a continuation of application 09/370,663, filed 6 August 1999, which was a continuation of application 08/934,457, filed 19 September 1997, now U.S. Patent 5,999,908 ("the '908 patent"), which was a continuation of application 08/243,638, filed 16 May 1994, which was a continuation-in-part of application 07/926,333, filed 6 August 1992.

The '078 patent is drawn to a system having the ability to obtain action and behavioral information during the actual use of products, services and information systems in order to aid in product design decisions (col. 1, lines 50-57), and to learn interactively and iteratively from the users of products and information systems

anywhere in the world while they are in use - without having to travel to their sites and without having to bring them to a testing laboratory (see col. 2, lines 36-41). It includes a Customer-Based Product Design Module (CB-PD Module) which produces a continuous source of Aggregated Customer Desires (ACD) and Defined Customer Desires (DCD) from customers and users while they are using these products and services, and allows vendors to continuously listen to Customers and understand their performance, their needs and their expectations (see col. 9, lines 40-50). One embodiment of the invention is illustrated in drawing Figure 2.

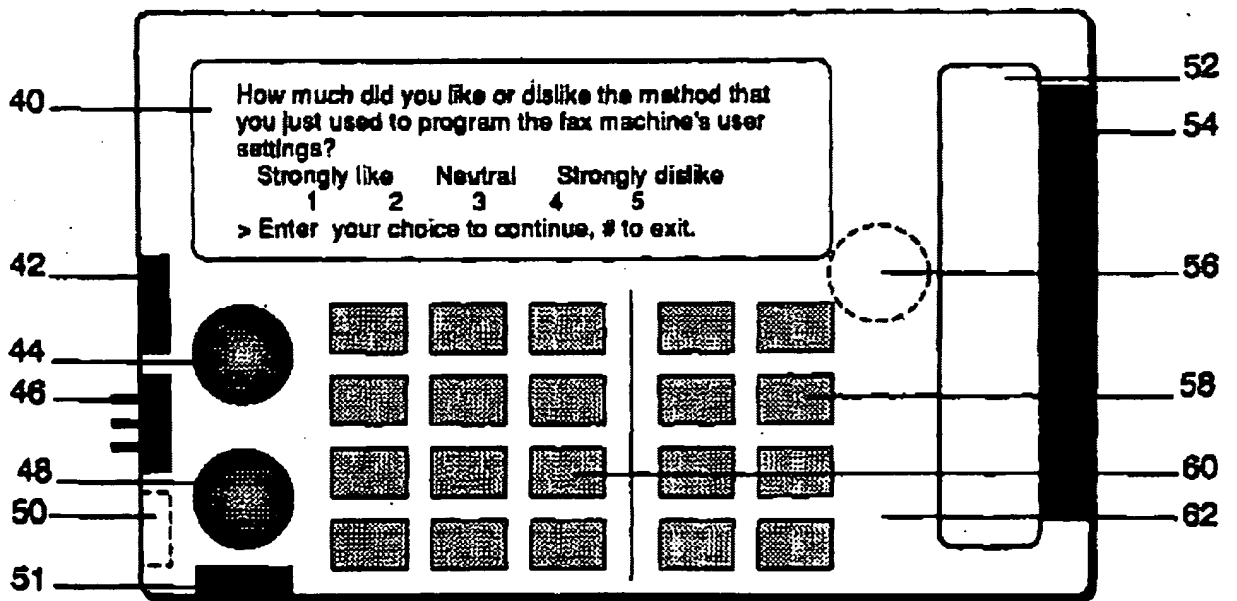


FIG. 2

The patent application was filed with 47 claims, including independent claims 1, 23 and 43. A preliminary amendment was filed, canceling claims 1-47, and adding new claims 48-139, including independent claims 48, 90, 98, 108, 109, 110, 118, 119, 120, 121 and 135.

First Action

In the first Office action, the examiner rejected all claims 48-139 in view of prior art.

First Amendment

In their response, the Patent Owner canceled claim 102 and added new claim 140. They also made a number of clarifying amendments which did not substantially alter the scope of the claims.

In addition, the Patent Owner argued that, regarding claim 48, the prior art failed to teach

“...units of a commodity that are used by respective users in different locations,

A user interface which is part of each of the units of the commodity, provides a medium for two-way local interaction between one of the users and the corresponding unit of the commodity, and is configured to elicit, from a user, information about the user’s perception of the commodity...”

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The Patent Owner further argued that, regarding claim 98, that the prior art failed to teach

“a user interface...[that] is configured to elicit information about (i) steps that a vendor of the commodity could take to improve the user’s satisfaction or (ii) training or support provided for users of the commodity”

The Patent Owner also argued that, regarding claim 135, the prior art failed to teach

“eliciting users for their perceptions of respective units of commodity”

Final Rejection

In the Final Rejection, the examiner allowed independent claims 48, 98 and 135, and their respective dependent claims. Claims 90, 91, 93-96, 108-121, 130 and 134 were rejected in view of newly applied prior art, while claims 92 and 97 were cited as including allowable subject matter.

There was also an obviousness-type double patenting rejection made of claim 48, based upon claim 1 of the '908 patent.

After Final Amendment

The Patent Owner filed an after final amendment, seeking to more substantially amend the claims. Also filed was a Terminal Disclaimer directed to the '908 patent, which was subsequently approved.

Advisory Action

The examiner refused entry of the Patent Owner's after final amendment, as changing the scope and requiring additional search and consideration.

Request for Continuing Examination

The Patent Owner filed an RCE, requesting entry of the previously submitted after final amendment.

The amendment canceled claims 91, 92, 108-121, 130 and 134. The features of canceled claim 92 were incorporated into independent claim 90.

Non-Final Rejection

The examiner allowed independent claims 48, 90 and 98, along with their respective dependent claims. Independent claim 135 and dependent claims 136-140 were rejected as indefinite under 35 U.S.C. § 112, second paragraph.

Amendment

The Patent Owner amended claims 135 to address the issue raised by the examiner; no other claims were amended.

Notice of Allowance

The examiner allowed independent claims 48, 90, 98 and 135, as well as their respective independent claims.

The examiner indicated the following reasons for allowance which are relevant to this reexamination proceeding:

Regarding claim 48 (which issued as claim 1), the prior art fails to teach:

“a user interface which is part of each of the units of the commodity, configured to provide a medium for two-way local interaction between one of the users and the corresponding unit of the commodity, and further configured to elicit, from a user, information about the user's perception of the commodity, and a memory within each of the units of the commodity capable of storing results of the two-way local interaction, the results including the elicited information about user perception of the commodity”

Regarding claim 135 (which issued as claim 69), the prior art fails to teach:

“eliciting user perceptions of respective units of the commodity through interactions at a user interface of the respective unit, and collecting and storing the received information at the remote database”

The Substantial New Question

At the time of allowance, the examiner cited clear reasons for allowance for independent claims 48 (issued claim 1) and 135 (issued claim 69), pointing out those features not taught in the prior art made of record during prosecution of the application.

Prior art which teaches or suggests these features would therefore raise a substantial new question of patentability.

Prior Art

The following prior art is cited by the Third Party Requester in alleging a substantial new question of patentability:

U.S. Patent 5,003,384 to Durden et al. (“**Durden**”)

U.S. Patent 5,077,582 to Kravette et al. (“**Kravette**”)

U.S. Patent 4,992,940 to Dworkin et al. (“**Dworkin**”) *

U.S. Patent 5,477,262 to Banker et al. (“**Banker**”)

U.S. Patent 5,956,505 to Manduley ("Manduley")

* Cited during prosecution of the '078 patent.

Proposed Substantial New Questions of Patentability

The Third Party Requester has requested reexamination of claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent, based upon the following allegations of a substantial new question or patentability based upon the following proposed rejections:

Issue 1: Claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 are anticipated under 35 U.S.C. § 102(b) by **Durden**.

Issue 2: Claims 1-7, 10, 15, 16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 are anticipated under 35 U.S.C. § 102(e) by **Kravette**.

Issue 3: Claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 are anticipated under 35 U.S.C. § 102(b) by **Dworkin**.

Issue 4: Claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 are anticipated under 35 U.S.C. § 102(e) by **Banker**.

Issue 5: Claims 1-7, 10, 15, 16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 are anticipated under 35 U.S.C. § 102(e) by **Manduley**.

Analysis

The examiner agrees that based upon the following analysis, the teachings of the cited prior art raises a substantial new question of patentability with regard to claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent.

Preliminary Issue: Claim Construction

The claims at issue in the '078 patent include some terms which require clarification in order to correctly analyze the prior art's applicability in determining a Substantial New Question of Patentability. In particular, the terms 'unit of a commodity' and 'user' will be considered.

Commodity

The term 'commodity' appears in the Abstract and the claims, but nowhere in the body of the specification.

A survey of the parent and other preceding applications shows that the term 'commodity' was first introduced in a preliminary amendment to the parent application, 09/370,663. The originally filed claims used the terms 'product', but a preliminary amendment filed concurrently with the application canceled the original claims and added new claims which used the term 'units of a commodity' in place of 'product'. The change in terminology from 'product' to 'units of a commodity' was therefore not necessitated in order to distinguish over prior art.

The independent claims of the '078 patent, for the most part, use the term 'units of a commodity'. The exception is independent claim 54, which uses the term 'units of a facsimile equipment'. Dependent claim 8 also includes the feature that the commodity is a facsimile machine. In light of these claims, 'facsimile equipment' is presumably one example of a commodity.

Dependent claim 6 includes the feature that the unit of a commodity comprises 'telephone extension equipment'. Claim 11 includes the feature that the unit of a commodity comprises 'consumer television equipment'. Claim 50 includes the feature that the commodity is a 'demonstration unit'.

In the Background of the Invention, the invention is characterized as a Customer-Based Product Design Module (see col. 2, line 22 et seq.), in which case the 'commodity'

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cited in the claims would equate to a 'product'. More generally, the claimed commodity is referred to in the Background variously as 'products, services and information systems' (see col. 1, lines 50-52), 'products and services' (see col. 2, line 25), and 'products, equipment, tools and toys' (col. 2, lines 46-49). A number of other examples are disclosed at col. 11, line 5 through col. 12, line 37.

Additionally, drawing Figure 1 comprises a flow chart of the Customer Design System (CDS), and includes the 'product or service' terminology.

Based upon this information, the term 'commodity' will be interpreted as a product or service, and a 'unit of a commodity' will be interpreted as a single instance of a product, or a single use of a service.

User

The term 'user' can be found throughout the claims and specification.

There is no explicit language in the specification which can be used to derive a definition, so the term should be given the ordinary meaning that the term would have to an ordinary artisan in the art in question at the time of the invention. "Absent an express intent to impart a novel meaning to a claim term, the words take on the

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ordinary and customary meanings attributed to them by those of ordinary skill in the art." *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 (Fed Cir. 2003).

In the context of the specification and claims, a 'user' would be understood by an ordinary artisan as a person who uses a product or service.

Issue 1: Durden

Durden does not raise a substantial new question of patentability with regard to claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent, for the reasons discussed below.

Durden teaches an impulse pay-per-view (IPPV) system, whereby in a cable television system, a subscriber is allowed to order a premium program (for which said subscriber is billed an additional amount) at the last minute (see col. 1, lines 6-16).

Durden discloses the fact that each subscriber in the cable system is provided with a set-top terminal (STT), and that each STT is equipped with an IPPV module which allows the subscriber to authorize his STT to receive a pay-per-view event, store the data associated with the purchase of that event in memory, and transmit that stored data to the cable operator via a telephone network (see col. 6, lines 43-62). **Durden**

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additionally discloses the use of a hand-held remote by the subscriber to communicate with the set-top terminal (see col. 11, line 66 through col. 12, line 2).

In the Request, it is alleged that **Durden** raises a Substantial New Question of Patentability of claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent, because **Durden** anticipates these claims under 35 U.S.C. § 102(b).

As discussed above, with regard to independent claim 1, a reference would have to teach the following features in order to raise an SNQ:

“a user interface which is part of each of the units of the commodity, configured to provide a medium for two-way local interaction between one of the users and the corresponding unit of the commodity, and further configured to elicit, from a user, information about the user's perception of the commodity, and a memory within each of the units of the commodity capable of storing results of the two-way local interaction, the results including the elicited information about user perception of the commodity”

Similarly, with regard to independent claim 69, a reference would have to teach the following features in order to raise an SNQ:

“eliciting user perceptions of respective units of the commodity through interactions at a user interface of the respective unit, and collecting and storing the received information at the remote database”

With respect to claim 1, the Requestor maps the set-top terminal (STT) disclosed by **Durden** to the claimed *unit of a commodity* (see page 36 of the Request).

The Requestor also maps the hand-held remote control disclosed in **Durden** to the claimed *user interface* (see page 37 of the Request).

The Requestor further maps **Durden's** disclosure of the subscriber's use of the hand-held remote control to authorize a purchase of a pay-per-view program to the claimed *eliciting, from a user, information about the user's perception of the commodity* (see pages 38 and 39 of the Request).

However, this mapping of features of **Durden** to claim 1 of the '078 patent does not support the Requester's alleged anticipation of the claim.

The Requestor has mapped the set-top terminal to the *unit of the commodity*, but mapped the selection of a desired pay-per-view program to *information about the user's perception of the commodity*.

The selection by a subscriber of a desired pay-per-view program reflects information about the subscriber's perception of content conveyed by the cable system through the set-top terminal, not the user's perception of the set-top terminal. In order to anticipate claim 1, **Durden** would have to disclose a user interface to elicit

information from the subscriber about the subscriber's perception of the set-top terminal.

The same analysis applies to the Requestor's proposed rejection of independent claim 69 of the '078 patent over **Durden** (see pages 66-75 of the Request).

The Requester's proposed rejection is actually analogous to the rejection made by the examiner in the first action during prosecution of the '078 patent. This rejection was successfully rebutted by the Patent Owner in their response (see Patent Owner's response, filed 29 September 2005, pages 26-27).

The rejection was based upon U.S. Patent 5,237,157 to **Kaplan**. **Kaplan** disclosed a music kiosk that included a user interface to allow a user to preview music and provide feedback in the form of a rating.

The Patent Owner successfully argued the following points:

1. If the examiner equated the music CDs with the units of the commodity, the rejection cannot be sustained, because the music CDs do not each contain a user interface; and

2. If the examiner equated the music kiosk with the unit of the commodity, the rejection cannot be sustained, because the user is providing feedback on their perception of the music CDs, and not on their perception of the music kiosk.

Regarding the system disclosed by **Kaplan**, the disclosed system could not anticipate the claimed invention, because the user was providing feedback on content being delivered by the unit of the commodity, and not on the unit of the commodity itself.

The rejections proposed by the Requestor based on **Durden** are analogously flawed, and cannot be sustained.

In light of these teachings, a reasonable examiner would not consider **Durden** important in deciding whether or not claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent are patentable. Therefore, **Durden** does not raise a substantial new question of patentability with respect to claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent.

Issue 2: Kravette

Kravette raises a substantial new question of patentability with regard to claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent, for the reasons discussed below.

Kravette teaches a system for monitoring paper processing devices, such as photocopiers (see Abstract). In accordance with the disclosed invention, photocopiers generate diagnostic signals when a malfunction is detected, or when maintenance such as toner or paper refill is required (see col. 4, lines 42-46). Said diagnostic signals are translated to a signal usable by an offsite end user to determine the condition of the photocopier (see col. 4, lines 50-55).

Upon receipt of a diagnostic signal a central station then dispatches a service person and informs the service person of the nature of the problem (see col. 9, lines 36-40). Each service person may be equipped with a portable hand held input/output device in the form of a keypad/display which may become part of the monitoring system through the use of an auxiliary input of the monitoring CPU (see col. 9, lines 41-44). The service person at the job site may also communicate with the central station through a modem by becoming part of the monitoring system through an input/output device; the service person would input his time of arrival at the job site, the work

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completed, parts replaced and needed, and the time of completion of the job (see col. 9, lines 49-55).

The central station may also communicate with the service person directly through the photocopier monitoring system (see col. 9, lines 59-67).

In the Request, it is alleged that **Kravette** raises a Substantial New Question of Patentability of claims 1-7, 10, 15, 16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent, because **Kravette** anticipates these claims under 35 U.S.C. § 102(e).

As discussed above, with regard to independent claim 1, a reference would have to teach the following features in order to raise an SNQ:

“a user interface which is part of each of the units of the commodity, configured to provide a medium for two-way local interaction between one of the users and the corresponding unit of the commodity, and further configured to elicit, from a user, information about the user's perception of the commodity, and a memory within each of the units of the commodity capable of storing results of the two-way local interaction, the results including the elicited information about user perception of the commodity”

Similarly, with regard to independent claim 69, a reference would have to teach the following features in order to raise an SNQ:

“eliciting user perceptions of respective units of the commodity through interactions at a user interface of the respective unit, and

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collecting and storing the received information at the remote database”

With respect to claim 1, the Requestor maps the photocopier disclosed by **Kravette** to the claimed *unit of a commodity* (see page 76 of the Request).

The Requestor also maps the portable hand held input/output device 34 disclosed in **Kravette** to the claimed *user interface* (see page 77 of the Request).

The Requestor further maps **Kravette's** disclosure of the service person's use of the portable hand held input/output device 34 to input and retrieve diagnostic and maintenance information from the monitoring system to the claimed *eliciting, from a user, information about the user's perception of the commodity* (see page 79 of the Request).

Three issues must be resolved with regard to this proposed rejection.

1. Does the service person disclosed by **Kravette** qualify as a 'user'?

Given the broad interpretation given the term 'user' as described above with respect to claim construction, the service person, 'using' the monitoring system to input and retrieve diagnostic data and service information (see col. 9, lines 14-20), as well as to communicate with the central station (see col. 9, lines 49-52), would qualify as a 'user'.

2. Does the user interface elicit information about the user's perception of the commodity?

Kravette discloses the service person providing input to the monitoring system regarding at least maintenance information, such as data related to recent service and data as to when certain copier parts were replaced (see col. 9, lines 14-20). The service person also inputs information regarding his time of arrival at the job site, the work completed, parts replaced and needed, and the time of completion of the job (see col. 9, lines 52-55).

Of this information disclosed by **Kravette** as being submitted by the service provider through portable hand held input/output device 34, *at least information regarding parts replaced and needed* would anticipate the claimed feature of 'information about the user's perception of the commodity', since this information about parts replaced and needed by the photocopier must be perceived by the service person.

3. Is the user interface 'part of each of the units of the commodity', as required by claim 1?

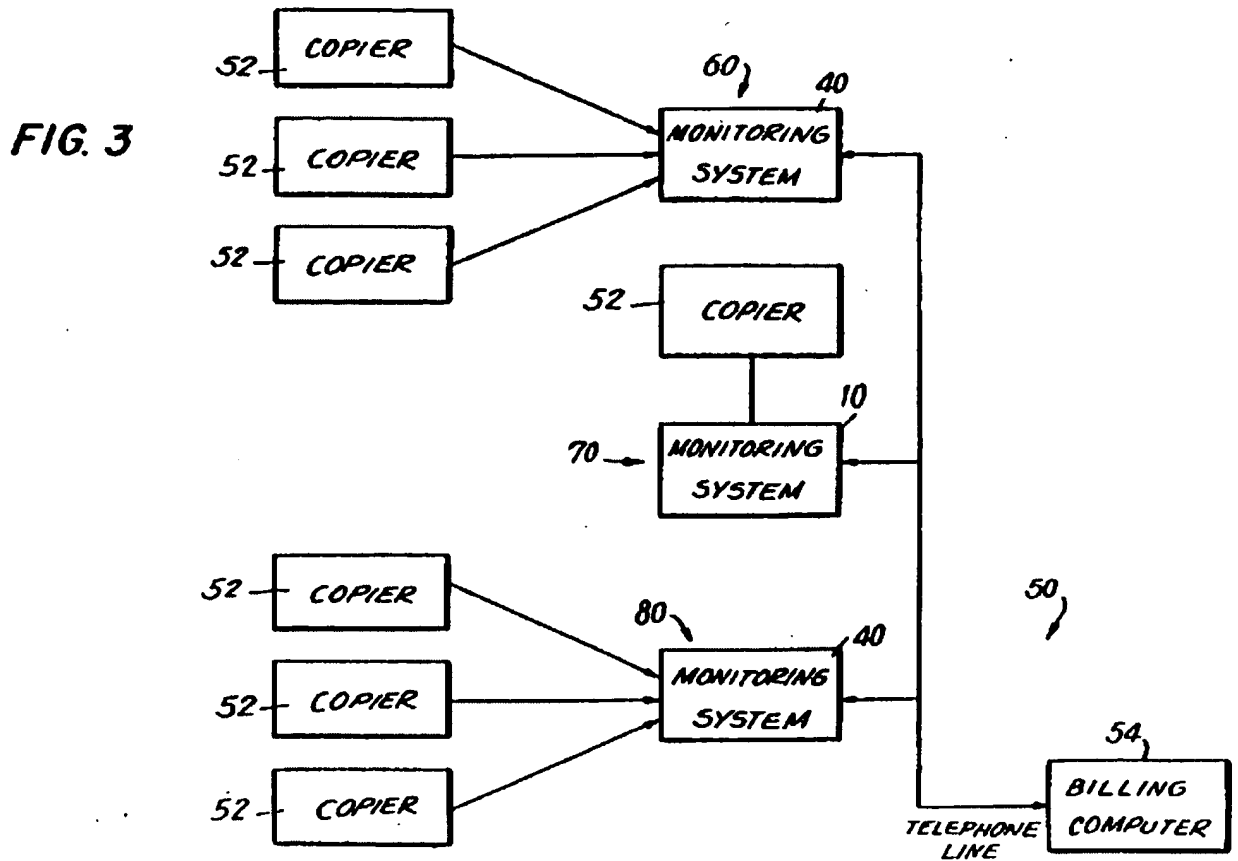
Throughout the specification and drawings of **Kravette**, the photocopier monitoring system 10 is depicted as separate from the photocopier. See, for example,

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drawing Figures 1, 2, 3 and 4. See also, for example, disclosure that Interface 12 of the photocopier monitoring system "receives signals from a copier (not shown)", col. 5, lines 12-13.

Given this disclosure, **Kravette** could not be relied upon to anticipate claim 1, since the portable hand held input/output device (the user interface) becomes part of the *monitoring system*, but elicits information from the user regarding the user's perceptions of the photocopier (the unit of the commodity); anticipation would require the user to input information regarding the user's perception of the *monitoring system*.

However, at col. 11, lines 1-4, **Kravette** discloses monitoring system 60, which includes a plurality of copiers 52 and a photocopier monitoring system 40. This is illustrated in drawing Figure 3:



When monitoring system 60 (encompassing both the photocopier monitoring system 40 and all attached copiers 52) is mapped to the claimed 'unit of the commodity', **Kravette** then anticipates claim 1, since the user interface becomes part of the unit of the commodity (the monitoring system 60), and elicits information regarding the user's perception of the unit of the commodity (since the copier is part of monitoring system 60).

In fact, **Kravette** additionally discloses a more analogous embodiment of the disclosed invention. **Kravette** discloses one embodiment where "...the entire monitoring system is manufactured internal to the photocopier to which it is to be applied" (see col. 15, lines 18-21). In this embodiment, the portable hand held input/output device (the user interface) becomes part of the photocopier (by virtue of becoming part of the monitoring system), and elicits information from the user regarding the user's perceptions of the photocopier, thus anticipating this feature of claim 1 of the '078 patent.

The same analysis applies to the Requestor's proposed rejection of independent claim 69 of the '078 patent over **Kravette** (see pages 108-116 of the Request).

Thus, with respect to independent claim 1, **Kravette** teaches those features which were cited by the examiner as reasons for allowance during prosecution of the '078 patent.

Kravette teaches a user interface which is part of each of the units of the commodity (see disclosure of the portable hand held input/output device 34 becoming part of the monitoring system 10, col. 9, lines 41-44; see also disclosure of an embodiment where the monitoring system is manufactured internal to the photocopier,

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col. 15, lines 18-21), configured to provide a medium for two-way local interaction between one of the users and the corresponding unit of the commodity, and further configured to elicit, from a user, information about the user's perception of the commodity (see disclosure that the service person can input time of arrival at the job site, the work completed, parts replaced and needed, and the time of completion of the job, col. 9, lines 52-55), and

a memory within each of the units of the commodity capable of storing results of the two-way local interaction, the results including the elicited information about user perception of the commodity (see disclosure that the diagnostic data of the photocopier can be stored in RAM 29, which can also store maintenance information, such as data related to recent service and data as to when certain copier parts were replaced, col. 9, lines 14-18).

With respect to independent claim 69, **Kravette** teaches those features which were cited by the examiner as reasons for allowance during prosecution of the '078 patent.

Kravette teaches eliciting user perceptions of respective units of the commodity through interactions at a user interface of the respective unit (see disclosure that the

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service person can input time of arrival at the job site, the work completed, parts replaced and needed, and the time of completion of the job, col. 9, lines 52-55), and collecting and storing the received information at the remote database (see disclosure that the service person can communicate with the central station by inputting his time of arrival, work completed, parts replaced and needed, and the time of completion of the job, col. 9, lines 49-55; see also disclosure that the billing or other computer at the central station sends a status inquiry signal to the monitoring system 10 to output the diagnostic data and maintenance information for storage on said billing or other computer, col. 9, lines 23-28).

In light of these teachings, there is a substantial likelihood that a reasonable examiner would consider **Kravette** important in deciding whether or not claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent are patentable.

The teachings of **Kravette** are new and non-cumulative with respect to the teachings of the prior art applied during the prosecution of the '078 patent. Furthermore, the teachings of **Kravette** have not been considered in a final holding of invalidity by a federal court. Accordingly, **Kravette** raises a substantial new question of patentability with regard to claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 that has not been decided in a previous examination.

Issue 3: Dworkin

Dworkin raises a substantial new question of patentability with regard to claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent, for the reasons discussed below.

Dworkin teaches an automated system for assisting a user in locating and purchasing products or services having desired characteristics, and also having the best available price (see col. 1, lines 63-65). The user tells the system the general type of product or service desired, and in response the system displays a template which gives various technical criteria for the product or service (see col. 2, lines 6-11). The user fills out entries on the template to define the minimum requirements for the product or service, and the system locates and displays information regarding products or services meeting these requirements (see col. 2, lines 11-18).

The system also allows the user to communicate complaints or suggestions to management or a particular supplier, or to receive help in using the system (see col. 2, lines 42-46; see also col. 4, lines 56-58; see also col. 10, lines 9-17).

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In the Request, it is alleged that **Dworkin** raises a Substantial New Question of Patentability of claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent, because **Dworkin** anticipates these claims under 35 U.S.C. § 102(b).

As discussed above, with regard to independent claim 1, a reference would have to teach the following features in order to raise an SNQ:

“a user interface which is part of each of the units of the commodity, configured to provide a medium for two-way local interaction between one of the users and the corresponding unit of the commodity, and further configured to elicit, from a user, information about the user's perception of the commodity, and a memory within each of the units of the commodity capable of storing results of the two-way local interaction, the results including the elicited information about user perception of the commodity”

Similarly, with regard to independent claim 69, a reference would have to teach the following features in order to raise an SNQ:

“eliciting user perceptions of respective units of the commodity through interactions at a user interface of the respective unit, and collecting and storing the received information at the remote database”

With respect to claim 1, the Requestor maps the terminals disclosed by **Dworkin** to the claimed *unit of a commodity* (see page 121 of the Request).

The Requestor also maps the main menu on the user's terminal disclosed in **Dworkin** to the claimed *user interface* (see page 122 of the Request).

The Requestor further maps **Dworkin's** disclosure of the user's selection of menu item 8 in order to communicate with management in order to submit complaints or offer suggestions for improvements to the claimed *eliciting, from a user, information about the user's perception of the commodity* (see pages 124-125 of the Request).

Under such an interpretation, **Dworkin** would fail to anticipate the relevant features of the '078 patent, because the claims require the system to elicit the user's information about their perception of *the commodity*, which in this case would be the terminal.

That being said, when the automated system for assisting a user in locating and purchasing desired products or services is interpreted as the unit of the commodity, **Dworkin would** anticipate the relevant features, since the disclosed complaints and suggestions (the elicited information) refer to the system, said system being the unit of the commodity.

The same analysis applies to the Requestor's proposed rejection of independent claim 69 of the '078 patent over **Dworkin** (see pages 154-160 of the Request).

Thus, with respect to independent claim 1, **Dworkin** teaches those features which were cited by the examiner as reasons for allowance during prosecution of the '078 patent.

Dworkin teaches a user interface which is part of each of the units of the commodity (see disclosure of the Main Menu, which is part of the automated system for assisting a user in locating and purchasing desired products or services, col. 4, lines 43-61; see also drawing Figure 3), configured to provide a medium for two-way local interaction between one of the users and the corresponding unit of the commodity, and further configured to elicit, from a user, information about the user's perception of the commodity (see disclosure of item number 8 of the Main Menu, which allows the user to communicate complaints or suggestions to management or a particular supplier, or to receive help in using the system, col. 2, lines 42-46; see also col. 4, lines 56-58; see also col. 10, lines 9-17), and

a memory within each of the units of the commodity capable of storing results of the two-way local interaction, the results including the elicited information about user perception of the commodity (see disclosure that the user-supplied communication, comprising complaints or suggestions, can be embodied in an electronic mail message,

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said electronic mail message inherently requiring memory for storage prior to transmission, col. 9, lines 9-12).

With respect to independent claim 69, **Dworkin** teaches those features which were cited by the examiner as reasons for allowance during prosecution of the '078 patent.

Dworkin teaches eliciting user perceptions of respective units of the commodity through interactions at a user interface of the respective unit (see disclosure of item number 8 of the Main Menu, which allows the user to communicate complaints or suggestions to management or a particular supplier, or to receive help in using the system, col. 2, lines 42-46; see also col. 4, lines 56-58; see also col. 10, lines 9-17), and

collecting and storing the received information at the remote database (see disclosure that the user-supplied communication, comprising complaints or suggestions, can be embodied in an electronic mail message transmitted to an electronic mailbox, col. 9, lines 9-12).

In light of these teachings, there is a substantial likelihood that a reasonable examiner would consider **Dworkin** important in deciding whether or not claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent are patentable.

The teachings of **Dworkin** are new and non-cumulative with respect to the teachings of the prior art applied during the prosecution of the '078 patent. **Dworkin** was cited during prosecution of the '078 patent, but was never applied in any claim rejections.

Furthermore, the teachings of **Dworkin** have not been considered in a final holding of invalidity by a federal court. Accordingly, **Dworkin** raises a substantial new question of patentability with regard to claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 that has not been decided in a previous examination.

Issue 4: Banker

Banker does not raise a substantial new question of patentability with regard to claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent, for the reasons discussed below.

Banker teaches an impulse pay-per-view (IPPV) system, whereby in a cable television system, a subscriber is allowed to order a premium program (for which said subscriber is billed an additional amount) at the last minute (see col. 12, lines 6-14).

Banker discloses the fact that each subscriber in the cable system is provided with a subscriber terminal 300, and that each subscriber terminal is equipped with an IPPV module which allows the subscriber to authorize his subscriber terminal to receive a pay-per-view event, store the data associated with the purchase of that event in memory, and transmit that stored data to the system operator via a telephone return path or radio frequency return path through the cable distribution system (see col. 12, lines 6-14).

In the Request, it is alleged that **Banker** raises a Substantial New Question of Patentability of claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent, because **Banker** anticipates these claims under 35 U.S.C. § 102(e).

However, the impulse pay-per-view system disclosed by **Banker** is analogous to the impulse pay-per-view system disclosed by **Durden** with respect to Issue 1 above.

As with the Requester's proposed rejection of claims 1 and 69 based on **Durden**, the Requester maps the subscriber terminals of **Banker** to the claimed 'units of the commodity' (see page 165 of the Request), and maps the selection of a pay-per-view program to the claimed 'eliciting from a user information about the user's perception of the commodity'.

As analogously discussed above regarding Issue 1 and **Durden**, the proposed rejection based on **Banker** cannot be supported, because the information elicited from the user is information regarding the user's perception of the content to be delivered by the IPPV system [the commodity], and not information regarding the user's perception of the IPPV system itself.

In light of these teachings, a reasonable examiner would not consider **Banker** important in deciding whether or not claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent are patentable. Therefore, **Banker** does not raise a substantial new question of patentability with respect to claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent.

Issue 5: Manduley

Manduley raises a substantial new question of patentability with regard to claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent, for the reasons discussed below.

Manduley teaches a method for activating an optional feature in a data processing device (see Abstract). The data processing device includes a display, keyboard and user interface software that allows a user to input data into the data processing device, and also allows the user to access application manager software which enables and controls access to the various applications resident in the data processing device (see col. 3, lines 41-44 and 57-65).

The data processing device includes a mechanism for allowing an authorized user to request activation of optional applications or features (see drawing Figures 3A through 3D; see also col. 5, line 2 through col. 7, line 39, and particularly col. 6, lines 1-8).

In the Request, it is alleged that **Manduley** raises a Substantial New Question of Patentability of claims 1-7, 10, 15, 16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent, because **Manduley** anticipates these claims under 35 U.S.C. § 102(e).

As discussed above, with regard to independent claim 1, a reference would have to teach the following features in order to raise an SNQ:

“a user interface which is part of each of the units of the commodity, configured to provide a medium for two-way local interaction between one of the users and the corresponding unit of the commodity, and further configured to elicit, from a user, information about the user's perception of the commodity, and

a memory within each of the units of the commodity capable of storing results of the two-way local interaction, the results including the elicited information about user perception of the commodity”

Similarly, with regard to independent claim 69, a reference would have to teach the following features in order to raise an SNQ:

“eliciting user perceptions of respective units of the commodity through interactions at a user interface of the respective unit, and collecting and storing the received information at the remote database”

With respect to claim 1, the Requestor maps the data processing devices disclosed by **Manduley** to the claimed *unit of a commodity* (see page 207 of the Request).

The Requestor also maps display 26 and keyboard 28 on the data processing devices disclosed in **Manduley** to the claimed *user interface* (see page 209 of the Request).

The Requestor further maps **Manduley's** disclosure of the user's request for activation of an optional application program or their various features to the claimed *eliciting, from a user, information about the user's perception of the commodity* (see page 210 of the Request).

The same analysis applies to the Requestor's proposed rejection of independent claim 69 of the '078 patent over **Manduley** (see pages 235-238 of the Request).

Thus, with respect to independent claim 1, **Manduley** teaches those features which were cited by the examiner as reasons for allowance during prosecution of the '078 patent.

Manduley teaches a user interface which is part of each of the units of the commodity (see disclosure of the data processing device [unit of the commodity] which includes a display, keyboard and user interface software [collectively, the user interface] that allows a user to input data into the data processing device, and also allows the user to access application manager software which enables and controls access to the various applications resident in the data processing device (see col. 3, lines 41-44 and 57-65), configured to provide a medium for two-way local interaction between one of the users and the corresponding unit of the commodity, and further configured to elicit, from a user, information about the user's perception of the commodity (see disclosure of the receipt of an optional application or feature activation request, col. 2, lines 63-67 et seq.), and

a memory within each of the units of the commodity capable of storing results of the two-way local interaction, the results including the elicited information about user

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perception of the commodity (see disclosure of the storage of request codes identifying the requested features and/or applications, as well as any required hardware, prior to transmission of the request to the data center, col. 6, lines 10-50 and 55-60).

With respect to independent claim 69, **Manduley** teaches those features which were cited by the examiner as reasons for allowance during prosecution of the '078 patent.

Manduley teaches eliciting user perceptions of respective units of the commodity through interactions at a user interface of the respective unit (see disclosure of the receipt of an optional application or feature activation request, col. 2, lines 63-67 et seq.), and

collecting and storing the received information at the remote database (see disclosure that the data center receives request codes from users or devices, col. 7, lines 40-45; see also disclosure that upon activation of the requested application or feature, the data center updates the customer's file to reflect activation of the requested programs or features and addition of any ordered hardware, col. 8, lines 18-21).

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In light of these teachings, there is a substantial likelihood that a reasonable examiner would consider **Manduley** important in deciding whether or not claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent are patentable.

The teachings of **Manduley** are new and non-cumulative with respect to the teachings of the prior art applied during the prosecution of the '078 patent.

Furthermore, the teachings of **Manduley** have not been considered in a final holding of invalidity by a federal court. Accordingly, **Manduley** raises a substantial new question of patentability with regard to claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 that has not been decided in a previous examination.

Conclusion

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 the patent owner 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).

The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 7,222,078 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 §§ 2207, 2282 and 2286.

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

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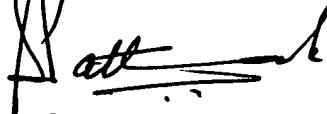
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Any inquiry concerning this communication should be directed to the Central Reexamination Unit at telephone number 571-272-7705.



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Art Unit 3992

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20 September 2011