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LAW OFFICE OF DUANE S. KOBAYASHI  
P.O. Box 3207  
Reston, VA 20195

EXAMINER

HEYMAN, JOHN S

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Brian K. Erickson

DLA PIPER LLP (US)

401 Congress Ave.

Suite 2500

Austin, TX 78701

***EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/012,987.

PATENT NO. 7765482.

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)).



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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

Control Number: 90/012,987  
Filing Date: 09/10/2013  
Appellant(s): U.S. Patent No. 7,765,482

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Duane S. Kobayashi  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed Nov. 24, 2014.

### **(1) Grounds of Rejection to be Reviewed on Appeal**

Every ground of rejection set forth in the Office action dated 05/21/2014 from which the appeal is taken is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

The following ground(s) of rejection are applicable to the appealed claims.

1. The rejection of claims 38, 40, 44-46 and 49 under 35 U.S.C. § 102(e) based on U.S. Patent No. 6,930,709 to Creamer et al. ("Creamer");
2. The rejection of claims 38, 40, 44-46 and 49 under 35 U.S.C. § 102(e) based on U.S. Patent No. 6,038,295 to Mattes ("Mattes"); and
3. The rejection of claim 46 under 35 U.S.C. § 103(a) based on Mattes in view of Creamer.

### **(2) Response to Arguments**

Appellant argues on page 2 of the Brief that:

- A.** "Claim 38 of the '482 Patent recites "pre-processing said digital content at said client device in accordance with one or more pre-processing parameters . . . said one or more pre- processing parameters controlling said client device in a placement of said digital content into a specified form in preparation for publication to one or more devices that are remote from a server device and said client device." ('482 Patent at 14:1-9.) When properly construed, neither Creamer nor Mattes discloses this claim limitation. As is demonstrated below, when claim 38 is construed under the broadest reasonable interpretation based on the evidence in the record, including dictionary definitions provided by the Examiner, neither Creamer nor Mattes discloses the placement of digital content into a

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“specified form in preparation for publication to one or more devices that are remote from a server device and said client device.” For at least this reason, claim 38, and claims 40, 44-46 and 49, which depend from claim 38, are patentable over Creamer and Mattes.”

However, as stated in the Final Rejection on pages 3 and 4 and the Claim Chart of the Request beginning on pages 13 and 22, (both incorporated herein by reference), the limitations of Claim 38 are shown as being clearly met. Thus, as pointed out on page 7 of the Final Rejection, the “pre-processing” feature of Claim 38 has been properly construed, and is anticipated by either Creamer or Mattes.

#### **B. Response to Claim Construction Argument**

The Appellant argues that the Examiner’s perspective of the claim language is

overbroad, and his position effectively nullifies the “specified form in preparation for publication” limitation of the claim, thereby allowing the Examiner to map the claim language to any pre-processing directed to any objective. The Appellant argues that, “however, when the language of claim 38 is considered in its entirety, it is clear that the pre-processing of the digital content must be ‘in preparation for publication’ and cannot be directed to unrelated objectives such as storage or archiving of the digital content” (Brief page 3).

But, as stated in the Final Rejection beginning on page 5, “During reexamination, claims are given in the broadest reasonable interpretation consistent with the specification and limitations in the specification are not read into the claims *In re Yamamoto* 740 F.2d 1569, 222 USPQ 934.”

Here, it should be emphasized that the claim does not limit the reason for compressing the image to only for and nothing but publication. Instead, the claim recites, “in preparation for publication” (i.e. NOT “nothing but publication”). So, as long as the compressed JPEG image gets eventually published on the internet after too

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