



APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/341,528	01/13/2003	Thomas E. Gorsuch	2479.1053-007	7146
21005	7590	05/05/2005	EXAMINER	
HAMILTON, BROOK, SMITH & REYNOLDS, P.C. 530 VIRGINIA ROAD P.O. BOX 9133 CONCORD, MA 01742-9133			RAMOS FELICIANO, ELISEO	
			ART UNIT	PAPER NUMBER
			2687	

DATE MAILED: 05/05/2005

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

# Office Action Summary

Examiner

Eliseo Ramos-Feliciano

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

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1)  Responsive to communication(s) filed on 13 January 2003.
- 2a)  This action is **FINAL**.                      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance 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.

## Disposition of Claims

- 4)  Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) 1 and 9-30 is/are allowed.
- 6)  Claim(s) 31-52 is/are rejected.
- 7)  Claim(s) 2-8 is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on 13 January 2003 is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a)  All    b)  Some \*    c)  None of:
- Certified copies of the priority documents have been received.
  - Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/24/2005.
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_.

## DETAILED ACTION

### *Information Disclosure Statement*

1. The references listed in the Information Disclosure Statement filed on January 24, 2005 have been considered by the examiner (see attached PTO-1449 form).

### *Specification*

2. The disclosure is objected to because of the following informalities: the reference made to a U.S. Patent Application made on page 1, lines 4-5 needs to be updated to include current status, e.g. patented and patent number. Appropriate correction is required.

### *Claim Objections*

3. **Claims 2-8** are objected to because of the following informalities: the used reference signs, i.e. "(a)" to "(g)", may lead to confusion with the steps recited in claim 1 given that these claims depend on claim 1, and claim 1 already recites "(a)" to "(e)" to make reference to such steps. Appropriate correction is required.

### *Double Patenting – Issue I: U.S. Patent No. 6,526,034*

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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5. **Claims 31-34, 37, and 39-47** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over *claims 1, 6-9, 11-16, and 18* of U.S. Patent No. 6,526,034. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons.

Regarding **claims 31-32** of present application, *claim 1* of U.S. Patent No. 6,526,034 discloses:

For use with a digital communication network having a first wireless digital communication path and a second wireless digital communication path for coupling data communication signals with a local wireless transceiver at a first site, the second digital communication path providing wider coverage and a slower communication rate than the first digital communication path, the local wireless transceiver being operative to conduct wireless communications with a remote wireless transceiver at a second site, a method of selecting a wireless communication path comprising the steps of:

- a) in response to a request to establish a communication session between said first and second sites, determining whether the first wireless digital communication path is available;
- b) establishing a communication session between the first and second sites using the first wireless digital communication path if the first wireless digital communications path is available;
- c) establishing a communication session between the first and second sites using the second wireless digital communication path if the first wireless digital communication path is not available;
- d) when a communication session has been established via the second wireless digital communication path, controlling the local wireless transceiver to appear to the second wireless digital communication path as though the bandwidth is continuously available during said communication session for wireless communications between said local and remote transceivers, irrespective of the need to transport data communication signals between said first and second sites; and
- e) when a communication session has been established via the second wireless communication path, in the absence of said need to transport data communication signals between said first and second sites, making said bandwidth available for wireless communication by another wireless transceiver of said digital communication network.

Other than for some grammatical differences and selected omitted elements, *claim 1* of U.S. Patent No. 6,526,034 claims the same as claims 31-32 of present application. Such differences are obvious expedient because omission of an element and its function in a

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combination is an obvious expedient if the remaining elements perform the same functions as before. In re KARLSON (CCPA) 136 USPQ 184 (1963).

Regarding **claims 33-34, 37, and 39** of present application, *claim 1* of U.S. Patent No. 6,526,034 discloses everything as applied above. In addition, *claims 6-8* of U.S. Patent No. 6,526,034 disclose the further added limitations.

Regarding **claims 40-47** of present application, *claim 1* of U.S. Patent No. 6,526,034 discloses everything as applied above. In addition, *claims 9, 11-16, and 18, respectively* of U.S. Patent No. 6,526,034 disclose the further added limitations.

***Double Patenting – Issue II: US Pat. Application No. 10/358,082***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. **Claims 31-52** are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over *claims 33-44, 46-48, 55-57, and 60-61*, of copending Application No. 10/358,082 (US Patent Publication Number 2004/0018854). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons.

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