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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/162,701 | 06/06/2002 | Xin Wang | 111325-113 | 6475 |
| 22204 | 7590 | 05/24/2006 | EXAMINER | |
| NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128 | | | REAGAN, JAMES A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3621 | |

DATE MAILED: 05/24/2006

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

| | | | |
|------------------------------|-----------------|--------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/162,701 | WANG ET AL. | |
| | Examiner | Art Unit | |
| | James A. Reagan | 3621 | |

-- 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) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, 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 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 21 February 2006.
- 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) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ 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 _____ 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:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ 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) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |

DETAILED ACTION

Status of Claims

1. This action is in response to the amendment filed on 21 February 2006.
2. Claim 10 has been amended.
3. Claims 1-27 have been examined.

RESPONSE TO ARGUMENTS

4. Applicant's arguments received on 21 February 2006 have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims.

With regard to the limitations of claims 1, 10, and 21, Applicant argues, "Ginter fails to teach, disclose, or suggest that rights associated with an item can include meta-rights specifying derivable rights that can be derived from the meta-rights by the rights consumer, that a determination is made regarding whether the rights consumer is entitled to derive the derivable rights specified by the meta-rights, or that, if the rights consumer is entitled to derive the derivable rights specified by the meta-rights, deriving one or more of the derivable rights and generating a license including the derived rights as is recited in claim 1." The Examiner respectfully disagrees and points to Ginter, column 31, line 26 to column 32, line 60 wherein Ginter discloses deriving

content control information by following different branches of controls to modify and evolve the control information for a digital file i.e. meta-rights.

It should be noted that the Examiner is not required to map each limitation to a cited passage within the prior art of reference, as is suggested by the Applicant, nor is it the Examiner's responsibility to translate the technology, techniques, and/or methods of the prior art of record, since it is the assumption of the Examiner that the Applicant and the Applicant's representatives are those of at least ordinary skill in the art. Since the Examiner assumes that the Patents used in making the rejections with regard to and in light of the instant claims have complied with the enablement standards at set for the by the United States Patent and Trademark Office, the Examiner correctly deduces that one of common skill would be able to read, understand, and manufacture the innovation as disclosed by the inventors. Subsequently, since the Applicants and their representatives are considered to be at least fundamentally schooled in the arts of the instant invention, it is also correct for the Examiner to infer that the same are capable of comprehending and appreciating the prior art as disclosed by the inventors and accredited by the USPTO. Ergo, the passages cited by the Examiner are a courtesy meant not only to lay a foundation of rejection of the claim limitations, but also to introduce the prior art of record as a benchmark of knowledge currently employed by artisans of the past and present, and also for establishing a pathway for continued prosecution. It is incumbent upon the Applicant and the Applicant's representative, then, to evaluate the prior art of record, point out misconceptions or other inaccuracies made by the Examiner, assert limitations that have not been properly addressed or that are novel, and, if deemed necessary, amend the claims to overcome the prior art of record, each and all in pursuit of an allowance.

Claim Rejections - 35 USC § 102

5. 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.

6. Claims 1-27 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ginter et al. (US 5,892,900 A).

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claims 1, 10, and 21:

Ginter discloses usage rights associated with digital works evolving as publishers and distributors provide the digital content to consumers. See at least column 47, line 56 to column 48, line 33; column 4, lines 14-27; column 5, lines 29-41, as well as other relevant and related Figures and text. Ginter therefore discloses the following limitations:



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