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90/013,016	10/07/2013	7647633	FINREXM0005	9521
115222	7590	05/22/2015	EXAMINER	
Bey & Cotropia PLLC (Finjan Inc.)			BASEHOAR, ADAM L	
Dawn-Marie Bey			ART UNIT	
213 Bayly Court			PAPER NUMBER	
Richmond, VA 23229			3992	
			MAIL DATE	
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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. 90/013,016.

PATENT NO. 7647633.

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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The present application is being examined under the pre-AIA first to invent provisions.

DETAILED ACTION

1. This Office action addresses original claims 1-7 and 28-33 as well as newly presented claims 42-52 of United States Patent Number 7,647,633 B2 (Edery et al.), for which it has been determined in the Order Granting Ex Parte Reexamination (hereafter the "Order") mailed 11/19/2013 that a substantial new question of patentability was raised in the Request for *Ex Parte* reexamination filed on 10/07/2013 (hereafter the "Request"). Claims 8-27 and 34-41 of the Edery '633 patent are not subject to this reexamination proceeding. A Non-Final Action was mailed on 11/19/2013 rejecting claims 1-7 and 28-33.

2. This is a Final Action in response to the Patent Owner's (PO) Response to Non-Final Office Action (hereafter the "PO Response") filed 02/19/2014. The PO Response included claim amendments to present new claims 42-52. The claim amendments have been entered and made of record. Thus, claims 1-7, 28-33, and 42-52 are currently pending and subject to reexamination.

3. Patent Owner filed a Petition to Accept Unintentionally Delayed Priority Claim under 37 C.F.R. § 1.78 on 02/19/2014. The Petition was accompanied by an Amendment to the Specification to correct the language of the benefit claim recited in the first paragraph of the specification. On 07/25/2014 the Office mailed a Petition Decision that dismissed said Petition. Therefore, the Amendment to the Specification filed on 02/19/2014 has not been entered.

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Subsequently, Patent Owner filed a Renewed Petition to Accept Unintentionally Delayed Priority Claim under 37 C.F.R. § 1.78 on 08/25/2014. The Renewed Petition was accompanied by a Supplemental Amendment to the Specification to correct the language of the benefit claim recited in the first paragraph of the specification. On 01/23/2015 the Office mailed a Petition Decision that granted the Renewed Petition. Therefore, the Supplemental Amendment to the Specification filed on 08/25/2014 has been entered and made of record.

4. PO's Response filed 02/19/2014 further included Declarations, pursuant to 37 C.F.R. § 1.132, of Dr. Nenad Medvidovic (hereafter the "Medvidovic Declaration") and of Phil Harstein (hereafter the "Harstein Declaration"). Both the Medvidovic Declaration and the Harstein Declaration, including their accompanying Exhibits, have been entered and made of record as discussed below.

5. It is noted that Patent Owner has provided notice that the related co-pending litigation proceeding Case No: 13-03133 SBA (Finjan Inc. vs. Fireeye, Inc.) was STAYED pending reexamination on 05/30/2014.

Reexamination

6. The Patent Owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 7,647,633 B2 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

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proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

Information Disclosure Statement

7. Regarding Information Disclosure Statement (IDS) submissions, MPEP 2256 recites the following: “Where patents, publications, and other such items of information are submitted by a party (patent owner or requester) in compliance with the requirements of the rules, the requisite degree of consideration to be given to such information will be normally limited by the degree to which the party filing the information citation has explained the content and relevance of the information. The initials of the examiner placed adjacent to the citations on the form PTO/SB/08A and 08B or its equivalent, without an indication to the contrary in the record, do not signify that the information has been considered by the examiner any further than to the extent noted above.”

Accordingly, the IDS submissions filed by Patent Owner on 12/20/2013, 02/18/2014, 02/19/2014, 03/28/2014, 06/05/2014, 06/10/2014, 06/24/2014, 10/01/2014, 11/19/2014, 02/25/2015, and 04/01/2015 have been considered by the Examiner only with the scope required by MPEP 2256, unless otherwise noted.

References Discussed in This Final Action

- **Ji** - (U.S. Patent No. 5,983,348, filed 09/10/1997, published 11/09/1999)
- **Liu** - (U.S. Patent No. 6,058,482, filed 05/22/1998, published 05/02/2000)

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