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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/010,422	02/26/2009	6,009,469	2655-0185	6565

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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 05/10/2010

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



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CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/010,422.

PATENT NO. 6,009,469.

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

PTOL-465 (Rev.07-04)

Office Action in Ex Parte Reexamination	Control No. 90/010,422	Patent Under Reexamination 6,009,469	
	Examiner ALEXANDER J. KOSOWSKI	Art Unit 3992	

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

- a Responsive to the communication(s) filed on 25 November 2009. b This action is made FINAL.
c A statement under 37 CFR 1.530 has not been received from the patent owner.

A shortened statutory period for response to this action is set to expire 2 month(s) from the mailing date of this letter. Failure to respond within the period for response will result in termination of the proceeding and issuance of an *ex parte* reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c)**. If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.

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

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 3. <input type="checkbox"/> Interview Summary, PTO-474. |
| 2. <input checked="" type="checkbox"/> Information Disclosure Statement, PTO/SB/08. | 4. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

- 1a. Claims 1-3, 5, 6, 8, 9 and 14-18 are subject to reexamination.
1b. Claims 4, 7 and 10-13 are not subject to reexamination.
2. Claims _____ have been canceled in the present reexamination proceeding.
3. Claims 1-3, 5 and 6 are patentable and/or confirmed.
4. Claims 8-9, 14-18 are rejected.
5. Claims _____ are objected to.
6. The drawings, filed on _____ are acceptable.
7. The proposed drawing correction, filed on _____ has been (7a) approved (7b) disapproved.
8. Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some* c) None of the certified copies have
 1 been received.
 2 not been received.
 3 been filed in Application No. _____
 4 been filed in reexamination Control No. _____
 5 been received by the International Bureau in PCT application No. _____
 * See the attached detailed Office action for a list of the certified copies not received.
9. Since the proceeding appears to be in condition for issuance of an *ex parte* reexamination certificate except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte* Quayle, 1935 C.D. 11, 453 O.G. 213.
10. Other: _____

cc: Requester (if third party requester)

DETAILED ACTION

1) This Office action addresses claims 1-3, 5-6, 8-9, 14-18 of United States Patent Number 6,009,469 (Mattaway et al), for which it has been determined in the Order Granting Ex Parte Reexamination (hereafter the "Order") mailed 3/13/09 that a substantial new question of patentability was raised in the Request for *Ex Parte* reexamination filed on 2/26/09 (hereafter the "Request"). Claims 4, 7, 10-13 are not subject to reexamination. This is a final office action in response to the amendment filed 11/25/09. The rejection of claims 8, 9, 14-18 are maintained below. Amended claims 1-3 and 5-6 are allowable and/or confirmed below.

IDS

2) With regard to the IDS's filed 12/14/09, 12/16/09, 1/26/10, 2/24/10, 3/5/10, 5/6/10:

Where the IDS citations are submitted but not described, the examiner is only responsible for cursorily reviewing the references. The initials of the examiner on the PTO-1449 indicate only that degree of review unless the reference is either applied against the claims, or discussed by the examiner as pertinent art of interest, in a subsequent office action. See Guidelines for Reexamination of Cases in View of *In re Portola Packaging, Inc.*, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997), 64 FR at 15347, 1223 Off. Gaz. Pat. Office at 125 (response to comment 6).

Consideration by the examiner of the information submitted in an IDS means that the examiner will consider the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner placed adjacent to the citations on the PTO-1449 or PTO/SB/08A and 08B or its equivalent mean that the information has been considered by the examiner to the extent noted above.

Regarding IDS submissions MPEP 2256 recites the following: "Where patents, publications, and other such items of information are submitted by a party (patent owner or requester) in compliance with the requirements of the rules, the requisite degree of consideration to be given to such information will be normally limited by the degree to which the party filing the information citation has explained the content and relevance of the information."

Accordingly, the IDS submissions have been considered by the Examiner only with the scope required by MPEP 2256, unless otherwise noted.

In addition, that which are not either prior art patents or prior art printed publications have been crossed out so as not to appear reprinted on the front page of the patent.

Claim Rejection Paragraphs

3) *Claim Rejections - 35 USC § 103*

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.

Issue 1

4) Claims 8-9, 14-15, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable by NetBIOS, further in view of Pinard.

Referring to **(Claim 8)**, NetBIOS teaches in a computer system having a display and capable of executing a process, a method for establishing a point-to-point communication from a caller process to a callee process over a computer network, the caller process capable of generating a user interface and being operatively connected to the callee process and a server process over the computer network (NetBIOS, pg. 356, 357, whereby the system is run on personal computers over TCP/IP networks, personal computers inherently containing a display), the method comprising the steps of: querying the server process to determine if the first callee process is accessible (NetBIOS, pg. 377, 388-389, 446, whereby a query is sent to the NBNS to determine if another node is logged in and discover the nodes IP address); and establishing a point-to-point communication link from the caller process to the first callee process (NetBIOS, pg. 397-400, whereby a point-point communication link is established between end nodes).

However, NetBIOS does not explicitly teach generating a user-interface element representing a first communication line, generating a user interface element representing a first callee process, and establishing the link in response to a user associating the element representing the first callee process with the element representing the first communication line

Pinard teaches a human machine interface for telephone feature invocation which is utilized on a personal computer and allows a user to make telephone calls by moving graphics around a screen. Pinard teaches a user interface element representing a first communication line and callee process (Pinard, Figure 6 and col. 5 lines 23-30), and also teaches clicking and dragging an icon representing a callee from a directory into a call setup icon to establish a call link (Pinard, Figure 3, col. 4 lines 38-51, Figure 6, col. 5 lines 36-37).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to utilizing the user-interface elements and interactions taught by Pinard in the invention taught by NetBIOS since Pinard teaches that the invention can be used with any system in which a personal computer in conjunction with a server operates (Pinard, col. 2 lines 43-46), since NetBIOS teaches that it can be implemented using different operating systems (NetBIOS, pg. 359), and since examiner notes that both NetBIOS and Pinard relate to communications between at least two users implemented in a computerized environment.

Referring to **(Claim 9)**, NetBIOS teaches the method of claim 8 wherein step C further comprises the steps of: querying the server process as to the on-line status of the first callee process (NetBIOS, pg. 377, 388-389, 446, 393-394, whereby name queries are used to discover if a node is connected and active); and receiving a network protocol address of the first callee

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process over the computer network from the server process (NetBIOS, pg. 389, 440, 464-465, whereby the NBNS answers queries with a list of IP addresses of connected nodes).

Referring to **(Claims 14-15 and 17-18)**, NetBIOS teaches the above. However, NetBIOS does not explicitly teach generating a user interface element representing a communication line having a temporarily disabled status; and temporarily disabling the point-to-point communication between the caller process and the first callee process, in response to the user associating the element representing the first callee process with the element representing the communication line having a temporarily disabled status, wherein the element generated represents a communication line on hold status, wherein the display further comprises a visual display, and wherein the user interface is a graphic user interface and the user-interface elements generated in steps A and B are graphic elements.

Pinard teaches a “hard hold” icon to which caller/callees may be dragged to be put on hold status (Pinard, Figure 12, col. 6 lines 36-53), teaches a visual display (Pinard, col. 4 lines 10-11, Figure 2), and teaches a graphical user interface in which the elements are graphic elements (Pinard, Figures 2-16).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to utilizing the user-interface elements and interactions taught by Pinard in the invention taught by NetBIOS since Pinard teaches that the invention can be used with any system in which a personal computer in conjunction with a server operates (Pinard, col. 2 lines 43-46), since NetBIOS teaches that it can be implemented using different operating systems

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(NetBIOS, pg. 359), and since examiner notes that both NetBIOS and Pinard relate to communications between at least two users implemented in a computerized environment.

5) Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable by NetBIOS, further in view of Pinard, further in view of VocalChat User's Guide.

Referring to **(Claim 16)**, NetBIOS teaches the above. However, NetBIOS does not explicitly teach wherein the element generated represents a communication line on mute status.

VocalChat User's Guide teaches the use of a MUTE option on a phone so that a user can talk without being heard by the other user's system (VocalChat User's Guide, pg. 57).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to utilize an element representing a communication line on MUTE status in the invention taught by NetBIOS and Pinard above since all three references relate to the field of communications over a computer network, since VocalChat and Pinard utilize a computer system for telephony features specifically, and since examiner notes that the use of a MUTE feature in telephone conversations is old and well known in the art.

Issue 2

6) Examiner notes the following will represent the Etherphone references utilized for the rejection below (All considered a single reference as published together):

"Zellweger": An Overview of the Etherphone System and its Applications

"Swinehart": Telephone Management in the Etherphone System

"Terry": Managing Stored Voice in the Etherphone System

7) Claims 8-9, 14-15, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable by Etherphone, further in view of Pinard.

Referring to **(Claim 8)**, Etherphone teaches in a computer system having a display and capable of executing a process, a method for establishing a point-to-point communication from a caller process to a callee process over a computer network, the caller process capable of generating a user interface and being operatively connected to the callee process and a server process over the computer network (Zellweger, pg. 1, 3, Figure 1, Swinehart Figures 1-10), the method comprising the steps of: querying the server process to determine if the first callee process is accessible (Swinehart, pg. 2, 4, Zellweger, pg. 5, whereby a query is transmitted to determine the location of a second Etherphone by contacting a server); and establishing a point-to-point communication link from the caller process to the first callee process (Swinehart, pg. 2, Zellweger, Figure 4, whereby voice datagrams are transmitted directly among participants).

However, Etherphone does not explicitly teach generating a user-interface element representing a first communication line, generating a user interface element representing a first callee process, and establishing the link in response to a user associating the element representing the first callee process with the element representing the first communication line

Pinard teaches a human machine interface for telephone feature invocation which is utilized on a personal computer and allows a user to make telephone calls by moving graphics around a screen. Pinard teaches a user interface element representing a first communication line and callee process (Pinard, Figure 6 and col. 5 lines 23-30), and also teaches clicking and

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dragging an icon representing a callee from a directory into a call setup icon to establish a call link (Pinard, Figure 3, col. 4 lines 38-51, Figure 6, col. 5 lines 36-37).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to utilizing the user-interface elements and interactions taught by Pinard in the invention taught by Etherphone since Pinard teaches that the invention can be used with any system in which a personal computer in conjunction with a server operates (Pinard, col. 2 lines 43-46), and since examiner notes that both Etherphone and Pinard relate to communications between at least two users implemented in a computerized environment.

Referring to **(Claim 9)**, Etherphone teaches the method of claim 8 wherein step C further comprises the steps of: querying the server process as to the on-line status of the first callee process (Swinehart, pg. 2, 4, Zellweger, pg. 5, whereby queries are transmitted to Voice Control Server); and receiving a network protocol address of the first callee process over the computer network from the server process (Swinehart, pg. 2, whereby the server sends the network protocol address of the logged in user to caller process on request).

Referring to **(Claims 14-15)**, Etherphone teaches the above. However, Etherphone does not explicitly teach generating a user interface element representing a communication line having a temporarily disabled status; and temporarily disabling the point-to-point communication between the caller process and the first callee process, in response to the user associating the element representing the first callee process with the element representing the communication

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line having a temporarily disabled status, and wherein the element generated represents a communication line on hold status.

Pinard teaches a "hard hold" icon to which caller/callees may be dragged to be put on hold status (Pinard, Figure 12, col. 6 lines 36-53).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to utilizing the user-interface elements and interactions taught by Pinard in the invention taught by Etherphone since Pinard teaches that the invention can be used with any system in which a personal computer in conjunction with a server operates (Pinard, col. 2 lines 43-46), and since examiner notes that both Etherphone and Pinard relate to communications between at least two users implemented in a computerized environment.

Referring to **(Claims 17-18)**, Etherphone teaches wherein the display further comprises a visual display (Swinehart, Fig. 1-10, Zellweger, Fig. 3-4, whereby computer displays are considered visual displays), and wherein the user interface is a graphic user interface and the user-interface elements generated in steps A and B are graphic elements (Swinehart, Fig. 1-10, Zellweger, Fig. 3-4, whereby a GUI is used showing graphic elements of call display).

8) Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable by Etherphone, further in view of Pinard, further in view of VocalChat User's Guide.

Referring to **(Claim 16)**, Etherphone teaches the above. However, Etherphone does not explicitly teach wherein the element generated represents a communication line on mute status.

VocalChat User's Guide teaches the use of a MUTE option on a phone so that a user can talk without being heard by the other user's system (VocalChat User's Guide, pg. 57).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to utilize an element representing a communication line on MUTE status in the invention taught by Etherphone and Pinard above since all three references relate to the field of communications over a computer network, since VocalChat and Pinard utilize a computer system for telephony features specifically, and since examiner notes that the use of a MUTE feature in telephone conversations is old and well known in the art.

Response to Arguments

9) In response to the amendment filed 11/25/09, some rejections are sustained as noted above, and others have been withdrawn. The following aspects of the current prosecution will be addressed as noted below:

- a) VocalChat are not printed publications.
- b) The 1.132 Declaration
- c) Objective evidence of non-obviousness
- d) Withdrawn rejections
- e) Maintained rejections

a) The amendment submitted 11/25/09 includes arguments that the VocalChat references are not printed publications. The Patent Owner (PO) cites exhibit L of the Request (the declaration of Alon Cohen) as the only evidence provided by PO that the VocalChat references

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are printed publications. Examiner notes that the Alon Cohen declaration fails to comply with 37 C.F.R. 1.68, including not setting forth in the body of the declaration that all statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true. Therefore, PO's arguments questioning the declaration as well as whether printed publication status has been established as set forth under statute are found persuasive. Examiner therefore withdraws all rejections utilizing the VocalChat references.

b) Examiner notes that all evidence presented has been considered in its entirety, including both PO's arguments, including secondary considerations, as well as the 1.132 Declaration submitted by expert Ketan Mayer-Patel.

c) Examiner notes that PO's arguments regarding objective evidence of non-obviousness, including commercial success and failure of others have been considered, however no nexus has been provided between the claimed invention and the submitted evidence as required by at least MPEP 716.03. Therefore, this evidence is not found persuasive.

d) In light of PO's arguments and amendments filed 11/25/09, as well as the declaration of expert Mayer-Patel, examiner withdraws the rejections of claims 1-3 and 5-6. Examiner finds the presented arguments to be persuasive.

With regard to the NetBios rejection, examiner agrees with declarant Mayer-Patel that bringing dynamic addressing into a NetBIOS type system would create a new set of obstacles that would need to be solved that are not obvious in view of the combination of references.

With regard to the rejection under Etherphone, examiner notes that a similar argument applies to Etherphone as to Netbios, namely that combining the system with dynamic addressing would create new, non obvious obstacles to overcome.

A reasons for confirmation for the claims discussed above will follow in a subsequent office action.

e) The rejection of claims 8, 9, 14-18 are maintained in view of NetBIOS and Etherphone.

With regard to the rejection of claim 8 under NetBIOS, maintained above:

Examiner first notes that claim 8 does not require any dynamic addressing limitations, unlike claims 1 and 5. Therefore, any arguments directed towards a combination with RFC 1531 do not apply to claim 8.

PO argues with regard to claim 8 that NetBIOS does not teach "determining if the first callee process is accessible". PO argues that having an "active name" is not synonymous with "determining if a first callee process is accessible", and that an "active name" simply refers to "a name that has been registered and that has not yet been de-registered". Examiner first notes that the term "accessible" is not specifically defined in PO's specification. Therefore, under a broadest reasonable interpretation, this limitation could simply mean that a user is registered with the system. In addition, examiner notes that PO's specification at col. 5 lines 39-44 teaches that the on-line status information may not always be current, and may be updated, for example, only every 24 hours based on operator configuration. Assuming a user being "accessible" is comparable to that user being "on-line", then the database of NetBIOS which contains active name information reads on claim 8, whether or not the user data is current.

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PO also argues that NetBIOS does not teach “that the active status of a name in the NetBIOS server is an indication of the active status of the owner of that name”. However, examiner notes that claim 8 only requires connecting to a callee process, not necessarily to a particular name.

With regard to the rejection under Etherphone, maintained above:

PO argues with regard to claim 8 that if the Etherphone are “participants”, then “there is no indication that the combination meets the limitation of ‘the caller process capable of generating a user interface’”. Examiner notes that PO appears to be arguing that the Etherphones are not capable of generating user interfaces by themselves. If this is the case, examiner points to Zellweger, page 2. Zellweger teaches that workstations work in combination with the Etherphones and provided the enhanced user interface functionality. The Etherphones are only used separately to split up voice-processing functionality due to hardware processing requirements. Therefore, the caller process is a function of the workstation in combination with the Etherphone.

Therefore, the current arguments regarding claims 8-9 and 14-18 are not persuasive, and the rejections above are maintained.

Conclusion

THIS ACTION IS MADE FINAL.

Extensions of time under 37 CFR 1.136(a) do not apply in reexamination proceedings. The provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Further, in 35 U.S.C. 305 and in 37 CFR 1.550(a), it is required that reexamination proceedings "will be conducted with special dispatch within the Office."

Extensions of time in reexamination proceedings are provided for in 37 CFR 1.550(c). A request for extension of time must be filed on or before the day on which a response to this action is due, and it must be accompanied by the petition fee set forth in 37 CFR 1.17(g). The mere filing of a request will not effect any extension of time. An extension of time will be granted only for sufficient cause, and for a reasonable time specified.

The filing of a timely first response to this final rejection will be construed as including a request to extend the shortened statutory period for an additional month, which will be granted even if previous extensions have been granted. In no event however, will the statutory period for response expire later than SIX MONTHS from the mailing date of the final action. See MPEP § 2265.

All correspondence relating to this ex parte reexamination proceeding should be directed as follows:

By U.S. Postal Service Mail to:

Mail Stop Ex Parte Reexam

Application/Control Number: 90/010,422

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ATTN: Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
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Any inquiry concerning this communication or earlier communications from the Reexamination Legal Advisor or Examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

/Alexander J Kosowski/

Primary Examiner, Art Unit 3992


ESK