



UNITED STATES PATENT AND TRADEMARK OFFICE

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

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO. Includes details for application 95/001,789, inventor FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP, and examiner FOSTER, ROLAND G.

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.

Transmittal of Communication to Third Party Requester Inter Partes Reexamination	Control No.	Patent Under Reexamination	
	95/001,789	7921211	
	Examiner	Art Unit	
	ROLAND FOSTER	3992	

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

┌────────────────────────────────── (THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS) ───────────────────────────────────┐

SIDLEY AUSTIN LLP
717 NORTH HARWOOD
SUITE 3400
DALLAS, TX 75201

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.

**Right of Appeal Notice
(37 CFR 1.953)**

Control No.	Patent Under Reexamination
95/001,789	7921211
Examiner	Art Unit
ROLAND FOSTER	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 26 December, 2012
Third Party(ies) on 23 January, 2013

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

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

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

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

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

- 1a. Claims 1-60 are subject to reexamination.
- 1b. Claims _____ are not subject to reexamination.
- 2. Claims _____ have been cancelled.
- 3. Claims _____ are confirmed. [Unamended patent claims].
- 4. Claims _____ are patentable. [Amended or new claims].
- 5. Claims 1-60 are rejected.
- 6. Claims _____ are objected to.
- 7. The drawings filed on _____ are acceptable. are not acceptable.
- 8. The drawing correction request filed on _____ is approved. disapproved.
- 9. Acknowledgment is made of the claim for priority under 35 U.S.C. 119 (a)-(d) or (f). The certified copy has:
 been received. not been received. been filed in Application/Control No. _____.
- 10. Other _____

Attachments

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

RIGHT OF APPEAL NOTICE

1. Introduction

This Office action addresses claims 1-60 of United States Patent No. 7,921,211 B2 (the "Larson" patent), for which reexamination was granted in the Order Granting *Inter Partes* Reexamination (hereafter the "Order"), mailed January 18, 2012 in response to a Request for *Inter Partes* Reexamination, filed October 18, 2011 (the "Request").

An Action Closing Prosecution ("ACP") mailed September 26, 2012 rejected all original claims 1-60 of the Larson patent.

The patent owner responded by filing arguments and associated evidence on December 26, 2012 (the "Response").

The third party requester responded by filing Comments on the Patent Owner's Response on January 23, 2013 (the "Comments").

Evidence Submitted After the ACP

The patent owner submitted the Supplemental Declaration of Angelos D. Keromytis, Ph.D. on December 26, 2012 (the "Supplemental Declaration"), which was after the mailing date of said ACP. Evidence submitted after an action closing prosecution (§ 1.949) in an *inter partes* reexamination filed under § 1.913 but before or on the same date of filing an appeal (§ 41.31 or §

Art Unit: 3992

41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. 37 CFR § 1.116(e). The patent owner did not set forth a showing why the Supplemental Declaration was necessary and was not earlier presented. After an ACP in an *inter partes* reexamination, the patent owner may once file comments limited to the issues raised in the Office action closing prosecution. 37 CFR § 1.951(a). Thus, the patent owner may not file additional comments showing why the Supplemental Declaration should be entered. The Supplemental Declaration is not of record in this proceeding. The examiner however has briefly reviewed the Supplemental Declaration, but it does not persuade the examiner to withdraw any rejection.

Conclusion

The examiner has fully considered the arguments and evidence of record provided in both the patent owner's Response and in the third party requester's Comments. Based on consideration of the entire record, the third party requester's arguments and evidence are deemed more persuasive. See the "Response to Arguments" section for further explanation. All prior rejections are maintained. Accordingly, this Office action is made a Right of Appeal Notice, which is a final Office action. See MPEP § 2673.01, .02. See also the "conclusion" section to this Office action.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.