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EXAMINER
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CRAVER, CHARLES R

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PAPER

**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.



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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

REEXAMINATION CONTROL NO. 90/013,740.

PATENT NO. 8155012.

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)).

## DETAILED ACTION

### **I. Summary**

In the instant 90/013,740 Reexamination of US Patent 8,155,012 (hereinafter “the ‘012 Patent”), claims 1-148 are under reexamination in light of the Order Granting Reexamination mailed 6/21/2016 responding to the request for reexamination filed 4/27/2016 by the Third Party Requestor. **Claims 1-148 are rejected.**

**THIS ACTION IS FINAL.** MPEP 2271.

### ***Extensions of Time***

Extensions of time under 37 CFR 1.136(a) will not be permitted in this reexamination proceedings because the provisions of 37 CFR 1.136 apply only to “an applicant” and not to the patent owner in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that ex parte reexamination proceedings “will be conducted with special dispatch” (37 CFR 1.550(a)). Extensions of time in ex parte reexamination proceedings are provided for in 37 CFR 1.550(c).

### ***Notification of Concurrent Proceedings***

The Patent Owner is reminded of the continuing responsibility under 37 CFR 1.985 to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 8,155,012 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP § 2686 and 2686.04.

## ***Service of Papers***

Any paper filed by either the patent owner or the third party requester ***must be served*** on the other party in the reexamination proceeding in the manner provided by 37 CFR 1.248. See 37 CFR 1.903 and MPEP 2666.06.

## **II. Background and Request**

### **Claims 1, 31, 67 and 108 recite:**

1. A method for adapting a piece of Ethernet data terminal equipment, the piece of Ethernet data terminal equipment having an Ethernet connector, the method comprising: selecting contacts of the Ethernet connector comprising a plurality of contacts, the selected contacts comprising at least one of the plurality of contacts of the Ethernet connector and at least another one of the plurality of contacts of the Ethernet connector; coupling at least one path across the selected contacts of the Ethernet connector; and associating distinguishing information about the piece of Ethernet data terminal equipment to impedance within the at least one path.

31. An adapted piece of Ethernet data terminal equipment comprising: an Ethernet connector comprising a plurality of contacts; and at least one path coupled across selected contacts, the selected contacts comprising at least one of the plurality of contacts of the Ethernet connector and at least another one of the plurality of contacts of the Ethernet connector, wherein distinguishing information about the piece of Ethernet data terminal equipment is associated to impedance within the at least one path.

67. A method for adapting a piece of terminal equipment, the piece of terminal equipment having an Ethernet connector, the method comprising: coupling at least one path across specific contacts of the Ethernet connector, the at least one path permits use of the specific contacts for Ethernet communication, the Ethernet connector comprising the contact 1 through the contact 8, the specific contacts of the Ethernet connector comprising at least one of the contacts of the Ethernet connector and at least another one of the contacts of the Ethernet connector; and arranging impedance within the at least one path to distinguish the piece of terminal equipment.

108. An adapted piece of terminal equipment having an Ethernet connector, the piece of terminal equipment comprising: at least one path coupled across specific contacts of the Ethernet connector, the at least one path permits use of the specific contacts for Ethernet communication, the Ethernet connector comprising the contact 1 through the contact 8, the specific contacts comprising at least one of the contacts of the Ethernet connector and at least another one of the contacts of the Ethernet connector, impedance within the at least one path arranged to distinguish the piece of terminal equipment.

The instant Patent is towards a security system for an Ethernet network.

Generally, electronic equipment connected to the network is managed and tracked

Art Unit: 3992

using signaling means along existing twisted-pair network cable in order to distinguish devices and detect if it is removed, and later if reconnected. Col. 4 l. 40-col. 6 l. 47.

### **III. Priority**

Third Party Requestor asserts on p. 3 of his Request that the effective date of claims are not that of the filing of the parent application 09/370,430 (8/9/1999) or its parent PCT Application (4/8/1999), or provisional Application 60/081,279 (4/8/1998) but rather the filing of the 12/239,001 application.

#### **35 U.S.C. 120 Priority Requires Possession of the Claimed Invention in an Earlier U.S. Patent**

Rejections may be made in reexamination proceedings based on intervening patents or printed publications where the patent claims under reexamination are entitled only to the filing date of the patent and are not supported by an earlier foreign or United States patent application whose filing date is claimed. For example, under 35 U.S.C. 120, the effective date of these claims would be the filing date of the application which resulted in the patent. Intervening patents or printed publications are available as prior art under *In re Russetta*, 255 F.2d 687, 118 USPQ 101 (CCPA 1958), and *In re van Langenhoven*, 458 F.2d 132, 173 USPQ 426 (CCPA 1972). See also MPEP § 201.11

MPEP § 2258.I.C (emphasis added).

Thus, a rejection may be made in a reexamination proceeding based on an intervening patent when the patent claims under reexamination are entitled, under 35 U.S.C. 120, only to the filing date of the patent under reexamination.

The Examiner notes that none of the proffered art would be considered intervening in this proceeding, all references predating the filing date of the original parent application, and as such SNQs raised by such references are not "intervening".

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