



Sheet \_\_\_\_\_ of \_\_\_\_\_

FORM PTO-14... (Rev. 7-97)	U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE	ATTY. DOCKET NO. 96262/6	SERIAL NO. O 09/054,740
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (See several sheets if necessary)		APPLICANT Thomas R. Wolzien	
		FILED DATE 4/3/98	GROUP 774-2611

**U.S. PATENT DOCUMENTS**

EXAMINER INITIAL	DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILED DATE IF APPROPRIATE
	4 8 9 4 7 8 9	1/90	Yee			
	4 9 0 5 0 9 4	2/90	Pocock et al.			
	5 1 2 8 7 5 2	7/92	Von Kohorn			
	5 2 8 5 2 7 8	2/94	Holman			

**FOREIGN PATENT DOCUMENTS**

	DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
						YES	NO

**OTHER DOCUMENTS (including Author, Title, Date, Pertinent Pages, Etc.)**


EXAMINER John W. Miller DATE CONSIDERED 4/99

EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/054,740	04/03/98	WOLZIEN	T 96262/6

LM02/0909  
AMSTER, ROTHSTEIN & EBENSTEIN  
90 PARK AVE.  
NEW YORK NY 10016

EXAMINER

MILLER, J  
ART UNIT PAPER NUMBER


2711  
DATE MAILED: 09/09/99

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

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No. 09/054,740	Applicant(s) Wolzien
Examiner John W. Miller	Group Art Unit 2711



- Responsive to communication(s) filed on \_\_\_\_\_
- This action is FINAL.
- 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.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**

- Claim(s) 18-29 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) 18-29 is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claims \_\_\_\_\_ are subject to restriction or election requirement.

**Application Papers**

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - All  Some\*  None of the CERTIFIED copies of the priority documents have been received.
  - received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- \*Certified copies not received: \_\_\_\_\_
- Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- Notice of References Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s); 3
- Interview Summary, PTO-413
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 18-29 are rejected under the judicially created doctrine of double patenting over claims 1-17 of U. S. Patent No. 5,761,606 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the providing of an online address with a video program, the electronic extraction of the address, the visual or auditory indication of the presence of an address, and the establishing of a communication link with an online information source associated with the address.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application

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which matured into a patent. See *In re Schneller*, 397 F 2d 350, 158 USPQ 210 (CCPA 1968).

See also MPEP § 804.

*Claim Rejections - 35 USC § 102*

3. 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 --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 18-20, 22, 23, 25, and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Honey et al (5,912,700), cited by the examiner.

Note the Honey et al reference, Figure 21 and the disclosure of col. 25, lines 38-67, which discloses hardware at a viewer's home which allows for the enhancement of television presentations based on non-video data. Particularly, television signals are received at by a television and sent to a decoder (which is a stand-alone decoder or one incorporated within a computer) to remove data from the vertical blanking interval of the signals. The decoder removes this non-video data, which may be one or more addresses of web-pages on the Internet, and displays the data in a window on the display of the computer such that the user is able to click on an address with a mouse or other input means, thus causing software in the computer (e.g. Mosaic or Netscape) to load the addressed web page.

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