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LAW OFFICE OF JONATHAN M. WALDMAN LLC  
830 Welsh Road # 256  
Huntingdon Valley, PA 19006

EXAMINER
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WASSUM, LUKE S

ART UNIT	PAPER NUMBER
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3992

MAIL DATE	DELIVERY MODE
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08/10/2012

PAPER

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

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



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

KING & SPALDING LLP  
PO BOX 889  
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**MAILED**

**AUG 10 2012**

**CENTRAL REEXAMINATION UNIT**

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

REEXAMINATION CONTROL NUMBER 95/000,638.

PATENT NUMBER 7620565.

TECHNOLOGY CENTER 3999.

ART UNIT 3992.

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.

<b>OFFICE ACTION IN INTER PARTES REEXAMINATION</b>	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 22 March, 2012

Third Party(ies) on 11 May, 2012

**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 2,7-11, 13, 19-22 and 25 are confirmed. [Unamended patent claims]
4.  Claims \_\_\_\_\_ are patentable. [Amended or new claims]
5.  Claims 1, 3-6, 14, 15, 17, 18 and 26-32 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 \_\_\_\_\_

## 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.

### *Prior Art*

The following prior art was cited by the Third Party Requester as establishing 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**")

### **Response to Arguments**

The Patent Owner's arguments, filed 8 December 2011, have been considered but they are not fully persuasive. The Third Party Requester's response, filed 11 May 2012, has also been considered.

The Patent Owner presented a number of arguments in their response. These arguments are addressed in turn below.

#### **Claim Construction**

The Patent Owner presents arguments regarding the interpretation of the claimed "cause the display of a user interface...if the counter exceeds a threshold".

In particular, the Patent Owner argues that the adopted interpretation is unreasonably broad because the examiner has erroneously disregarded the examiner's Reasons for Allowance of the original application (see item 4, beginning on page 10 of the Patent Owner's response), and because the adopted interpretation is not reasonable in light of the overall claim language and specification (see item 6, beginning on page 16 of the Patent Owner's response).

Regarding the Patent Owner's first argument, the Third Party Requester argues that the examiner did indeed consider the original examiner's Reasons for Allowance

(see item B1, page 7 of the Requester's comments, filed 11 May 2012), and that the broadest reasonable interpretation in reexamination does not require giving weight to prosecution history (id., item B2, page 9).

Regarding the Patent Owner's second argument, the Third Party Requester argues that the broadest reasonable interpretation consistent with the specification is no narrower than the examiner's interpretation (id., item A1, page 4), and that the Patent Owner's proposed claim construction is improper because it reads limitations into the claims from the specification (id., item A2, page 5).

Regarding the Patent Owner's first argument [that the examiner has erroneously disregarded the examiner's Reasons for Allowance of the original application], the examiner does not find this argument persuasive, and adopts the Third Party's position.

The original examiner made the following statement with respect to Reasons for Allowance and the Levine reference:

Levine ("Protecting Your Power") teaches watchdog device programmed to take action, such as dialing telephone numbers, to report an unusual or threshold-exceeding condition (paragraphs beginning, "Complete environmental watchdog systems" and "Most of these protection devices supervise"), but does not teach causing the display of a user interface, configured to probe for information regarding a use of the product, based on a threshold-exceeding condition.

This statement, however, cannot be interpreted as imparting any particular construction to the "cause the display of a user interface...if the counter exceeds a threshold" language of the claims.

The conditional portion of the claim limitation cites a counter, and the fact that said counter exceeds a threshold. On the other hand, Levine is cited as disclosing a device which reports "an unusual or threshold-exceeding condition".

It is clear that the portion of the original examiner's statement "[Levine] does not teach causing the display of a user interface, configured to probe for information regarding the use of the product" refers to the claim language not met by the reference (it is noted that the exact claim language is used), while the phrase "based on a threshold-exceeding condition" makes reference to the relevant disclosure of Levine, even using the identical "threshold-exceeding condition" language from the reference.

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This being the case, the original examiner's statement should be interpreted as stating that while Levine does disclose taking actions based upon a threshold-exceeding condition, it does not teach *causing the display of a user interface, configured to probe for information regarding the use of the product* based upon a threshold-exceeding condition.

Furthermore, it could not have been the intent of the examiner to provide claim construction guidance through this statement, since the claim language clearly requires a counter, while the language which the Patent Owner proposes as the original examiner's interpretation contains none. Were there intent on the part of the examiner to provide claim construction guidance, then it would have been necessary to explicitly address the claimed counter and why the proposed interpretation would have been reasonable despite the lack of any reference to a counter.

Since the language which the Patent Owner alleges was the original examiner's interpretation of the claimed *cause the display of a user interface...if the counter exceeds a threshold* does not include a counter as required by the claims, the original examiner's statement regarding Reasons for Allowance cannot reasonably be interpreted as providing claim construction guidance for the *cause the display of a user interface...if the counter exceeds a threshold* feature of the claims.



Regarding the Patent Owner's second argument [that the adopted interpretation is not reasonable in light of the overall claim language and specification], the examiner finds this argument persuasive.

Specifically, in light of the Patent Owner's arguments regarding claim interpretation which renders other claim terms superfluous or "functionally meaningless" (Patent Owner's response, page 18), as well as the portion of the specification of the '565 patent regarding the claimed counter (col. 29, lines 57-64), the examiner agrees that the claim language, read in light of the specification, would reasonably require a linkage between the display of the user interface and the trigger event which causes the counter to exceed a threshold. Therefore, claim construction of the clause "if the counter exceeds a threshold" is reconsidered in this action.

### SNQ

The Patent Owner argues that the prior art cited in the Request fails to raise a Substantial New Question of Patentability, because they are cumulative to the prior art cited during prosecution of the original application (see item 7, page 21 of the Patent Owner's response).

The Third Party Requester argues that the cited prior art is not cumulative to the record, since none of **Durden, Kravette and Thacher** "substantially reiterates verbatim the teachings of" McKenna, Moore and Levine (see Third Party's response, page 11).

The examiner respectfully disagrees with the Patent Owner, and adopts the Third Party's position.

As discussed above, the references cited by the Third Party Requester also include the claimed feature of a counter whose value is checked against a threshold in order to trigger an event. None of the McKenna, Moore or Levine references cited during the original prosecution includes this feature.

### **Durden**

The Patent Owner argues that **Durden** fails to disclose the claimed display of a user interface if the counter exceeds a threshold (see reason 1, page 28 of the Patent Owner's response), and furthermore that **Durden** fails to disclose a display at all (see reason 2, page 30 of the Patent Owner's response).

The Third Party Requester argues that **Durden** does indeed disclose the display of a user interface if a counter exceeds a threshold (see item A1, page 12 of the Third

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Party Requester's response), and that **Durden** does indeed disclose a display (see item A2, page 15 of the Third Party Requester's response).

The examiner finds the Patent Owner's arguments persuasive as to reason 1.

With respect to reason 2, the examiner adopts the Third Party's position.

At col. 2, lines 45-55, **Durden** discloses an apparatus which allows subscribers to view an event for a predetermined preview time period before requiring the subscribers to purchase the event, as well as a predetermined free time period:

**A preview time generator, responsive to the system operator, generates a downloadable transaction to permit the plurality of subscribers to receive an event for a predetermined preview time period before requiring the subscribers to purchase an event. The apparatus also includes a free time generator responsive to the system operator which generates a downloadable transaction which permits the plurality of subscribers to further receive the event for a predetermined free time period before requiring the subscribers to purchase the event.**

However, although this disclosure strongly suggests the display of a user interface upon the expiration of preview time or free time (the claimed *if the counter exceeds a threshold*), providing the subscriber the opportunity to purchase the event in order to continue viewing, since at that point they are required to purchase the event or discontinue viewing (the claimed *cause the display of a user interface configured to probe for*

*information regarding the use of the product*), this step would not necessarily have been inherent.

Nonetheless, upon further reconsideration, the examiner has presented new grounds of rejection on obviousness grounds in this Office action.

Regarding *Durden's display*, an ordinary artisan at the time of the invention would have understood that the disclosed display would include the hardware devices and the information displayed thereon.

### **Kravette**

The Patent Owner argues that **Kravette** fails to disclose the claimed display of a user interface if the counter exceeds a threshold (see page 35 of the Patent Owner's response).

The Third Party Requester argues that **Kravette** does indeed disclose the display of a user interface if a counter exceeds a threshold (see item B, page 16 of the Third Party Requester's response).

The examiner finds the Patent Owner's arguments persuasive in light of the newly considered claim construction of the claimed *if the counter exceeds a threshold*.

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In the rejection of record, the counter counting the number of papers processed by the copier is mapped to the claimed *monitor[ing] a product for an occurrence in the product of a trigger event of a plurality of trigger events.*

However, while Kravette does disclose taking an action upon the occurrence of a triggering event (a copy being made) which increments a counter and checks to see if the counter exceeds a threshold, that action is disclosed as the transmission of an accumulative count to a central station; col. 2, line 50 through col. 3, line 7:

**Generally speaking, in accordance with the invention, a system for monitoring a printing or paper processing device, such as a photocopier, and automatically notifying the appropriate off site parties at appropriate times of the status of the photocopier as well as the status of the service contract and preventive maintenance needs is provided. A counter counts the number of papers processed by the copier producing a count signal. A monitoring system computer receives the count signal and increments a count value over a predetermined period. An interface circuit monitors the operation of the copier by monitoring the internal diagnostic signals of the copier as displayed on a photocopier display device associated with each copier and signals a central station when a malfunction of the copier has occurred, indicating the nature of the problem by translating the diagnostic signal and transmitting a translated diagnostic signal. The monitoring system computer also transmits both an accumulative count once the prede-**

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**terminated time period has elapsed or once a predetermined number of counts has occurred indicating the number of papers which have been processed. A modem receives the accumulative count and diagnostic signals from the monitoring system computer and transmits each signal to the appropriate party at the central station.**

Kravette additionally discloses that at a predetermined time or upon a predetermined event, a report for each of the copiers is transmitted to the central station; col. 3, lines 17-27:

**A plurality of copiers at a single site may be provided with a local area network. A master controller containing a single modem is attached to a single telephone line. The controller polls the monitoring system computer at each copier through the local area network to ascertain the number of copies made and the maintenance status of each copier. At a predetermined time or upon predetermined events such as a maintenance requirement at a particular copier, the controller transmits a single report for each of the copiers through the modem to a central station.**

However, the transmission of reports from the copiers to the central station cannot be equated to the display of a user interface configured to probe for information regarding the use of the product.

Furthermore, the rejection of record maps portable input/output device 34 to the claimed *user interface configured to probe for information regarding use of the product.*

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Although the service person does input information via portable input/output device 34 regarding use of the product, the user interface is displayed when the service person connects the device to the copier while performing maintenance on the copier. There is no disclosed connection between the counter having reached a threshold and the display of the user interface configured to probe for information regarding the use of the product.

In light of the newly considered claim construction of the claimed *if the counter exceeds a threshold*, the rejections of claims 1-6, 8-10, 14, 15, 17-19, 21, 22 and 26-32 as being anticipated by **Kravette** presented in the Office action mailed 11 October 2011 are withdrawn. The rejections proposed by the Third Party Requester based upon **Kravette** are not adopted by the Office.

### Thacher

The Patent Owner argues that **Thacher** fails to disclose the claimed display of a user interface if the counter exceeds a threshold (see page 37 of the Patent Owner's response).

The Third Party Requester argues that **Thacher** does indeed disclose the display of a user interface if a counter exceeds a threshold (see item C, page 19 of the Third Party Requester's response).

The examiner respectfully disagrees with the Patent Owner, and adopts the Third Party's position.

**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 rejection of record, the counter counting the number of 'men' or 'tries' which will define the end of the game is mapped to the claimed *monitor[ing] a product for an occurrence in the product of a trigger event of a plurality of trigger events.*

The 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*



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*interface configured to probe for information regarding the use of the product, if the counter exceeds a threshold.*

**Thacher** discloses that at the end of the game (thus, when the counter of 'men' or 'tries' reaches zero), the score is transmitted to the central computer and is stored. Also disclosed is an alternative embodiment whereby the validated user can enter his score manually on a keyboard associated with the video game; col. 2, line 67 through col. 3, line 5:

**The player plays the video game. At the end of the game, the score is transmitted to the central computer**

**and is stored. Alternatively, the game can be polled and a continuously updated score transmitted to the central computer. As a further alternative, the validated player could enter his score manually on a keyboard associated with the video game.**

While **Thacher** does not explicitly disclose the claimed display of a user interface configured to probe for information regarding the use of the product, an ordinary artisan would have understood this feature to be inherent (or alternatively obvious), for the reasons discussed in the rejection below.

**Manduley**

The Patent Owner argues that **Manduley** fails to qualify as prior art, because based upon the declaration of inventor Daniel H. Abelow, and related evidence, the '565 patent predates **Manduley** (see page 39 of the Patent Owner's response).

The Third Party Requester did not address this argument in their response.

The examiner finds the Patent Owner's arguments persuasive.

The Declaration of inventor Daniel H. Abelow, filed 8 December 2011, as well as the supporting exhibits, taken together with the Patent Owner's response to the Request for Information under 37 C.F.R. § 1.105, filed 22 March 2012, and the supporting exhibits, provides sufficient evidence that the claimed invention was conceived and reduced to practice prior to 31 August 1991. As a result, the **Manduley** reference does not qualify as prior art.

The rejections of claims 1-5, 10, 14, 15, 17, 22, 26-28, 30 and 31 as being anticipated by **Manduley** presented in the Office action mailed 11 October 2011 are withdrawn. The rejections proposed by the Third Party Requester based upon **Manduley** are not adopted by the Office.

Hutchins

The Patent Owner argues that **Hutchins** fails to disclose the claimed display of a user interface...if the counter exceeds a threshold (see reason 1, page 41 of the Patent Owner's response), and that **Hutchins** fails to disclose storage or transmission of the input received from the user interface (see reason 2, page 45 of the Patent Owner's response).

The Third Party Requester argues that **Hutchins** does indeed disclose the display of a user interface if a counter exceeds a threshold (see item D1, page 22 of the Third Party Requester's response), and that **Hutchins** does disclose the storage or transmission of the input received from the user interface (see item D2, page 25 of the Third Party Requester's response).

The examiner finds the Patent Owner's argument persuasive.

**Hutchins** teaches a system for collecting event data from a machine tool, said event data including both ordinary program steps from within the machine tool part program, and events representing operator intervention of the programmed process operating on the machine tool (see Abstract). The system includes a local computer having an operator interface (see item 14, drawing Figure 7). The operator interface provides two-way interaction between the machine tool operator and computer 10, and

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may include a video display, flat panel display, touch screen, keyboard or buttons as appropriate (see col. 6, lines 30-38).

The operator may perform a number of actions (operator-initiated events) which can be interpreted as providing information regarding a use of the product. Col. 3, lines 18-27 discloses:

**These machine tool operator initiated events include, but are not limited to: down-loading a machine tool part program to the machine tool; setting the batch size; beginning or ending the operation cycle of the machine tool part program; skipping or deleting operations such as may occur when reworking a work piece; editing the machine tool part program data using the local editing capabilities of the controller; and setting the feed rate override (FRO), spindle speed override (SSO), or the traverse rate override (TRO).**

These operator-initiated events are submitted via the operator interface, as disclosed at col. 6, lines 30-66:

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The computer user interface 14 permits two way interaction between the machine tool operator and computer 10. Computer user interface 14 may include a video display, flat panel display, touch screen, keyboard, or buttons as appropriate and serves as the user interface of local computer 10. The computer user interface 14 includes a display that produces a visual image corresponding to display signals from central processing unit 11 for the user

Of local computer 10 and the corresponding machine tool(s) 5, and input devices, i.e., touch screen keyboard, buttons that produce input signals as software interrupts that permit the machine tool operator to direct the operation of the system.

While not a requirement for the use of this invention, a touch screen display for the user interface is believed to be advantageous. A touch screen display can replace the keyboard, making a more friendly interface for the skilled machinists who run these machines. In addition, eliminating the keyboard eliminates a component susceptible to dirt in the manufacturing environment where machine tools exist. Touch screen displays are typically used with a Menu program. The computer is programmed to display various labelled regions on the touch screen display. The program performs a corresponding function when the machine tool operator touches one of these regions. This technique permits local computer 10 to change the meaning of various regions on the touch screen display to correspond to the current operating condition of machine tool 5. Thus local computer 10 can generate a display on computer user interface 14 having available options that is changeable to fit the circumstances. All possible available inputs need not be presented to the machine tool operator simultaneously, but only those relevant to the current operating state. Touch screen displays of the type described here are known in the art.

Since the user interface allows the machine operator to submit information regarding the use of the product, it would qualify as the claimed *user interface configured to probe for information regarding the use of the product*.

The Third Party points out that **Hutchins** discloses that the user interface is updated as the program runs in order to appraise the machine tool operator of the status of the machine tool at col. 14, lines 54-64:

**Subprogram 100 signals (sends a message to) the display program to update a window display of the operating program (processing block 104). Computer user interface 14 preferably shows a portion of the currently executing machine tool part program. The executing machine tool part program step is in a predetermined location within this window. The machine tool part program scrolls within this window when executing a new program step. This process serves to appraise the machine tool operator of the status of machine tool 5 within its machine tool part program.**

However, what **Hutchins** fails to disclose is any connection between the completion of the machine tool program (corresponding to the claimed *if a counter exceeds a threshold*) and the display of the user interface (corresponding to the claimed *cause the display of a user interface configured to probe for information regarding the use of the product*).

In light of the newly considered claim construction of the claimed *if the counter exceeds a threshold*, the rejections of claims 1, 5, 14, 15, 17, 26-28, 30 and 31 as being

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anticipated by **Hutchins** presented in the Office action mailed 11 October 2011 are withdrawn. The rejections proposed by the Third Party Requester based upon **Hutchins** are not adopted by the Office.

### **Response to Requirement for Information Under 37 C.F.R. § 1.105**

The Patent Owner's response to the RFI, filed 22 March 2012, establishes that a confidentiality agreement existed between the Harvard Business School (HBS) and the consultants (including inventor Daniel H. Abelow), and that this agreement obligated HBS to maintain "confidentiality of consultants' methodologies and systems" with regard to the Online Assessment System.

The 8 documents originally filed with the USPTO as Disclosure Document 290,592, filed 5 September 1991, do not qualify as prior art publications, in light of the confidentiality agreement between HBS and the consultants.

### **Claim Construction**

As discussed above, the Patent Owner's arguments regarding claim interpretation which renders other claim terms superfluous or "functionally

meaningless" (Patent Owner's response, page 18), as well as the portion of the specification of the '565 patent regarding the claimed counter (col. 29, lines 57-64), are persuasive. The claim language, read in light of the specification, would reasonably require a linkage between the display of the user interface and the trigger event which causes the counter to exceed a threshold.

Therefore, the clause "if the counter exceeds a threshold" is now interpreted to require the display of a user interface configured to probe for information regarding the use of a product in response to a trigger event which causes the counter to exceed a threshold.

#### 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



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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 negated by the manner in which the invention was made.

#### **Claim Rejections - 35 USC § 102 and § 103**

1. Claims 1, 3-5, 14, 15, 17, 26-28, 30 and 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over **Durden**.

2. Regarding claim 1, **Durden** teaches a unit (see disclosure of the control apparatus, col. 2, lines 11-12, see also disclosure of set-top terminal 15, drawing Figure 1 and col. 6, lines 43-48) substantially as claimed, comprising:

a) a memory (see memory 16 and 21, drawing Figure 1; see also col. 6, lines 57-61);

b) a transmitter (see disclosure of the transmission of the subscriber's billing information, reflecting the selected events, over a telephone network, col. 3, lines 39-41); and

c) a processor (see disclosure of the microprocessor, col. 2, lines 17-26 and col. 3, lines 39-41), coupled to the memory and to the transmitter, configured to:

i) monitor a product (the set-top terminal) for an occurrence in the product of a trigger event of a predetermined plurality of trigger events (see disclosure of the decrementing of free time and/or preview time counters on the average of every sixty seconds, col. 10, lines 20-26; see also col. 10, lines 60-66 and col. 11, lines 9-12);

ii) increment a counter corresponding to the trigger event upon detection of the occurrence of the trigger event (see disclosure of the decrementing of free time and/or preview time counters on the average of every sixty

seconds, col. 10, lines 20-26; see also col. 10, lines 60-66 and col. 11, lines 9-12);

iii) cause the display of a user interface configured to probe for information regarding a use of the product (see disclosure that the subscriber may, through the use of the hand-held remote control and a programming guide, request to purchase a desired event, col. 11, line 66 through col. 12, line 12; see also col. 10, lines 20-25);

iv) cause the memory to store an input received from the user interface (see disclosure of the user's entry of an access code in order to purchase a desired event, col. 7, lines 19-22; see also disclosure of the storage of data associated with the purchase of the desired event in memory, col. 6, lines 57-61 and col. 12, lines 8-14); and

v) cause the transmitter to transmit the input to a server (see disclosure of the transmission of stored data associated with the purchase of a desired event to the cable operator via a telephone network, col. 6, lines 57-61).

Durden does not explicitly disclose that the user interface configured to probe for information regarding the use of the product is displayed *if the counter exceeds a threshold.*

However, it would have been obvious to one of ordinary skill in the art at the time of the invention to display the user interface in response to the counter exceeding a threshold.

Durden discloses that upon the expiration of preview time and free time, the impulse pay-per-view module will de-authorize all impulse pay-per-view channels and "close out" all impulse pay-per-view events that are in progress at col. 11, lines 17-24:

**A security counter controls the length of time that an impulse pay-per-view module will allow the cable TV subscriber to view an impulse pay-per-view channel without receiving an IPPV authorization transaction. When that length of time has elapsed, the impulse pay-per-view module will deauthorize all impulse pay-per-view channels and "close out" all impulse pay-per-view events that are in progress.**

Durden further discloses that the free time and preview time generators permit subscribers to receive an event for a predetermined amount of time before requiring them to purchase the event at col. 2, lines 45-55:

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A preview time generator, responsive to the system operator, generates a downloadable transaction to permit the plurality of subscribers to receive an event for a predetermined preview time period before requiring the subscribers to purchase an event. The apparatus also includes a free time generator responsive to the system operator which generates a downloadable transaction which permits the plurality of subscribers to further receive the event for a predetermined free time period before requiring the subscribers to purchase the event.

Since the system disclosed by Durden would "close out" all pay-per-view events upon the expiration of free time and preview time, and in order for the subscriber to continue to view the event they have begun to watch, they are required to purchase the event, it would have been obvious to one of ordinary skill in the art at the time of the invention, upon expiration of the free time and preview time counters [the claimed *if the counter exceeds a threshold*], to display a user interface offering the subscriber the opportunity to purchase the event [the claimed *user interface configured to probe for information regarding the use of the product*], since otherwise the subscriber would simply have the event they are watching suddenly blocked, and the reason for this might not be apparent to the subscriber without the system notifying them to give them the opportunity to purchase the event in order to continue watching.

3. Regarding claim 15, **Durden** teaches a method substantially as claimed,

comprising:

- a) monitoring a product (the set-top terminal) for an occurrence in the product of a trigger event of a predetermined plurality of trigger events (see disclosure of the decrementing of free time and/or preview time counters on the average of every sixty seconds, col. 10, lines 20-26; see also col. 10, lines 60-66 and col. 11, lines 9-12);
- b) incrementing a counter corresponding to the trigger event upon detection of the occurrence of the trigger event (see disclosure of the decrementing of free time and/or preview time counters on the average of every sixty seconds, col. 10, lines 20-26; see also col. 10, lines 60-66 and col. 11, lines 9-12);
- c) displaying a user interface configured to probe for information regarding a use of the product (see disclosure that the subscriber may, through the use of the hand-held remote control and a programming guide, request to purchase a desired event, col. 11, line 66 through col. 12, line 12; see also col. 10, lines 20-25);
- d) storing an input received from the user interface on a device (see disclosure of the user's entry of an access code in order to purchase a desired event, col.

7, lines 19-22; see also disclosure of the storage of data associated with the purchase of the desired event in memory, col. 6, lines 57-61 and col. 12, lines 8-14); and

e) transmitting the input to a server (see disclosure of the transmission of stored data associated with the purchase of a desired event to the cable operator via a telephone network, col. 6, lines 57-61).

**Durden** does not explicitly disclose that the user interface configured to probe for information regarding the use of the product is displayed *if the counter exceeds a threshold*.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention to display the user interface in response to the counter exceeding a threshold.

**Durden** discloses that upon the expiration of preview time and free time, the impulse pay-per-view module will de-authorize all impulse pay-per-view channels and "close out" all impulse pay-per-view events that are in progress at col. 11, lines 17-24:

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**A security counter controls the length of time that an impulse pay-per-view module will allow the cable TV subscriber to view an impulse pay-per-view channel without receiving an IPPV authorization transaction. When that length of time has elapsed, the impulse pay-per-view module will deauthorize all impulse pay-per-view channels and "close out" all impulse pay-per-view events that are in progress.**

Durden further discloses that the free time and preview time generators permit subscribers to receive an event for a predetermined amount of time before requiring them to purchase the event at col. 2, lines 45-55:

**A preview time generator, responsive to the system operator, generates a downloadable transaction to permit the plurality of subscribers to receive an event for a predetermined preview time period before requiring the subscribers to purchase an event. The apparatus also includes a free time generator responsive to the system operator which generates a downloadable transaction which permits the plurality of subscribers to further receive the event for a predetermined free time period before requiring the subscribers to purchase the event.**

Since the system disclosed by Durden would "close out" all pay-per-view events upon the expiration of free time and preview time, and in order for the subscriber to continue to view the event they have begun to watch, they are required to purchase the event, it would have been obvious to one of ordinary skill in the art at the time of the invention, upon expiration of the free time and preview time counters [the claimed *if the*



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*counter exceeds a threshold*], to display a user interface offering the subscriber the opportunity to purchase the event [the claimed *user interface configured to próbe for information regarding the use of the product*], since otherwise the subscriber would simply have the event they are watching suddenly blocked, and the reason for this might not be apparent to the subscriber without the system notifying them to give them the opportunity to purchase the event in order to continue watching.

4. Regarding claim 27, **Durden** teaches a tangible computer-readable medium having stored thereon computer executable instructions that, if executed by a computing device, cause the computing device to perform a method substantially as claimed (see disclosure of the control apparatus including a microprocessor, col. 2, lines 11-25 et seq.), comprising:

- a) monitoring a product (the set-top terminal) for an occurrence in the product of a trigger event of a predetermined plurality of trigger events (see disclosure of the decrementing of free time and/or preview time counters on the average of every sixty seconds, col. 10, lines 20-26; see also col. 10, lines 60-66 and col. 11, lines 9-12);

- b) incrementing a counter corresponding to the trigger event upon detection of the occurrence of the trigger event (see disclosure of the decrementing of free time and/or preview time counters on the average of every sixty seconds, col. 10, lines 20-26; see also col. 10, lines 60-66 and col. 11, lines 9-12);
- c) displaying a user interface configured to probe for information regarding a use of the product (see disclosure that the subscriber may, through the use of the hand-held remote control and a programming guide, request to purchase a desired event, col. 11, line 66 through col. 12, line 12; see also col. 10, lines 20-25);
- d) storing an input received from the user interface on a device (see disclosure of the user's entry of an access code in order to purchase a desired event, col. 7, lines 19-22; see also disclosure of the storage of data associated with the purchase of the desired event in memory, col. 6, lines 57-61 and col. 12, lines 8-14); and
- e) transmitting the input to a server (see disclosure of the transmission of stored data associated with the purchase of a desired event to the cable operator via a telephone network, col. 6, lines 57-61).

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Durden does not explicitly disclose that the user interface configured to probe for information regarding the use of the product is displayed *if the counter exceeds a threshold.*

However, it would have been obvious to one of ordinary skill in the art at the time of the invention to display the user interface in response to the counter exceeding a threshold.

Durden discloses that upon the expiration of preview time and free time, the impulse pay-per-view module will de-authorize all impulse pay-per-view channels and "close out" all impulse pay-per-view events that are in progress at col. 11, lines 17-24:

**A security counter controls the length of time that an impulse pay-per-view module will allow the cable TV subscriber to view an impulse pay-per-view channel without receiving an IPPV authorization transaction. When that length of time has elapsed, the impulse pay-per-view module will deauthorize all impulse pay-per-view channels and "close out" all impulse pay-per-view events that are in progress.**

Durden further discloses that the free time and preview time generators permit subscribers to receive an event for a predetermined amount of time before requiring them to purchase the event at col. 2, lines 45-55:

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A preview time generator, responsive to the system operator, generates a downloadable transaction to permit the plurality of subscribers to receive an event for a predetermined preview time period before requiring the subscribers to purchase an event. The apparatus also includes a free time generator responsive to the system operator which generates a downloadable transaction which permits the plurality of subscribers to further receive the event for a predetermined free time period before requiring the subscribers to purchase the event.

Since the system disclosed by Durden would "close out" all pay-per-view events upon the expiration of free time and preview time, and in order for the subscriber to continue to view the event they have begun to watch, they are required to purchase the event, it would have been obvious to one of ordinary skill in the art at the time of the invention, upon expiration of the free time and preview time counters [the claimed *if the counter exceeds a threshold*], to display a user interface offering the subscriber the opportunity to purchase the event [the claimed *user interface configured to probe for information regarding the use of the product*], since otherwise the subscriber would simply have the event they are watching suddenly blocked, and the reason for this might not be apparent to the subscriber without the system notifying them to give them the opportunity to purchase the event in order to continue watching.

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5. Regarding claim 30, **Durden** teaches a physical unit (see disclosure of the control apparatus, col. 2, lines 11-12, see also disclosure of set-top terminal 15, drawing Figure 1 and col. 6, lines 43-48) substantially as claimed, comprising:

- a) means for monitoring a product (the set-top terminal) for an occurrence in the product of a trigger event of a predetermined plurality of trigger events (see disclosure of the decrementing of free time and/or preview time counters on the average of every sixty seconds, col. 10, lines 20-26; see also col. 10, lines 60-66 and col. 11, lines 9-12);
- b) means for incrementing a counter corresponding to the trigger event upon detection of the occurrence of the trigger event (see disclosure of the decrementing of free time and/or preview time counters on the average of every sixty seconds, col. 10, lines 20-26; see also col. 10, lines 60-66 and col. 11, lines 9-12);
- c) means for probing for information regarding a use of the product (see disclosure that the subscriber may, through the use of the hand-held remote control and a programming guide, request to purchase a desired event, col. 11, line 66 through col. 12, line 12; see also col. 10, lines 20-25);
- d) means for storing an input received from the means for probing (see disclosure of the user's entry of an access code in order to purchase a

desired event, col. 7, lines 19-22; see also disclosure of the storage of data associated with the purchase of the desired event in memory, col. 6, lines 57-61 and col. 12, lines 8-14); and

e) means for transmitting the input to a server (see disclosure of the transmission of stored data associated with the purchase of a desired event to the cable operator via a telephone network, col. 6, lines 57-61).

**Durden** does not explicitly disclose that the means for probing for information regarding the use of the product is displayed *if the counter exceeds a threshold*.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention to display a user interface in response to the counter exceeding a threshold.

**Durden** discloses that upon the expiration of preview time and free time, the impulse pay-per-view module will de-authorize all impulse pay-per-view channels and "close out" all impulse pay-per-view events that are in progress at col. 11, lines 17-24:

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**A security counter controls the length of time that an impulse pay-per-view module will allow the cable TV subscriber to view an impulse pay-per-view channel without receiving an IPPV authorization transaction. When that length of time has elapsed, the impulse pay-per-view module will deauthorize all impulse pay-per-view channels and "close out" all impulse pay-per-view events that are in progress.**

Durden further discloses that the free time and preview time generators permit subscribers to receive an event for a predetermined amount of time before requiring them to purchase the event at col. 2, lines 45-55:

**A preview time generator, responsive to the system operator, generates a downloadable transaction to permit the plurality of subscribers to receive an event for a predetermined preview time period before requiring the subscribers to purchase an event. The apparatus also includes a free time generator responsive to the system operator which generates a downloadable transaction which permits the plurality of subscribers to further receive the event for a predetermined free time period before requiring the subscribers to purchase the event.**

Since the system disclosed by Durden would "close out" all pay-per-view events upon the expiration of free time and preview time, and in order for the subscriber to continue to view the event they have begun to watch, they are required to purchase the event, it would have been obvious to one of ordinary skill in the art at the time of the invention, upon expiration of the free time and preview time counters [the claimed *if the*

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*counter exceeds a threshold*], to display a user interface offering the subscriber the opportunity to purchase the event [the claimed *user interface configured to probe for information regarding the use of the product*], since otherwise the subscriber would simply have the event they are watching suddenly blocked, and the reason for this might not be apparent to the subscriber without the system notifying them to give them the opportunity to purchase the event in order to continue watching.

6. Regarding claim 3, **Durden** additionally teaches a unit wherein the input reflects a submission of a purchase order (see disclosure that the subscriber can enter an event ID of a desired event in order to purchase that event, col. 12, lines 5-12 et seq.).

7. Regarding claim 4, **Durden** additionally teaches a unit wherein the input reflects a request for interactive assistance (see disclosure of the use of the programming guide in the selection of desired events, col. 12, lines 5-12).

8. Regarding claim 5, **Durden** additionally teaches a unit wherein the processor is further configured to monitor the product for an occurrence in the product of a second triggering event of the predefined plurality of trigger events, and increment a second



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counter corresponding to the second trigger event upon detection of the occurrence of the second trigger event in the product (see disclosure that each subscriber has a plurality of counters corresponding to a number of pay channels, col. 10, lines 51-54 et seq.).

9. Regarding claim 14, **Durden** additionally teaches a unit wherein the processor is further configured to increment the counter corresponding to the trigger event upon detection of a second occurrence of the trigger event (see disclosure that the free time and preview time counters are decremented periodically, on average every sixty seconds, col. 11, lines 9-12 et seq.).

10. Regarding claim 17, **Durden** additionally teaches a method further comprising monitoring the product for an occurrence in the product of a second triggering event of the predefined plurality of trigger events, and increment a second counter corresponding to the second trigger event upon detection of the occurrence of the second trigger event in the product (see disclosure that each subscriber has a plurality of counters corresponding to a number of pay channels, col. 10, lines 51-54 et seq.).

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11. Regarding claim 26, **Durden** additionally teaches a method further comprising incrementing the counter corresponding to the trigger event upon detection of a second occurrence of the trigger event in the product (see disclosure that the free time and preview time counters are decremented periodically, on average every sixty seconds, col. 11, lines 9-12 et seq.).

12. Regarding claim 28, **Durden** additionally teaches a tangible computer readable medium wherein the monitoring further comprises monitoring the product for an occurrence in the product of a second triggering event of the predefined plurality of trigger events, and incrementing a second counter corresponding to the second trigger event upon detection of the occurrence of the second trigger event in the product (see disclosure that each subscriber has a plurality of counters corresponding to a number of pay channels, col. 10, lines 51-54 et seq.).

13. Regarding claim 31, **Durden** additionally teaches a physical unit further comprising means for monitoring the product for an occurrence in the product of a second triggering event of the predefined plurality of trigger events, and means for incrementing a second counter corresponding to the second trigger event upon detection of the occurrence of the second trigger event in the product (see disclosure

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that each subscriber has a plurality of counters corresponding to a number of pay channels, col. 10, lines 51-54 et seq.).

14. Claims 1, 5, 6, 14, 15, 17, 18 and 26-32 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over **Thacher**.

15. Regarding claim 1, **Thacher** teaches a unit (see disclosure of video game machines, col. 2, lines 53-55) substantially as claimed, comprising:

a) a memory (see disclosure of internal memory, col. 4, lines 62-65);

b) a transmitter (see disclosure of the transmission of score data to a data link for transmission to the central computer, col. 4, line 66 through col. 5, line 2; see also disclosure of an apparatus for reading data stored in the game memory to obtain score data and to transmit the score data to the communications port, col. 5, lines 2-24; see also col. 5, lines 61-63 and col. 6, lines 1-6); and

c) a processor (see disclosure that the units are microprocessor-based, col. 2, lines 1-11), coupled to the memory and to the transmitter, configured to:

- i) monitor a product (the game terminal) for an occurrence in the product of a trigger event of a predetermined plurality of trigger events (see disclosure of the decrementing of a counter of "tries" or "men" as the game progresses, col. 11, lines 52-66; see also col. 14, lines 52-59);
- ii) increment a counter corresponding to the trigger event upon detection of the occurrence of the trigger event (see disclosure of the decrementing of a counter of "tries" or "men" as the game progresses, col. 11, lines 52-66; see also col. 14, lines 52-59);
- iii) cause the display of a user interface configured to probe for information regarding a use of the product if the counter exceeds a threshold (see disclosure that the game console recognizes the end of a game when the counter of "men" or "tries" is decremented to zero [the claimed *if the counter exceeds a threshold*], col. 11, lines 52-66; see also col. 14, lines 52-59; see also disclosure that at the end of the game, the score is transmitted to the central computer and is stored, col. 2, line 67 through col. 3, line 1; see also disclosure that in one embodiment, a validated user may enter his score manually on a keyboard associated with the video game, col. 3, lines 3-5; the fact that the scores are transmitted to the central computer upon the completion of the game

renders inherent the fact that the system displays a user interface prompting the validated user for input of their score [the claimed *information regarding the use of the product*], since otherwise the system would have no way to know how long to wait for the user to submit the score information before attempting transmission of score data to the central computer);

iv) cause the memory to store an input received from the user interface (see disclosure of the storage of score data, col. 4, line 62 through col. 5, line 2); and

v) cause the transmitter to transmit the input to a server (see disclosure of the transmission of score data to the central computer, col. 2, lines 67-68 and col. 4, line 62 through col. 5, line 2).

To the extent that it could be argued that the display of a user interface to probe for information regarding a use of the product if the counter exceeds a threshold is not inherent, it would have been obvious to one of ordinary skill in the art at the time of the invention to display a user interface to the validated user to prompt them for score data [the claimed *probing for information regarding the use of the product*] in response to a game's completion [the claimed *if the counter exceeds a threshold*], because **Thacher**

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discloses that upon the completion of a game, the score data is transmitted to the central computer.

If the game console is to receive score data from the validated user, and the game console must transmit the score data to the central computer, it would have been obvious to an ordinary artisan at the time of the invention to display a user interface to the validated user to prompt them for input of their score immediately upon completion of a game, because otherwise the game console must wait an undetermined amount of time, or even forever, before receiving the score data that needs to be transmitted to the central computer.

16. Regarding claim 15, **Thacher** teaches a method substantially as claimed, comprising:

- a) monitoring a product (the game terminal) for an occurrence in the product of a trigger event of a predetermined plurality of trigger events (see disclosure of the decrementing of a counter of "tries" or "men" as the game progresses, col. 11, lines 52-66; see also col. 14, lines 52-59);
- b) incrementing a counter corresponding to the trigger event upon detection of the occurrence of the trigger event (see disclosure of the decrementing of a

counter of "tries" or "men" as the game progresses, col. 11, lines 52-66; see also col. 14, lines 52-59);

- c) displaying a user interface configured to probe for information regarding a use of the product if the counter exceeds a threshold (see disclosure that the game console recognizes the end of a game when the counter of "men" or "tries" is decremented to zero [the claimed *if the counter exceeds a threshold*], col. 11, lines 52-66; see also col. 14, lines 52-59; see also disclosure that at the end of the game, the score is transmitted to the central computer and is stored, col. 2, line 67 through col. 3, line 1; see also disclosure that in one embodiment, a validated user may enter his score manually on a keyboard associated with the video game, col. 3, lines 3-5; the fact that the scores are transmitted to the central computer upon the completion of the game renders inherent the fact that the system displays a user interface prompting the validated user for input of their score [the claimed *information regarding the use of the product*], since otherwise the system would have no way to know how long to wait for the user to submit the score information before attempting transmission of score data to the central computer);
- d) storing an input received from the user interface (see disclosure of the storage of score data, col. 4, line 62 through col. 5, line 2); and

e) transmitting the input to a server (see disclosure of the transmission of score data to the central computer, col. 2, lines 67-68 and col. 4, line 62 through col. 5, line 2).

To the extent that it could be argued that the display of a user interface to probe for information regarding a use of the product if the counter exceeds a threshold is not inherent, it would have been obvious to one of ordinary skill in the art at the time of the invention to display a user interface to the validated user to prompt them for score data [the claimed *probing for information regarding the use of the product*] in response to a game's completion [the claimed *if the counter exceeds a threshold*], because **Thacher** discloses that upon the completion of a game, the score data is transmitted to the central computer.

If the game console is to receive score data from the validated user, and the game console must transmit the score data to the central computer, it would have been obvious to an ordinary artisan at the time of the invention to display a user interface to the validated user to prompt them for input of their score immediately upon completion of a game, because otherwise the game console must wait an undetermined amount of time, or even forever, before receiving the score data that needs to be transmitted to the central computer.



17. Regarding claim 27, **Thacher** teaches a tangible computer-readable medium having stored thereon computer executable instructions that, if executed by a computing device, cause the computing device to perform a method substantially as claimed (see disclosure of firmware, col. 12, lines 18-22; see also disclosure of the downloading of different programs from the central computer in order to change the game being played, col. 18, lines 64-68), comprising:

- a) monitoring a product (the game terminal) for an occurrence in the product of a trigger event of a predetermined plurality of trigger events (see disclosure of the decrementing of a counter of "tries" or "men" as the game progresses, col. 11, lines 52-66; see also col. 14, lines 52-59);
- b) incrementing a counter corresponding to the trigger event upon detection of the occurrence of the trigger event (see disclosure of the decrementing of a counter of "tries" or "men" as the game progresses, col. 11, lines 52-66; see also col. 14, lines 52-59);
- c) displaying a user interface configured to probe for information regarding a use of the product if the counter exceeds a threshold (see disclosure that the game console recognizes the end of a game when the counter of "men" or

"tries" is decremented to zero [the claimed *if the counter exceeds a threshold*], col. 11, lines 52-66; see also col. 14, lines 52-59; see also disclosure that at the end of the game, the score is transmitted to the central computer and is stored, col. 2, line 67 through col. 3, line 1; see also disclosure that in one embodiment, a validated user may enter his score manually on a keyboard associated with the video game, col. 3, lines 3-5; the fact that the scores are transmitted to the central computer upon the completion of the game renders inherent the fact that the system displays a user interface prompting the validated user for input of their score [the claimed *information regarding the use of the product*], since otherwise the system would have no way to know how long to wait for the user to submit the score information before attempting transmission of score data to the central computer);

- d) storing an input received from the user interface (see disclosure of the storage of score data, col. 4, line 62 through col. 5, line 2); and
- e) transmitting the input to a server (see disclosure of the transmission of score data to the central computer, col. 2, lines 67-68 and col. 4, line 62 through col. 5, line 2).

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To the extent that it could be argued that the display of a user interface to probe for information regarding a use of the product if the counter exceeds a threshold is not inherent, it would have been obvious to one of ordinary skill in the art at the time of the invention to display a user interface to the validated user to prompt them for score data [the claimed *probing for information regarding the use of the product*] in response to a game's completion [the claimed *if the counter exceeds a threshold*], because **Thacher** discloses that upon the completion of a game, the score data is transmitted to the central computer.

If the game console is to receive score data from the validated user, and the game console must transmit the score data to the central computer, it would have been obvious to an ordinary artisan at the time of the invention to display a user interface to the validated user to prompt them for input of their score immediately upon completion of a game, because otherwise the game console must wait an undetermined amount of time, or even forever, before receiving the score data that needs to be transmitted to the central computer.

18. Regarding claim 30, **Thacher** teaches a physical unit (see disclosure of video game machines, col. 2, lines 53-55) substantially as claimed, comprising:

- a) means for monitoring a product (the game terminal) for an occurrence in the product of a trigger event of a predetermined plurality of trigger events (see disclosure of the decrementing of a counter of "tries" or "men" as the game progresses, col. 11, lines 52-66; see also col. 14, lines 52-59);
- b) means for incrementing a counter corresponding to the trigger event upon detection of the occurrence of the trigger event (see disclosure of the decrementing of a counter of "tries" or "men" as the game progresses, col. 11, lines 52-66; see also col. 14, lines 52-59);
- c) means for probing for information regarding a use of the product if the counter exceeds a threshold (see disclosure that the game console recognizes the end of a game when the counter of "men" or "tries" is decremented to zero [the claimed *if the counter exceeds a threshold*], col. 11, lines 52-66; see also col. 14, lines 52-59; see also disclosure that at the end of the game, the score is transmitted to the central computer and is stored, col. 2, line 67 through col. 3, line 1; see also disclosure that in one embodiment, a validated user may enter his score manually on a keyboard associated with the video game, col. 3, lines 3-5; the fact that the scores are transmitted to the central computer upon the completion of the game renders inherent the fact that the system displays a user interface prompting the validated user

for input of their score [the claimed *information regarding the use of the product*], since otherwise the system would have no way to know how long to wait for the user to submit the score information before attempting transmission of score data to the central computer);

d) means for storing an input received from the user interface (see disclosure of the storage of score data, col. 4, line 62 through col. 5, line 2); and

e) means for transmitting the input to a server (see disclosure of the transmission of score data to the central computer, col. 2, lines 67-68 and col. 4, line 62 through col. 5, line 2).

To the extent that it could be argued that the display of a user interface to probe for information regarding a use of the product if the counter exceeds a threshold is not inherent, it would have been obvious to one of ordinary skill in the art at the time of the invention to display a user interface to the validated user to prompt them for score data [the claimed *probing for information regarding the use of the product*] in response to a game's completion [the claimed *if the counter exceeds a threshold*], because Thacher discloses that upon the completion of a game, the score data is transmitted to the central computer.

If the game console is to receive score data from the validated user, and the game console must transmit the score data to the central computer, it would have been obvious to an ordinary artisan at the time of the invention to display a user interface to the validated user to prompt them for input of their score immediately upon completion of a game, because otherwise the game console must wait an undetermined amount of time, or even forever, before receiving the score data that needs to be transmitted to the central computer.

19. Regarding claim 5, **Thacher** additionally teaches a unit wherein the processor is further configured to monitor the product for an occurrence in the product of a second triggering event of the predefined plurality of trigger events, and increment a second counter corresponding to the second trigger event upon detection of the occurrence of the second trigger event in the product (see disclosure of the tracking of each player's score during the playing of a game, said score [the claimed *second counter*] being incremented upon each occurrence of a score-producing event [the claimed *second trigger event*], col. 8, lines 1-2 et seq.).

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20. Regarding claim 6, **Thacher** additionally teaches a unit wherein the processor is further configured to cause the memory to store the second counter, and cause the transmitter to transmit the value of the second counter (see disclosure that the score data [the claimed *second counter*] is stored in a memory, and transmitted to the central computer, col. 2, lines 29-33 et seq.).

21. Regarding claim 14, **Thacher** additionally teaches a unit wherein the processor is further configured to increment the counter corresponding to the trigger event upon detection of a second occurrence of the trigger event (see disclosure of the decrementing of a counter of "tries" or "men" as the game progresses, col. 11, lines 52-66; see also col. 14, lines 52-59).

22. Regarding claim 17, **Thacher** additionally teaches a method further comprising monitoring the product for an occurrence in the product of a second triggering event of the predefined plurality of trigger events, and incrementing a second counter corresponding to the second trigger event upon detection of the occurrence of the second trigger event in the product (see disclosure of the tracking of each player's score during the playing of a game, said score [the claimed *second counter*] being incremented

upon each occurrence of a score-producing event [the claimed *second trigger event*], col. 8, lines 1-2 et seq.).

23. Regarding claim 18, **Thacher** additionally teaches a method further comprising storing the second counter on the device, and transmitting the value of the second counter to the server (see disclosure that the score data [the claimed *second counter*] is stored in a memory, and transmitted to the central computer, col. 2, lines 29-33 et seq.).

24. Regarding claim 26, **Thacher** additionally teaches a method further comprising incrementing the counter corresponding to the trigger event upon detection of a second occurrence of the trigger event in the product (see disclosure of the decrementing of a counter of "tries" or "men" as the game progresses, col. 11, lines 52-66; see also col. 14, lines 52-59).

25. Regarding claim 28, **Thacher** additionally teaches a tangible computer readable medium wherein the monitoring further comprises monitoring the product for an occurrence in the product of a second triggering event of the predefined plurality of trigger events, and incrementing a second counter corresponding to the second trigger event upon detection of the occurrence of the second trigger event in the product (see



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disclosure of the tracking of each player's score during the playing of a game, said score [the claimed *second counter*] being incremented upon each occurrence of a score-producing event [the claimed *second trigger event*], col. 8, lines 1-2 et seq.).

26. Regarding claim 29, **Thacher** additionally teaches a tangible computer readable medium wherein the method further includes storing the second counter on the device, and causing the transmitter to transmit the value of the second counter to the server (see disclosure that the score data [the claimed *second counter*] is stored in a memory, and transmitted to the central computer, col. 2, lines 29-33 et seq.).

27. Regarding claim 31, **Thacher** additionally teaches a physical unit further comprising means for monitoring the product for an occurrence in the product of a second triggering event of the predefined plurality of trigger events, and means for incrementing a second counter corresponding to the second trigger event upon detection of the occurrence of the second trigger event in the product (see disclosure of the tracking of each player's score during the playing of a game, said score [the claimed *second counter*] being incremented upon each occurrence of a score-producing event [the claimed *second trigger event*], col. 8, lines 1-2 et seq.).

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28. Regarding claim 32, **Thacher** additionally teaches a physical unit further comprising means for storing the second counter on the device, and means for causing the transmitter to transmit the value of the second counter to the server (see disclosure that the score data [the claimed *second counter*] is stored in a memory, and transmitted to the central computer, col. 2, lines 29-33 et seq.).

#### 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:

##### **Kravette**

Independent claims 1, 15, 27 and 30 include the feature of *monitor[ing] a product for an occurrence in the product of a trigger event of a plurality of trigger events.*

However, while **Kravette** does disclose taking an action upon the occurrence of a triggering event (a copy being made) which increments a counter and checks to see if the counter exceeds a threshold, the action taken is disclosed as the transmission of an accumulative count to a central station; col. 2, line 50 through col. 3, line 7:

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Generally speaking, in accordance with the invention, a system for monitoring a printing or paper processing device, such as a photocopier, and automatically notifying the appropriate off site parties at appropriate times of the status of the photocopier as well as the status of the service contract and preventive maintenance needs is provided. A counter counts the number of papers processed by the copier producing a count signal. A monitoring system computer receives the count signal and increments a count value over a predetermined period. An interface circuit monitors the operation of the copier by monitoring the internal diagnostic signals of the copier as displayed on a photocopier display device associated with each copier and signals a central station when a malfunction of the copier has occurred, indicating the nature of the problem by translating the diagnostic signal and transmitting a translated diagnostic signal. The monitoring system computer also transmits both an accumulative count once the prede-

termined time period has elapsed or once a predetermined number of counts has occurred indicating the number of papers which have been processed. A modem receives the accumulative count and diagnostic signals from the monitoring system computer and transmits each signal to the appropriate party at the central station.

Kravette additionally discloses that at a predetermined time or upon a predetermined event, a report for each of the copiers is transmitted to the central station; col. 3, lines 17-27.

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**A plurality of copiers at a single site may be provided with a local area network. A master controller containing a single modem is attached to a single telephone line. The controller polls the monitoring system computer at each copier through the local area network to ascertain the number of copies made and the maintenance status of each copier. At a predetermined time or upon predetermined events such as a maintenance requirement at a particular copier, the controller transmits a single report for each of the copiers through the modem to a central station.**

However, the transmission of reports from the copiers to the central station cannot be equated to the display of a user interface configured to probe for information regarding the use of the product.

Kravette also discloses a portable input/output device 34. Although the service person does input information via portable input/output device 34 regarding use of the product, the user interface is displayed when the service person connects the device to the copier while performing maintenance. There is no connection between the counter having reached a threshold and the claimed *display of the user interface configured to probe for information regarding the use of the product.*

Kravette fails to disclose the claimed feature of independent claims 1, 15, 27 and 30 of *displaying a user interface configured to probe for information regarding a use of the product if the counter exceeds a threshold.*

### Hutchins

**Hutchins** teaches a system for collecting event data from a machine tool, said event data including both ordinary program steps from within the machine tool part program, and events representing operator intervention of the programmed process operating on the machine tool (see Abstract). The system includes a local computer having an operator interface (see item 14, drawing Figure 7). The operator interface provides two-way interaction between the machine tool operator and computer 10, and may include a video display, flat panel display, touch screen, keyboard or buttons as appropriate (see col. 6, lines 30-38).

The operator may perform a number of actions (operator-initiated events) which can be interpreted as providing information regarding a use of the product. Col. 3, lines 18-27 discloses:

**These machine tool operator initiated events include, but are not limited to: down-loading a machine tool part program to the machine tool; setting the batch size; beginning or ending the operation cycle of the machine tool part program; skipping or deleting operations such as may occur when reworking a work piece; editing the machine tool part program data using the local editing capabilities of the controller; and setting the feed rate override (FRO), spindle speed override (SSO), or the traverse rate override (TRO).**

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These operator-initiated events are submitted via the operator interface, as disclosed at col. 6, lines 30-66:

The computer user interface 14 permits two way interaction between the machine tool operator and computer 10. Computer user interface 14 may include a video display, flat panel display, touch screen, keyboard, or buttons as appropriate and serves as the user interface of local computer 10. The computer user interface 14 includes a display that produces a visual image corresponding to display signals from central processing unit 11 for the user

Of local computer 10 and the corresponding machine tool(s) 5, and input devices, i.e., touch screen keyboard, buttons that produce input signals as software interrupts that permit the machine tool operator to direct the operation of the system.

While not a requirement for the use of this invention, a touch screen display for the user interface is believed to be advantageous. A touch screen display can replace the keyboard, making a more friendly interface for the skilled machinists who run these machines. In addition, eliminating the keyboard eliminates a component susceptible to dirt in the manufacturing environment where machine tools exist. Touch screen displays are typically used with a Menu program. The computer is programmed to display various labelled regions on the touch screen display. The program performs a corresponding function when the machine tool operator touches one of these regions. This technique permits local computer 10 to change the meaning of various regions on the touch screen display to correspond to the current operating condition of machine tool 5. Thus local computer 10 can generate a display on computer user interface 14 having available options that is changeable to fit the circumstances. All possible available inputs need not be presented to the machine tool operator simultaneously, but only those relevant to the current operating state. Touch screen displays of the type described here are known in the art.

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Since the user interface allows the machine operator to submit information regarding the use of the product, it would qualify as the claimed *user interface configured to probe for information regarding the use of the product*.

Hutchins does disclose that the user interface is updated as the program runs in order to appraise the machine tool operator of the status of the machine tool at col. 14, lines 54-64:

**Subprogram 100 signals (sends a message to) the display program to update a window display of the operating program (processing block 104). Computer user interface 14 preferably shows a portion of the currently executing machine tool part program. The executing machine tool part program step is in a predetermined location within this window. The machine tool part program scrolls within this window when executing a new program step. This process serves to appraise the machine tool operator of the status of machine tool 5 within its machine tool part program.**

However, what Hutchins fails to disclose is any connection between the completion of the machine tool program (corresponding to the claimed *if a counter exceeds a threshold*) and the display of the user interface (corresponding to the claimed *cause the display of a user interface configured to probe for information regarding the use of the product*).

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**Claim 2**

Regarding claim 2, the Requestor maps **Durden's** 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** 45  
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 request a variety of services such as scheduling a product maintenance appointment, 50 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.

Additionally, the Requestor maps **Thacher's** 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*.

### Claim 7

Regarding claim 7, the Requestor did not propose rejections of claim 7 in light of **Durden** or **Thacher**.

### Claims 8 & 9

Regarding claim 8 (and dependent claim 9), the Requestor maps **Durden's** 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*.

Further 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) disclosed by **Thacher** to the claimed *wherein one of the predefined plurality of trigger*

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*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).

### Claims 10 & 11

Regarding claim 10 (and dependent claim 11), the Requestor maps Durden's 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*.

Further 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) disclosed by **Thacher** 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*.

### **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 **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.

**Claims 19 & 21**

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Regarding claim 19 (and dependent claim 21), the Requestor maps **Durden's** 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*.

Further 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) disclosed by **Thacher** to the claimed *one of the predefined plurality of trigger events is a*

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*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).

### **Claim 20**

Regarding claim 20, the Requestor did not propose rejections of claim 20 in light of **Durden** or **Thacher**.

### **Claim 22**



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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) disclosed by **Durden** 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*.

Further 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) disclosed by **Thacher** to the claimed *wherein a trigger event of the predefined*

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*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*.

### 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

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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 **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.

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. 7,620,565 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.

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,

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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.

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).

Any paper filed with the Office, i.e., any submission made, by either the patent owner or the third party requester must be served on every other party in the reexamination proceeding including any other third party requester that is part of the proceeding due to merger of reexamination proceedings.

As proof of service, the party submitting the paper to the Office must attach a certificate of service to the paper. It is required that the certificate of service set forth the

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name and address of the party served and the method of service. Further, a copy of the certificate of service must be attached with the copy of the paper that is served on the other party. The failure of the patent owner or the third party requester to serve documents may result in their being refused consideration. See MPEP § 2666.06 and 37 C.F.R. § 1.903.

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  
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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:

/Michael J. Yigdall/  
Primary Examiner, Art Unit 3992

/Sudhanshu C. Pathak/  
Supervisory Patent Examiner  
Art Unit 3992

lsw  
9 August 2012