



UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,638	08/12/2011	7620565	13557-105161.R2	5827
26980	7590	10/11/2011	EXAMINER	
McKeon Meunier Carlin & Curfman, LLC 817 West Peachtree Street Suite 900 Atlanta, GA 30308			WASSUM, LUKE S	
			ART UNIT	PAPER NUMBER
			3992	
			MAIL DATE	DELIVERY MODE
			10/11/2011	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.



UNITED STATES PATENT AND TRADEMARK OFFICE

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

DO NOT USE IN PALM PRINTER

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
KING & SPALDING LLP
P O BOX 889
BELMONT, CA 94002-0889

Date: **MAILED**
OCT 11 2011
CENTRAL REEXAMINATION UNIT

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

REEXAMINATION CONTROL NO. : 95000638
PATENT NO. : 7620565
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.

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

Control No.	Patent Under Reexamination
95/000,638	7620565
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: _____

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.

Transmittal of Communication to Third Party Requester Inter Partes Reexamination	Control No.	Patent Under Reexamination
	95/000,638	7620565
	Examiner	Art Unit
	LUKE S. WASSUM	3992

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

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.

DECISION GRANTING INTER PARTES REEXAMINATION

A substantial new question of patentability affecting claims 1-11, 13-15, 17-22 and 25-32 of U.S. Patent Number 7,620,565 is raised by the request for *inter partes* reexamination filed 12 August 2011. Claims 1-11, 13-15, 17-22 and 25-32 are subject to reexamination.

Prosecution History

U.S. Patent 7,620,565 ("the '565 patent") issued on 17 November 2009, from application number 11/509,701, filed 25 August 2006. The patent is a continuation of application 09/369,391, filed 6 August 1999, now U.S. Patent 7,133,834, which is 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 '565 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 44-51), 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 27-32). 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. 10, lines 10-20). One embodiment of the invention is illustrated in drawing Figure 2.

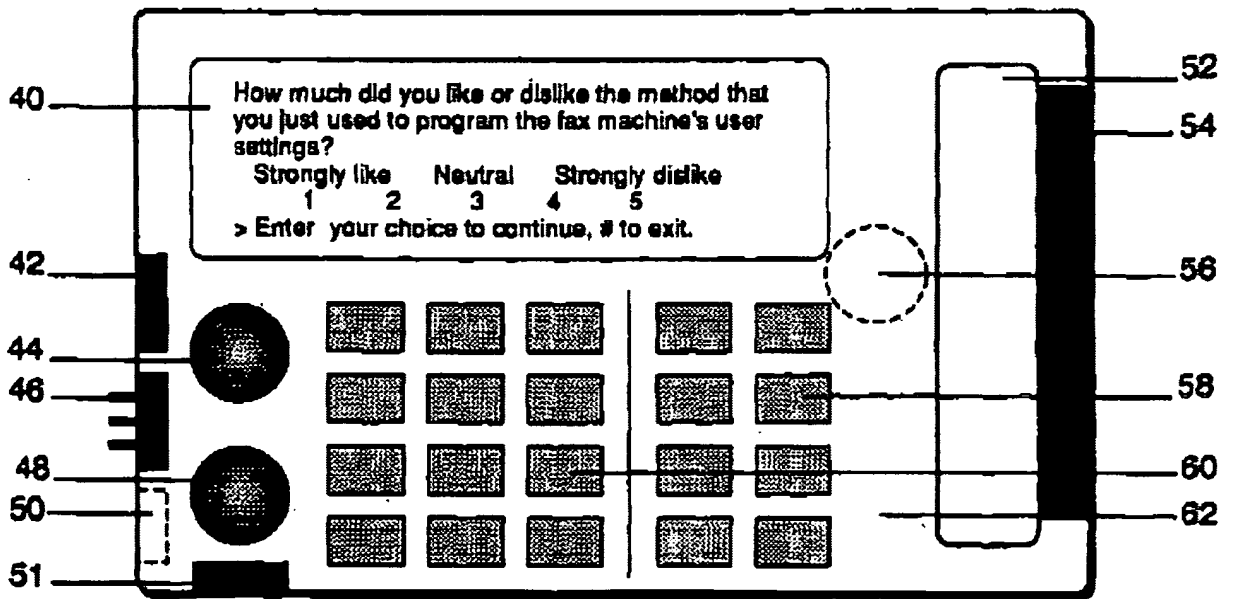


FIG. 2

Art Unit: 3992

The system allows customers and users to provide direct, on-task understanding of their use of the products and services, and their unfilled needs, to the product vendors, designers and developers (see col. 8, lines 23-26).

The CB-PD module includes pre-programmed trigger events. The module monitors the customer's use of the product for the occurrence of the trigger events, and upon detection, a counter for each specific trigger event is incremented. The actual trigger point occurs at specific instances when both the trigger increments the counter, and that counter reaches specific values (see col. 29, lines 49-65).

When a trigger point is reached, the CB-PD module requests the customer's participation in a Development Interaction (DI) (see col. 18, lines 18-29).

The As-Filed Application

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 48-71, including independent claims 48, 56, 60 and 65.

First Action

In the first Office action, the examiner rejected all claims on Double Patenting grounds as follows:

Art Unit: 3992

Claims 48-55 were rejected in view of claims 1 and 19-21 of U.S. Patent 7,222,078 ("the '078 patent").

Claims 56-59 were rejected in view of claim 1 of the '078 patent.

Claims 60-64 were rejected in view of claims 1, 19-21 and 69 of the '078 patent.

Claims 65-71 were rejected in view of claims 1-3, 5 and 19-21 of the '078 patent.

Additionally, claims 54, 63 and 70 were rejected under 35 U.S.C. § 112 first paragraph, as failing to comply with the written description requirement.

Claims 60 and 64 were rejected under 35 U.S.C. § 102, and claims 48-53, 55-59, 61, 62, 65-69 and 71 were rejected under 35 U.S.C. § 103.

First Amendment

In their response, the Patent Owner canceled claims 49, 56-59 and 65-71 and added new claims 72-91, of which 86 and 89 were independent. They also extensively amended the remaining claims. Also filed was a Terminal Disclaimer directed to the '078 patent, which was subsequently approved.

In addition, the Patent Owner presented arguments that the various rejections should be withdrawn in view of the amendments to the claims.

Art Unit: 3992

Notice of Allowance

After reaching agreement on an Examiner's Amendment to resolve a 101 issue regarding independent claim 89, the examiner allowed independent claims 48, 60, 86 and 89 (which issued as independent claims 1, 15, 27 and 30), as well as their respective dependent claims.

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

Regarding all 4 independent claims, the prior art fails to teach:

“causing the display of a user interface, configured to probe for information regarding a use of a product, based on a threshold-exceeding condition.”

The Substantial New Question

At the time of allowance, the examiner cited clear reasons for allowance for independent claims 48 (issued claim 1), 60 (issued claim 15), 86 (issued claim 27) and 89 (issued claim 30), 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 5,083,271 to Thacher et al. ("**Thacher**")

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

U.S. Patent 5,291,416 to Hutchins ("**Hutchins**")

None of the patents were cited during prosecution of the '565 patent.

Proposed Substantial New Questions of Patentability

The Third Party Requester has requested reexamination of claims 1-11, 13-15, 17-22 and 25-32 of the '565 patent, based upon the following allegations of a substantial new question or patentability based upon the following proposed rejections:

Art Unit: 3992

Issue 1: Claims 1-6, 8-11, 13-15, 17-19, 21, 22 and 25-32 are anticipated under 35

U.S.C. § 102(b) by **Durden**.

Issue 2: Claims 1-6, 8-11, 13-15, 17-19, 21, 22 and 25-32 are anticipated under 35

U.S.C. § 102(e) by **Kravette**.

Issue 3: Claims 1-6, 8-11, 13-15, 17-19, 21, 22 and 25-32 are anticipated under 35

U.S.C. § 102(e) by **Thacher**.

Issue 4: Claims 1-6, 8-11, 13-15, 17-19, 21, 22 and 25-32 are anticipated under 35

U.S.C. § 102(e) by **Manduley**.

Issue 5: Claims 1, 2, 5-10, 14, 15, 17-22 and 26-32 are anticipated under 35 U.S.C. §

102(e) by **Hutchins**.

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 1-11, 13-15, 17-22 and 25-32 of the '565 patent.

Preliminary Issue: Claim Construction

The claims at issue in the '565 patent include some terms which require clarification in order to correctly analyze the prior art's applicability in determining a

Art Unit: 3992

Substantial New Question of Patentability. In particular, the terms 'unit', 'information regarding a use of the product' and 'if the counter exceeds a threshold' will be considered.

Unit

The term 'unit' appears in independent claim 1 (and dependent claims). Therein, it is claimed that the unit comprises a memory, a transmitter and a processor configured to monitor a product.

Upon review of the specification of the '565 patent, the claimed unit appears to correspond to the disclosed CB-PD module.

For instance, at col. 18, lines 18-27, the '565 patent discloses

One of the product's features will be a CB-PD Module 14, which will include a custom Customer Design Instrument (CDI) specific for that product. As the Customer uses the product 16, pre-programmed trigger points are checked in the CB-PD Module 18. These trigger points may be initiated by the CB-PD Module or by the Customer. If a trigger point has not been reached, the Customer's use is not interrupted. If a trigger point is reached, the CB-PD Module requests the Customer's participation in a Development Interaction (DI) 20.

At col. 11, lines 38-56, the '565 patent discloses the components of a typical general purpose CB-PD module, including the claimed memory, a transmitter and a processor:

A CB-PD Module may have varied designs, to fit the functionality of each particular product or service. For a first example, consider a general purpose CB-PD Module. This would be a removable, self-contained module that could be either battery powered or receive its electricity from the product. It includes its own display or speaker for communicating with the Customer; its own keypad or microphone for the Customer to communicate with it; its own microprocessor and memory to run Customer Design Instruments (CDI), interact with the Customer and store the Aggregate Customer Desires (ACD) data that result from those interactions; its own interface to the product to receive signals of specific types of events (such as when the product is turned on and off, when certain product features are activated, etc.); its own means to communicate with the Vendor (such as by an internal modem to link to the telephone network, by a plug to connect to an interface unit like a bar code reader, by a removable chip that stores and carries the data to an external reader, etc.), etc.

At col. 21, lines 27-31 and 62-67, the '565 patent discloses that the CB-PD can be fully integrated with the product:

In cases where the product contains the means to perform some of these functions, as will be illustrated in another preferred embodiment, it may not be necessary to duplicate those features in that product's CB-PD Module.

Art Unit: 3992

The CB-PD Module in the facsimile machine 70 is therefore able to employ already existing product features 72, 74, 76, 78, 80, 82, 84 and may therefore merge them with the CB-PD Module to produce an integrated product design and integrated product/CB-PD Module operation. 65

In view of these disclosures, it is clear that the claimed 'unit' can be interpreted as being analogous to the disclosed CB-PD module for monitoring a user's actions while using the product, and furthermore that in some embodiments, the 'unit' may be integrated with and part of the product itself.

Information Regarding a Use of the Product

This term appears in independent claims 1, 15, 27 and 30 (and their respective dependent claims). This information is input into the system in response to the display of a user interface which probes the user for this information.

There is no explicit definition of this term in the specification of the '565 patent. The term is present in the specification, however.

For instance, at col. 4, lines 15-25, regarding Market Research, the patent discloses

Art Unit: 3992

15 Why doesn't market research provide greater understand-
ing? In market research, a variety of methodologies are used
to segment groups of customers and to show the preferences
and desires of the market segments. Typically, market
20 research focuses on gathering either quantitative data (such as
demographic information or numerical responses to surveys
and questionnaires) or qualitative data (such as from focus
groups). One of the main limitations of these research studies
is that they are usually separate from the customers' actual
25 and everyday use of the products and services being investi-
gated.

At col. 8, lines 23-26:

The customers and users provide
direct, on-task understanding of their use of the products and
25 services, and of their unfilled needs, to the product vendors,
designers and developers

At col. 23, lines 56-60:

An optional clock/calendar circuit 140 may be included to
provide a trigger for running Development Interactions (DI),
to stamp the time and date of each DI in the Aggregate
Customer Desires (ACD) file, to log the frequency of use of
the product or of certain features of it, etc. 60

At col. 42, lines 35-45:

Art Unit: 3992

35 Most of the time, when benchmarking probes are
employed in conjunction with the use of the product, these
would be triggered 282 as pre-use or post-use Development
Interactions (DI) 284; they would generally not be on-task
probes. For example, benchmarking probes 294 given at the
40 start of the use of a product 282 might help determine what the
Customers like about this product 294, what they like most
about competing products 294, and what might be improved
in this product (in the Vendor's prices, support policies, etc.)
45 to keep their company from purchasing competing products
294.

Since there does not seem to be any disclosure that would impose any significant
narrowing of the scope of the term, *information regarding a use of the product* will be
interpreted as any information related in any way to the manner in which a product is
used.

If the Counter Exceeds a Threshold

This qualifier is applied to the displaying of the user interface in independent
claims 1, 15, 27 and 30.

The display of the user interface in this context refers to the initiation of a
Development Interaction (DI), defined in the specification as "the actual event when a
Customer interacts with the Customer Directed Product (CDP)" (see col. 17, lines 7-9).

It is also disclosed at col. 25, lines 34-37 that the DI can be initiated by the system
or by the user:

Art Unit: 3992

With a combination of the speaker 190, microphone 192, display 182 and keypad 188 together, the CB-PD Module in this embodiment is capable of conducting a Development 35 Interaction (DI) with the Customer. This may be initiated by the Customer or by the CB-PD Module.

The claim language, including the "if the counter exceeds a threshold" language, is apparently intended to limit the claimed DI to a system-initiated DI. However, applying the broadest reasonable interpretation, this limitation merely states that the user interface is displayed if the counter exceeds a threshold.

The current claim language does not require the user interface to be displayed immediately upon the counter exceeding the threshold, nor does it require that the user interface *not* be displayed when the counter has not exceeded a threshold, since there is no claim language defining the case where the counter has not yet exceeded a threshold.

Thus, any display of a user interface configured to probe for information related to a use of the product which occurs after an event trigger counter exceeds a threshold would anticipate this feature of the claim.

Issue 1: Durden

Art Unit: 3992

Durden raises a substantial new question of patentability with regard to claims 1-11, 13-15, 17-22 and 25-32 of the '565 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** 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 1-6, 8-11, 13-15, 17-19, 21, 22 and 25-32 of the '078 patent, because **Durden** anticipates these claims under 35 U.S.C. § 102(b).

As discussed above, with regard to the independent claims 1, 15, 27 and 30, a reference would have to teach the following features in order to raise an SNQ:

Art Unit: 3992

“caus[ing] the display of a user interface configured to probe for information regarding a use of the product, if the counter exceeds a threshold”

The Requestor maps the set-top terminal (STT) disclosed by **Durden** to the claimed *unit* (see page 34 of the Request) and also to the claimed *product* (see page 36 of the Request).

The Requestor also maps the counter counting down until free time has elapsed disclosed in **Durden** to the claimed *monitor[ing] a product for an occurrence in the product of a trigger event of a plurality of trigger events* (see pages 36-37 of the Request).

The Requestor further maps **Durden's** disclosure of the hand-held remote control, STT and television to the claimed *user interface* (see page 38 of the Request).

Finally, the Requestor maps the subscriber's use of the hand-held remote to authorize the purchase of a pay-per-view program to the claimed *caus[ing] the display of a user interface configured to probe for information regarding the use of the product, if the counter exceeds a threshold* (see pages 38-40 of the Request).

With respect to independent claims 1, 15, 27 and 30, **Durden** teaches those features which were cited by the examiner as reasons for allowance during prosecution of the '565 patent.

For instance, **Durden** discloses the capability to provide a user with a user interface with which the user may authorize the purchase of a pay-per-view program (see col. 1, lines 15-17; see also col. 2, lines 23-27). The disclosed selection of a desired pay-per-view program is analogous to the claimed *information regarding a use of the product*, since the selection of a desired program indicates the user's intent to use the STT (the claimed *product*) to watch the selected pay-per-view program.

The display of the user interface can be initiated after the free time has expired (see col. 2, lines 50-55), analogous to the claimed *if the counter exceeds a threshold*.

In light of these teachings, there is a substantial likelihood that a reasonable examiner would consider **Durden** important in deciding whether or not claims 1-11, 13-15, 17-22 and 25-32 of the '565 patent are patentable.

The teachings of **Durden** are new and non-cumulative with respect to the teachings of the prior art applied during the prosecution of the '565 patent. Furthermore, the teachings of **Durden** have not been considered in a final holding of invalidity by a federal court. Accordingly, **Durden** raises a substantial new question of patentability with regard to claims 1-11, 13-15, 17-22 and 25-32 that has not been decided in a previous examination.

Issue 2: Kravette

Kravette raises a substantial new question of patentability with regard to claims 1-11, 13-15, 17-22 and 25-32 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

Art Unit: 3992

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 1-6, 8-11, 13-15, 17-19, 21, 22 and 25-32 of the '565 patent, because **Kravette** anticipates these claims under 35 U.S.C. § 102(e).

As discussed above, with regard to the independent claims 1, 15, 27 and 30, a reference would have to teach the following features in order to raise an SNQ:

“caus[ing] the display of a user interface configured to probe for information regarding a use of the product, if the counter exceeds a threshold”

The Requestor maps the computer control 16 disclosed by **Kravette** to the claimed *unit* (see page 81 of the Request). The Requestor also maps the paper processing device/copier to the claimed *product* (see page 83 of the Request).

The Requestor also maps the counter counting the number of papers processed by the copier disclosed in **Kravette** to the claimed *monitor[ing] a product for an occurrence*

Art Unit: 3992

in the product of a trigger event of a plurality of trigger events (see pages 83-84 of the Request).

The Requestor also maps the display device for visually displaying to the user the status of the device disclosed in **Kravette** to the claimed *user interface* (see page 85 of the Request).

The Requestor further maps **Kravette's** disclosure of a readable counter to display a total paper count value corresponding to the number of sheets of paper processed by the photocopier to the claimed *caus[ing] the display of a user interface configured to probe for information regarding the use of the product, if the counter exceeds a threshold* (see page 85 of the Request).

Given this mapping, **Kravette** could not be relied upon to anticipate independent claim 1, 15, 27 and 30, since there is no disclosure of the display device (the claimed user interface) probing for information regarding a use of the product. The display device is used only to display information, not to accept input information.

However, at col. 9, lines 14-21 and 41-55, **Kravette** discloses that a service person can input and retrieve data through the use of portable input/output device 34. When

Art Unit: 3992

attached to the system through the monitoring CPU, the portable input/output device becomes part of the system.

When portable input/output device 34 is mapped to the claimed *user interface*, **Kravette** then discloses a user interface which probes for information regarding the use of a product.

Thus, with respect to independent claims 1, 15, 27 and 30, **Kravette** teaches those features which were cited by the examiner as reasons for allowance during prosecution of the '565 patent.

Kravette teaches a user interface (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, col. 15, lines 18-21), configured to probe for information regarding the use of the product (see disclosure that the service person can input parts replaced and needed, information which gives an indication as to how often the copier is used, as well as which features of the copier are used more often, qualifying as the claimed *information regarding the use of the product*, col. 9, lines 52-55).

Furthermore, the user interface can be displayed when the counter has exceeded a threshold (see disclosure of the counter which transmits a count once a predetermined

Art Unit: 3992

number of papers have been processed, col. 2, line 67 through col. 3, line 3), analogous to the claimed *if the counter exceeds a threshold*.

In light of these teachings, there is a substantial likelihood that a reasonable examiner would consider **Kravette** important in deciding whether or not claims 1-11, 13-15, 17-22 and 25-32 of the '565 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 '565 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 1-11, 13-15, 17-22 and 25-32 that has not been decided in a previous examination.

Issue 3: Thacher

Thacher raises a substantial new question of patentability with regard to claims 1-11, 13-15, 17-22 and 25-32 of the '565 patent, for the reasons discussed below.

Art Unit: 3992

Thacher teaches a tournament system for multi-player electronic games (see Abstract). At the end of the game, the player's score is transmitted to a central computer and is stored (see col. 2, line 67 through col. 3, line 1). A validated player can enter his score manually on a keyboard associated with the video game (see col. 3, lines 3-5).

Also disclosed is the counting of 'men' or 'tries', which when exhausted, indicates the end of the game (see col. 11, lines 50-57).

In the Request, it is alleged that **Thacher** raises a Substantial New Question of Patentability of claims 1-6, 8-11, 13-15, 17-19, 21, 22 and 25-32 of the '565 patent, because **Thacher** anticipates these claims under 35 U.S.C. § 102(e).

As discussed above, with regard to the independent claims 1, 15, 27 and 30, a reference would have to teach the following features in order to raise an SNQ:

"caus[ing] the display of a user interface configured to probe for information regarding a use of the product, if the counter exceeds a threshold"

Art Unit: 3992

The Requestor maps the video game machine disclosed by **Thacher** to the claimed *unit* (see pages 119-120 of the Request) and also to the claimed *product* (see page 124 of the Request).

The Requestor also maps the counter counting the number of 'men' or 'tries' which will define the end of the game disclosed in **Thacher** to the claimed *monitor[ing] a product for an occurrence in the product of a trigger event of a plurality of trigger events* (see pages 122-123 of the Request).

The Requestor also maps the video game disclosed in **Thacher** to the claimed *user interface* (see page 124 of the Request).

The Requestor further maps **Thacher's** disclosure of the validated user's ability to manually enter his score on a keyboard associated with the video game to the claimed *caus[ing] the display of a user interface configured to probe for information regarding the use of the product, if the counter exceeds a threshold* (see page 124 of the Request).

With respect to independent claims 1, 15, 27 and 30, **Thacher** teaches those features which were cited by the examiner as reasons for allowance during prosecution of the '565 patent.

For instance, **Thacher** discloses the capability for a validated user to manually enter his score on a keyboard associated with the video game (see col. 3, lines 3-5). The

Art Unit: 3992

disclosed score information is analogous to the claimed *information regarding a use of the product*, since the score information relates information regarding the user's use of the product; the user has used the product to achieve the given score.

The entry of score information through the user interface can be initiated after the game has completed (see disclosure that score information is transmitted to the central computer at the end of the game, col. 2, line 67 through col. 3, line 1; see also disclosure that the system counts down the 'men' or 'tries' indicative of end of game conditions, col. 11, lines 50-57), analogous to the claimed *if the counter exceeds a threshold* (as described in the Request)

In light of these teachings, there is a substantial likelihood that a reasonable examiner would consider **Thacher** important in deciding whether or not claims 1-11, 13-15, 17-22 and 25-32 of the '565 patent are patentable.

The teachings of **Thacher** are new and non-cumulative with respect to the teachings of the prior art applied during the prosecution of the '565 patent. Furthermore, the teachings of **Thacher** have not been considered in a final holding of invalidity by a federal court. Accordingly, **Thacher** raises a substantial new question of patentability with regard to claims 1-11, 13-15, 17-22 and 25-32 that has not been decided in a previous examination.

Issue 4: Manduley

Manduley raises a substantial new question of patentability with regard to claims 1-11, 13-15, 17-22 and 25-32 of the '565 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).

Features of the data processing device can be activated on a temporary basis (col. 6, lines 15-17). When the feature is activated on a temporary basis, the user can be limited to a specific number of uses of the feature (see col. 8, line 63 through col. 9, line 10). Each time the user activates the feature, a usage counter is decremented (see col. 5, lines 45-49). When the usage counter is nearly exhausted, the data processing device can display a warning message to the user, along with instructions on how permanent or further temporary activation may be requested (see col. 9, lines 11-24).

Art Unit: 3992

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 1-6, 8-11, 13-15, 17-19, 21, 22 and 25-32 of the '565 patent, because **Manduley** anticipates these claims under 35 U.S.C. § 102(e).

As discussed above, with regard to the independent claims 1, 15, 27 and 30, a reference would have to teach the following features in order to raise an SNQ:

“caus[ing] the display of a user interface configured to probe for information regarding a use of the product, if the counter exceeds a threshold”

The Requestor maps the data processing device disclosed by **Manduley** to the claimed *unit* (see pages 159-160 of the Request) and also to the claimed *product* (see page 163 of the Request).

The Requestor also maps measuring the amount of permitted usage of the feature based on a quantity of usage disclosed in **Manduley** to the claimed *monitor[ing]*

Art Unit: 3992

a product for an occurrence in the product of a trigger event of a plurality of trigger events (see pages 161-162 of the Request).

The Requestor also maps the display and keyboard disclosed in **Manduley** to the claimed *user interface* (see page 162 of the Request).

The Requestor further maps **Manduley's** disclosure of the display of a warning message to the user when the quantity of usage of a temporarily activated feature will soon expire, along with the display of information on how the user can request either permanent or additional temporary activation of the feature, to the claimed *caus[ing] the display of a user interface configured to probe for information regarding the use of the product, if the counter exceeds a threshold* (see pages 163-164 of the Request).

With respect to independent claims 1, 15, 27 and 30, **Manduley** teaches those features which were cited by the examiner as reasons for allowance during prosecution of the '565 patent.

For instance, **Manduley** discloses 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). The disclosed activation request is analogous to the claimed *information regarding a*

Art Unit: 3992

use of the product, since the request is an indication that the user will use the activated feature of the product in the future.

The request for feature activation can be entered in response to the system's display of a warning message to the user when the quantity of usage of a temporarily activated feature will soon expire, along with the display of information on how the user can request either permanent or additional temporary activation of the feature (see disclosure that the system may display a warning message to the user when the quantity of usage of a temporarily activated feature will soon expire, as well as displaying information on how the user can request permanent or additional temporary activation of the feature, col. 9, lines 10-24), analogous to the claimed *if the counter exceeds a threshold*.

In light of these teachings, there is a substantial likelihood that a reasonable examiner would consider **Manduley** important in deciding whether or not claims 1-11, 13-15, 17-22 and 25-32 of the '565 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 '565 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

Art Unit: 3992

of patentability with regard to claims 1-11, 13-15, 17-22 and 25-32 that has not been decided in a previous examination.

Issue 5: Hutchins

Hutchins raises a substantial new question of patentability with regard to claims 1-11, 13-15, 17-22 and 25-32 of the '565 patent, for the reasons discussed below.

Hutchins teaches a system for providing event feedback for a machine tool (see Abstract). The system includes a local computer connected with one or more machine tools (see drawing Figure 1). The system generates 'significant event records' consisting of the event, date and time of the event (see col. 3, lines 4-7).

One type of event logged is an operator-initiated event (see col. 3, lines 16-27). The system provides a user interface so that the machine tool operator can direct the operation of the system (see col. 6, lines 30-43).

The local computer controls the execution of the machine tool through the running of specific machine tool part programs (see col. 14, lines 20-26). Execution of a program also includes the specification of the batch size (see col. 14, lines 27-29).

Art Unit: 3992

Program execution involves the use of a program counter and a batch counter. The program counter increments with each program step, until the program counter exceeds a threshold indicating completion of the program. The batch counter increments at the completion of each part program until a sufficient number of parts have been completed in accordance with the batch size (see col. 16, lines 2-24; see also drawing Figure 5).

In the Request, it is alleged that **Hutchins** raises a Substantial New Question of Patentability of claims 1, 2, 5-10, 14, 15, 17-22 and 26-32 of the '565 patent, because **Hutchins** anticipates these claims under 35 U.S.C. § 102(e).

As discussed above, with regard to the independent claims 1, 15, 27 and 30, a reference would have to teach the following features in order to raise an SNQ:

“caus[ing] the display of a user interface configured to probe for information regarding a use of the product, if the counter exceeds a threshold”

The Requestor maps the local computer connected to a machine tool disclosed by **Hutchins** to the claimed *unit* (see page 202 of the Request) and also to the claimed *product* (see page 206 of the Request).

Art Unit: 3992

The Requestor also maps the completion of each program step and the completion of a parts program disclosed in **Hutchins** to the claimed *monitor[ing] a product for an occurrence in the product of a trigger event of a plurality of trigger events* (see pages 203-204 of the Request).

The Requestor also maps computer user interface 14 disclosed in **Hutchins** to the claimed *user interface* (see page 206 of the Request).

The Requestor further maps **Hutchins'** disclosure of the computer user interface for accepting an operator-initiated event to the claimed *caus[ing] the display of a user interface configured to probe for information regarding the use of the product, if the counter exceeds a threshold* (see pages 206 of the Request).

With respect to independent claims 1, 15, 27 and 30, **Hutchins** teaches those features which were cited by the examiner as reasons for allowance during prosecution of the '565 patent.

For instance, **Hutchins** discloses a mechanism for allowing a user to submit operator-initiated events (see col. 3, lines 16-27). The disclosed operator-initiated events are analogous to the claimed *information regarding a use of the product*, since the operator-initiated event defines how the user is using the product.

Art Unit: 3992

The operator-initiated events can be entered after either the program counter has exceeded a threshold, or after a batch counter has exceeded a threshold (see col. 16, lines 3-24), analogous to the claimed *if the counter exceeds a threshold*.

In light of these teachings, there is a substantial likelihood that a reasonable examiner would consider **Hutchins** important in deciding whether or not claims 1-11, 13-15, 17-22 and 25-32 of the '565 patent are patentable.

The teachings of **Hutchins** are new and non-cumulative with respect to the teachings of the prior art applied during the prosecution of the '565 patent. Furthermore, the teachings of **Hutchins** have not been considered in a final holding of invalidity by a federal court. Accordingly, **Hutchins** raises a substantial new question of patentability with regard to claims 1-11, 13-15, 17-22 and 25-32 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.

Art Unit: 3992

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

By EFS-Web: Registered Users may submit correspondence via EFS-Web, at <https://efs.uspto.gov/efile/myportal/efs-registered>.

By Mail to: Mail Stop *Inter Partes* Reexam
Central Reexamination Unit
Commissioner for 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 Street
Alexandria, VA 22314

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 submission after the "soft scanning" process is complete.

Art Unit: 3992

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



Luke S. Wassum
Primary Examiner
Art Unit 3992

Conferees:

Demul Repor. SE AU 3992



lsw
3 October 2011