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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/460,711	06/02/95	HARVEY	I 5634 212

EXAMINER

26M1/0722

ART UNIT	PAPER NUMBER
	2

HOWREY & SIMON
1299 PENNSYLVANIA AVENUE NW
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2619
DATE MAILED: 07/22/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☑ This application has been examined ☑ Responsive to communication filed on 5-9-96 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire —3— month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☑ Notice of References Cited by Examiner, PTO-892.
2. ☑ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☑ Claims 2-5 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. ☑ Claims 1 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☑ Claims 2-5 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____ ; filed on _____.
13. ☐ Since this application apppears to be 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.
14. ☐ Other

EXAMINER'S ACTION

PTOL-326 (Rev. 2/93)

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

2. This action will not attempt to determine the effective 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.

3. 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. Claim 2, line 10, recites "signal", while line 11, recites "signal". Should signals be used in line 11? In claim 3, line 13, should "said one of" be deleted since line 9 only recited one intermediate set? Note language in claim 4, step 2.

6. 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.

7. Claim 2 is rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

8. 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.

9. 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.

10. There are three types of double patenting rejections:

a) Statutory double patenting rejection under 35 USC 101,

b) Nonstatutory obvious type double patenting,

c) Nonstatutory non-obviousness type double patenting.

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 matter with representative ones of the patented claims.

11. Claims 2-5 (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 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

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