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EXAMINER	
WASSUM, LUKE S	

ART UNIT	PAPER NUMBER
3992	

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

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

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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.

OFFICE ACTION IN 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. --

Responsive to the communication(s) filed by:
Patent Owner on _____
Third Party(ies) on 12 August, 2011

RESPONSE TIMES ARE SET TO EXPIRE AS FOLLOWS:

For Patent Owner's Response:
2 MONTH(S) from the mailing date of this action. 37 CFR 1.945. EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.956.
For Third Party Requester's Comments on the Patent Owner Response:
30 DAYS from the date of service of any patent owner's response. 37 CFR 1.947. NO EXTENSIONS OF TIME ARE PERMITTED. 35 U.S.C. 314(b)(2).

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

This action is not an Action Closing Prosecution under 37 CFR 1.949, nor is it a Right of Appeal Notice under 37 CFR 1.953.

PART I. THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

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

PART II. SUMMARY OF ACTION:

1a. ☒ Claims 1-11, 13-15, 17-22 and 25-32 are subject to reexamination.
1b. ☒ Claims 12, 16, 23 and 24 are not subject to reexamination.
2. ☐ Claims _____ have been canceled.
3. ☒ Claims 7,13,20 and 25 are confirmed. [Unamended patent claims]
4. ☐ Claims _____ are patentable. [Amended or new claims]
5. ☒ Claims 1-6, 8-11, 14, 15, 17-19, 21, 22 and 16-32 are rejected.
6. ☐ Claims _____ are objected to.
7. ☐ The drawings filed on _____ ☐ are acceptable ☐ are not acceptable.
8. ☐ The drawing correction request filed on _____ is: ☐ approved. ☐ disapproved.
9. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119 (a)-(d). The certified copy has: ☐ been received. ☐ not been received. ☐ been filed in Application/Control No 95000638.
10. ☐ Other _____

Transmittal of Communication to Third Party Requester Inter Partes Reexamination	Control No.	Patent Under Reexamination
	95/000,638	7620565
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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.

DETAILED ACTION

Inter Partes Reexamination

This Office action addresses claims 1-11, 13-15, 17-22 and 25-32 of U.S. Patent Number 7,620,565, subject to reexamination in accordance with the accompanying Order Granting Inter Partes Reexamination.

Prior Art

The following prior art raises a Substantial New Question of Patentability, as discussed in the Order Granting Inter Partes Reexamination:

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**")

Relevant Statutes

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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

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

Proposed Rejections

The Third Party Requestor has proposed the following rejections of claims 1-11, 13-15, 17-22 and 25-32 of the '565 patent:

1. The request proposes that 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**.

2. The request proposes that 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**.

3. The request proposes that 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**.

4. The request proposes that 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**.

5. The request proposes that claims 1, 2, 5-10, 14, 15, 17-22 and 26-32 are anticipated under 35 U.S.C. § 102(e) by **Hutchins**.

The proposed rejections 1-5 are **adopted**, as modified, for the reasons set forth below.

Claim Rejections - 35 USC § 102

Claims 1, 3-5, 14, 15, 17, 26-28, 30 and 31 are anticipated under 35 U.S.C. § 102(b) by **Durden**.

The Third Party Requestor has provided a detailed analysis and mapping of the features of **Durden** to the claim elements of the '565 patent (see Request, pages 34-80, as well as Exhibit CC-A). The Requestor's analysis and rationale for rejection of claims 1, 3-5, 14, 15, 17, 26-28, 30 and 31 is adopted by the examiner and is incorporated by reference, with the following modifications.

The Requestor's proposed rejections of claims 2, 6, 8-11, 13, 18, 19, 21, 22, 25, 29 and 32 are **not adopted**.

Regarding claim 2, the Requestor maps the request for a pay-per-view event or an impulse pay-per-view event (see col. 6, lines 43-48) to the claimed *request to schedule maintenance* (see Request, page 42, as well as Exhibit CC-A, pages 8-9).

Within the specification of the '565 patent, the most relevant disclosure concerning a request for scheduled maintenance is in col. 41, at lines 45-53:

> 7. Interactive Services and Transactions
> Interactive communications like those described in the On-line Customer Support (OCS) feature may be extended to providing other services and to conducting transactions:
> Interactive services: For example, Customers may is request a variety of services such as scheduling a product maintenance appointment, requesting that another copy of the product's manual be sent, or asking to have a salesperson contact them about a possible future order

Clearly, the subscriber's request to purchase a pay-per-view program does not anticipate the claimed request to schedule maintenance. **Durden** does not disclose any feature which is analogous to the claimed request to schedule maintenance.

The Requestor's proposed rejection of claim 2 in view of **Durden** is **not adopted**.

Regarding claim 4, the Requestor maps the programming guide (see col. 12, lines 11-12) to the claimed *request for interactive assistance* (see Request, page 44, as well as Exhibit CC-A, page 10).

Within the specification of the '565 patent, the most relevant disclosure concerning a request for interactive assistance is in col. 32, lines 62 through col. 33, line 5:

> Help or On-line Customer Support (OCS) (this button, icon or trigger enables the Customer to report problems on-line to a vendor; a variety of uses for an OCS button are possible, such as (1) Problem Reports (PR) inform product designers about Customer problems, (2) OCS Requests provide immediate notices to the Vendor's customer service staff about Customer problems, and (3) receiving interactive Customer Support on-line, with a passive report generated that itemizes what support was needed, so the Vendor gains a clear understanding of Customer problems).

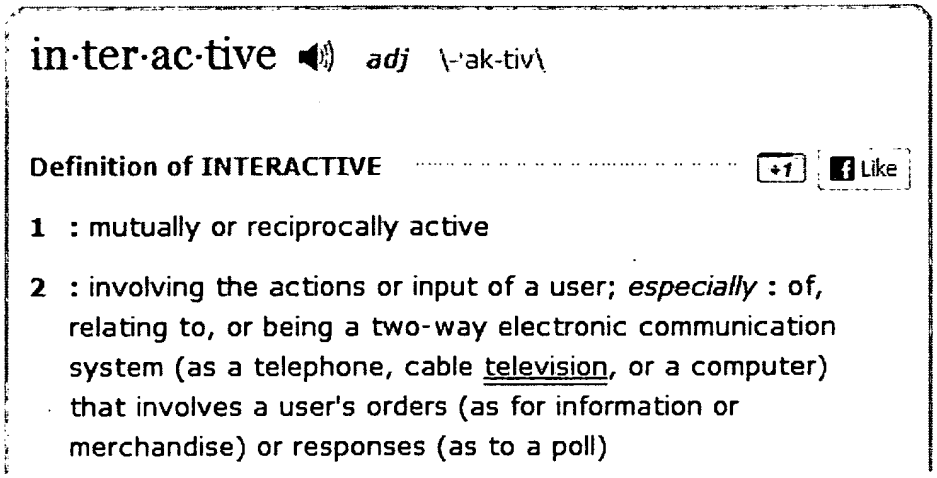
Also relevant is the disclosure of col. 40, line 43 through col. 41, line 29:

6.B. On-Line Customer Support (OCS) Requests

On-line Customer Support (OCS) Requests, on the other hand, may be more immediate and responsive. If the Customer Directed Product (CDP) has a means of communications (such as the facsimile machine **70** in FIG. **3** or the CB-PD Module in **120** FIG. **5**) the last function, On-line Customer Support (OCS) Requests, may be used to replace some types of initial Customer telephone calls into a Vendor's customer service department. In brief, the Customer issues an On-line Customer Support (OCS) Request **282** (such as by pressing a Help button or command, or by an On-line Customer Support (OCS) button or command). If Help is requested, a menu is displayed **284** with the OCS Request feature as one choice **284**. If On-line Customer Support (OCS) is requested then the user interface is more direct. Regardless of the steps involved, when the Customer selects this choice, a passive probe **291** reads the available product data **292** and writes the available information **292** about the Customer's current uses of the product and its configuration. An On-line Customer Support (OCS) Customer Design Instrument (CDI) then provides the first Customer Probe (CP) **294**, reads the Customer input **296** and writes the input as a record **304**. After the Customer completes the On-line Customer Support (OCS) Request **306** a thank you message is displayed **308**.

> By pressing a "transmit" function **312**, perhaps one with an "urgent transmissions code or phone number, this data is immediately sent **336** to the Vendor's computer. There, if a correct on-line response is available it may be downloaded immediately to the customer's product along with any new trigger event parameters needed (in the event any of them need to be modified, such as the frequency count of interactions before firing as a trigger). The next time that trigger fires (whether Vendor Initiated or Customer Initiated), the On-line Customer Support reply may be displayed to assist the Customer. Alternatively, if there is not an on-line solution, the an appropriate message is sent to the customer based on the action the vendor plans to take, along with any new trigger event parameters needed so the customer receives the message at an appropriate time during use.
>
> If there is not an appropriate on-line solution to download to the customer's product, the urgent transmission code enables the customer's On-line Customer Support (OCS). Request to be routed **336** to the Vendor's customer support staff via its internal E-mail system or by another means. There, a customer support employee may use the On-Line Customer Support (OCS) Request information from this Customer Directed Product (CDP) to research the problem and phone the Customer rapidly, providing early support to Customers if that is desired. That solution may also be placed on-line, ready for downloading the next time a similar On-line Customer Support (OCS) Request arrives at the vendor's computer. Thus, the actual receipt of these requests prompts the evolution of user-appropriate on-line support.

There is no explicit definition of the term *interactive assistance* nor of the term *interactive* in the '565 patent. However, Merriam-Webster defines the term 'interactive' as follows:



in·ter·ac·tive adj \-'ak-tiv\

Definition of INTERACTIVE

+1 Like

1 : mutually or reciprocally active

2 : involving the actions or input of a user; *especially* : of, relating to, or being a two-way electronic communication system (as a telephone, cable television, or a computer) that involves a user's orders (as for information or merchandise) or responses (as to a poll)

In light of this information, the disclosed programming guide would anticipate the claimed *interactive assistance,* since the subscriber inputs requests/searches and the programming guide responds in accordance with the subscriber's requests/searches, thereby assisting the subscriber in purchasing desired programs.

Regarding claim 6, the Requestor maps the free time counters resident in memory (see col. 12, lines 47-54) to the claimed *caus[ing] the memory to store the second counter* (see Request, page 46, as well as Exhibit CC-A, page 11).

Additionally, the Requestor maps the transmission of data associated with the purchase of a pay-per-view program to the cable operator (see col. 6, lines 57-61) to the claimed *cause the transmitter to transmit a value of the second counter* (see Request, pages 46-47; see also Exhibit CC-A, page 12).

However, the free time counters track the amount of free time remaining for a given pay-per-view channels, and are independent of the information that would need to be transmitted to the cable operator in order for the purchase of a pay-per-view program to be carried out. For instance, the examiner notes **Durden's** disclosure that upon purchase, information associated with the impulse pay-per-view program purchased by the subscriber is transmitted to the system manager or other control computer, and that the data includes the event ID and the time of purchase (see col. 9, lines 14-20).

The Requestor's proposed rejection of claim 6 in view of **Durden** is **not adopted**.

Regarding claim 8 (and dependent claim 9), the Requestor maps the unsuccessful attempt by the IPPV system to dial into the telephone network in order to report events to the system manager (see col. 12, lines 64 through col. 13, line 36) to the claimed *wherein one of the predefined plurality of trigger events is a problem associated with the product.* (see Request, page 47; see also Exhibit CC-A, page 12).

However, with respect to parent claim 1, the Requestor has previously mapped the free time counter decrementing (see col. 10, lines 47-49) to the claimed *trigger events* (see Request, pages 36-38; see also Exhibit CC-A, pages 3-4).

There is no also disclosure of **Durden's** disclosed unsuccessful attempts to report events to the system manager being tracked by incrementing a counter, as required by parent claim 1.

In view of this analysis, the detection of an unsuccessful attempt to report events to the system manager cannot anticipate the claimed *wherein one of the predefined plurality of trigger events is a problem associated with the product.*

The Requestor's proposed rejection of claims 8 and 9 in view of **Durden** is **not adopted**.

Regarding claim 10 (and dependent claim 11), the Requestor maps the subscriber's use of the hand-held remote control (see col. 11, line 68 through col. 12, line 2) to the claimed *wherein the trigger event of the predefined plurality of trigger events is a use of at least one product feature* (see Request, page 49; see also Exhibit CC-A, page 13).

However, with respect to parent claim 1, the Requestor has mapped the free time counter decrementing (see col. 10, lines 47-49) to the claimed *trigger events* (see Request, pages 36-38; see also Exhibit CC-A, pages 3-4). The Requestor has also previously mapped the subscriber's use of the hand-held remote control with the claimed *prob[ing] for information regarding the use of the product* (see Request, page 38; see also Exhibit CC-A, page 5).

There is no also disclosure of the subscriber's use of the hand-held remote control being tracked by incrementing a counter, as required by parent claim 1.

In view of this analysis, the subscriber's use of the hand-held remote control cannot anticipate the claimed *wherein the trigger event of the predefined plurality of trigger events is a use of at least one product feature.*

The Requestor's proposed rejection of claims 10 and 11 in view of **Durden** is **not adopted**.

Regarding claim 13, the Requestor maps the subscriber's module/set top terminal (see col. 3, lines 3-11) to the claimed *wherein the product is a cellular telephone* (see Request, page 50; see also Exhibit CC-A, page 14).

While **Durden's** set top terminal (previously mapped by the Requestor to the claimed *product*; see Request, page 36; see also Exhibit CC-A, page 3) does indeed include IPPV Module 20 which communicates with System Manager 8 via a Telephone Network 24 (see drawing Figure 1 et seq.), the set top terminal clearly cannot reasonably be interpreted as embodying a telephone, let alone a cellular telephone.

For instance, the set top terminal "allows the subscriber to tune and descramble the services that he has requested from the cable system operator" (see col. 6, lines 43-48). A cellular telephone does not have these capabilities.

In view of this analysis, the set top terminal cannot anticipate the claimed *wherein the product is a cellular telephone.*

The Requestor's proposed rejection of claim 13 in view of **Durden** is **not adopted**.

Regarding claim 18, the Requestor maps the free time counters resident in memory (see col. 12, lines 47-54) to the claimed *storage of the second counter in memory* (see Request, page 59, as well as Exhibit CC-A, page 21).

Additionally, the Requestor maps the transmission of data associated with the purchase of a pay-per-view program to the cable operator (see col. 6, lines 57-61) to the claimed *transmitting a value of the second counter to the server* (see Request, page 59; see also Exhibit CC-A, page 21).

However, the free time counters track the amount of free time remaining for a given pay-per-view channels, and are independent of the information that would need to be transmitted to the cable operator in order for the purchase of a pay-per-view program to be carried out. For instance, the examiner notes **Durden's** disclosure that upon purchase, information associated with the impulse pay-per-view program purchased by the subscriber is transmitted to the system manager or other control

computer, and that the data includes the event ID and the time of purchase (see col. 9, lines 14-20).

The Requestor's proposed rejection of claim 18 in view of **Durden** is **not adopted**.

Regarding claim 19 (and dependent claim 21), the Requestor maps the unsuccessful attempt by the IPPV system to dial into the telephone network in order to report events to the system manager (see col. 12, lines 64 through col. 13, line 36) to the claimed *wherein one of the predefined plurality of trigger events is a problem associated with the product* (see Request, page 60; see also Exhibit CC-A, page 22).

However, with respect to parent claim 15, the Requestor has previously mapped the free time counter decrementing (see col. 10, lines 47-49) to the claimed *trigger events* (see Request, pages 52-54; see also Exhibit CC-A, pages 15-17).

There is no also disclosure of **Durden's** disclosed unsuccessful attempts to report events to the system manager being tracked by incrementing a counter, as required by parent claim 15.

In view of this analysis, the detection of an unsuccessful attempt to report events to the system manager cannot anticipate the claimed *wherein one of the predefined plurality of trigger events is a problem associated with the product.*

The Requestor's proposed rejection of claims 19 and 21 in view of **Durden** is **not adopted**.

Regarding claim 22, the Requestor maps the subscriber's use of the hand-held remote control (see col. 11, line 68 through col. 12, line 2) to the claimed *wherein the trigger event of the predefined plurality of trigger events is a use of at least one product feature* (see Request, page 62; see also Exhibit CC-A, page 23).

However, with respect to parent claim 15, the Requestor has mapped the free time counter decrementing (see col. 10, lines 47-49) to the claimed *trigger events* (see Request, pages 52-54; see also Exhibit CC-A, pages 15-17). The Requestor has also previously mapped the subscriber's use of the hand-held remote control with the claimed *prob[ing] for information regarding the use of the product* (see Request, page 54; see also Exhibit CC-A, pages 16-17).

There is no also disclosure of the subscriber's use of the hand-held remote control being tracked by incrementing a counter, as required by parent claim 15.

In view of this analysis, the subscriber's use of the hand-held remote control cannot anticipate the claimed *wherein one of the predefined plurality of trigger events is a use of at least one product feature.*

The Requestor's proposed rejection of claim 22 in view of **Durden** is **not adopted**.

Regarding claim 25, the Requestor maps the subscriber's module/set top terminal (see col. 3, lines 3-11) to the claimed *wherein the product is a cellular telephone* (see Request, page 62; see also Exhibit CC-A, page 23).

While **Durden's** set top terminal (previously mapped by the Requestor to the claimed *product*; see Request, page 52; see also Exhibit CC-A, page 15) does indeed include IPPV Module 20 which communicates with System Manager 8 via a Telephone Network 24 (see drawing Figure 1 et seq.), the set top terminal clearly cannot reasonably be interpreted as embodying a telephone, let alone a cellular telephone.

For instance, the set top terminal "allows the subscriber to tune and descramble the services that he has requested from the cable system operator" (see col. 6, lines 43-48). A cellular telephone does not have these capabilities.

In view of this analysis, the set top terminal cannot anticipate the claimed *wherein the product is a cellular telephone.*

The Requestor's proposed rejection of claim 25 in view of **Durden** is **not adopted**.

Regarding claim 29, the Requestor maps the free time counters resident in memory (see col. 12, lines 47-54) to the claimed *storing the second counter on the device* (see Request, page 72, as well as Exhibit CC-A, page 31).

Additionally, the Requestor maps the transmission of data associated with the purchase of a pay-per-view program to the cable operator (see col. 6, lines 57-61) to the claimed *transmitting a value of the second counter to the server* (see Request, page 72; see also Exhibit CC-A, page 31).

However, the free time counters track the amount of free time remaining for a given pay-per-view channels, and are independent of the information that would need to be transmitted to the cable operator in order for the purchase of a pay-per-view program to be carried out. For instance, the examiner notes **Durden's** disclosure that upon purchase, information associated with the impulse pay-per-view program purchased by the subscriber is transmitted to the system manager or other control computer, and that the data includes the event ID and the time of purchase (see col. 9, lines 14-20).

The Requestor's proposed rejection of claim 29 in view of **Durden** is **not adopted**.

Regarding claim 32, the Requestor maps the free time counters resident in memory (see col. 12, lines 47-54) to the claimed *means for storing the second counter on the device* (see Request, page 80, as well as Exhibit CC-A, page 38).

Additionally, the Requestor maps the transmission of data associated with the purchase of a pay-per-view program to the cable operator (see col. 6, lines 57-61) to the claimed *means for transmitting the value of the second counter to the server* (see Request, page 80; see also Exhibit CC-A, page 38).

However, the free time counters track the amount of free time remaining for a given pay-per-view channels, and are independent of the information that would need to be transmitted to the cable operator in order for the purchase of a pay-per-view program to be carried out. For instance, the examiner notes **Durden's** disclosure that upon purchase, information associated with the impulse pay-per-view program purchased by the subscriber is transmitted to the system manager or other control computer, and that the data includes the event ID and the time of purchase (see col. 9, lines 14-20).

The Requestor's proposed rejection of claim 32 in view of **Durden** is **not adopted**.

Claims 1-6, 8-10, 14, 15, 17-19, 21, 22 and 26-32 are anticipated under 35 U.S.C. § 102(e) by **Kravette**.

The Third Party Requestor has provided a detailed analysis and mapping of the features of **Kravette** to the claim elements of the '565 patent (see Request, pages 80-119, as well as Exhibit CC-B). The Requestor's analysis and rationale for rejection of claims 1-6, 8-10, 14, 15, 17-19, 21, 22 and 26-32 is adopted by the examiner and is incorporated by reference, with the following modifications.

The Requestor's proposed rejections of claims 11, 13 and 25 are **not adopted**.

Regarding independent claim 1 (and dependent claims), the Requestor maps the display of diagnostic and monitoring signals on a visual display device (see col. 12, lines 21-24) to the claimed *caus[ing] the display of a user interface configured to probe for information regarding the use of a product* (see Request, page 85; see also Exhibit CC-B, pages 5-6).

However, there is no disclosure of the visual display device (the claimed *user interface*) probing for information regarding the use of a product. The visual display device is used only to display information, not to accept input information regarding the use of the product (see col. 4, lines 38-42; see also col. 8, lines 29-41).

The examiner instead maps portable hand-held input-output device 34, usable by the service person (see col. 9, lines 14-20 and 41-49), to the claimed *user interface*. The portable hand-held input-output device 34 is 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 counts the number of papers processed, col. 2, line 67 through col. 3, line 3), analogous to the claimed *if the counter exceeds a threshold*.

When portable input/output device 34 is mapped to the claimed *user interface*, **Kravette** then discloses the claimed *caus[ing] the display of a user interface which probes for information regarding the use of a product if the counter exceeds a threshold.*

Regarding claim 2, the Requestor maps **Kravette's** disclosure of a service person's ability to use portable input/output device 34 to communicate with the central station (see col. 9, lines 49-52) to the claimed *wherein the input reflects a request to schedule maintenance* (see Request, page 87; see also Exhibit CC-B, page 8).

The Requestor also maps the generation of a signal which causes the photocopier to display maintenance requirements (see col. 4, lines 42-46) to claim 2, but the signals which drive the photocopier display are automatically generated from within the photocopier, and not received through the user interface as required by parent claim 1.

The examiner instead maps **Kravette's** disclosure that the service person can input parts replaced and needed through portable input/output device 34 (see col. 9, lines 52-55) to the claimed *wherein the input reflects a request to schedule maintenance,* the disclosed 'input of parts needed' anticipating the claimed *request to schedule maintenance.*

Regarding claim 3, the Requestor maps the internally generated signals which drive the display device to cause the photocopier to report maintenance requirements (see col. 4, lines 42-46) to the claimed *wherein the input reflects a submission of a purchase order* (see Request, page 88; see also Exhibit CC-B, page 8).

However, the signals which drive the photocopier display and report maintenance requirements are automatically generated from within the photocopier, and not received through the user interface as required by parent claim 1.

The examiner instead maps **Kravette's** disclosure that the service person can input parts replaced and needed through portable input/output device 34 (see col. 9, lines 52-55) to the claimed *wherein the input reflects a submission of a purchase order,* the

disclosed 'input of parts needed' anticipating the claimed *purchase order*, since any needed parts would have to be purchased.

Regarding claim 4, the examiner additionally cites **Kravette's** disclosure of the service person's use of portable input/output device 34 to retrieve information stored in RAM from the dispatcher at the central station, the information comprising further instructions (see col. 9, lines 59-68). The disclosed use of portable input/output device 34 to access RAM 29 to retrieve further instructions anticipates the claimed *request for interactive assistance*; the service person requests access to information in RAM, and the system responds by displaying the stored information.

Regarding claim 11, the Requestor maps the paper processing device (see Abstract) to the claimed *wherein the at least one product feature is "undo"* (see Request, page 94; see also Exhibit CC-B, page 12).

However, there is no explicit disclosure in **Kravette** of a 'Cancel' function, as alleged by the Requestor.

The Requestor's proposed rejection of claim 11 in view of **Kravette** is **not adopted**.

Regarding claim 13, the Requestor maps modem 14 (see col. 8, line 65 through col. 9, line 1) to the claimed *wherein the product is a cellular telephone* (see Request, page 95; see also Exhibit CC-B, page 12).

However, regarding parent claim 1, the Requester previously mapped the photocopier to the claimed *product* (see Request, page 83; see also Exhibit CC-B, page 4). While it may be true that the photocopier may include a modem, a modem is not analogous to the claimed cellular telephone. Furthermore, claim 13 requires that the product **is** a cellular telephone, not that the product includes a cellular telephone.

Kravette's photocopier cannot reasonably anticipate a telephone, let alone a cellular telephone.

The Requestor's proposed rejection of claim 13 in view of **Kravette** is **not adopted**.

Regarding independent claim 15 (and dependent claims), the Requestor maps the display of diagnostic and monitoring signals on a visual display device (see col. 12, lines 21-24) to the claimed *displaying a user interface configured to probe for information regarding the use of a product* (see Request, page 85; see also Exhibit CC-B, pages 5-6).

However, there is no disclosure of the visual display device (the claimed *user interface*) probing for information regarding the use of a product. The visual display

device is used only to display information, not to accept input information regarding the use of the product (see col. 4, lines 38-42; see also col. 8, lines 29-41).

The examiner instead maps portable hand-held input-output device 34, usable by the service person (see col. 9, lines 14-20 and 41-49), to the claimed *user interface.* The portable hand-held input-output device 34 is 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 counts the number of papers processed, col. 2, line 67 through col. 3, line 3), analogous to the claimed *if the counter exceeds a threshold.*

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

Regarding claim 25, the Requestor maps modem 14 (see col. 8, line 65 through col. 9, line 1) to the claimed *wherein the product is a cellular telephone* (see Request, page 105; see also Exhibit CC-B, page 20).

However, regarding parent claim 15, the Requester previously mapped the photocopier to the claimed *product* (see Request, page 96; see also Exhibit CC-B, pages 13-15). While it may be true that the photocopier may include a modem, a modem is not analogous to the claimed cellular telephone. Furthermore, claim 25 requires that the product **is** a cellular telephone, not that the product includes a cellular telephone.

Kravette's photocopier cannot reasonably anticipate a telephone, let alone a cellular telephone.

The Requestor's proposed rejection of claim 25 in view of **Kravette** is **not adopted**.

Regarding independent claim 27 (and dependent claims), the Requestor maps the display of diagnostic and monitoring signals on a visual display device (see col. 12, lines 21-24) to the claimed *displaying a user interface configured to probe for information regarding the use of a product* (see Request, pages 108-109; see also Exhibit CC-B, pages 22-23).

However, there is no disclosure of the visual display device (the claimed *user interface*) probing for information regarding the use of a product. The visual display device is used only to display information, not to accept input information regarding the use of the product (see col. 4, lines 38-42; see also col. 8, lines 29-41).

The examiner instead maps portable hand-held input-output device 34, usable by the service person (see col. 9, lines 14-20 and 41-49), to the claimed *user interface*. The portable hand-held input-output device 34 is 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 counts the number of papers processed, col. 2, line 67 through col. 3, line 3), analogous to the claimed *if the counter exceeds a threshold*.

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

Regarding independent claim 30 (and dependent claims), the Requestor maps the display of diagnostic and monitoring signals on a visual display device (see col. 12, lines 21-24) to the claimed *means for probing for information regarding the use of a product* (see Request, page 115; see also Exhibit CC-B, pages 29-30).

However, there is no disclosure of the visual display device probing for information regarding the use of a product. The visual display device is used only to display information, not to accept input information regarding the use of the product (see col. 4, lines 38-42; see also col. 8, lines 29-41).

The examiner instead maps portable hand-held input-output device 34, usable by the service person (see col. 9, lines 14-20 and 41-49), to the claimed *means for probing*. The portable hand-held input-output device 34 is 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 of portable hand-held input-output device 34 can be displayed when the counter has exceeded a threshold (see disclosure of the counter

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

When portable input/output device 34 is mapped to the claimed *means for probing*, **Kravette** then discloses the claimed *means for probing for information regarding the use of a product if the counter exceeds a threshold.*

Claims 1, 5, 6, 14, 15, 17, 18 and 26-32 are anticipated under 35 U.S.C. § 102(e) by **Thacher**.

The Third Party Requestor has provided a detailed analysis and mapping of the features of **Thacher** to the claim elements of the '565 patent (see Request, pages 119-159, as well as Exhibit CC-C). The Requestor's analysis and rationale for rejection of claims 1, 5, 6, 14, 15, 17, 18 and 26-32 is adopted by the examiner and is incorporated by reference, with the following modifications.

The Requestor's proposed rejections of claims 2-4, 8-11, 13, 19, 21, 22 and 25 are **not adopted.**

Regarding claim 2, the Requestor maps the display of a maintenance sequence to attract players to the video game after the game has ended (see col. 15, lines 17-20) to

the claimed *wherein the input reflects a request to schedule maintenance* (see Request, page 126; see also Exhibit CC-C, page 7).

However, the claimed *input* refers to the claimed *information regarding a use of the product input through the user interface* of parent claim 1. The display of a maintenance sequence to attract players to the video game after the game has ended cannot reasonably be mapped to *information regarding a use of the product input through the user interface.*

Furthermore, the Requester has previously mapped the claimed *input* to the user's manually submitted score data (see Request, page 124; see also Exhibit CC-C, pages 5-6), which is inconsistent with the proposed mapping of the claimed *input* with respect to claim 2.

The display of a maintenance sequence to attract players to the video game after the game has ended does not anticipate the claimed *input [which] reflects a request to schedule maintenance.* There is no disclosure in **Thacher** which is analogous to the claimed *input [which] reflects a request to schedule maintenance.*

The Requestor's proposed rejection of claim 2 in view of **Thacher** is **not adopted**.

Regarding claim 3, the Requestor maps the insertion of a credit card into a credit card reader of the video game machine (see col. 2, lines 53-55) to the claimed *wherein the*

input reflects a submission of a purchase order (see Request, page 127; see also Exhibit CC-C, page 7).

However, the claimed *input* refers to the claimed *information regarding a use of the product input through the user interface* of parent claim 1. The insertion of a credit card into a credit card reader cannot reasonably be mapped to *information regarding a use of the product input through the user interface.*

Furthermore, the Requester has previously mapped the claimed *input* to the user's manually submitted score data (see Request, page 124; see also Exhibit CC-C, pages 5-6), which is inconsistent with the proposed mapping of the claimed *input* with respect to claim 3.

The insertion of a credit card into a video game machine does not anticipate the claimed *input [which] reflects a submission of a purchase order.* There is no disclosure in **Thacher** which is analogous to the claimed *input [which] reflects a submission of a purchase order.*

The Requestor's proposed rejection of claim 3 in view of **Thacher** is **not adopted**.

Regarding claim 4, the Requestor maps the selection of a game play function (see col. 7, lines 33-42) to the claimed *wherein the input reflects a request for interactive assistance* (see Request, page 127; see also Exhibit CC-C, page 8).

However, the Requester has previously mapped the claimed *input* to the user's manually submitted score data (see Request, page 124; see also Exhibit CC-C, pages 5-6), which is inconsistent with the proposed mapping of the claimed *input* with respect to claim 4.

Furthermore, the selection of a game play function cannot be reasonably interpreted as *a request for interactive assistance*. **Thacher** discloses the player's ability to select "a function" from a menu, but offers no disclosure of *a request for interactive assistance* as an available function.

The selection of a game play function does not anticipate the claimed *input [which] reflects a request for interactive assistance*. There is no disclosure in **Thacher** which is analogous to the claimed *input [which] reflects a request for interactive assistance*.

The Requestor's proposed rejection of claim 4 in view of **Thacher** is **not adopted**.

Regarding claim 5, the Requestor maps the count of 'men' or 'tries' (see col. 11, lines 52-56) to the claimed *second counter corresponding to a second trigger event* (see Request, pages 128-129; see also Exhibit CC-C, pages 8-9).

However, with relation to parent claim 1, the Requester has previously mapped the count of 'men' or 'tries' to the claimed *[first] counter* (see Request, pages 122-123; see

also Exhibit CC-C, pages 3-4). The video game's count of 'men' or 'tries' cannot be mapped to both the first and second counter.

The examiner instead maps the tracking of a player's score to the claimed *second counter* (see disclosure that the player's score data is stored as it increments, col. 8, lines 1-2).

Regarding claim 6, **Thacher** discloses the storage of score data (see col. 8, lines 1-2), anticipating the claimed *caus[ing] the memory to store the second counter*, as well as the transmission of score data (see col. 2, lines 29-33 et seq.), anticipating the claimed *caus[ing] the transmitter to transmit the value of the second counter.*

Regarding claim 8 (and dependent claim 9), the Requestor maps the central computer's monitoring for tampering with game machines (see col. 19, lines 1-17) to the claimed *wherein one of the predefined plurality of trigger events is a problem associated with the product* (see Request, pages 130-131; see also Exhibit CC-C, page 10).

However, the claimed *trigger events* are events which are tracked through a corresponding counter, as recited in parent claim 1, yet there is no disclosure of any counter associated with the disclosed monitoring for tampering with game machines.

Furthermore, the Requestor has previously mapped 'counter corresponding to a trigger event' with the loss of 'men' or 'tries' (see Request, pages 122-123; see also Exhibit CC-C, pages 3-4).

Finally, the claimed *trigger events* and corresponding counters occur within the claimed unit/product, which has been previously mapped by the Requester to the video game machine (see Request, pages 119 and 122; see also Exhibit CC-C, pages 1-2), while **Thacher's** disclosed monitoring for tampering with game machines occurs at the central computer (see col. 19, lines 1-17).

The Requestor's proposed rejection of claims 8 and 9 in view of **Thacher** is **not adopted**.

Regarding claim 10 (and dependent claim 11), the Requestor maps the insertion of a credit card (see col. 2, lines 53-55) or alternately the player's selection of a menu choice (see col. 16, lines 45-51) to the claimed *wherein a trigger event of the predefined plurality of trigger events is a use of at least one product feature* (see Request, page 132; see also Exhibit CC-C, page 11).

However, the claimed *trigger events* are events which are tracked through a corresponding counter, as recited in parent claim 1, yet there is no disclosure of any counter associated with the use of a credit card or selection of a menu choice.

Furthermore, the Requestor has previously mapped *counter corresponding to a trigger event* with the loss of 'men' or 'tries' (see Request, pages 122-123; see also Exhibit CC-C, pages 3-4), in which case the *trigger events* would be the loss of a 'man' or the completion of a 'try' (or more generally, the end of a round), none of which could reasonably be seen as anticipating the claimed *use of at least one product feature.*

The Requestor's proposed rejection of claims 10 and 11 in view of **Thacher** is **not adopted**.

Regarding claim 13, the Requestor maps the telephone line (see col. 6, lines 12-16) to the claimed *wherein the product is a cellular telephone* (see Request, page 134; see also Exhibit CC-C, page 12).

However, regarding parent claim 1, the Requester previously mapped the video game machine to the claimed *product* (see Request, pages 119 and 122; see also Exhibit CC-B, pages 1-2). While it may be true that the video game machine may include a telephone line, a telephone line is not analogous to the claimed cellular telephone. Furthermore, claim 13 requires that the product **is** a cellular telephone, not that the product includes a cellular telephone.

Thacher's video game machine cannot reasonably anticipate a telephone, let alone a cellular telephone.

The Requestor's proposed rejection of claim 13 in view of **Thacher** is **not adopted**.

Regarding claim 14, the Requestor maps the incrementing of score data (see col. 8, lines 1-2) to the claimed *detection of a second instance of the trigger event* (see Request, page 135; see also Exhibit CC-C, page 12).

However, the Requestor has previously mapped *counter corresponding to a trigger event* with the loss of 'men' or 'tries' (see Request, pages 122-123; see also Exhibit CC-C, pages 3-4); score data has been mapped to the *second trigger event* of claims 5 and 6.

When the loss of 'men' or 'tries' is mapped to the claimed *detection of a second instance of the trigger event*, **Thacher** then anticipates the feature of claim 14.

Regarding claim 17, the Requestor maps the count of 'men' or 'tries' (see col. 11, lines 52-56) to the claimed *second counter corresponding to a second trigger event* (see Request, pages 139-140; see also Exhibit CC-C, page 17).

However, with relation to parent claim 15, the Requester has previously mapped the count of 'men' or 'tries' to the claimed *[first] counter* (see Request, pages 136-137; see also Exhibit CC-C, page 14). The video game's count of 'men' or 'tries' cannot be mapped to both the first and second counter.

The examiner instead maps the tracking of a player's score to the claimed *second counter* (see disclosure that the player's score data is stored as it increments, col. 8, lines 1-2).

Regarding claim 18, **Thacher** discloses the storage of score data (see col. 8, lines 1-2), anticipating the claimed *storing the second counter on the device*, as well as the transmission of score data (see col. 2, lines 29-33 et seq.), anticipating the claimed *transmitting a value of the second counter to the server*.

Regarding claim 19 (and dependent claim 21), the Requestor maps the central computer's monitoring for tampering with game machines (see col. 19, lines 1-17) to the claimed *one of the predefined plurality of trigger events is a problem associated with the product* (see Request, pages 141-142; see also Exhibit CC-C, pages 18-19).

However, the claimed *trigger events* are events which are tracked through a corresponding counter, as recited in parent claim 15, yet there is no disclosure of any counter associated with the disclosed monitoring for tampering with game machines.

Furthermore, the Requestor has previously mapped 'counter corresponding to a trigger event' with the loss of 'men' or 'tries' (see Request, pages 136-137; see also Exhibit CC-C, pages 14).

Finally, the claimed *trigger events* and corresponding counters occur within the claimed *product*, which has been previously mapped by the Requester to the video game machine (see Request, page 135; see also Exhibit CC-C, page 12), while **Thacher's** disclosed monitoring for tampering with game machines occurs at the central computer (see col. 19, lines 1-17).

The Requestor's proposed rejection of claims 19 and 21 in view of **Thacher** is **not adopted**.

Regarding claim 22, the Requestor maps the insertion of a credit card (see col. 2, lines 53-55) or alternately the player's selection of a menu choice (see col. 16, lines 45-51) to the claimed *wherein a trigger event of the predefined plurality of trigger events is a use of at least one product feature* (see Request, page 143; see also Exhibit CC-C, pages 19-20).

However, the claimed *trigger events* are events which are tracked through a corresponding counter, as recited in parent claim 15, yet there is no disclosure of any counter associated with the use of a credit card or selection of a menu choice.

Furthermore, the Requestor has previously mapped *counter corresponding to a trigger event* with the loss of 'men' or 'tries' (see Request, pages 136-137; see also Exhibit CC-C, page 14), in which case the *trigger events* would be the loss of a 'man' or the completion of a 'try' (or more generally, the end of a round), none of which could reasonably be seen as anticipating the claimed *use of at least one product feature.*

The Requestor's proposed rejection of claim 22 in view of **Thacher** is **not adopted**.

Regarding claim 25, the Requestor maps the telephone line (see col. 6, lines 12-16) to the claimed *wherein the product is a cellular telephone* (see Request, page 144; see also Exhibit CC-C, page 20).

However, regarding parent claim 15, the Requester previously mapped the video game machine to the claimed *product* (see Request, page 135; see also Exhibit CC-B, page 12). While it may be true that the video game machine may include a telephone line, a telephone line is not analogous to the claimed *cellular telephone.* Furthermore, claim 25 requires that the product **is** a cellular telephone, not that the product includes a cellular telephone.

Thacher's video game machine cannot reasonably anticipate a telephone, let alone a cellular telephone.

The Requestor's proposed rejection of claim 25 in view of **Thacher** is **not adopted**.

Regarding claim 26, the Requestor maps the incrementing of score data (see col. 8, lines 1-2) to the claimed *detection of a second instance of the trigger event* (see Request, page 145; see also Exhibit CC-C, pages 20-21).

However, the Requestor has previously mapped *counter corresponding to a trigger event* with the loss of 'men' or 'tries' (see Request, pages 136-137; see also Exhibit CC-C, page 14); score data has been mapped to the *second trigger event* of claims 17 and 18.

When the loss of 'men' or 'tries' is mapped to the claimed *detection of a second instance of the trigger event*, **Thacher** then anticipates the feature of claim 26.

Regarding claim 28, the Requestor maps the count of 'men' or 'tries' (see col. 11, lines 52-56) to the claimed *second counter corresponding to a second trigger event* (see Request, pages 150-151; see also Exhibit CC-C, page 26).

However, with relation to parent claim 27, the Requester has previously mapped the count of 'men' or 'tries' to the claimed *[first] counter* (see Request, pages 147-148; see also Exhibit CC-C, page 23). The video game's count of 'men' or 'tries' cannot be mapped to both the first and second counter.

The examiner instead maps the tracking of a player's score to the claimed *second counter* (see disclosure that the player's score data is stored as it increments, col. 8, lines 1-2).

Regarding claim 29, **Thacher** discloses the storage of score data (see col. 8, lines 1-2), anticipating the claimed *storing the second counter on the device*, as well as the transmission of score data (see col. 2, lines 29-33 et seq.), anticipating the claimed *transmitting a value of the second counter to the server.*

Regarding claim 31, the Requestor maps the count of 'men' or 'tries' (see col. 11, lines 52-56) to the claimed *second counter corresponding to a second trigger event* (see Request, page 157; see also Exhibit CC-C, page 33).

However, with relation to parent claim 30, the Requester has previously mapped the count of 'men' or 'tries' to the claimed *[first] counter* (see Request, page 154; see also Exhibit CC-C, page 30). The video game's count of 'men' or 'tries' cannot be mapped to both the first and second counter.

The examiner instead maps the tracking of a player's score to the claimed *second counter* (see disclosure that the player's score data is stored as it increments, col. 8, lines 1-2).

Regarding claim 32, **Thacher** discloses the storage of score data (see col. 8, lines 1-2), anticipating the claimed *means for storing the second counter on the device,* as well as the transmission of score data (see col. 2, lines 29-33 et seq.), anticipating the claimed *means for transmitting a value of the second counter to the server.*

Claims 1-5, 10, 14, 15, 17, 22, 26-28, 30 and 31 are anticipated under 35 U.S.C. § 102(e) by **Manduley**.

The Third Party Requestor has provided a detailed analysis and mapping of the features of **Manduley** to the claim elements of the '565 patent (see Request, pages 159-201, as well as Exhibit CC-D). The Requestor's analysis and rationale for rejection of claims 1-5, 10, 14, 15, 17, 22, 26-28, 30 and 31 is adopted by the examiner and is incorporated by reference, with the following modifications.

The Requestor's proposed rejections of claims 6, 8, 9, 11, 13, 18, 19, 21, 25, 29 and 32 are **not adopted**.

Regarding claim 2, the Requestor maps a user's request submitter to the data center for the activation of an application or feature (see col. 7, lines 39-44) to the

claimed *wherein the input reflects a request to schedule maintenance* (see Request, page 165; see also Exhibit CC-D, page 6).

Within the specification of the '565 patent, the most relevant disclosure concerning a request for scheduled maintenance is in col. 41, at lines 45-53:

> 7. Interactive Services and Transactions
> Interactive communications like those described in the On-line Customer Support (OCS) feature may be extended to providing other services and to conducting transactions:
> Interactive services: For example, Customers may is request a variety of services such as scheduling a product maintenance appointment, requesting that another copy of the product's manual be sent, or asking to have a salesperson contact them about a possible future order

The user's request for activation of an application or feature can be interpreted broadly enough that it would anticipate the claimed *request to schedule maintenance,* since it can be interpreted as a request from the user for the data center to schedule a time to activate the requested application or feature, said activation anticipating the claimed *maintenance.*

Regarding claim 6, the Requestor maps the transmission of request codes to the data center (see col. 7, lines 24-26) to the claimed *caus[ing] the transmitter to transmit a value of the second counter* (see Request, page 170; see also Exhibit CC-D, page 10).

However, with respect to parent claim 5, the Requester has previously mapped the usage counter with the amount of usage allowed, as stored in the activation map (see col. 8, line 63 through col. 9, line 5) to the claimed *second counter corresponding to the second trigger event* (see Request, pages 167-168; see also Exhibit CC-D, pages 7-8).

Clearly, the transmission of the request code requesting activation of an application or feature cannot anticipate the claimed *caus[ing] the transmitter to transmit a value of the second counter*, which in this case would be the usage counter.

The Requestor's proposed rejection of claim 6 in view of **Manduley** is **not adopted**.

Regarding claim 8 (and dependent claim 9), the Requestor maps the determination of an error in decrypting a user's request code (see col. 8, lines 6-12) to the claimed *wherein one of the predefined plurality of trigger events is a problem associated with the product* (see Request, page 171; see also Exhibit CC-D, page 11).

However, the claimed *trigger events* are events which are tracked through a corresponding counter, as recited in parent claim 1, yet there is no disclosure of any counter associated with the disclosed determination of an error in decrypting a user's request code.

Furthermore, the Requestor has previously mapped the *counter corresponding to a trigger event* with the counting down of the usage counter with the amount of usage allowed (see Request, pages 161-162; see also Exhibit CC-D, pages 3-4).

Finally, the claimed *trigger events* and corresponding counters occur within the claimed *unit/product*, which has been previously mapped by the Requester to the data processing device (see Request, pages 159 and 161; see also Exhibit CC-D, pages 1 and 3), while **Manduley's** disclosed determination of an error in decrypting a user's request code occurs at the data center (see col. 8, lines 6-12).

The Requestor's proposed rejection of claims 8 and 9 in view of **Manduley** is **not adopted**.

Regarding claim 11, the Requestor maps the deactivation of a feature upon exhaustion of the permitted usage (see col. 5, lines 55-57) to the claimed *trigger event [which] is the use of a product feature wherein the product feature is "undo"* (see Request, page 173; see also Exhibit CC-D, page 12).

However, the claimed *trigger events* are events which are tracked through a corresponding counter, as recited in parent claim 1, yet there is no disclosure of any counter associated with the disclosed deactivation of a feature upon exhaustion of the

permitted usage. Granted, feature deactivation is the *consequence* of trigger events, but it is not itself a trigger event.

Furthermore, there is no disclosure in **Manduley** of any 'undo' or 'cancel' functionality.

The Requestor's proposed rejection of claim 11 in view of **Manduley** is **not adopted**.

Regarding claim 13, the Requestor maps the disclosed cellular telephone (see col. 7, lines 22-24) to the claimed *wherein the product is a cellular telephone* (see Request, page 174; see also Exhibit CC-D, page 12).

However, the cellular telephone disclosed by **Manduley** is disclosed in the context of the communication link used between the data center and the data processing device. The Requester has previously mapped the claimed *product* to the data processing device (see Request, pages 159 and 161; see also Exhibit CC-D, pages 1 and 3),

The claim limitation requires that the product **is** a cellular telephone. Were this the case, then the specification clearly would not disclose the use of a cellular telephone to provide communication between the data center and the product (which is exactly what is disclosed at col. 7, lines 18-28). In light of these facts, the data processing device

(the claimed *product*) disclosed by **Manduley** cannot anticipate the claimed *wherein the product is a cellular telephone.*

The Requestor's proposed rejection of claim 13 in view of **Manduley** is **not adopted**.

Regarding claim 18, the Requestor maps the transmission of request codes to the data center (see col. 7, lines 24-26) to the claimed *transmitting a value of the second counter to the server* (see Request, page 182; see also Exhibit CC-D, page 19).

However, with respect to parent claim 17, the Requester has previously mapped the usage counter with the amount of usage allowed, as stored in the activation map (see col. 8, line 63 through col. 9, line 5) to the claimed *second counter corresponding to the second trigger event* (see Request, pages 179-180; see also Exhibit CC-D, pages 17-18).

Clearly, the transmission of the request code requesting activation of an application or feature cannot anticipate the claimed *transmitting a value of the second counter to the server,* which in this case would be the usage counter.

The Requestor's proposed rejection of claim 18 in view of **Manduley** is **not adopted**.

Regarding claim 19 (and dependent claim 21), the Requestor maps the determination of an error in decrypting a user's request code (see col. 8, lines 6-12) to the claimed *wherein one of the predefined plurality of trigger events is a problem associated with the product* (see Request, page 183; see also Exhibit CC-D, pages 19-20).

However, the claimed *trigger events* are events which are tracked through a corresponding counter, as recited in parent claim 15, yet there is no disclosure of any counter associated with the disclosed determination of an error in decrypting a user's request code.

Furthermore, the Requestor has previously mapped *counter corresponding to a trigger event* with the counting down of the usage counter with the amount of usage allowed (see Request, pages 175-177; see also Exhibit CC-D, pages 13-15).

Finally, the claimed *trigger events* and corresponding counters occur within the claimed *product*, which has been previously mapped by the Requester to the data processing device (see Request, pages 175 and 177; see also Exhibit CC-D, pages 13 and 15), while **Manduley's** disclosed determination of an error in decrypting a user's request code occurs at the data center (see col. 8, lines 6-12).

The Requestor's proposed rejection of claims 19 and 21 in view of **Manduley** is **not adopted**.

Regarding claim 25, the Requestor maps the disclosed cellular telephone (see col. 7, lines 22-24) to the claimed *wherein the product is a cellular telephone* (see Request, page 185; see also Exhibit CC-D, page 21).

However, the cellular telephone disclosed by **Manduley** is disclosed in the context of the communication link used between the data center and the data processing device. The Requester has previously mapped the claimed *product* to the data processing device (see Request, pages 175 and 177; see also Exhibit CC-D, pages 13 and 15),

The claim limitation requires that the product **is** a cellular telephone. Were this the case, then the specification clearly would not disclose the use of a cellular telephone to provide communication between the data center and the product (which is exactly what is disclosed at col. 7, lines 18-28). In light of these facts, the data processing device (the claimed *product*) disclosed by **Manduley** cannot anticipate the claimed *wherein the product is a cellular telephone.*

The Requestor's proposed rejection of claim 25 in view of **Manduley** is **not adopted**.

Regarding claim 29, the Requestor maps the transmission of request codes to the data center (see col. 7, lines 24-26) to the claimed *transmitting a value of the second counter to the server* (see Request, page 194; see also Exhibit CC-D, page 29).

However, with respect to parent claim 28, the Requester has previously mapped the usage counter with the amount of usage allowed, as stored in the activation map (see col. 8, line 63 through col. 9, line 5) to the claimed *second counter corresponding to the second trigger event* (see Request, pages 191-192; see also Exhibit CC-D, pages 26-27).

Clearly, the transmission of the request code requesting activation of an application or feature cannot anticipate the claimed *transmitting a value of the second counter to the server*, which in this case would be the usage counter.

The Requestor's proposed rejection of claim 29 in view of **Manduley** is **not adopted**.

Regarding claim 32, the Requestor maps the transmission of request codes to the data center (see col. 7, lines 24-26) to the claimed *means for transmitting a value of the second counter to the server* (see Request, page 201; see also Exhibit CC-D, page 36).

However, with respect to parent claim 31, the Requester has previously mapped the usage counter with the amount of usage allowed, as stored in the activation map

(see col. 8, line 63 through col. 9, line 5) to the claimed *second counter corresponding to the second trigger event* (see Request, pages 198-199; see also Exhibit CC-D, pages 33-34).

Clearly, the transmission of the request code requesting activation of an application or feature cannot anticipate the claimed *means for transmitting a value of the second counter to the server,* which in this case would be the usage counter.

The Requestor's proposed rejection of claim 32 in view of **Manduley** is **not adopted**.

Claims 1, 5, 14, 15, 17, 26-28, 30 and 31 are anticipated under 35 U.S.C. § 102(e) by **Hutchins**.

The Third Party Requestor has provided a detailed analysis and mapping of the features of **Hutchins** to the claim elements of the '565 patent (see Request, pages 202-249, as well as Exhibit CC-E). The Requestor's analysis and rationale for rejection of claims 1, 5, 14, 15, 17, 26-28, 30 and 31 is adopted by the examiner and is incorporated by reference, with the following modifications.

The Requestor's proposed rejections of claims 2, 6-10, 18-22, 29 and 32 are **not adopted**.

Regarding claim 2, the Requestor maps the maintenance of the machine tool part programs (see col. 1, lines 12-17) to the claimed *wherein the input reflects a request to schedule maintenance* (see Request, page 210; see also Exhibit CC-E, page 9).

However, the claimed *input* constitutes input supplied by the user (**Hutchins'** machine tool operator) with respect to maintenance of the product (**Hutchins'** machine tool/local computer). Even were the disclosed maintenance of the machine tool part programs deemed to be analogous to the claimed *maintenance of the product,* there is no disclosure in **Hutchins** analogous to the input by the user of a *request* for maintenance.

The Requestor's proposed rejection of claim 2 in view of **Hutchins** is **not adopted**.

Regarding claim 6, the Requestor maps the transmission of event data, including the setting of a batch size, the batch ID, and the completion of a batch, to the host computer (see col. 14, lines 31-33; see also col. 16, lines 25-27) to the claimed *caus[ing] the transmitter to transmit a value of the second counter* (see Request, page 212; see also Exhibit CC-E, page 11).

However, with respect to parent claim 5, the claimed *second counter* has been mapped to the batch counter (see Request, page 211; see also Exhibit CC-E, pages 9-10).

There is no disclosure of the transmission of the contents of the batch counter in **Hutchins**.

The Requestor's proposed rejection of claim 6 in view of **Hutchins** is **not adopted**.

Regarding claim 7, the Requestor maps the determination of a user's desire to exit the tool status display (see col. 17, lines 58-67) to the claimed *wherein one of the predefined plurality of trigger events is an exiting of a feature of the product without a use of the feature* (see Request, page 213; see also Exhibit CC-E, pages 11-12).

However, the claimed *trigger events* are events which are tracked through a corresponding counter, as recited in parent claim 1, yet there is no disclosure of any counter associated with the disclosed determination of a user's desire to exit the tool status display.

Furthermore, the Requestor has previously mapped the claimed *counter corresponding to a trigger event* with the disclosed program counter (see Request, pages 204; see also Exhibit CC-E, page 4), in which case the trigger event cannot correspond to the claimed *exiting of a feature of the product without a use of the feature.*

Finally, there is no disclosure in **Hutchins** which corresponds to the user's exiting of a feature without using said feature. The disclosed Tool Status Display cited

by the Requester, for instance, is used implicitly by the user immediately upon activation, since its function is to display the tool status.

The Requestor's proposed rejection of claim 7 in view of **Hutchins** is **not adopted**.

Regarding claim 8 (and dependent claim 9), the Requestor maps the flagging portions of machine tool part programs for debugging (see col. 15, lines 12-18) to the claimed *wherein one of the predefined plurality of trigger events is a problem associated with the product* (see Request, page 214; see also Exhibit CC-E, page 12).

However, the claimed *trigger events* are events which are tracked through a corresponding counter, as recited in parent claim 1, yet there is no disclosure of any counter associated with the disclosed flagging of portions of machine tool part programs for debugging.

Furthermore, the Requestor has previously mapped the claimed *counter corresponding to a trigger event* with the disclosed program counter (see Request, pages 204; see also Exhibit CC-E, page 4), in which case the trigger event cannot correspond to the claimed *problem associated with the product.*

The Requestor's proposed rejection of claims 8 and 9 in view of **Hutchins** is **not adopted**.

Regarding claim 10, the Requestor maps the override by the machine tool operator of default feed rate, spindle speed or traverse rate settings (see col. 15, lines 42-45) to the claimed *wherein one of the predefined plurality of trigger events is a use of at least one product feature* (see Request, page 215; see also Exhibit CC-E, page 13).

However, the claimed *trigger events* are events which are tracked through a corresponding counter, as recited in parent claim 1, yet there is no disclosure of any counter associated with the disclosed override by the machine tool operator of default feed rate, spindle speed or traverse rate settings.

Furthermore, the Requestor has previously mapped the claimed *counter corresponding to a trigger event* with the disclosed program counter (see Request, pages 204; see also Exhibit CC-E, page 4), in which case the trigger event cannot correspond to the claimed *use of at least one product feature.*

The Requestor's proposed rejection of claim 10 in view of **Hutchins** is **not adopted**.

Regarding claim 18, the Requestor maps the transmission of event data, including the setting of a batch size, the batch ID, and the completion of a batch, to the host computer (see col. 14, lines 31-33; see also col. 16,.lines 25-27) to the claimed

transmitting a value of the second counter to the server (see Request, pages 226-227; see also Exhibit CC-E, page 22).

However, with respect to parent claim 17, the claimed *second counter* has been mapped to the batch counter (see Request, page 225; see also Exhibit CC-E, page 22).

There is no disclosure of the transmission of the contents of the batch counter to a server in **Hutchins**.

The Requestor's proposed rejection of claim 18 in view of **Hutchins** is **not adopted**.

Regarding claim 19 (and dependent claim 21), the Requestor maps the flagging portions of machine tool part programs for debugging (see col. 15, lines 12-18) to the claimed *wherein one of the predefined plurality of trigger events is a problem associated with the product* (see Request, page 227; see also Exhibit CC-E, page 22).

However, the claimed *trigger events* are events which are tracked through a corresponding counter, as recited in parent claim 15, yet there is no disclosure of any counter associated with the disclosed flagging of portions of machine tool part programs for debugging.

Furthermore, the Requestor has previously mapped the claimed *counter corresponding to a trigger event* with the disclosed program counter (see Request, page

218; see also Exhibit CC-E, page 15), in which case the trigger event cannot correspond to the claimed *problem associated with the product.*

The Requestor's proposed rejection of claims 19 and 21 in view of **Hutchins** is **not adopted**.

Regarding claim 20, the Requestor maps the determination of a user's desire to exit the tool status display (see col. 17, lines 58-67) to the claimed *wherein one of the predefined plurality of trigger events is an exiting of a feature of the product without a use of the feature* (see Request, page 228; see also Exhibit CC-E, page 23).

However, the claimed *trigger events* are events which are tracked through a corresponding counter, as recited in parent claim 15, yet there is no disclosure of any counter associated with the disclosed determination of a user's desire to exit the tool status display.

Furthermore, the Requestor has previously mapped the claimed *counter corresponding to a trigger event* with the disclosed program counter (see Request, pages 218; see also Exhibit CC-E, page 15), in which case the trigger event cannot correspond to the claimed *exiting of a feature of the product without a use of the feature.*

Finally, there is no disclosure in **Hutchins** which corresponds to the user's exiting of a feature without using said feature. The disclosed Tool Status Display cited

by the Requester, for instance, is used implicitly by the user immediately upon activation, since its function is to display the tool status.

The Requestor's proposed rejection of claim 20 in view of **Hutchins** is **not adopted**.

Regarding claim 22, the Requestor maps the override by the machine tool operator of default feed rate, spindle speed or traverse rate settings (see col. 15, lines 42-45) to the claimed *wherein one of the predefined plurality of trigger events is a use of at least one product feature* (see Request, page 230; see also Exhibit CC-E, page 24).

However, the claimed *trigger events* are events which are tracked through a corresponding counter, as recited in parent claim 15, yet there is no disclosure of any counter associated with the disclosed override by the machine tool operator of default feed rate, spindle speed or traverse rate settings.

Furthermore, the Requestor has previously mapped the claimed *counter corresponding to a trigger event* with the disclosed program counter (see Request, pages 218; see also Exhibit CC-E, page 15), in which case the trigger event cannot correspond to the claimed *use of at least one product feature.*

The Requestor's proposed rejection of claim 22 in view of **Hutchins** is **not adopted**.

Regarding claim 29, the Requestor maps the transmission of event data, including the setting of a batch size, the batch ID, and the completion of a batch, to the host computer (see col. 14, lines 31-33; see also col. 16, lines 25-27) to the claimed *transmitting a value of the second counter to the server* (see Request, page 240; see also Exhibit CC-E, page 33).

However, with respect to parent claim 28, the claimed *second counter* has been mapped to the batch counter (see Request, page 239; see also Exhibit CC-E, page 32).

There is no disclosure of the transmission of the contents of the batch counter to a server in **Hutchins**.

The Requestor's proposed rejection of claim 29 in view of **Hutchins** is **not adopted**.

Regarding claim 32, the Requestor maps the transmission of event data, including the setting of a batch size, the batch ID, and the completion of a batch, to the host computer (see col. 14, lines 31-33; see also col. 16, lines 25-27) to the claimed *transmitting a value of the second counter to the server* (see Request, page 249; see also Exhibit CC-E, page 42).

However, with respect to parent claim 31, the claimed *second counter* has been mapped to the batch counter (see Request, page 248; see also Exhibit CC-E, page 41).

There is no disclosure of the transmission of the contents of the batch counter to a server in **Hutchins**.

The Requestor's proposed rejection of claim 32 in view of **Hutchins** is **not adopted**.

Claim Rejections - 35 USC § 103

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Kravette** as applied to claims 1-6, 8-10, 14, 15, 17-19, 21, 22 and 26-32 above, and further in view of **Landa** (U.S. Patent 4,435,068).

Regarding claim 11, **Kravette** teaches the unit substantially as claimed.

Kravette does not explicitly teach the unit wherein the at least one product feature is "undo".

However, **Landa** teaches a photocopier including an "undo" feature (see disclosure of a 'cancel' button to prematurely terminate a copying cycle, col. 21, lines 43-54; the examiner notes that the specification of the '565 patent discloses the "undo" feature as analogous to a 'cancel' function, see col. 28, lines 39-43).

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a mechanism to terminate a copy job, since otherwise erroneously initiated copy jobs would have to be allowed to proceed to completion, which would waste paper.

STATEMENT OF REASONS FOR PATENTABILITY AND/OR CONFIRMATION

The following is an examiner's statement of reasons for patentability and/or confirmation of the claims found patentable in this reexamination proceeding:

Claim 7

Regarding claim 7, the Requestor maps **Hutchins'** determination of a user's desire to exit the tool status display (see col. 17, lines 58-67) to the claimed *wherein one of*

the predefined plurality of trigger events is an exiting of a feature of the product without a use of the feature (see Request, page 213; see also Exhibit CC-E, pages 11-12).

However, the claimed *trigger events* are events which are tracked through a corresponding counter, as recited in parent claim 1, yet there is no disclosure of any counter associated with the disclosed determination of a user's desire to exit the tool status display.

Furthermore, the Requestor has previously mapped the claimed *counter corresponding to a trigger event* with the disclosed program counter (see Request, pages 204; see also Exhibit CC-E, page 4), in which case the trigger event cannot correspond to the claimed *exiting of a feature of the product without a use of the feature.*

Finally, there is no disclosure in **Hutchins** which corresponds to the user's exiting of a feature without using said feature. The disclosed Tool Status Display cited by the Requester, for instance, is used implicitly by the user immediately upon activation, since its function is to display the tool status.

Claim 13

Regarding claim 13, the Requestor maps **Durden's** subscriber's module/set top terminal (see col. 3, lines 3-11) to the claimed *wherein the product is a cellular telephone* (see Request, page 50; see also Exhibit CC-A, page 14).

While **Durden's** set top terminal (previously mapped by the Requestor to the claimed 'product'; see Request, page 36; see also Exhibit CC-A, page 3) does indeed include IPPV Module 20 which communicates with System Manager 8 via a Telephone Network 24 (see drawing Figure 1 et seq.), the set top terminal clearly cannot reasonably be interpreted as embodying a telephone, let alone a cellular telephone.

For instance, the set top terminal "allows the subscriber to tune and descramble the services that he has requested from the cable system operator" (see col. 6, lines 43-48). A cellular telephone does not have these capabilities.

In view of this analysis, the set top terminal cannot anticipate the claimed *wherein the product is a cellular telephone.*

Further regarding claim 13, the Requestor also maps **Kravette's** modem 14 (see col. 8, line 65 through col. 9, line 1) to the claimed *wherein the product is a cellular telephone* (see Request, page 95; see also Exhibit CC-B, page 12).

However, regarding parent claim 1, the Requester previously mapped the photocopier to the claimed *product* (see Request, page 83; see also Exhibit CC-B, page 4).

While it may be true that the photocopier may include a modem, a modem is not analogous to the claimed cellular telephone. Furthermore, claim 13 requires that the product **is** a cellular telephone, not that the product includes a cellular telephone.

Kravette's photocopier cannot reasonably anticipate a telephone, let alone a cellular telephone.

Further regarding claim 13, the Requestor also maps **Thacher's** telephone line (see col. 6, lines 12-16) to the claimed *wherein the product is a cellular telephone* (see Request, page 134; see also Exhibit CC-C, page 12).

However, regarding parent claim 1, the Requester previously mapped the video game machine to the claimed *product* (see Request, pages 119 and 122; see also Exhibit CC-B, pages 1-2). While it may be true that the video game machine may include a telephone line, a telephone line is not analogous to the claimed cellular telephone. Furthermore, claim 13 requires that the product **is** a cellular telephone, not that the product includes a cellular telephone.

Thacher's video game machine cannot reasonably anticipate a telephone, let alone a cellular telephone.

Finally, the Requestor also maps **Manduley's** cellular telephone (see col. 7, lines 22-24) to the claimed *wherein the product is a cellular telephone* (see Request, page 174; see also Exhibit CC-D, page 12).

However, the cellular telephone disclosed by **Manduley** is disclosed in the context of the communication link used between the data center and the data processing device. The Requester has previously mapped the claimed *product* to the data processing device (see Request, pages 159 and 161; see also Exhibit CC-D, pages 1 and 3),

The claim limitation requires that the product **is** a cellular telephone. Were this the case, then the specification clearly would not disclose the use of a cellular telephone to provide communication between the data center and the product (which is exactly what is disclosed at col. 7, lines 18-28). In light of these facts, the data processing device (the claimed *product*) disclosed by **Manduley** cannot anticipate the claimed *wherein the product is a cellular telephone.*

Claim 20

Regarding claim 20, the Requestor maps **Hutchins'** determination of a user's desire to exit the tool status display (see col. 17, lines 58-67) to the claimed *wherein one of*

the predefined plurality of trigger events is an exiting of a feature of the product without a use of the feature (see Request, page 228; see also Exhibit CC-E, page 23).

However, the claimed *trigger events* are events which are tracked through a corresponding counter, as recited in parent claim 15, yet there is no disclosure of any counter associated with the disclosed determination of a user's desire to exit the tool status display.

Furthermore, the Requestor has previously mapped the claimed *counter corresponding to a trigger event* with the disclosed program counter (see Request, pages 218; see also Exhibit CC-E, page 15), in which case the trigger event cannot correspond to the claimed *exiting of a feature of the product without a use of the feature.*

Finally, there is no disclosure in **Hutchins** which corresponds to the user's exiting of a feature without using said feature. The disclosed Tool Status Display cited by the Requester, for instance, is used implicitly by the user immediately upon activation, since its function is to display the tool status.

Claim 25

Regarding claim 25, the Requestor maps **Durden's** subscriber's module/set top terminal (see col. 3, lines 3-11) to the claimed *wherein the product is a cellular telephone* (see Request, page 62; see also Exhibit CC-A, page 23).

While **Durden's** set top terminal (previously mapped by the Requestor to the claimed *product*; see Request, page 52; see also Exhibit CC-A, page 15) does indeed include IPPV Module 20 which communicates with System Manager 8 via a Telephone Network 24 (see drawing Figure 1 et seq.), the set top terminal clearly cannot reasonably be interpreted as embodying a telephone, let alone a cellular telephone.

For instance, the set top terminal "allows the subscriber to tune and descramble the services that he has requested from the cable system operator" (see col. 6, lines 43-48). A cellular telephone does not have these capabilities.

In view of this analysis, the set top terminal cannot anticipate the claimed *wherein the product is a cellular telephone.*

Further regarding claim 25, the Requestor also maps **Kravette's** modem 14 (see col. 8, line 65 through col. 9, line 1) to the claimed *wherein the product is a cellular telephone* (see Request, page 105; see also Exhibit CC-B, page 20).

However, regarding parent claim 15, the Requester previously mapped the photocopier to the claimed *product* (see Request, page 96; see also Exhibit CC-B, pages

13-15). While it may be true that the photocopier may include a modem, a modem is not analogous to the claimed cellular telephone. Furthermore, claim 25 requires that the product **is** a cellular telephone, not that the product includes a cellular telephone.

Kravette's photocopier cannot reasonably anticipate a telephone, let alone a cellular telephone.

Further regarding claim 25, the Requestor also maps **Thacher's** telephone line (see col. 6, lines 12-16) to the claimed *wherein the product is a cellular telephone* (see Request, page 144; see also Exhibit CC-C, page 20).

However, regarding parent claim 15, the Requester previously mapped the video game machine to the claimed *product* (see Request, page 135; see also Exhibit CC-B, page 12). While it may be true that the video game machine may include a telephone line, a telephone line is not analogous to the claimed cellular telephone. Furthermore, claim 25 requires that the product **is** a cellular telephone, not that the product includes a cellular telephone.

Thacher's video game machine cannot reasonably anticipate a telephone, let alone a cellular telephone.

Finally, regarding claim 25, the Requestor also maps **Manduley's** cellular telephone (see col. 7, lines 22-24) to the claimed *wherein the product is a cellular telephone* (see Request, page 185; see also Exhibit CC-D, page 21).

However, the cellular telephone disclosed by **Manduley** is disclosed in the context of the communication link used between the data center and the data processing device. The Requester has previously mapped the claimed *product* to the data processing device (see Request, pages 175 and 177; see also Exhibit CC-D, pages 13 and 15),

The claim limitation requires that the product **is** a cellular telephone. Were this the case, then the specification clearly would not disclose the use of a cellular telephone to provide communication between the data center and the product (which is exactly what is disclosed at col. 7, lines 18-28). In light of these facts, the data processing device (the claimed *product*) disclosed by **Manduley** cannot anticipate the claimed *wherein the product is a cellular telephone.*

Any comments considered necessary by PATENT OWNER regarding the above statement must be submitted promptly to avoid processing delays. Such submission by

the patent owner should be labeled: "Comments on Statement of Reasons for Patentability and/or Confirmation" and will be placed in the reexamination file.

Conclusion

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 §§ 2686 and 2686.04.

The Patent Owner is reminded that any proposed amendment to the specification and/or claims in the reexamination proceeding must comply with the provisions of 37 C.F.R. § 1.530(d)-(j), must be formally presented pursuant to 37 C.F.R. § 1.52(a) and (b), and must include any fees required by 37 C.F.R. § 1.20(c). See MPEP § 2250(IV) for examples to assist in the preparation of proper amendments in reexamination proceedings.

The examiner notes that independent claims 1 and 15 have dependent claims that are not subject to reexamination.

The Patent Owner is reminded that in order to avoid unnecessary narrowing of the current scope of those dependent claims not subject to reexamination, any amendments to an independent claim can be made by:

- Canceling the independent claim;
- Adding an amended version of the independent claim as a new claim; and
- Amending those dependent claims subject to reexamination to depend from the new claim.

See MPEP § 2260.01.

In order to ensure full consideration of any amendments, affidavits or declarations, or other documents as evidence of patentability, such documents must be submitted in response to this Office action. Submissions after the next Office action, which is intended to be an Action Closing Prosecution (ACP), will be governed by 37 CFR 1.116(b) and (d), which will be strictly enforced.

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
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United States Patent & Trademark Office
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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.

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

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lsw
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