



# UNITED STATES DEPARTMENT OF COMMERCE Patent and Trademark Office Address: COMMISSIONER OF PATENTS AND TRADEMARKS Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/449,097	05/24/95 HAR	VEY	j 5634.208
UO/447,UJ/	50, E (1 20 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1	Г	EXAMINER
		26M1/0827	
THOMAS J SCO			ART UNIT PAPER NUMBER
HOWREY AND SIMON 1299 PENNSYLVANIA AVENUE NW			ے۔ 2619
WASHINGTON	DC 20004	DA	ATE MAILED: 08/27/96
			00/2//30
This is a communication from COMMISSIONER OF PATE	n the examiner in charge of your NTS AND TRADEMARKS	application.	
		ACTION SUMMARY	
Responsive to communicat	ion(s) filed on $5-9$	-96	
This action is FINAL.			
			on as to the merits is closed in
•	ce under Ex parte Quayle, 19		
hichever is longer, from the m	nailing date of this communic	et to expire cation. Failure to respond within	the period for response will cause
e application to become abar 136(a).	ndoned. (35 U.S.C. § 133).	Extensions of time may be obtain	ned under the provisions of 37 CFR
isposition of Claims			
Claim(s)	2-4		is/are pending in the application
Of the above, claim(s)			is/are withdrawn from consideration
			is/are allowed.
Claim(s) 2 -	4	9. 1	is/are rejected.
Claim(s)			is/are objected to.
Claims		are su	bject to restriction or election requiremen
pplication Papers			
See the attached Notice	•	•	
		is/are objecte	
☐ The proposed drawing or	orrection, filed on		is  approved  disapproved
☐ The specification is object	cted to by the Examiner.		
☐ The oath or declaration i	s objected to by the Examina	er.	
riority under 35 U.S.C. § 1	19		
Acknowledgement is made	of a claim for foreign priority	y under 35 U.S.C. § 119(a)-(d).	
☐ All ☐ Some* ☐ No	one of the CERTIFIED cop	ies of the priority documents have	ve been
received.			
received in Application	n No. (Series Code/Serial Nu	ımber)	·
		International Bureau (PCT Rule	17.2(a)).
_	d:		*
-	of a claim for domestic prio	rity under 35 U.S.C. § 119(e).	
.ttachment(s)			
Notice of Reference Cite			
☐ Information Disclosure S		per No(s)	
Interview Summary, PTC			
Notice of Draftsperson's	•	O-948	
Notice of Informal Paten			
PTO1 -326 (P 4205)	SEE OFFICE ACT	ION ON THE FOLLOWING PAG	\$E\$
PTOL-326 (Rev. 10/95)		i	



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This action is in response to the amendment filed May 9, 1996.

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This action will not attempt to determine the effective 2. filing date of this application. The action will apply art against the claims using two possible effective filing dates, i.e. serial number 06/317,510, filed November 3, 1981, and serial number 07/096,096, filed September 11, 1987. Applicants can overcome the art rejections by establishing that the art applied does not meet the claimed limitations or that the art does not have an early enough filing date.

The action will make initial double patenting rejections presuming that all of the present claims were fully disclosed in both the '81 and '87 cases.

In any rejections made under 35 USC 112, first paragraph, applicants will be asked to clarify, where required by the examiner, how the present claims are fully disclosed in both the '81 and '87 cases.

Applicants are reminded of their duty to maintain a line of patentable demarcation between related applications. It has been noted by the PTO that many of the pending applications have similar claimed subject matter. In the related 327 applications (the serial numbers are included in a list below), it is estimated that there may be between 10,000 and 20,000 claims. Applicants should insure that substantially duplicate claims do not appear in different cases, and should bring to the PTO's



attention instances where similar claims have been treated inconsistently, i.e. rejected in one case but not in another.

- 4. Applicants are cautioned that their continual use of alternatives in the claims raises questions concerning the exact claim meaning. More importantly, it raises questions whether the disclosure supports every possible embodiment or permutation that can be created by the alternative language.
- 5. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an enabling disclosure. What do applicants mean by "digital television"? Please reference both the '81 and '87 cases to define this term. It appears that this was not disclosed in the '81 case. The '87 case refers to "digital video" numerous times, and "digital television" once. It is not clear whether applicants are using these terms interchangeably. Applicants should provide support and/or arguments, with references to the two disclosures, why their brief mention of digital television provided an enabling disclosure.
- 6. Claim 2 is rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.
- 7. The double patenting rejections in this action are based on the premise that all of the present claims were fully disclosed in U.S. Patents 4,694,490; 4,704,725; 4,965,825; and 5,109,414. Since there was a restriction made in 5,233,654, there will be no double patenting made on that patent or 5,335,277.

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8. The PTO's copies of the parent files are in poor form since they have been copied many time by members of the public. The files also are missing some of the papers. The double patenting rejections below presumes that there were no requirements for restriction made in any of the parent files.

- 9. There are three types of double patenting rejections:
  - a) Statutory double patenting rejection under 35 USC 101,

Nonstatutory non-obviousness type double patenting.

b) Nonstatutory obvious type double patenting,

matter with representative ones of the patented claims.

- In this action, the rejections of the third type that are directed to the claims of the parent patented files will have two different versions. The first rejects the claims because they have not been established to be independent and distinct from the patented claims. The second version includes that premise, and further supports the rejection by establishing that representative claims from this application have common subject
- 10. Claims 2-4 (all of the claims in this application) are rejected under the judicially created doctrine of non-obviousness non-statutory double patenting over the patented claims in U.S. Patents 4,694,490; 4,704,725; 4,965,825; and 5,109,414 since the claims, if allowed, would improperly extend the "right to exclude" already granted in those patents.

The subject matter claimed in the instant application is fully disclosed in the patents and is covered by the patents



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since the patents and the application are claiming common subject matter, as follows: a signal processing apparatus and method including an interactive communications system apparatus and method. Furthermore, there is no apparent reason why applicants were prevented from presenting claims corresponding to those of the instant application during prosecution of the parent applications which matured into patents. In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

A review of the claims in each of the four parent patents (5,109,414; 4,964,825; 4,704,725; 4,694,490) was made. These patented claims do not appear "independent and distinct" from the claims in this application. The present claims are directed to a method and apparatus for controlling communications including television communications or programming. The claims in patent 5,109,414 were directed to a processing system and method for signal distribution including television. The claims in patent 4,965,825 were directed to a system and process for signal processing including carrier communications. The claims in patent 4,704,725 were directed to a method of communicating data to receiver stations. The claims in patent 4,694,490 were directed to a method for communicating and processing television programs.

Applicants' invention can be envisioned at in three parts.

As with most cable TV systems, there is a head end station which generates the video programming. Applicants have included an



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