

## Electronic Acknowledgement Receipt

<b>EFS ID:</b>	44579874
<b>Application Number:</b>	90014507
<b>International Application Number:</b>	
<b>Confirmation Number:</b>	6188
<b>Title of Invention:</b>	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS
<b>First Named Inventor/Applicant Name:</b>	8213970
<b>Customer Number:</b>	172615
<b>Filer:</b>	John Christopher Kappos/Cinda Pacheco
<b>Filer Authorized By:</b>	John Christopher Kappos
<b>Attorney Docket Number:</b>	2525.993REX0
<b>Receipt Date:</b>	21-DEC-2021
<b>Filing Date:</b>	15-MAY-2020
<b>Time Stamp:</b>	17:28:09
<b>Application Type:</b>	Reexam (Third Party)

### Payment information:

Submitted with Payment	no
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### File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Reexam Change in Pwr Atty for Third Party Requester	90_014507-PTOSB81C-970-patent.pdf	332738 <small>5ff4ac05c452565b7f4bbffd531ccf58774d8c94</small>	no	2

### Warnings:

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**Information:**

2	Reexam Certificate of Service	90_014507-Reexam-Certificate-of-Service-970-patent.pdf	162300	no	1
			58c32ea11dba0b95bccd9f11bbd3d19f7cb35b94		

**Warnings:**

**Information:**

<b>Total Files Size (in bytes):</b>	495038
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**New Applications Under 35 U.S.C. 111**

**If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.**

**National Stage of an International Application under 35 U.S.C. 371**

**If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.**

**New International Application Filed with the USPTO as a Receiving Office**

**If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.**



US008213970C1

(12) **EX PARTE REEXAMINATION CERTIFICATE** (11959th)

**United States Patent**  
**Beyer**

(10) **Number:** **US 8,213,970 C1**

(45) **Certificate Issued:** **Dec. 9, 2021**

(54) **METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS**

(75) Inventor: **Malcolm K. Beyer**, Jupiter Inlet Colony, FL (US)

(73) Assignee: **AGIS Software Development LLC**

**Reexamination Request:**

No. 90/014,507, May 15, 2020

**Reexamination Certificate for:**

Patent No.: **8,213,970**

Issued: **Jul. 3, 2012**

Appl. No.: **12/324,122**

Filed: **Nov. 26, 2008**

**Related U.S. Application Data**

(63) Continuation-in-part of application No. 11/612,830, filed on Dec. 19, 2006, now Pat. No. 7,853,273, (Continued)

(51) **Int. Cl.**

**H04M 1/7243** (2021.01)

**H04M 1/72457** (2021.01)

**H04M 1/72415** (2021.01)

**H04M 1/72427** (2021.01)

**H04W 4/12** (2009.01)

(52) **U.S. Cl.**

CPC ..... **H04M 1/7243** (2021.01); **H04M 1/72415** (2021.01); **H04M 1/72427** (2021.01); **H04M 1/72457** (2021.01); **H04M 2250/06** (2013.01); **H04M 2250/22** (2013.01); **H04M 2250/62** (2013.01); **H04M 2250/64** (2013.01); **H04W 4/12** (2013.01)

(58) **Field of Classification Search**

None

See application file for complete search history.

(56) **References Cited**

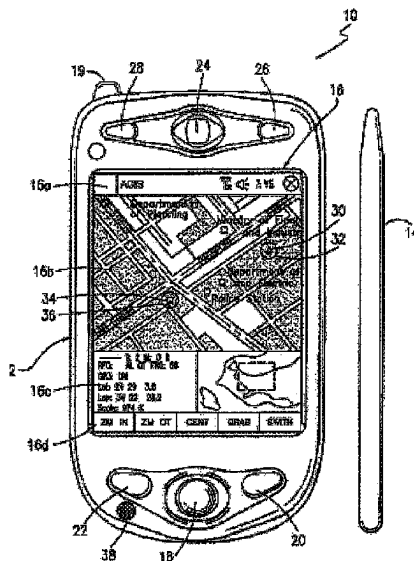
To view the complete listing of prior art documents cited during the proceeding for Reexamination Control Number 90/014,507, please refer to the USPTO's public Patent Application Information Retrieval (PAIR) system under the Display References tab.

*Primary Examiner* — Eric B. Kiss

(57) **ABSTRACT**

The system and method having a specialized software application on a personal computer or a PDA/cell phone that that enables a participant to force an automatic acknowledgement and a manual response to a text or voice message from other participants within the same network. Each participant's PDA/cell phone includes a force message alert software application program for both creating and processing these forced message alerts. The system and method enabled by the force message alert software application program provides the ability to (a) allow an operator to create and transmit a forced message alert from a sender PDA/cell phone to one or more recipient PCs and PDA/cell phones within the communication network; (b) automatically transmit an acknowledgement of receipt to the sender PDA cell phone upon the receipt of the forced message alert; (c) periodically resend the message to the recipient PCs and PDA/cell phones that have not sent an acknowledgement; (d) provide an indication of which recipient PCs and PDA/cell phones have acknowledged the forced message alert; (e) provide a manual response list on the display of the recipient PC and PDA/cell phone's display that can only be cleared by manually transmitting a response; and (f) provide an indication on the sender PDA/cell phone of the status and content the manual responses.

**Attention is directed to the decision of *AGIS Software Dev., LLC v. Google LLC*, No. 2020-1401, slip op. (Fed. Cir. Feb. 4, 2021) relating to this patent. This reexamination may not have resolved all questions raised by this decision. See 37 CFR 1.552(c) for *ex parte* reexamination and 37 CFR 1.906(c) for *inter partes* reexamination.**



**Related U.S. Application Data**

which is a continuation-in-part of application No. 11/308,648, filed on Apr. 17, 2006, now Pat. No. 7,630,724, which is a continuation-in-part of application No. 10/711,490, filed on Sep. 21, 2004, now Pat. No. 7,031,728.



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**EX PARTE  
REEXAMINATION CERTIFICATE**

THE PATENT IS HEREBY AMENDED AS  
INDICATED BELOW.

**Matter enclosed in heavy brackets [ ] appeared in the patent, but has been deleted and is no longer a part of the patent; matter printed in italics indicates additions made to the patent.**

AS A RESULT OF REEXAMINATION, IT HAS BEEN DETERMINED THAT:

Claims 1 and 3-9 were previously cancelled.

Claims 2 and 10 are determined to be patentable as amended.

Claims 11-13, dependent on an amended claim, are determined to be patentable.

2. [The system as in claim 1] *A communication system for transmitting, receiving, confirming receipt, and responding to an electronic message, comprising: a predetermined network of participants, wherein each participant has a similarly equipped PDA/cell phone that includes a CPU and a touch screen display a CPU and memory; a data transmission means that facilitates the transmission of electronic files between said PDA/cell phones in different locations; a sender PDA/cell phone and at least one recipient PDA/cell phone for each electronic message; a forced message alert software application program including a list of required possible responses to be selected by a participant recipient of a forced message response loaded on each participating PDA/cell phone; means for attaching a forced message alert software packet to a voice or text message creating a forced message alert that is transmitted by said sender PDA/cell phone to the recipient PDA/cell phone, said forced message alert software packet containing a list of possible required responses and requiring the forced message alert software on said recipient PDA/cell phone to transmit an automatic acknowledgment to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone; means for requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display; means for receiving and displaying a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have not automatically acknowledged the forced message alert; means for periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced message alert; and means for receiving and displaying a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert and details the response from each recipient PDA/cell phone that responded; and means for displaying a geographical map with georeferenced entities on the display of the sender PDA/cell phone; means for obtaining location and status data associated with the recipient PDA/cell phone; and means for presenting a recipient symbol on the geographical map corresponding to a correct geographical location of the recipient PDA/cell phone, wherein the forced message alert software application program on the recipient PDA/cell phone includes:*

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means for transmitting the acknowledgment of receipt to said sender PDA/cell phone immediately upon receiving a forced message alert from the sender PDA/cell phone;

means for controlling of the recipient PDA/cell phone upon transmitting said automatic acknowledgment and causing, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PDA/cell phone or causes, in cases where the forced message alert is a voice message, the voice message being periodically repeated by the speakers of the recipient PDA/cell phone while said response list is shown on the display;

means for allowing a manual response to be manually selected from the response list or manually recorded and transmitting said manual response to the sender PDA/cell phone; and

means for clearing the text message and a response list from the display of the recipient PDA/cell phone or stopping the repeating voice message and clearing the response list from the display of the recipient PDA/cell phone once the manual response is transmitted.

10. A method of receiving, acknowledging and responding to a forced message alert from a sender PDA/cell phone to a recipient PDA/cell phone, wherein the receipt, acknowledgment, and response to said forced message alert is forced by a forced message alert software application program, said method comprising the steps of:

receiving an electronically transmitted electronic message; identifying said electronic message as a forced message alert, wherein said forced message alert comprises of a voice or text message and a forced message alert application software packet, which triggers the activation of the forced message alert software application program within the recipient PDA/cell phone;

transmitting an automatic acknowledgment of receipt to the sender PDA/cell phone, which triggers the forced message alert software application program to take control of the recipient PDA/cell phone and show the content of the text message and a required response list on the display recipient PDA/cell phone or to repeat audibly the content of the voice message on the speakers of the recipient PDA/cell phone and show the required response list on the display recipient PDA/cell phone; and

transmitting a selected required response from the response list in order to allow the message required response list to be cleared from the recipient's cell phone display, whether said selected response is a chosen option from the response list, causing the forced message alert software to release control of the recipient PDA/cell phone and stop showing the content of the text message and a response list on the display recipient PDA/cell phone and or stop repeating the content of the voice message on the speakers of the recipient PDA/cell phone;

displaying the response received from the PDA cell phone that transmitted the response on the sender of the forced alert PDA/cell phone; and

providing a list of the recipient PDA/cell phones have automatically acknowledged receipt of a forced alert message; and displaying a geographical map with georeferenced entities on the display of the sender PDA/cellphone; obtaining location and status data associated with the recipient PDA/cellphone; and presenting a recipient symbol on the geographical map corresponding to a

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**4**

*correct geographical location of the recipient PDA/  
cellphone based on at least the location data.*

\* \* \* \* \*



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/014,507	05/15/2020	8213970	2525.993REX0	6188
172615	7590	11/15/2021	EXAMINER	
Fabricant LLP 411 Theodore Fremd Road Suite 206 South Rye, NY 10580			KISS, ERIC B	
			ART UNIT	PAPER NUMBER
			3992	
			MAIL DATE	DELIVERY MODE
			11/15/2021	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)

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
1100 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

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

REEXAMINATION CONTROL NO. 90/014,507.

PATENT UNDER REEXAMINATION 8213970.

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)).

<b>Notice of Intent to Issue Ex Parte Reexamination Certificate</b>	<b>Control No.</b> 90/014,507	<b>Patent Under Reexamination</b> 8213970	
	<b>Examiner</b> ERIC B KISS	<b>Art Unit</b> 3992	<b>AIA Status</b> No

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

1.  Prosecution on the merits is (or remains) closed in this *ex parte* reexamination proceeding. This proceeding is subject to reopening at the initiative of the Office or upon petition. *Cf.* 37 CFR 1.313(a). A Certificate will be issued in view of
  - (a)  Patent owner's communication(s) filed: 19 October 2021.
  - (b)  Patent owner's failure to file an appropriate timely response to the Office action mailed: \_\_\_\_\_.
  - (c)  Patent owner's failure to timely file an Appeal Brief (37 CFR 41.31).
  - (d)  The decision on appeal by the  Board of Patent Appeals and Interferences  Court dated \_\_\_\_\_
  - (e)  Other: \_\_\_\_\_.
2. The Reexamination Certificate will indicate the following:
  - (a) Change in the Specification:  Yes  No
  - (b) Change in the Drawing(s):  Yes  No
  - (c) Status of the Claim(s):
    - (1) Patent claim(s) confirmed: \_\_\_\_\_.
    - (2) Patent claim(s) amended (including dependent on amended claim(s)): 2 and 10-13
    - (3) Patent claim(s) canceled: \_\_\_\_\_.
    - (4) Newly presented claim(s) patentable: \_\_\_\_\_.
    - (5) Newly presented canceled claims: 14-15.
    - (6) Patent claim(s)  previously  currently disclaimed: \_\_\_\_\_
    - (7) Patent claim(s) not subject to reexamination: \_\_\_\_\_.
3.  A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on \_\_\_\_\_.
4.  Note the attached statement of reasons for patentability and/or confirmation. Any comments considered necessary by patent owner regarding reasons for patentability and/or confirmation must be submitted promptly to avoid processing delays. Such submission(s) should be labeled: "Comments On Statement of Reasons for Patentability and/or Confirmation."
5.  Note attached NOTICE OF REFERENCES CITED (PTO-892).
6.  Note attached LIST OF REFERENCES CITED (PTO/SB/08 or PTO/SB/08 substitute).
7.  The drawing correction request filed on \_\_\_\_\_ is:  approved  disapproved.
8.  Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All   b)  Some\*   c)  None of the certified copies have
    - been received.
    - not been received.
    - been filed in Application No. \_\_\_\_\_.
    - been filed in reexamination Control No. \_\_\_\_\_.
    - been received by the International Bureau in PCT Application No. \_\_\_\_\_.

\* Certified copies not received: \_\_\_\_\_.
9.  Note attached Examiner's Amendment.
10.  Note attached Interview Summary (PTO-474).
11.  Other: Claims 1 and 3-9 were canceled in IPR2018-01079 (Trial Cert. issued Sep. 1, 2021).

**All correspondence** relating to this reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

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cc: Requester (if third party requester)

**NOTICE OF INTENT TO ISSUE *EX PARTE* REEXAMINATION CERTIFICATE**

Claims 2 and 10-13 of U.S. Pat. 8,213,970 are under reexamination.

The reply filed October 19, 2021, has been received and entered. Previously proposed claims 14 and 15 have been canceled, their subject matter being incorporated into the proposed amendments to claims 2 and 10, respectively.

**Related Proceedings**

The examiner is aware of the following related matters:

The '970 patent is currently involved in the litigation styled *AGIS Software Dev., LLC v. Google LLC*, Case No. 2:19-cv-00361 (E.D. Tex.), which was filed on November 4, 2019.

The '970 patent was involved in an *Inter Partes* Review of claims 1 and 3-9, in which a Final Written Decision found the challenged claims unpatentable. See *Google LLC v. AGIS Software Dev., LLC*, IPR2018-01079, Final Written Decision (P.T.A.B. Nov. 19, 2019). A Notice of Appeal to the United States Court of Appeals for the Federal Circuit was filed on January 21, 2020. The Federal Circuit affirmed the decision of the Patent Trial and Appeal Board. *AGIS Software Dev., LLC v. Google LLC*, No. 2020-1401, slip op. (Fed. Cir. Feb. 4, 2021).

Requests for *Ex Parte* Reexamination have been filed for commonly-assigned U.S. Pats. 9,408,055; 9,445,251; and 9,467,838.

Petitions for *Inter Partes* Review of commonly-assigned U.S. Pat. 9,820,123 have also been filed.

**Patentable Subject Matter**

Claims 2 and 10-13 are patentable as amended.

**STATEMENT OF REASONS FOR PATENTABILITY AND/OR CONFIRMATION**

The following is an examiner's statement of reasons for patentability and/or confirmation of the claims found patentable in this reexamination proceeding:

The prior art cited in the Request fails to teach or fairly suggest means for obtaining location and status data associated with the recipient PDA/cell phone (i.e., the algorithm described in the '970 patent at col. 3, lines 52-67) and means for presenting a recipient symbol on the geographical map (displayed on the means for displaying . . ., i.e., on the LCD display of the sender PDA/cell phone, described in the '970 patent at col. 4, lines 12-16) corresponding to a correct geographical location of the recipient PDA/cell phone (i.e., the algorithm described in the '970 patent at col. 5, lines 28-44), in the context of independent claim 2.

The prior art cited in the Request fails to teach or fairly suggest obtaining location and status data associated with the recipient PDA/cellphone and presenting a recipient symbol on the geographical map (displayed on the sender PDA/cell phone) corresponding to a correct geographical location of the recipient PDA/cellphone based on at least the location data, in the context of independent claim 10.

Any comments considered necessary by PATENT OWNER regarding the above statement must be submitted promptly to avoid processing delays. Such submission by the patent owner should be labeled: "Comments on Statement of Reasons for Patentability and/or Confirmation" and will be placed in the reexamination file.

**Conclusion**

Claims 2 and 10-13 of U.S. Pat. 8,213,970 are patentable as amended.

All correspondence relating to this *ex parte* reexamination proceeding should be directed:

By Mail to:           Mail Stop *Ex Parte* Reexam  
                          Central Reexamination Unit  
                          Commissioner for Patents  
                          United States Patent & Trademark Office  
                          P.O. Box 1450  
                          Alexandria, VA 22313-1450

By FAX to:           (571) 273-9900  
                          Central Reexamination Unit

Any inquiry concerning this communication should be directed to Central Reexamination Unit at telephone number (571) 272-7705.


/Eric B. Kiss/  
Primary Examiner, Art Unit 3992

**Conferees:**

/NICK CORSARO/  
Primary Examiner, Art Unit 3992

/ANDREW J. FISCHER/  
Supervisory Patent Reexamination Specialist, Art Unit 3992




<b>Reexamination</b> 	<b>Application/Control No.</b> 90/014,507	<b>Applicant(s)/Patent Under Reexamination</b> 8213970
	<b>Certificate Date</b>	<b>Certificate Number</b> C1

<b>Requester Correspondence Address:</b> <input type="checkbox"/> <b>Patent Owner</b> <input checked="" type="checkbox"/> <b>Third Party</b>
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005

<b>LITIGATION REVIEW</b> <input checked="" type="checkbox"/>	/EBK/ (examiner initials)	16 May 2020 (date)
Case Name		Director Initials
AGIS Software Dev., LLC v. Google LLC, Case No. 2:19-cv-00361 (E.D. Tex.)		

COPENDING OFFICE PROCEEDINGS	
TYPE OF PROCEEDING	NUMBER
IPR	IPR2018-00821 (Institution Denied)
IPR	IPR2018-01079 (FWD)
IPR	IPR2019-00411 (Terminated)
IPR	IPR2019-00485 (Institution Denied)

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<b><i>Search Notes</i></b> 	<b>Application/Control No.</b> 90/014,507	<b>Applicant(s)/Patent Under Reexamination</b> 8213970
	<b>Examiner</b> ERIC B KISS	<b>Art Unit</b> 3992

CPC - Searched*		
Symbol	Date	Examiner

CPC Combination Sets - Searched*		
Symbol	Date	Examiner


US Classification - Searched*			
Class	Subclass	Date	Examiner

\* See search history printout included with this form or the SEARCH NOTES box below to determine the scope of the search.

Search Notes		
Search Notes	Date	Examiner
Reviewed patent file history	07/02/2020	/EBK/

Interference Search			
US Class/CPC Symbol	US Subclass/CPC Group	Date	Examiner


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<b>Issue Classification</b> 	<b>Application/Control No.</b> 90/014,507	<b>Applicant(s)/Patent Under Reexamination</b> 8213970
	<b>Examiner</b> ERIC B KISS	<b>Art Unit</b> 3992

CPC						
Symbol					Type	Version
H04M	/	1	/	7243	F	2021-01-01
H04M	/	1	/	72457	A	2021-01-01
H04M	/	1	/	72415	A	2021-01-01
H04M	/	1	/	72427	A	2021-01-01
H04M	/	2250	/	06	A	2013-01-01
H04M	/	2250	/	22	A	2013-01-01
H04M	/	2250	/	62	A	2013-01-01
H04M	/	2250	/	64	A	2013-01-01
H04W	/	4	/	12	A	2013-01-01

CPC Combination Sets				
Symbol	Type	Set	Ranking	Version
/	/			

NONE	<b>Total Claims Allowed:</b>	
(Assistant Examiner)	(Date)	5
/Eric B. Kiss/ Patent Reexamination Specialis, Art Unit 3992	28 October 2021	O.G. Print Claim(s)   O.G. Print Figure
(Primary Examiner)	(Date)	2   1a

<b>Issue Classification</b> 	<b>Application/Control No.</b> 90/014,507	<b>Applicant(s)/Patent Under Reexamination</b> 8213970
	<b>Examiner</b> ERIC B KISS	<b>Art Unit</b> 3992


INTERNATIONAL CLASSIFICATION			
CLAIMED			
H04M1/7243	/	1	/ 7243
H04M1/72457	/	1	/ 72457
H04M1/72415	/	1	/ 72415
H04M1/72427	/	1	/ 72427
H04W4/12	/	4	/ 12

NON-CLAIMED			
	/		/

US ORIGINAL CLASSIFICATION	
CLASS	SUBCLASS

CROSS REFERENCES(S)					
CLASS	SUBCLASS (ONE SUBCLASS PER BLOCK)				

NONE	<b>Total Claims Allowed:</b>					
(Assistant Examiner)	(Date)	5				
/Eric B. Kiss/ Patent Reexamination Specialis, Art Unit 3992 (Primary Examiner)	28 October 2021 (Date)	<table border="1"> <tr> <td>O.G. Print Claim(s)</td> <td>O.G. Print Figure</td> </tr> <tr> <td>2</td> <td>1a</td> </tr> </table>	O.G. Print Claim(s)	O.G. Print Figure	2	1a
O.G. Print Claim(s)	O.G. Print Figure					
2	1a					

<b>Issue Classification</b> 	<b>Application/Control No.</b> 90/014,507	<b>Applicant(s)/Patent Under Reexamination</b> 8213970
	<b>Examiner</b> ERIC B KISS	<b>Art Unit</b> 3992

Claims renumbered in the same order as presented by applicant
  CPA
  T.D.
  R.1.47

CLAIMS															
Final	Original	Final	Original	Final	Original	Final	Original	Final	Original	Final	Original	Final	Original	Final	Original
	1	10	10												
2	2	11	11												
	3	12	12												
	4	13	13												
	5	-	14												
	6	-	15												
	7														
	8														
	9														

NONE	<b>Total Claims Allowed:</b>	
(Assistant Examiner)	(Date)	5
/Eric B. Kiss/ Patent Reexamination Specialis, Art Unit 3992	28 October 2021	O.G. Print Claim(s)   O.G. Print Figure
(Primary Examiner)	(Date)	2   1a

## Bibliographic Data

Application No: 90/014,507

Foreign Priority claimed:  Yes  No

35 USC 119 (a-d) conditions met:  Yes  No  Met After Allowance

Verified and Acknowledged:

Examiner's Signature

Initials

Title:

METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE  
REMOTE COMMUNICATIONS

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FILING or 371(c) DATE	CLASS	GROUP ART UNIT	ATTORNEY DOCKET NO.
05/15/2020	455	3992	2525.993REX0
<b>RULE</b>			

### APPLICANTS

### INVENTORS

8213970,

AGIS SOFTWARE DEVELOPMENT LLC, MARSHALL, TX, UNITED STATES

JONATHAN TUMINARO (3RD PTY REQ.), WASHINGTON, DC, UNITED STATES

### CONTINUING DATA

This application is a REX of 12324122 11/26/2008 PAT 8213970

12324122 is a CIP of 11612830 12/19/2006 PAT 7853273

11612830 is a CIP of 11308648 04/17/2006 PAT 7630724

11308648 is a CIP of 10711490 09/21/2004 PAT 7031728

### FOREIGN APPLICATIONS

**IF REQUIRED, FOREIGN LICENSE GRANTED\*\***

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UNITED STATES

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

U.S. PATENT NO.: 8,213,970 ART UNIT: 3992  
CONTROL NUMBER: 90/014,507 CONF. NO.: 6188  
FILING DATE: May 15, 2020 EXAMINER: Kiss, Eric B.  
TITLE: **METHOD OF UTILIZING FORCED ALERTS FOR  
INTERACTIVE REMOTE COMMUNICATIONS**

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**AMENDMENT AND REPLY UNDER 37 C.F.R. 1.113 TO A FINAL OFFICE ACTION**

This paper is submitted under 37 C.F.R. 1.113 in response to the final Office Action mailed from the Office on August 19, 2021. Owner authorizes any required fee to be charged to Deposit Account No. 60-3614.

**A listing of the claims** begins on page 2.

**Remarks** begin on page 9.



## CLAIMS

A listing of claims follows:

Claim 1. A communication system for transmitting, receiving, confirming receipt, and responding to an electronic message, comprising: a predetermined network of participants, wherein each participant has a similarly equipped PDA/cell phone that includes a CPU and a touch screen display a CPU and memory; a data transmission means that facilitates the transmission of electronic files between said PDA/cell phones in different locations; a sender PDA/cell phone and at least one recipient PDA/cell phone for each electronic message; a forced message alert software application program including a list of required possible responses to be selected by a participant recipient of a forced message response loaded on each participating PDA/cell phone; means for attaching a forced message alert software packet to a voice or text message creating a forced message alert that is transmitted by said sender PDA/cell phone to the recipient PDA/cell phone, said forced message alert software packet containing a list of possible required responses and requiring the forced message alert software on said recipient PDA/cell phone to transmit an automatic acknowledgment to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone; means for requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display; means for receiving and displaying a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have not automatically acknowledged the forced message alert; means for periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced message alert; and means for receiving and displaying a listing of which recipient PDA/cell phones have transmitted a manual response to

said forced message alert and details the response from each recipient PDA/cell phone that responded.

Claim 2. (amended), [The system as in claim 1] A communication system for transmitting, receiving, confirming receipt, and responding to an electronic message, comprising: a predetermined network of participants, wherein each participant has a similarly equipped PDA/cell phone that includes a CPU and a touch screen display a CPU and memory; a data transmission means that facilitates the transmission of electronic files between said PDA/cell phones in different locations; a sender PDA/cell phone and at least one recipient PDA/cell phone for each electronic message; a forced message alert software application program including a list of required possible responses to be selected by a participant recipient of a forced message response loaded on each participating PDA/cell phone; means for attaching a forced message alert software packet to a voice or text message creating a forced message alert that is transmitted by said sender PDA/cell phone to the recipient PDA/cell phone, said forced message alert software packet containing a list of possible required responses and requiring the forced message alert software on said recipient PDA/cell phone to transmit an automatic acknowledgment to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone; means for requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display; means for receiving and displaying a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have not automatically acknowledged the forced message alert; means for periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced

message alert; and means for receiving and displaying a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert and details the response from each recipient PDA/cell phone that responded; and means for displaying a geographical map with georeferenced entities on the display of the sender PDA/cell phone; means for obtaining location and status data associated with the recipient PDA/cell phone; and means for presenting a recipient symbol on the geographical map corresponding to a correct geographical location of the recipient PDA/cell phone, wherein the forced message alert software application program on the recipient PDA/cell phone includes: means for transmitting the acknowledgment of receipt to said sender PDA/cell phone immediately upon receiving a forced message alert from the sender PDA/cell phone; means for controlling of the recipient PDA/cell phone upon transmitting said automatic acknowledgment and causing, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PDA/cell phone or causes, in cases where the forced message alert is a voice message, the voice message being periodically repeated by the speakers of the recipient PDA/cell phone while said response list is shown on the display; means for allowing a manual response to be manually selected from the response list or manually recorded and transmitting said manual response to the sender PDA/cell phone; and means for clearing the text message and a response list from the display of the recipient PDA/cell phone or stopping the repeating voice message and clearing the response list from the display of the recipient PDA/cell phone once the manual response is transmitted.

Claim 3. The system as in claim 1, wherein said data transmission means is TCP/IP or another communications protocol.

Claim 4. The system as in claim 1, wherein the response list that is transmitted within the forced message alert software packet is a default response list that is embedded in the forced message alert software application program.

Claim 5. The system as in claim 1, wherein the response list that is transmitted within the forced message alert software packet is a custom response list that is created at the time the specific forced message alert is created on the sender PDA/cell phone.

Claim 6. A method of sending a forced message alert to one or more recipient PDA/cell phones within a predetermined communication network, wherein the receipt and response to said forced message alert by each intended recipient PDA/cell phone is tracked, said method comprising the steps of: accessing a forced message alert software application program on a sender PDA/cell phone; creating the forced message alert on said sender PDA/cell phone by attaching a voice or text message to a forced message alert application software packet to said voice or text message; designating one or more recipient PDA/cell phones in the communication network; electronically transmitting the forced message alert to said recipient PDA/cell phones; receiving automatic acknowledgements from the recipient PDA/cell phones that received the message and displaying a listing of which recipient PDA/cell phones have acknowledged receipt of the forced message alert and which recipient PDA/cell phones have not acknowledged receipt of the forced message alert; periodically resending the forced message alert to the recipient PDA/cell phones that have not acknowledged receipt; receiving responses to the forced message alert from the recipient PDA/cell phones and displaying the response from each recipient PDA/cell phone; and providing a manual response list on the display of the recipient PDA/cell phone that can only be cleared by the recipient providing a required response from the list; clearing the recipient's display screen or

causing the repeating voice alert to cease upon recipient selecting a response from the response list required that can only be cleared by manually selecting and transmitting a response to the manual response list.

Claim 7. The method as in claim 6, wherein each PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it.

Claim 8. The method as in claim 6, wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program.

Claim 9. The method as in claim 6, wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PDA/cell phone.

Claim 10. (amended), A method of receiving, acknowledging and responding to a forced message alert from a sender PDA/cell phone to a recipient PDA/cell phone, wherein the receipt, acknowledgment, and response to said forced message alert is forced by a forced message alert software application program, said method comprising the steps of: receiving an electronically transmitted electronic message; identifying said electronic message as a forced message alert, wherein said forced message alert comprises of a voice or text message and a forced message alert application software packet, which triggers the activation of the forced message alert software application program within the recipient PDA/cell phone; transmitting an automatic acknowledgment of receipt to the sender PDA/cell phone, which triggers the forced message

alert software application program to take control of the recipient PDA/cell phone and show the content of the text message and a required response list on the display recipient PDA/cell phone or to repeat audibly the content of the voice message on the speakers of the recipient PDA/cell phone and show the required response list on the display recipient PDA/cell phone; and transmitting a selected required response from the response list in order to allow the message required response list to be cleared from the recipient's cell phone display, whether said selected response is a chosen option from the response list, causing the forced message alert software to release control of the recipient PDA/cell phone and stop showing the content of the text message and a response list on the display recipient PDA/cell phone and or stop repeating the content of the voice message on the speakers of the recipient PDA/cell phone; displaying the response received from the PDA cell phone that transmitted the response on the sender of the forced alert PDA/cell phone; and providing a list of the recipient PDA/cell phones have automatically acknowledged receipt of a forced alert message and their response to the forced alert message; and displaying a geographical map with georeferenced entities on the display of the sender PDA/cellphone; obtaining location and status data associated with the recipient PDA/cellphone; and presenting a recipient symbol on the geographical map corresponding to a correct geographical location of the recipient PDA/cellphone based on at least the location data.

Claim 11. The method as in claim 10, wherein each PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it.

Claim 12. The method as in claim 10, wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program.

Claim 13. The method as in claim 10, wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PDA/cell phone.

Cancel claim 14.

Cancel claim 15.

### **REMARKS**

This paper is in response to the final Office Action dated August 19, 2021. Claims 2 and 10-13 (the “Challenged Claims”) are subject to reexamination and stand rejected. Claims 14-15 were previously added in the response to the non-final Office action mailed on March 3, 2021. In this response, claims 2 and 10 are amended to include the patentable subject matter recited in claims 14 and 15, respectively. Previously added claims 14 and 15 are canceled. Therefore, Claims 2 and 10-13 are present for reexamination.

### **Claim Status**

Claims 2 and 10-13 are rejected under pre-AIA U.S.C. 103(a) as being unpatentable over U.S. Pat. App. Pub. 2006/0218232 to Kubala (“Kubala”) in view of U.S. Pat. 6,854,007 to Hammond (“Hammond”).

Claims 2 and 10-13 are rejected under pre-AIA 35 U.S.C. 103(a) as unpatentable over Hammond in view of U.S. Pat. 5,325,310 to Johnson (“Johnson”) further in view of U.S. Pat. 5,742,905 to Pepe (“Pepe”)

Claims 14 and 15 are patentable.

### **Patent Owner’s Summary of Examiner Interview**

Patent Owner thanks the Examiners for the courtesy extended during the Examiner interview on September 13, 2021 between Examiners Erik B. Kiss, Nick Corsaro, and Andrew J. Fischer, and Patent Owner’s representatives, Jialin Zhong (Reg. No. 62,937) and Enrique W. Iturralde (Reg. No. 72,883).

During the interview, different forms of amendments to claims for taking the patentable subject matter recited in claims 14 and 15 were discussed. The examiners indicated that the



rewritten versions of the claims with the scope identical to the patentable subject matter would be entered and allowed.

Remarks

While Patent Owner does not agree with the rejection on the merit, to facilitate matters, claim 2 has been rewritten without prejudice to include the subject matter of the base claim 1 and the subject matter of the patentable claim 14, and claim 10 has been rewritten without prejudice to include the subject matter of the patentable claim 15. Therefore, independent claims 2 and 10 as presented, as well as their respective dependent claims, are patentable over Kubala and Hammond and over Hammond, Johnson, and Pepe.

**CONCLUSION**

For these reasons, Patent Owner respectfully requests withdrawal of the rejections and issuance of a reexamination certificate allowing all of the Challenged Claims.

Dated: October 19, 2021

Respectfully submitted,

**Zhong Law, LLC**

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Attorney for Owner



Dated: October 19, 2021

Respectfully submitted,  
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Attorney for Patent Owner

## Electronic Acknowledgement Receipt

<b>EFS ID:</b>	44056693
<b>Application Number:</b>	90014507
<b>International Application Number:</b>	
<b>Confirmation Number:</b>	6188
<b>Title of Invention:</b>	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS
<b>First Named Inventor/Applicant Name:</b>	8213970
<b>Customer Number:</b>	172615
<b>Filer:</b>	Jialin Zhong/Eddie Rowell
<b>Filer Authorized By:</b>	Jialin Zhong
<b>Attorney Docket Number:</b>	2525.993REX0
<b>Receipt Date:</b>	19-OCT-2021
<b>Filing Date:</b>	15-MAY-2020
<b>Time Stamp:</b>	15:48:21
<b>Application Type:</b>	Reexam (Patent Owner)

### Payment information:

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### File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1		AGIS_Response_to_Final_Rejection_re_970_Patent.pdf	53259 9a89134b80e0607cca76958ce7366ecd184e9d8	yes	10

Multipart Description/PDF files in .zip description			
Document Description	Start	End	
Response After Final Action	1	1	
Claims	2	8	
Applicant Arguments/Remarks Made in an Amendment	9	10	

**Warnings:**

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2	Reexam Certificate of Service	90-014507_Certificate_of_Service_of_FOAR.pdf	26325	no	2
			b75f9fc69e85aed534234ed95581ed11dc21d00		

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/014,507	05/15/2020	8213970	2525.993REX0	6188
172615	7590	10/18/2021	EXAMINER	
Fabricant LLP 411 Theodore Fremd Road Suite 206 South Rye, NY 10580			KISS, ERIC B	
			ART UNIT	PAPER NUMBER
			3992	
			MAIL DATE	DELIVERY MODE
			10/18/2021	PAPER

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

REEXAMINATION CONTROL NO. 90/014,507 .

PATENT UNDER REEXAMINATION 8213970 .

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)).

<b><i>Ex Parte Reexamination Interview Summary</i></b>	<b>Control No.</b> 90/014,507	<b>Patent Under Reexamination</b> 8213970	
	<b>Examiner</b> ERIC B KISS	<b>Art Unit</b> 3992	<b>AIA (FITF) Status</b> No

All participants (USPTO personnel, patent owner, patent owner's representative):

- |   |                              |
|---|------------------------------|
| (1) <u>ERIC KISS</u>                    | (3) <u>Jialin Zhong</u>      |
| (2) <u>Andrew Fischer, Nick Corsaro</u> | (4) <u>Enrique Iturralde</u> |

Date of Interview: 12 October 2021

Type: a)  Telephonic    b)  Video Conference  
c)  Personal (copy given to: 1)  patent owner    2)  patent owners representative)

Exhibit shown or demonstration conducted: d)  Yes    e)  No.  
If Yes, brief description: \_\_\_\_\_

Agreement with respect to the claims f)  was reached. g)  was not reached. h)  N/A.  
Any other agreement(s) are set forth below under "Description of the general nature of what was agreed to..."

Claim(s) discussed: 2 .

Identification of prior art discussed: See Continuation Sheet .

Description of the general nature of what was agreed to if an agreement was reached, or any other comments:  
\_\_\_\_\_ .

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims patentable, if available, must be attached. Also, where no copy of the amendments that would render the claims patentable is available, a summary thereof must be attached.)

A FORMAL WRITTEN RESPONSE TO THE LAST OFFICE ACTION MUST INCLUDE PATENT OWNER'S STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. (See MPEP § 2281). IF A RESPONSE TO THE LAST OFFICE ACTION HAS ALREADY BEEN FILED, THEN PATENT OWNER IS GIVEN **ONE MONTH** FROM THIS INTERVIEW DATE TO PROVIDE THE MANDATORY STATEMENT OF THE SUBSTANCE OF THE INTERVIEW (37 CFR 1.560(b)). THE REQUIREMENT FOR PATENT OWNERS STATEMENT CAN NOT BE WAIVED. **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

/Eric B. Kiss/ Patent Reexamination Specialis, Art Unit 3992		
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cc: Requester (if third party requester)



Continuation of Identification of prior art discussed: Parties discussed the construction of the claim term "forced message alert". Patent Owner's representatives contended that a forced message alert does not include within its scope an email message. The examiners noted that the '970 patent specification does not appear to contain any clear disavowal of scope for the term or a clear, deliberate, and precise definition of "forced message alert" that would require reading the claim as excluding email. Patent Owner's representatives pointed to col. 4, lines 1-6, as reciting a list of data types that allegedly distinguish the forced message alert from an email. However, the Examiners did not agree that this description precluded the forced message alert from being an email message. Instead, the Examiners noted that this passage described the various types of data that the server was capable of handling as a list of examples. Patent Owner's representatives discussed a proposed amendment to the claims to expressly recite that the forced message alert was not an email message. The Examiner's expressed concerns regarding whether such an amendment would be sufficiently supported under 35 U.S.C. 112(a).

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<b>PATENT APPLICATION FEE DETERMINATION RECORD</b> Substitute for Form PTO-875	Application or Docket Number 90/014,507	Filing Date 05/15/2020	<input type="checkbox"/> To be Mailed
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ENTITY:  LARGE  SMALL  MICRO

**APPLICATION AS FILED - PART I**

FOR	(Column 1) NUMBER FILED	(Column 2) NUMBER EXTRA	RATE (\$)	FEE (\$)
<input type="checkbox"/> BASIC FEE (37 CFR 1.16(a), (b), or (c))	N/A	N/A	N/A	
<input type="checkbox"/> SEARCH FEE (37 CFR 1.16(k), (i), or (m))	N/A	N/A	N/A	
<input type="checkbox"/> EXAMINATION FEE (37 CFR 1.16(o), (p), or (q))	N/A	N/A	N/A	
TOTAL CLAIMS (37 CFR 1.16(i))	minus 20 = *		x \$100 =	
INDEPENDENT CLAIMS (37 CFR 1.16(h))	minus 3 = *		x \$460 =	
<input type="checkbox"/> APPLICATION SIZE FEE (37 CFR 1.16(s))	If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$310 (\$155 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).			
<input type="checkbox"/> MULTIPLE DEPENDENT CLAIM PRESENT (37 CFR 1.16(j))				
* If the difference in column 1 is less than zero, enter "0" in column 2.			TOTAL	

**APPLICATION AS AMENDED - PART II**

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<b>AMENDMENT</b>	10/18/2021	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA		
	Total (37 CFR 1.16(i))	* 13	Minus	** 20	= 0	x \$100 =	0
	Independent (37 CFR 1.16(h))	* 4	Minus	*** 4	= 0	x \$480 =	0
<input type="checkbox"/> Application Size Fee (37 CFR 1.16(s))							
<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))							
						TOTAL ADD'L FEE	0
<b>AMENDMENT</b>		CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA		
	Total (37 CFR 1.16(i))	*	Minus	**	=	x \$0 =	
	Independent (37 CFR 1.16(h))	*	Minus	***	=	x \$0 =	
<input type="checkbox"/> Application Size Fee (37 CFR 1.16(s))							
<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))							
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**APPLICATION AS FILED - PART I**

FOR	(Column 1) NUMBER FILED	(Column 2) NUMBER EXTRA	RATE (\$)	FEE (\$)
<input type="checkbox"/> BASIC FEE (37 CFR 1.16(a), (b), or (c))	N/A	N/A	N/A	
<input type="checkbox"/> SEARCH FEE (37 CFR 1.16(k), (i), or (m))	N/A	N/A	N/A	
<input type="checkbox"/> EXAMINATION FEE (37 CFR 1.16(o), (p), or (q))	N/A	N/A	N/A	
TOTAL CLAIMS (37 CFR 1.16(i))	minus 20 = *		x \$100 =	
INDEPENDENT CLAIMS (37 CFR 1.16(h))	minus 3 = *		x \$460 =	
<input type="checkbox"/> APPLICATION SIZE FEE (37 CFR 1.16(s))	If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$310 (\$155 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).			
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<input type="checkbox"/> Application Size Fee (37 CFR 1.16(s))							
<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))							
						TOTAL ADD'L FEE	0

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<b>AMENDMENT</b>		CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA		
	Total (37 CFR 1.16(i))	*	Minus	**	=	x \$0 =	
	Independent (37 CFR 1.16(h))	*	Minus	***	=	x \$0 =	
<input type="checkbox"/> Application Size Fee (37 CFR 1.16(s))							
<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))							
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Please find below and/or attached an Office communication concerning this application or proceeding.

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WASHINGTON, DC 20005

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

REEXAMINATION CONTROL NO. 90/014,507 .

PATENT UNDER REEXAMINATION 8213970 .

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)).

<b><i>Ex Parte Reexamination Interview Summary</i></b>	<b>Control No.</b> 90/014,507	<b>Patent Under Reexamination</b> 8213970	
	<b>Examiner</b> ERIC B KISS	<b>Art Unit</b> 3992	<b>AIA (FITF) Status</b> No

All participants (USPTO personnel, patent owner, patent owner's representative):

- |   |                              |
|---|------------------------------|
| (1) <u>ERIC KISS</u>                                    | (3) <u>Jialin Zhong</u>      |
| (2) <u>Andrew J. Fischer (SPRS), Nick Corsaro (PRS)</u> | (4) <u>Enrique Iturralde</u> |

Date of Interview: 13 September 2021

Type: a)  Telephonic b)  Video Conference  
c)  Personal (copy given to: 1)  patent owner 2)  patent owners representative)

Exhibit shown or demonstration conducted: d)  Yes e)  No.  
If Yes, brief description: Proposed amendment

Agreement with respect to the claims f)  was reached. g)  was not reached. h)  N/A.  
Any other agreement(s) are set forth below under "Description of the general nature of what was agreed to..."

Claim(s) discussed: 14-15 .

Identification of prior art discussed: \_\_\_\_\_ .

Description of the general nature of what was agreed to if an agreement was reached, or any other comments:  
See Continuation Sheet .

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims patentable, if available, must be attached. Also, where no copy of the amendments that would render the claims patentable is available, a summary thereof must be attached.)

A FORMAL WRITTEN RESPONSE TO THE LAST OFFICE ACTION MUST INCLUDE PATENT OWNER'S STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. (See MPEP § 2281). IF A RESPONSE TO THE LAST OFFICE ACTION HAS ALREADY BEEN FILED, THEN PATENT OWNER IS GIVEN **ONE MONTH** FROM THIS INTERVIEW DATE TO PROVIDE THE MANDATORY STATEMENT OF THE SUBSTANCE OF THE INTERVIEW (37 CFR 1.560(b)). THE REQUIREMENT FOR PATENT OWNERS STATEMENT CAN NOT BE WAIVED. **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

/Eric B. Kiss/ Patent Reexamination Specialist, Art Unit 3992		
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cc: Requester (if third party requester)

Continuation of Description of the general nature of what was agreed to if an agreement was reached, or any other comments: Parties discussed a proposed amendment to claims 14 and 15 that does not alter the scope of the claims, but rather simply includes all of the features of the parent claims. Because claims 14 and 15 were previously found allowable, the examiner indicated that the rewritten versions of the same claims, which are identical in scope, would likewise be considered allowable. Parties briefly discussed proposed dependent claims 16-20, which contain the language found in previously-presented dependent claims. The examiner indicated that such proposed claims would be entered for the purpose of appeal if submitted in a formal response. Patent Owner's representatives asked whether it would be possible to somehow split the proceeding into two separate proceedings in order to preserve the allowable subject matter while appealing the rejected claims. The examiner was unable to suggest a proper procedure for doing so, but indicated allowed claims would naturally remain in the case upon appeal of the rejected claims.

## EXAMINER INTERVIEW AGENDA

**App. No.:** 90/014,507

**Title:** Method of utilizing forced alerts for interactive remote communications

**Examiners:** Eric B. Kiss, Nick Corsaro, Andrew J. Fischer

**Time:** 11:00 AM on 9/13

**Patent Owner's Representatives:** Jialin Zhong, Vincent Rubino, Enrique Iturralde

**Agenda:** to discuss:

1. Entry of proposed amendments to claims 14-15 and new claims 16-21.

### **Proposed amendments:**

14. (New, amended) A communication system for transmitting, receiving, confirming receipt, and responding to an electronic message, comprising: a predetermined network of participants, wherein each participant has a similarly equipped PDA/cell phone that includes a CPU and a touch screen display a CPU and memory; a data transmission means that facilitates the transmission of electronic files between said PDA/cell phones in different locations; a sender PDA/cell phone and at least one recipient PDA/cell phone for each electronic message; a forced message alert software application program including a list of required possible responses to be selected by a participant recipient of a forced message response loaded on each participating PDA/cell phone; means for attaching a forced message alert software packet to a voice or text message creating a forced message alert that is transmitted by said sender PDA/cell phone to the recipient PDA/cell phone, said forced message alert software packet containing a list of possible required responses and requiring the forced message alert software on said recipient PDA/cell phone to transmit an automatic acknowledgment to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone; means for requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display; means for receiving and displaying a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have not automatically acknowledged the forced message alert; means for periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced message alert; means for receiving and displaying a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert and details the response from each recipient PDA/cell phone that responded; and means for displaying a geographical map with georeferenced entities on the display of the sender PDA/cell phone; means for obtaining location and status data associated with the recipient PDA/cell phone; and means for presenting a recipient symbol on the geographical map corresponding to a correct geographical location of the recipient PDA/cell phone, wherein the forced message alert software application program on the recipient PDA/cell phone includes: means for transmitting the acknowledgment of receipt to said sender PDA/cell phone



immediately upon receiving a forced message alert from the sender PDA/cell phone; means for controlling of the recipient PDA/cell phone upon transmitting said automatic acknowledgment and causing, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PDA/cell phone or causes, in cases where the forced message alert is a voice message, the voice message being periodically repeated by the speakers of the recipient PDA/cell phone while said response list is shown on the display; means for allowing a manual response to be manually selected from the response list or manually recorded and transmitting said manual response to the sender PDA/cell phone; and means for clearing the text message and a response list from the display of the recipient PDA/cell phone or stopping the repeating voice message and clearing the response list from the display of the recipient PDA/cell phone once the manual response is transmitted.

15. (New, amended) A method of receiving, acknowledging and responding to a forced message alert from a sender PDA/cell phone to a recipient PDA/cell phone, wherein the receipt, acknowledgment, and response to said forced message alert is forced by a forced message alert software application program, said method comprising the steps of: receiving an electronically transmitted electronic message; identifying said electronic message as a forced message alert, wherein said forced message alert comprises of a voice or text message and a forced message alert application software packet, which triggers the activation of the forced message alert software application program within the recipient PDA/cell phone; transmitting an automatic acknowledgment of receipt to the sender PDA/cell phone, which triggers the forced message alert software application program to take control of the recipient PDA/cell phone and show the content of the text message and a required response list on the display recipient PDA/cell phone or to repeat audibly the content of the voice message on the speakers of the recipient PDA/cell phone and show the required response list on the display recipient PDA/cell phone; and transmitting a selected required response from the response list in order to allow the message required response list to be cleared from the recipient's cell phone display, whether said selected response is a chosen option from the response list, causing the forced message alert software to release control of the recipient PDA/cell phone and stop showing the content of the text message and a response list on the display recipient PDA/cell phone and or stop repeating the content of the voice message on the speakers of the recipient PDA/cell phone; displaying the response received from the PDA cell phone that transmitted the response on the sender of the forced alert PDA/cell phone; providing a list of the recipient PDA/cell phones have automatically acknowledged receipt of a forced alert message and their response to the forced alert message; and displaying a geographical map with georeferenced entities on the display of the sender PDA/cellphone; obtaining location and status data associated with the recipient PDA/cellphone; and presenting a recipient symbol on the geographical map corresponding to a correct geographical location of the recipient PDA/cellphone based on at least the location data.

16. (New) The system as in claim 14, wherein said data transmission means is TCP/IP or another communications protocol.

17. (New) The system as in claim 14, wherein the response list that is transmitted within the forced message alert software packet is a default response list that is embedded in the forced message alert software application program.

18. (New) The system as in claim 14, wherein the response list that is transmitted within the forced message alert software packet is a custom response list that is created at the time the specific forced message alert is created on the sender PDA/cell phone.

19. (New) The method as in claim 15, wherein each PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it.

20. (New) The method as in claim 15, wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program.

21. (New) The method as in claim 15, wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PDA/cell phone.

Date: September 12, 2021

/Jialin Zhong/  
Jialin Zhong  
Reg. No.: 62,937





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ART UNIT 3992.

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### FINAL ACTION

Claims 2 and 10-13 of U.S. Pat. 8,213,970 are under reexamination.

The reply filed June 3, 2021, has been received and entered. The patent owner has proposed new claims 14 and 15. Claims 2 and 10-15 are pending.

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties 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).

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 8,213,970 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 §§ 2207, 2282 and 2286.

### Related Proceedings

The examiner is aware of the following related matters:

The '970 patent is currently involved in the litigation styled *AGIS Software Dev., LLC v. Google LLC*, Case No. 2:19-cv-00361 (E.D. Tex.), which was filed on November 4, 2019.

The '970 patent was involved in an *Inter Partes* Review of claims 1 and 3-9, in which a Final Written Decision found the challenged claims unpatentable. See *Google LLC v. AGIS Software Dev., LLC*, IPR2018-01079, Final Written Decision (P.T.A.B. Nov. 19, 2019). A Notice of Appeal to the United States Court of Appeals for the Federal Circuit was filed on January 21, 2020. The Federal Circuit affirmed the decision of the Patent Trial and Appeal Board. *AGIS Software Dev., LLC v. Google LLC*, No. 2020-1401, slip op. (Fed. Cir. Feb. 4, 2021).

Requests for *Ex Parte* Reexamination have been filed for commonly-assigned U.S. Pats. 9,408,055; 9,445,251; and 9,467,838.

Petitions for *Inter Partes* Review of commonly-assigned U.S. Pat. 9,820,123 have also been filed.

#### **Patents and Publications Cited in the Request**

The request cites the following prior art patents and printed publications:

- 1) U.S. Pat. App. Pub. 2006/0218232 (Kubala);
- 2) U.S. Pat. 6,854,007 (Hammond);
- 3) U.S. Pat. 5,325,310 (Johnson); and
- 4) U.S. Pat. 5,742,905 (Pepe).

#### **Response to Amendment**

The amendment filed June 3, 2021, is objected to as failing to comply with 37 CFR § 1.530(e), which requires an explanation of the support in the disclosure of the patent for the changes to the claims made by the amendment paper.

#### **Additional Evidence Considered**

The Declaration of David Hilliard Williams, filed by the third party requester, has been considered.

The Declaration of Dr. Loren Terveen, filed by the patent owner, has been considered.

#### **Response to Arguments**

##### **Disavowal of claim scope**

The patent owner contends:

As an additional preliminary matter, the representative claim 2 of the '970 patent do not cover email messages. In particular, the claimed forced message alerts are not email messages. For the purposes of clarity, and to the extent any parties have incorrectly interpreted the claim term forced message alerts to mean email messages, **Patent Owner expressly disavows the claim scope for email messages.** The Kubala reference concerns email messages and the Kubala embodiments relied upon in the Office Action describe only email messages. Kubala, as applied in the Office Action, is thus

inapplicable to the inventions in Claims 2 and 10-13 of the '970 patent. See Terveen Decl. at ¶¶ 14-15, 17-18.

(Remarks at 9 (emphasis added).)

Applicant may rebut the presumption of plain meaning by clearly disavowing the full scope of the claim term in the specification. Disavowal, or disclaimer of claim scope, is only considered when it is clear and unmistakable. See *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1341, 58 USPQ2d 1059, 1063 (Fed.Cir.2001) ("Where the specification makes clear that the invention does not include a particular feature, that feature is deemed to be outside the reach of the claims of the patent, even though the language of the claims, read without reference to the specification, might be considered broad enough to encompass the feature in question.").

An applicant may not add a special definition or disavowal after the filing date of the application. MPEP 2173.01(I). However, an applicant may point out or explain in remarks where the specification as filed contains a special definition or disavowal. *Id.*

Here, the patent owner's attempted disavowal is ineffective because the specification as filed contains no clear and unmistakable language indicating such a disavowal.

### **Claim 2 – Kubala and “means for controlling”**

The patent owner contends that because Kubala requires a user to open an email message containing a mandatory response flag in order to initiate the requirement for the recipient to respond, there is no teaching of a “means for controlling” which “cause[s] . . . the text message and a response list to be shown on the display of the recipient PDA/cell phone,” as required by claim 2, (see Remarks at 10-12). The patent owner further contends that Kubala's email application does not “take control” to display the text message and response list, (see Remarks at 12-13).

In the Final Written Decision in the *Inter Partes* Review of claims 1 and 3-9 of the '970 patent, the Patent Trial and Appeal Board discussed the “taking control” aspect of claim 2 (in rejecting the



patent owner's contention that claim 1 required "taking control of the device until a response is made, and then releasing control of the device," the Board noted that claim 2 explicitly recites "means for controlling a PDA/cell phone, supporting our determination that claim 1 does not require taking control of a PDA/cell phone"). *Google LLC v. AGIS Software Dev., LLC*, IPR2018-01079, Final Written Decision (P.T.A.B. Nov. 19, 2019), pp. 51-52. The Board discussed the proper interpretation of the "taking control" aspect of the invention, noting that "[e]ven if we were to agree with Patent Owner that claim 1 requires taking control of a PDA/cell phone, this would not alter the outcome of our Final Decision." *Id.* at 52. The Board reasoned:

In light of the claim language and Specification, we would interpret the forced message alert software application program "effectively tak[ing] control" of a PDA/cell phone to mean that the application program does not allow a recipient to clear a text message and response list or stop a voice message from repeating until the recipient selects a response, because this is the only written description associated with taking control of a PDA/cell phone. [’970 patent, 9:46-54, Claim 2; *see also* ’970 patent at 8:52-57] (explaining that when the recipient selects a response, the application program "releases control" of the recipient device, clearing the display and stopping repeating the voice message). The Specification offers no support for a broader interpretation of taking control of a PDA/cell phone.

Under the hypothetical interpretation in the preceding paragraph, we would find Petitioner has made a persuasive showing because, as we discussed above, Petitioner has shown Kubala teaches requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display. We note that a finding that Kubala teaches e-mail application 206 taking control of a PDA/cell phone would be further supported by Kubala's disclosure that "the user must reply to the received e-mail in some manner *before the e-mail application will allow the user to perform some other action.*" [Kubala] ¶ 53 (emphasis added).

....

When asked why a skilled artisan wouldn't have understood "taking control" to be limited to the only written description in the Specification of what happens when the application program effectively takes control of a PDA (i.e., [’970 patent], 8:39-51 and corresponding portion of Figure 4), Patent Owner responded that "taking control" must mean more because Figure 4 states "the forced voice alert software takes control of the recipient's cell phone . . . and causes" display of the text message or repeating the voice message until a response is sent—the "and" indicating taking control must mean something other than displaying the text message or repeating the voice message until a response is sent, according to Patent Owner. [Hearing Tr.] 36:18-37:25. Patent Owner's position appeared to be that because "taking control" must mean more than

what is described at 8:39–51 and corresponding portion of Figure 4, and because the Specification doesn't explicitly describe any other form of taking control, taking control could be so broad as to include physically grabbing a phone away from someone's hands. *Id.* If we were to consider this belated argument, we would reject Patent Owner's conclusion that "take control" is so broad. The broadest reasonable interpretation of a claim that invokes 35 U.S.C. § 112, ¶ 6 is the structure, material, or act described in the specification as performing the entire claimed function and equivalents thereof. *In re Donaldson Co.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994) (en banc). Therefore, we would not interpret limitation 1.6 more broadly than what is described in the Specification as taking control of a PDA. As we discussed above, the only possible description of taking control of a PDA/cell phone is at 8:39–51 and the corresponding portion of Figure 4.

*Id.* at 52-54.

Although claims 2 and 10-13 were not before the PTAB in the IPR proceeding, the examiner arrived at similar findings here. Specifically, the examiner finds that the "taking control" aspect of the invention, as recited in claims 2 and 10, is supported only by col. 8, lines 39-51, and the corresponding portions of Fig. 4 of the '970 patent, and the forced message alert software application program "effectively tak[ing] control" of a PDA/cell phone means that the application program does not allow a recipient to clear a text message and response list or stop a voice message from repeating until the recipient selects a response. The examiner maintains that Kubala teaches such "taking control." Kubala teaches requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display, and further, Kubala discloses that "the user must reply to the received e-mail in some manner before the e-mail application will allow the user to perform some other action." See Kubala at ¶ 53.

#### **Claim 10 – Kubala and "take control"**

Regarding claim 10, the patent owner contends that Kubala does not teach "tak[ing] control of the recipient PDA/cell phone," (Remarks at 13). This argument has been addressed above and is unpersuasive for reasons already stated.

**Claim 10 – Kubala and “release control”**

The patent owner additionally contends that Kubala does not teach the communication system causing the forced message alert software to release control of the recipient PDA/cell phone, (Remarks at 14-15).

Kubala discloses “causing the forced message alert software to release control of the recipient PDA/cell phone” as claimed. For example, each of the embodiments that Kubala explicitly discloses and suggests “represent[s] a different way of attempting to fulfill a request from the sender of the original message that the recipient should or must provide a reply message in response to the original message.” Kubala at ¶ [0054]. In particular, Kubala discloses that “the user must reply to the received e-mail message in some manner before the e-mail application will allow the user to perform some other action.” Id. at ¶ [0053]. The plain language of Kubala suggests that a user is (1) not allowed to perform some other action before replying to the received e-mail message in some manner, and (2) allowed to perform some other action after replying to the received e-mail message in some manner. Thus, Kubala teaches both “tak[ing] control” and “releas[ing] control” as claimed.

**Disavowal of claim scope and enablement of Kubala**

As noted above, the patent owner’s attempted disavowal of claim scope is ineffective. Patent owner’s contention that the Kubala reference’s disclosure is only enabled as to email applications for email messages and does not disclose how to carry out a mandatory response flag for any other types of messages that are not email messages, (Remarks at 15-16), is not persuasive because the patent owner’s showing is not commensurate in scope with the claims. Email messaging is reasonably within the scope of the claims. The patent owner has admitted that Kubala is enabling for carrying out mandatory response flags for email messages, (*see id.*), which is sufficient to show that Kubala is enabling as applied in the claim rejections.

**Claim 2 – Hammond/Pepe/Johnson and “means for controlling”**

The patent owner contends that because Hammond requires that “the recipient accesses and reviews a message,” there is no teaching of a “means for controlling” which “cause[s] . . . the text message and a response list to be shown on the display of the recipient PDA/cell phone,” as required by claim 2, (see Remarks at 17-20). The patent owner further contends that Hammond’s system does not “take control” to display the text message and response list, (see Remarks at 19-20).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Claims 2 and 10-13 are rejected based on the combination of Hammond, Pepe, and Johnson. As noted in the previous Office action, and maintained below, Pepe discloses the structure and Hammond and Johnson disclose the claimed function of the “means for controlling . . .” limitation. First, Johnson discloses “controlling of the recipient PDA/cell phone upon transmitting said automatic acknowledgment” as claimed. For example, Johnson’s electronic mail object takes control of a device and response must be provided by a recipient in order to clear a received message from recipient’s display. See Johnson at 4:27-31 (“[T]he sender of the electronic mail object may mark or associate an attribute with the electronic mail object such that it cannot be exited out of until the appropriate reply has been made.”); see also *id.* at 4:18-42.

Second, Hammond discloses “causing, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PDA/cell phone or causes, in cases where the forced message alert is a voice message, the voice message being periodically repeated by the speakers of the recipient PDA/cell phone while said response list is shown on the display” as claimed. For example, Hammond explains that “electronic messages” can include email, text,

and voice messages. Hammond at 1:13-16, 1:21-26. Hammond's "system tracks whether each message has been delivered and reviewed by to [sic] each recipient, and uses the message information to resend the messages whose delivery or review is not confirmed." *Id.* at 2:47-50; *see also id.* at Abstract, 2:1-8, 4:21-28, 5:6-20, 6:66-7:63, 10:48-63, Figs. 2, 3A-3B, 4, 5A-5B.

Third, Pepe discloses the claimed structure required by this means-plus-function limitation. For example, Pepe discloses the "application software residing in the PDA" that is described in Pepe by "the screens displayed on a PCI subscriber's PDA." Pepe at 34:10-15; *see also id.* at 5:17-20 ("The application residing in the PDA is described in FIGS. 28-45, which illustrate exemplary screens displayed to a PCI subscriber using a wireless PDA."), 34:9-36:51, Figs. 28-45. Specifically, Pepe's Figures 42 and 45 are exemplary screens that may appear when a user wants to edit a message to be sent to another PDA/cell phone. Each of these screens includes a list of possible responses (i.e., box 710 in Figure 42 and box 734 in Figure 45) that can be selected by the user to send in response to a received message. *See id.* at 36:16-20, 36:38-51.

**Claim 10 – Hammond/Pepe/Johnson and "take control"**

Regarding claim 10, the patent owner contends that Hammond does not teach "tak[ing] control of the recipient PDA/cell phone," (Remarks at 20). This argument has been addressed above and is unpersuasive for reasons already stated.

**Claim 10 – Hammond/Pepe/Johnson and "release control"**

The patent owner additionally contends that the combination of Hammond, Pepe, and Johnson does not teach the communication system causing the forced message alert software to release control of the recipient PDA/cell phone, (Remarks at 20-22).

As set forth in the previous Office action, and maintained below, Johnson discloses “which triggers the . . . application program to take control of the recipient PDA/cell phone” as claimed. For example, Johnson states that “[t]he recipient of the electronic mail object is prompted for a specific response in response to the recipient opening an electronic mail object and is prohibited from performing a selected action until the specific response has been entered by the recipient.” Johnson at Abstract. Thus, Johnson demonstrates that the email application takes control of a recipient device until the recipient provides a specific response. As Johnson takes control until an appropriate reply is made as described above, Johnson also releases control once the reply is made. Johnson at 4:11-42.

**Claim Rejections - 35 USC § 103**

In the event the determination of the status of the application as subject to AIA 35 U.S.C. 102 and 103 (or as subject to pre-AIA 35 U.S.C. 102 and 103) is incorrect, any correction of the statutory basis for the rejection will not be considered a new ground of rejection if the prior art relied upon, and the rationale supporting the rejection, would be the same under either status.

The following is a quotation of pre-AIA 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 2 and 10-13 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Kubala and Hammond.**

The claim chart below discusses relevant teachings of the prior art corresponding to the claim elements.

Claims	Prior Art
2. [A communication system for transmitting, receiving, confirming receipt, and responding to an electronic message, comprising:]	Kubala discloses a communication system for transmitting, receiving, and responding to an electronic message. See Kubala at ¶ [0054], Abstract.  Kubala also discloses that the communication system was known to “generate return receipts to the sender when the sender’s e-mail message is received at its intended destination or when the recipient opens the e-mail message, thereby providing an acknowledgment that a particular message has been received and/or opened. <i>Id.</i> at ¶[0006].
[a predetermined network of participants, wherein each participant has a similarly equipped PDA/cell phone that includes a CPU and a touch screen display a CPU and memory;]	Kubala discloses a predetermined network of participants, which includes a plurality of personal digital assistants 107, 112. Kubala at ¶¶[0026]-[0027], Fig. 1A.

	<p>Each PDA/cell phone includes at least one CPU 122, a memory 124, 126, and a user interface adapter 148, which Kubala describes as being coupled to a touch-screen display. <i>Id.</i> at ¶¶[0029]-[0030], Fig. 1B.</p>
<p>[a data transmission means that facilitates the transmission of electronic files between said PDA/cell phones in different locations;]</p>	<p>Kubala supports a network 109, a client 110, and PDAs/cell phones 112 that (1) “communicate with one another” using, for example, TCP/IP or (2) “directly transfer data between themselves” using, for example, “Bluetooth™ wireless technology or WiFi technology (IEEE 802.11).” Kubala at ¶¶ [0026]-[0027], Fig. 1A.</p>
<p>[a sender PDA/cell phone and at least one recipient PDA/cell phone for each electronic message;]</p>	<p>Kubala discloses a plurality of PDAs/cell phones that communicate with each other. Kubala at ¶¶ [0027], [0032]-[0033], Fig. 1A. In other words, one PDA/cell phone sends an electronic message (i.e., “a sender PDA/cell phone”) and another PDA/cell phone receives it (i.e., a “recipient PDA/cell phone”).</p>
<p>[a forced message alert software application program including a list of required possible responses to be selected by a participant recipient of a forced message response loaded on each participating PDA/cell phone;]</p>	<p>Kubala Figure 2 illustrates an enhanced email application 208 that includes a mandatory-response functional unit 212. The combined enhanced email application 208 and mandatory-response functional unit 212 read on the claimed “forced message alert software application program.” Referring to Figure 2, Kubala explains that the mandatory-response functional unit 212 provides an email message 218 in response to an email message 214 with mandatory-response flag 216. Kubala at ¶ [0035]; <i>see also id.</i> at ¶¶ [0013], [0033], [0036].</p> <p>Kubala also discloses the claimed “list of possible responses to be selected by a participant recipient of a forced message response loaded on each participating PDA/cell phone.” Kubala’s Figure 11C shows an example of alerting a user by displaying a menu 1120 of possible responses to a sender’s message. Kubala explains that a recipient’s selection of one of the “quick response[s]” in menu 1120 fulfills “the sender’s request that the recipient is required to provide a mandatory response.” Kubala at ¶¶ [0022], [0047], [0057]; <i>see also id.</i> at ¶¶ [0054]-[0055].</p>



	<p>Kubala's Figure 11A shows an example of alerting a user by displaying a warning message 1102 when an e-mail message that contains a mandatory request flag is received, and that the recipient "must provide a reply message in response to the original message." Kuballa at ¶¶[0054].</p>
<p>[means for attaching a forced message alert software packet to a voice or text message creating a forced message alert that is transmitted by said sender PDA/cell phone to the recipient PDA/cell phone, said forced message alert software packet containing a list of possible required responses and requiring the forced message alert software on said recipient PDA/cell phone to transmit an automatic acknowledgment to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone;]</p>	<p>Kubala discloses an enhanced email application 206 on a computing device (e.g., PDA) 202, as illustrated in Fig. 2. See Kubala at ¶¶ [0033]-[0036].</p> <p>Kubala discloses a mandatory-response flag 216 that is attached to an email message 214, as illustrated in Fig. 2. Kubala explains that the e-mail message 214 may be a text message, voicemail message, audio message, video message, or other type of message. Kubala at ¶ [0032]. Kubala also explains that "[m]andatory response flag 216 may be implemented in a variety of data formats . . ." <i>Id.</i> at ¶[0035]; see also <i>id.</i> at ¶¶ [0036]-[0041], [0054]-[0061], Figs. 3-4. Thus, Kubala creates the claimed "forced message alert." For example, Kubala's mandatory-response flag 216 that is attached to email message 214 reads on "attaching a forced message alert software packet to a voice or text message creating a forced message alert" as claimed.</p> <p>Kubala also discloses the claimed "list of possible required responses." Kubala's Fig. 11C illustrates an example of alerting a user by displaying a menu 1120 of possible responses that a recipient may choose from in order to respond to a sender's message. Kubala at ¶¶ [0022], [0047], [0057]. And, Kubala discloses that, in one embodiment, the "text strings that are used as menu items" may be "extracted from the original e-mail message that was received from the sender . . ." <i>Id.</i> at ¶[0057]; see also <i>id.</i> at ¶ [0040]-[0041].</p> <p>Moreover, Kubala teaches or suggests the claimed functionality of "requiring the forced message alert software on said recipient PDA/cell phone to transmit an automatic acknowledgment</p>

	<p>to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone.” In fact, Kubala discloses that it was known “to generate return receipts to the sender when the sender’s email message is received at its intended destination or when the recipient opens the e-mail message, thereby providing an acknowledgment that a particular message has been received.” Kubala at ¶ [0006]. Based on these teachings in Kubala, a person of ordinary skill in the art at the time of invention would have understood that the condition that causes the acknowledgement to be sent back to the sender is a configurable parameter which could be set to occur when the sender’s email message is received at its intended destination or, in other words, as soon as it is received at the recipient’s device.</p>
<p>[means for requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display;]</p>	<p>Kubala discloses an enhanced email application 206 on a computing device (e.g., PDA) 202, as illustrated in Fig. 2. See Kubala at ¶¶ [0033]-[0036].</p> <p>Kubala also discloses: “The e-mail application may indicate the presence of a mandatory response flag: using a message within a pop-up window; other information within a status bar; through the use of colors on a display screen; or through some other means of alerting the user.” See Kubala at ¶ [0047]. Again, Kubala discloses “diagrams that represent a set of GUI windows through which an e-mail application alerts a user by displaying warning messages and error messages to the user as a result of a user action when the e-mail application has an e-mail message that contains a mandatory request flag.” See <i>id.</i> at ¶ [0022]. An example of the GUI window alert includes a menu of possible responses from which a recipient can choose. See <i>id.</i> at ¶¶ [0047], [0057], Fig. 11C (menu 1120) which satisfy the claimed “response list.”</p> <p>Although the specific embodiment illustrated in Figure 11C shows that a user can “select ‘CANCEL’ to close without sending a reply,” Kubala also explicitly teaches that “the recipient can be prevented from closing a review of the</p>

	<p>received e-mail message, from deleting the received e-mail message, and from exiting the e-mail application until the recipient has responded to the received email message.” <i>Id.</i> at ¶ [0009], Fig. 11C; <i>see also id.</i> at ¶ [0055]. Moreover, Kubala also discloses that a recipient being required to respond to a mandatory-response message is a configurable feature. <i>See id.</i> at ¶¶ [0009], [0054]-[0055], [0059]-[0060]. For example, the recipient may be required to respond “when the recipient first reviews the e-mail message.” <i>Id.</i> at ¶ [0060].</p>
<p>[means for receiving and displaying a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have not automatically acknowledged the forced message alert;]</p>	<p>Kubala discloses an enhanced email application program 206, 208 that includes mandatory-response functional unit 210, 212 on a PDA. <i>See</i> Kubala at ¶¶ [0033]-[0036], Fig. 2.</p> <p>Kubala further explains that it was known to automatically acknowledge receipt of an electronic message. <i>See id.</i> at ¶[0006]. In addition, Kubala explicitly discloses that the receiving e-mail application may collect and record information about the manner in which the recipient responds to an e-mail message that has a mandatory-response flag. The information may include mandatory-response return-status codes included within the reply e-mail. <i>Id.</i> at ¶¶ [0050]-[0051], [0061], Fig. 9. A person of ordinary skill in the art at the time of invention would have known that a listing of the recorded information regarding the responses or automatic acknowledgements were accessible.</p> <p>To the extent it is argued that Kubala does not teach this limitation, Hammond also states that “the recipient computer systems provide receipts when messages are received and when messages are reviewed . . .” Hammond at 5:20-23; <i>see also id.</i> at Abstract, 2:11-18.</p> <p>These acknowledgement receipts are tracked in Hammond’s Message Tracking Tables, as depicted in Figure 2 and are described throughout the specification. <i>See id.</i> at 3:1-4:28, 5:31-37, 6:56-8:45, 10:6-22.</p> <p>A person of ordinary skill in the art at the time of invention would have been motivated to</p>

	<p>combine Hammond with Kubala based on the disclosures in the references themselves, particularly as they relate to exchanging and tracking recipient-device acknowledgements. Again, Kubala generally discloses that it was known to provide acknowledgement receipts, , see Kubala at ¶ [0006], and record details about the responses to the emails with mandatory-response flags. Hammond also discloses acknowledgement receipts and how to track these acknowledgement receipts. Because these disclosures in Kubala and Hammond are directed to tracking responses to mandatory-responses messages, these disclosures would have motivated a person of ordinary skill in the art to combine Hammond and Kubala. Moreover, it would have been obvious to one of ordinary skill in the art at the time of invention to utilize the tracking tables of Hammond with the system of Kubala in order to manage response tracking information in a known effective way.</p>
<p>[means for periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced message alert; and]</p>	<p>Kubala discloses an enhanced email application 208 that includes mandatory-response functional unit 212 on a PDA. See Kubala at ¶¶ [0033]-[0036], Fig. 2.</p> <p>Kubala discloses that when a reply to an email message with an associated mandatory-response flag has not been made, the enhanced email application 208 loops back to alert the recipient via 1012, as illustrated in Figure 10. The looping back at 1012 has the effect of resending the message to the user until the user replies to the received e-mail message as required. See Kubala at ¶ [0053], Fig. 10.</p> <p>To the extent that it is argued that Kubala does not teach this limitation, Hammond's "system tracks whether each message has been delivered and reviewed by to [sic] each recipient, and uses the message information to resend the messages whose delivery or review is not confirmed." Hammond at 2:47-50; see also <i>id.</i> at Abstract, 2:1-8, 4:21-28, 5:5-6:20, 6:66-7:63, 10:48-63, Figs. 2, 3A, 3B, 4, 5A, 5B.</p>

<p>[means for receiving and displaying a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert and details the response from each recipient PDA/cell phone that responded.]</p>	<p>Kubala discloses an enhanced email application 206, 208 and a mandatory-response functional unit 210, 212 on a PDA, which together are designed to receive and display a listing of which recipient PDA/cell phones have transmitted a manual response to said forced-message alert, and details the response from each recipient PDA/cell phone that responded. See Kubala at ¶¶ [0033]-[0036], [0050]-[0051], [0061], Fig. 2.</p> <p>Kubala's Figure 2 shows that a sending PDA (e.g., computing device 202) can receive and display a response (e.g., email message 218) from a recipient PDA (e.g., computing device 204). See Kubala at ¶¶ [0026]-[0041].</p> <p>Kubala also discloses "receiving and displaying a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert." For example, Kubala states that the receiving e-mail application 208 may collect and record information about the manner in which the recipient responds to an e-mail message that has a mandatory-response flag. The information may include mandatory-response return-status codes included within the reply e-mail. Kubala at ¶¶ [0050]-[0051], [0061], Fig. 9.</p> <p>A person of ordinary skill in the art at the time of invention would have known that a listing of the recorded information regarding the responses to e-mail messages were available and accessible.</p>
<p>. . . wherein the forced message alert software application program on the recipient PDA/cell phone includes:</p>	<p>Kubala discloses the claimed "forced message alert software application program" as a combination of an enhanced email application 208 and mandatory response functional unit 212, on a receiving computing device (e.g., PDA) 204, as illustrated in Figure 2.</p>
<p>means for transmitting the acknowledgment of receipt to said sender PDA/cell phone immediately upon receiving a forced message alert from the sender PDA/cell phone;</p>	<p>Kubala discloses the combination of an enhanced email application 208 and mandatory response functional unit 212 on a recipient computing device 204 (e.g., PDA), as illustrated in Figure 2. See Kubala at ¶¶ [0033]-[0036].</p> <p>Kubala discloses that it was known "to generate return receipts to the sender when the sender's</p>

	<p>email message is received at its intended destination or when the recipient opens the e-mail message, thereby providing an acknowledgment that a particular message has been received.” Kubala at ¶ [0006].</p> <p>Based on these teachings in Kubala, a person of ordinary skill in the art at the time of invention would have understood that the condition that causes the acknowledgement to be sent back to the sender is a configurable parameter which could be set to occur when the sender’s email message is received at its intended destination or, in other words, as soon as it is received at the recipient’s device.</p>
<p>means for controlling of the recipient PDA/cell phone upon transmitting said automatic acknowledgment and causing, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PDA/cell phone or causes, in cases where the forced message alert is a voice message, the voice message being periodically repeated by the speakers of the recipient PDA/cell phone while said response list is shown on the display;</p>	<p>Kubala discloses the combination of an enhanced email application 208 and mandatory response functional unit 212 on a recipient computing device 204 (e.g., PDA). Kubala at ¶¶ [0033]-[0036], Fig. 2.</p> <p>Kubala discloses the required function of “controlling ... the recipient PDA/cell phone upon transmitting said automatic acknowledgment.” As discussed above, Kubala discloses various embodiments for requiring a response to an “e-mail message.” And Kubala explains that its disclosure is not limited to only emails; instead, according to Kubala, “an e-mail message comprise various types of electronic messages, e.g., text messages, instant messages, fax messages, voicemail messages, video messages, audio messages, and other types of messages.” Kubala at ¶ [0032]. Each of the embodiments that Kubala explicitly discloses and suggests “represents] a different way of attempting to fulfill a request from the sender of the original message that the recipient should or must provide a reply message in response to the original message.” <i>Id.</i> at ¶ [0054]. In particular, Kubala discloses that “the user must reply to the received e-mail message in some manner before the e-mail application will allow the user to perform some other action.” <i>Id.</i> at ¶ [0053].</p> <p>Although the specific embodiment illustrated in Figure 11C shows that a user can “select</p>

'CANCEL' to close without sending a reply," Kubala also explicitly teaches that "the recipient can be prevented from closing a review of the received e-mail message, from deleting the received e-mail message, and from exiting the e-mail application until the recipient has responded to the received email message." Kubala at ¶ [0009], Fig. 11C; see also *id.* at ¶ [0055]. Moreover, Kubala also discloses that a recipient being required to respond to a mandatory-response message is a configurable feature. See *id.* at ¶¶ [0054]-[0055], [0059]-[0060]. For example, the recipient may be required to respond "when the recipient first reviews the e-mail message." *Id.* at ¶ [0060].

Kubala's Figure 11A (reproduced below) shows an example of alerting a user by displaying a warning message 1102 when an e-mail message that contains a mandatory request flag is received, and shows that the recipient "must provide a reply message in response to the original message." *Id.* at ¶ [0054].

Kubala teaches or suggests the claimed requirement of "causing, in cases where the force[d] message alert is a text message, the text message and a response list to be shown on the display of the recipient PDA/cell phone or causes, in cases where the forced message alert is a voice message, the voice message being periodically repeated by the speakers of the recipient PDA/cell phone while said response list is shown on the display." As set forth above, Kubala explains that e-mail message 214 may be a text message or a voicemail or audio message. Kubala at ¶ [0032]. Kubala discloses that when a reply to an email message with an associated mandatory-response flag has not been made, the enhanced email application 208 loops back to alert the recipient via 1012, as illustrated in Figure 10. The looping back at 1012 has the effect of resending the message—that can be a text or voice message—to the user until the user replies to the received message as required. See *id.* at ¶ [0053]; Fig. 10.

	<p>To the extent that it is argued that Kubala does not teach this limitation, Hammond's "system tracks whether each message has been delivered and reviewed by to [sic] each recipient, and uses the message information to resend the messages whose delivery or review is not confirmed." Hammond at 2:47-50; <i>see also id.</i> at Abstract, 2:1-8, 4:21-28, 5:5-6:20, 6:66-7:63, 10:48-63, Figs. 2, 3A, 3B, 4, 5A, 5B.</p>
<p>means for allowing a manual response to be manually selected from the response list or manually recorded and transmitting said manual response to the sender PDA/cell phone; and</p>	<p>Kubala's Figure 2 shows that a receiving PDA (e.g., computing device 204) can receive email message 214 from a sender PDA (e.g., computing device 202). Kubala discloses an enhanced email application 208 and a mandatory-response functional unit 212 on a recipient PDA, which together are designed to receive and display a response list, and also transmit a selection from the response list to computing device 202—the sender PDA—via email message 218. <i>See</i> Kubala at ¶¶ [0033]-[0036], [0050]-[0051], [0061], Fig. 2.</p> <p>Kubala states that the receiving e-mail application 208 may collect and record information about the manner in which the recipient responds to an e-mail message that has a mandatory-response flag. The information may include mandatory-response return-status codes included within the reply e-mail. Kubala at ¶¶ [0041], [0050]-[0051], [0061], Fig. 9. A person of ordinary skill in the art at the time of invention would have known that a listing of the recorded information regarding the responses to e-mail messages were available and accessible.</p> <p>Hammond also provides this disclosure. Hammond discloses a "Message Receipt Tracker component [that] attempts to identify when sent messages have been delivered to recipients and when sent messages have been reviewed by recipients." Hammond at 5:17-20; <i>see also id.</i> at 5:20-6:55. Hammond's Figure 2 shows a Message Tracking Table that includes detailed information about electronic messages that have been read by recipients. <i>See id.</i> at 6:56-8:45. And Hammond discloses a Message Receipt Tracker routine, <i>id.</i></p>



	<p>at Fig. 4, 10:5-47, and a Message Tracking Table Processor routine, <i>id.</i> at Figs. 5A, 5B, 10:48-11:48.</p>
<p>means for clearing the text message and a response list from the display of the recipient PDA/cell phone or stopping the repeating voice message and clearing the response list from the display of the recipient PDA/cell phone once the manual response is transmitted.</p>	<p>Kubala discloses that a user can select a response from a menu of responses. Kubala's use of the term "email message" includes "text messages, instant messages, fax messages, voicemail messages, video messages, audio messages, and other types of messages." Kubala at ¶¶ [0032]-[0033], [0057], Fig. 11C.</p> <p>Kubala also teaches the required function of "clearing the text message and a response list from the display of the recipient PDA/cell phone or stopping the repeating voice message and clearing the response list from the display of the recipient PDA/cell phone once the manual response is transmitted." For example, after selecting a response from menu 1120, a user presses the "INSTANT" button 1118, which closes window 1112, thus clearing or stopping the text message, the repeating voice message, and a response list from the display of the recipient PDA, and generating a reply message. Kubala at ¶ [0057]. Kubala explains:</p> <p style="padding-left: 40px;">"INSTANT" button 1118 closes window 1112 and then creates a reply e-mail message with an automatically generated reply message in which the message body is predetermined or pre-configured; in this example, when "INSTANT" button 1118 is selected, the e-mail application determines which menu item within menu 1120 has been selected by the user as a quick response to the original e-mail message, thereby fulfilling the sender's request that the recipient is required to provide a mandatory response.</p> <p><i>Id.</i>; see also <i>id.</i> at ¶¶ [0033]-[0036], [0049], [0053]-[0054], Figs. 2, 8, 10, 11C.</p>
<p>10. A method of receiving, acknowledging and responding to a forced message alert from a sender PDA/cell phone to a recipient PDA/cell phone, wherein the receipt, acknowledgment,</p>	<p>Kubala discloses a "method of receiving, acknowledging and responding to a forced message alert from a sender PDA/cell phone to a recipient PD A/cell phone" as claimed. For</p>

<p>and response to said forced message alert is forced by a forced message alert software application program, said method comprising the steps of:</p>	<p>example, Kubala discloses a communication system for receiving, and responding to an electronic message. <i>See</i> Kubala at ¶ [0054], Abstract. Kubala also discloses a plurality of PDAs/cell phones that communicate with each other. <i>Id.</i> at ¶¶ [0027], [0032]-[0033], Fig. 1A. In other words, one PDA/cell phone sends an electronic message (i.e., “a sender PDA/cell phone”) and another PDA/cell phone receives it (i.e., a “recipient PDA/cell phone”).</p> <p>Kubala also discloses “wherein the receipt, acknowledgment, and response to said forced message alert is forced by a forced message alert software application program” as claimed. Kubala discloses that it was known to “generate return receipts to the sender when the sender’s e-mail message is received at its intended destination or when the recipient opens the e-mail message, thereby providing an acknowledgement that a particular message has been received and/or opened.” Kubala at ¶ [0006].</p> <p>Kubala’s Figure 2 illustrates an enhanced email application 208 that includes a mandatory-response functional unit 212. The combined enhanced email application 208 and mandatory-response functional unit 212 read on the claimed “forced message alert software application program.” Referring to Figure 2, Kubala explains that the mandatory-response functional unit 212 provides an email message 218 in response to an email message 214 with a mandatory-response flag 216. As discussed above, the mandatory-response flag 216 attached to the email message 214 reads on the claimed “forced message alert.” <i>Id.</i> at ¶ [0035]; <i>see also id.</i> at ¶¶ [0013], [0036].</p> <p>Kubala’s Figure 11A shows an example of alerting a user by displaying a warning message 1102 when an e-mail message that contains a mandatory request flag is received, and that the recipient “must provide a reply message in response to the original message.” Kubala at ¶ [0054]. This demonstrates that the response to said forced message alert is forced by the combination of Kubala’s enhanced email</p>
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	<p>application 208 and mandatory response functional unit 212.</p>
<p>receiving an electronically transmitted electronic message;</p> <p>identifying said electronic message as a forced message alert, wherein said forced message alert comprises of a voice or text message and a forced message alert application software packet, which triggers the activation of the forced message alert software application program within the recipient PDA/cell phone;</p>	<p>Kubala discloses the claimed forced message alert software application program as the combination of an enhanced email application 208 and mandatory response functional unit 212 on a receiving computing device 204 (e.g., receiving PDA) that receives email message 214, as illustrated in Figure 2. See Kubala at ¶¶ [0033]-[0036].</p> <p>The claimed “forced message alert [that] comprises of a voice or text message and a forced message alert application software packet” is met by Kubala’s disclosure of email message 214 and the mandatory response flag 216. Kubala explains that e-mail message 214 may be a text message, voicemail message, audio message, video message, or other type of message. Kubala at ¶ [0032]. Kubala also explains that “[mandatory response flag 216 acts as an indicator ... to e-mail application 208 that e-mail message 214 should be handled as an important message with a required mandatory response. Mandatory response flag 216 may be implemented in a variety of data formats . . . .” Id. at ¶ [0035]; see also <i>id.</i> at ¶¶ [0036]-[0041], Figs. 3, 4.</p>
<p>transmitting an automatic acknowledgment of receipt to the sender PDA/cell phone, which triggers the forced message alert software application program to take control of the recipient PDA/cell phone and show the content of the text message and a required response list on the display recipient PDA/cell phone or to repeat audibly the content of the voice message on the speakers of the recipient PDA/cell phone and show the required response list on the display recipient PDA/cell phone; and</p>	<p>Kubala discloses “transmitting an automatic acknowledgment of receipt to the sender PDA/cell phone” as claimed. For example, Kubala discloses that it was known to “generate return receipts to the sender when the sender’s e-mail message is received at its intended destination or when the recipient opens the e-mail message, thereby providing an acknowledgement that a particular message has been received and/or opened.” Kubala at ¶ [0006].</p> <p>Kubala discloses “triggers the forced message alert software application program to take control of the recipient PDA/cell phone” as claimed. For example, Kubala’s Figure 2 illustrates an enhanced email application 208 that includes a mandatory-response functional unit 212 on computing device 204. The combined enhanced</p>

email application 208 and mandatory-response functional unit 212 read on the claimed “forced message alert software application program to take control of the recipient PDA/cell phone.” Referring to Figure 2, Kubala explains that the mandatory-response functional unit 210 provides an email message 218 in response to an email message 214 with a mandatory-response flag 216. *Id.* at ¶ [0035]; *see also id.* at ¶¶ [0013], [0033], [0036].

Each of the embodiments that Kubala explicitly discloses and suggests “represent a different way of attempting to fulfill a request from the sender of the original message that the recipient should or must provide a reply message in response to the original message.” Kubala at ¶ [0054]. In particular, Kubala discloses that “the user must reply to the received e-mail message in some manner before the e-mail application will allow the user to perform some other action.” *Id.* at ¶ [0053].

Kubala also discloses the claimed “show the content of the text message and a required response list on the display recipient PDA/cell phone” as claimed. Kubala’s Figure 11C shows an example of displaying the content of a message and a menu 1120 of possible responses to a sender’s message.

Kubala also discloses “to repeat audibly the content of the voice message on the speakers of the recipient PDA/cell phone and show the required response list on the display recipient PDA/cell phone” as claimed. Kubala explains that e-mail message 214 may be a text message, or a voicemail or audio message. Kubala at ¶ [0032]. And, Kubala states that a data processing system such as a PDA can include an “audio output system.” *Id.* at ¶ [0029]. Kubala discloses that when a reply to an email message with an associated mandatory-response flag has not been made, the enhanced email application 208 loops back to alert the recipient via 1012, as illustrated in Figure 10. The looping back at 1012 has the effect of resending the message to the user until

	<p>the user replies to the received e-mail message as required. <i>See id.</i> at ¶ [0053], Fig. 10.</p> <p>To the extent that it is argued that Kubala does not teach this limitation, Hammond's "system tracks whether each message has been delivered and reviewed by to [sic] each recipient, and uses the message information to resend the messages whose delivery or review is not confirmed." Hammond at 2:47-50; <i>see also id.</i> at Abstract, 2:1-8, 4:21-28, 5:5-6:20, 6:66-7:63, 10:48-63, Figs. 2, 3A, 3B, 4, 5A, 5B.</p>
<p>transmitting a selected required response from the response list in order to allow the message required response list to be cleared from the recipient's cell phone display, whether said selected response is a chosen option from the response list, causing the forced message alert software to release control of the recipient PDA/cell phone and stop showing the content of the text message and a response list on the display recipient PDA/cell phone and or stop repeating the content of the voice message on the speakers of the recipient PDA/cell phone;</p>	<p>Kubala discloses "transmitting a selected required response from the response list in order to allow the message required response list to be cleared from the recipient's cell phone display, whether said selected response is a chosen option from the response list, causing the forced message alert software to . . . stop showing the content of the text message and a response list on the display recipient PDA/cell phone and or stop repeating the content of the voice message on the speakers of the recipient PDA/cell phone" as claimed. For example, Kubala discloses that a user can select a response from a menu of responses. Kubala's use of the term "email message" includes "text messages, instant messages, fax messages, voicemail messages, video messages, audio messages, and other types of messages." <i>See Kubala</i> at ¶¶ [0032]-[0033], [0057], Fig. 11C.</p> <p>After selecting a response from menu 1120, a user presses the "INSTANT" button 1118, which closes window 1112, thus clearing or stopping the text message, the repeating voice message, and a response list from the display of the recipient PDA, and generating a reply message. Kubala at ¶ [0057]. Kubala explains:</p> <p style="padding-left: 40px;">"INSTANT" button 1118 closes window 1112 and then creates a reply e-mail message with an automatically generated reply message in which the message body is predetermined or pre-configured; in this example, when "INSTANT" button 1118 is selected, the e-mail</p>

	<p>application determines which menu item within menu 1120 has been selected by the user as a quick response to the original e-mail message, thereby fulfilling the sender's request that the recipient is required to provide a mandatory response.</p> <p><i>Id.</i>; see also <i>id.</i> at ¶¶ [0022], [0033]-[0036], [0047], [0049], [0053]-[0055], [0057], [0060], Figs. 2, 8, 10, 11C.</p> <p>Kubala discloses “causing the forced message alert software to release control of the recipient PDA/cell phone” as claimed. For example, each of the embodiments that Kubala explicitly discloses and suggests “represent[s] a different way of attempting to fulfill a request from the sender of the original message that the recipient should or must provide a reply message in response to the original message.” Kubala at ¶ [0054]. In particular, Kubala discloses that “the user must reply to the received e-mail message in some manner before the e-mail application will allow the user to perform some other action.” <i>Id.</i> at ¶ [0053]. Accordingly, after the user has replied to the received email, it follows that Kubala’s e-mail application releases control of the PDA/cell phone to allow the user to perform some other action.</p>
<p>displaying the response received from the PDA[/] cell phone that transmitted the response on the sender of the forced alert PDA/cell phone; and</p>	<p>Kubala discloses “displaying the response received from the PDA[/]cell phone that transmitted the response on the sender of the forced alert PDA/cell phone” as claimed. Kubala discloses an enhanced email application 206, 208 and a mandatory-response functional unit 210, 212 on a PDA, which together are designed to receive and display a listing of which recipient PDA/cell phone (e.g., computing device 204) has transmitted a manual response to the forced message alert, and details the response from each recipient PDA/cell phone that responded. See Kubala at ¶¶ [0033]-[0036], [0050]-[0051], [0061], Fig. 2.</p> <p>Kubala’s Figure 2 shows that a sending PDA (e.g., computing device 202) can receive and display a</p>

	<p>response (e.g., email message 218) from a recipient PDA (e.g., computing device 204). See Kubala at ¶¶ [0026]-[0041]. This disclosure from Kubala meets the claimed requirement “displaying the response received from the PDA[/]cell phone that transmitted the response on the sender of the forced alert PDA/cell phone.”</p> <p>Hammond also provides this disclosure. Hammond discloses “displaying the response received from the PDA[/]cell phone that transmitted the response on the sender of the forced alert PDA/cell phone,” as claimed. For example, Hammond discloses a “Message Receipt Tracker component [that] attempts to identify when sent messages have been delivered to recipients and when sent messages have been reviewed by recipients.” Hammond at 5:17-20; see also <i>id.</i> at 5:20-6:55. Hammond’s Figure 2 shows a Message Tracking Table that includes detailed information about electronic messages that have been read by recipients. See <i>id.</i> at 6:56-8:45. And, Hammond discloses a Message Receipt Tracker routine, <i>id.</i> at FIG. 4, 10:5-47, and a Message Tracking Table Processor routine, <i>id.</i> at Figs. 5A, 5B, 10:48-11:48.</p> <p>A person of ordinary skill in the art at the time of invention would have been motivated to combine Hammond with Kubala based on the disclosures in the references themselves, particularly as they relate to exchanging and tracking recipient-device acknowledgements. Again, Kubala generally discloses that it was known to provide acknowledgement receipts, , see Kubala at ¶ [0006], and record details about the responses to the emails with mandatory-response flags. Hammond also discloses acknowledgement receipts and how to track these acknowledgement receipts. Because these disclosures in Kubala and Hammond are directed to tracking responses to mandatory-responses messages, these disclosures would have motivated a person of ordinary skill in the art to combine Hammond and Kubala. Moreover, it would have been obvious to one of ordinary skill in the art at the time of invention to utilize</p>
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	<p>the tracking tables of Hammond with the system of Kubala in order to manage response tracking information in a known effective way.</p>
<p>providing a list of the recipient PDA/cell phones have automatically acknowledged receipt of a forced alert message and their response to the forced alert message.</p>	<p>Kubala discloses “providing a list of the recipient PDA/cell phones have automatically acknowledged receipt of a forced alert message and their response to the forced alert message” as claimed. For example, Kubala discloses an enhanced email application 206, 208 that includes mandatory-response functional unit 210, 212 on a PDA. <i>See</i> Kubala at ¶¶ [0033]-[0036], Fig. 2. Kubala further explains that it was known to automatically acknowledge receipt of an electronic message. <i>See id.</i> at ¶ [0006]. In addition, Kubala explicitly discloses that the receiving e-mail application may collect and record information about the manner in which the recipient responds to an e-mail message that has a mandatory-response flag. The information may include mandatory-response return-status codes included within the reply e-mail. <i>Id.</i> at ¶¶ [0050]-[0051], [0061], Fig. 9. A person of ordinary skill in the art at the time of invention would have known that a listing of the recorded information regarding the responses or automatic acknowledgements were accessible.</p> <p>To the extent it is argued that Kubala does not teach this limitation, Hammond also discloses “providing a list of the recipient PDA/cell phones have automatically acknowledged receipt of a forced alert message and their response to the forced alert message” as claimed. For example, Hammond states that “the recipient computer systems provide receipts when messages are received and when messages are reviewed . . . Hammond at 5:20-23; <i>see also id.</i> at Abstract, 2:11-18. These acknowledgement receipts are tracked in Hammond’s Message Tracking Tables, as depicted in Figure 2, and are described throughout the specification. <i>See id.</i> at 3:1-4:28, 5:31-37, 10:6-22, 6:56-8:45.</p>
<p>11. The method as in claim 10, wherein each PDA/cell phone within a predetermined communication network is similarly equipped</p>	<p>Kubala discloses “wherein each PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it”</p>



<p>and has the forced message alert software application program loaded on it.</p>	<p>as claimed. For example, the predetermined network of participants is shown in Kubala's Figure 1A, which includes a plurality of personal digital assistants 107, 112. See Kubala at ¶¶ [0026]-[0027].</p> <p>Kubala's Figure 1B illustrates that each PDA/cell phone includes at least one CPU 122, a memory 124, 126, and a user interface adapter 148, which Kubala describes as being coupled to a touch-screen display. See Kubala at ¶¶ [0029]-[0030].</p> <p>Kubala's Figure 2 illustrates an enhanced email application 206, 208 that includes a mandatory-response functional unit 210, 212. The combined enhanced email application 206, 208 and mandatory-response functional unit 210, 212 read on the claimed "forced message alert software application program loaded on" computing device 202, 204 that can be a PDA/cell phone. Kubala at ¶ [0035]; see also <i>id.</i> at ¶¶ [0013], [0033], [0036].</p>
<p>12. The method as in claim 10, wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program.</p>	<p>Kubala teaches or suggests at least a "forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program," as claimed. For example, Kubala says that "[t]he text strings that are used as menu items may be obtained in a variety of manners." Kubala at ¶ [0057]. Furthermore, Kubala's Figure 11C includes a list of possible default responses, including "too busy right now," "looks okay," and "request declined." <i>Id.</i> at ¶ [0057], Fig. 11C. These are default responses. Kubala also explains that the text strings may be "required and standardized within a data format specification, e.g., in a standard similar to RFC 2822." <i>Id.</i> at ¶ [0057]; see also <i>id.</i> at ¶ [0060]. Kubala's disclosure of these types of menu items teaches or suggests the claimed "default [response] list."</p>
<p>13. The method as in claim 10, wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the</p>	<p>Kubala discloses "wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on</p>

<p>time the specific forced message alert is created on the sender PDA/cell phone.</p>	<p>the sender PDA/cell phone” as claimed. Again, Kubala says that “[t]he text strings that are used as menu items may be obtained in a variety of manners.” Kubala at ¶ [0057]. In one example, the text strings are “configurable”:</p> <p style="padding-left: 40px;">[T]he text strings may be configurable through the enhanced e-mail application by allowing user-specifiable or system-administrator-specifiable parameters. As another alternative, the text strings may be extracted from the original e-mail message that was received from the sender, in which case the text strings may have been configured as user-specifiable or system-administrator-specifiable parameters in the sender’s instance of the enhanced e-mail application.”</p> <p><i>Id.</i>; see also <i>id.</i> at ¶ [0060]. Kubala’s disclosure of “configurable” menu items teaches or suggests the claimed “custom response list.”</p>
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**Claims 2 and 10-13 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Hammond, Johnson, and Pepe.**

The claim chart below discusses relevant teachings of the prior art corresponding to the claim elements. The Declaration of David Hilliard Williams (filed with the Request) is also cited below, as relevant to determining the scope and content of the prior art.

Claims	Prior Art
<p>2. [A communication system for transmitting, receiving, confirming receipt, and responding to an electronic message, comprising:]</p>	<p>Hammond, Johnson, and Pepe each disclose communication systems for transmitting, receiving, and responding to electronic messages. See Hammond at Abstract, 2:11-18; Johnson at Abstract, 3:4-15, Fig. 1; Pepe at Abstract, 3:45-57, 5:28-14:21, Figs. 1-6. And, Hammond’s and Johnson’s systems “confirm [ ] receipt” of</p>

	<p>electronic messages, as claimed. <i>See</i> Hammond at 3:1-30, 5:17-61; Johnson at 1:58-61, 3:64-4:2.</p>
<p>[a predetermined network of participants, wherein each participant has a similarly equipped PDA/cell phone that includes a CPU and a touch screen display a CPU and memory;]</p>	<p>Hammond, Johnson, and Pepe each disclose “a predetermined network of participants,” as claimed. <i>See</i> Hammond at Abstract, 2:11-18; Johnson at Abstract, 2:16-31, 3:4-15, Fig. 1; Pepe at Abstract, 3:45-57, 5:28-14:21, Figs. 1-6. But, Hammond’s and Johnson’s networks include “computers.” <i>See, e.g.</i>, Hammond at 4:29-47, Fig. 1 (describing computer systems 100, 150, 160, 170, and 180); Johnson at 3:4-4:2, Fig. 1 (describing computers 12 and 30 in LAN 10 and 32).</p> <p>To the extent that Hammond and Johnson’s disclosure of “computers” is found to not encompass a PDA/cell phone, Pepe supplies this missing disclosure. For example, Pepe’s Figures 1-6 show a plurality of PDA/cell phones interacting in a network. <i>See also</i> Pepe at 5:28-14:21. Each PDA includes a CPU, an input-output device, a display, and a memory. <i>See id.</i> at 16:50-61, Fig. 12. Although the phrase “touchscreen display” does not appear in Pepe, a person of ordinary skill in the art at the time of invention would have understood Pepe’s disclosure of an input-output device and display to teach or suggest the claimed touchscreen display, because PDAs with touchscreen displays were known well before the ’970 patent. (<i>See</i> Williams Decl. at ¶¶ 5, 80, 82, 93, 99, 258, 263 (discussing devices that included a touchscreen display).)</p> <p>A person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe with Hammond and Johnson at least based on the teachings in these references. For example, all these references are directed to sending and receiving electronic messages. <i>See</i> Hammond at Abstract, 2:11-17; Johnson at Abstract, 3:4-15, Fig. 1; Pepe at Abstract, 3:45-58, 5:28-14:21, Figs. 1-6. And, Hammond says that “any transmission medium”—including “wireless RF”—“can be used for the transmission of the electronic messages.” Hammond at 4:33-38. Similarly, Johnson says that “[t]he electronic mail object may be in the form of text, an image, or a</p>

	<p>voice message.” Johnson at 4:1-2; <i>see also id.</i> at 4:3-18. Hammond’s disclosure of “wireless RF” and Johnson’s disclosure of “text,” “image,” or “voice” messages suggests the use of a PDA/cell phone. (See Williams Decl. at ¶¶ 264-265.) Based on these disclosures, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe’s PDA/cell phone with the force-response message systems of Hammond and Johnson.</p>
<p>[a data transmission means that facilitates the transmission of electronic files between said PDA/cell phones in different locations;]</p>	<p>Pepe discloses a PCI server 48 that enables the PDA/cell phone to communicate according to TCP/IP. <i>See</i> Pepe at 24:31-38, 24:54-61. And, those communications can be with other PDAs/cell phones. <i>See id.</i> at 33:4-34:10.</p>
<p>[a sender PDA/cell phone and at least one recipient PDA/cell phone for each electronic message;]</p>	<p>Pepe expressly discloses a sender PDA/cell phone and at least one recipient PDA/cell phone for each electronic message. Pepe explains that a first PDA/cell phone can send a message to a second PDA/cell phone. <i>See</i> Pepe at 33:5-52, Figs. 25-26; <i>see also id.</i> at Figs. 1-6 (showing PDAs in a network), 9:1-6 (explaining that a plurality of PDAs may be connected to a wireless network and messages may be sent to and from those PDAs).</p>
<p>[a forced message alert software application program including a list of required possible responses to be selected by a participant recipient of a forced message response loaded on each participating PDA/cell phone;]</p>	<p>The combination of Hammond, Johnson, and Pepe discloses this limitation. In particular, Hammond and Johnson each disclose systems for requiring a response to an electronic message. <i>See</i> Hammond at Abstract, 1:66-2:50, 3:31-4:28, 6:3-19, 9:12-15; Johnson at Abstract, 1:58-61, 3:64-4:2, 4:28-39, 5:1-6:65, 7:46-62, Fig. 6. Yet neither Hammond nor Johnson discloses a software-application program that is loaded on each PDA/cell phone and that includes a list of possible responses.</p> <p>Pepe supplies this missing disclosure. It discloses “application software residing in the PDA” that is described in Pepe by “the screens displayed on a PCI subscriber’s PDA.” Pepe at 34:10-15; <i>see also id.</i> at 5:17-20 (“The application residing in the PDA is described in FIGS. 28-45, which illustrate exemplary screens displayed to a PCI subscriber using a wireless PDA.”), 34:9-36:51, Figs. 28-45.</p>

	<p>Specifically, Pepe's Figures 42 and 45 are exemplary screens that may appear when a user wants to edit a message to be sent to another PDA/cell phone. Each of these screens includes a list of possible responses (i.e., box 710 in Figure 42 and box 734 in Figure 45) that can be selected by the user to send in response to a received message. <i>See id.</i> at 36:16-20, 36:38-51.</p> <p>As explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe's PDA/cell phone with the forced-response message systems of Hammond and Johnson.</p>
<p>[means for attaching a forced message alert software packet to a voice or text message creating a forced message alert that is transmitted by said sender PDA/cell phone to the recipient PDA/cell phone, said forced message alert software packet containing a list of possible required responses and requiring the forced message alert software on said recipient PDA/cell phone to transmit an automatic acknowledgment to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone;]</p>	<p>The combination of Hammond, Johnson, and Pepe discloses this limitation. In particular, Hammond and Johnson each alone discloses the transmission of forced message alerts to recipient computers. For example, Hammond explains that "electronic messages" include "email, paging [text] messages, and voice mail." Hammond at 1:13-16, 1:21-26. Hammond also discloses "message delivery information" that is attached to a message. <i>Id.</i> at 3:31-43. Thus, Hammond creates the claimed "forced message alert." For example, Hammond's "message delivery information" that is attached to a message reads on "attaching a forced message alert software packet to a voice or text message creating a forced message alert" as claimed. <i>See id.</i> at Abstract, 1:66-2:50, 3:1-4:28, 5:17-61, 6:3-19.</p> <p>Johnson discloses "a mechanism for forcing a recipient to reply to an electronic mail object with data." Johnson at 4:4-6. Johnson also states that "the sender of the electronic mail object may mark or associate an attribute with the electronic mail object such that it cannot be exited out of until the appropriate reply has been made. These attributes are called 'persistent reply attributes'." <i>Id.</i> at 4:28-32. And, Johnson says that "[t]he electronic mail object may be in the form of text, an image, or a voice message." <i>Id.</i> at 4:1-2. Thus, Johnson's persistent reply attribute reads on the claimed "forced message</p>

	<p>alert software packet” as the persistent reply attribute marks or attaches to a “voice or text message creating a forced message alert” as claimed. <i>See id.</i> at 1:58-61, 2:1-35, 3:64-4:42, 6:60-65. Thus, Johnson creates the claimed “forced message alert.”</p> <p>And, Hammond and Johnson also each disclose that the transmitted message requires the recipient device to transmit an automatic acknowledgement as soon as the message is received by the recipient device. <i>See</i> Hammond at 1:46-54, 5:17-44, 11:55-12:6; Johnson at 1:58-61, 2:6-15, 3:64-4:1. Yet, Hammond and Johnson do not explicitly disclose application software on a PDA/cell phone as required by the recited “means for attaching . . .”, nor do these references explicitly disclose a list of possible required responses—as recited in this claim.</p> <p>Pepe, however, describes both. First, as set forth above, Pepe discloses “application software residing in the PDA.” <i>See</i> Pepe at 5:17-20, 34:9-36:51, Figs. 28-45.</p> <p>Second, as also set forth above, Pepe discloses a list of possible responses that can be selected by a user to send in response to a received message. <i>See id.</i> at 36:16-20, 36:38-51, Figs. 42, 45.</p>
<p>[means for requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display;]</p>	<p>Johnson discloses the function, and Pepe discloses the structure, recited in this limitation. In particular, Johnson discloses that a response must be provided by a “recipient in order to clear [a received message] from recipient’s cell phone display.” <i>See</i> Johnson at 4:27-31 (“[T]he sender of the electronic mail object may mark or associate an attribute with the electronic mail object such that it cannot be exited out of until the appropriate reply has been made.”); <i>see also id.</i> at 4:18-42. Pepe discloses the structure required by this means-plus-function, the application software that is resident on the PDA/cell phone, Pepe at 5:17-20, 34:9-36:51, Figs. 28-45, and a list of possible responses that can be selected by a user to send in response to a received message. <i>See</i> Pepe at 36:16-20, 36:38-51, Figs. 42, 45. As</p>

	<p>explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe's PDA/cell phone with Johnson's forced-response message system.</p>
<p>[means for receiving and displaying a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have not automatically acknowledged the forced message alert;]</p>	<p>Hammond discloses the function, and Pepe discloses the structure, recited in this limitation. In particular, Hammond tracks which recipients have automatically acknowledged a forced-message alert. <i>See</i> Hammond at 2:11-15 (disclosing that Hammond's system tracks "message delivery information and message review information"); <i>see also id.</i> at 5:17-8:45, (disclosing additional details about the Message Receipt Tracker component and Message Tracking Table Processor component), Fig. 2 (illustrating an example Message Tracking Table). Hammond also tracks which recipients have not automatically acknowledged the forced message alert. <i>See id.</i> at 2:11-15 (disclosing that Hammond's system "specifies actions to take when a message is not delivered or not reviewed within a specified period of time."); <i>see also id.</i> at 5:17-8:45 (disclosing additional details about the Message Receipt Tracker component), FIG. 2 (illustrating an example Message Tracking Table). Despite disclosing these claimed functions, Hammond does not disclose the claimed structure—i.e., application software on a PDA—required by this means-plus-function limitation.</p> <p>But, Pepe discloses this structure. Specifically, Pepe discloses application software that is resident on the PDA/cell phone. <i>See</i> Pepe at 5:17-20, 34:9-36:51, Figs. 28-45. And, as explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe's PDA/cell phone with Hammond's forced-response message system.</p>
<p>[means for periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced message alert; and]</p>	<p>Hammond discloses the claimed function, and Pepe discloses the claimed structure. In particular, Hammond's "system tracks whether each message has been delivered and reviewed by to [sic] each recipient, and uses the message information to resend the messages whose</p>

	<p>delivery or review is not confirmed.” Hammond at 2:47-50; <i>see also id.</i> at Abstract, 2:1-8, 4:21-28, 5:6-20, 6:66-7:63, 10:48-63, Figs. 2, 3A-3B, 4, 5A-5B. Despite disclosing this function, Hammond does not disclose the claimed structure—i.e., application software on a PDA—required by this means-plus-function limitation.</p> <p>But, Pepe discloses this structure. Specifically, Pepe discloses application software that is resident on the PDA/cell phone. <i>See</i> Pepe at 5:17-20, 34:9-36:51, Figs. 28-45. And, as explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe’s PDA/cell phone with Hammond’s forced-response message system.</p>
<p>[means for receiving and displaying a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert and details the response from each recipient PDA/cell phone that responded.]</p>	<p>Hammond discloses the claimed function, and Pepe discloses the claimed structure. In particular, Hammond discloses a “Message Receipt Tracker component [that] attempts to identify when sent messages have been delivered to recipients and when sent messages have been reviewed by recipients.” Hammond at 5:17-20; <i>see also id.</i>, 5:20-6:55. Hammond’s Figure 2 shows a Message Tracking Table that includes detailed information about electronic messages that have been read by recipients. <i>See id.</i> at 6:56-8:45. And, Hammond discloses a Message Receipt Tracker routine, <i>id.</i> at Fig. 4, 10:5-47, and a Message Tracking Table Processor routine, <i>id.</i> at Figs. 5A, 5B, 10:48-11:48. Despite disclosing these functions, Hammond does not expressly disclose the claimed structure—i.e., application software on a PDA—required by this means-plus-function limitation.</p> <p>But, Pepe discloses this structure. Specifically, Pepe discloses application software that is resident on the PDA/cell phone. <i>See</i> Pepe at 5:17-20, 34:9-36:51, Figs. 28-45. And, as explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe’s PDA/cell phone with Hammond’s force response message system.</p>



<p>. . . wherein the forced message alert software application program on the recipient PDA/cell phone includes:</p>	<p>Hammond and Johnson each disclose a “recipient PDA/cell phone” as claimed. In particular, Hammond and Johnson each disclose systems for requiring a response to an electronic message. <i>See</i> Hammond at Abstract, 1:66-2:50, 3:31-4:28, 6:3-19, 9:12-15; Johnson at Abstract, 1:58-61, 3:64-4:2, 4:28-39, 5:1-6:65, 7:46-62, Fig. 6. Yet neither Hammond nor Johnson discloses a software-application program that is loaded on each PDA/cell phone and that includes a list of possible responses.</p> <p>Pepe supplies this missing disclosure. Pepe discloses “forced message alert software application program on the recipient PDA/cell phone” as claimed. For example, Pepe discloses “application software residing in the PDA” that is described in Pepe by “the screens displayed on a PCI subscriber’s PDA.” Pepe at 34:10-15; <i>see also id.</i> at 5:17-20 (“The application residing in the PDA is described in FIGS. 28-45, which illustrate exemplary screens displayed to a PCI subscriber using a wireless PDA”), 34:9-36:51, Figs. 28-45. Specifically, Pepe’s Figures 42 and 45 are exemplary screens that may appear when a user wants to edit a message to be sent to another PDA/cell phone. Each of these screens includes a list of possible responses (i.e., box 710 in Figure 42 and box 734 in Figure 45) that can be selected by the user to send in response to a received message. <i>See id.</i> at 36:16-20, 36:38-51.</p> <p>As explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe’s PDA/cell phone with the forced response message systems of Hammond and Johnson.</p>
<p>means for transmitting the acknowledgment of receipt to said sender PDA/cell phone immediately upon receiving a forced message alert from the sender PDA/cell phone;</p>	<p>Hammond and Johnson disclose the claimed function, and Pepe discloses the claimed structure. Hammond and Johnson each disclose “transmitting the acknowledgment of receipt to said sender PDA/cell phone immediately upon receiving a forced message alert from the sender PDA/cell phone” as claimed. For example, Hammond and Johnson disclose that a transmitted message requires the recipient device to transmit an automatic</p>

	<p>acknowledgement as soon as the message is received by the recipient device. See Hammond at 1:46-54, 5:17-44, 11:55-12:6; Johnson at 1:58-61, 2:6-15, 3:64-4:1. Pepe discloses the claimed structure required by this means-plus-function limitation. For example, Pepe discloses application software that is resident on the PDA/cell phone. See Pepe, 5:17-20, 34:9-36:51, Figs. 28-45.</p> <p>As explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe's PDA/cell phone with the forced-response message systems of Hammond and Johnson.</p>
<p>means for controlling of the recipient PDA/cell phone upon transmitting said automatic acknowledgment and causing, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PDA/cell phone or causes, in cases where the forced message alert is a voice message, the voice message being periodically repeated by the speakers of the recipient PDA/cell phone while said response list is shown on the display;</p>	<p>Pepe discloses the structure and Hammond and Johnson disclose the claimed function of this limitation. First, Johnson discloses "controlling of the recipient PDA/cell phone upon transmitting said automatic acknowledgment" as claimed. For example, Johnson's electronic mail object takes control of a device and response must be provided by a recipient in order to clear a received message from recipient's display. See Johnson at 4:27-31 ("[T]he sender of the electronic mail object may mark or associate an attribute with the electronic mail object such that it cannot be exited out of until the appropriate reply has been made."); see also <i>id.</i> at 4:18-42.</p> <p>Second, Hammond discloses "causing, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PDA/cell phone or causes, in cases where the forced message alert is a voice message, the voice message being periodically repeated by the speakers of the recipient PDA/cell phone while said response list is shown on the display" as claimed. For example, Hammond explains that "electronic messages" can include email, text, and voice messages. Hammond at 1:13-16, 1:21-26. Hammond's "system tracks whether each message has been delivered and reviewed by to [sic] each recipient, and uses the message information to resend the messages whose delivery or review is not confirmed." <i>Id.</i> at 2:47-</p>

	<p>50; <i>see also id.</i> at Abstract, 2:1-8, 4:21-28, 5:6-20, 6:66-7:63, 10:48-63, Figs. 2, 3A-3B, 4, 5A-5B.</p> <p>Third, Pepe discloses the claimed structure required by this means-plus-function limitation. For example, Pepe discloses the “application software residing in the PDA” that is described in Pepe by “the screens displayed on a PCI subscriber’s PDA.” Pepe at 34:10-15; <i>see also id.</i> at 5:17-20 (“The application residing in the PDA is described in FIGS. 28-45, which illustrate exemplary screens displayed to a PCI subscriber using a wireless PDA.”), 34:9-36:51, Figs. 28-45. Specifically, Pepe’s Figures 42 and 45 are exemplary screens that may appear when a user wants to edit a message to be sent to another PDA/cell phone. Each of these screens includes a list of possible responses (i.e., box 710 in Figure 42 and box 734 in Figure 45) that can be selected by the user to send in response to a received message. <i>See id.</i> at 36:16-20, 36:38-51.</p> <p>As explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe’s PDA/cell phone with Hammond and Johnson’s forced-response message system.</p>
<p>means for allowing a manual response to be manually selected from the response list or manually recorded and transmitting said manual response to the sender PDA/cell phone; and</p>	<p>Hammond discloses the claimed function, and Pepe discloses the claimed structure. Hammond discloses “allowing a manual response to be manually selected from the response list or manually recorded and transmitting said manual response to the sender PDA/cell phone” as claimed. In particular, Hammond discloses a “Message Receipt Tracker component [that] attempts to identify when sent messages have been delivered to recipients and when sent messages have been reviewed by recipients.” Hammond at 5:17-20; <i>see also id.</i> at 5:20-6:55. Hammond’s Figure 2 shows a Message Tracking Table that includes detailed information about electronic messages that have been read by recipients. <i>See id.</i> at 6:56-8:45. And, Hammond discloses a Message Receipt Tracker routine, <i>id.</i> at FIG. 4, 10:5-47, and a Message Tracking Table Processor routine, <i>id.</i> at Figs. 5A, 5B, 10:48-11:48. Thus, Hammond teaches or</p>

	<p>suggests “allowing a manual response to be manually selected from the response list or manually recorded and transmitting said manual response” as claimed. Despite disclosing these functions, Hammond does not expressly disclose the claimed structure—i.e., application software on a PDA—required by this means-plus-function limitation.</p> <p>But Pepe discloses the required structure of this means-plus-function limitation. Specifically, Pepe discloses application software that is resident on the PDA/cell phone. <i>See</i> Pepe at 5:17-20, 34:9-36:51, Figs. 28-45. And, as explained above, a person of ordinary skill in the art would have been motivated to combine Pepe’s PD A/cell phone with Hammond’s forced-response message system.</p>
<p>means for clearing the text message and a response list from the display of the recipient PDA/cell phone or stopping the repeating voice message and clearing the response list from the display of the recipient PDA/cell phone once the manual response is transmitted.</p>	<p>As set forth above, Pepe provides the structure and Johnson discloses the function of this limitation. Johnson at 4:18-42; Pepe at 5:17-20, 34:9-36:51, Figs. 28-45. Johnson discloses “clearing the text message and a response list from the display of the recipient PDA/cell phone or stopping the repeating voice message and clearing the response list from the display of the recipient PDA/cell phone once the manual response is transmitted” as claimed. In particular, Johnson discloses that “the sender of the electronic mail object may mark or associate an attribute with the electronic mail object such that it cannot be exited out of until the appropriate reply has been made” Johnson at 4:27-31; <i>see also id.</i> at 4:18-24, 4:33-42.</p> <p>And, Pepe discloses the structure required by this means-plus-function limitation. For example, Pepe discloses application software that is resident on the PDA/cell phone, Pepe at 5:17-20, 34:9-36:51, Figs. 28-45, and a list of possible responses that can be selected by a user to send in response to a received message, <i>id.</i> at 36:16-20, 36:38-51, Figs. 42, 45. As explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe’s PDA/cell phone with Johnson’s forced-response system.</p>

<p>10. A method of receiving, acknowledging and responding to a forced message alert from a sender PDA/cell phone to a recipient PDA/cell phone, wherein the receipt, acknowledgment, and response to said forced message alert is forced by a forced message alert software application program, said method comprising the steps of:</p>	<p>Hammond and Johnson disclose “receiving, acknowledging and responding to a forced message alert from a sender PDA/cell phone to a recipient PDA/cell phone, wherein the receipt, acknowledgment, and response to said forced message alert is forced” as claimed. For example, Hammond and Johnson each disclose communication systems for transmitting, receiving, and responding to electronic messages. See Hammond at Abstract, 2:11-18; Johnson at Abstract, 3:4-15, Fig. 1. And, Hammond’s and Johnson’s systems include receipt, acknowledgment” of electronic messages, as claimed. See Hammond at 3:1-30, 1:46-54; 5:17-61; Johnson at 1:58-61, 3:64-4:2.</p> <p>Hammond and Johnson each disclose systems for requiring a response to an electronic message. See Hammond at Abstract, 1:66-2:50, 3:31-4:28, 6:3-19, 9:12-15; Johnson at Abstract, 1:58-61, 3:64-4:2, 4:28-39, 5:1-6:65, 7:46-62, Fig. 6. Yet, neither Hammond nor Johnson discloses a software-application program that is loaded on each PDA/cell phone and that includes a list of possible responses.</p> <p>Pepe supplies this missing disclosure. First, Pepe discloses “receiving, acknowledging and responding to a forced message alert from a sender PDA/cell phone to a recipient PDA/cell phone,” as claimed. For example, Pepe discloses communication systems for transmitting, receiving, and responding to electronic messages. See Pepe at Abstract, 3:45-57, 5:28-14:21, Figs. 1-6. And, Pepe expressly discloses a sender PDA/cell phone and at least one recipient PDA/cell phone for each electronic message. Pepe explains that a first PDA/cell phone can send a message to a second PDA/cell phone. See <i>id.</i> at 33:5-52, Figs. 25-26; see also <i>id.</i> at Figs. 1-6 (showing PDAs in a network), 9:1-6 (explaining that a plurality of PDAs may be connected to a wireless network and messages may be sent to and from those PDAs.</p> <p>Second, Pepe discloses “wherein the receipt, acknowledgment, and response to said forced</p>
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	<p>message alert is ... by a forced message alert software application program” as claimed. For example, Pepe discloses “application software residing in the PDA” that is described in Pepe by “the screens displayed on a PCI subscriber’s PDA.” Pepe at 34:10-15; <i>see also id.</i> at 5:17-20 (“The application residing in the PDA is described in FIGS. 28-45, which illustrate exemplary screens displayed to a PCI subscriber using a wireless PDA.”), 34:9-36:51, Figs. 28-45. Specifically, Pepe’s Figures 42 and 45 are exemplary screens that may appear when a user wants to edit a message to be sent to another PDA/cell phone. Each of these screens includes a list of possible responses (i.e., box 710 in Figure 42 and box 734 in Figure 45) that can be selected by the user to send in response to a received message. <i>See id.</i> at 36:16-20, 36:38-51.</p> <p>As explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe’s PDA/cell phone with the forced-response message systems of Hammond and Johnson.</p>
<p>receiving an electronically transmitted electronic message;</p> <p>identifying said electronic message as a forced message alert, wherein said forced message alert comprises of a voice or text message and a forced message alert application software packet, which triggers the activation of the forced message alert software application program within the recipient PDA/cell phone;</p>	<p>The combination of Hammond, Johnson, and Pepe disclose this limitation. Hammond and Johnson disclose “receiving an electronically transmitted electronic message; identifying said electronic message as a forced message alert, wherein said forced message alert comprises of a voice or text message and a forced message alert application software packet, which triggers the activation of the . . . application program within the recipient PDA/cell phone” as claimed. In particular, Hammond and Johnson each alone discloses the transmission of forced message alerts to recipient computers. <i>See</i> Hammond at Abstract, 1:66-2:50, 3:1-4:28, 5:17-61, 6:3-19; Johnson at 1:58-61, 2:3-35, 3:64-4:42, 6:60-65. But, Hammond and Johnson do not explicitly disclose application software on a PDA/cell phone as required.</p> <p>Pepe, however, discloses “forced message alert software application program within the recipient PDA/cell phone” as claimed. For example, Pepe discloses “application software residing in the</p>

	<p>PDA.” See Pepe at 5:17-20, 34:9-36:51, Figs. 28-45. As explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe’s PDA/cell phone with the forced-response message systems of Hammond and Johnson.</p>
<p>transmitting an automatic acknowledgment of receipt to the sender PDA/cell phone, which triggers the forced message alert software application program to take control of the recipient PDA/cell phone and show the content of the text message and a required response list on the display recipient PDA/cell phone or to repeat audibly the content of the voice message on the speakers of the recipient PDA/cell phone and show the required response list on the display recipient PDA/cell phone; and</p>	<p>First, Hammond and Johnson disclose “transmitting an automatic acknowledgment of receipt to the sender PDA/cell phone” as claimed. Hammond and Johnson each discloses that the transmitted message requires the recipient device to transmit an automatic acknowledgement as soon as the message is received by the recipient device. See Hammond at 1:46-54, 5:17-44, 11:55-12:6; Johnson at 1:58-61, 2:6-15, 3:64-4:1.</p> <p>Second, Johnson discloses “which triggers the . . . application program to take control of the recipient PDA/cell phone” as claimed. For example, Johnson states that “[t]he recipient of the electronic mail object is prompted for a specific response in response to the recipient opening an electronic mail object and is prohibited from performing a selected action until the specific response has been entered by the recipient.” Johnson at Abstract. Thus, Johnson demonstrates that the email application takes control of a recipient device until the recipient provides a specific response.</p> <p>Third, Hammond and Johnson also disclose “show the content of the text message and a required response . . . on the display recipient PDA/cell phone or to repeat audibly the content of the voice message on the speakers of the recipient PDA/cell phone and show the required response . . . on the display recipient PDA/cell phone ” as claimed. For example, Hammond and Johnson’s electronic messages include text and voice messages. Hammond at 1:13-16; Johnson at 4:1-2; see also Johnson at 4:3-18. Johnson discloses a “mechanism for forcing a recipient to reply to an electronic mail object . . . the mechanism may prevent the deletion and archival of the note or image until an appropriate reply is made.” Johnson at 4:4-28. Thus, the</p>

	<p>content of the text or voice message remains on the display or is repeated until the recipient provides the required response. And, Hammond's "system tracks whether each message has been delivered and reviewed by to [sic] each recipient, and uses the message information to resend the messages whose delivery or review is not confirmed." Hammond at 2:47-50; <i>see also id.</i> at Abstract, 2:1-8, 4:21-28, 5:6:19, 6:66-7:63, 10:48-63, Figs. 2, 3 A, 3B, 4, 5A, 5B.</p> <p>But, Hammond and Johnson do not explicitly disclose application software on a PDA/cell phone, nor do these references explicitly disclose a list of possible required responses.</p> <p>Pepe, however, supplies both limitations. Pepe discloses "the forced message alert software application program . . . of the recipient PDA/cell phone" and the "required response list" as claimed. As set forth above, Pepe discloses "application software residing in the PDA." <i>See</i> Pepe at 5:17-20, 34:9-36:51, Figs. 28-45. And, as set forth above, Pepe discloses a list of possible responses that can be selected by a user to send in response to a received message. <i>See id.</i> at 36:16-20, 36:38-51, Figs. 42, 45.</p> <p>As explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe's PDA/cell phone with the forced-response message systems of Hammond and Johnson.</p>
<p>transmitting a selected required response from the response list in order to allow the message required response list to be cleared from the recipient's cell phone display, whether said selected response is a chosen option from the response list, causing the forced message alert software to release control of the recipient PDA/cell phone and stop showing the content of the text message and a response list on the display recipient PDA/cell phone and or stop repeating the content of the voice message on the speakers of the recipient PDA/cell phone;</p>	<p>As set forth above, the combination of Pepe and Johnson discloses the features of this limitation. Johnson discloses "transmitting a selected required response . . . in order to allow the message . . . to be cleared from the recipient's cell phone display, whether said selected response is a chosen option . . . causing the . . . software to release control of the recipient PDA/cell phone and stop showing the content of the text message and a response . . . on the display recipient PDA/cell phone and or stop repeating the content of the voice message on the speakers of the recipient</p>



	<p>PDA/cell phone” as claimed. As Johnson takes control until an appropriate reply is made as described above, Johnson also releases control once the reply is made. Johnson at 4:11-42.</p> <p>Pepe discloses the “response list” as claimed as well as the “forced message alert software . . . of the recipient PDA/cell phone” as claimed. For example, Pepe discloses application software that is resident on the PDA/cell phone, Pepe at 5:17-20, 34:9-36:51, Figs. 28-45, and a list of possible responses that can be selected by a user to send in response to a received message, <i>id.</i> at 36:16-20, 36:38-51, Figs. 42, 45. As explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe’s PDA/cell phone with Johnson’s forced-response system.</p>
<p>displaying the response received from the PDA[/] cell phone that transmitted the response on the sender of the forced alert PDA/cell phone; and</p>	<p>Hammond and Pepe disclose the claimed limitation. Hammond discloses “displaying the response received from the PDA[/]cell phone that transmitted the response on the sender of the forced alert PD A/cell phone” as claimed. In particular, Hammond discloses a “Message Receipt Tracker component [that] attempts to identify when sent messages have been delivered to recipients and when sent messages have been reviewed by recipients.” Hammond at 5:17-20; <i>see also id.</i> at 5:20-6:55. Hammond’s Figure 2 shows a Message Tracking Table that includes detailed information about electronic messages that have been read by recipients. <i>See id.</i> at 6:56-8:45. And, Hammond discloses a Message Receipt Tracker routine, <i>id.</i> at Fig. 4, 10:5-47, and a Message Tracking Table Processor routine, <i>id.</i> at Figs. 5A-5B, 10:48-11:48.</p> <p>Hammond does not expressly disclose the application software on a PDA. But, Pepe discloses this structure. Specifically, Pepe discloses application software that is resident on the PDA/cell phone. <i>See</i> Pepe at 5:17-20, 34:9-36:51, Figs. 28-45. And, as explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe’s PDA/cell phone with Hammond’s forced-response message system.</p>

<p>providing a list of the recipient PDA/cell phones have automatically acknowledged receipt of a forced alert message and their response to the forced alert message.</p>	<p>Hammond discloses “providing a list of the recipient PDA/cell phones [that] have automatically acknowledged receipt of a forced alert message and their response to the forced alert message” as claimed. In particular, Hammond tracks which recipients have automatically acknowledged a forced-message alert. <i>See</i> Hammond at 2:11-15 (disclosing that Hammond’s system tracks “message delivery information and message review information”); <i>see also id.</i> at 5:17-8:45 (disclosing additional details about the Message Receipt Tracker component and Message Tracking Table Processor component), Fig. 2 (illustrating an example Message Tracking Table). Hammond also tracks which recipients have not automatically acknowledged the forced message alert. <i>See id.</i> at 2:11-15 (disclosing that Hammond’s system “specifies actions to take when a message is not delivered or not reviewed within a specified period of time”); <i>see also id.</i> at 5:17-8:45, (disclosing additional details about the Message Receipt Tracker component), Fig. 2 (illustrating an example Message Tracking Table). Despite disclosing these claimed functions, Hammond does not disclose the application software on a PDA.</p> <p>But, Pepe discloses this structure. Specifically, Pepe discloses application software that is resident on the PDA/cell phone. <i>See</i> Pepe at 5:17-20, 34:9-36:51, Figs. 28-45. And, as explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe’s PDA/cell phone with Hammond’s forced-response message system.</p>
<p>11. The method as in claim 10, wherein each PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it.</p>	<p>Hammond, Johnson, and Pepe each disclose “a predetermined network of participants,” as claimed. <i>See</i> Hammond at Abstract, 2:11-18; Johnson at Abstract, 2:16-31, 3:4-15, Fig. 1; Pepe at Abstract, 3:45-58, 5:28-14:21, Figs. 1-6. But, Hammond’s and Johnson’s networks include “computers.” <i>See, e.g.,</i> Hammond at 4:29-47, Fig. 1 (describing computer systems 100, 150, 160, 170, and 180); Johnson at 3:4-4:2, Fig. 1</p>

	<p>(describing computers 12 and 30 in LAN 10 and 32).</p> <p>To the extent that Hammond and Johnson's disclosure of "computers" is found to not encompass a PDA/cell phone, Pepe supplies this missing disclosure. Pepe discloses "each PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it" as claimed. For example, Pepe's Figures 1-6 show a plurality of PDA/cell phones interacting in a network. <i>See also</i> Pepe at 5:28-14:21. Each PDA includes a CPU, an input-output device, a display, and a memory. <i>See id.</i> at 16:50-61, Fig. 12.</p> <p>Pepe discloses application software that is resident on the PDA/cell phone. <i>See</i> Pepe at 5:17-20, 34:9-36:51, Figs. 28-45. And, as explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe's PDA/cell phone with Hammond and Johnson's forced-response message system.</p>
<p>12. The method as in claim 10, wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program.</p>	<p>Pepe discloses "said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program" as claimed. For example, Pepe discloses application software residing in the PDA. Pepe at 5:17-20, 34:9-36:51, Figs. 28-45. In Figures 42 and 45, Pepe shows a list of possible responses (i.e., box 710 in Figure 42 and box 734 in Figure 45) that can be selected by the user to send in response to a received message. <i>See id.</i> at 36:16-20, 36:38-51. A person of ordinary skill in the art at the time of invention would have understood Pepe's list of possible responses to teach or suggest the claimed default response list.</p>
<p>13. The method as in claim 10, wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PDA/cell phone.</p>	<p>Pepe discloses "said forced message alert application software packet contains a response list, wherein said response list is a custom response list" as claimed. Specifically, Pepe discloses application software residing in the PDA. Pepe at 5:17-20, 34:9-36:51, Figs. 28-45.</p>

	<p>Pepe's Figures 42 and 45 show lists of possible responses. And, Pepe says that "[t]he user may compose a unique message in box 708 or edit one already on a list shown in box 710." <i>Id.</i> at 36:16-20.</p> <p>Johnson discloses "said response . . . is a custom response list that is created at the time the specific forced message alert is created on the sender PDA/cell phone" as claimed. For example, Johnson discloses that the sender of a forced-response message may set certain "persistent reply attributes" that "govern user interaction for forcing a reply containing data from the recipient of the electronic mail object." Johnson at 4:33-39; <i>see also id.</i> at 5:43-6:65. A person of ordinary skill in the art at the time of invention would have understood that Johnson's persistent reply attributes are compatible with Pepe's teachings, and could have been used to specify a custom response list to be displayed on a recipient's PDA/cell phone, as taught by Pepe.</p> <p>And, as explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe's PDA/cell phone with Johnson's forced-response message system.</p>
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**Patentable Subject Matter**

Proposed new claims 14 and 15 are patentable.

The prior art cited in the Request fails to teach or fairly suggest means for obtaining location and status data associated with the recipient PDA/cell phone (i.e., the algorithm described in the '970 patent at col. 3, lines 52-67) and means for presenting a recipient symbol on the geographical map (displayed on the means for displaying . . . , i.e., on the LCD display of the sender PDA/cell phone, described in the '970 patent at col. 4, lines 12-16) corresponding to a correct geographical location of the recipient PDA/cell phone (i.e., the algorithm described in the '970 patent at col. 5, lines 28-44), in the context of parent claim 2.

The prior art cited in the Request fails to teach or fairly suggest obtaining location and status data associated with the recipient PDA/cellphone and presenting a recipient symbol on the geographical map (displayed on the sender PDA/cell phone) corresponding to a correct geographical location of the recipient PDA/cellphone based on at least the location data, in the context of parent claim 10.

Conclusion

**THIS ACTION IS MADE FINAL.**

A shortened statutory period for response to this action is set to expire two months from the mailing date of this action.

**Extensions of time under 37 CFR 1.136(a) do not apply in reexamination proceedings.** The provisions of 37 CFR 1.136 apply only to “an applicant” and not to parties in a reexamination proceeding. Further, in 35 U.S.C. 305 and in 37 CFR 1.550(a), it is required that reexamination proceedings “will be conducted with special dispatch within the Office.”

**Extensions of time in reexamination proceedings are provided for in 37 CFR 1.550(c).** A request for extension of time must specify the requested period of extension and it must be accompanied by the petition fee set forth in 37 CFR 1.17(g). Any request for an extension in a third party requested ex parte reexamination must be filed on or before the day on which action by the patent owner is due, and the mere filing of a request will not effect any extension of time. A request for an extension of time in a third party requested ex parte reexamination will be granted only for sufficient cause, and for a reasonable time specified. Any request for extension in a patent owner requested ex parte reexamination (including reexamination ordered under 35 U.S.C. 257) for up to two months from the time period set in the Office action must be filed no later than two months from the expiration of the time period set in the Office action. A request for an extension in a patent owner requested ex parte reexamination for more than two months from the time period set in the Office action must be filed on or before the day on which action by the patent owner is due, and the mere filing of a request for an extension for more than two months will not effect the extension. The time for taking action in a patent owner requested ex parte reexamination will not be extended for more than two months from the time period set in the Office action in the absence of sufficient cause or for more than a reasonable time.

The filing of a timely first response to this final rejection will be construed as including a request to extend the shortened statutory period for an additional two months. In no event, however, will the statutory period for response expire later than SIX MONTHS from the mailing date of the final action. See MPEP § 2265. **All** correspondence relating to this *ex parte* reexamination proceeding should be directed:

By Mail to:           Mail Stop *Ex Parte* Reexam  
                          Central Reexamination Unit  
                          Commissioner for Patents  
                          United States Patent & Trademark Office  
                          P.O. Box 1450  
                          Alexandria, VA 22313-1450

By FAX to:           (571) 273-9900  
                          Central Reexamination Unit

Any inquiry concerning this communication should be directed to Central Reexamination Unit at telephone number (571) 272-7705.

/Eric B. Kiss/  
Primary Examiner, Art Unit 3992

Conferees:

/NICK CORSARO/  
Primary Examiner, Art Unit 3992

/ANDREW J. FISCHER/  
Supervisory Patent Reexamination Specialist, Art Unit 3992

<b>Office Action in Ex Parte Reexamination</b>	<b>Control No.</b> 90/014,507	<b>Patent Under Reexamination</b> 8213970	
	<b>Examiner</b> ERIC B KISS	<b>Art Unit</b> 3992	<b>AIA (FITF) Status</b> No

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

- a.  Responsive to the communication(s) filed on 03 June 2021.  
 A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on \_\_\_\_\_.
- b.  This action is made FINAL.
- c.  A statement under 37 CFR 1.530 has not been received from the patent owner.

A shortened statutory period for response to this action is set to expire 2 month(s) from the mailing date of this letter. Failure to respond within the period for response will result in termination of the proceeding and issuance of an *ex parte* reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c)**. If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.

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

1.  Notice of References Cited by Examiner, PTO-892.                      3.  Interview Summary, PTO-474.  
2.  Information Disclosure Statement, PTO/SB/08.                      4.  \_\_\_\_\_.

**Part II SUMMARY OF ACTION**

- 1a.  Claims 2 and 10-15 are subject to reexamination.
- 1b.  Claims 1 and 3-9 are not subject to reexamination.
2.  Claims \_\_\_\_\_ have been canceled in the present reexamination proceeding.
3.  Claims 14-15 are patentable and/or confirmed.
4.  Claims 2 and 10-13 are rejected.
5.  Claims \_\_\_\_\_ are objected to.
6.  The drawings, filed on \_\_\_\_\_ are acceptable.
7.  The proposed drawing correction, filed on \_\_\_\_\_ has been (7a)  approved (7b)  disapproved.
8.  Acknowledgment is made of the priority claim under 35 U.S.C. 119(a)-(d) or (f).  
a)  All b)  Some\* c)  None of the certified copies have  
1  been received.  
2  not been received.  
3  been filed in Application No. \_\_\_\_\_.  
4  been filed in reexamination Control No. \_\_\_\_\_.  
5  been received by the International Bureau in PCT application No. \_\_\_\_\_.
- \* See the attached detailed Office action for a list of the certified copies not received.
9.  Since the proceeding appears to be in condition for issuance of an *ex parte* reexamination certificate 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.
10.  Other: \_\_\_\_\_

cc: Requester (if third party requester)





## **CLAIMS**

A listing of claims follows:

1. A communication system for transmitting, receiving, confirming receipt, and responding to an electronic message, comprising: a predetermined network of participants, wherein each participant has a similarly equipped PDA/cell phone that includes a CPU and a touch screen display a CPU and memory; a data transmission means that facilitates the transmission of electronic files between said PDA/cell phones in different locations; a sender PDA/cell phone and at least one recipient PDA/cell phone for each electronic message; a forced message alert software application program including a list of required possible responses to be selected by a participant recipient of a forced message response loaded on each participating PDA/cell phone; means for attaching a forced message alert software packet to a voice or text message creating a forced message alert that is transmitted by said sender PDA/cell phone to the recipient PDA/cell phone, said forced message alert software packet containing a list of possible required responses and requiring the forced message alert software on said recipient PDA/cell phone to transmit an automatic acknowledgment to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone; means for requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display; means for receiving and displaying a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have not automatically acknowledged the forced message alert; means for periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced message alert; and means for receiving and displaying a listing of

which recipient PDA/cell phones have transmitted a manual response to said forced message alert and details the response from each recipient PDA/cell phone that responded.

2. The system as in claim 1, wherein the forced message alert software application program on the recipient PDA/cell phone includes: means for transmitting the acknowledgment of receipt to said sender PDA/cell phone immediately upon receiving a forced message alert from the sender PDA/cell phone; means for controlling of the recipient PDA/cell phone upon transmitting said automatic acknowledgment and causing, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PDA/cell phone or causes, in cases where the forced message alert is a voice message, the voice message being periodically repeated by the speakers of the recipient PDA/cell phone while said response list is shown on the display; means for allowing a manual response to be manually selected from the response list or manually recorded and transmitting said manual response to the sender PDA/cell phone; and means for clearing the text message and a response list from the display of the recipient PDA/cell phone or stopping the repeating voice message and clearing the response list from the display of the recipient PDA/cell phone once the manual response is transmitted.

3. The system as in claim 1, wherein said data transmission means is TCP/IP or another communications protocol.

4. The system as in claim 1, wherein the response list that is transmitted within the forced message alert software packet is a default response list that is embedded in the forced message alert software application program.

5. The system as in claim 1, wherein the response list that is transmitted within the forced message alert software packet is a custom response list that is created at the time the specific forced message alert is created on the sender PDA/cell phone.

6. A method of sending a forced message alert to one or more recipient PDA/cell phones within a predetermined communication network, wherein the receipt and response to said forced message alert by each intended recipient PDA/cell phone is tracked, said method comprising the steps of: accessing a forced message alert software application program on a sender PDA/cell phone; creating the forced message alert on said sender PDA/cell phone by attaching a voice or text message to a forced message alert application software packet to said voice or text message; designating one or more recipient PDA/cell phones in the communication network; electronically transmitting the forced message alert to said recipient PDA/cell phones; receiving automatic acknowledgements from the recipient PDA/cell phones that received the message and displaying a listing of which recipient PDA/cell phones have acknowledged receipt of the forced message alert and which recipient PDA/cell phones have not acknowledged receipt of the forced message alert; periodically resending the forced message alert to the recipient PDA/cell phones that have not acknowledged receipt; receiving responses to the forced message alert from the recipient PDA/cell phones and displaying the response from each recipient PDA/cell phone; and providing a manual response list on the display of the recipient PDA/cell phone that can only be cleared by the recipient providing a required response from the list; clearing the recipient's display screen or causing the repeating voice alert to cease upon recipient selecting a response from the response list required that can only be cleared by manually selecting and transmitting a response to the manual response list.

7. The method as in claim 6, wherein each PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it.
8. The method as in claim 6, wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program.
9. The method as in claim 6, wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PDA/cell phone.
10. A method of receiving, acknowledging and responding to a forced message alert from a sender PDA/cell phone to a recipient PDA/cell phone, wherein the receipt, acknowledgment, and response to said forced message alert is forced by a forced message alert software application program, said method comprising the steps of: receiving an electronically transmitted electronic message; identifying said electronic message as a forced message alert, wherein said forced message alert comprises of a voice or text message and a forced message alert application software packet, which triggers the activation of the forced message alert software application program within the recipient PDA/cell phone; transmitting an automatic acknowledgment of receipt to the sender PDA/cell phone, which triggers the forced message alert software application program to take control of the recipient PDA/cell phone and show the content of the text message and a required response list on the display recipient PDA/cell phone or to repeat audibly the content of the voice message on the speakers of the recipient PDA/cell phone and show the required response list on the display recipient PDA/cell phone; and transmitting a

selected required response from the response list in order to allow the message required response list to be cleared from the recipient's cell phone display, whether said selected response is a chosen option from the response list, causing the forced message alert software to release control of the recipient PDA/cell phone and stop showing the content of the text message and a response list on the display recipient PDA/cell phone and or stop repeating the content of the voice message on the speakers of the recipient PDA/cell phone; displaying the response received from the PDA cell phone that transmitted the response on the sender of the forced alert PDA/cell phone; and providing a list of the recipient PDA/cell phones have automatically acknowledged receipt of a forced alert message and their response to the forced alert message.

11. The method as in claim 10, wherein each PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it.

12. The method as in claim 10, wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program.

13. The method as in claim 10, wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PDA/cell phone.

14. (New) The system as in claim 2, further comprising: means for displaying a geographical map with georeferenced entities on the display of the sender PDA/cell phone; means for obtaining location and status data associated with the recipient PDA/cell phone; and means for

presenting a recipient symbol on the geographical map corresponding to a correct geographical location of the recipient PDA/cell phone.

15. (New) The method as in claim 10, further comprising: displaying a geographical map with georeferenced entities on the display of the sender PDA/cellphone; obtaining location and status data associated with the recipient PDA/cellphone; and presenting a recipient symbol on the geographical map corresponding to a correct geographical location of the recipient PDA/cellphone based on at least the location data.

**REMARKS**

This paper is in response to the Office Action dated March 3, 2021. Claims 2 and 10-13 (the “Challenged Claims”) are subject to reexamination and stand rejected. Patent Owner respectfully traverses the rejection of Claims 2 and 10-13 for the reasons stated herein. No claims are amended or cancelled in this paper. Claims 14 and 15 are added. Therefore, Claims 2 and 10-13 are subject to reexamination and Claims 14-15 are subject to examination.

**Patent Owner’s Summary of Examiner Interview**

Patent Owner thanks the Examiners for the courtesy extended during the Examiner interview on May 17, 2021 between Examiners Erik B. Kiss, Nick Corsaro, and Andrew J. Fischer, and Patent Owner’s representatives, Jialin Zhong (Reg. No. 62,937), Vincent J. Rubino, III (Reg. No. 68,594), and Enrique W. Iturralde (Reg. No. 72,883).

During the interview, Patent Owner’s representative Vincent Rubino discussed the rejection of claims 2 and 10 over the Kubala and Hammond references, including (a) the means-plus function limitation “means for controlling...” of claim 2, and the (b) limitation for taking control and releasing control of claim 10. Patent Owner’s representative Jialin Zhong discussed new claims. Examiners requested an identification of the corresponding algorithm for the “means for controlling...” limitation of claim 2, and Examiners indicated that Patent Owner’s forthcoming response and expert declaration would be given further consideration. No agreement was reached during the interview.



**Rejection 1 (Kubala) under 35 U.S.C. § 103**

The Office Action states at page 3 that Claims 2 and 10-13 of U.S. Patent No. 8,213,970 (the “’970 Patent”) are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application 2006/0218232 (“Kubala”), U.S. Patent No. 6,854,007 (“Hammond”), U.S. Patent No. 5,325,310 (“Johnson”), and U.S. Patent No. 5,742,905 (“Pepe”). Patent Owner respectfully traverses this rejection for the following reasons. This response is supported by the Declaration of Dr. Loren Terveen, Ph.D. (“Terveen Decl.”).

As a preliminary matter, the below issues have not been considered or decided in any prior proceedings before the Patent Trial and Appeal Board (PTAB) or the U.S. Court of Appeals for the Federal Circuit (CAFC). This is because Claims 2 and 10 (and the specific limitations identified below) were not the subject of prior IPR challenges.

As an additional preliminary matter, the representative claim 2 of the ’970 patent do not cover email messages. In particular, the claimed forced message alerts are not email messages. For the purposes of clarity, and to the extent any parties have incorrectly interpreted the claim term forced message alerts to mean email messages, Patent Owner expressly disavows the claim scope for email messages. The Kubala reference concerns email messages and the Kubala embodiments relied upon in the Office Action describe only email messages. Kubala, as applied in the Office Action, is thus inapplicable to the inventions in Claims 2 and 10-13 of the ’970 patent. See Terveen Decl. at ¶¶ 14-15, 17-18.

The Office Action concerns two different types of claims. First, Claim 2 is subject to section 112 sixth paragraph because it comprises computer-implemented means-plus-function limitations. Such limitations require that patent specification specify one or more algorithms for performing the claimed function. Below, in response to Examiner’s request, the Patent Owner

identifies the corresponding algorithm for the “means for controlling” limitation of Claim 2.

Second, Claims 10-13 are not subject to section 112 sixth paragraph because they do not contain any means-plus-function limitations. Accordingly, Patent Owner is not required to identify any corresponding algorithms for Claims 10-13. See Terveen Decl. at ¶¶ 16.

Claim 2 recites “means for controlling of the recipient PDA/cell phone upon transmitting said automatic acknowledgment and causing, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PDA/cell phone or causes, in cases where the forced message alert is a voice message, the voice message being periodically repeated by the speakers of the recipient PDA/cell phone while said response list is shown on the display.” With respect to the claimed limitation “causing, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PDA/cell phone or causes, in cases where the forced message alert is a voice message, the voice message being periodically repeated by the speakers of the recipient PDA/cell phone while said response list is shown on the display,” the Office Action maps the forced message alert and text message to Kubala’s e-mail message 214 with a flag, but fails to identify any teaching in which the “means for controlling” is responsible for “causing, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PDA/cell phone.” This is not surprising because Kubala’s purported invention is an email application in which **a user must open emails**. See Terveen Decl. at ¶¶ 19-21. The Office Action focuses on Kubala’s purported teaching of a flag in an email corresponding to an indication that the recipient “must provide a reply message in response to the original message.” But Kubala’s flag does not control the recipient device so as to cause “the text message and a response list to be shown on the display” of the recipient device.” To the

contrary, Kubala requires user selection of a control to open and review emails. See Terveen Decl. at ¶¶ 19-21. There is no teaching or suggestion in Kubala of a communication system with a “means for controlling” which “cause[s] . . . the text message and a response list to be shown on the display of the recipient PDA/cell phone.” See Terveen Decl. at ¶¶ 19-21.

Instead, as described in the Office Action’s mapping, Kubala describes an email application 208 with certain enhancements for flagging email messages. Office Action at 11-12. The Office Action notes particular attention to Kubala’s disclosure that “the user must reply to the received e-mail message in some manner before the e-mail application will allow the user to perform some other action” and “the recipient can be prevented from closing a review of the received e-mail message, from deleting the received e-mail message, and from exiting the e-mail application until the recipient has responded to the received message.” Office Action at 11. But Kubala’s email application does not teach or suggest a “means for controlling” which is responsible for “causing . . . the text message and a response list to be shown on the display of the recipient PDA/cell phone.” The Office Action identifies flags corresponding to Kubala’s emails. But these flags do not teach or suggest any “causing . . . the text message and a response list to be shown on the display of the recipient PDA/cell phone.” This is because the flags do not require the email to be opened or displayed in any way. See Terveen Decl. at ¶ 22. Rather, as described in the Office Action, the recipient may be required to respond, “when the recipient first reviews the e-mail message.” Office Action at 12. Kubala requires user input to open the email message, which means that there is no communication system with a “means for controlling” which “cause[s] . . . the text message and a response list to be shown on the display of the recipient PDA/cell phone,” as required by Claim 2. See Terveen Decl. at ¶ 22. Kubala explicitly states that “a recipient opens an email message that contains a mandatory response flag” and

“selecting a control within an e-mail application to open an e-mail message.” Kubala at paragraph 0047. See Terveen Decl. at ¶ 22.

In comparison, Claim 2 of the '970 patent requires more: a communication system with a “means for controlling” which “cause[s] . . . the text message and a response list to be shown on the display of the recipient PDA/cell phone.” The claimed “means for controlling” function is clearly linked to the algorithm described in Fig. 4 of the '970 patent, which requires that “the forced voice alert software takes control of the recipient’s cell phone, integrated PDA/cell phone or PC and causes the text message to be displayed or the voice message to be periodically repeated and a list of responses to be shown on the display of the recipient cell phone, integrated PDA/cell phone or PC PDA/cell.” See Terveen Decl. at ¶ 23. This algorithm corresponding to the “means for controlling” function is further described in the specification at 8:37-44 (“the forced voice alert software application program effectively takes control of the recipient PC or PDA/cell phone. If a text message was received, the forced voice alert software application program causes the text message and the response list to be shown on the display of the recipient PC or PDA/cell phone until a manual response is selected from the response list.”). See Terveen Decl. at ¶ 23. Contrary to the disclosed algorithm in the '970 patent specification, Kubala’s email application does not take control to display the text message and response list. See Terveen Decl. at ¶ 23. Instead, as discussed above and as stated in the Office Action, the user of Kubala’s email application must open and view the email message (which also does not expressly contain a response list as claimed). See Terveen Decl. at ¶ 23.

As Dr. Terveen explains, a person of ordinary skill in the art would have understood that the “means for controlling” the claimed communication system of Claim 2 must cause the display of the text message and the response list. See Terveen Decl. at ¶ 24. Dr. Terveen

confirms that a user opening an email does not satisfy this claimed requirement and does not comport with the claim as a whole which requires a *forced* message alert rather than an email added to the inbox queue awaiting opening by a user like any other email. See Terveen Decl. at ¶ 24. The addition of a flag to the email for requiring a response does not teach taking control so as to cause the display of the text message and response list. This is especially true because Kubala explicitly teaches that a user must open the email. Kubala at paragraph 0047. In Kubala, the user retains control of displaying the email because the user must open the email. See Terveen Decl. at ¶ 24. A person of ordinary skill in the art would not have understood Kubala's teaching that a user alone retains control of opening an email to satisfy the "means for controlling" recited in Claim 2 because Kubala's email application does not take control to cause a text message and a response list to be shown on the display of the recipient device. See Terveen Decl. at ¶ 24.

Similarly, Claim 10 requires "transmitting an automatic acknowledgment of receipt to the sender PDA/cell phone, *which triggers the forced message alert software application program to take control of the recipient PDA/cell phone and show the content of the text message and a required response list on the display recipient PDA/cell phone or to repeat audibly the content of the voice message on the speakers of the recipient PDA/cell phone and show the required response list on the display recipient PDA/cell phone.*" As Dr. Terveen states, Claim 10 also requires that forced alert message alert software application program to take control of the recipient device and show the text message and response list on the display of the recipient device. See Terveen Decl. at ¶ 25. For the same reasons provided above in response to Claim 2, Kubala does not teach Claim 10. See Terveen Decl. at ¶ 25.

In addition, Claim 10 requires “transmitting a selected required response from the response list in order to allow the message required response list to be cleared from the recipient’s cell phone display, whether said selected response is a chosen option from the response list, ***causing the forced message alert software to release control of the recipient PDA/cell phone and stop showing the content of the text message and a response list on the display recipient PDA/cell phone*** and or stop repeating the content of the voice message on the speakers of the recipient PDA/cell phone.” As Dr. Terveen states, Kubala does not disclose the communication system causing the forced message alert software to release control of the recipient PDA/cell phone. See Terveen Decl. at ¶ 26. The Office Action does not map any teaching in Kubala to this portion of the limitation. Instead, the Office Action identifies a user “must reply to the received e-mail message in some manner before the e-mail application will allow the user to perform some other action.” Office Action at 19. The Office Action further contends that “it follows that Kubala’s e-mail application releases control of the PDA/cell phone to allow the user to perform some other action.” But the Office Action’s use of “it follows” demonstrates that Kubala does not teach causing the forced message alert software to release control of the device. See Terveen Decl. at ¶ 26. There is no citation to Kubala for this portion of the limitation and there is no teaching in Kubala to support that this limitation is met by Kubala. See Terveen Decl. at ¶ 26.

As Dr. Terveen states, Kubala does not teach a forced message alert software program that takes control or releases control of the PDA/cell phone. See Terveen Decl. at ¶ 27. Kubala at most concerns a mandatory response flag in an email to request a mandatory response. Kubala at paragraphs 0053-54. But Kubala does not take control in a manner that forces open a text message and a response list or release control in the manner required by Claim 10. See Terveen

Decl. at ¶¶ 27. As Dr. Terveen opines, to the extent the Office Action reads in any form of control into the reference, Kubala's recitation of "before the e-mail application will allow the user to perform some other action," does not teach or suggest *releasing control* as required by the claims. See Terveen Decl. at ¶¶ 27. Dr. Terveen opines that a person of ordinary skill in the art would not have understood the Kubala reference to teach or suggest any releasing control of the recipient device, as required by Claim 10. See Terveen Decl. at ¶¶ 27.

Finally, regarding Patent Owner's disavowal of email messages, Dr. Terveen opines that, to the extent the Kubala reference states that "email message comprise various types of electronic messages, *e.g.*, text messages, instant messages, fax messages, voicemail messages, video messages, audio messages, and other types of messages," the Kubala reference's disclosure is sufficiently enabled only as to email applications for email messages. Terveen Decl. at ¶¶ 17-18. Kubala describes how the mandatory response flag would be implemented in emails (*i.e.*, email message headers for delivery using, for example, SMTP or MIME formats) and expressly states that any header that is not recognized by an email application "should be ignored." Kubala at paragraphs 37-38. The law requires that, to render a claim obvious, the prior art must enable a skilled artisan to make and use the claimed invention. *Raytheon Techs. Corp. v. Gen. Elec. Co.*, 993 F.3d 1374, 1380 (Fed. Cir. 2021). In the absence of such other supporting evidence to enable a skilled artisan to make the claimed invention, a standalone section 103 reference must enable the portions of its disclosure being relied upon. *Id.* at 1381. Kubala does not describe how to carry out or make or use any mandatory response flag in any other types of applications or for any types of messages besides email messages. Terveen Decl. at ¶¶ 17-18. There is no other relevant disclosure in the asserted prior art for mandatory response flags, so Kubala itself must be self-enabling for mandatory response flags. Terveen Decl. at ¶¶

17-18. In this case, Kubala is only self-enabling as to email messages and Kubala provides no enabling disclosure regarding how to carry out mandatory response flags for any other types of messages that are not email messages in email formats. Terveen Decl. at ¶¶ 17-18. Dr. Terveen opines that a skilled artisan would understand that Kubala's disclosure is limited to email messages and that an email message (notwithstanding any messages that are part of, attached to, comprised within the email message) in an email format for an email application would be required to carry out Kubala's invention. Terveen Decl. at ¶¶ 17-18. Indeed, the embodiments identified in the Office Action are disclosures related only to email messages within email applications. Because the '970 patent is not directed to email messages, as email messages are expressly disavowed by Patent Owner herein, the Kubala reference does not teach or suggest the claimed inventions of the '970 patent. Terveen Decl. at ¶¶ 17-18.

Accordingly, Patent Owner respectfully requests a notice confirming the validity of Claims 2 and 10-13 of the '970 patent.

**Rejection 2 (Hammond) under 35 U.S.C. § 103**

The Office Action states, at page 23, that Claims 2 and 10-13 of U.S. Patent No. 8,213,970 (the "'970 Patent") are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,854,007 ("Hammond"), U.S. Patent No. 5,325,310 ("Johnson"), and U.S. Patent No. 5,742,905 ("Pepe"). Patent Owner respectfully traverses this rejection for the following reasons. This response is supported by the Declaration of Dr. Loren Terveen, Ph.D. ("Terveen Decl.").

Patent Owner submits that Claims 2 and 10-13 are valid for similar reasons as presented above and as applied to Hammond. Claim 2 recites "means for controlling of the recipient PDA/cell phone upon transmitting said automatic acknowledgment and causing, in cases where



the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PDA/cell phone or causes, in cases where the forced message alert is a voice message, the voice message being periodically repeated by the speakers of the recipient PDA/cell phone while said response list is shown on the display.” With respect to the claimed requirement “causing, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PDA/cell phone or causes, in cases where the forced message alert is a voice message, the voice message being periodically repeated by the speakers of the recipient PDA/cell phone while said response list is shown on the display,” the Office Action maps the forced message alert and text message to Hammond’s “electronic messages” with “message delivery information” (Office Action at 26), but fails to identify any teaching in which the “means for controlling” is responsible for “causing, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PDA/cell phone.” This is because Hammond’s purported invention requires that **users must open electronic messages**. See Terveen Decl. at ¶ 28. The Office Action focuses on Hammond’s purported teaching of a “system tracks whether each message has been delivered and reviewed by to [sic] each recipient and uses the message information to resend the messages whose delivery or reviewed is not confirmed.” Office Action at 31. But this teaching confirms that users must access and open electronic messages and that users must take affirmative actions to access and open messages. See Terveen Decl. at ¶ 28. Similar to the relied upon portions of Kubala, the Office Action focuses on Hammond’s ensuring transmission of the message and checking for replies. See Terveen Decl. at ¶ 28. The disclosure teaching that Hammond’s server checks for delivery/review and resends messages when “review[] is not confirmed” demonstrates that there is no “means for controlling” that “cause[s]

the text message and a response list to be shown on the display” of the recipient device.” To the contrary, Hammond requires that “the recipient accesses and reviews a message.” Hammond at 5:20-31. There is no teaching in Hammond of a communication system with a “means for controlling” which “cause[s] . . . the text message and a response list to be shown on the display of the recipient PDA/cell phone.” See Terveen Decl. at ¶ 28.

The Office Action identifies Hammond’s “electronic messages” and “message delivery information” but these elements do not “caus[e] . . . the text message and a response list to be shown on the display of the recipient PDA/cell phone.” This is because Hammond expressly states that “electronic messages” must be accessed and reviewed by the user recipient, and there is no teaching otherwise. See Terveen Decl. at ¶ 29. Additionally, Hammond’s “message delivery information” does not modify Hammond’s “electronic messages” in any manner so as to “caus[e] . . . the text message and a response list to be shown on the display of the recipient PDA/cell phone.” Rather, as described in the Office Action, the server waits for the recipient to review the electronic messages and is directed to tracking those opening and reviewing the messages. Office Action at 31. Hammond expressly requires user input to access and review the electronic messages, which means that there is no communication system with a “means for controlling” which “cause[s] . . . the text message and a response list to be shown on the display of the recipient PDA/cell phone,” as required by Claim 2. Hammond explicitly states that “the recipient accesses and reviews a message.” Hammond at 5:20-31. See Terveen Decl. at ¶ 29.

In comparison, Claim 2 of the ’970 patent requires more: a communication system with a “means for controlling” which “cause[s] . . . the text message and a response list to be shown on the display of the recipient PDA/cell phone.” As stated above, the claimed “means for controlling” function is clearly linked to the algorithm described in Fig. 4 of the ’970 patent,

which requires that “the forced voice alert software takes control of the recipient’s cell phone, integrated PDA/cell phone or PC and causes the text message to be displayed or the voice message to be periodically repeated and a list of responses to be shown on the display of the recipient cell phone, integrated PDA/cell phone or PC PDA/cell.” See Terveen Decl. at ¶ 30. This algorithm corresponding to the “means for controlling” function is further described in the specification at 8:37-44 (“the forced voice alert software application program effectively takes control of the recipient PC or PDA/cell phone. If a text message was received, the forced voice alert software application program causes the text message and the response list to be shown on the display of the recipient PC or PDA/cell phone until a manual response is selected from the response list.”). See Terveen Decl. at ¶ 30. Contrary to the disclosed algorithm in the ’970 patent specification, Hammond’s system (the Office Action at page 25 concedes that Hammond does not teach or suggest any relevant application to meet the forced message alert software program) does not take control to show the text message and response list on the display. See Terveen Decl. at ¶ 30. Instead, as discussed above and as stated in the Office Action, the recipient user must access and open for review Hammond’s electronic message. See Terveen Decl. at ¶ 30.

As Dr. Terveen explains, a person of ordinary skill in the art would have understood that the “means for controlling” of the claimed communication system of Claim 2 must cause the display of the text message and the response list. See Terveen Decl. at ¶ 31. Dr. Terveen confirms that requiring a user to access and open an email for review does not satisfy this claimed requirement and does not comport with the claim as a whole which requires a *forced* message alert, rather than an electronic message added to a queue awaiting access by a user like any other type of message. See Terveen Decl. at ¶ 31. The addition of Hammond’s “message

delivery information” to the message for tracking/resending the message does not teach taking control so as to cause the display of the text message and response list on the recipient device’s display. This is especially true because Hammond explicitly teaches that the recipient user must herself access and open for the message for review and Hammond confirms that messages do not need to be accessed and can sit in a state of “reviewed is not confirmed.” Hammond at 5:20-31; Office Action at 31. In Hammond, the user retains control of accessing and displaying the messages because the user must access the messages. See Terveen Decl. at ¶ 31. A person of ordinary skill in the art would not have understood Hammond’s teaching that a user alone retains control of accessing/opening an electronic message to satisfy the “means for controlling” recited in Claim 2 because Hammond’s system does not take control to cause a text message and a response list to be shown on the display of the recipient device. See Terveen Decl. at ¶ 31.

Similarly, Claim 10 requires “transmitting an automatic acknowledgment of receipt to the sender PDA/cell phone, *which triggers the forced message alert software application program to take control of the recipient PDA/cell phone and show the content of the text message and a required response list on the display recipient PDA/cell phone or to repeat audibly the content of the voice message on the speakers of the recipient PDA/cell phone and show the required response list on the display recipient PDA/cell phone.*” As Dr. Terveen states, Claim 10 also requires that forced alert message alert software application program to take control of the recipient device and show the text message and response list on the display of the recipient device. See Terveen Decl. at ¶ 32. For the same reasons provided above in response to Claim 2, Hammond does not teach Claim 10. See Terveen Decl. at ¶ 32.

In addition, Claim 10 requires “transmitting a selected required response from the response list in order to allow the message required response list to be cleared from the

recipient's cell phone display, whether said selected response is a chosen option from the response list, ***causing the forced message alert software to release control of the recipient PDA/cell phone and stop showing the content of the text message and a response list on the display recipient PDA/cell phone*** and or stop repeating the content of the voice message on the speakers of the recipient PDA/cell phone.” For this limitation, the Office Action pivots to state that Johnson at 4:11-42 teaches takes control and releases control. While the Office Action does not identify what elements in Johnson are responsible for taking control and releasing control, it appears that the Office Action is relying on Johnson's “persistent reply attributes” as a mechanism that is “set on an electronic mail object before the electronic mail object is sent for distribution” to “prevent the deletion and archival of the note or image until an appropriate reply is made.” Johnson at 4:11-42. This data structure is similar to Kubala's “mandatory response flag,” described above, and the same rationale for traversal applies here. See Terveen Decl. at ¶ 33. As with all emails, Johnson's disclosure is provided “in response to the recipient opening the electronic mail object” which means that the user must open the email and thus cannot meet the limitations ***triggers the forced message alert software application program to take control of the recipient PDA/cell phone and show the content of the text message and a required response list on the display recipient PDA/cell phone*** or ***causing the forced message alert software to release control of the recipient PDA/cell phone and stop showing the content of the text message and a response list on the display recipient PDA/cell phone*** as required by Claim 10. As Dr. Terveen states, the combination of Hammond, Johnson, and Pepe does not teach a forced message alert software program that takes control or releases control of the PDA/cell phone. See Terveen Decl. at ¶ 33. Instead, the user in Johnson retains control of opening and

displaying a message and the user causes display of the text message and response list. See Terveen Decl. at ¶ 33.

Accordingly, Patent Owner respectfully requests a notice confirming the validity of Claims 2 and 10-13 of the '970 patent.

**Newly Added Claims 14-15**

Patent Owner respectfully requests consideration of newly added claims 14 and 15, which are directed to displaying a geographical map with georeferenced entities on the display of the sender PDA/cellphone; obtaining location and status data associated with the recipient PDA/cellphone; and presenting a recipient symbol on the geographical map corresponding to a correct geographical location of the recipient PDA/cellphone based on at least the location data, as well as means for performing the same steps. Patent Owner submits that new claims 14 and 15 do not add new matter and are supported by the original disclosure of the patent. As Dr. Terveen opines, newly added claims 14 and 15 are patentable and valid over the prior art references in the Office Action. See Terveen Decl. at ¶ 34. To the extent that the above disavowal and traversal does not overcome the existing prior art rejection, Patent Owner respectfully requests consideration and allowance of Claims 14 and 15 and invites Examiner to contact Patent Owner's counsel of record to discuss further amendments to advance the prosecution of the reexamination application.

**CONCLUSION**

For these reasons, Patent Owner respectfully requests withdrawal of the rejections and issuance of a reexamination certificate allowing all of the Challenged Claims.

Respectfully submitted,

ZHONG LAW, LLC  
Attorneys/Agents for Applicants

Date: June 3, 2021

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

U.S. PATENT NO.: 8,213,970 ART UNIT: 3992  
CONTROL NUMBER: 90/014,507 CONF. NO.: 6188  
FILING DATE: May 15, 2020 EXAMINER: Eric B. Kiss  
TITLE: **METHOD OF UTILIZING FORCED ALERTS FOR  
INTERACTIVE REMOTE COMMUNICATIONS**

**FILED ELECTRONICALLY**

Mail Stop *Ex Parte* Reexam  
ATTN: Central Reexamination Unit  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

**CERTIFICATE OF SERVICE ON THIRD-PARTY REQUESTOR**

Dear Commissioner:

The undersigned, on behalf of the Patent Owner, hereby certifies that copies of the following documents are being served on the Third-Party Requestor electronically on June 3, 2021:

1. Response to non-final Office Action mailed March 3, 2021
2. Declaration of Dr. Loren Terveen

The name and addresses of the parties being served are as follows:

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
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*Attorneys for Third-Party Requestor, Google LLC*

Respectfully submitted,

ZHONG LAW, LLC  
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Date: June 3, 2021

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conducted research regarding algorithm design, human-computer interaction, artificial intelligence, computing systems, and online communities;

taught courses in user interface design, implementation, and evaluation, collaborative and social computing, computer programming, GUI toolkits and implementation, and collaborative computing;

provided expert services, investigating both process and design technologies of various devices (graphical user interfaces), systems (interactive program guide systems, information processing, hypertext, inference, information search), products related to wireless tracking and geofencing; and

3. I am an inventor on a number of patents directed to wireless communication of location and tracking information, including a wireless myoelectric control apparatus and methods and system and method for selecting and displaying hyperlinked information resources.

4. Because of my background, training, and experience, I am qualified as an expert to opine on the patent under examination. A more detailed account of my work experience and other qualifications is listed in my Curriculum Vitae attached as **Exhibit A** to this declaration.

#### **The '970 Patent and its Prosecution History**

5. United States Patent No. 8,213,970 ("970 Patent") is entitled "METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS" and issued on July 3, 2012. The '970 Patent, filed on November 26, 2008, was given Application No. 12/324,122. The '970 Patent includes one independent apparatus claim, four dependent apparatus claims, two independent method claims, and six dependent method claims.

6. I reviewed the prosecution history of the '970 Patent, inclusive of cited prior art, and expect to testify with respect to these documents to explain the subject matter and disclosures of this patent. The following sections contain a summary of this review.

7. An Office Action was issued by the PTO on September 20, 2010, in which the Examiner rejected claims 1 through 14. Claims 1, 4, and 6 were rejected under 35 U.S.C. §

102(e) as anticipated by Keating et al. US 20040082352. Claims 2, 3, and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Keating et al. US20040082352 in view of Esler et al. US 20050241026. Claims 7 through 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Keating et al. US 20040082352 in view of Dalton et al. US20040192365.<sup>1</sup>

8. Applicant submitted an Amendment dated December 17, 2010, that amended claims 2-7, and 11 and canceled claim 1.<sup>2</sup>

9. An Office Action was issued by the PTO on March 11, 2011, in which the Examiner rejected claims 2 through 14. Claims 2 through 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Keating et al. US 20040082352 in view of Maggenti et al. US 20020061762. Claims 11 through 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Keating et al. US 20040082352 in view of Dalton et al. US 20040192365.<sup>3</sup>

10. Applicant submitted an Amendment dated September 9, 2011, that amended claims 2, 3, 7, and 11.<sup>4</sup>

11. A Notice of Allowance was issued by the PTO on April 25, 2012 that allowed claims 2 through 14.<sup>5</sup>

### **The Level of Ordinary Skill in The Art**

12. In my opinion, a person of ordinary skill in the art at the time of the claimed invention is someone with at least a bachelor's degree in computer science or computer engineering with one to two years of experience in the field of computer programming for

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<sup>1</sup> See '970 Patent Prosecution History, Office Action dated Sept. 20, 2010, pp. 2-12.

<sup>2</sup> *Id.*, Preliminary Amendment dated Dec. 17, 2010, pp. 8-12.

<sup>3</sup> *Id.*, Office Action dated March 11, 2011, pp. 2-13.

<sup>4</sup> *Id.*, Preliminary Amendment dated Sept. 9, 2011, pp. 8-12.

<sup>5</sup> *Id.* Notice of Allowance dated Apr. 25, 2012.

communications systems, or the equivalent education and work experience. Extensive experience and technical training might substitute for educational requirements, while advanced degrees might substitute for experience. At times, I will refer to a person of ordinary skill in the art as a “POSITA” or a “skilled artisan.”

**Rejection 1: The Combination of Kubala, Hammond, Johnson, and Pepe**

13. I have reviewed the Office Action mailed on May 3, 2021. I understand that Claims 2 and 10-13 of U.S. Patent No. 8,213,970 (the “’970 Patent”) are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application 2006/0218232 (“Kubala”), U.S. Patent No. 6,854,007 (“Hammond”), U.S. Patent No. 5,325,310 (“Johnson”), and U.S. Patent No. 5,742,905 (“Pepe”). I have reviewed the Kubala, Hammond, Johnson, and Pepe references.

14. I note that the portions relied upon in the asserted prior art are directed to email messages. I understand that Patent Owner, in its response to this Office Action, has expressly stated that the claims of the ’970 patent do not cover email messages and that, the claimed forced message alerts, specifically, are not email messages. I understand that the Patent Owner has expressly stated that to the extent any parties have incorrectly interpreted forced message alerts to mean email messages, Patent Owner expressly disavows the claim scope for email messages as they would pertain to the claimed forced message alerts.

15. In my opinion, this disavowal of subject matter is particularly relevant to the Office Action because the Kubala reference concerns “email messages” and the Kubala embodiments relied upon in the Office Action are limited to “email messages.” I understand that one of the Office’s guiding principles is to provide “high quality patents” and to “optimize patent

quality by providing clear notice to the public of the boundaries of the inventive subject matter.” MPEP 2173. Here, the Patent Owner never intended to cover “email messages” and has specifically disavowed “email messages” from the claim scope of “forced message alert” in an effort to raise confidence in the quality of this patent and to avoid any ambiguity as to the breadth of the claim scope.

16. I note that there are two sets of claims at issue in this reexamination. The first set includes claim 2, which contains computer-implemented means-plus-function limitations. For computer-implemented means-plus-function limitations, the law requires the disclosure in the specification of an algorithm for performing the claimed function. The second set includes claims 10-13. Claims 10-13 do not recite any computer-implemented means-plus-function limitations and thus do not require the identification of an algorithm. Below, I discuss the algorithm for the “means for controlling” limitation in claim 2.

17. Kubala is inapplicable to claims 2 and 10-13 of the '970 patent. The Office Action relies solely on the disclosure of an email application for transmitting email messages and including flags in those email messages within the confines of known email formats for email messages. The Office Action relies on an enhanced email application 208 which includes a mandatory-response functional unit 212 to read on the claimed “forced message alert software application program.” Office Action at 5. The Office Action relies on the email message 214 with a mandatory response flag 216 to read on the claimed “forced message alert.” Office Action at 6.

18. I understand that the law requires that, to render a claim obvious, the prior art must enable a skilled artisan to make and use the claimed invention. I also understand that in the absence of such other supporting evidence to enable a skilled artisan to make the claimed

invention, a section 103 reference must enable the portions of its disclosure being relied upon. Id. at 1381. As presented in the Office Action and as explained herein, I understand that the Office Action relies on Kubala's email application and email messages with mandatory response flags in its obviousness rejection of claims 2 and 10-13. However, Kubala does not describe how to carry out or make or use any mandatory response flag in any other types of applications or for any types of messages besides email messages. Because there is no other relevant disclosure in the asserted prior art for mandatory response flags, Kubala itself must be self-enabling for mandatory response flags. In this case, Kubala is only self-enabling as to disclosing mandatory response flags in email messages with email formats, and Kubala provides no enabling disclosure regarding how to carry out mandatory response flags for any other types of messages that are not email messages with email formats. To the extent the Office Action points to the statement that "email message comprise various types of electronic messages, e.g., text messages, instant messages, fax messages, voicemail messages, video messages, audio messages, and other types of messages," this does not change the fact that Kubala's disclosure is sufficiently enabled only as to email applications for email messages with email formats. Kubala describes how the mandatory response flag would be implemented in emails (i.e., email message headers for delivery using, for example, SMTP or MIME formats) and expressly states that any header that is not recognized by an email application "should be ignored." Kubala at paragraphs 37-38. I have reviewed Kubala in its entirety, and Kubala does not sufficiently describe how to carry out or make or use any mandatory response flag in any other types of applications or for any other types of messages besides email messages. In my opinion, a skilled artisan would understand that Kubala's disclosure is limited to email messages and that an email message (notwithstanding any messages that are part of, attached to, comprised within the email message)



in an email format for an email application would be required to carry out Kubala's invention. Otherwise, the embodiments identified in the Office Action are disclosures related only to email messages within email applications. Because the '970 patent is not directed to email messages, as email messages are expressly disavowed by Patent Owner herein, the Kubala reference does not disclose or suggest the claimed inventions of the '970 patent.

19. I have reviewed Rejection 1 in view of Kubala, Hammond, Johnson, and Pepe, and it is my opinion that the rejection should be withdrawn and the Office should confirm the validity of claims 2 and 10-13. I note that Claim 2 recites "means for controlling of the recipient PDA/cell phone upon transmitting said automatic acknowledgment and causing, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PDA/cell phone or causes, in cases where the forced message alert is a voice message, the voice message being periodically repeated by the speakers of the recipient PDA/cell phone while said response list is shown on the display." In my opinion, this limitation is not met by Kubala, particularly with respect to the portion reciting "means for controlling...causing, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PDA/cell phone."

20. For this limitation, Examiner applies Kubala's e-mail message 214 with a flag to the claimed the forced message alert and text message. However, there is no teaching in Kubala that discloses or suggests that the "means for controlling" and "causing, in cases where the force message alert is a text message, the text message and a response list to be shown on the display

of the recipient PDA/cell phone.” This is because Kubala’s purported invention is an email application in which a user must open emails.

21. Examiner focuses on Kubala’s flag in an email corresponding to an indication that the recipient “must provide a reply message in response to the original message.” But a person of ordinary skill in the art would understand that Kubala’s flag does not control the recipient device so as to cause the text message and a response list to be shown on the display of the recipient device. This is because Kubala expressly requires user selection of a control to open and review emails. Accordingly, a person of ordinary skill in the art would understand that, in Kubala, the user retains control and the user causes the display of the email. There is no teaching in Kubala of a communication system with a “means for controlling” which “cause[s] . . . the text message and a response list to be shown on the display of the recipient PDA/cell phone.” In my opinion, this is an important difference between the claimed invention and Kubala’s email application, and the rejection should be withdrawn.

22. Examiner notes that Kubala describes an email application 208 with certain enhancements for flagging email messages. Office Action at 11-12. Further, Examiner draws attention to Kubala’s disclosure that “the user must reply to the received e-mail message in some manner before the e-mail application will allow the user to perform some other action” and “the recipient can be prevented from closing a review of the received e-mail message, from deleting the received e-mail message, and from exiting the e-mail application until the recipient has responded to the received message.” Office Action at 11. But a person of ordinary skill in the art would understand that Kubala’s email application does not disclose a “means for controlling” which is responsible for “causing . . . the text message and a response list to be shown on the display of the recipient PDA/cell phone.” Examiner identifies flags corresponding to Kubala’s

emails. But a person of ordinary skill in the art would understand that Kubala's flags do not disclose any "causing . . . the text message and a response list to be shown on the display of the recipient PDA/cell phone." Rather, the skilled artisan would understand that Kubala's flags do not take control or cause the email to be opened or displayed in any way. Examiner appears to acknowledge this when it cites to Kubala's teaching that the recipient may be required to respond, "when the recipient first reviews the e-mail message." Office Action at 12. Like other email applications, Kubala needs users to open the email message. Kubala explicitly teaches that "a recipient opens an email message that contains a mandatory response flag" and "selecting a control within an e-mail application to open an e-mail message." Kubala at paragraph 0047. This disclosure supports my opinion that Kubala does not disclose or suggest communication system with a communication system with a "means for controlling" which "cause[s] . . . the text message and a response list to be shown on the display of the recipient PDA/cell phone."

23. In my opinion, this limitation is a means-plus-function limitation subject to § 112 6<sup>th</sup> paragraph, which requires a corresponding structure in the form of an algorithm (because it is a computer-based limitation). I note that the claimed "means for controlling" function is clearly linked to the algorithm described in Fig. 4 of the '970 patent, which requires that "the forced voice alert software takes control of the recipient's cell phone, integrated PDA/cell phone or PC and causes the text message to be displayed or the voice message to be periodically repeated and a list of responses to be shown on the display of the recipient cell phone, integrated PDA/cell phone or PC PDA/cell." This algorithm corresponding to the "means for controlling" function is further described in the specification at 8:37-44 ("the forced voice alert software application program effectively takes control of the recipient PC or PDA/cell phone. If a text message was received, the forced voice alert software application program causes the text message and the

response list to be shown on the display of the recipient PC or PDA/cell phone until a manual response is selected from the response list.”). Kubala does not disclose the claimed function or corresponding structure in the form of an algorithm. Contrary to the disclosed algorithm in the '970 patent specification, Kubala's email application does not take control to display the text message and response list. This element is missing from Kubala, which teaches that a user must open and view the email message. Kubala at paragraph 0047. There is no teaching otherwise.

24. A person of ordinary skill in the art would have understood that the “means for controlling” the claimed communication system of Claim 2 must cause the display of the text message and the response list. The skilled artisan would understand that a user opening an email (1) does not satisfy this claimed requirement and (2) does not meet the claim as a whole which requires a *forced* message alert rather than an email added to the inbox queue awaiting opening by a user like any other email. The skilled artisan would have understood that, because the user must open the email to review, Kubala's addition of a flag for requiring a response to an email does not teach taking control so as to cause the display of the text message and response list. Kubala at paragraph 0047. In each and every embodiment disclosed in Kubala, the user retains control of displaying the email because the user must open the email. A person of ordinary skill in the art would not have understood Kubala to disclose or suggest the claimed “means for controlling” recited in Claim 2 because (1) Kubala's user retains control of opening and displaying emails and (2) Kubala's email application does not take control to cause a text message and a response list to be shown on the display of the recipient device.

25. I note that Claim 10 also requires “transmitting an automatic acknowledgment of receipt to the sender PDA/cell phone, *which triggers the forced message alert software application program to take control of the recipient PDA/cell phone and show the content of*

*the text message and a required response list on the display recipient PDA/cell phone or to repeat audibly the content of the voice message on the speakers of the recipient PDA/cell phone and show the required response list on the display recipient PDA/cell phone.”* A person of ordinary skill in the art would understand that Claim 10 also requires that forced alert message alert software application program to take control of the recipient device and show the text message and response list on the display of the recipient device. Thus, for the same reasons provided above, it is my opinion that Kubala does not teach Claim 10.

26. Finally, I note that Claim 10 requires “transmitting a selected required response from the response list in order to allow the message required response list to be cleared from the recipient’s cell phone display, whether said selected response is a chosen option from the response list, *causing the forced message alert software to release control of the recipient PDA/cell phone and stop showing the content of the text message and a response list on the display recipient PDA/cell phone* and or stop repeating the content of the voice message on the speakers of the recipient PDA/cell phone.” In my opinion, Kubala does not disclose the communication system causing the forced message alert software to *release control* of the recipient PDA/cell phone. I reviewed the relevant section of the Office Action, and I am unable to identify any mapping of a specific element in Kubala to this portion of the limitation. I note that the Office Action identifies a user “must reply to the received e-mail message in some manner before the e-mail application will allow the user to perform some other action.” Office Action at 19. I note that Examiner states that “it follows that Kubala’s e-mail application releases control of the PDA/cell phone to allow the user to perform some other action.” I disagree with Examiner’s conclusory statement that “it follows” that Kubala releases control. To the contrary, this conclusory statement is unsupported by the Kubala reference and demonstrates

that Kubala does not teach causing the forced message alert software to release control of the device. A person of ordinary skill in the art would understand that Kubala does not disclose releasing control and that there is no teaching in Kubala to support that this limitation is met by Kubala.

27. In my expert opinion, Kubala does not teach a forced message alert software program that takes control or releases control of the PDA/cell phone. Kubala discloses a mandatory response flag in an email to request a mandatory response. Kubala at 0053-0054. Kubala does not take control in a manner that forces open a text message and a response list or release control. Kubala's recitation of "before the e-mail application will allow the user to perform some other action," does not teach or suggest *releasing control* as required by the claims. A person of ordinary skill in the art would not have understood the Kubala reference to disclose any releasing control of the recipient device. Thus, it is my opinion that Kubala does not teach Claim 10.

**Rejection 2: The Combination of Hammond, Johnson, and Pepe**

28. In my opinion, the combination based on Hammond, Johnson and Pepe does not render obvious claims 2 and 10-13 for similar reasons. Regarding claim 2, the Hammond combination does not disclose a communication system with a "means for controlling" which includes "causing, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PDA/cell phone." Examiner applies Hammond's "electronic messages" with "message delivery information" (Office Action at 26) to the claimed forced message alert and text message. However, Hammond's "electronic messages" with "message delivery information" fails to meet the required "means for

controlling” which “caus[es], in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PDA/cell phone.” Again, Hammond’s purported invention requires that users must open electronic messages, which means that it fails to disclose the limitation. Examiner focuses on Hammond’s teaching of a “system tracks whether each message has been delivered and reviewed by to [sic] each recipient and uses the message information to resend the messages whose delivery or reviewed is not confirmed.” Office Action at 31. A person of ordinary skill in the art would understand that this teaching confirms that users must access and open electronic messages, that users must take affirmative actions to access and open messages and that the cited disclosures focus merely on Hammond’s ensuring transmission of the message and checking for replies. The skilled artisan would understand that a server checking for delivery or review of messages and resends messages when “review[] is not confirmed” demonstrates that there is no “means for controlling” that “cause[s] the text message and a response list to be shown on the display” of the recipient device.” My opinions are supported by Hammond’s disclosure, which requires that “the recipient accesses and reviews a message.” Hammond at 5:20-31. Accordingly, Hammond cannot teach a communication system with a “means for controlling” which “cause[s] . . . the text message and a response list to be shown on the display of the recipient PDA/cell phone.”

29. In my opinion, Hammond’s “electronic messages” and “message delivery information” do not “caus[e] . . . the text message and a response list to be shown on the display of the recipient PDA/cell phone.” My opinion is supported by the fact that Hammond expressly states that “electronic messages” must be accessed and reviewed by the user recipient, and there is no teaching otherwise. Hammond at 5:20-31. Hammond’s “message delivery information” does not modify Hammond’s “electronic messages” in any manner so as to “caus[e] . . . the text

message and a response list to be shown on the display of the recipient PDA/cell phone.”

Rather, Hammond’s server waits for the recipient to review the electronic messages and is directed to tracking those opening and reviewing the messages. Office Action at 31.

Hammond’s system has no control over displaying messages. Hammond expressly requires user input to access and review the electronic messages, which means that there is no communication system with a “means for controlling” which “cause[s] . . . the text message and a response list to be shown on the display of the recipient PDA/cell phone,” as required by Claim 2. Hammond explicitly teaches that “the recipient accesses and reviews a message.” Hammond at 5:20-31.

30. As stated above, this limitation is a means-plus-function limitation and the claimed “means for controlling” function is clearly linked to the algorithm described in Fig. 4 of the ’970 patent, which requires that “the forced voice alert software takes control of the recipient’s cell phone, integrated PDA/cell phone or PC and causes the text message to be displayed or the voice message to be periodically repeated and a list of responses to be shown on the display of the recipient cell phone, integrated PDA/cell phone or PC PDA/cell.” This algorithm corresponding to the “means for controlling” function is further described in the specification at 8:37-44 (“the forced voice alert software application program effectively takes control of the recipient PC or PDA/cell phone. If a text message was received, the forced voice alert software application program causes the text message and the response list to be shown on the display of the recipient PC or PDA/cell phone until a manual response is selected from the response list.”). Hammond’s disclosure does not meet the function or the corresponding structure. I agree with the Examiner’s finding that Hammond does not disclose any relevant application to meet the forced message alert software program. Office Action at page 25. Hammond also does not take control to show the text message and response list on the display



because Hammond explicitly describes that a recipient user must access and open for review Hammond's electronic message.

31. As I explained above, a person of ordinary skill in the art would have understood that the "means for controlling" of the claimed communication system of Claim 2 must cause the display of the text message and the response list. A person of ordinary skill in the art would understand that requiring a user to access and open an email for review means that an electronic message is added to a queue to await access by a user like any other type of message, and that explicit requirement (1) does not satisfy this claimed requirement and (2) does not meet the claim as a whole which requires a *forced* message alert,. Further, the skilled artisan would understand that the addition of Hammond's "message delivery information" to the message for tracking/resending the message does not teach taking control so as to cause the display of the text message and response list on the recipient device's display. This is especially true because Hammond explicitly teaches that the recipient user must access and open the message for review and Hammond confirms that messages do not need to be accessed and can remain un-displayed in a state of "reviewed is not confirmed." Hammond at 5:20-31; Office Action at 31. As in Kubala, the user in Hammond retains control of accessing and displaying the messages because the user must access the messages. A person of ordinary skill in the art would not have understood Hammond's teaching that a user alone retains control of accessing/opening an electronic message to satisfy the "means for controlling" recited in Claim 2 because Hammond's system does not take control to cause a text message and a response list to be shown on the display of the recipient device.

32. My opinions also rely to Claim 10, which requires "transmitting an automatic acknowledgment of receipt to the sender PDA/cell phone, *which triggers the forced message*

*alert software application program to take control of the recipient PDA/cell phone and show the content of the text message and a required response list on the display recipient PDA/cell phone or to repeat audibly the content of the voice message on the speakers of the recipient PDA/cell phone and show the required response list on the display recipient PDA/cell phone.”*

A person of ordinary skill in the art would understand that Claim 10 also requires that forced alert message alert software application program to take control of the recipient device and show the text message and response list on the display of the recipient device. Thus, for the same reasons provided above, it is my opinion that Hammond does not teach Claim 10.

33. Finally, I note that Claim 10 further requires “*the forced message alert software to release control of the recipient PDA/cell phone and stop showing the content of the text message and a response list on the display recipient PDA/cell phone.*” I note that Examiner switches the reading to apply Johnson at 4:11-42 to the *takes control* and *releases control* limitations. Examiner does not identify what elements in Johnson are responsible for taking control and releasing control. It appears that the Office Action is relying on Johnson’s “persistent reply attributes” as a mechanism that is “set on an electronic mail object before the electronic mail object is sent for distribution” to “prevent the deletion and archival of the note or image until an appropriate reply is made.” Johnson at 4:11-42. Johnson’s “persistent reply attribute” appears to be a data structure which is similar to Kubala’s “mandatory response flag.” Thus, the claims are not met for the same reasons. A person of ordinary skill in the art would understand that Johnson’s disclosure is similar to all emails and email applications and that Johnson’s emails are only shown on the display “in response to the recipient opening the electronic mail object.” The skilled artisan would understand this disclosure to mean that the user in Johnson must open the email and thus cannot meet the limitations *triggers the forced*

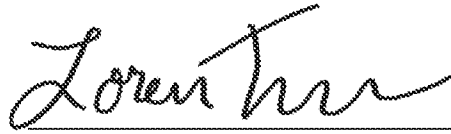
*message alert software application program to take control of the recipient PDA/cell phone and show the content of the text message and a required response list on the display recipient PDA/cell phone or causing the forced message alert software to release control of the recipient PDA/cell phone and stop showing the content of the text message and a response list on the display recipient PDA/cell phone* as required by Claim 10. Thus, the combination of Hammond, Johnson and Pepe does not teach a forced message alert software program that takes control or releases control of the PDA/cell phone, as required by claim 10, because the user in Johnson retains control of opening and displaying a message.

#### New Claims

34. I understand that Patent Owner is adding claims 14 and 15 and is requesting consideration of these claims for patentability. I have reviewed added claims 14 and 15 and compared the claims against the prior art in the Office Action. In my opinion, claims 14 and 15 are patentable and valid over the prior art in the Office Action. The prior art in the Office Action does not teach or suggest the claimed inventions of claims 2 and 10 with the additional limitations reciting displaying a geographical map with georeferenced entities on the display of the sender PDA/cellphone, obtaining location and status data associated with the recipient PDA/cellphone, and presenting a recipient symbol on the geographical map corresponding to a correct geographical location of the recipient PDA/cellphone based on at least the location data.

I declare under the penalty of perjury that the foregoing is true and correct to the best of my knowledge.

Executed this 3<sup>rd</sup> day of June, 2021 in Minneapolis, MN.

A handwritten signature in cursive script, reading "Loren Terveen". The signature is written in black ink and is positioned above a horizontal line.

Loren G. Terveen, Ph.D.

# EXHIBIT A

# Loren G. Terveen

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**Address**            Department of Computer Science and Engineering  
University of Minnesota  
Minneapolis, MN 55455

**Education**            Ph.D. in Computer Sciences            University of Texas            1991  
M.S. in Computer Sciences            University of Texas            1988  
B.A. in Computer Science,  
Mathematics, History            University of South Dakota            1984

**Affiliations**            Member of ACM, ACM/SIGCHI

**Research  
Interests**            Human-Computer Interaction, Social Computing

**Professional  
Experience**            Professor                      University of Minnesota            2002 --  
Distinguished McKnight University Professor            2017 --  
Principal Member of            AT&T Labs - Research            1996-2002  
Technical Staff  
Member of Technical Staff            AT&T Bell Labs            1991-1996  
Graduate Research Intern            Microelectronics and            1986-19991  
Computer Corporation  
Teaching Assistant            University of Texas at Austin            1985

## AWARDS AND MAJOR ROLES

ACM Distinguished Scientist (awarded 2009)

ACM SIGCHI Academy (2019 - )

ACM SIGCHI President (2015-2018)

ACM Council, SIG Governing Board Representative (2016 -- 2018)

# RESEARCH

## External Funding

NSF:CHS:Small: Incorporating and Balancing Stakeholder Values in Algorithm Design (UMN **PI**), Award Total \$500,000, UMN Share \$243,941 for 8/1/2019 to 7/31/2022.

NSF: EAGER: AI-DCL: Capture, Explain and Negotiate the Inherent Trade-offs in Machine Learning Algorithms (UMN **co-PI**), Award Total \$295,713, UMN Share \$103,267 for 10/1/2019 to 9/30/2022.

NSF:CHS: Small: Collaborative Research: Structured Data Peer Production: Addressing Challenges and Leveraging Opportunities (**PI**), \$249,738 for 9/1/2018 - 8/31/2021.

National Cancer Institute (NCI): Restore: Improving sexual outcomes of gay and bisexual prostate cancer survivors (R. Simon Rosser **PI**; my role: **Co-PI**); \$2,039,220 (directs) \$3,039,541 (total), 2017-2022.

NSF: "PFI:BIC: Smart Human-Centered Collision Warning System: sensors, intelligent algorithms and human-computer interfaces for safe and minimally intrusive car-bicycle interactions" (Co-PI, with Rajesh Rajamani (PI), Max Donath, and Nichole Morris), \$999,773 for September 1, 2016 to August 31, 2019.

NSF: "Computer-Supported Cooperative Work Doctoral Colloquium" (**PI**), \$25,000 for 03/01/2016 to 02/28/2017.

National Institute on Drug Abuse: "A Technology-Delivered Peer-to-Peer Support ARB Adherence Intervention for HIV+ Adults", (Co-PI, with Keith Horvath(PI) and Darin Erickson), \$3,302,62 for 07/01-2015 to 05/31/2020.

NSF: "HCC: Tools and Mechanisms to Support Social Participation Efforts", (**PI**), \$499,399 for 10/01/2012 to 09/30/2015.

NSF: "SoCS: Collaborative Research: Novel Algorithms and Interaction Mechanisms to Enhance Social Production", (**PI**), \$527,140, for 7/01/2012 to 06/30/2015.

NSF: "Collaborative Research: Supporting Newcomer Socialization in Online Production Communities", (**PI**), \$301,135.00 for 08/2011 to 08/31/2015.

Minnesota Department of Transportation: "Statewide Cycloplan: A Bicycle Planning Tool with Participatory GIS", (**PI**), \$130,000, for 10/01/2011 to 06/30/2013.

Metropolitan Council: "Cycloplan II", (**PI**), \$71,350, for 08/15/2011 to 05/31/2012.

NSF: "Wikisym Doctoral Consortium", (**PI**), \$13,163, for 05/01/2011 to 04/30/2012.

IBM: "Mobile Crowdsensing", (PI), \$100,000 awarded 04/01/2011

NSF: "Social-Computational Systems (SoCS) Community Meeting" (PI), \$48,801 for 09/01/2010 to 08/31/2011

NSF: "SoCS: Collaborative Research: Information Framing: Intelligent Interfaces for an Online Production Community", (PI), \$375,000 for 09/15/2010 to 08/31/2015.

NSF: "Collaborative Research: Guiding Folksonomy Development to Enable Novel Tagging Applications" (PI, with J. Riedl and S. Sen (Macalester College)). \$949,788 for 04/1/2010 to 03/31/2014 (UMN Share).

Minnesota Department of Transportation: Bike, Bus, and Beyond: Extending Cyclopath to Enable MultiModal Routing (PI), \$60,627, for 07/08/2010 to 01/31/2012

NIH: An Interactive Website to Promote Communication about Sexual Health and Dating Relationships between Parents and Teens (Co-PI, with Sonya Brady (PI), Simon Rosser, and Renee Sieving), \$679,500 for 09/30/2009 to 08/31/2011.

Metropolitan Council: "Cycloplan" (PI), \$185,000, October 2009 – March 2011.

NSF "Collaborative Research: Understanding Online Volunteer Communities: Toward Theory-Based Design" (co-PI, with J. Riedl, J. Konstan, M. Snyder, & Y. Ren; R. Kraut (CMU) \$2,400,000 for 08/01/2008 to 07/31/2013.

NSF: "Recommender Systems Doctoral Consortium" (PI) \$15,415, 2007-2008.

NSF: "Mining Spatiotemporal Data: From Personal Use to Community Knowledge" (PI) \$449,570 for 12/1/2005 to 11/30/2009.

NSF: "Collaborative Research: Mark This! - Operationalizing the notion of "place" for interactive community systems" (PI, with Q. Jones (NJIT) and S. Whittaker (Univ. of Sheffield)). \$173,411 for 6/1/2003 to 5/31/2007 (UMN share).

NSF: "Being There: Mobile Devices for Community and Commerce" (PI, with J. Konstan, J. Riedl, and S. Shekhar). \$120,000 for 9/1/2002 to 8/31/2005.

NSF: "ITR: Collaborative Research: Designing On-Line Communities to Enhance Participation" (co-PI, with J. Konstan & J. Riedl, R. Kraut & S. Kiesler (CMU), P. Resnick and Y. Chen (Univ. of Michigan)). \$1,246,017 for 9/1/2003 to 8/31/2009 (UMN share).

AT&T: "VURI: Collaborative Filtering and Intelligent Interface Design for Enhanced TV Applications" (PI). \$35,000 for November 1, 2008 to October 31, 2009.



AT&T: "VURI: Collaborative Filtering and Intelligent Interface Design for Enhanced TV Applications" (PI). \$35,000 for June 1, 2007 to May 31, 2008.

## Internal Funding

Minnesota/China Collaborative Research Grant: "Expertise Oriented Mining for Web Community". \$10,000 for July 1, 2007 to June 30, 2008 (PI, with Jie Tang, Tsinghua University, Beijing China).

University of Minnesota TEL grant: "The Next Generation Online Learning Environment: Designing for Community and Collaboration". \$10,000 for September 2006 to May 2007. (co-PI, with Joan Hughes, David Ernst, and Ann Ooms, College of Education and Human Development).

University of Minnesota Digital Technology Center: "Indoor Navigation Aids for Visually Impaired People". \$25,67 for June 2005 to December 2006. (co-PI, with S. Shekhar and G. Legge).

University of Minnesota Digital Technology Center: "Eye-Tracking Research on Community Websites: Photo Directories and Building Social Networks". \$19,300 for June 2004 to June 2005. (co-PI, with J. Konstan).

University of Minnesota Grant-In-Aid: "Facilitating Participation in Online Communities". \$20,397 for 1/1/2003 to 6/30/2004.

## Books

1. Bickhard, M.H. and Terveen, L.G. Foundational Issues in Artificial Intelligence and Cognitive Science: Impasse and Solution, (1995), Elsevier Science.

## Refereed Journal Papers

2. Levonian, Z., Dow, M., Erickson, D.R., Ghosh, S., Miller Hillberg, H., Narayanan, S., Terveen, L. and Yarosh, L. Patterns of Patient and Caregiver Mutual Support Connections in an Online Health Community. In *Proceedings of the ACM on Human-Computer Interaction*, Vol. 4 (2020).
3. Zhu, H., Yu, B., Halfaker, A., and Terveen, L. Value-Sensitive Algorithm Design: Method, Case Study, and Lessons. In *Proceedings of the ACM on Human-Computer Interaction*, Vol. 2, No. 2 (2018).
4. Miller Hillberg, H., Levonian, Z., Terveen, L., and Hecht, B. What I See is What You Don't Get: Effects of Seeing Emoji Rendering Differences Across Platforms. In *Proceedings of the ACM on Human-Computer Interaction*, Vol. 2, No. 2 (2018).
5. Hall, A., Terveen, L., and Halfaker, A. Bot Detection in Wikidata Using Behavioral Cues. In *Proceedings of the ACM on Human-Computer Interaction*, Vol. 2, No. 2 (2018).
6. Sheppard, S.A., Turner, J., Thebault-Spieker, J., Zhu, H., and Terveen, L. Never Too Old, Cold or Dry to Watch the Sky: A Survival Analysis of Citizen Science Volunteerism. In *Proceedings of the ACM on Human-Computer Interaction*, Vol. 1, No. 2 (2017).
7. Thebault-Spieker, J., Kluver, D., Klein, M., Halfaker, A., Hecht, B., Terveen, L., and Konstan, J. Simulation Experiments On (The Absence of) Ratings Bias in Reputation Systems. In *Proceedings of the ACM on Human-Computer Interaction*, Vol. 1, No. 2 (2017).

8. Yu, B., Wang, X., Lin, A.Y., Ren, Y., Terveen, L., and Zhu, H. Out With The Old, In With The New? Unpacking Member Turnover in Online Production Groups. In *Proceedings of the ACM on Human-Computer Interaction*, Vol. 1, No. 2 (2017).
9. Nguyen, T.T., Harper, F.M., Terveen, L., and Konstan, J. User Personality and User Satisfaction with Recommender Systems. In *Information Systems Frontiers* (2017).
10. Filson Moses, J., Dwyer, P.C., Fugelstad, P.T., Kim, J.S., Maki, A., Synder, M., and Terveen, L. Encouraging Online Engagement: The Role of Interdependent Self-Construal and Social Motives in Fostering Online Participation. In *Personality and Individual Differences* (2017).
11. Thebault-Spieker, J., Terveen, L., and Hecht, B. Towards a Geographic Understanding of the Sharing economy: Systemic Biases in UberX and TaskRabbit. In *ACM Transactions on Computer-Human Interaction* (2017).
12. Brady, S.S., Sieving, R.E., Terveen, L.G., Rosser, R. S., Kodet, A.J., and Rothberg, V.D. An Interactive Website to Reduce Sexual Risk Behavior: Process Evaluation of TeensTalkHealth, *JMIR Research Protocols* (2015).
13. Ren, Y., Harper, F.M., Drenner, S., Terveen, L., Kiesler, S., Riedl, J., and Kraut, R.E. (2012). Building Member Attachment in Online Communities: Applying Theories of Group Identity and Interpersonal Bonds. *Management Information Systems Quarterly*.
14. Jones, Q., Grandhi, S., Karam, S., Whittaker, S., Zhou, C., and Terveen, L. Geographic 'Place' and Community Information Preferences, in *Computer-Supported Cooperative Work*.
15. Zhou, C., Frankowski, D., Ludford, P., Shekhar, S., Terveen, L., Discovering Personally Meaningful Places from Location Data: An Interactive Clustering Approach. *ACM Transactions on Information System*, 25, 3 (July 2007).
16. Ling, K., Beenen, G., Ludford, P.J., Wang, X., Chang, K., Li, X., Cosley, D., Frankowski, D., Terveen, L., Rashid, A.M., Resnick, P., and Kraut, R.E. Using Psychology to Motivate Contributions to Online Communities. *Journal of Computer-Mediated Communication*, 10, 4 (June 2005).
17. Terveen, L. and McDonald, D. Social Matching: A Framework and Research Agenda. *ACM Transactions on Computer-Human Interaction*, 12, 3 (2005), 401-434.
18. Whittaker, S., Jones, Q., Nardi, B., Creech, M., Terveen, L., Isaacs, E., and Hainsworth, J. ContactMap: organizing communication in a social desktop, in *ACM Transactions on Computer-Human Interaction*, 11, 4 (December 2004), 445-471.
19. Jones, Q., Grandhi, S., Terveen, L., and Whittaker, S. People-To-People-to-Geographical-Places: The P3 Framework for Location-Based Community Systems. in *Computer-Supported Cooperative Work*, 13, 3-4 (August 2004), 249-282.
20. Herlocker, J.L., Konstan, J.A., Terveen, L.G., and Riedl, J.T. Evaluating Collaborative Filtering Recommender Systems, *ACM Transactions on Information Systems* (2004).
21. Amento, B., Terveen, L., Hill, W., Hix, D., and Schulman, R. Experiments in Social Data Mining: The TopicShop System, in *ACM Transactions on Computer-Human Interaction*, 10, 1 (March 2003), 54-85.
22. Whittaker, S., Terveen, L.G. and Nardi, B.A. Let's stop pushing the envelope and start addressing it, in *Human-Computer Interaction*, 15, 2-3 (Sep 2000), 75-106.
23. Terveen, L.G., Hill, W.C., and Amento, B. Constructing, Organizing, and Visualizing Collections of Topically Related Web Resources, in *ACM Transactions on Computer-Human Interaction*, 6, 1 (Mar. 1999), 67-94.

24. Selfridge, P.G. and Terveen, L.G. Knowledge Management Tools for Business Process Support and Reengineering, in *Journal of Intelligent Systems in Accounting, Finance, and Management* (Jan. 1996).
25. Terveen, L.G. An Overview of Human-Computer Collaboration, in *Knowledge-Based Systems*, 8, 2-3 (1995), 67-81.
26. Terveen, L.G., Selfridge, P.G., and Long, M.D. Living Design Memory: Framework, System, and Lessons Learned, in *Human-Computer Interaction*, 10, 1 (1995), 1-37.
27. Terveen, L.G. Intelligent Systems as Cooperative Systems, in *International Journal of Intelligent Systems*, 3, 2-4 (1993), 217-250.
28. Brachman, R.J., Selfridge, P.G., Terveen, L.G., Altman, B., Borgida, A., Halper, F., Kirk, T., Lazar, A., McGuinness, D.L., and Resnick, L.A. Integrated Support for Data Archaeology, in *International Journal of Intelligent and Cooperative Information Systems*, 2, 2 (1993), 159-185.

## Refereed Conference Papers

29. Yu, B., Ye, Y., Terveen, L., Wu, Z.S., Forlizzi, J., and Zhu, H. Keeping Designers in the Loop: Communicating Inherent Algorithmic Trade-offs Across Multiple Objectives. In *Proceedings of DIS 2020, the ACM Conference on Designing Interactive Systems*.
30. Smith, C.E., Yu, B., Srivastava, A., Halfaker, A., Terveen, L., and Zhu, H. Keeping Community in the Loop: Understanding Wikipedia Stakeholder Values for Machine Learning-Based Systems. In *Proceedings of CHI 2020, the ACM Conference on Human Factors in Computing Systems*.
31. Levonian, Z., Erikson, D., Luo, W., Narayanan, S., Rubya, S., Vachher, P., Terveen, L. and Yarosh, S. Bridging Qualitative and Quantitative Methods for User Modeling: Tracing Cancer Patient Behavior in an Online Health Community. In *Proceedings of ICWSM 2020, AAI Conference on the Web and Social Media*.
32. Cheng, H.F., Yu, B., Fu, S., Zhao, J., Hecht, B., Konstan, J., Terveen, L., Yarosh, S., and Zhu, H. Teaching UI Design at Global Scales: A Case Study of Designing Collaborative Capstone Projects for MOOC Students, in *Proceedings of ACM Learning at Scale 2019*.
33. Hall, A., Thebault-Spieker, J., Sen, S., Hecht, B., and Terveen, L. Exploring the Relationship Between “Informal Standards” and Contributor Practice in OpenStreetMap. In *Proceedings of OpenSym 2018*.
34. Thebault-Spieker, J., Halfaker, A., Terveen, L., and Hecht, B. Distance and Attraction: Gravity Models for Geographic Content Production. In *Proceedings of CHI 2018, the ACM Conference on Human Factors in Computing Systems*.
35. Thebault-Spieker, J., Hecht, B., and Terveen, L. Geographic Biases are ‘Born, not Made’: Exploring Contributors’ Spatiotemporal Behavior in OpenStreetMap. In *Proceedings of ACM Group 2018*.
36. Kang, J., Condiff, K., Chang, S., Terveen, L., Konstan, J., and Harper, F.M. Understanding How People Use Natural Language to Ask for Recommendations, in *RecSys 2017*.
37. Miller, H., Kluver, D., Thebault-Spieker, J., Terveen, L., and Hecht, B. Understanding Emoji Ambiguity in Context: The Role of Text in Emoji-Related Miscommunication. In *Proceedings of ICWSM 2017, AAI Conference on the Web and Social Media*.
38. Hall, A., McRoberts, S., Thebault-Spieker, J., Lin, A.Y., Sen, S., Hecht, B., and Terveen, L. Freedom versus Standardization: Structured Data Generation in a Peer Production

- Community. In *Proceedings of CHI 2017, the ACM Conference on Human Factors in Computing Systems (CHI 2017)*.
39. Yu, B., Ren, Y., Terveen, L., and Zhu, H. Predicting Member Productivity and Withdrawal from Pre-Joining Attachments in Online Production Groups. In *Proceedings of CSCW 2017, The ACM Conference on Computer-Supported Cooperative Work and Social Computing*.
  40. Chang, S., Harper, M., and Terveen, L. Crowd-Based Personalized Natural Language Explanations for Recommendations. In *Proceedings of RecSys 2016, The ACM Conference on Recommender Systems*.
  41. Chang, S., Harper, M., He, L., and Terveen, L. CrowdLens: Experimenting with Crowd-Powered Recommendation and Explanation. In *Proceedings of ICWSM 2016, AAAI Conference on the Web and Social Media*.
  42. Miller, H., Thebault-Spieker, J., Chang, S., Johnson, I., Terveen, L., and Hecht, B. “Blissfully happy” or “ready to fight”: Varying Interpretations of Emoji. In *Proceedings of ICWSM 2016, AAAI Conference Web and Social Media*.
  43. Zhao, Q., Huang, Z., Harper, F.M., Terveen, L., and Konstan, J. “Precision Crowdsourcing: Closing the Loop to Turn Information Consumers into Information Producers”. In *Proceedings of CSCW 2016, The ACM Conference on Computer Supported Cooperative Work and Social Computing*.
  44. Harper, F.M., Xu, F., Kaur, H., Condiff, K., Chang, S., and Terveen, L. Putting Users in Control of their Recommendations. In *Proceedings of RecSys2015, The ACM Conference on Recommender Systems*.
  45. Kapoor, K., Kumar, V., Terveen, L., Konstan, J.A., and Schrater, P. “I like to explore sometimes” – Adapting to Dynamic User Novelty Preferences. In *Proceedings of RecSys2015, The ACM Conference on Recommender Systems*.
  46. Warncke-Wang, M., Ranjan, V., Terveen, L., and Hecht, B. Misalignment Between Supply and Demand of Quality Content in Peer Production Communities. In *Proceedings of the International Conference on Weblogs and Social Media (ICWSM '15)*.
  47. Chang, S., Harper, F.M., and Terveen, L. Using Groups of Items to Bootstrap New Users in Recommender Systems. In *Proceedings of the 18th ACM conference on Computer supported cooperative work & social computing (CSCW '15)*. ACM, New York, NY, USA.
  48. Miller, H., Chang, S., and Terveen, L. “I LOVE THIS SITE!” vs. “It’s a little girly”: Perceptions of and Initial User Experience with Pinterest. In *Proceedings of the 18th ACM conference on Computer supported cooperative work & social computing (CSCW '15)*. ACM, New York, NY, USA.
  49. Thebault-Spieker, J., Terveen, L., and Hecht, B. 2015. Avoiding the South Side and the Suburbs: The Geography of Mobile Crowdsourcing Markets. In *Proceedings of the 18th ACM conference on Computer supported cooperative work & social computing (CSCW '15)*. ACM, New York, NY, USA.
  50. Warncke-Wang, M., Hecht, B., and Terveen, L. The Success and Failure of Quality Improvement Projects in Peer Production Communities. In *Proceedings of the 18th ACM conference on Computer supported cooperative work & social computing (CSCW '15)*. ACM, New York, NY, USA.
  51. Panciera, K., Masli, M., and Terveen, L. Crème de la Crème: Elite contributors in an online community, in *Proceedings of the 10<sup>th</sup> International Symposium on Open Collaboration (OpenSym 2014)*.

52. Kumar, V., Kluver, D., Terveen, L., and Riedl, J. More Efficient Tagging Systems with Tag Seeding, in Proceedings of IEEE SocialCom 2014.
53. Nguyen, T., Hui, P., Harper, F.M., Terveen, L., and Konstan, J. Exploring the Filter Bubble: The Effect of Using Recommender Systems on Content Diversity, in Proceedings of WWW 2014.
54. Halfaker, A., Geiger, S., and Terveen, L. Snuggle: Designing for Efficient Socialization and Ideological Critique, in Proceedings of CHI 2014.
55. Chang, S., Kumar, V., Gilbert, E., and Terveen, L. Specialization, Homophily, and Gender in a Social Curation Site Findings from Pinterest, in Proceedings of CSCW 2014.
56. Grevet, C., Terveen, L., and Gilbert, E. Managing Political Differences in Social Media, in Proceedings of CSCW 2014.
57. Masli, M., and Terveen, L. Leveraging the Contributory Potential of User Feedback, in Proceedings of CSCW 2014.
58. Sheppard, S.A., Wiggins, A., and Terveen, L. Capturing Quality: Retaining Provenance for Curated Volunteer Monitoring Data, in Proceedings of CSCW 2014.
59. DeLong, C., Terveen, L., and Srivastava, J. (2013). TeamSkill and the NBA: Applying Lessons from the Virtual World to the Real World, in Proceedings of ASONAM 2013.
60. Torre, F., Liu, Y., Liu, Z., and Terveen, L. (2013). Local Knowledge Matters for Crowdsourcing Systems: Experience from Transferring an American Site to China, in Proceedings of ICWSM 2013.
61. Gilbert, E., Bakshi, S, Chang, S., and Terveen, L. (2013). "I Need to Try This!": A Statistical Overview of Pinterest, in Proceedings of CHI 2013.
62. Torre, F., Pitchford, D., Brown, P., and Terveen, L. (2012). Matching GPS Traces to (Possibly) Incomplete Map Data: Bridging Map Building and Map Matching, in ACM SIGSPATIAL GIS 2012.
63. Dunne, L, Zhang, J., and Terveen, L. (2012). An Investigation of Contents and Use of the Home Wardrobe, in UbiComp 2012.
64. Dong, Z., Shi, C., Sen, S., Terveen, L., and Riedl, J. (2012). War Versus Inspirational in Forrest Gump: Cultural Effects in Tagging Communities, in ICWSM 2012.
65. Masli, M. and Terveen, L. (2012) Evaluating Compliance-Without-Pressure Techniques for Increasing Participation in Online Communities, in CHI 2012.
66. Fuglestad P.T., Dwyer, P.C., Filson Moses, J., Kim, J.S., Mannino, C.A., Terveen, L., and Snyder, M. (2012) What Makes Users Rate (Share, Tag, Edit...)? Predicting Patterns of Participation in Online Communities, in CSCW 2012.
67. Nathan, M., Topkara, M., Lai, J., Pan, S., Wood, S., Boston, J., and Terveen, L. (2012) In Case You Missed It: Benefits of Attendee-Shared Annotations for Non-attendees of Remote Meetings, in CSCW 2012.
68. Priedhorsky, R., Pitchford, D., Sen, S., and Terveen, L. (2012), Recommending Routes in the Context of Bicycling: Algorithms, Evaluation, and the Value of Personalization, in CSCW 2012.
69. Lam, S.K., Uduwage, A., Dong, Z., Sen, S., Musicant, D.R., Terveen, L., and Riedl, J. (2011). WP:Clubhouse? An Exploration of Wikipedia's Gender Imbalance, in Wikisym 2011. *Best Paper Winner*.
70. Panciera, K., Masli, M., and Terveen, L.G. (2011). "How Should I Go from \_\_\_ to \_\_\_ without Getting Killed? Motivations and Benefits in Open Collaboration", in Wikisym 2011.

71. Priedhorsky, R., and Terveen, L.G. (2011). Wiki Grows Up: Arbitrary Data Models, Access Control, and Beyond, in Wikisym 2011.
72. Sheppard, S.A. and Terveen, L.G. (2011). Quality is a Verb: The Operationalization of Data Quality in a Citizen Science Community, in Wikisym 2011.
73. Masli, M., Priedhorsky, R., and Terveen, L. (2011). Task Specialization in Social Production Communities: The Case of Geographic Volunteer Work, in the Proceedings the 4<sup>th</sup> International AAAI Conference on Weblogs and Social Media (ICWSM 2011).
74. Torre, F., Sheppard, S.A., Priedhorsky, R., and Terveen, L. (2010) bumpy, caution with merging: An Exploration of Tagging in a Geowiki, in GROUP 2010.
75. Panciera, K., Priedhorsky, R., Erickson, T., and Terveen, L. (2010). Lurking? Cyclopaths? A Quantitative Analysis of User Behavior in a Geowiki, in CHI 2010. **Best of CHI Nominee.**
76. Priedhorsky, R., Masli, M., and Terveen, L. (2010). Eliciting and Focusing Geographic Volunteer Work, in CSCW 2010.
77. Panciera, K., Halfaker, A., and Terveen, L. (2009). Wikipedians are Born, Not Made: A Study of Power Editors on Wikipedia, in GROUP 2009. *36% Acceptance Rate.*
78. Reily, K., Ludford Finnerty, P., and Terveen, L. Two Peers are Better than One: Aggregating Peer Reviews for Computing Assignments is Surprisingly Accurate, in GROUP 2009. *36% Acceptance Rate.*
79. Ludwig, M., Priedhorsky, R., and Terveen, L. (2009). Path Selection: A Novel Interaction Technique for Mapping Applications, to appear in CHI 2009. *24% acceptance rate.*
80. Priedhorsky, R., and Terveen, L. (2008). The Computational Geowiki: What, Why, and How, in CSCW 2008. *23% acceptance rate.* **Best of CSCW Nominee.**
81. Drenner, S., Sen, S., and Terveen, L. (2008). Crafting the Initial User Experience to Achieve Community Goals, in RecSys 2008. *30% acceptance rate.*
82. Reily, K., Ludford, P., and Terveen, L. (2008). Sharescape: An Interface for Place Annotation, in NordiCHI 2008. *30% acceptance rate.*
83. Nathan, M., Harrison, C., Yarosh, S., Terveen, L., Stead, L., and Amento, B. (2008), CollaboraTV: Making Television Viewing Social Again, in uxTV 2008.
84. Priedhorsky, R., Jordan, B., and Terveen, L. (2007), How a Personalized Geowiki Can Help Bicyclists Share Information More Effectively, in WikiSym 2007. *50% acceptance rate.*
85. Priedhorsky, R., Chen, J., Lam, A., Panciera, K., Terveen, L., and Riedl, J. (2007), Creating, Destroying, and Restoring Value in Wikipedia, in ACM Group 2007.
86. Rouben, A. and Terveen, L. (2007), Speech and Non-Speech Audio: Navigational Information and Cognitive Load, in International Conference on Auditory Displays (ICAD).
87. Ludford, P., Priedhorsky, R., Reily, K., and Terveen, L. (2007), Capturing, Sharing, and Using Local Place Information, in CHI 2007. *25% acceptance rate.*
88. Cosley, D., Frankowski, D., Terveen, L., and Riedl, J. (2007), SuggestBot: Using Intelligent Task Routing to Help People Find Work in Wikipedia, in IUI 2007. *22% acceptance rate.*
89. Harper, F.M., Frankowski, D., Drenner, S., Ren, Y., Kiesler, S., Terveen, L., Kraut, R., and Riedl, J. (2007), Talk Amongst Yourselves: Inviting Users To Participate In Online Conversations, in IUI 2007. *22% acceptance rate.*
90. Frankowski, D., Cosley, D., Sen, S., Terveen, L., and Riedl, J. You Are What You Say: Privacy Risks of Public Mentions, in SIGIR 2006. *19% acceptance rate.*
91. Ludford, P.J., Frankowski, D., Reily, K., Wilms, K., and Terveen, L., Because I Carry My Cell Phone Anyway: Functional Location-Based Reminder Applications, in *Proceedings of CHI 2006.* *23% acceptance rate.*

92. Cosley, D., Frankowski, D., Terveen, L., and Riedl, J., Using Intelligent Task Routing and Contribution Review to Help Communities Build Artifacts of Lasting Value, in *Proceedings of CHI 2006*. 23% acceptance rate.
93. Drenner, S., Harper, M., Frankowski, D., Riedl, J., and Terveen, L. Insert Movie Reference Here: A System to Bridge Conversation and Item-Oriented Web Sites, in *Proceedings of CHI 2006* (Tech Note).
94. Zhou, C., Ludford, P., Frankowski, D., and Terveen, L. How Do People's Concepts of Place Relate to Physical Locations? In *Proceedings of INTERACT 2005*. 27% acceptance rate.
95. D. Cosley, D. Frankowski, S. Kiesler, L. Terveen, J. Riedl. How Oversight Improves Member-Maintained Communities. In *Proceedings of CHI 2005*, Portland, OR, 2005. 25% acceptance rate.
96. Jones, Q., Grandhi, S., Whittaker, S., Chivakula, K., and Terveen, L. Putting Systems into Place: A Qualitative Study of Design Requirements for Location Aware Community Systems, in *Proceedings of CSCW 2004*. 30% acceptance rate.
97. Zhou, C., Ludford, P., Shekhar, S., and Terveen, L. Discovering Personal Gazetteers: An Interactive Clustering Approach, in *ACM GIS 2004* (12<sup>th</sup> International Symposium on Geographic Information Systems). 33% acceptance rate.
98. Ludford, P., Cosley, D., Frankowski, D., and Terveen, L.G. Think Different: Increasing Online Community Participation Using Uniqueness and Group Dissimilarity, in *Proceedings of CHI 2004*. 16% acceptance rate.
99. Cosley, D., Ludford, P. and Terveen, L.G. Studying the Effect of Similarity in Online Task-Focused Interactions, *Proceedings of GROUP 2003*. 35% acceptance rate.
100. Ludford, P. and Terveen, L.G. Does an Individual's Myers-Briggs Type Indicator Preference Influence Task-Oriented Technology Use?, *Proceedings of Interact 2003*. 34% acceptance rate.
101. Whittaker, S., Jones, Q., and Terveen, L.G. Contact Management: Identifying Contacts to Support Long-Term Communication, *Proceedings of CSCW 2002*, 216-225. 20% acceptance rate.
102. Terveen, L.G., McMackin, J., Amento, B., and Hill, W. Specifying Preferences Based On User History, *Proceedings of CHI 2002*, 315-322. 15% acceptance rate.
103. Whittaker, S., Jones, Q., and Terveen, L.G. Managing Long Term Conversations: Conversation and Contact Management, *Proceedings of HICSS 2002*. 50% acceptance rate.
104. Amento, B., Terveen, L., Hill, W., and Hix, D. TopicShop: Enhanced Support for Evaluating and Organizing Collections of Web Sites, *Proceedings of UIST 2000*. 26% acceptance rate.
105. #Amento, B., Terveen, L., and Hill, W. Does 'Authority' Mean Quality? Predicting Expert Quality Ratings of Web Documents, *Proceedings of SIGIR 2000*. 27% acceptance rate.
106. Amento, B., Hill, W., Terveen, L., Hix, D., and Ju, P. An Empirical Evaluation of User Interfaces for Topic Management of Web Sites, *Proceedings of CHI 1999*, 552-559. 25% acceptance rate.
107. Terveen, L.G and Hill, W.C. Evaluating Emergent Collaboration on the Web, *Proceedings of CSCW 1998*, 355-362. 19% acceptance rate.
108. Whittaker, S., Terveen, L.G, Hill, W.C., and Cherny, L. The Dynamics of Mass Interaction, *Proceedings of CSCW 1998*, 257-264. 19% acceptance rate.

109. Terveen, L.G and Hill, W.C. Finding and Visualizing Inter-site Clan Graphs, *Proceedings of CHI 1998*, 448-455. 23% acceptance rate.
110. Terveen, L.G and Hill, W.C. Involving Users in Continuous Design of Web Content, in *Proceedings of DIS 1997*, ACM Press, 137-145. 41% acceptance rate
111. Terveen, L.G., Hill, W.C., Amento, B., McDonald, D., and Creter, J. Building Task-Specific Interfaces to High Volume Conversational Data, *Proceedings of CHI 1997*, 226-233. 23% acceptance rate.
112. Hill, W.C. and Terveen, L.G Using Frequency-of-Mention in Public Conversations for Social Filtering, *Proceedings of CSCW 1996*, 106-112.
113. Terveen, L.G. and Murray, L. Helping Users Program Their Personal Agents, *Proceedings of CHI 1996*, 355-361. 23% acceptance rate.
114. Terveen, L.G. and Tuomenoksa, M.L. DynaDesigner: A Tool for Rapid Creation of Device-Independent, *Proceedings of INTERACT 1995*, 386-389.
115. Terveen, L.G. and Selfridge, P.G. Intelligent Assistance for Software Construction: A Case Study, *Proceedings of Knowledge-Based Software Engineering 1994*, 14-21.
116. Terveen, L.G., Selfridge, P.G., and Long, M.D. From 'Folklore' to 'Living Design Memory', in *Proceedings of INTERCHI 1993*, 15-22. 19% Acceptance Rate.
117. Terveen, L.G. Interface Support for Data Archaeology, *ISMM International Conference on Information and Knowledge Management (CIKM'93)*. (acceptance rate for 1992 unknown; average is 24%).
118. Brachman, R. J., Selfridge, P.G., Terveen, L.G., Altman, B., Borgida, A., Helper, F., Kirk, T., Lazar, A., McGuinness, D.L., and Resnick, L. A., Knowledge Representation Support for Data Archaeology, *ISMM International Conference on Information and Knowledge Management (CIKM'92)*. (acceptance rate for 1992 unknown; average is 24%).
119. Selfridge, P.G., Terveen, L.G., and Long, M.D. Managing Design Knowledge to Provide Assistance to Large-Scale Software Development, *Proceedings of Knowledge-Based Software Engineering 1992*, 154-162.
120. Terveen, L.G. and Wroblewski, D.A. A Tool for Achieving Consensus in Knowledge Editing, *Proceedings of AAAI 1991*, 74-79. 24% acceptance rate.
121. Terveen, L.G., Wroblewski, D.A., and Tighe, S.N. Intelligent Assistance Through Collaborative Manipulation, *Proceedings of IJCAI 1991*, 9-14. (acceptance rate for 1991 unknown; typically in low 20s).
122. Terveen, L.G. and Wroblewski, D.A. A Collaborative Interface for Browsing and Editing Large Knowledge Bases, *Proceedings of AAAI 1990*, 491-496. 18% acceptance rate.

## Book Chapters

123. Terveen, L., Riedl, J., Konstan, J., and Lampe, C. (2014) "Study, Build, Repeat: Using Online Communities as a Research Platform", in *Human Computer Interaction Ways of Knowing*, edited by Judith S. Olson and Wendy Kellogg, New York: Springer.
124. Amento, B., Harrison, C., Nathan, M., and Terveen, L. (2009), Asynchronous Communication – Fostering Social Interaction with CollaboraTV, in Cesar, P., Geerts, D., and Chorianopoulos, K. (ed.), *Social Interactive Television: Immersive Shared Experiences and Perspectives* (2009), Information Science Reference.
125. Amento, B., Terveen, L.G and Hill, W. From PHOAKS to TopicShop: Experiments in Social Data Mining, in Lueg, C. and Fisher, D. (ed.), *From Usenet to CoWebs: Interacting with Social Information Spaces* (2002), Springer.



126. Whittaker, S., Terveen, L.G, Hill, W.C., and Cherny, L. The Dynamics of Mass Interaction, in Lueg, C. and Fisher, D. (ed.), *From Usenet to CoWebs: Interacting with Social Information Spaces* (2002), (this chapter is a reprint of Whittaker et al 1998), Springer.
127. Terveen, L.G and Hill, W. Beyond Recommender Systems: Helping People Help Each Other, in Carroll, J. (ed.), *HCI in the New Millennium* (2001), Addison Wesley.
128. Terveen, L.G. Computer-Mediated Collaboration, in *More than Screen Deep: Toward Every-Citizen Interfaces to the Nation's Information Infrastructure* (1997), National Academy Press.

## Other Publications

129. Kaur, H., Johnson, I., Miller, H., Terveen, L., Lampe, C., Hecht, b., and Lasecki, W. Oh The Places You'll Share: An Affordances-Based Model of Social Media Posting Behaviors. In *Extended Abstracts of CHI 2017* (ACM Conference on Human Factors in Computing Systems). 40% acceptance rate.
130. Masli, M. and Terveen, L. Geographical Social Production: Lessons from Cyclopath, in CHI 2013 GeoHCI Workshop.
131. Masli, M., Bouman, L., Owen, A., and Terveen, L. Geowiki + route analysis = improved transportation planning, CSCW 2013 Interactive Poster.
132. Brady, S. S., Sieving, R. E., Terveen, L. G., Rosser, B. R. S., Kodet, A. J., & Rothberg, V. D. (2012, October). *TeensTalkHealth: An interactive website to promote healthy relationships and prevent STIs*. Paper presented at the annual meeting of the American Public Health Association, San Francisco, CA.
133. Society for Personality and Social Psychology, San Antonio, TX. January, 2011. "The role of community orientation in promoting online participation" (with J. S. Kim, P. C. Dwyer, J. Filson Moses, P. T. Fuglestad, C. A. Mannino, R Davies, & M. Snyder)
134. Society for Personality and Social Psychology, San Antonio, TX. January, 2011. "Applying a functional approach to participation in online groups" (with P. T. Fuglestad, P. C. Dwyer, J. Filson Moses, J. S. Kim, C. A. Mannino, R Davies, & M. Snyder)
135. Society for Personality and Social Psychology, San Antonio, TX. January, 2011. "Past volunteerism predicts amount of content contributed in an online community" (with P. C. Dwyer, J. Filson Moses, P. T. Fuglestad, J. S. Kim, C. A. Mannino, R Davies, & M. Snyder)
136. Society for Personality and Social Psychology, San Antonio, TX. January, 2011. "Social motives and personality as predictors of online participation" (with J. Filson Moses, P. C. Dwyer, P. T. Fuglestad, J. S. Kim, C. A. Mannino, R Davies, & M. Snyder)
137. Kapoor, N., Frankowski, D., Konstan, J., and Terveen, L. Lessons Learned in Implementing the CHIplace Online Community, in *Proceedings of Human-Computer Interaction International 2005*.
138. Zhou, C., Ludford, P., Frankowski, D., and Terveen, L. An Experiment in Exploring How People Describe Places, Short Paper in *Proceedings of Pervasive 2005*.
139. Zhou, C., Ludford, P., Frankowski, D., and Terveen, L. An Experiment in Discovering Personally Meaningful Places from Location Data, Short Paper in *Proceedings of CHI 2005*.
140. Kapoor, N., Konstan, J., and Terveen, L. How Peer Photos Influence Member Participation in Online Communities, Short Paper in *Proceedings of CHI 2005*.
141. Amento, B., Hill, W., and Terveen, L. The Sound of One Hand: A Wrist-mounted Bio-acoustic Fingertip Gesture Interface, Short Paper in *Proceedings of CHI 2002*, 724-725. 33% acceptance rate.

142. Terveen, L., Hill, W., and Amento, B. Collaborative Filtering to Locate, Comprehend, and Organize Collections of Websites, in SIGART Bulletin, 9, 3&4 (1998), 10-17.
143. Terveen, L., Hill, W., Amento, B., McDonald, D., and Creter, J. 1997. PHOAKS: a system for sharing recommendations. *Commun. ACM* 40, 3 (Mar. 1997), 59-62.
144. Terveen, L.G., Stolze, M., and Hill, W. From 'Model World' to 'Magic World', in *SIGCHI Bulletin*, 27, 4 (1995), 31-34.
145. Terveen, L.G., Papavero, E., and Tuomenoksa, M. DynaDesigner: A Tool for Rapid Design and Deployment of Device-Independent Interactive Services, Refereed Formal Demonstration in *Adjunct Proceedings of CHI'95*, 29-30.
146. Terveen, L.G. Person-Computer Cooperation through Collaborative Manipulation. Ph.D. Thesis, University of Texas Department of Computer Sciences, 1991.

## Invited Presentations

Carnegie Mellon University

Northwestern University

The University of California Irvine

Carleton College

Twin Cities MetroGIS Policy Board

Hennepin County Bicycle Advisory Committee

University of Minnesota Digital Humanities Collaborative

University of Minnesota Advanced Transportation Technologies Seminar Series

Georgia Tech

University of Minnesota Urban Ecosystems Symposium

University of Minnesota New Media

IBM T.J. Watson Research

University of Illinois

University of Maryland

University of Washington

Carnegie-Mellon University

Swedish Institute of Computer Science / Royal Institute of Technology

Uppsala University, Sweden

New Jersey Institute of Technology

Microsoft Research

Vassar University

Rensselaer Polytechnic Institute

University of Colorado

Virginia Tech

University of Nebraska

## ***Conference Presentations***

- ACM Conference on Computer-Supported Cooperative Work (CSCW), 2014.
- ACM Conference on Computer-Supported Cooperative Work (CSCW), 2012.
- ACM Conference on Computer-Supported Cooperative Work (CSCW), 2002.
- ACM Conference on Computer-Supported Cooperative Work (CSCW), 1998.
- ACM Conference on Human Factors in Computing Systems (CHI), 1998.
- ACM Conference on Design of Interactive Systems, 1997.
- ACM Conference on Human Factors in Computing Systems (CHI), 1997.
- ACM Conference on Human Factors in Computing Systems (CHI), 1996.
- IFIP TC13 International Conference on Human-Computer Interaction (INTERACT), 1995.
- IEEE Conference on Knowledge-Based Software Engineering, 1994.
- ACM Conference on Human Factors in Computing Systems (CHI), 1993.
- Conference on Information and Knowledge Management, 1993.
- Conference on Information and Knowledge Management, 1992.
- National Conference on Artificial Intelligence (AAAI), 1991.
- International Joint Conference on Artificial Intelligence (IJCAI), 1991.
- National Conference on Artificial Intelligence (AAAI), 1990.

## ***Workshop Presentations***

- CHI 2013 GeoHCI Workshop
  - “Geographical Social Production: Lessons from Cyclopath”
- CSCW 2002 Workshop on “The Role of Place in Shaping Virtual Communities”:
  - “Place-Based Community Information Systems”.
- CHI 99 Workshop on “Interacting with Recommender Systems”:
  - “Visualization Interfaces for Recommender Systems”.
- 1999 Human-Computer Interaction Consortium Workshop:
  - “A Reference Task Agenda for Human-Computer Interaction”.
- 1998 AAI Workshop on “Recommender Systems”:
  - “The PHOAKS Recommender System”.
- 1997 Human-Computer Interaction Consortium Workshop:
  - “The PHOAKS Recommender System”.
- 1995 Lifelike Computer Characters Workshop:
  - “Hidden Hands, not Talking Heads: The Magic World Interaction Paradigm”.
- 1995 Lifelike Computer Characters Workshop:
  - “Moving Agent-User Voice Dialogue towards Natural Conversation”.

- CHI 95 Workshop on “‘Model World’ to ‘Magic World’: Making Visual Objects the Medium for Intelligent Design Assistance”:
  - “The ‘Magic World’ Approach to Human-Computer Collaboration”.
- 1993 AAAI Fall Symposium: “Human-Computer Collaboration: Reconciling Theory, Synthesizing Practice”:
  - “A Framework for Human-Computer Collaboration”
- 1993 AI-ED Workshop on “Collaborative Problem Solving: Theoretical Frameworks and Innovative Systems”:
  - “Collaborative Problem Solving in Interactive Systems”.
- 1992 CAIA Workshop on “Applying AI To Software Problems: Assessing Promises and Pitfalls”:
  - “Representing and Disseminating Software Design Knowledge”.
- 1992 AAAI Spring Symposium on “Cognitive Aspects of Knowledge Acquisition”:
  - “In The Footprints of The Masters: Embedding Knowledge Acquisition in Organizational Activity”.
- AAAI 90 Workshop on “Complex Systems, Ethnomethodology, and Interaction Analysis”:
  - “Resources for Person-Computer Collaboration”.
- 1990 AAAI Spring Symposium on “Knowledge-Based Human-Computer Communication”:
  - “Tools for Human-Computer Collaboration”.

## **Patents**

U.S. Patent # 5,388,188. Apparatus and methods for providing design advice. (with P. Selfridge). Issued February 7, 1995.

U.S. Patent #5,659,724. Interactive data analysis apparatus employing a knowledge base. (with A. Borgida, R.J. Brachman, T. Kirk, and P. Selfridge). Issued August 19, 1997.

U.S. Patent #5,680,530. Graphical environment for interactively specifying a target system (with P. Selfridge). Issued October 21, 1997.

U.S. Patent #5,806,060. Interactive data analysis employing a knowledge base. (with A. Borgida, R.J. Brachman, T. Kirk, and P. Selfridge). Issued September 8, 1998.

U.S. Patent # 5,809,492. Apparatus and method for defining rules for personal agents. (with L. Murray). Issued September 15, 1998.

U.S. Patent # 5,953,393. Personal Telephone Agent. (With P. Culbreth, P. Danielsen, R.J. Hall, E. Papavero, and M. Tuomenoksa). Issued September 14, 1999.

U.S. Patent #6,029,192. System and method for locating resources on a network using resource evaluations derived from electronic messages. (with W.C. Hill). Issued February 22, 2000.

U.S. Patent #6,244,873. Wireless myoelectric control apparatus and methods. (with W.C. Hill, F.C. Pereira, and Y. Singer). Issued June 12, 2001.

U.S. Patent #6,256,648. System and method for selecting and displaying hyperlinked information resources. (with W.C. Hill). Issued July 3, 2001.

U.S. Patent #9,430,043. Bioacoustic Control System, Method, and Apparatus. (with B. Amento and W.C. Hill). Issued August 30, 2016.

## CONSULTING

This is my consulting record for the years 2016-2020. I have received compensation for the patent litigation cases listed below in the past 4 years. I provide details for the cases where my role has been disclosed publicly and general descriptions otherwise.

- Retained on behalf of a computer software and hardware company. General technology area: information processing, hypertext, inference. Writing expert reports.
- Retained on behalf of a computer software and hardware company. General technology area: graphical user interfaces. Writing expert reports.
- Retained by on behalf of a consumer electronics company. General technology area: graphical user interfaces. Writing expert reports.
- Retained by Erise IP on behalf Apple (2020)
  - Worked on *Inter Partes* review declaration
  - **Deposed: September 2020**
- Retained on behalf of a communications company. General technology area: interactive program guide systems. Writing expert reports.
- Retained on behalf of a computer and internet software company. General technology area: information search. Did not write expert reports.
- Retained by Erise IP on Behalf of Unified Patents, Inc. (2018)
  - Worked on *Inter Partes* review declaration
  - **Deposed: September 2019**
- Retained on behalf of a computer software and hardware company. General technology area: graphical user interfaces. Wrote expert reports.
- Retained by Klarquist Sparkman on behalf of LinkedIn (2018)
  - Worked on an *Inter Partes* review declaration
- Retained by Klarquist Sparkman on behalf of Microsoft (2017-2018)
  - Worked on multiple *Inter Partes* review declarations and a Post Grant Review declaration
- Microsoft Corporation and Microsoft Mobile, Inc. vs. Koninklijke Philips N.V.
  - Retained as expert on behalf of Microsoft by Perkins Coie (2017-2019)
  - PTAB Case No. IPR2018-00023
  - Wrote an *Inter Partes* Review declaration

- **Deposed: July 2018**
  - District Court Case
    - **Deposed: July 2019**
- Retained by Perkins-Coie on behalf of Microsoft (vs. Cypress Lake Software)
  - Wrote a Post Grant Review declaration
- Retained on behalf of a home entertainment company. General technology area: interactive program guide systems. Writing expert reports.

## **SERVICE**

### **University of Minnesota Committees**

- College of Science & Engineering Consultative Committee: 2015-2018
- College of Science & Engineering Honors & Awards Committee, 2017-2020

### **External Professional Activities**

#### ***ACM Special Interest Group on Computer Human Interaction***

- President: 2015-2018
- Executive Committee: Adjunct Chair for Awards, 2012 – 2015.
- Executive Committee: Vice President for Membership and Communication, 2009 – 2012.

#### ***Conference Chair***

- CHI 2002: ACM Conference on Human Factors in Computing Systems
- IUI 1998: ACM Conference on Intelligent User Interfaces.

#### ***Program Committee Chair***

- CSCW 2004: ACM Conference on Computer-Supported Cooperative Work.
- CSCW 2013: ACM Conference on Computer-Supported Cooperative Work.

#### ***Computer Supported Cooperative Work (CSCW) Steering Committee***

- Chair, 2012-2014 (First elected Chair of the committee that oversees the CSCW Conference and the general CSCW and Social Computing research community.)

#### ***Awards Committee Chair***

- CSCW 2008: ACM Conference on Computer-Supported Cooperative Work.

#### ***Journals Edited***

- Special Issue of *Knowledge-Based Systems* on Human-Computer Collaboration, Vol. 8, No. 2-3, 1995.

### ***Proceedings Edited***

- Proceedings of the 2002 ACM Conference on Human Factors in Computing Systems (CHI 2002).
- Proceedings of the 1998 ACM Conference on Intelligent User Interfaces (IUI 1998).

### ***Editorial Boards***

- Communications of the ACM, 2009-present.
- ACM Transactions on CHI, 2000-2006.
- Knowledge-Based Systems, 1993-present.
- ACM *intelligence*, 1998-2001.

### ***Program Committees***

- ACM Conference on Human Factors in Computing Systems (CHI): 1999-2004, 2006, 2016.
- ACM Conference on Computer-Supported Cooperative Work (CSCW): 2000, 2006, 2008, 2010, 2011, 2012, 2015.
- ACM Conference on Intelligent User Interfaces (IUI): 1997-2000, 2004.
- ACM Recommender Systems Conference: 2007, 2008, 2009, 2010, 2013.
- ACM GROUP Conference: 2007, 2009, 2010.
- ACM SIGIR Conference: 2008.
- AAI Conference on the Web and Social Media: 2011, 2012, 2016.
- User Modeling, Adaptation, and Personalization: 2011, 2016.
- NordiCHI 2008, 2010.
- Communities and Technology: 2009.
- Computer-Supported Cooperative Learning 2002.
- User Modeling: 2001.
- International Conference on Knowledge Capture 2001.
- Knowledge-Based Software Engineering (KBSE): 1994-1999.
- Intelligent Data Analysis: 1997.
- National Conference on Artificial Intelligence (AAAI): 1996-1997.
- IEEE Conference on Artificial Intelligence for Applications (CAIA): 1994.
- International Workshop on Privacy-Aware Location-based Mobile Services: 2007.
- SIGIR Workshop on Future Challenges in Expertise Retrieval: 2008.

### ***Other conference leadership positions***

- ACM Conference on Computer-Supported Cooperative Work Doctoral Consortium Co-Chair, 2016 and 2011.
- The 2<sup>nd</sup> AAI Conference on Human Computation and Crowdsourcing (HCOMP 2014)

Doctoral Consortium Co-Chair.

- International Symposium on Wikis and Open Collaboration Doctoral Symposium Chair, 2011.
- ACM Conference on Recommender Systems Doctoral Consortium, Co-Chair, 2007.
- International Joint Conference for Artificial Intelligence Doctoral Consortium, Co-Chair, 1997.
- American Association for Artificial Intelligence Doctoral Consortium, Co-Chair, 1997.
- American Association for Artificial Intelligence Doctoral Consortium, Co-Chair, 1996.

## ***Reviewer***

### **Journals**

- ACM Computing Surveys.
- IEEE Transactions on Data and Knowledge Engineering.
- IEEE Expert.
- Information Systems.
- International Journal of Human-Computer Studies.
- Journal of Computer-Supported Cooperative Work.

### **Conferences**

- Ninth IFIP International Conference on Human-Computer Interaction (INTERACT): 2003.
- ACM Conference on Human Factors in Computing Systems (CHI): 1995-1998.
- ACM Conference on Computer-Supported Cooperative Work (CSCW): 1998.
- ACM Symposium on User Interface Software and Technology (UIST): 1996.
- ISSM Conference on Information and Knowledge Management: 1993.

### ***National Science Foundations Panels***

Served on panels in 1996, 1998, 2001, 2003, 2005, 2010, 2012, 2013.

### ***Workshops Organized***

- ACM Wikis and Open Collaboration Doctoral Symposium, 2011.
- Social Computational Systems Community Workshop, 2011.
- ACM Computer Supported Cooperative Work Doctoral Consortium, 2011.
- International Conference on Ubiquitous Computing (UbiComp): “Multi-device Interfaces for Ubiquitous Peripheral Interaction”, 2003.
- ACM Conference on Human Factors in Computer Systems (CHI): “Interacting with Recommender Systems”, 1999.
- International Joint Conference for Artificial Intelligence Doctoral Consortium, 1997.



- American Association for Artificial Intelligence Doctoral Consortium, 1997.
- American Association for Artificial Intelligence Doctoral Consortium, 1996.
- ACM Conference on Human Factors in Computer Systems (CHI): “’Model World’ to ‘Magic World’: Making Visual Objects the Medium for Intelligent Design Assistance”, 1995.
- ACM Conference on Human Factors in Computer Systems (CHI): “New Uses and Abuses of Interaction History”, 1994.
- AAAI Fall Symposium: “Human-Computer Collaboration: Reconciling Theory, Synthesizing Practice”, 1993.
- World Conference on Artificial Intelligence and Education: “Collaborative Problem Solving: Theoretical Frameworks and Innovative Systems”, 1993.
- Conference on AI for Applications: “Applying AI To Software Problems: Assessing Promises and Pitfalls”, 1992.

### ***Other Professional Service***

- Member of SIGCHI Publications Board and Conference Management Committee, 2002-2004.
- ACM Special Interest Group on Artificial Intelligence Conference Chair (1995-1999); originated and co-organized Doctoral Consortia held in conjunction with AAAI and IJCAI.

### ***Internal Service***

- Associate Department Head, 2019-
- Chair, Department Head Search Committee, 2015.
- Chair, Strategic Planning Committee, 2013-2014.
- Chair, Social Computing Faculty Search Committee, 2013-2014.
- Curriculum Committee, 2012-2013.
- Chair, Strategic Planning Committee / Faculty Recruiting Committee, 2011-2012.
- Director of Graduate Studies: 2007-2010.
- Communications Committee: 2007
- Newsletter/Brochure Committee (chair): 2006-2007
- Research Opportunities Committee: 2005-2007
- Curriculum Committee: 2003-2005.
- Hosted Robert Kraut, Cray Colloquium speaker: October 2003.
- Participated in recruiting and admission activities.
- Information, Technology, and Everyday Life Initiative: Committee Member.

## TEACHING AND ADVISING

### *Ph.D. Students Advised*

- Dan Cosley (co-advised with John Riedl): completed PhD July 2006, currently an Associate Professor at Cornell University; on leave as Program Director at NSF.
- Pamela Ludford: completed PhD September 2007, currently an independent consultant.
- Reid Priedhorksy: completed PhD August 2010, currently a Postdoctoral Research Associate at Los Alamos National Laboratories.
- Mikhail Masli: completed PhD July 2013, currently employed at IBM.
- Aaron Halfaker (co-advised with John Riedl): completed PhD September 2013, currently employed at the Wikimedia Foundation.
- Katie Panciera: completed PhD August 2014; currently employed at Google.
- Fernando Torre: completed PhD September 2014; founder of a startup.
- Shuo (Steven) Chang: completed PhD August 2016; currently employed at Quora.
- Tien Nguyen (co-advised with Joe Konstan): completed PhD August 2016; currently employed at Pinterest.
- Morten Warncke-Wang (co-advised with Brent Hecht): completed PhD December 2016.
- Jacob Thebault-Spieker (co-advised with Brent Hecht): completed PhD December 2017; currently PostDoc at Virginia Tech.
- Hannah Miller (co-advised with Brent Hecht): completed PhD August 2018; currently Assistant Professor at University of Wisconsin Oshkosh.
- Vikas Kumar (entered program Fall 2011; co-advised with Joe Konstan).
- Andrew Hall: completed PhD August 2019; currently employed at 3M.
- Bowen Yu (entered program Fall 2014; co-advised with Haiyi Zhu).
- Zach Levonian (entered program Fall 2017; co-advised with Lana Yarosh).
- Charles Chuankai Zhang (entered program Fall 2019).
- Colleen Estelle Smith (entered program Fall 2016)
- Mohammed (Mo) Houtti (entered program Fall 2019)

### *M.S. Students Advised*

- Tyler Danielsen – received degree in 2016
- Jie Kang – received degree in 2016
- Zahra Eslami – received degree in 2015
- Yanjie Liu – received degree in 2013
- Renji Yu – received degree in 2012
- Carol Drysdale – received degree in 2011
- Jingwen Zhang – received degree in 2011

- Jisu Oh – received degree in 2010
- Sara Drenner – received degree in 2008
- Anna Rouben – received degree in 2006
- Arjun Sundararajan – received degree in 2006
- Pamela Ludford – received degree in 2005
- Rahul Akolkar – graduated May 2004

### ***Undergraduate Honors / Senior Thesis Students Advised***

- Avleen Kaur 2020
- Harmanprett Kaur, 2016
- Arlo Siemsen, 2014
- Johnathan Frenz, 2013
- David Pitchford - 2012
- Michael Ludwig - 2010
- Jordan Focht – 2010
- Kurt Wilms - 2005
- John Murphy – 2004

### ***Other Committees***

- Catherine Grevet, PhD.: member of preliminary and final examination committees (Georgia Tech).
- Loxley Wang, PhD: member of preliminary and final examination committees.
- Abigail Bakke, PhD: member of preliminary and final examination committees
- Tahir Sousa, MS: member of final examination committee
- Tony Lam, PhD: member of preliminary examination committee.
- Michael Janseen, PhD: member of preliminary examination committee.
- Haleh Hagh Shenan, PhD: member of preliminary & final examination committees.
- Julie Beilfuss, MS: member of final examination committee.
- Liv Knatterud, MS: member of final examination committee.
- Sean McNee, MS: member of final examination committee.
- Shankar Subrahmanian, MS: member of final examination committee.
- Vamsee Venuturumilli, MS: member of final examination committee.
- Eric Gilbert, Ph.D. Preliminary and Final Examination Committees (UIUC, 2009/2010): member of thesis committee.
- Yi (Jenny) Zhang, Ph.D. (New Jersey Institute of Technology, 2004): member of thesis committee.

- Brian Amento, Ph.D. (Virginia Tech, 2001): member of thesis committee.
- David McDonald, Ph.D. (UC Irvine, 2000): member of thesis committee.

### ***Courses taught***

Semester	Course
Fall 2016	CSCI 5115: User Interface Design, Implementation, and Evaluation
Spring 2016	CSCI 5125: Collaborative and Social Computing
Fall 2015	CSCI 1133H: Introduction to Computer Science (Honors) CSCI 8115: Human-Computer Interaction and UI Technology
Spring 2015	CSCI 5125: Collaborative and Social Computing
Fall 2014	CSCI 5115: User Interface Design, Implementation, and Evaluation HSEM 2519H: Honors Seminar on Crowdsourcing
Spring 2014	CSCI 8115: Human-Computer Interaction and UI Technology
Fall 2013	CSCI 1901H: Introduction to Computer Science (Honors) CSCI 5115: User Interface Design, Implementation, and Evaluation
Spring 2013	CSCI 5125: Collaborative and Social Computing SEng 5115: User Interface Design and Evaluation
Fall 2012	CSCI 5115: User Interface Design, Implementation, and Evaluation
Spring 2012	CSCI 8115: Human-Computer Interaction and UI Technology SEng 5115: User Interface Design and Evaluation
Fall 2011	CSCI 1902: Structure of Computer Programming II CSCI 5115: User Interface Design, Implementation, and Evaluation
Spring 2011	CSCI 5125: Collaborative and Social Computing SEng 5115: User Interface Design and Evaluation
Fall 2010	CSCI 5115: User Interface Design, Implementation, and Evaluation
Spring 2010	CSCI 8115: Human-Computer Interaction and UI Technology
Fall 2009	CSCI 5115: User Interface Design, Implementation, and Evaluation
Spring 2009	CSCI 5125: Collaborative and Social Computing SEng 5115: User Interface Design and Evaluation
Fall 2008	CSCI 5115: User Interface Design, Implementation, and Evaluation
Spring 2008	CSCI 1902: Structure of Computer Programming II SEng 5115: User Interface Design and Evaluation
Fall 2007	CSCI 5115: User Interface Design, Implementation, and Evaluation
Spring 2007	SEng 5115: User Interface Design and Evaluation
Spring 2007	CSCI 5125: Collaborative and Social Computing
Fall 2006	CSCI 1902: Structure of Computer Programming II CSCI 5115: User Interface Design, Implementation, and Evaluation
Spring 2006	CSCI 8115: Human-Computer Interaction and UI Technology
Fall 2005	CSCI 1902: Structure of Computer Programming II
Spring 2005	CSCI 5116: GUI Toolkits and Their Implementation

Fall 2004 CSCI 5115: User Interface Design, Implementation, and Evaluation  
Spring 2004 CSCI 5980: Collaborative Computing  
Fall 2003 CSCI 5115: User Interface Design, Implementation, and Evaluation  
Spring 2003 CSCI 5116: GUI Toolkits and Their Implementation  
Fall 2002 CS 8115: Human-Computer Interaction and UI Technology

### ***Tutorials***

“Intelligent User Interfaces: Issues, Approaches, Evaluation”, offered at 1993 Conference on Artificial Intelligence for Applications.

## Electronic Acknowledgement Receipt

<b>EFS ID:</b>	42892937
<b>Application Number:</b>	90014507
<b>International Application Number:</b>	
<b>Confirmation Number:</b>	6188
<b>Title of Invention:</b>	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS
<b>First Named Inventor/Applicant Name:</b>	8213970
<b>Customer Number:</b>	172615
<b>Filer:</b>	Jialin Zhong/Eddie Rowell
<b>Filer Authorized By:</b>	Jialin Zhong
<b>Attorney Docket Number:</b>	2525.993REX0
<b>Receipt Date:</b>	03-JUN-2021
<b>Filing Date:</b>	15-MAY-2020
<b>Time Stamp:</b>	16:49:22
<b>Application Type:</b>	Reexam (Patent Owner)

### Payment information:

Submitted with Payment	no
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### File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1		2021-06-03_AGIS_Response_to _Final_Rejection_re_970_Paten t.pdf	110959  8421763f6929dfef230595568ced87a490fe 3bab	yes	23

Multipart Description/PDF files in .zip description					
Document Description			Start	End	
Amendment/Req. Reconsideration-After Non-Final Reject			1	1	
Claims			2	7	
Applicant Arguments/Remarks Made in an Amendment			8	23	
<b>Warnings:</b>					
<b>Information:</b>					
2	Reexam Miscellaneous Incoming Letter	90-014507_Transmittal_Letter.pdf	18161	no	1
			b1a88d26efe281af304092f195cc07f3c26944aa		
<b>Warnings:</b>					
<b>Information:</b>					
3	Reexam Certificate of Service	90-014507_Certificate_of_Service.pdf	25118	no	2
			cd0648fcbcf6b83b513bb1641ee6c6891e104343		
<b>Warnings:</b>					
<b>Information:</b>					
4	Oath or Declaration filed	2021-06-03_FINAL_Terveen_Dec_re_Reexam_of_970_Patent_210603_063707_signed.pdf	767991	no	44
			6d79e63c941f674e8c5f403cc05f09f985736e54		
<b>Warnings:</b>					
<b>Information:</b>					
<b>Total Files Size (in bytes):</b>			922229		



**This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.**

**New Applications Under 35 U.S.C. 111**

**If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.**

**National Stage of an International Application under 35 U.S.C. 371**

**If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.**

**New International Application Filed with the USPTO as a Receiving Office**

**If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.**

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>PATENT APPLICATION FEE DETERMINATION RECORD</b> Substitute for Form PTO-875	Application or Docket Number 90/014,507	Filing Date 05/15/2020	<input type="checkbox"/> To be Mailed
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ENTITY:  LARGE  SMALL  MICRO

**APPLICATION AS FILED - PART I**

FOR	(Column 1) NUMBER FILED	(Column 2) NUMBER EXTRA	RATE (\$)	FEE (\$)
<input type="checkbox"/> BASIC FEE (37 CFR 1.16(a), (b), or (c))	N/A	N/A	N/A	
<input type="checkbox"/> SEARCH FEE (37 CFR 1.16(k), (i), or (m))	N/A	N/A	N/A	
<input type="checkbox"/> EXAMINATION FEE (37 CFR 1.16(o), (p), or (q))	N/A	N/A	N/A	
TOTAL CLAIMS (37 CFR 1.16(i))	15 minus 20 =	* 0	x \$100 =	0
INDEPENDENT CLAIMS (37 CFR 1.16(h))	3 minus 3 =	* 0	x \$460 =	0
<input type="checkbox"/> APPLICATION SIZE FEE (37 CFR 1.16(s))	If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$310 (\$155 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).			
<input type="checkbox"/> MULTIPLE DEPENDENT CLAIM PRESENT (37 CFR 1.16(j))				
* If the difference in column 1 is less than zero, enter "0" in column 2.			TOTAL	0

**APPLICATION AS AMENDED - PART II**

	(Column 1)		(Column 2)	(Column 3)	RATE (\$)	ADDITIONAL FEE (\$)
<b>AMENDMENT</b>	06/03/2021		CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	
	Total (37 CFR 1.16(i))	*	15	Minus	**	20
	Independent (37 CFR 1.16(h))	*	3	Minus	***	3
	<input type="checkbox"/> Application Size Fee (37 CFR 1.16(s))					
<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))						
					TOTAL ADD'L FEE	0

	(Column 1)		(Column 2)	(Column 3)	RATE (\$)	ADDITIONAL FEE (\$)
<b>AMENDMENT</b>			CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	
	Total (37 CFR 1.16(i))	*		Minus	**	=
	Independent (37 CFR 1.16(h))	*		Minus	***	=
	<input type="checkbox"/> Application Size Fee (37 CFR 1.16(s))					
<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))						
					TOTAL ADD'L FEE	

\* If the entry in column 1 is less than the entry in column 2, write "0" in column 3. LIE

\*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20". /RHONDA BELL/

\*\*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3".

The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.

This collection of information is required by 37 CFR 1.16. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*



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P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Table with columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO., EXAMINER, ART UNIT, PAPER NUMBER, MAIL DATE, DELIVERY MODE. Includes application details for 90/014,507 and 172615 7590.

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)

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
1100 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

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

REEXAMINATION CONTROL NO. 90/014,507.

PATENT UNDER REEXAMINATION 8213970.

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)).

<b><i>Ex Parte Reexamination Interview Summary</i></b>	<b>Control No.</b> 90/014,507	<b>Patent Under Reexamination</b> 8213970	
	<b>Examiner</b> ERIC B KISS	<b>Art Unit</b> 3992	<b>AIA (FITF) Status</b> No

All participants (USPTO personnel, patent owner, patent owner's representative):

- |   |   |
|---|---|
| (1) <u>ERIC KISS</u>                    | (3) <u>Jialin Zhong, Vincent Rubino</u> |
| (2) <u>Nick Corsaro, Andrew Fischer</u> | (4) <u>Enrique Iturralde</u>            |

Date of Interview: 17 May 2021

Type: a)  Telephonic    b)  Video Conference  
c)  Personal (copy given to: 1)  patent owner    2)  patent owners representative)

Exhibit shown or demonstration conducted: d)  Yes    e)  No.  
If Yes, brief description: \_\_\_\_\_

Agreement with respect to the claims f)  was reached. g)  was not reached. h)  N/A.  
Any other agreement(s) are set forth below under "Description of the general nature of what was agreed to..."

Claim(s) discussed: 2 .

Identification of prior art discussed: Kubala, Hammond .

Description of the general nature of what was agreed to if an agreement was reached, or any other comments:  
See Continuation Sheet .

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims patentable, if available, must be attached. Also, where no copy of the amendments that would render the claims patentable is available, a summary thereof must be attached.)

A FORMAL WRITTEN RESPONSE TO THE LAST OFFICE ACTION MUST INCLUDE PATENT OWNER'S STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. (See MPEP § 2281). IF A RESPONSE TO THE LAST OFFICE ACTION HAS ALREADY BEEN FILED, THEN PATENT OWNER IS GIVEN **ONE MONTH** FROM THIS INTERVIEW DATE TO PROVIDE THE MANDATORY STATEMENT OF THE SUBSTANCE OF THE INTERVIEW (37 CFR 1.560(b)). THE REQUIREMENT FOR PATENT OWNERS STATEMENT CAN NOT BE WAIVED. **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

/Eric B. Kiss/ Patent Reexamination Specialist, Art Unit 3992		
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cc: Requester (if third party requester)

Continuation of Description of the general nature of what was agreed to if an agreement was reached, or any other comments: In addition to claim 2, the parties discussed proposed new claims 14-16 (see attached agenda).

Parties discussed the "means for controlling of the recipient PDA/cell phone . . ." feature of claim 2. Patent Owner's representatives contended that this limitation required more than merely taking control of an email program, for example, because a user could hypothetically close the email program or use different software applications on the controlled device. The examiners stressed that the system claims must be structurally different from the prior art and requested clarification as to the specific structure corresponding to the claimed "means for controlling of the recipient PDA/cell phone". Patent Owner's representatives explained that the means described in the specification is software, and the examiners requested that the Patent Owner clarify in its response the specific algorithm within the patent disclosure that corresponds to the claimed feature. Similarly, with regard to proposed new claims 14 and 15, the examiners requested that Patent Owner specifically point out the corresponding structures for the claimed means, and to the extent that any of the means are software, to point to the specific algorithms disclosed in the patent.

With regard to proposed new claims 15 and 16, Patent Owner's representatives indicated that the corresponding disclosure is found in the '728 patent, incorporated by reference into the '970 patent disclosure. The examiners requested that Patent Owner demonstrate in its response that such an incorporation is legally proper to support the proposed claims.

## EXAMINER INTERVIEW AGENDA

**App. No.:** 90/014,507

**Title:** Method of utilizing forced alerts for interactive remote communications

**Examiners:** Eric B. Kiss, Nick Corsaro, Andrew J. Fischer

**Time:** 15:00 – 16:00 PM, May 17, 2021

**Communication:** TBD by Examiners

**Patent Owner's Representatives:** Jialin Zhong, Vincent Rubino, Enrique Iturralde

### Relevant Issues:

1. Claims 2 and 10-13 are rejected as unpatentable over Kubala and Hammond.
2. Claims 2 and 10-13 are rejected as unpatentable over Hammond, Johnson, and Pepe.

### Agenda: to discuss:

1. the feature of “means for controlling of the recipient PDA/cell phone . . .” recited in claim 2 in view of Kubala and Hammond and in view of Hammond, Johnson, and Pepe, and
2. proposed new claims 14-16.

### New claims 14-16:

14. (New) The system as in claim 2, further comprising means for releasing control of the recipient PDA/cell phone after selection of the response to the sender PDA/cell phone.
15. (New) The system as in claim 2, further comprising:
  - means for displaying a geographical map with georeferenced entities on the display of the sender PDA/cell phone;
  - means for obtaining location and status data associated with the recipient PDA/cell phone; and
  - means for presenting a recipient symbol on the geographical map corresponding to a correct geographical location of the recipient PDA/cell phone.
16. (New) The method as in claim 10, further comprising:
  - displaying a geographical map with georeferenced entities on the display of the sender PDA/cellphone;
  - obtaining location and status data associated with the recipient PDA/cellphone; and
  - presenting a recipient symbol on the geographical map corresponding to a correct geographical location of the recipient PDA/cellphone based on at least the location data.

Date: May 13, 2021

/Jialin Zhong/  
\_\_\_\_\_  
Jialin Zhong  
Reg. No.: 62,937



# United States Patent and Trademark Office

*Office of the Chief Financial Officer*

Document Code:WFEE

User :C46167

Sale Accounting Date:04/16/2021

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Sale Item Reference Number	Effective Date
90014507	04/15/2021

Document Number	Fee Code	Fee Code Description	Amount Paid	Payment Method
I20214FA16023161	1251	EXTENSION FOR RESPONSE WITHIN 1ST MONTH	\$220.00	Deposit Account





Dated: April 12, 2021

Respectfully submitted,  
**FABRICANT LLP**

FABRICANT LLP  
230 Park Ave, 3<sup>rd</sup> Fl. W.  
New York, NY 10169  
Tel: 212-257-5797  
Fax: 212-257-5796

/Peter Lambrianakos/  
Peter Lambrianakos, Reg. No. 58,279  
Attorney for Patent Owner  
Email: plambrianakos@fabricantllp.com



in connection with the same, including determining whether an Examiner interview would be prudent given the nature and content of the Office Action.

3. The COVID-19 pandemic has significantly affected Patent Owner's ability to prepare its response to the Office Action.
4. Due to the COVID-19 pandemic, Patent Owner's offices have been closed and its operations have been significantly delayed because of the shift to remote work.
5. Patent Owner AGIS is a Texas company. Inventor Malcom K. Beyer, Jr. resides in Florida.
6. Restrictive measures imposed to contain the COVID-19 virus have substantially affected the work activities of AGIS personnel and the named inventor who is all located remotely and who is unable to convene in-person. These restrictive measures are necessary to ensure the safety of Patent Owner's personnel, including Mr. Beyer.
7. Due to the COVID-19 pandemic, Patent Owner and its counsel have experienced significant delays in preparing a response to the Office Action.
8. Patent Owner is currently working with its counsel to retain an expert witness for the preparation and submission of an expert declaration in the '970 Reexam. Patent Owner's efforts to retain an expert have been significantly delayed by the COVID-19 pandemic and the related travel restrictions.

#### **LEGAL AUTHORITY**

37 C.F.R. 1.550 provides, in relevant part:

- (c) The time for taking any action by a patent owner in an ex parte reexamination proceeding may be extended as provided in this paragraph.

- (1) Any request for such an extension must specify the requested period of extension and be accompanied by the petition fee set forth in § 1.17(g).
- (2) Any request for an extension in a third party requested ex parte reexamination must be filed on or before the day on which action by the patent owner is due, and the mere filing of such a request for extension will not effect the extension. A request for an extension in a third party requested ex parte reexamination will not be granted in the absence of sufficient cause or for more than a reasonable time.
- (3) Any request for an extension in a patent owner requested or Director ordered ex parte reexamination for up to two months from the time period set in the Office action must be filed no later than two months from the expiration of the time period set in the Office action. A request for an extension in a patent owner requested or Director ordered ex parte reexamination for more than two months from the time period set in the Office action must be filed on or before the day on which action by the patent owner is due, and the mere filing of a request for an extension for more than two months from the time period set in the Office action will not effect the extension. The time for taking action in a patent owner requested or Director ordered ex parte reexamination will not be extended for more than two months from the time period set in the Office action

in the absence of sufficient cause or for more than a reasonable time.

MPEP 2265 provides in relevant part:

Requests for any extension of time in third party requested reexaminations, and requests for an extension of more than two months from the time period set in the Office action in patent owner requested or Director ordered reexaminations, must include a showing of sufficient cause, and the extension must be for a reasonable time.

Any evaluation of whether sufficient cause has been shown for an extension must balance the need to provide the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. 305) that the proceeding be conducted with special dispatch.

Any request for an extension of time, except for the "no cause" extension in patent owner requested or Director ordered reexamination provided in 37 CFR 1.550(c), must fully state the reasons therefor. The reasons must include a statement of what action the patent owner has taken to provide a response as of the date the request for extension is submitted, and why, in spite of the action taken thus far, the requested additional time is needed. The

statement must include a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.

...

However, in third party requested ex parte reexaminations, a first request for an extension of time will generally be granted if a sufficient cause is shown, and for a reasonable time specified — usually one month. The reasons stated in the request will be evaluated by the CRU SPRS or TC Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period. Second or subsequent requests for an extension of time and requests for an extension of more than one month in third party requested reexaminations will only be granted in extraordinary situations.

#### **DISCUSSION**

In support of this Petition, Patent Owner states as follows:

Despite Patent Owner's substantial efforts and resources devoted to this reexamination, the one-month period for filing a response to the Non-final Office Action in the '970 Reexam is unduly burdensome. Without a one-month extension of time, which is warranted during the extraordinary situation arising from the COVID-19 pandemic, Patent Owner will be significantly prejudiced.

Patent Owner requires the one-month extension to overcome substantial delays resulting from the COVID-19 pandemic. Because of the COVID-19 pandemic, Patent Owner's efforts to retain an expert for the preparation and submission of an expert declaration in the '970 Reexam have been significantly delayed by the COVID-19 pandemic. Additionally, the COVID-19 pandemic has significantly affected Patent Owner's ability to prepare its response to the Office Action. Due to the COVID-19 pandemic, Patent Owner's offices have been closed and its operations have been significantly delayed because of the shift to remote work. Patent Owner AGIS is a Texas company. Inventor Malcom K. Beyer, Jr. resides in Florida. Restrictive measures imposed to contain the COVID-19 virus have substantially affected the work activities of AGIS personnel and the named inventor who is all located remotely and who is unable to convene in-person. These restrictive measures are necessary to ensure the safety of Patent Owner's personnel, including Mr. Beyer. Due to the COVID-19 pandemic, Patent Owner and its counsel have experienced significant delays in preparing a response to the Office Action. Patent Owner is currently working with its counsel to retain an expert witness for the preparation and submission of an expert declaration in the '970 Reexam. Patent Owner's efforts to retain an expert have been significantly delayed by the COVID-19 pandemic and the related travel restrictions.

Given the need for input from AGIS personnel and the inventor located across the country and given the need to retain an expert witness, Patent Owner respectfully requests a one-month extension of time to allow Patent Owner to coordinate schedules and receive such input and to allow the expert witness to review all pertinent materials and prepare his expert declaration. The current two-month time period to prepare this response is insufficient due to the conflicting schedules and remote locations of all parties involved.



Patent Owner respectfully submits that, with the one-month extension, the proceedings will proceed with “special dispatch” under 35 U.S.C. 305, while providing the Patent Owner with a fair opportunity to present argument against the challenges to its patents. A one-month extension in this reexamination would provide a due date of June 3, 2021.

### **CONCLUSION**

Given the foregoing, Patent Owner believes that this extraordinary situation warrants additional time needed to respond to the grounds of rejection in the Non-final Office Action. Because of substantial delays arising from the COVID-19 pandemic, Patent Owner respectfully requests a one-month extension of time to file its response to the Office Action mailed on March 3, 2021 in the '970 Reexam. The requested extension would Office Action would extend the current due date of May 3, 2021 to June 3, 2021.

The Commissioner is further authorized to deduct any underpayment of fees or any<sup>2</sup> additional fees required in connection with the filing of this paper from Deposit Account No. 603614.

Dated: April 12, 2021

Respectfully submitted,  
**FABRICANT LLP**

**FABRICANT LLP**  
230 Park Ave, 3<sup>rd</sup> Fl. W.  
New York, NY 10169  
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/Peter Lambrianakos/  
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Table with columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO., EXAMINER, ART UNIT, PAPER NUMBER, MAIL DATE, DELIVERY MODE. Includes application details for Fabricant LLP and examiner KISS, ERIC B.

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.



THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

Date: April 14, 2021

STERNE, KESSLER, GOLDSTEIN & FOX PLLC  
1100 NEW YORK AVENUE , NW  
WASHINGTON, DC 20005

**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. : 90014507

PATENT NO. : 8213970

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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<b>Decision on Petition for Extension of Time in Reexamination</b>	Application No. 90/014,507	Applicant(s) 8,213,970 B2
	Examiner Eric B. KISS	Art Unit 3992

1. THIS IS A DECISION ON THE PETITION FILED April 12, 2021 with Certificate of Service on April 13, 2021.
2. THIS DECISION IS ISSUED PURSUANT TO:
- A.  37 CFR 1.550(c) – The time for taking any action by a patent owner in a third party requested *ex parte* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- B.  37 CFR 1.550(c) – The time for taking action by a patent owner in a patent owner requested *ex parte* reexamination proceeding will only be extended for more than two months for sufficient cause and for a reasonable time specified.
- C.  37 CFR 1.956 – The time for taking any action by a patent owner in an *inter partes* reexamination proceeding will be extended only for sufficient cause and for a reasonable time specified.
- The petition is before the Central Reexamination Unit for consideration.
3. FORMAL MATTERS  
Patent Owner requests that the period for filing a response to the Non-Final Office action mailed March 3, 2021, which set a two (2) month period to file a response (i.e., response due May 3, 2021), be extended by an additional one (1) month (i.e., response due June 3, 2021).
- A. Petition fee per 37 CFR §1.17(g):
- i.  Petition includes authorization to debit a deposit account.
- ii.  Petition includes authorization to charge a credit card account.
- iii.  Other: \_\_\_\_\_.
- B.  Proper certificate of service was provided. (Not required in reexamination where patent owner is requester.)
- C.  Petition was timely filed.
- D.  Petition properly signed.
4. DECISION (See MPEP 2265 and 2665)
- A.  Granted or  Granted-in-part for one (1) month. (See 37 CFR 1.550(c) and 37 CFR 1.956).
- i.  Other/comment: See CONCLUSION below.
- B.  Dismissed because:
- i.  Formal matters (See unchecked box(es) (A, B, C and/or D) in section 4 above).
- ii.  Petitioner failed to provide a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.
- iii.  Petitioner failed to explain why, in spite of the action taken thus far, the requested additional time is needed.
- iv.  The statements provided fail to establish sufficient cause to warrant extension of the time for taking action (See attached).
- v.  The petition is moot.
- vi.  Other/comment: \_\_\_\_\_
5. CONCLUSION: **Patent Owner's April 12, 2021 "PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.550(c)" is hereby granted for "sufficient cause" for one (1) additional month. Accordingly, the response time period is extended from May 3, 2021 to June 3, 2021 and the response to the March 3, 2021 Non-Final Office action is now due by the end of the day on Thursday, June 3, 2021.**

Telephone inquiries with regard to this decision should be directed to Gay Ann Spahn at 571-272-7731 in the CRU.

/Gay Ann Spahn/  
Supervisory Patent Reexamination Specialist  
Central Reexamination Unit



Dated: April 13, 2021

Respectfully submitted,  
**FABRICANT LLP**

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/Peter Lambrianakos/  
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## Electronic Acknowledgement Receipt

<b>EFS ID:</b>	42439075
<b>Application Number:</b>	90014507
<b>International Application Number:</b>	
<b>Confirmation Number:</b>	6188
<b>Title of Invention:</b>	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS
<b>First Named Inventor/Applicant Name:</b>	8213970
<b>Customer Number:</b>	172615
<b>Filer:</b>	Peter Lambrianakos/Eddie Rowell
<b>Filer Authorized By:</b>	Peter Lambrianakos
<b>Attorney Docket Number:</b>	2525.993REX0
<b>Receipt Date:</b>	13-APR-2021
<b>Filing Date:</b>	15-MAY-2020
<b>Time Stamp:</b>	13:01:02
<b>Application Type:</b>	Reexam (Patent Owner)

### Payment information:

Submitted with Payment	no
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### File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Reexam Certificate of Service	90-014507_Certificate_of_Servi ce.pdf	161283  7c21330e6b325770e94eb832059b8d1f99a ba0d1	no	2

### Warnings:

<b>Information:</b>	
<b>Total Files Size (in bytes):</b>	161283
<p><b>This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.</b></p> <p><b><u>New Applications Under 35 U.S.C. 111</u></b>  <b>If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.</b></p> <p><b><u>National Stage of an International Application under 35 U.S.C. 371</u></b>  <b>If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.</b></p> <p><b><u>New International Application Filed with the USPTO as a Receiving Office</u></b>  <b>If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.</b></p>	





in connection with the same, including determining whether an Examiner interview would be prudent given the nature and content of the Office Action.

3. The COVID-19 pandemic has significantly affected Patent Owner's ability to prepare its response to the Office Action.
4. Due to the COVID-19 pandemic, Patent Owner's offices have been closed and its operations have been significantly delayed because of the shift to remote work.
5. Patent Owner AGIS is a Texas company. Inventor Malcom K. Beyer, Jr. resides in Florida.
6. Restrictive measures imposed to contain the COVID-19 virus have substantially affected the work activities of AGIS personnel and the named inventor who is all located remotely and who is unable to convene in-person. These restrictive measures are necessary to ensure the safety of Patent Owner's personnel, including Mr. Beyer.
7. Due to the COVID-19 pandemic, Patent Owner and its counsel have experienced significant delays in preparing a response to the Office Action.
8. Patent Owner is currently working with its counsel to retain an expert witness for the preparation and submission of an expert declaration in the '970 Reexam. Patent Owner's efforts to retain an expert have been significantly delayed by the COVID-19 pandemic and the related travel restrictions.

#### **LEGAL AUTHORITY**

37 C.F.R. 1.550 provides, in relevant part:

(c) The time for taking any action by a patent owner in an ex parte reexamination proceeding may be extended as provided in this paragraph.

(1) Any request for such an extension must specify the requested period of extension and be accompanied by the petition fee set forth in § 1.17(g).

(2) Any request for an extension in a third party requested ex parte reexamination must be filed on or before the day on which action by the patent owner is due, and the mere filing of such a request for extension will not effect the extension. A request for an extension in a third party requested ex parte reexamination will not be granted in the absence of sufficient cause or for more than a reasonable time.

(3) Any request for an extension in a patent owner requested or Director ordered ex parte reexamination for up to two months from the time period set in the Office action must be filed no later than two months from the expiration of the time period set in the Office action. A request for an extension in a patent owner requested or Director ordered ex parte reexamination for more than two months from the time period set in the Office action must be filed on or before the day on which action by the patent owner is due, and the mere filing of a request for an extension for more than two months from the time period set in the Office action will not effect the extension. The time for taking action in a patent owner requested or Director ordered ex parte reexamination will not be extended for more than two months from the time period set in the Office action

in the absence of sufficient cause or for more than a reasonable time.

MPEP 2265 provides in relevant part:

Requests for any extension of time in third party requested reexaminations, and requests for an extension of more than two months from the time period set in the Office action in patent owner requested or Director ordered reexaminations, must include a showing of sufficient cause, and the extension must be for a reasonable time.

Any evaluation of whether sufficient cause has been shown for an extension must balance the need to provide the patent owner with a fair opportunity to present an argument against any attack on the patent, and the requirement of the statute (35 U.S.C. 305) that the proceeding be conducted with special dispatch.

Any request for an extension of time, except for the "no cause" extension in patent owner requested or Director ordered reexamination provided in 37 CFR 1.550(c), must fully state the reasons therefor. The reasons must include a statement of what action the patent owner has taken to provide a response as of the date the request for extension is submitted, and why, in spite of the action taken thus far, the requested additional time is needed. The

statement must include a factual accounting of reasonably diligent behavior by all those responsible for preparing a response to the outstanding Office action within the statutory time period.

...

However, in third party requested ex parte reexaminations, a first request for an extension of time will generally be granted if a sufficient cause is shown, and for a reasonable time specified — usually one month. The reasons stated in the request will be evaluated by the CRU SPRS or TC Director, and the requests will be favorably considered where there is a factual accounting of reasonably diligent behavior by all those responsible for preparing a response within the statutory time period. Second or subsequent requests for an extension of time and requests for an extension of more than one month in third party requested reexaminations will only be granted in extraordinary situations.

### **DISCUSSION**

In support of this Petition, Patent Owner states as follows:

Despite Patent Owner's substantial efforts and resources devoted to this reexamination, the one-month period for filing a response to the Non-final Office Action in the '970 Reexam is unduly burdensome. Without a one-month extension of time, which is warranted during the extraordinary situation arising from the COVID-19 pandemic, Patent Owner will be significantly prejudiced.

Patent Owner requires the one-month extension to overcome substantial delays resulting from the COVID-19 pandemic. Because of the COVID-19 pandemic, Patent Owner's efforts to retain an expert for the preparation and submission of an expert declaration in the '970 Reexam have been significantly delayed by the COVID-19 pandemic. Additionally, the COVID-19 pandemic has significantly affected Patent Owner's ability to prepare its response to the Office Action. Due to the COVID-19 pandemic, Patent Owner's offices have been closed and its operations have been significantly delayed because of the shift to remote work. Patent Owner AGIS is a Texas company. Inventor Malcom K. Beyer, Jr. resides in Florida. Restrictive measures imposed to contain the COVID-19 virus have substantially affected the work activities of AGIS personnel and the named inventor who is all located remotely and who is unable to convene in-person. These restrictive measures are necessary to ensure the safety of Patent Owner's personnel, including Mr. Beyer. Due to the COVID-19 pandemic, Patent Owner and its counsel have experienced significant delays in preparing a response to the Office Action. Patent Owner is currently working with its counsel to retain an expert witness for the preparation and submission of an expert declaration in the '970 Reexam. Patent Owner's efforts to retain an expert have been significantly delayed by the COVID-19 pandemic and the related travel restrictions.

Given the need for input from AGIS personnel and the inventor located across the country and given the need to retain an expert witness, Patent Owner respectfully requests a one-month extension of time to allow Patent Owner to coordinate schedules and receive such input and to allow the expert witness to review all pertinent materials and prepare his expert declaration. The current two-month time period to prepare this response is insufficient due to the conflicting schedules and remote locations of all parties involved.

Patent Owner respectfully submits that, with the one-month extension, the proceedings will proceed with “special dispatch” under 35 U.S.C. 305, while providing the Patent Owner with a fair opportunity to present argument against the challenges to its patents. A one-month extension in this reexamination would provide a due date of June 3, 2021.

### **CONCLUSION**

Given the foregoing, Patent Owner believes that this extraordinary situation warrants additional time needed to respond to the grounds of rejection in the Non-final Office Action. Because of substantial delays arising from the COVID-19 pandemic, Patent Owner respectfully requests a one-month extension of time to file its response to the Office Action mailed on March 3, 2021 in the '970 Reexam. The requested extension would Office Action would extend the current due date of May 3, 2021 to June 3, 2021.

The Commissioner is further authorized to deduct any underpayment of fees or any additional fees required in connection with the filing of this paper from Deposit Account No. 603614.

Dated: April 12, 2021

Respectfully submitted,  
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Attorney for Patent Owner  
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Dated: April 12, 2021

Respectfully submitted,  
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## Electronic Patent Application Fee Transmittal

<b>Application Number:</b>	90014507
<b>Filing Date:</b>	15-May-2020
<b>Title of Invention:</b>	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS
<b>First Named Inventor/Applicant Name:</b>	8213970
<b>Filer:</b>	Peter Lambrianakos/Eddie Rowell
<b>Attorney Docket Number:</b>	2525.993REX0

Filed as Large Entity

**Filing Fees for ex parte reexam**

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
<b>Basic Filing:</b>				
<b>Pages:</b>				
<b>Claims:</b>				
<b>Miscellaneous-Filing:</b>				
<b>Petition:</b>				
<b>Patent-Appeals-and-Interference:</b>				
<b>Post-Allowance-and-Post-Issuance:</b>				
<b>Extension-of-Time:</b>				

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
PETITION FEE- 37 CFR 1.17(G) (GROUP II)	1463	1	220	220
<b>Miscellaneous:</b>				
<b>Total in USD (\$)</b>				<b>220</b>

## Electronic Acknowledgement Receipt

<b>EFS ID:</b>	42429530
<b>Application Number:</b>	90014507
<b>International Application Number:</b>	
<b>Confirmation Number:</b>	6188
<b>Title of Invention:</b>	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS
<b>First Named Inventor/Applicant Name:</b>	8213970
<b>Customer Number:</b>	172615
<b>Filer:</b>	Peter Lambrianakos/Eddie Rowell
<b>Filer Authorized By:</b>	Peter Lambrianakos
<b>Attorney Docket Number:</b>	2525.993REX0
<b>Receipt Date:</b>	12-APR-2021
<b>Filing Date:</b>	15-MAY-2020
<b>Time Stamp:</b>	18:39:31
<b>Application Type:</b>	Reexam (Patent Owner)

### Payment information:

Submitted with Payment	yes
Payment Type	CARD
Payment was successfully received in RAM	\$220
RAM confirmation Number	E20214BI40230849
Deposit Account	
Authorized User	

The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows:

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**File Listing:**

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Reexam Request for Extension of Time	90-014507_Petition_for_extens ion.pdf	42095  cb2b9f2410b1705f0f23eba55a1291df134e f5c	no	7

**Warnings:**

**Information:**

2	Reexam Certificate of Service	90-014507_Certificate_of_Servi ce.pdf	25651  82cf5f7facc67aa8876bfb8ff7265bb8874 899	no	2
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**Warnings:**

**Information:**

3	Fee Worksheet (SB06)	fee-info.pdf	30509  7ccd415067109be77ec78a5a1a5f68b503f1 083d	no	2
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**Warnings:**

**Information:**

<b>Total Files Size (in bytes):</b>			98255		
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**This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.**

**New Applications Under 35 U.S.C. 111**

**If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.**

**National Stage of an International Application under 35 U.S.C. 371**

**If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.**

**New International Application Filed with the USPTO as a Receiving Office**

**If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.**



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
**United States Patent and Trademark Office**  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/014,507	05/15/2020	8213970	2525.993REX0	6188
172615	7590	03/03/2021	EXAMINER	
Fabricant LLP 411 Theodore Fremd Road Suite 206 South Rye, NY 10580			KISS, ERIC B	
			ART UNIT	PAPER NUMBER
			3992	
			MAIL DATE	DELIVERY MODE
			03/03/2021	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.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
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P.O. Box 1450  
Alexandria, VA 22313-1450  
www.uspto.gov

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
1100 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

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

REEXAMINATION CONTROL NO. 90/014,507 .

PATENT UNDER REEXAMINATION 8213970 .

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)).

<b>Office Action in Ex Parte Reexamination</b>	<b>Control No.</b> 90/014,507	<b>Patent Under Reexamination</b> 8213970	
	<b>Examiner</b> ERIC B KISS	<b>Art Unit</b> 3992	<b>AIA (FITF) Status</b> No

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

- a.  Responsive to the communication(s) filed on 15 May 2020.  
 A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on \_\_\_\_\_.
- b.  This action is made FINAL.
- c.  A statement under 37 CFR 1.530 has not been received from the patent owner.

A shortened statutory period for response to this action is set to expire 2 month(s) from the mailing date of this letter. Failure to respond within the period for response will result in termination of the proceeding and issuance of an *ex parte* reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c)**. If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.

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

1.  Notice of References Cited by Examiner, PTO-892.                      3.  Interview Summary, PTO-474.  
2.  Information Disclosure Statement, PTO/SB/08.                      4.  \_\_\_\_\_.

**Part II SUMMARY OF ACTION**

- 1a.  Claims 2 and 10-13 are subject to reexamination.
- 1b.  Claims 1 and 3-9 are not subject to reexamination.
2.  Claims \_\_\_\_\_ have been canceled in the present reexamination proceeding.
3.  Claims \_\_\_\_\_ are patentable and/or confirmed.
4.  Claims 2 and 10-13 are rejected.
5.  Claims \_\_\_\_\_ are objected to.
6.  The drawings, filed on \_\_\_\_\_ are acceptable.
7.  The proposed drawing correction, filed on \_\_\_\_\_ has been (7a)  approved (7b)  disapproved.
8.  Acknowledgment is made of the priority claim under 35 U.S.C. 119(a)-(d) or (f).  
a)  All b)  Some\* c)  None of the certified copies have  
1  been received.  
2  not been received.  
3  been filed in Application No. \_\_\_\_\_.  
4  been filed in reexamination Control No. \_\_\_\_\_.  
5  been received by the International Bureau in PCT application No. \_\_\_\_\_.
- \* See the attached detailed Office action for a list of the certified copies not received.
9.  Since the proceeding appears to be in condition for issuance of an *ex parte* reexamination certificate 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.
10.  Other: \_\_\_\_\_

cc: Requester (if third party requester)



### **NON-FINAL ACTION**

Claims 2 and 10-13 of U.S. Pat. 8,213,970 are under reexamination.

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties 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).

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 8,213,970 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 §§ 2207, 2282 and 2286.

### **Related Proceedings**

The examiner is aware of the following related matters:

The '970 patent is currently involved in the litigation styled *AGIS Software Dev., LLC v. Google LLC*, Case No. 2:19-cv-00361 (E.D. Tex.), which was filed on November 4, 2019.

The '970 patent was involved in an *Inter Partes* Review of claims 1 and 3-9, in which a Final Written Decision found the challenged claims unpatentable. See *Google LLC v. AGIS Software Dev., LLC*, IPR2018-01079, Final Written Decision (P.T.A.B. Nov. 19, 2019). A Notice of Appeal to the United States Court of Appeals for the Federal Circuit was filed on January 21, 2020. The Federal Circuit affirmed the decision of the Patent Trial and Appeal Board. *AGIS Software Dev., LLC v. Google LLC*, No. 2020-1401, slip op. (Fed. Cir. Feb. 4, 2021).

Requests for *Ex Parte* Reexamination have been filed for commonly-assigned U.S. Pats. 9,408,055; 9,445,251; and 9,467,838.

Petitions for *Inter Partes* Review of commonly-assigned U.S. Pat. 9,820,123 have also been filed.

**Patents and Publications Cited in the Request**

The request cites the following prior art patents and printed publications:

- 1) U.S. Pat. App. Pub. 2006/0218232 (Kubala);
- 2) U.S. Pat. 6,854,007 (Hammond);
- 3) U.S. Pat. 5,325,310 (Johnson); and
- 4) U.S. Pat. 5,742,905 (Pepe).

**Additional Evidence Considered**

The Declaration of David Hilliard Williams, filed by the third party requester, has been considered.

**Priority Date**

The Request contends that the '970 patent is not entitled to priority to any of the earlier-filed applications in its continuity chain, and is instead entitled to a priority date of only November 26, 2008—its actual filing date, (Request at 17-20).

Upon review, the examiner agrees with the contentions and evidentiary support in the Request, (*see id.*), that none of the earlier-filed applications provide sufficient written description support for at least a forced-message alert software-application program, as required by each independent claims of the '970 patent. Accordingly, the examiner agrees that the '970 patent is entitled to a priority date of November 26, 2008.

**Claim Rejections - 35 USC § 103**

In the event the determination of the status of the application as subject to AIA 35 U.S.C. 102 and 103 (or as subject to pre-AIA 35 U.S.C. 102 and 103) is incorrect, any correction of the statutory basis for the rejection will not be considered a new ground of rejection if the prior art relied upon, and the rationale supporting the rejection, would be the same under either status.

The following is a quotation of pre-AIA 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 2 and 10-13 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over**

**Kubala and Hammond.**

The claim chart below discusses relevant teachings of the prior art corresponding to the claim elements.

Claims	Prior Art
<p>2. [A communication system for transmitting, receiving, confirming receipt, and responding to an electronic message, comprising:]</p>	<p>Kubala discloses a communication system for transmitting, receiving, and responding to an electronic message. See Kubala at ¶ [0054], Abstract.</p> <p>Kubala also discloses that the communication system was known to “generate return receipts to the sender when the sender’s e-mail message is received at its intended destination or when the recipient opens the e-mail message, thereby providing an acknowledgment that a particular message has been received and/or opened. <i>Id.</i> at ¶[0006].</p>
<p>[a predetermined network of participants, wherein each participant has a similarly equipped PDA/cell phone that includes a CPU and a touch screen display a CPU and memory;]</p>	<p>Kubala discloses a predetermined network of participants, which includes a plurality of personal digital assistants 107, 112. Kubala at ¶¶[0026]-[0027], Fig. 1A.</p> <p>Each PDA/cell phone includes at least one CPU 122, a memory 124, 126, and a user interface adapter 148, which Kubala describes as being coupled to a touch-screen display. <i>Id.</i> at ¶¶[0029]-[0030], Fig. 1B.</p>
<p>[a data transmission means that facilitates the transmission of electronic files between said PDA/cell phones in different locations;]</p>	<p>Kubala supports a network 109, a client 110, and PDAs/cell phones 112 that (1) “communicate with one another” using, for example, TCP/IP or (2) “directly transfer data between themselves”</p>

	<p>using, for example, “Bluetooth™ wireless technology or WiFi technology (IEEE 802.11).” Kubala at ¶¶ [0026]-[0027], Fig. 1A.</p>
<p>[a sender PDA/cell phone and at least one recipient PDA/cell phone for each electronic message;]</p>	<p>Kubala discloses a plurality of PDAs/cell phones that communicate with each other. Kubala at ¶¶ [0027], [0032]-[0033], Fig. 1A. In other words, one PDA/cell phone sends an electronic message (i.e., “a sender PDA/cell phone”) and another PDA/cell phone receives it (i.e., a “recipient PDA/cell phone”).</p>
<p>[a forced message alert software application program including a list of required possible responses to be selected by a participant recipient of a forced message response loaded on each participating PDA/cell phone;]</p>	<p>Kubala Figure 2 illustrates an enhanced email application 208 that includes a mandatory-response functional unit 212. The combined enhanced email application 208 and mandatory-response functional unit 212 read on the claimed “forced message alert software application program.” Referring to Figure 2, Kubala explains that the mandatory-response functional unit 212 provides an email message 218 in response to an email message 214 with mandatory-response flag 216. Kubala at ¶ [0035]; <i>see also id.</i> at ¶¶ [0013], [0033], [0036].</p> <p>Kubala also discloses the claimed “list of possible responses to be selected by a participant recipient of a forced message response loaded on each participating PDA/cell phone.” Kubala’s Figure 11C shows an example of alerting a user by displaying a menu 1120 of possible responses to a sender’s message. Kubala explains that a recipient’s selection of one of the “quick response[s]” in menu 1120 fulfills “the sender’s request that the recipient is required to provide a mandatory response.” Kubala at ¶¶ [0022], [0047], [0057]; <i>see also id.</i> at ¶¶ [0054]-[0055].</p> <p>Kubala’s Figure 11A shows an example of alerting a user by displaying a warning message 1102 when an e-mail message that contains a mandatory request flag is received, and that the recipient “must provide a reply message in response to the original message.” Kuballa at ¶¶[0054].</p>
<p>[means for attaching a forced message alert software packet to a voice or text message]</p>	<p>Kubala discloses an enhanced email application 206 on a computing device (e.g., PDA) 202, as</p>

<p>creating a forced message alert that is transmitted by said sender PDA/cell phone to the recipient PDA/cell phone, said forced message alert software packet containing a list of possible required responses and requiring the forced message alert software on said recipient PDA/cell phone to transmit an automatic acknowledgment to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone;]</p>	<p>illustrated in Fig. 2. See Kubala at ¶¶ [0033]-[0036].</p> <p>Kubala discloses a mandatory-response flag 216 that is attached to an email message 214, as illustrated in Fig. 2. Kubala explains that the e-mail message 214 may be a text message, voicemail message, audio message, video message, or other type of message. Kubala at ¶ [0032]. Kubala also explains that “[m]andatory response flag 216 may be implemented in a variety of data formats . . .” <i>Id.</i> at ¶[0035]; see also <i>id.</i> at ¶¶ [0036]-[0041], [0054]-[0061], Figs. 3-4. Thus, Kubala creates the claimed “forced message alert.” For example, Kubala’s mandatory-response flag 216 that is attached to email message 214 reads on “attaching a forced message alert software packet to a voice or text message creating a forced message alert” as claimed.</p> <p>Kubala also discloses the claimed “list of possible required responses.” Kubala’s Fig. 11C illustrates an example of alerting a user by displaying a menu 1120 of possible responses that a recipient may choose from in order to respond to a sender’s message. Kubala at ¶¶ [0022], [0047], [0057]. And, Kubala discloses that, in one embodiment, the “text strings that are used as menu items” may be “extracted from the original e-mail message that was received from the sender . . .” <i>Id.</i> at ¶[0057]; see also <i>id.</i> at ¶ [0040]-[0041].</p> <p>Moreover, Kubala teaches or suggests the claimed functionality of “requiring the forced message alert software on said recipient PDA/cell phone to transmit an automatic acknowledgment to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone.” In fact, Kubala discloses that it was known “to generate return receipts to the sender when the sender’s email message is received at its intended destination or when the recipient opens the e-mail message, thereby providing an acknowledgment that a particular message has been received.” Kubala at ¶ [0006]. Based on these teachings in Kubala, a person of</p>
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	<p>ordinary skill in the art at the time of invention would have understood that the condition that causes the acknowledgement to be sent back to the sender is a configurable parameter which could be set to occur when the sender's email message is received at its intended destination or, in other words, as soon as it is received at the recipient's device.</p>
<p>[means for requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display;]</p>	<p>Kubala discloses an enhanced email application 206 on a computing device (e.g., PDA) 202, as illustrated in Fig. 2. See Kubala at ¶¶ [0033]-[0036].</p> <p>Kubala also discloses: "The e-mail application may indicate the presence of a mandatory response flag: using a message within a pop-up window; other information within a status bar; through the use of colors on a display screen; or through some other means of alerting the user." See Kubala at ¶ [0047]. Again, Kubala discloses "diagrams that represent a set of GUI windows through which an e-mail application alerts a user by displaying warning messages and error messages to the user as a result of a user action when the e-mail application has an e-mail message that contains a mandatory request flag." See <i>id.</i> at ¶ [0022]. An example of the GUI window alert includes a menu of possible responses from which a recipient can choose. See <i>id.</i> at ¶¶ [0047], [0057], Fig. 11C (menu 1120) which satisfy the claimed "response list."</p> <p>Although the specific embodiment illustrated in Figure 11C shows that a user can "select 'CANCEL' to close without sending a reply," Kubala also explicitly teaches that "the recipient can be prevented from closing a review of the received e-mail message, from deleting the received e-mail message, and from exiting the e-mail application until the recipient has responded to the received email message." <i>Id.</i> at ¶ [0009], Fig. 11C; see also <i>id.</i> at ¶ [0055]. Moreover, Kubala also discloses that a recipient being required to respond to a mandatory-response message is a configurable feature. See <i>id.</i> at ¶¶ [0009], [0054]-[0055], [0059]-[0060]. For example, the recipient may be required to</p>

	<p>respond “when the recipient first reviews the e-mail message.” <i>Id.</i> at ¶ [0060].</p>
<p>[means for receiving and displaying a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have not automatically acknowledged the forced message alert;]</p>	<p>Kubala discloses an enhanced email application program 206, 208 that includes mandatory-response functional unit 210, 212 on a PDA. <i>See</i> Kubala at ¶¶ [0033]-[0036], Fig. 2.</p> <p>Kubala further explains that it was known to automatically acknowledge receipt of an electronic message. <i>See id.</i> at ¶[0006]. In addition, Kubala explicitly discloses that the receiving e-mail application may collect and record information about the manner in which the recipient responds to an e-mail message that has a mandatory-response flag. The information may include mandatory-response return-status codes included within the reply e-mail. <i>Id.</i> at ¶¶ [0050]-[0051], [0061], Fig. 9. A person of ordinary skill in the art at the time of invention would have known that a listing of the recorded information regarding the responses or automatic acknowledgements were accessible.</p> <p>To the extent it is argued that Kubala does not teach this limitation, Hammond also states that “the recipient computer systems provide receipts when messages are received and when messages are reviewed . . .” Hammond at 5:20-23; <i>see also id.</i> at Abstract, 2:11-18. These acknowledgement receipts are tracked in Hammond’s Message Tracking Tables, as depicted in Figure 2 and are described throughout the specification. <i>See id.</i> at 3:1-4:28, 5:31-37, 6:56-8:45, 10:6-22.</p> <p>A person of ordinary skill in the art at the time of invention would have been motivated to combine Hammond with Kubala based on the disclosures in the references themselves, particularly as they relate to exchanging and tracking recipient-device acknowledgements. Again, Kubala generally discloses that it was known to provide acknowledgement receipts, , <i>see</i> Kubala at ¶ [0006], and record details about the responses to the emails with mandatory-response flags. Hammond also discloses acknowledgement receipts and how to</p>

	<p>track these acknowledgement receipts. Because these disclosures in Kubala and Hammond are directed to tracking responses to mandatory-responses messages, these disclosures would have motivated a person of ordinary skill in the art to combine Hammond and Kubala. Moreover, it would have been obvious to one of ordinary skill in the art at the time of invention to utilize the tracking tables of Hammond with the system of Kubala in order to manage response tracking information in a known effective way.</p>
<p>[means for periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced message alert; and]</p>	<p>Kubala discloses an enhanced email application 208 that includes mandatory-response functional unit 212 on a PDA. See Kubala at ¶¶ [0033]-[0036], Fig. 2.</p> <p>Kubala discloses that when a reply to an email message with an associated mandatory-response flag has not been made, the enhanced email application 208 loops back to alert the recipient via 1012, as illustrated in Figure 10. The looping back at 1012 has the effect of resending the message to the user until the user replies to the received e-mail message as required. See Kubala at ¶ [0053], Fig. 10.</p> <p>To the extent that it is argued that Kubala does not teach this limitation, Hammond's "system tracks whether each message has been delivered and reviewed by to [sic] each recipient, and uses the message information to resend the messages whose delivery or review is not confirmed." Hammond at 2:47-50; see also <i>id.</i> at Abstract, 2:1-8, 4:21-28, 5:5-6:20, 6:66-7:63, 10:48-63, Figs. 2, 3A, 3B, 4, 5A, 5B.</p>
<p>[means for receiving and displaying a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert and details the response from each recipient PDA/cell phone that responded.]</p>	<p>Kubala discloses an enhanced email application 206, 208 and a mandatory-response functional unit 210, 212 on a PDA, which together are designed to receive and display a listing of which recipient PDA/cell phones have transmitted a manual response to said forced-message alert, and details the response from each recipient PDA/cell phone that responded. See Kubala at ¶¶ [0033]-[0036], [0050]-[0051], [0061], Fig. 2.</p>



	<p>Kubala's Figure 2 shows that a sending PDA (e.g., computing device 202) can receive and display a response (e.g., email message 218) from a recipient PDA (e.g., computing device 204). See Kubala at ¶¶ [0026]-[0041].</p> <p>Kubala also discloses "receiving and displaying a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert." For example, Kubala states that the receiving e-mail application 208 may collect and record information about the manner in which the recipient responds to an e-mail message that has a mandatory-response flag. The information may include mandatory-response return-status codes included within the reply e-mail. Kubala at ¶¶ [0050]-[0051], [0061], Fig. 9.</p> <p>A person of ordinary skill in the art at the time of invention would have known that a listing of the recorded information regarding the responses to e-mail messages were available and accessible.</p>
<p>... wherein the forced message alert software application program on the recipient PDA/cell phone includes:</p>	<p>Kubala discloses the claimed "forced message alert software application program" as a combination of an enhanced email application 208 and mandatory response functional unit 212, on a receiving computing device (e.g., PDA) 204, as illustrated in Figure 2.</p>
<p>means for transmitting the acknowledgment of receipt to said sender PDA/cell phone immediately upon receiving a forced message alert from the sender PDA/cell phone;</p>	<p>Kubala discloses the combination of an enhanced email application 208 and mandatory response functional unit 212 on a recipient computing device 204 (e.g., PDA), as illustrated in Figure 2. See Kubala at ¶¶ [0033]-[0036].</p> <p>Kubala discloses that it was known "to generate return receipts to the sender when the sender's email message is received at its intended destination or when the recipient opens the e-mail message, thereby providing an acknowledgment that a particular message has been received." Kubala at ¶ [0006].</p> <p>Based on these teachings in Kubala, a person of ordinary skill in the art at the time of invention would have understood that the condition that causes the acknowledgement to be sent back to</p>

	<p>the sender is a configurable parameter which could be set to occur when the sender's email message is received at its intended destination or, in other words, as soon as it is received at the recipient's device.</p>
<p>means for controlling of the recipient PDA/cell phone upon transmitting said automatic acknowledgment and causing, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PDA/cell phone or causes, in cases where the forced message alert is a voice message, the voice message being periodically repeated by the speakers of the recipient PDA/cell phone while said response list is shown on the display;</p>	<p>Kubala discloses the combination of an enhanced email application 208 and mandatory response functional unit 212 on a recipient computing device 204 (e.g., PDA). Kubala at ¶¶ [0033]-[0036], Fig. 2.</p> <p>Kubala discloses the required function of "controlling ... the recipient PDA/cell phone upon transmitting said automatic acknowledgment." As discussed above, Kubala discloses various embodiments for requiring a response to an "e-mail message." And Kubala explains that its disclosure is not limited to only emails; instead, according to Kubala, "an e-mail message comprise various types of electronic messages, e.g., text messages, instant messages, fax messages, voicemail messages, video messages, audio messages, and other types of messages." Kubala at ¶ [0032]. Each of the embodiments that Kubala explicitly discloses and suggests "represents] a different way of attempting to fulfill a request from the sender of the original message that the recipient should or must provide a reply message in response to the original message." <i>Id.</i> at ¶ [0054]. In particular, Kubala discloses that "the user must reply to the received e-mail message in some manner before the e-mail application will allow the user to perform some other action." <i>Id.</i> at ¶ [0053].</p> <p>Although the specific embodiment illustrated in Figure 11C shows that a user can "select 'CANCEL' to close without sending a reply," Kubala also explicitly teaches that "the recipient can be prevented from closing a review of the received e-mail message, from deleting the received e-mail message, and from exiting the e-mail application until the recipient has responded to the received email message." Kubala at ¶ [0009], Fig. 11C; see also <i>id.</i> at ¶ [0055]. Moreover, Kubala also discloses that a recipient being required to respond to a mandatory-</p>

response message is a configurable feature. *See id.* at ¶¶ [0054]-[0055], [0059]-[0060]. For example, the recipient may be required to respond “when the recipient first reviews the e-mail message.” *Id.* at ¶ [0060].

Kubala’s Figure 11A (reproduced below) shows an example of alerting a user by displaying a warning message 1102 when an e-mail message that contains a mandatory request flag is received, and shows that the recipient “must provide a reply message in response to the original message.” *Id.* at ¶ [0054].

Kubala teaches or suggests the claimed requirement of “causing, in cases where the force[d] message alert is a text message, the text message and a response list to be shown on the display of the recipient PDA/cell phone or causes, in cases where the forced message alert is a voice message, the voice message being periodically repeated by the speakers of the recipient PDA/cell phone while said response list is shown on the display.” As set forth above, Kubala explains that e-mail message 214 may be a text message or a voicemail or audio message. Kubala at ¶ [0032]. Kubala discloses that when a reply to an email message with an associated mandatory-response flag has not been made, the enhanced email application 208 loops back to alert the recipient via 1012, as illustrated in Figure 10. The looping back at 1012 has the effect of resending the message—that can be a text or voice message—to the user until the user replies to the received message as required. *See id.* at ¶ [0053]; Fig. 10.

To the extent that it is argued that Kubala does not teach this limitation, Hammond’s “system tracks whether each message has been delivered and reviewed by to [sic] each recipient, and uses the message information to resend the messages whose delivery or review is not confirmed.” Hammond at 2:47-50; *see also id.* at Abstract, 2:1-8, 4:21-28, 5:5-6:20, 6:66-7:63, 10:48-63, Figs. 2, 3A, 3B, 4, 5A, 5B.

<p>means for allowing a manual response to be manually selected from the response list or manually recorded and transmitting said manual response to the sender PDA/cell phone; and</p>	<p>Kubala's Figure 2 shows that a receiving PDA (e.g., computing device 204) can receive email message 214 from a sender PDA (e.g., computing device 202). Kubala discloses an enhanced email application 208 and a mandatory-response functional unit 212 on a recipient PDA, which together are designed to receive and display a response list, and also transmit a selection from the response list to computing device 202—the sender PDA—via email message 218. See Kubala at ¶¶ [0033]-[0036], [0050]-[0051], [0061], Fig. 2.</p> <p>Kubala states that the receiving e-mail application 208 may collect and record information about the manner in which the recipient responds to an e-mail message that has a mandatory-response flag. The information may include mandatory-response return-status codes included within the reply e-mail. Kubala at ¶¶ [0041], [0050]-[0051], [0061], Fig. 9. A person of ordinary skill in the art at the time of invention would have known that a listing of the recorded information regarding the responses to e-mail messages were available and accessible.</p> <p>Hammond also provides this disclosure. Hammond discloses a "Message Receipt Tracker component [that] attempts to identify when sent messages have been delivered to recipients and when sent messages have been reviewed by recipients." Hammond at 5:17-20; see also <i>id.</i> at 5:20-6:55. Hammond's Figure 2 shows a Message Tracking Table that includes detailed information about electronic messages that have been read by recipients. See <i>id.</i> at 6:56-8:45. And Hammond discloses a Message Receipt Tracker routine, <i>id.</i> at Fig. 4, 10:5-47, and a Message Tracking Table Processor routine, <i>id.</i> at Figs. 5A, 5B, 10:48-11:48.</p>
<p>means for clearing the text message and a response list from the display of the recipient PDA/cell phone or stopping the repeating voice message and clearing the response list from the display of the recipient PDA/cell phone once the manual response is transmitted.</p>	<p>Kubala discloses that a user can select a response from a menu of responses. Kubala's use of the term "email message" includes "text messages, instant messages, fax messages, voicemail messages, video messages, audio messages, and other types of messages." Kubala at ¶¶ [0032]-[0033], [0057], Fig. 11C.</p>

	<p>Kubala also teaches the required function of “clearing the text message and a response list from the display of the recipient PDA/cell phone or stopping the repeating voice message and clearing the response list from the display of the recipient PDA/cell phone once the manual response is transmitted.” For example, after selecting a response from menu 1120, a user presses the “INSTANT” button 1118, which closes window 1112, thus clearing or stopping the text message, the repeating voice message, and a response list from the display of the recipient PDA, and generating a reply message. Kubala at ¶ [0057]. Kubala explains:</p> <p>“INSTANT” button 1118 closes window 1112 and then creates a reply e-mail message with an automatically generated reply message in which the message body is predetermined or pre-configured; in this example, when “INSTANT” button 1118 is selected, the e-mail application determines which menu item within menu 1120 has been selected by the user as a quick response to the original e-mail message, thereby fulfilling the sender's request that the recipient is required to provide a mandatory response.</p> <p><i>Id.</i>; see also <i>id.</i> at ¶¶ [0033]-[0036], [0049], [0053]-[0054], Figs. 2, 8, 10, 11C.</p>
<p>10. A method of receiving, acknowledging and responding to a forced message alert from a sender PDA/cell phone to a recipient PDA/cell phone, wherein the receipt, acknowledgment, and response to said forced message alert is forced by a forced message alert software application program, said method comprising the steps of:</p>	<p>Kubala discloses a “method of receiving, acknowledging and responding to a forced message alert from a sender PDA/cell phone to a recipient PDA/cell phone” as claimed. For example, Kubala discloses a communication system for receiving, and responding to an electronic message. See Kubala at ¶ [0054], Abstract. Kubala also discloses a plurality of PDAs/cell phones that communicate with each other. <i>Id.</i> at ¶¶ [0027], [0032]-[0033], Fig. 1A. In other words, one PDA/cell phone sends an electronic message (i.e., “a sender PDA/cell phone”) and another PDA/cell phone receives it (i.e., a “recipient PDA/cell phone”).</p>

	<p>Kubala also discloses “wherein the receipt, acknowledgment, and response to said forced message alert is forced by a forced message alert software application program” as claimed. Kubala discloses that it was known to “generate return receipts to the sender when the sender’s e-mail message is received at its intended destination or when the recipient opens the e-mail message, thereby providing an acknowledgement that a particular message has been received and/or opened.” Kubala at ¶ [0006].</p> <p>Kubala’s Figure 2 illustrates an enhanced email application 208 that includes a mandatory-response functional unit 212. The combined enhanced email application 208 and mandatory-response functional unit 212 read on the claimed “forced message alert software application program.” Referring to Figure 2, Kubala explains that the mandatory-response functional unit 212 provides an email message 218 in response to an email message 214 with a mandatory-response flag 216. As discussed above, the mandatory-response flag 216 attached to the email message 214 reads on the claimed “forced message alert.” <i>Id.</i> at ¶ [0035]; <i>see also id.</i> at ¶¶ [0013], [0036].</p> <p>Kubala’s Figure 11A shows an example of alerting a user by displaying a warning message 1102 when an e-mail message that contains a mandatory request flag is received, and that the recipient “must provide a reply message in response to the original message.” Kubala at ¶ [0054]. This demonstrates that the response to said forced message alert is forced by the combination of Kubala’s enhanced email application 208 and mandatory response functional unit 212.</p>
<p>receiving an electronically transmitted electronic message;</p> <p>identifying said electronic message as a forced message alert, wherein said forced message alert comprises of a voice or text message and a forced message alert application software packet, which triggers the activation of the forced message</p>	<p>Kubala discloses the claimed forced message alert software application program as the combination of an enhanced email application 208 and mandatory response functional unit 212 on a receiving computing device 204 (e.g., receiving PDA) that receives email message 214, as illustrated in Figure 2. <i>See</i> Kubala at ¶¶ [0033]-[0036].</p>

<p>alert software application program within the recipient PDA/cell phone;</p>	<p>The claimed “forced message alert [that] comprises of a voice or text message and a forced message alert application software packet” is met by Kubala’s disclosure of email message 214 and the mandatory response flag 216. Kubala explains that e-mail message 214 may be a text message, voicemail message, audio message, video message, or other type of message. Kubala at ¶ [0032]. Kubala also explains that “[mandatory response flag 216 acts as an indicator ... to e-mail application 208 that e-mail message 214 should be handled as an important message with a required mandatory response. Mandatory response flag 216 may be implemented in a variety of data formats . . . .” <i>Id.</i> at ¶ [0035]; <i>see also id.</i> at ¶¶ [0036]-[0041], Figs. 3, 4.</p>
<p>transmitting an automatic acknowledgment of receipt to the sender PDA/cell phone, which triggers the forced message alert software application program to take control of the recipient PDA/cell phone and show the content of the text message and a required response list on the display recipient PDA/cell phone or to repeat audibly the content of the voice message on the speakers of the recipient PDA/cell phone and show the required response list on the display recipient PDA/cell phone; and</p>	<p>Kubala discloses “transmitting an automatic acknowledgment of receipt to the sender PDA/cell phone” as claimed. For example, Kubala discloses that it was known to “generate return receipts to the sender when the sender’s e-mail message is received at its intended destination or when the recipient opens the e-mail message, thereby providing an acknowledgement that a particular message has been received and/or opened.” Kubala at ¶ [0006].</p> <p>Kubala discloses “triggers the forced message alert software application program to take control of the recipient PDA/cell phone” as claimed. For example, Kubala’s Figure 2 illustrates an enhanced email application 208 that includes a mandatory-response functional unit 212 on computing device 204. The combined enhanced email application 208 and mandatory-response functional unit 212 read on the claimed “forced message alert software application program to take control of the recipient PDA/cell phone.” Referring to Figure 2, Kubala explains that the mandatory-response functional unit 210 provides an email message 218 in response to an email message 214 with a mandatory-response flag 216. <i>Id.</i> at ¶ [0035]; <i>see also id.</i> at ¶¶ [0013], [0033], [0036].</p>

Each of the embodiments that Kubala explicitly discloses and suggests “represent a different way of attempting to fulfill a request from the sender of the original message that the recipient should or must provide a reply message in response to the original message.” Kubala at ¶ [0054]. In particular, Kubala discloses that “the user must reply to the received e-mail message in some manner before the e-mail application will allow the user to perform some other action.” *Id.* at ¶ [0053].

Kubala also discloses the claimed “show the content of the text message and a required response list on the display recipient PDA/cell phone” as claimed. Kubala’s Figure 11C shows an example of displaying the content of a message and a menu 1120 of possible responses to a sender’s message.

Kubala also discloses “to repeat audibly the content of the voice message on the speakers of the recipient PDA/cell phone and show the required response list on the display recipient PDA/cell phone” as claimed. Kubala explains that e-mail message 214 may be a text message, or a voicemail or audio message. Kubala at ¶ [0032]. And, Kubala states that a data processing system such as a PDA can include an “audio output system.” *Id.* at ¶ [0029]. Kubala discloses that when a reply to an email message with an associated mandatory-response flag has not been made, the enhanced email application 208 loops back to alert the recipient via 1012, as illustrated in Figure 10. The looping back at 1012 has the effect of resending the message to the user until the user replies to the received e-mail message as required. *See id.* at ¶ [0053], Fig. 10.

To the extent that it is argued that Kubala does not teach this limitation, Hammond’s “system tracks whether each message has been delivered and reviewed by to [sic] each recipient, and uses the message information to resend the messages whose delivery or review is not confirmed.” Hammond at 2:47-50; *see also id.* at Abstract, 2:1-8, 4:21-28, 5:5-6:20, 6:66-7:63, 10:48-63, Figs. 2, 3A, 3B, 4, 5A, 5B.



<p>transmitting a selected required response from the response list in order to allow the message required response list to be cleared from the recipient's cell phone display, whether said selected response is a chosen option from the response list, causing the forced message alert software to release control of the recipient PDA/cell phone and stop showing the content of the text message and a response list on the display recipient PDA/cell phone and or stop repeating the content of the voice message on the speakers of the recipient PDA/cell phone;</p>	<p>Kubala discloses "transmitting a selected required response from the response list in order to allow the message required response list to be cleared from the recipient's cell phone display, whether said selected response is a chosen option from the response list, causing the forced message alert software to . . . stop showing the content of the text message and a response list on the display recipient PDA/cell phone and or stop repeating the content of the voice message on the speakers of the recipient PDA/cell phone" as claimed. For example, Kubala discloses that a user can select a response from a menu of responses. Kubala's use of the term "email message" includes "text messages, instant messages, fax messages, voicemail messages, video messages, audio messages, and other types of messages." See Kubala at ¶¶ [0032]-[0033], [0057], Fig. 11C.</p> <p>After selecting a response from menu 1120, a user presses the "INSTANT" button 1118, which closes window 1112, thus clearing or stopping the text message, the repeating voice message, and a response list from the display of the recipient PDA, and generating a reply message. Kubala at ¶ [0057]. Kubala explains:</p> <p style="padding-left: 40px;">"INSTANT" button 1118 closes window 1112 and then creates a reply e-mail message with an automatically generated reply message in which the message body is predetermined or pre-configured; in this example, when "INSTANT" button 1118 is selected, the e-mail application determines which menu item within menu 1120 has been selected by the user as a quick response to the original e-mail message, thereby fulfilling the sender's request that the recipient is required to provide a mandatory response.</p> <p><i>Id.</i>; see also <i>id.</i> at ¶¶ [0022], [0033]-[0036], [0047], [0049], [0053]-[0055], [0057], [0060], Figs. 2, 8, 10, 11C.</p>
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	<p>Kubala discloses “causing the forced message alert software to release control of the recipient PDA/cell phone” as claimed. For example, each of the embodiments that Kubala explicitly discloses and suggests “represent[s] a different way of attempting to fulfill a request from the sender of the original message that the recipient should or must provide a reply message in response to the original message.” Kubala at ¶ [0054]. In particular, Kubala discloses that “the user must reply to the received e-mail message in some manner before the e-mail application will allow the user to perform some other action.” <i>Id.</i> at ¶ [0053]. Accordingly, after the user has replied to the received email, it follows that Kubala’s e-mail application releases control of the PDA/cell phone to allow the user to perform some other action.</p>
<p>displaying the response received from the PDA[/] cell phone that transmitted the response on the sender of the forced alert PDA/cell phone; and</p>	<p>Kubala discloses “displaying the response received from the PDA[/]cell phone that transmitted the response on the sender of the forced alert PDA/cell phone” as claimed. Kubala discloses an enhanced email application 206, 208 and a mandatory-response functional unit 210, 212 on a PDA, which together are designed to receive and display a listing of which recipient PDA/cell phone (e.g., computing device 204) has transmitted a manual response to the forced message alert, and details the response from each recipient PDA/cell phone that responded. See Kubala at ¶¶ [0033]-[0036], [0050]-[0051], [0061], Fig. 2.</p> <p>Kubala’s Figure 2 shows that a sending PDA (e.g., computing device 202) can receive and display a response (e.g., email message 218) from a recipient PDA (e.g., computing device 204). See Kubala at ¶¶ [0026]-[0041]. This disclosure from Kubala meets the claimed requirement “displaying the response received from the PDA[/]cell phone that transmitted the response on the sender of the forced alert PDA/cell phone.”</p> <p>Hammond also provides this disclosure. Hammond discloses “displaying the response received from the PDA[/]cell phone that</p>

	<p>transmitted the response on the sender of the forced alert PDA/cell phone,” as claimed. For example, Hammond discloses a “Message Receipt Tracker component [that] attempts to identify when sent messages have been delivered to recipients and when sent messages have been reviewed by recipients.” Hammond at 5:17-20; <i>see also id.</i> at 5:20-6:55. Hammond’s Figure 2 shows a Message Tracking Table that includes detailed information about electronic messages that have been read by recipients. <i>See id.</i> at 6:56-8:45. And, Hammond discloses a Message Receipt Tracker routine, <i>id.</i> at FIG. 4, 10:5-47, and a Message Tracking Table Processor routine, <i>id.</i> at Figs. 5A, 5B, 10:48-11:48.</p> <p>A person of ordinary skill in the art at the time of invention would have been motivated to combine Hammond with Kubala based on the disclosures in the references themselves, particularly as they relate to exchanging and tracking recipient-device acknowledgements. Again, Kubala generally discloses that it was known to provide acknowledgement receipts, , <i>see Kubala at ¶ [0006]</i>, and record details about the responses to the emails with mandatory-response flags. Hammond also discloses acknowledgement receipts and how to track these acknowledgement receipts. Because these disclosures in Kubala and Hammond are directed to tracking responses to mandatory-responses messages, these disclosures would have motivated a person of ordinary skill in the art to combine Hammond and Kubala. Moreover, it would have been obvious to one of ordinary skill in the art at the time of invention to utilize the tracking tables of Hammond with the system of Kubala in order to manage response tracking information in a known effective way.</p>
<p>providing a list of the recipient PDA/cell phones have automatically acknowledged receipt of a forced alert message and their response to the forced alert message.</p>	<p>Kubala discloses “providing a list of the recipient PDA/cell phones have automatically acknowledged receipt of a forced alert message and their response to the forced alert message” as claimed. For example, Kubala discloses an enhanced email application 206, 208 that includes mandatory-response functional unit 210, 212 on a PDA. <i>See Kubala at ¶¶ [0033]-[0036]</i>,</p>

	<p>Fig. 2. Kubala further explains that it was known to automatically acknowledge receipt of an electronic message. <i>See id.</i> at ¶ [0006]. In addition, Kubala explicitly discloses that the receiving e-mail application may collect and record information about the manner in which the recipient responds to an e-mail message that has a mandatory-response flag. The information may include mandatory-response return-status codes included within the reply e-mail. <i>Id.</i> at ¶¶ [0050]-[0051], [0061], Fig. 9. A person of ordinary skill in the art at the time of invention would have known that a listing of the recorded information regarding the responses or automatic acknowledgements were accessible.</p> <p>To the extent it is argued that Kubala does not teach this limitation, Hammond also discloses “providing a list of the recipient PDA/cell phones have automatically acknowledged receipt of a forced alert message and their response to the forced alert message” as claimed. For example, Hammond states that “the recipient computer systems provide receipts when messages are received and when messages are reviewed . . . Hammond at 5:20-23; <i>see also id.</i> at Abstract, 2:11-18. These acknowledgement receipts are tracked in Hammond’s Message Tracking Tables, as depicted in Figure 2, and are described throughout the specification. <i>See id.</i> at 3:1-4:28, 5:31-37, 10:6-22, 6:56-8:45.</p>
<p>11. The method as in claim 10, wherein each PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it.</p>	<p>Kubala discloses “wherein each PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it” as claimed. For example, the predetermined network of participants is shown in Kubala’s Figure 1A, which includes a plurality of personal digital assistants 107, 112. <i>See Kubala</i> at ¶¶ [0026]-[0027].</p> <p>Kubala’s Figure 1B illustrates that each PDA/cell phone includes at least one CPU 122, a memory 124, 126, and a user interface adapter 148, which Kubala describes as being coupled to a touch-screen display. <i>See Kubala</i> at ¶¶ [0029]-[0030].</p>

	<p>Kubala's Figure 2 illustrates an enhanced email application 206, 208 that includes a mandatory-response functional unit 210, 212. The combined enhanced email application 206, 208 and mandatory-response functional unit 210, 212 read on the claimed "forced message alert software application program loaded on" computing device 202, 204 that can be a PDA/cell phone. Kubala at ¶ [0035]; <i>see also id.</i> at ¶¶ [0013], [0033], [0036].</p>
<p>12. The method as in claim 10, wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program.</p>	<p>Kubala teaches or suggests at least a "forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program," as claimed. For example, Kubala says that "[t]he text strings that are used as menu items may be obtained in a variety of manners." Kubala at ¶[0057]. Furthermore, Kubala's Figure 11C includes a list of possible default responses, including "too busy right now," "looks okay," and "request declined." <i>Id.</i> at ¶ [0057], Fig. 11C. These are default responses. Kubala also explains that the text strings may be "required and standardized within a data format specification, e.g., in a standard similar to RFC 2822." <i>Id.</i> at ¶ [0057]; <i>see also id.</i> at ¶ [0060]. Kubala's disclosure of these types of menu items teaches or suggests the claimed "default [response] list."</p>
<p>13. The method as in claim 10, wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PDA/cell phone.</p>	<p>Kubala discloses "wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PDA/cell phone" as claimed. Again, Kubala says that "[t]he text strings that are used as menu items may be obtained in a variety of manners." Kubala at ¶ [0057]. In one example, the text strings are "configurable":</p> <p>[T]he text strings may be configurable through the enhanced e-mail application by allowing user-specifiable or system-administrator-specifiable parameters. As another alternative, the text strings may be extracted from the original e-</p>

	<p>mail message that was received from the sender, in which case the text strings may have been configured as user-specifiable or system-administrator-specifiable parameters in the sender's instance of the enhanced e-mail application."</p> <p><i>Id.</i>; see also <i>id.</i> at ¶ [0060]. Kubala's disclosure of "configurable" menu items teaches or suggests the claimed "custom response list."</p>
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**Claims 2 and 10-13 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Hammond, Johnson, and Pepe.**

The claim chart below discusses relevant teachings of the prior art corresponding to the claim elements. The Declaration of David Hilliard Williams (filed with the Request) is also cited below, as relevant to determining the scope and content of the prior art.

Claims	Prior Art
2. [A communication system for transmitting, receiving, confirming receipt, and responding to an electronic message, comprising:]	Hammond, Johnson, and Pepe each disclose communication systems for transmitting, receiving, and responding to electronic messages. See Hammond at Abstract, 2:11-18; Johnson at Abstract, 3:4-15, Fig. 1; Pepe at Abstract, 3:45-57, 5:28-14:21, Figs. 1-6. And, Hammond's and Johnson's systems "confirm [ ] receipt" of electronic messages, as claimed. See Hammond at 3:1-30, 5:17-61; Johnson at 1:58-61, 3:64-4:2.
[a predetermined network of participants, wherein each participant has a similarly equipped PDA/cell phone that includes a CPU and a touch screen display a CPU and memory;]	Hammond, Johnson, and Pepe each disclose "a predetermined network of participants," as claimed. See Hammond at Abstract, 2:11-18; Johnson at Abstract, 2:16-31, 3:4-15, Fig. 1; Pepe at Abstract, 3:45-57, 5:28-14:21, Figs. 1-6. But, Hammond's and Johnson's networks include "computers." See, e.g., Hammond at 4:29-47, Fig. 1 (describing computer systems 100, 150, 160, 170, and 180); Johnson at 3:4-4:2, Fig. 1

(describing computers 12 and 30 in LAN 10 and 32).

To the extent that Hammond and Johnson's disclosure of "computers" is found to not encompass a PDA/cell phone, Pepe supplies this missing disclosure. For example, Pepe's Figures 1-6 show a plurality of PDA/cell phones interacting in a network. *See also* Pepe at 5:28-14:21. Each PDA includes a CPU, an input-output device, a display, and a memory. *See id.* at 16:50-61, Fig. 12. Although the phrase "touchscreen display" does not appear in Pepe, a person of ordinary skill in the art at the time of invention would have understood Pepe's disclosure of an input-output device and display to teach or suggest the claimed touchscreen display, because PDAs with touchscreen displays were known well before the '970 patent. (*See* Williams Decl. at ¶¶ 5, 80, 82, 93, 99, 258, 263 (discussing devices that included a touchscreen display).)

A person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe with Hammond and Johnson at least based on the teachings in these references. For example, all these references are directed to sending and receiving electronic messages. *See* Hammond at Abstract, 2:11-17; Johnson at Abstract, 3:4-15, Fig. 1; Pepe at Abstract, 3:45-58, 5:28-14:21, Figs. 1-6. And, Hammond says that "any transmission medium"—including "wireless RF"—"can be used for the transmission of the electronic messages." Hammond at 4:33-38. Similarly, Johnson says that "[t]he electronic mail object may be in the form of text, an image, or a voice message." Johnson at 4:1-2; *see also id.* at 4:3-18. Hammond's disclosure of "wireless RF" and Johnson's disclosure of "text," "image," or "voice" messages suggests the use of a PDA/cell phone. (*See* Williams Decl. at ¶¶ 264-265.) Based on these disclosures, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe's PDA/cell phone with the force-response message systems of Hammond and Johnson.

<p>[a data transmission means that facilitates the transmission of electronic files between said PDA/cell phones in different locations;]</p>	<p>Pepe discloses a PCI server 48 that enables the PDA/cell phone to communicate according to TCP/IP. <i>See</i> Pepe at 24:31-38, 24:54-61. And, those communications can be with other PDAs/cell phones. <i>See id.</i> at 33:4-34:10.</p>
<p>[a sender PDA/cell phone and at least one recipient PDA/cell phone for each electronic message;]</p>	<p>Pepe expressly discloses a sender PDA/cell phone and at least one recipient PDA/cell phone for each electronic message. Pepe explains that a first PDA/cell phone can send a message to a second PDA/cell phone. <i>See</i> Pepe at 33:5-52, Figs. 25-26; <i>see also id.</i> at Figs. 1-6 (showing PDAs in a network), 9:1-6 (explaining that a plurality of PDAs may be connected to a wireless network and messages may be sent to and from those PDAs).</p>
<p>[a forced message alert software application program including a list of required possible responses to be selected by a participant recipient of a forced message response loaded on each participating PDA/cell phone;]</p>	<p>The combination of Hammond, Johnson, and Pepe discloses this limitation. In particular, Hammond and Johnson each disclose systems for requiring a response to an electronic message. <i>See</i> Hammond at Abstract, 1:66-2:50, 3:31-4:28, 6:3-19, 9:12-15; Johnson at Abstract, 1:58-61, 3:64-4:2, 4:28-39, 5:1-6:65, 7:46-62, Fig. 6. Yet neither Hammond nor Johnson discloses a software-application program that is loaded on each PDA/cell phone and that includes a list of possible responses.</p> <p>Pepe supplies this missing disclosure. It discloses "application software residing in the PDA" that is described in Pepe by "the screens displayed on a PCI subscriber's PDA." Pepe at 34:10-15; <i>see also id.</i> at 5:17-20 ("The application residing in the PDA is described in FIGS. 28-45, which illustrate exemplary screens displayed to a PCI subscriber using a wireless PDA."), 34:9-36:51, Figs. 28-45. Specifically, Pepe's Figures 42 and 45 are exemplary screens that may appear when a user wants to edit a message to be sent to another PDA/cell phone. Each of these screens includes a list of possible responses (i.e., box 710 in Figure 42 and box 734 in Figure 45) that can be selected by the user to send in response to a received message. <i>See id.</i> at 36:16-20, 36:38-51.</p>



	<p>As explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe's PDA/cell phone with the forced-response message systems of Hammond and Johnson.</p>
<p>[means for attaching a forced message alert software packet to a voice or text message creating a forced message alert that is transmitted by said sender PDA/cell phone to the recipient PDA/cell phone, said forced message alert software packet containing a list of possible required responses and requiring the forced message alert software on said recipient PDA/cell phone to transmit an automatic acknowledgment to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone;]</p>	<p>The combination of Hammond, Johnson, and Pepe discloses this limitation. In particular, Hammond and Johnson each alone discloses the transmission of forced message alerts to recipient computers. For example, Hammond explains that "electronic messages" include "email, paging [text] messages, and voice mail." Hammond at 1:13-16, 1:21-26. Hammond also discloses "message delivery information" that is attached to a message. <i>Id.</i> at 3:31-43. Thus, Hammond creates the claimed "forced message alert." For example, Hammond's "message delivery information" that is attached to a message reads on "attaching a forced message alert software packet to a voice or text message creating a forced message alert" as claimed. <i>See id.</i> at Abstract, 1:66-2:50, 3:1-4:28, 5:17-61, 6:3-19.</p> <p>Johnson discloses "a mechanism for forcing a recipient to reply to an electronic mail object with data." Johnson at 4:4-6. Johnson also states that "the sender of the electronic mail object may mark or associate an attribute with the electronic mail object such that it cannot be exited out of until the appropriate reply has been made. These attributes are called 'persistent reply attributes'." <i>Id.</i> at 4:28-32. And, Johnson says that "[t]he electronic mail object may be in the form of text, an image, or a voice message." <i>Id.</i> at 4:1-2. Thus, Johnson's persistent reply attribute reads on the claimed "forced message alert software packet" as the persistent reply attribute marks or attaches to a "voice or text message creating a forced message alert" as claimed. <i>See id.</i> at 1:58-61, 2:1-35, 3:64-4:42, 6:60-65. Thus, Johnson creates the claimed "forced message alert."</p> <p>And, Hammond and Johnson also each disclose that the transmitted message requires the recipient device to transmit an automatic</p>

	<p>acknowledgement as soon as the message is received by the recipient device. <i>See</i> Hammond at 1:46-54, 5:17-44, 11:55-12:6; Johnson at 1:58-61, 2:6-15, 3:64-4:1. Yet, Hammond and Johnson do not explicitly disclose application software on a PDA/cell phone as required by the recited “means for attaching . . .”, nor do these references explicitly disclose a list of possible required responses—as recited in this claim.</p> <p>Pepe, however, describes both. First, as set forth above, Pepe discloses “application software residing in the PDA.” <i>See</i> Pepe at 5:17-20, 34:9-36:51, Figs. 28-45.</p> <p>Second, as also set forth above, Pepe discloses a list of possible responses that can be selected by a user to send in response to a received message. <i>See id.</i> at 36:16-20, 36:38-51, Figs. 42, 45.</p>
<p>[means for requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display;]</p>	<p>Johnson discloses the function, and Pepe discloses the structure, recited in this limitation. In particular, Johnson discloses that a response must be provided by a “recipient in order to clear [a received message] from recipient’s cell phone display.” <i>See</i> Johnson at 4:27-31 (“[T]he sender of the electronic mail object may mark or associate an attribute with the electronic mail object such that it cannot be exited out of until the appropriate reply has been made.”); <i>see also id.</i> at 4:18-42. Pepe discloses the structure required by this means-plus-function, the application software that is resident on the PDA/cell phone, Pepe at 5:17-20, 34:9-36:51, Figs. 28-45, and a list of possible responses that can be selected by a user to send in response to a received message. <i>See</i> Pepe at 36:16-20, 36:38-51, Figs. 42, 45. As explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe’s PDA/cell phone with Johnson’s forced-response message system.</p>
<p>[means for receiving and displaying a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have</p>	<p>Hammond discloses the function, and Pepe discloses the structure, recited in this limitation. In particular, Hammond tracks which recipients have automatically acknowledged a forced-message alert. <i>See</i> Hammond at 2:11-15</p>

<p>not automatically acknowledged the forced message alert;]</p>	<p>(disclosing that Hammond’s system tracks “message delivery information and message review information”); <i>see also id.</i> at 5:17-8:45, (disclosing additional details about the Message Receipt Tracker component and Message Tracking Table Processor component), Fig. 2 (illustrating an example Message Tracking Table). Hammond also tracks which recipients have not automatically acknowledged the forced message alert. <i>See id.</i> at 2:11-15 (disclosing that Hammond’s system “specifies actions to take when a message is not delivered or not reviewed within a specified period of time.”); <i>see also id.</i> at 5:17-8:45 (disclosing additional details about the Message Receipt Tracker component), FIG. 2 (illustrating an example Message Tracking Table). Despite disclosing these claimed functions, Hammond does not disclose the claimed structure—i.e., application software on a PDA—required by this means-plus-function limitation.</p> <p>But, Pepe discloses this structure. Specifically, Pepe discloses application software that is resident on the PDA/cell phone. <i>See Pepe</i> at 5:17-20, 34:9-36:51, Figs. 28-45. And, as explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe’s PDA/cell phone with Hammond’s forced-response message system.</p>
<p>[means for periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced message alert; and]</p>	<p>Hammond discloses the claimed function, and Pepe discloses the claimed structure. In particular, Hammond’s “system tracks whether each message has been delivered and reviewed by to [sic] each recipient, and uses the message information to resend the messages whose delivery or review is not confirmed.” Hammond at 2:47-50; <i>see also id.</i> at Abstract, 2:1-8, 4:21-28, 5:6-20, 6:66-7:63, 10:48-63, Figs. 2, 3A-3B, 4, 5A-5B. Despite disclosing this function, Hammond does not disclose the claimed structure—i.e., application software on a PDA—required by this means-plus-function limitation.</p> <p>But, Pepe discloses this structure. Specifically, Pepe discloses application software that is</p>

	<p>resident on the PDA/cell phone. <i>See</i> Pepe at 5:17-20, 34:9-36:51, Figs. 28-45. And, as explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe's PDA/cell phone with Hammond's forced-response message system.</p>
<p>[means for receiving and displaying a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert and details the response from each recipient PDA/cell phone that responded.]</p>	<p>Hammond discloses the claimed function, and Pepe discloses the claimed structure. In particular, Hammond discloses a "Message Receipt Tracker component [that] attempts to identify when sent messages have been delivered to recipients and when sent messages have been reviewed by recipients." Hammond at 5:17-20; see also <i>id.</i>, 5:20-6:55. Hammond's Figure 2 shows a Message Tracking Table that includes detailed information about electronic messages that have been read by recipients. <i>See id.</i> at 6:56-8:45. And, Hammond discloses a Message Receipt Tracker routine, <i>id.</i> at Fig. 4, 10:5-47, and a Message Tracking Table Processor routine, <i>id.</i> at Figs. 5A, 5B, 10:48-11:48. Despite disclosing these functions, Hammond does not expressly disclose the claimed structure—i.e., application software on a PDA—required by this means-plus-function limitation.</p> <p>But, Pepe discloses this structure. Specifically, Pepe discloses application software that is resident on the PDA/cell phone. <i>See</i> Pepe at 5:17-20, 34:9-36:51, Figs. 28-45. And, as explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe's PDA/cell phone with Hammond's force response message system.</p>
<p>. . . wherein the forced message alert software application program on the recipient PDA/cell phone includes:</p>	<p>Hammond and Johnson each disclose a "recipient PDA/cell phone" as claimed. In particular, Hammond and Johnson each disclose systems for requiring a response to an electronic message. <i>See</i> Hammond at Abstract, 1:66-2:50, 3:31-4:28, 6:3-19, 9:12-15; Johnson at Abstract, 1:58-61, 3:64-4:2, 4:28-39, 5:1-6:65, 7:46-62, Fig. 6. Yet neither Hammond nor Johnson discloses a software-application program that is loaded on each PDA/cell phone and that includes a list of possible responses.</p>

	<p>Pepe supplies this missing disclosure. Pepe discloses “forced message alert software application program on the recipient PDA/cell phone” as claimed. For example, Pepe discloses “application software residing in the PDA” that is described in Pepe by “the screens displayed on a PCI subscriber’s PDA.” Pepe at 34:10-15; <i>see also id.</i> at 5:17-20 (“The application residing in the PDA is described in FIGS. 28-45, which illustrate exemplary screens displayed to a PCI subscriber using a wireless PDA”), 34:9-36:51, Figs. 28-45. Specifically, Pepe’s Figures 42 and 45 are exemplary screens that may appear when a user wants to edit a message to be sent to another PDA/cell phone. Each of these screens includes a list of possible responses (i.e., box 710 in Figure 42 and box 734 in Figure 45) that can be selected by the user to send in response to a received message. <i>See id.</i> at 36:16-20, 36:38-51.</p> <p>As explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe’s PDA/cell phone with the forced response message systems of Hammond and Johnson.</p>
<p>means for transmitting the acknowledgment of receipt to said sender PDA/cell phone immediately upon receiving a forced message alert from the sender PDA/cell phone;</p>	<p>Hammond and Johnson disclose the claimed function, and Pepe discloses the claimed structure. Hammond and Johnson each disclose “transmitting the acknowledgment of receipt to said sender PDA/cell phone immediately upon receiving a forced message alert from the sender PDA/cell phone” as claimed. For example, Hammond and Johnson disclose that a transmitted message requires the recipient device to transmit an automatic acknowledgement as soon as the message is received by the recipient device. <i>See</i> Hammond at 1:46-54, 5:17-44, 11:55-12:6; Johnson at 1:58-61, 2:6-15, 3:64-4:1. Pepe discloses the claimed structure required by this means-plus-function limitation. For example, Pepe discloses application software that is resident on the PDA/cell phone. <i>See</i> Pepe, 5:17-20, 34:9-36:51, Figs. 28-45.</p>

	<p>As explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe's PDA/cell phone with the forced-response message systems of Hammond and Johnson.</p>
<p>means for controlling of the recipient PDA/cell phone upon transmitting said automatic acknowledgment and causing, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PDA/cell phone or causes, in cases where the forced message alert is a voice message, the voice message being periodically repeated by the speakers of the recipient PDA/cell phone while said response list is shown on the display;</p>	<p>Pepe discloses the structure and Hammond and Johnson disclose the claimed function of this limitation. First, Johnson discloses "controlling of the recipient PDA/cell phone upon transmitting said automatic acknowledgment" as claimed. For example, Johnson's electronic mail object takes control of a device and response must be provided by a recipient in order to clear a received message from recipient's display. <i>See</i> Johnson at 4:27-31 ("[T]he sender of the electronic mail object may mark or associate an attribute with the electronic mail object such that it cannot be exited out of until the appropriate reply has been made."); <i>see also id.</i> at 4:18-42.</p> <p>Second, Hammond discloses "causing, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PDA/cell phone or causes, in cases where the forced message alert is a voice message, the voice message being periodically repeated by the speakers of the recipient PDA/cell phone while said response list is shown on the display" as claimed. For example, Hammond explains that "electronic messages" can include email, text, and voice messages. Hammond at 1:13-16, 1:21-26. Hammond's "system tracks whether each message has been delivered and reviewed by to [sic] each recipient, and uses the message information to resend the messages whose delivery or review is not confirmed." <i>Id.</i> at 2:47-50; <i>see also id.</i> at Abstract, 2:1-8, 4:21-28, 5:6-20, 6:66-7:63, 10:48-63, Figs. 2, 3A-3B, 4, 5A-5B.</p> <p>Third, Pepe discloses the claimed structure required by this means-plus-function limitation. For example, Pepe discloses the "application software residing in the PDA" that is described in Pepe by "the screens displayed on a PCI subscriber's PDA." Pepe at 34:10-15; <i>see also id.</i> at 5:17-20 ("The application residing in the PDA is</p>

	<p>described in FIGS. 28-45, which illustrate exemplary screens displayed to a PCI subscriber using a wireless PDA.”), 34:9-36:51, Figs. 28-45. Specifically, Pepe’s Figures 42 and 45 are exemplary screens that may appear when a user wants to edit a message to be sent to another PDA/cell phone. Each of these screens includes a list of possible responses (i.e., box 710 in Figure 42 and box 734 in Figure 45) that can be selected by the user to send in response to a received message. <i>See id.</i> at 36:16-20, 36:38-51.</p> <p>As explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe’s PDA/cell phone with Hammond and Johnson’s forced-response message system.</p>
<p>means for allowing a manual response to be manually selected from the response list or manually recorded and transmitting said manual response to the sender PDA/cell phone; and</p>	<p>Hammond discloses the claimed function, and Pepe discloses the claimed structure. Hammond discloses “allowing a manual response to be manually selected from the response list or manually recorded and transmitting said manual response to the sender PDA/cell phone” as claimed. In particular, Hammond discloses a “Message Receipt Tracker component [that] attempts to identify when sent messages have been delivered to recipients and when sent messages have been reviewed by recipients.” Hammond at 5:17-20; <i>see also id.</i> at 5:20-6:55. Hammond’s Figure 2 shows a Message Tracking Table that includes detailed information about electronic messages that have been read by recipients. <i>See id.</i> at 6:56-8:45. And, Hammond discloses a Message Receipt Tracker routine, <i>id.</i> at FIG. 4, 10:5-47, and a Message Tracking Table Processor routine, <i>id.</i> at Figs. 5A, 5B, 10:48-11:48. Thus, Hammond teaches or suggests “allowing a manual response to be manually selected from the response list or manually recorded and transmitting said manual response” as claimed. Despite disclosing these functions, Hammond does not expressly disclose the claimed structure—i.e., application software on a PDA—required by this means-plus-function limitation.</p>

	<p>But Pepe discloses the required structure of this means-plus-function limitation. Specifically, Pepe discloses application software that is resident on the PDA/cell phone. See Pepe at 5:17-20, 34:9-36:51, Figs. 28-45. And, as explained above, a person of ordinary skill in the art would have been motivated to combine Pepe's PDA/cell phone with Hammond's forced-response message system.</p>
<p>means for clearing the text message and a response list from the display of the recipient PDA/cell phone or stopping the repeating voice message and clearing the response list from the display of the recipient PDA/cell phone once the manual response is transmitted.</p>	<p>As set forth above, Pepe provides the structure and Johnson discloses the function of this limitation. Johnson at 4:18-42; Pepe at 5:17-20, 34:9-36:51, Figs. 28-45. Johnson discloses "clearing the text message and a response list from the display of the recipient PDA/cell phone or stopping the repeating voice message and clearing the response list from the display of the recipient PDA/cell phone once the manual response is transmitted" as claimed. In particular, Johnson discloses that "the sender of the electronic mail object may mark or associate an attribute with the electronic mail object such that it cannot be exited out of until the appropriate reply has been made" Johnson at 4:27-31; see also <i>id.</i> at 4:18-24, 4:33-42.</p> <p>And, Pepe discloses the structure required by this means-plus-function limitation. For example, Pepe discloses application software that is resident on the PDA/cell phone, Pepe at 5:17-20, 34:9-36:51, Figs. 28-45, and a list of possible responses that can be selected by a user to send in response to a received message, <i>id.</i> at 36:16-20, 36:38-51, Figs. 42, 45. As explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe's PDA/cell phone with Johnson's forced-response system.</p>
<p>10. A method of receiving, acknowledging and responding to a forced message alert from a sender PDA/cell phone to a recipient PDA/cell phone, wherein the receipt, acknowledgment, and response to said forced message alert is forced by a forced message alert software application program, said method comprising the steps of:</p>	<p>Hammond and Johnson disclose "receiving, acknowledging and responding to a forced message alert from a sender PDA/cell phone to a recipient PDA/cell phone, wherein the receipt, acknowledgment, and response to said forced message alert is forced" as claimed. For example, Hammond and Johnson each disclose communication systems for transmitting,</p>



	<p>receiving, and responding to electronic messages. See Hammond at Abstract, 2:11-18; Johnson at Abstract, 3:4-15, Fig. 1. And, Hammond's and Johnson's systems include receipt, acknowledgement" of electronic messages, as claimed. See Hammond at 3:1-30, 1:46-54; 5:17-61; Johnson at 1:58-61, 3:64-4:2.</p> <p>Hammond and Johnson each disclose systems for requiring a response to an electronic message. See Hammond at Abstract, 1:66-2:50, 3:31-4:28, 6:3-19, 9:12-15; Johnson at Abstract, 1:58-61, 3:64-4:2, 4:28-39, 5:1-6:65, 7:46-62, Fig. 6. Yet, neither Hammond nor Johnson discloses a software-application program that is loaded on each PDA/cell phone and that includes a list of possible responses.</p> <p>Pepe supplies this missing disclosure. First, Pepe discloses "receiving, acknowledging and responding to a forced message alert from a sender PDA/cell phone to a recipient PDA/cell phone," as claimed. For example, Pepe discloses communication systems for transmitting, receiving, and responding to electronic messages. See Pepe at Abstract, 3:45-57, 5:28-14:21, Figs. 1-6. And, Pepe expressly discloses a sender PDA/cell phone and at least one recipient PDA/cell phone for each electronic message. Pepe explains that a first PDA/cell phone can send a message to a second PDA/cell phone. See <i>id.</i> at 33:5-52, Figs. 25-26; see also <i>id.</i> at Figs. 1-6 (showing PDAs in a network), 9:1-6 (explaining that a plurality of PDAs may be connected to a wireless network and messages may be sent to and from those PDAs.</p> <p>Second, Pepe discloses "wherein the receipt, acknowledgment, and response to said forced message alert is ... by a forced message alert software application program" as claimed. For example, Pepe discloses "application software residing in the PDA" that is described in Pepe by "the screens displayed on a PCI subscriber's PDA." Pepe at 34:10-15; see also <i>id.</i> at 5:17-20 ("The application residing in the PDA is described in FIGS. 28-45, which illustrate exemplary screens displayed to a PCI subscriber</p>
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	<p>using a wireless PDA.”), 34:9-36:51, Figs. 28-45. Specifically, Pepe’s Figures 42 and 45 are exemplary screens that may appear when a user wants to edit a message to be sent to another PDA/cell phone. Each of these screens includes a list of possible responses (i.e., box 710 in Figure 42 and box 734 in Figure 45) that can be selected by the user to send in response to a received message. <i>See id.</i> at 36:16-20, 36:38-51.</p> <p>As explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe’s PDA/cell phone with the forced-response message systems of Hammond and Johnson.</p>
<p>receiving an electronically transmitted electronic message;</p> <p>identifying said electronic message as a forced message alert, wherein said forced message alert comprises of a voice or text message and a forced message alert application software packet, which triggers the activation of the forced message alert software application program within the recipient PDA/cell phone;</p>	<p>The combination of Hammond, Johnson, and Pepe disclose this limitation. Hammond and Johnson disclose “receiving an electronically transmitted electronic message; identifying said electronic message as a forced message alert, wherein said forced message alert comprises of a voice or text message and a forced message alert application software packet, which triggers the activation of the . . . application program within the recipient PDA/cell phone” as claimed. In particular, Hammond and Johnson each alone discloses the transmission of forced message alerts to recipient computers. <i>See</i> Hammond at Abstract, 1:66-2:50, 3:1-4:28, 5:17-61, 6:3-19; Johnson at 1:58-61, 2:3-35, 3:64-4:42, 6:60-65. But, Hammond and Johnson do not explicitly disclose application software on a PDA/cell phone as required.</p> <p>Pepe, however, discloses “forced message alert software application program within the recipient PDA/cell phone” as claimed. For example, Pepe discloses “application software residing in the PDA.” <i>See</i> Pepe at 5:17-20, 34:9-36:51, Figs. 28-45. As explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe’s PDA/cell phone with the forced-response message systems of Hammond and Johnson.</p>
<p>transmitting an automatic acknowledgment of receipt to the sender PDA/cell phone, which</p>	<p>First, Hammond and Johnson disclose “transmitting an automatic acknowledgment of</p>

<p>triggers the forced message alert software application program to take control of the recipient PDA/cell phone and show the content of the text message and a required response list on the display recipient PDA/cell phone or to repeat audibly the content of the voice message on the speakers of the recipient PDA/cell phone and show the required response list on the display recipient PDA/cell phone; and</p>	<p>receipt to the sender PDA/cell phone” as claimed. Hammond and Johnson each discloses that the transmitted message requires the recipient device to transmit an automatic acknowledgement as soon as the message is received by the recipient device. <i>See</i> Hammond at 1:46-54, 5:17-44, 11:55-12:6; Johnson at 1:58-61, 2:6-15, 3:64-4:1.</p> <p>Second, Johnson discloses “which triggers the . . . application program to take control of the recipient PDA/cell phone” as claimed. For example, Johnson states that “[t]he recipient of the electronic mail object is prompted for a specific response in response to the recipient opening an electronic mail object and is prohibited from performing a selected action until the specific response has been entered by the recipient.” Johnson at Abstract. Thus, Johnson demonstrates that the email application takes control of a recipient device until the recipient provides a specific response.</p> <p>Third, Hammond and Johnson also disclose “show the content of the text message and a required response . . . on the display recipient PDA/cell phone or to repeat audibly the content of the voice message on the speakers of the recipient PDA/cell phone and show the required response . . . on the display recipient PDA/cell phone ” as claimed. For example, Hammond and Johnson’s electronic messages include text and voice messages. Hammond at 1:13-16; Johnson at 4:1-2; <i>see also</i> Johnson at 4:3-18. Johnson discloses a “mechanism for forcing a recipient to reply to an electronic mail object . . . the mechanism may prevent the deletion and archival of the note or image until an appropriate reply is made.” Johnson at 4:4-28. Thus, the content of the text or voice message remains on the display or is repeated until the recipient provides the required response. And, Hammond’s “system tracks whether each message has been delivered and reviewed by to [sic] each recipient, and uses the message information to resend the messages whose delivery or review is not confirmed.” Hammond at 2:47-50; <i>see also id.</i> at</p>
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	<p>Abstract, 2:1-8, 4:21-28, 5:6:19, 6:66-7:63, 10:48-63, Figs. 2, 3 A, 3B, 4, 5A, 5B.</p> <p>But, Hammond and Johnson do not explicitly disclose application software on a PDA/cell phone, nor do these references explicitly disclose a list of possible required responses.</p> <p>Pepe, however, supplies both limitations. Pepe discloses “the forced message alert software application program . . . of the recipient PDA/cell phone” and the “required response list” as claimed. As set forth above, Pepe discloses “application software residing in the PDA.” See Pepe at 5:17-20, 34:9-36:51, Figs. 28-45. And, as set forth above, Pepe discloses a list of possible responses that can be selected by a user to send in response to a received message. See <i>id.</i> at 36:16-20, 36:38-51, Figs. 42, 45.</p> <p>As explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe’s PDA/cell phone with the forced-response message systems of Hammond and Johnson.</p>
<p>transmitting a selected required response from the response list in order to allow the message required response list to be cleared from the recipient’s cell phone display, whether said selected response is a chosen option from the response list, causing the forced message alert software to release control of the recipient PDA/cell phone and stop showing the content of the text message and a response list on the display recipient PDA/cell phone and or stop repeating the content of the voice message on the speakers of the recipient PDA/cell phone;</p>	<p>As set forth above, the combination of Pepe and Johnson discloses the features of this limitation. Johnson discloses “transmitting a selected required response . . . in order to allow the message . . . to be cleared from the recipient’s cell phone display, whether said selected response is a chosen option . . . causing the . . . software to release control of the recipient PDA/cell phone and stop showing the content of the text message and a response . . . on the display recipient PDA/cell phone and or stop repeating the content of the voice message on the speakers of the recipient PDA/cell phone” as claimed. As Johnson takes control until an appropriate reply is made as described above, Johnson also releases control once the reply is made. Johnson at 4:11-42.</p> <p>Pepe discloses the “response list” as claimed as well as the “forced message alert software . . . of the recipient PDA/cell phone” as claimed. For example, Pepe discloses application software that</p>

	<p>is resident on the PDA/cell phone, Pepe at 5:17-20, 34:9-36:51, Figs. 28-45, and a list of possible responses that can be selected by a user to send in response to a received message, <i>id.</i> at 36:16-20, 36:38-51, Figs. 42, 45. As explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe's PDA/cell phone with Johnson's forced-response system.</p>
<p>displaying the response received from the PDA[/] cell phone that transmitted the response on the sender of the forced alert PDA/cell phone; and</p>	<p>Hammond and Pepe disclose the claimed limitation. Hammond discloses "displaying the response received from the PDA[/]cell phone that transmitted the response on the sender of the forced alert PD A/cell phone" as claimed. In particular, Hammond discloses a "Message Receipt Tracker component [that] attempts to identify when sent messages have been delivered to recipients and when sent messages have been reviewed by recipients." Hammond at 5:17-20; <i>see also id.</i> at 5:20-6:55. Hammond's Figure 2 shows a Message Tracking Table that includes detailed information about electronic messages that have been read by recipients. <i>See id.</i> at 6:56-8:45. And, Hammond discloses a Message Receipt Tracker routine, <i>id.</i> at Fig. 4, 10:5-47, and a Message Tracking Table Processor routine, <i>id.</i> at Figs. 5A-5B, 10:48-11:48.</p> <p>Hammond does not expressly disclose the application software on a PDA. But, Pepe discloses this structure. Specifically, Pepe discloses application software that is resident on the PDA/cell phone. <i>See</i> Pepe at 5:17-20, 34:9-36:51, Figs. 28-45. And, as explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe's PDA/cell phone with Hammond's forced-response message system.</p>
<p>providing a list of the recipient PDA/cell phones have automatically acknowledged receipt of a forced alert message and their response to the forced alert message.</p>	<p>Hammond discloses "providing a list of the recipient PDA/cell phones [that] have automatically acknowledged receipt of a forced alert message and their response to the forced alert message" as claimed. In particular, Hammond tracks which recipients have automatically acknowledged a forced-message alert. <i>See</i> Hammond at 2:11-15</p>

	<p>(disclosing that Hammond's system tracks "message delivery information and message review information"); <i>see also id.</i> at 5:17-8:45 (disclosing additional details about the Message Receipt Tracker component and Message Tracking Table Processor component), Fig. 2 (illustrating an example Message Tracking Table). Hammond also tracks which recipients have not automatically acknowledged the forced message alert. <i>See id.</i> at 2:11-15 (disclosing that Hammond's system "specifies actions to take when a message is not delivered or not reviewed within a specified period of time"); <i>see also id.</i> at 5:17-8:45, (disclosing additional details about the Message Receipt Tracker component), Fig. 2 (illustrating an example Message Tracking Table). Despite disclosing these claimed functions, Hammond does not disclose the application software on a PDA.</p> <p>But, Pepe discloses this structure. Specifically, Pepe discloses application software that is resident on the PDA/cell phone. <i>See Pepe</i> at 5:17-20, 34:9-36:51, Figs. 28-45. And, as explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe's PDA/cell phone with Hammond's forced-response message system.</p>
<p>11. The method as in claim 10, wherein each PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it.</p>	<p>Hammond, Johnson, and Pepe each disclose "a predetermined network of participants," as claimed. <i>See Hammond</i> at Abstract, 2:11-18; <i>Johnson</i> at Abstract, 2:16-31, 3:4-15, Fig. 1; <i>Pepe</i> at Abstract, 3:45-58, 5:28-14:21, Figs. 1-6. But, Hammond's and Johnson's networks include "computers." <i>See, e.g., Hammond</i> at 4:29-47, Fig. 1 (describing computer systems 100, 150, 160, 170, and 180); <i>Johnson</i> at 3:4-4:2, Fig. 1 (describing computers 12 and 30 in LAN 10 and 32).</p> <p>To the extent that Hammond and Johnson's disclosure of "computers" is found to not encompass a PDA/cell phone, Pepe supplies this missing disclosure. Pepe discloses "each PDA/cell phone within a predetermined communication network is similarly equipped</p>

	<p>and has the forced message alert software application program loaded on it” as claimed. For example, Pepe’s Figures 1-6 show a plurality of PDA/cell phones interacting in a network. <i>See also</i> Pepe at 5:28-14:21. Each PDA includes a CPU, an input-output device, a display, and a memory. <i>See id.</i> at 16:50-61, Fig. 12.</p> <p>Pepe discloses application software that is resident on the PDA/cell phone. <i>See</i> Pepe at 5:17-20, 34:9-36:51, Figs. 28-45. And, as explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe’s PDA/cell phone with Hammond and Johnson’s forced-response message system.</p>
<p>12. The method as in claim 10, wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program.</p>	<p>Pepe discloses “said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program” as claimed. For example, Pepe discloses application software residing in the PDA. Pepe at 5:17-20, 34:9-36:51, Figs. 28-45. In Figures 42 and 45, Pepe shows a list of possible responses (i.e., box 710 in Figure 42 and box 734 in Figure 45) that can be selected by the user to send in response to a received message. <i>See id.</i> at 36:16-20, 36:38-51. A person of ordinary skill in the art at the time of invention would have understood Pepe’s list of possible responses to teach or suggest the claimed default response list.</p>
<p>13. The method as in claim 10, wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PDA/cell phone.</p>	<p>Pepe discloses “said forced message alert application software packet contains a response list, wherein said response list is a custom response list” as claimed. Specifically, Pepe discloses application software residing in the PDA. Pepe at 5:17-20, 34:9-36:51, Figs. 28-45. Pepe’s Figures 42 and 45 show lists of possible responses. And, Pepe says that “[t]he user may compose a unique message in box 708 or edit one already on a list shown in box 710.” <i>Id.</i> at 36:16-20.</p> <p>Johnson discloses “said response . . . is a custom response list that is created at the time the specific forced message alert is created on the</p>

	<p>sender PDA/cell phone” as claimed. For example, Johnson discloses that the sender of a forced-response message may set certain “persistent reply attributes” that “govern user interaction for forcing a reply containing data from the recipient of the electronic mail object.” Johnson at 4:33-39; <i>see also id.</i> at 5:43-6:65. A person of ordinary skill in the art at the time of invention would have understood that Johnson’s persistent reply attributes are compatible with Pepe’s teachings, and could have been used to specify a custom response list to be displayed on a recipient’s PDA/cell phone, as taught by Pepe.</p> <p>And, as explained above, a person of ordinary skill in the art at the time of invention would have been motivated to combine Pepe’s PDA/cell phone with Johnson’s forced-response message system.</p>
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**Conclusion**

In order to ensure full consideration of any amendments, affidavits or declarations, or other documents as evidence of patentability, such documents must be submitted in response to this Office action. Submissions after the next Office action, which is intended to be a final action, will be governed by the requirements of 37 CFR 1.116, after final rejection and 37 CFR 41.33 after appeal, which will be strictly enforced.

**All correspondence relating to this *ex parte* reexamination proceeding should be directed:**

By Mail to:           Mail Stop *Ex Parte* Reexam  
                          Central Reexamination Unit  
                          Commissioner for Patents  
                          United States Patent & Trademark Office  
                          P.O. Box 1450  
                          Alexandria, VA 22313-1450

By FAX to:           (571) 273-9900  
                          Central Reexamination Unit

By hand:             Customer Service Window  
                          Randolph Building  
                          401 Dulany Street  
                          Alexandria, VA 22314

Any inquiry concerning this communication should be directed to Central Reexamination Unit at telephone number (571) 272-7705.

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Supervisory Patent Examiner, Art Unit 3992





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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
90/014,507	05/15/2020	8213970	2525.993REX0

**CONFIRMATION NO. 6188**

**POWER OF ATTORNEY NOTICE**



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Date Mailed: 09/18/2020

**NOTICE REGARDING CHANGE OF POWER OF ATTORNEY**

This is in response to the Power of Attorney filed 09/15/2020.

- The Power of Attorney to you in this application has been revoked by the assignee who has intervened as provided by 37 CFR 3.71. Future correspondence will be mailed to the new address of record(37 CFR 1.33).

Questions about the contents of this notice and the requirements it sets forth should be directed to the Office of Data Management, Application Assistance Unit, at (571) 272-4000 or (571) 272-4200 or 1-888-786-0101.

/rbell/



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Bib Data Sheet

CONFIRMATION NO. 9036

Table with 5 columns: SERIAL NUMBER (12/324,122), FILING OR 371(c) DATE (11/26/2008), CLASS (455), GROUP ART UNIT (2617), ATTORNEY DOCKET NO. (10963.3819)

AIA (First Inventor to File): NO

INVENTORS

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APPLICANTS

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\*\* CONTINUING DATA \*\*\*\*\*

This application is a CIP of 11/612,830 12/19/2006 PAT 7853273
which is a CIP of 11/308,648 04/17/2006 PAT 7630724
which is a CIP of 10/711,490 09/21/2004 PAT 7031728

\*\* FOREIGN APPLICATIONS \*\*\*\*\*

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12/08/2008

Table with 5 columns: Foreign Priority claimed (yes/no), 35 USC 119 (a-d) conditions met (yes/no/Met after Allowance), STATE OR COUNTRY (FL), SHEETS DRAWING (6), TOTAL CLAIMS (14), INDEPENDENT CLAIMS (3)

ADDRESS

172615

TITLE

METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS

FILING FEE RECEIVED 762

FEES: Authority has been given in Paper
No. \_\_\_\_\_ to charge/credit DEPOSIT ACCOUNT
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CONFIRMATION NO. 1477

Table with 5 columns: SERIAL NUMBER (90/014,509), FILING OR 371(c) DATE (05/15/2020), CLASS (455), GROUP ART UNIT (3992), ATTORNEY DOCKET NO. (2525.995REX0)

AIA (First Inventor to File): YES

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APPLICANTS

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\*\* CONTINUING DATA \*\*\*\*\*

This application is a REX of 14/633,804 02/27/2015 PAT 9445251
which is a CON of 14/529,978 10/31/2014 PAT 9467838
which is a CIP of 14/027,410 09/16/2013 PAT 8880042
which is a CON of 13/751,453 01/28/2013 PAT 8538393
which is a CIP of 12/761,533 04/16/2010 PAT 8364129
which is a CIP of 11/615,472 12/22/2006 PAT 8126441
which is a CIP of 11/308,648 04/17/2006 PAT 7630724
which is a CIP of 10/711,490 09/21/2004 PAT 7031728

\*\* FOREIGN APPLICATIONS \*\*\*\*\*

Table with 5 columns: Foreign Priority claimed (yes/no), 35 USC 119 (a-d) conditions met (yes/no/Met after Allowance), STATE OR COUNTRY, SHEETS DRAWING, TOTAL CLAIMS (35), INDEPENDENT CLAIMS (2). Includes fields for Verified and Acknowledged, Examiner's Signature, and Initials.

ADDRESS
172615

TITLE
METHOD TO PROVIDE AD HOC AND PASSWORD PROTECTED DIGITAL AND VOICE NETWORKS

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No. \_\_\_\_\_ for following:

1.16 Fees ( Filing )

1.17 Fees ( Processing Ext. of  
time )

1.18 Fees ( Issue )

Other \_\_\_\_\_

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
90/014,507	05/15/2020	8213970	2525.993REX0

**CONFIRMATION NO. 6188**

**POA ACCEPTANCE LETTER**

172615  
Fabricant LLP  
230 Park Avenue, 3FL W.  
New York, NY 10169



Date Mailed: 09/18/2020

**NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY**

This is in response to the Power of Attorney filed 09/15/2020.

The Power of Attorney in this application is accepted. Correspondence in this application will be mailed to the above address as provided by 37 CFR 1.33.

Questions about the contents of this notice and the requirements it sets forth should be directed to the Office of Data Management, Application Assistance Unit, at (571) 272-4000 or (571) 272-4200 or 1-888-786-0101.

/rbell/

Under the Paperwork Reduction Act of 1995 no person is required to respond to a collection of information unless it displays a valid OMB control number.

<b>REEXAMINATION -- PATENT OWNER                  POWER OF ATTORNEY OR                  REVOCATION OF POWER OF ATTORNEY                  WITH A NEW POWER OF ATTORNEY                  AND                  CHANGE OF CORRESPONDENCE ADDRESS</b>	Control Number(s)	90/D14,507
	Filing Date(s)	05/15/2020
	First Named Inventor	Beyer Jr., Malcolm K.
	Title	Method of rolling based alerts for proactive remote communications
	Patent Number	8,213,970
	Examiner Name	KISS, ERIC B.
Attorney Docket No(s)	102.0002 REX02	

I hereby revoke all previous patent owner powers of attorney given in the above-identified reexamination proceeding control number(s).

A Power of Attorney is submitted herewith.

OR

I hereby appoint Practitioner(s) associated with the Customer Number identified in the box at right as my/our attorney(s) or agent(s) to prosecute the proceeding(s) identified above, and to transact all business in the United States Patent and Trademark Office connected therewith:

OR

I hereby appoint Practitioner(s) named below as my/our attorney(s) or agent(s) to prosecute the proceeding(s) identified above, and to transact all business in the United States Patent and Trademark Office connected therewith:

Practitioner(s) Name	Registration Number
Vincent J. Rufo, II	89,594
Peter Lamprinoskos	89,226
Enrique W. Bernalde	72,885
Alan Zhang	82,897

Please recognize or change the correspondence address for the above-identified reexamination proceeding control number(s) (more than one may be changed only if they are merged proceedings) to be:

The address associated with the above-identified Customer Number.

OR

The address associated with the Customer Number identified in the box at right: **172615**

OR

Firm or Individual Name

Address

City State Zip

Country

Telephone Email

I am the:

Inventor, having ownership of the patent being reexamined.

OR

Patent owner.

Statement under 37 CFR 3.73(b) (Form PTO/SB/96) submitted herewith or filed on \_\_\_\_\_

**SIGNATURE of inventor or Patent Owner**

Signature	<i>Malcolm K. Beyer Jr.</i>	Date	September 14, 2020
Name	Malcolm K. Beyer, Jr.	Telephone	761-744-5010
Title and Company	CEO, AQMI Software Development LLC		

**NOTE:** Signatures of all the inventors or patent owners of the entire interest or their representative(s) are required. If more than one signature is required, submit multiple forms, check the box below, and identify the total number of forms submitted in the blank below.

A total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 37 CFR 1.31, 1.32, and 1.33. The information is required to obtain or retain a benefit by the public, which is to update (and by the USPTO to process) the file of a patent or reexamination proceeding. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.34. This collection is estimated to take 15 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*



## Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**STATEMENT UNDER 37 CFR 3.73(b)**Applicant/Patent Owner: AGIS Software Development LLCApplication No./Patent No.: 9,213,970Filed/Issue Date: 07/03/2012

Titled:

Method of utilizing forced alerts for interactive remote communications

AGIS Software Development LLC

a limited liability company

(Name of Assignee)

(Type of Assignee, e.g., corporation, partnership, university, government agency, etc)

states that it is:

1.  the assignee of the entire right, title, and interest in;
2.  an assignee of less than the entire right, title, and interest in  
(The extent (by percentage) of its ownership interest is \_\_\_\_\_ %); or
3.  the assignee of an undivided interest in the entirety of (a complete assignment from one of the joint inventors was made)

the patent application/patent identified above, by virtue of either:

- A.  An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or a copy\* is attached.

OR

- B.  A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as follows:

1. From: Malcolm K. Beyer Jr. et al. To: Advanced Ground Information Systems, Inc.

The document was recorded in the United States Patent and Trademark Office at  
Reel 028362 Frame 0435 or a copy\* is attached.

2. From: Advanced Ground Information Systems, Inc. To: AGIS Holdings, Inc.

The document was recorded in the United States Patent and Trademark Office at  
Reel 042759 Frame 0661 or a copy\* is attached.

3. From: AGIS Holdings, Inc. To: AGIS Software Development LLC

The document was recorded in the United States Patent and Trademark Office at  
Reel 042760 Frame 0102 or a copy\* is attached.

Additional documents in the chain of title are listed on a supplemental sheet(s).

\*As required by 37 CFR 3.73(b)(1)(i), if a copy/copies is/are attached, the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11.

[NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, to record the assignment in the records of the USPTO. See MPEP 302.]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

Signature

September 14, 2020

Date

Malcolm K. Beyer Jr.

CEO

Printed or Typed Name

Title or Registration Number

This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22310-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

## Privacy Act Statement

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The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
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6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
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9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

## Electronic Acknowledgement Receipt

<b>EFS ID:</b>	40568533
<b>Application Number:</b>	90014507
<b>International Application Number:</b>	
<b>Confirmation Number:</b>	6188
<b>Title of Invention:</b>	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS
<b>First Named Inventor/Applicant Name:</b>	8213970
<b>Customer Number:</b>	22235
<b>Filer:</b>	Jialin Zhong/Eddie Rowell
<b>Filer Authorized By:</b>	Jialin Zhong
<b>Attorney Docket Number:</b>	2525.993REX0
<b>Receipt Date:</b>	15-SEP-2020
<b>Filing Date:</b>	15-MAY-2020
<b>Time Stamp:</b>	22:32:04
<b>Application Type:</b>	Reexam (Patent Owner)

### Payment information:

Submitted with Payment	no
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### File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Power of Attorney	970_poa.pdf	1161080  <small>c8f68027d103eb7d290531ac59d8fb4aef5fd717</small>	no	2

### Warnings:

Information:					
2	Assignee showing of ownership per 37 CFR 3.73	970_sb96.pdf	1186443	no	2
			dbcd5f24d02761721bf1f15db01eb9b1980da1f0		
Warnings:					
Information:					
Total Files Size (in bytes):				2347523	
<p><b>This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.</b></p> <p><b><u>New Applications Under 35 U.S.C. 111</u></b>  <b>If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.</b></p> <p><b><u>National Stage of an International Application under 35 U.S.C. 371</u></b>  <b>If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.</b></p> <p><b><u>New International Application Filed with the USPTO as a Receiving Office</u></b>  <b>If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.</b></p>					



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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO. Includes application details for 90/014,507 and examiner information for KISS, ERIC B.

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)

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
1100 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

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

REEXAMINATION CONTROL NO. 90/014,507 .

PATENT UNDER REEXAMINATION 8213970 .

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)).

<b>Order Granting Request For Ex Parte Reexamination</b>	<b>Control No.</b> 90/014,507	<b>Patent Under Reexamination</b> 8213970	
	<b>Examiner</b> ERIC B KISS	<b>Art Unit</b> 3992	<b>AIA (FITF) Status</b> No

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

The request for *ex parte* reexamination filed 05/15/2020 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a)  PTO-892, b)  PTO/SB/08, c)  Other: \_\_\_\_\_

1.  The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

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cc:Requester ( if third party requester )



### ORDER GRANTING *EX PARTE* REEXAMINATION

A substantial new question of patentability affecting claims 2 and 10-13 of U.S. Pat. 8,213,970 is raised by the request for *ex parte* reexamination.

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties 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).

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 8,213,970 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 §§ 2207, 2282 and 2286.

#### Related Proceedings

The examiner is aware of the following related matters:

The '970 patent is currently involved in the litigation styled *AGIS Software Dev., LLC v. Google LLC*, Case No. 2:19-cv-00361 (E.D. Tex.), which was filed on November 4, 2019.

The '970 patent was involved in an *Inter Partes* Review of claims 1 and 3-9, in which a Final Written Decision found the challenged claims unpatentable. See *Google LLC v. AGIS Software Dev., LLC*, IPR2018-01079, Final Written Decision (P.T.A.B. Nov. 19, 2019). A Notice of Appeal to the United States Court of Appeals for the Federal Circuit was filed on January 21, 2020.

Requests for *Ex Parte* Reexamination have been filed for commonly-assigned U.S. Pats. 9,408,055; 9,445,251; and 9,467,838.

Petitions for *Inter Partes* Review of commonly-assigned U.S. Pat. 9,820,123 have also been filed.

### **Patents and Publications Cited in the Request**

The request cites the following prior art patents and printed publications:

- 1) U.S. Pat. App. Pub. 2006/0218232 (Kubala);
- 2) U.S. Pat. 6,854,007 (Hammond);
- 3) U.S. Pat. 5,325,310 (Johnson); and
- 4) U.S. Pat. 5,742,905 (Pepe).

### **Prosecution History**

U.S. Patent 8,213,970 issued from App. 12/324,122, filed on Nov. 26, 2008. The '122 App. is a continuation-in-part of App. 11/612,830 (filed on Dec. 19, 2006, and now U.S. Pat. 7,853,273), which is a continuation-in-part of App. 11/308,648 (filed on Apr. 17, 2006, and now U.S. Pat. 7,630,724), which is a continuation-in-part of App. 10/711,490 (filed on Sep. 21, 2004, and now U.S. Pat. 7,031,728).

The '122 App. was originally filed with 14 claims.

The Office initially rejected claims 1, 4, and 6 under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. App. Pub. 2004/0082352 (Keating et al.). '122 App., Non-Final Rej., Sep. 20, 2010, p. 2. Claims 2, 3, and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Keating in view of U.S. Pat App. Pub. 2005/0241026 (Esler et al.). *Id.* at 4. Claims 7-14 were rejected under § 103(a) as being unpatentable over Keating in view of U.S. Pat App. Pub. 2004/0192365 (Dalton et al.). *Id.* at 6.

Applicant responded by canceling claim 1 and amending claims 2-7 and arguing that Keating does not disclose a forced message alert software application program loaded on each participating PC or PDA/cell phone as required in the amended claims. See '122 App., Remarks, Dec. 17, 2010, p. 8.

The Office rejected claims 2-10 under § 103(a) as being unpatentable over Keating in view of U.S. Pat. App. Pub. 2002/0061762 (Maggenti et al.). '122 App., Final Rej., Mar. 11, 2011, p. 2. Claims 11-14 were rejected under § 103(a) as being unpatentable over Keating in view of Dalton. *Id.* at 10.

Applicant responded by amending claims 2, 3, and 7. Applicant again contended, *inter alia*, that Keating did not disclose a forced message alert system. See '122 App., Remarks, Sep. 9, 2011, p. 7.

The examiner subsequently allowed claims 2-14 upon entry of an Examiner's Amendment removing references to a "PC" in all pending claims. '122 App., Examiner's Amendment, Apr. 25, 2012.

The examiner provided the following statement of reasons for allowance of the amended claims:

[C]laims 2-14 have been found to be novel and the inventive because prior art record fails to show or teach means for attaching a forced message alert software packet to a voice or text message creating a forced message alert that is transmitted by said sender PDA/cell phone to the recipient PDA/cell phone, said forced message alert software packet containing a list of possible required responses and requiring the forced message alert software on said recipient PDA/cell phone to transmit an automatic acknowledgment to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone; means for requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display; means for receiving and displaying a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have not automatically acknowledged the forced message alert.

*Id.* at 9.

#### Priority Date

The Request contends that the '970 patent is not entitled to priority to any of the earlier-filed applications in its continuity chain, and is instead entitled to a priority date of only November 26, 2008 — its actual filing date, (Request at 17-20).

Upon review, the examiner agrees with the contentions and evidentiary support in the Request, (*see id.*), that none of the earlier-filed applications provide sufficient written description support for at least a forced-message alert software-application program, as required by each independent claims of the '970 patent. Accordingly, the examiner agrees that the '970 patent is entitled to a priority date of November 26, 2008.

### Substantial New Questions of Patentability (SNQs)

#### A. The SNQ requirement

The Office may only grant a reexamination request if an SNQ affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. 35 U.S.C. §§ 303(a) and 304.

The court in *Swanson* evaluated the scope of the SNQ requirement in reexamination, extensively citing the legislative history of the original reexamination statute and the 2002 amendment:

“[I]n passing the original reexamination statute, Congress stated that ‘this new procedure will permit any party to petition the patent office to review the efficacy of a patent, subsequent to its issuance, on the basis of new information about preexisting technology which may have escaped review at the time of the initial examination of the patent application,’ and explained that the substantial new question requirement bars ‘reconsideration of any argument already decided by the office, whether during the original examination or an earlier reexamination.’” *In re Swanson*, 540 F.3d 1368, 1377 (Fed. Cir. 2008) (quoting H.R. Rep. No. 96-1307 (1980)) (emphasis omitted). “[T]he substantial new question requirement ‘guard[s] against simply repeating the prior examination on the same issues and arguments’ and bars ‘a second examination, on the identical ground that had previously been raised and overcome.” *Id.* at 1380 (quoting *In re Recreative Technologies Corp.*, 83 F.3d 1394, 1396-97 (Fed. Cir. 1996)). Further, “[t]he issue raised must be more than just questioning the judgment of the examiner.” *Id.* (quoting H.R. Rep. No. 107-120 (2002)). “[T]o decide whether a reference that was previously considered by the PTO creates a substantial new question of patentability, the PTO should evaluate the context in which the reference was previously considered and the scope of the prior consideration and determine whether the reference is now being considered for a substantially different purpose.” *Id.*

A prior art patent or printed publication raises a substantial question of patentability where there is a substantial likelihood that a reasonable examiner would consider the prior art patent or

printed publication important in deciding whether or not the claim is patentable, unless the same question of patentability has already been decided as to the claim in a final holding of invalidity by the Federal court system or by the Office in a previous examination. MPEP § 2242.

**B. Kubala and Hammond (SNQ 1)**

The request asserts that a substantial new question of patentability as to claims 2 and 10-13 of the '970 patent is raised by Kubala and Hammond, (Request at 7). The examiner agrees.

Neither Kubala nor Hammond were considered by the examiner during the prosecution of the application that matured into the '970 patent.

As described in the Request, Kubala discloses PDAs that send and receive mandatory-response messages, (see Request at 32-35 (citing Kubala at Abstract, FIGS. 2, 9, 11A, 11C, ¶¶ 22, 32, 33, 35, 36, 50, 51, 57, and 61)).

As described in the Request, Hammond discloses tracking acknowledgements of and responses to mandatory-response messages, (see Request at 35-37 (citing Hammond at 1:13-16, 1:21-26, 3:1-5, 3:31-43, 6:3-19, 6:56-8:45, 10:5-11:48; FIGS. 2, 4, 5A, 5B)).

Because these new and non-cumulative technical teachings appear to be relevant to the specific features cited by the examiner as being absent from the prior art during prosecution of the '970 patent, there is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether claims 2 and 10-13 of the '970 patent are patentable. Accordingly, Kubala and Hammond raise a substantial new question of patentability as to these claims.

**C. Hammond, Johnson, and Pepe (SNQ 2)**

The request asserts that a substantial new question of patentability as to claims 2 and 10-13 of the '970 patent is raised by Hammond, Johnson, and Pepe, (Request at 8-9). The examiner agrees.

Hammond, Johnson, and Pepe were not considered by the examiner in the application that matured into the '970 patent.

As described in the Request, Hammond discloses tracking acknowledgements of and responses to mandatory-response messages, (see Request at 35-37 (citing Hammond at 1:13-16, 1:21-26, 3:1-5, 3:31-43, 6:3-19, 6:56-8:45, 10:5-11:48; FIGS. 2, 4, 5A, 5B)).

As described in the Request, Johnson discloses preventing a user from closing a mandatory-response message that has not been responded to, (see Request at 38-39 (citing Johnson at Abstract, 4:1-6, 28-32)).

As described in the Request, Pepe discloses PDAs that provide an on-screen menu of possible responses to an incoming message, (see Request at 39 (citing Pepe at 34:10-15, 36:16-20, 36:38-51, FIGS. 42, 45)).

Because these new and non-cumulative technical teachings appear to be relevant to the specific features cited by the examiner as being absent from the prior art during prosecution of the '970 patent, there is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether claims 2 and 10-13 of the '970 patent are patentable. Accordingly, Hammond, Johnson, and Pepe raise a substantial new question of patentability as to these claims.

**Conclusion**

A substantial new question of patentability has been raised as to claims 2 and 10-13 of U.S. Pat. 8,213,970.

**All** correspondence relating to this ex parte reexamination proceeding should be directed:

By Mail to:           Mail Stop *Ex Parte* Reexam  
                          Central Reexamination Unit  
                          Commissioner for Patents  
                          United States Patent & Trademark Office  
                          P.O. Box 1450  
                          Alexandria, VA 22313-1450

By FAX to:           (571) 273-9900  
                          Central Reexamination Unit

By hand:             Customer Service Window  
                          Randolph Building  
                          401 Dulany Street  
                          Alexandria, VA 22314


Any inquiry concerning this communication should be directed to Central Reexamination Unit at telephone number (571) 272-7705.

/Eric B. Kiss/  
Primary Examiner, Art Unit 3992

**Conferees:**

/NICK CORSARO/  
Primary Examiner, Art Unit 3992

/ANDREWJ. FISCHER/  
Supervisory Patent Reexamination Specialist, Art Unit 3992

<b><i>Search Notes</i></b> 	<b>Application/Control No.</b> 90/014,507	<b>Applicant(s)/Patent Under Reexamination</b> 8213970
	<b>Examiner</b> ERIC B KISS	<b>Art Unit</b> 3992

CPC - Searched*		
Symbol	Date	Examiner

CPC Combination Sets - Searched*		
Symbol	Date	Examiner

US Classification - Searched*			
Class	Subclass	Date	Examiner


\* See search history printout included with this form or the SEARCH NOTES box below to determine the scope of the search.

Search Notes		
Search Notes	Date	Examiner
Reviewed patent file history	07/02/2020	/EBK/

Interference Search			
US Class/CPC Symbol	US Subclass/CPC Group	Date	Examiner

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<b>Reexamination</b> 	<b>Application/Control No.</b> 90/014,507	<b>Applicant(s)/Patent Under Reexamination</b> 8213970
	<b>Certificate Date</b>	<b>Certificate Number</b>

<b>Requester Correspondence Address:</b> <input type="checkbox"/> <b>Patent Owner</b> <input checked="" type="checkbox"/> <b>Third Party</b>
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005

<b>LITIGATION REVIEW</b> <input checked="" type="checkbox"/>	/EBK/ (examiner initials)	16 May 2020 (date)
Case Name		Director Initials
AGIS Software Dev., LLC v. Google LLC, Case No. 2:19-cv-00361 (E.D. Tex.)		

COPENDING OFFICE PROCEEDINGS	
TYPE OF PROCEEDING	NUMBER
IPR	IPR2018-00821 (Institution Denied)
IPR	IPR2018-01079 (FWD)
IPR	IPR2019-00411 (Terminated)
IPR	IPR2019-00485 (Institution Denied)

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Substitute for form 1449/PTO				<b>Complete if Known</b>	
<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> <i>(Use as many sheets as necessary)</i>				Control Number	To Be Assigned
				Filing Date	To Be Assigned
				First Named Inventor	Malcolm K. Beyer
				Art Unit	To Be Assigned
				Examiner Name	To Be Assigned
Sheet	1	of	2	Attorney Docket Number	2525.993REX0

U.S. PATENT DOCUMENTS						
Examiner initials*	Cite No. <sup>1</sup>	Document Number		Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code <sup>2</sup> (if known)				
	EX1001	8,213,970 B2		07-03-2012	Beyer	
	EX1005	2006/0218232 A1		09-28-2006	Kubala <i>et al.</i>	
	EX1006	6,854,007 B1		02-08-2005	Hammond	
	EX1007	5,325,310		06-28-1994	Johnson <i>et al.</i>	
	EX1008	5,742,905		04-21-1998	Pepe <i>et al.</i>	
	EX1009	2003/0128195 A1		07-10-2003	Banerjee <i>et al.</i>	

FOREIGN PATENT DOCUMENTS							
Examiner initials*	Cite No. <sup>1</sup>	Foreign Patent Document		Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T <sup>6</sup>
		Country Code <sup>3</sup> -Number <sup>4</sup> -Kind Code <sup>5</sup> (if known)					

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published	T <sup>2</sup>
	EX1002	Prosecution History of U.S. Patent No. 8,213,970 (Application No. 12/324,122) ("970 Prosecution History")	
	EX1010	<i>Simon Says "Here's How!" Simon™ Mobile Communications Made Simple</i> , Simon Users Manual, IBM Corp., 1994. ("Simon")	
	EX1011	Prosecution History of U.S. Patent Application No. 10/711,490 ("490 application")	
	EX1012	Prosecution History of U.S. Application No. 11/308,648 ("648 application")	
	EX1013	Prosecution History of U.S. Application No. 11/612,830 ("830 application")	

Examiner Signature		Date Considered	
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\*EXAMINER: Initial if reference 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. <sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.

Substitute for form 1449/PTO				<b>Complete if Known</b>	
<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> <i>(Use as many sheets as necessary)</i>				Control Number	To Be Assigned
				Filing Date	To Be Assigned
				First Named Inventor	Malcolm K. Beyer
				Art Unit	To Be Assigned
				Examiner Name	To Be Assigned
Sheet	2	of	2	Attorney Docket Number	2525.993REX0

	EX1014	McKinsey & Company, The McKinsey Report: FDNY 9/11 Response (2002) ("The McKinsey Report")	
	EX1015	<i>Apple Newton</i> , Wikipedia.com, <a href="https://en.wikipedia.org/wiki/Apple_Newton">https://en.wikipedia.org/wiki/Apple_Newton</a> (last visited May 10, 2018) ("Apple")	
	EX1016	<i>From touch displays to the Surface: A brief history of touchscreen technology</i> , Arstechnica.com <a href="https://arstechnica.com/gadgets/2013/04/from-touch-displays-to-the-surface-a-brief-history-of-touchscreen-technology/">https://arstechnica.com/gadgets/2013/04/from-touch-displays-to-the-surface-a-brief-history-of-touchscreen-technology/</a> (last visited May 10, 2018) ("Arstechnica")	
	EX1017	Reexamination Control No. 90/006,572 (Decision dated June 30, 2010) ("572 Reexamination Decision")	
	EX1018	Reexamination Control No. 90/013,808 (Decision dated June 15, 2018) ("808 Reexamination Decision")	
	EX1019	Reexamination Control No. 90/014,071 (Decision dated November 13, 2018) ("071 Reexamination Decision")	
	EX1020	Reexamination Control No. 95/000,185 (Decision dated August 22, 2008 ("185 Reexamination Decision")	
	EX1021	<i>SDI Technologies v. Bose Corp.</i> , IPR2013-00350, Paper 36, Final Written Decision (P.T.A.B. Nov. 7, 2014)	
	EX1022	<i>Google LLC v. AGIS Software Development, LLC</i> , IPR2018-01079, Paper 2, Petition (P.T.A.B. May 15, 2018)	
	EX1023	<i>Google LLC v. AGIS Software Development, LLC</i> , IPR2018-01079, Paper 8, Petitioner's Reply (P.T.A.B. Sept. 19, 2018)	
	EX1024	<i>Google LLC v. AGIS Software Development, LLC</i> , IPR2018-01079, Paper 34, Final Written Decision (P.T.A.B. Nov. 19, 2019)	

15015203.1

Examiner Signature	/Eric B. Kiss/	Date Considered	07/02/2020
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\*EXAMINER: Initial if reference 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. <sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
90/014,507 05/15/2020 8213970 2525.993REX0 6188

22235 7590 05/28/2020
Malin Haley DiMaggio & Bowen, P.A.
Spectrum Office Building
4901 NW 17th Way, Suite 308
FORT LAUDERDALE, FL 33309

EXAMINER

CORSARO, NICK

Table with 2 columns: ART UNIT, PAPER NUMBER

3992

Table with 2 columns: MAIL DATE, DELIVERY MODE

05/28/2020

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)

STERNE KESSLER GOLDSTEIN & FOX PLLC  
1100 NEW YORK AVENUE, NW  
WASHINGTON, DC 20005

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

REEXAMINATION CONTROL NO. 90/014,507.

PATENT UNDER REEXAMINATION 8213970.

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)).

<b><i>Ex Parte Reexamination Interview Summary – Pilot Program for Waiver of Patent Owner’s Statement</i></b>	<b>Control No.</b>	<b>Patent Under Reexamination is Requested</b>	
	90/014,507	8213970	
	<b>Examiner</b>	<b>Art Unit</b>	<b>AIA (FITF) Status</b>
CORSARO	3992	No	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address. --**

**All participants (USPTO official and patent owner):**

- (1) MANUEL SALDANA, CRU (3) \_\_\_\_\_  
(2) BARRY HALEY, REG 25339 (4) \_\_\_\_\_

Date of Telephonic Interview: 18 May 2020.

**A. The USPTO official requested waiver of the patent owner’s statement pursuant to the pilot program for waiver of patent owner’s statement in *ex parte* reexamination proceedings.\***

- The patent owner **agreed** to waive its right to file a patent owner’s statement under 35 U.S.C. 304 in the event reexamination is ordered for the above-identified patent.
- The patent owner **did not agree** to waive its right to file a patent owner’s statement under 35 U.S.C. 304 at this time.
- USPTO personnel were unable to reach the patent owner.\*\*

**B. The Patent Owner of record telephoned the Office and indicated they would like to participate in the pilot program for waiver of patent owner’s statement in *ex parte* reexamination proceedings.\***

- The Patent owner of record telephoned the Office and **agreed** to waive its right to file a patent owner’s statement under 35 U.S.C. 304 in the event reexamination is ordered for the above-identified patent.

The patent owner is not required to file a written statement of this telephone communication under 37 CFR 1.560(b) or otherwise. However, any disagreement as to this interview summary must be brought to the immediate attention of the USPTO, and no later than one month from the mailing date of this interview summary. Extensions of time are governed by 37 CFR 1.550(c).

\*For more information regarding this pilot program, see *Pilot Program for Waiver of Patent Owner’s Statement in Ex Parte Reexamination Proceedings*, 75 Fed. Reg. 47269 (August 5, 2010), available on the USPTO Web site at <http://www.uspto.gov/patents/law/notices/2010.jsp>.

\*\*The patent owner may contact the USPTO personnel at (571) 272-7705 or at the telephone number provided below if the patent owner decides to waive the right to file a patent owner’s statement under 35 U.S.C. 304.

/MANUEL SALDANA/ (571)272-7740  
Signature and telephone number of the USPTO official, who contacted, was contacted by, or attempted to contact the patent owner.

cc: Requester (if third party requester)



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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P.O. Box 1450
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Table with 3 columns: REEXAM CONTROL NUMBER (90/014,507), FILING OR 371 (c) DATE (05/15/2020), PATENT NUMBER (8213970)

CONFIRMATION NO. 6188
REEXAM ASSIGNMENT NOTICE

22235
Malin Haley DiMaggio & Bowen, P.A.
Spectrum Office Building
4901 NW 17th Way, Suite 308
FORT LAUDERDALE, FL 33309



Date Mailed: 05/19/2020

NOTICE OF ASSIGNMENT OF REEXAMINATION REQUEST

The above-identified request for reexamination has been assigned to Art Unit 3992. All future correspondence to the proceeding should be identified by the control number listed above and directed to the assigned Art Unit.

A copy of this Notice is being sent to the latest attorney or agent of record in the patent file or to all owners of record. (See 37 CFR 1.33(c)). If the addressee is not, or does not represent, the current owner, he or she is required to forward all communications regarding this proceeding to the current owner(s). An attorney or agent receiving this communication who does not represent the current owner(s) may wish to seek to withdraw pursuant to 37 CFR 1.36 in order to avoid receiving future communications. If the address of the current owner(s) is unknown, this communication should be returned within the request to withdraw pursuant to Section 1.36.

NOTICE OF USPTO EX PARTE REEXAMINATION PATENT OWNER STATEMENT WAIVER PROGRAM

The USPTO has implemented a pilot program where, after a reexamination proceeding has been granted a filing date and before the examiner begins his or her review, the patent owner may orally waive the right to file a patent owner's statement. See "Pilot Program for Waiver of Patent Owner's Statement in Ex Parte Reexamination Proceedings," 75 FR 47269 (August 5, 2010). One goal of the pilot program is to reduce the pendency of reexamination proceedings and improve the efficiency of the reexamination process.

Ordinarily when ex parte reexamination is ordered, the USPTO must wait until after the receipt of the patent owner's statement and the third party requester's reply, or after the expiration of the time period for filing the statement and reply (a period that can be as long as 5 to 6 months), before mailing a first determination of patentability. The USPTO's first determination of patentability is usually a first Office action on the merits or a Notice of Intent to Issue Reexamination Certificate (NIRC).

Under the pilot program, the patent owner's oral waiver allows the USPTO to act on the first determination of patentability immediately after determining that reexamination will be ordered, and in a suitable case issue the reexamination order and the first determination of patentability (which could be a NIRC if the claims under reexamination are confirmed) at the same time.

Benefits to the Patent Owner for participating in this pilot program include reduction in pendency.

To participate in this pilot program, Patent Owners may contact the USPTO's Central Reexamination Unit (CRU) at 571-272-7705. The USPTO will make the oral waiver of record in the reexamination file in an interview summary and a copy will be mailed to the patent owner and any third party requester.

cc: Third Party Requester(if any)
STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, NW
WASHINGTON, DC 20005

/rbell/

Legal Instruments Examiner
Central Reexamination Unit 571-272-7705; FAX No. 571-273-9900



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
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P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

REEXAM CONTROL NUMBER	FILING OR 371 (c) DATE	PATENT NUMBER
90/014,507	05/15/2020	8213970

STERNE, KESSLER, GOLDSTEIN & FOX PLLC  
1100 NEW YORK AVENUE, NW  
WASHINGTON, DC 20005

**CONFIRMATION NO. 6188**  
**REEXAMINATION REQUEST**  
**NOTICE**



Date Mailed: 05/19/2020

**NOTICE OF REEXAMINATION REQUEST FILING DATE**

*(Third Party Requester)*

Requester is hereby notified that the filing date of the request for reexamination is 05/15/2020, the date that the filing requirements of 37 CFR § 1.510 were received.

A decision on the request for reexamination will be mailed within three months from the filing date of the request for reexamination. (See 37 CFR 1.515(a)).

A copy of the Notice is being sent to the person identified by the requester as the patent owner. Further patent owner correspondence will be the latest attorney or agent of record in the patent file. (See 37 CFR 1.33). Any paper filed should include a reference to the present request for reexamination (by Reexamination Control Number).

cc: Patent Owner  
22235  
Malin Haley DiMaggio & Bowen, P.A.  
Spectrum Office Building  
4901 NW 17th Way, Suite 308  
FORT LAUDERDALE, FL 33309

/rbell/

\_\_\_\_\_  
Legal Instruments Examiner  
Central Reexamination Unit 571-272-7705; FAX No. 571-273-9900



# Patent Assignment Abstract of Title

## Total Assignments: 3

**Application #:** 12324122      **Filing Dt:** 11/26/2008      **Patent #:** 8213970      **Issue Dt:** 07/03/2012  
**PCT #:** NONE      **Intl Reg #:**      **Publication #:** US20090075685      **Pub Dt:** 03/19/2009  
**Inventor:** Malcolm K. Beyer JR.  
**Title:** METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS

## Assignment: 1

**Reel/Frame:** 028262 / 0435      **Received:** 05/24/2012      **Recorded:** 05/24/2012      **Mailed:** 05/25/2012      **Pages:** 2

**Conveyance:** ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

**Assignor:** BEYER, MALCOLM K., JR.

**Exec Dt:** 05/24/2012

**Assignee:** ADVANCED GROUND INFORMATION SYSTEMS, INC.  
92 LIGHTHOUSE DRIVE  
JUPITER, FLORIDA 33469

**Correspondent:** MALIN HALEY DIMAGGIO BOWEN & LHOTA, P.A.  
1936 S. ANDREWS AVENUE  
FORT LAUDERDALE, FL 33324

## Assignment: 2

**Reel/Frame:** 042759 / 0661      **Received:** 06/20/2017      **Recorded:** 06/20/2017      **Mailed:** 06/21/2017      **Pages:** 7

**Conveyance:** ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

**Assignor:** ADVANCED GROUND INFORMATION SYSTEMS, INC.

**Exec Dt:** 06/15/2017

**Assignee:** AGIS HOLDINGS, INC.  
92 LIGHTHOUSE DRIVE  
JUPITER, FLORIDA 33469

**Correspondent:** SAMUEL S. STONE  
GOODWIN PROCTER LLP  
100 NORTHERN AVENUE  
BOSTON, MA 02210

## Assignment: 3

**Reel/Frame:** 042760 / 0102      **Received:** 06/20/2017      **Recorded:** 06/20/2017      **Mailed:** 06/21/2017      **Pages:** 7

**Conveyance:** ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

**Assignor:** AGIS HOLDINGS, INC.

**Exec Dt:** 06/15/2017

**Assignee:** AGIS SOFTWARE DEVELOPMENT LLC  
100 W. HOUSTON STREET  
MARSHALL, TEXAS 75670

**Correspondent:** SAMUEL S. STONE  
GOODWIN PROCTER LLP  
100 NORTHERN AVENUE  
BOSTON, MA 02210

Search Results as of: 05/18/2020 09:56 AM

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v.2.6  
Web interface last modified: Jun 26, 2017 v.2.6

# Litigation Search Report OCRU

Application Number: 90/014,507

TO: EILEEN LILLIS  
LOCATION: REM04D35  
ART UNIT: 3993  
DATE: 05/16/2020

From: MANUEL SALDANA  
Location: OCRU, REM 4C71  
Phone: (571) 272-7740  
MANUEL.SALDANA@USPTO.GOV

## Search Notes

### LITIGATION FOUND FOR US PATENT 8,213,970

#### **2:19cv361, Agis Software Dev Llc V. Google Llc(OPEN)**

- 1) I performed a KeyCite Search in Westlaw, which retrieves all history on the patent including any litigation.
- 2) I performed a search on the patent in Lexis CourtLink for any open dockets or closed cases.
- 3) I performed a search in Lexis in the Federal Courts and Administrative Materials databases for any cases found.

Document: 2:19cv361, Agis Software Development Llc V. Google Llc Actions



### 2:19cv361, Agis Software Development Llc V. Google Llc

US District Court Docket

US District Court for the Eastern District of TEXAS [LIVE]

(Marshall)

This case was retrieved on 05/16/2020

#### Header

<b>Case Number:</b> 2:19cv361	<b>Class Code:</b> Open
<b>Date Filed:</b> 11/04/2019	<b>Statute:</b> 15:1126
<b>Assigned To:</b> District Judge Rodney Gilstrap	<b>Jury Demand:</b> Both
<b>Nature of Suit:</b> Patent (830)	<b>Demand Amount:</b> \$0
<b>Cause:</b> Patent Infringement	<b>NOS Description:</b> Patent
<b>Lead Docket:</b> None	
<b>Other Docket:</b> 2:19cv00359, 2:19cv00362	
<b>Jurisdiction:</b> Federal Question	

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**Plaintiff**

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Luann Loraine Simmons

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Waze Mobile Limited

Consolidated from case 2:19-cv-359 |

**Consol Defendant**

Samsung Electronics Co., LTD,

Consolidated from case 2:19-cv-362 |

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Proceedings

Retrieve Document(s)					
	Availability	#	Date	Proceeding Text	Source
	Free	1	11/04/2019	COMPLAINT for Patent Infringement against Google LLC ( Filing fee \$ 400 receipt number 0540-7506587 ), filed by AGIS Software Development LLC. (Attachments: # 1 Exhibit A, # 2 Exhibit B, # 3 Exhibit C, # 4 Exhibit D, # 5 Exhibit E, # 6 Exhibit F, # 7 Cover Sheet)(Baxter, Samuel) (Entered: 11/04/2019)	
	Runner		11/04/2019	Case assigned to District Judge Rodney Gilstrap. (ch, ) (Entered: 11/04/2019)	
	Online	2	11/04/2019	Notice of Filing of Patent/Trademark Form (AO 120). AO 120 mailed to the Director of the U.S. Patent and Trademark Office. (Baxter, Samuel) (Entered: 11/04/2019)	
	Runner		11/04/2019	In accordance with the provisions of 28 USC Section: 636(c), you are hereby notified that a U.S. Magistrate Judge of this district court is available to conduct any or all proceedings in this case including a jury or non-jury trial and to order the entry of a final judgment. The form Consent to Proceed Before Magistrate Judge is available on our website. All signed consent forms, excluding pro se parties, should be filed electronically using the event Notice Regarding Consent to Proceed Before Magistrate Judge. (ch, ) (Entered: 11/04/2019)	
	Online	3	11/04/2019	CORPORATE DISCLOSURE STATEMENT filed by AGIS Software Development LLC identifying Corporate Parent AGIS Holdings, Inc. for AGIS Software Development LLC. (Baxter, Samuel) (Entered: 11/04/2019)	
	Online	4	11/04/2019	NOTICE of Attorney Appearance by Alfred Ross Fabricant on behalf of AGIS Software Development LLC (Fabricant, Alfred) (Entered: 11/04/2019)	
	Online	5	11/05/2019	SUMMONS Issued as to Google LLC. (ch, ) (Entered: 11/05/2019)	

Availability	#	Date	Proceeding Text	Source
Online	6	11/06/2019	SUMMONS Returned Executed by AGIS Software Development LLC. Google LLC served on 11/5/2019, answer due 11/26/2019. (Fabricant, Alfred) (Entered: 11/06/2019)	
Online	7	11/21/2019	NOTICE of Attorney Appearance by James Mark Mann on behalf of Google LLC (Mann, James) (Entered: 11/21/2019)	
Online	8	11/22/2019	Defendant's Unopposed First Application for Extension of Time to Answer Complaint re Google LLC.( Mann, James) (Entered: 11/22/2019)	
Runner		11/22/2019	Defendant's Unopposed FIRST Application for Extension of Time to Answer Complaint is granted pursuant to Local Rule CV-12 for Google LLC to 12/26/2019. 30 Days Granted for Deadline Extension. ( ch, ) (Entered: 11/22/2019)	
Online	9	11/22/2019	NOTICE of Attorney Appearance by Peter Lambrianakos on behalf of AGIS Software Development LLC (Lambrianakos, Peter) (Entered: 11/22/2019)	
Online	10	11/22/2019	NOTICE of Attorney Appearance by Vincent J Rubino, III on behalf of AGIS Software Development LLC (Rubino, Vincent) (Entered: 11/22/2019)	
Online	11	11/22/2019	NOTICE of Attorney Appearance by Enrique William Iturralde on behalf of AGIS Software Development LLC (Iturralde, Enrique) (Entered: 11/22/2019)	
Online	12	11/25/2019	NOTICE of Attorney Appearance by Gregory Blake Thompson on behalf of Google LLC (Thompson, Gregory) (Entered: 11/25/2019)	
Online	13	12/18/2019	Unopposed MOTION for Extension of Time to File Answer or Otherwise Respond to Plaintiff's Complaint by Google LLC. (Attachments: # 1 <u>Text of Proposed Order</u> )(Mann, James) (Entered: 12/18/2019)	
Online	14	12/26/2019	Defendant's Unopposed Second Application for Extension of Time to Answer Complaint re Google LLC.( Mann, James) (Entered: 12/26/2019)	
Runner		12/26/2019	Defendant's Unopposed SECOND Application for Extension of Time to Answer Complaint is granted pursuant to Local Rule CV-12 for Google LLC to 1/10/2020. 15 Days Granted for Deadline Extension. ( ch, ) (Entered: 12/26/2019)	
Online	16	12/27/2019	ORDER granting 13 Unopposed MOTION for Extension of Time to File Answer or Otherwise Respond to Plaintiff's Complaint. Google LLC answer due 2/18/2020.. Signed by District Judge Rodney Gilstrap on 12/27/2019. (ch, ) (Entered: 12/30/2019)	
Online	15	12/30/2019	Amended MOTION for Extension of Time to File Answer or Otherwise Respond to Plaintiff's Complaint by Google LLC. (Attachments: # 1 <u>Text of Proposed Order</u> )(Mann, James) (Entered: 12/30/2019)	
Online	17	01/17/2020	ORDER denying 15 Amended MOTION for Extension of Time to File Answer or Otherwise Respond to Plaintiff's Complaint. Google LLC answers due 2/18/2020. Signed by District Judge Rodney Gilstrap on 1/17/2020. (ch, ) (Entered: 01/21/2020)	
Online	18	02/07/2020	Unopposed MOTION for Extension of Time to File Answer or Otherwise Respond to Plaintiff's Complaint by Google LLC. (Attachments: # 1 <u>Text of Proposed Order</u> )(Mann, James) (Entered: 02/07/2020)	
Online	19	02/18/2020	NOTICE of Attorney Appearance - Pro Hac Vice by Mark Liang on behalf of Google LLC. Filing fee \$ 100, receipt number 0540-7667356. (Liang, Mark) (Entered: 02/18/2020)	
Online	20	02/18/2020	NOTICE of Attorney Appearance - Pro Hac Vice by Darin W Snyder on behalf of Google LLC. Filing fee \$ 100, receipt number 0540-7667444. (Snyder, Darin) (Entered: 02/18/2020)	
Online	21	02/18/2020	NOTICE of Attorney Appearance - Pro Hac Vice by Luann Loraine Simmons on behalf of Google LLC. Filing fee \$ 100, receipt number 0540-7667472. (Simmons, Luann) (Entered: 02/18/2020)	

Availability	#	Date	Proceeding Text	Source
Online	22	02/18/2020	NOTICE of Attorney Appearance - Pro Hac Vice by David S Almeling on behalf of Google LLC. Filing fee \$ 100, receipt number 0540-7667492. (Almeling, David) (Entered: 02/18/2020)	
Online	23	02/18/2020	NOTICE of Attorney Appearance by Bill Trac on behalf of Google LLC (Trac, Bill) (Entered: 02/18/2020)	
Online	24	02/18/2020	Unopposed MOTION for Leave to File Defendant's Motion to Dismiss for Improper Venue Under Seal by Google LLC (Attachments: # 1 Text of Proposed Order(Mann, James) (Entered: 02/18/2020)	
Online	25	02/18/2020	SEALED PATENT MOTION to Dismiss for Improper Venue by Google LLC. (Attachments: # 1 Declaration of Mark Liang, # 2 Exhibit 1 to Declaration of Mark Liang, # 3 Exhibit 2 to Declaration of Mark Liang, # 4 Exhibit 3 to Declaration of Mark Liang, # 5 Exhibit 4 to Declaration of Mark Liang, # 6 Exhibit 5 to Declaration of Mark Liang, # 7 Exhibit 6 to Declaration of Mark Liang, # 8 Declaration of Joshua Cho, # 9 Declaration of Joe Data, # 10 Declaration of Adam Henson, # 11 Exhibit A to Declaration of Adam Henson, # 12 Exhibit B to Declaration of Adam Henson, # 13 Exhibit C to Declaration of Adam Henson, # 14 Exhibit D to Declaration of Adam Henson, # 15 Declaration of Sallie Lim, # 16 Declaration of Tyler Krause, # 17 Declaration of Keith McCaffien, # 18 Declaration of Shannon Stroger, # 19 Declaration of Prithviraj Subburaj, # 20 Text of Proposed Order(Mann, James) (Entered: 02/18/2020)	
Online	26	02/18/2020	CORPORATE DISCLOSURE STATEMENT filed by Google LLC identifying Corporate Parent Alphabet Inc. for Google LLC. (Mann, James) (Entered: 02/18/2020)	
Online	27	02/18/2020	DEMAND for Trial by Jury by Google LLC. (Mann, James) (Entered: 02/18/2020)	
Online	28	02/20/2020	REDACTION to 25 SEALED PATENT MOTION to Dismiss for Improper Venue by Google LLC (Attachments: # 1 Declaration of Mark Liang, # 2 Exhibit 1 of Declaration of Mark Liang, # 3 Exhibit 2 of Declaration of Mark Liang, # 4 Exhibit 3 of Declaration of Mark Liang, # 5 Exhibit 4 of Declaration of Mark Liang, # 6 Exhibit 5 of Declaration of Mark Liang, # 7 Exhibit 6 of Declaration of Mark Liang, # 8 Declaration of Joshua Cho, # 9 Declaration of Joe Data, # 10 Declaration of Adam Henson, # 11 Exhibit A of Declaration of Adam Henson, # 12 Exhibit B of Declaration of Adam Henson, # 13 Exhibit C of Declaration of Adam Henson, # 14 Exhibit D of Declaration of Adam Henson, # 15 Declaration of Sallie Lim, # 16 Declaration of Tyler Krause, # 17 Declaration of Keith McCaffien, # 18 Declaration of Shannon Stroger, # 19 Declaration of Prithviraj Subburaj, # 20 Text of Proposed Order(Mann, James) (Entered: 02/20/2020)	
Online	29	02/20/2020	CONSOLIDATION ORDER - above-captioned cases are hereby ORDERED to be CONSOLIDATED for all pretrial issues with the LEAD CASE, Case No. 2:19-cv-00361. All parties are instructed to file any future filings in the LEAD CASE. Individual cases remain active for trial. Signed by District Judge Rodney Gilstrap on 2/20/2020. (ch, ) (Entered: 02/20/2020)	
Online	30	02/21/2020	ORDER - Scheduling Conference set for 3/23/2020 01:30 PM before District Judge Rodney Gilstrap. Signed by District Judge Rodney Gilstrap on 2/21/2020 (ch, ) (Entered: 02/24/2020)	
Online	31	02/25/2020	Agreed MOTION for Extension of Time for Plaintiff to Respond to Defendant's Motion to Dismiss for Improper Venue by AGIS Software Development LLC. (Attachments: # 1 Text of Proposed Order(Fabricam, Alfred) (Entered: 02/25/2020)	
Online	32	02/27/2020	ORDER granting 24 Unopposed MOTION for Leave to File Defendant's Motion to Dismiss for Improper Venue Under Seal. Signed by District Judge Rodney Gilstrap on 2/27/2020. (ch, ) (Entered: 02/28/2020)	

	Availability 	# 	Date 	Proceeding Text 	Source 
	Online	33	02/27/2020	ORDER granting 31 Agreed MOTION for Extension of Time for Plaintiff to Respond to Defendant's Motion to Dismiss for Improper Venue. Signed by District Judge Rodney Gilstrap on 2/27/2020. (ch, ) (Entered: 02/28/2020)	
	Online	34	03/03/2020	Unopposed MOTION for Leave to File Motion to Transfer Venue to the Northern District of California Under Seal by Samsung Electronics Co., LTD. (Attachments: # 1 Text of Proposed Order) (Mann, James) (Entered: 03/03/2020)	
	Online	35	03/03/2020	SEALED PATENT MOTION to Transfer Venue to The Northern District of California by Samsung Electronics Co., LTD.. (Attachments: # 1 Declaration of Chris Szymonka Jo, # 2 Declaration of Kyontae Bong, # 3 Declaration of Shannon Shaper, # 4 Text of Proposed Order)(Mann, James) (Entered: 03/03/2020)	
	Online	36	03/03/2020	Additional Attachments to Main Document: 35 SEALED PATENT MOTION to Transfer Venue to The Northern District of California.. (Attachments: # 1 Declaration of Bill Trap, # 2 Exhibit A, # 3 Exhibit B, # 4 Exhibit C, # 5 Exhibit D, # 6 Exhibit E, # 7 Exhibit F, # 8 Exhibit G, # 9 Exhibit H, # 10 Exhibit I, # 11 Exhibit J, # 12 Exhibit K, # 13 Exhibit L, # 14 Exhibit M, # 15 Exhibit N, # 16 Exhibit O, # 17 Exhibit P, # 18 Exhibit Q, # 19 Exhibit R, # 20 Exhibit S)(Mann, James) (Entered: 03/03/2020)	
	Online	37	03/03/2020	Unopposed MOTION for Leave to File Motion to Transfer Venue to the Northern District of California Under Seal by Waze Mobile Limited. (Attachments: # 1 Text of Proposed Order)(Mann, James) (Entered: 03/03/2020)	
	Online	38	03/03/2020	SEALED PATENT MOTION to Transfer Venue to The Northern District of California by Waze Mobile Limited. (Attachments: # 1 Declaration of Shannon Shaper, # 2 Text of Proposed Order)(Mann, James) (Entered: 03/03/2020)	
	Online	39	03/03/2020	Additional Attachments to Main Document: 38 SEALED PATENT MOTION to Transfer Venue to The Northern District of California.. (Attachments: # 1 Declaration of Bill Trap, # 2 Exhibit A, # 3 Exhibit B, # 4 Exhibit C, # 5 Exhibit D, # 6 Exhibit E, # 7 Exhibit F, # 8 Exhibit G, # 9 Exhibit H, # 10 Exhibit I, # 11 Exhibit J, # 12 Exhibit K, # 13 Exhibit L, # 14 Exhibit M, # 15 Exhibit N, # 16 Exhibit O, # 17 Exhibit P, # 18 Exhibit Q, # 19 Exhibit R, # 20 Exhibit S)(Mann, James) (Entered: 03/03/2020)	
	Online	40	03/04/2020	ORDER granting 34 Unopposed MOTION for Leave to File Motion to Transfer Venue to the Northern District of California Under Seal. Signed by District Judge Rodney Gilstrap on 3/4/2020. (ch, ) (Entered: 03/04/2020)	
	Online	41	03/04/2020	ORDER granting 37 Unopposed MOTION for Leave to File Motion to Transfer Venue to the Northern District of California Under Seal. Signed by District Judge Rodney Gilstrap on 3/4/2020. (ch, ) (Entered: 03/04/2020)	
	Online	42	03/04/2020	ORDER granting 18 Unopposed MOTION for Extension of Time to File Answer or Otherwise Respond to Plaintiff's Complaint. Signed by District Judge Rodney Gilstrap on 3/4/2020. (ch, ) (Entered: 03/04/2020)	
	Online	43	03/07/2020	Joint MOTION for Extension of Time for Plaintiff AGIS Software Development LLC to Comply with P. R. 3-1 & 3-2 (Infringement Contentions) and for Defendants Google LLC, Samsung Electronics Co., Ltd., Samsung Electronics America, inc., and Waze Mobile Limited to Comply with P. R. 3-3 & 3-4 (Invalidity Contentions) by AGIS Software Development LLC. (Attachments: # 1 Text of Proposed Order)(Fabricant, Alfred) (Entered: 03/07/2020)	
	Online	44	03/09/2020	REDACTION to 38 SEALED PATENT MOTION to Transfer Venue to The Northern District of California by Waze Mobile Limited. (Attachments: # 1 Declaration of Shannon Shaper, # 2 Text of Proposed Order)(Mann, James) (Entered: 03/09/2020)	

	Availability 	# 	Date 	Proceeding Text 	Source 
	Online	45	03/09/2020	ORDER granting 43 Motion Joint MOTION for Extension of Time for Plaintiff AGIS Software Development LLC to Comply with P. R. 3-1 & 3-2 (Infringement Contentions) and for Defendants Google LLC, Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Waze Mobile Limited to Comply with P. R. 3-3 & 3-4 (Invalidity Contentions). Signed by District Judge Rodney Gilstrap on 3/9/2020. (ch, ) (Entered: 03/09/2020)	
	Online	46	03/09/2020	REDACTION to 35 SEALED PATENT MOTION to Transfer Venue to The Northern District of California by Samsung Electronics Co., LTD.. (Attachments: # 1 Declaration of Chris Byoungja Jo, # 2 Declaration of Kwontae Song, # 3 Declaration of Shannon Shaper, # 4 Text of Proposed Order/Mano, James) (Entered: 03/09/2020)	
	Online	47	03/10/2020	NOTICE of Attorney Appearance by Alessandra Carcaterra Messing on behalf of AGIS Software Development LLC (Messing, Alessandra) (Entered: 03/10/2020)	
	Online	48	03/11/2020	Agreed MOTION to Extend Deadline for Plaintiff to Respond to Waze Mobile Limited's Motion to Transfer Venue to the Northern District of California Under 28 U.S.C. § 1404(a) by AGIS Software Development LLC. (Attachments: # 1 Text of Proposed Order) (Fabricant, Alfred) (Entered: 03/11/2020)	
	Online	49	03/11/2020	Agreed MOTION to Extend Deadline for Plaintiff to Respond to Samsung Defendants' Motion to Transfer Venue to the Northern District of California Under 28 U.S.C. § 1404(a) by AGIS Software Development LLC. (Attachments: # 1 Text of Proposed Order) (Fabricant, Alfred) (Entered: 03/11/2020)	
	Online	50	03/12/2020	ORDER granting 49 Agreed MOTION to Extend Deadline for Plaintiff to Respond to Samsung Defendants' Motion to Transfer Venue to the Northern District of California Under 28 U.S.C. § 1404(a). Signed by District Judge Rodney Gilstrap on 3/12/2020. (ch, ) (Entered: 03/12/2020)	
	Online	51	03/12/2020	ORDER granting 48 Agreed MOTION to Extend Deadline for Plaintiff to Respond to Waze Mobile Limited's Motion to Transfer Venue to the Northern District of California Under 28 U.S.C. § 1404(a). Signed by District Judge Rodney Gilstrap on 3/12/2020. (ch, ) (Entered: 03/12/2020)	
	Online	52	03/15/2020	Unopposed MOTION for a Second Extension of Time for Plaintiff to Respond to Defendant's Motion to Dismiss for Improper Venue (Dkt. 25) by AGIS Software Development LLC. (Attachments: # 1 Text of Proposed Order/Fabricant, Alfred) (Entered: 03/15/2020)	
	Runner		03/16/2020	NOTICE of Hearing: Scheduling Conference RESET for 3/23/2020 11:00 AM in Ctrm 106 (Marshall) before District Judge Rodney Gilstrap. ***Please note that only the TIME for the hearing has changed.***(jm) (Entered: 03/16/2020)	
	Online	53	03/16/2020	ORDER granting 52 Unopposed MOTION for a Second Extension of Time for Plaintiff to Respond to Defendant's Motion to Dismiss for Improper Venue (Dkt. 25). Signed by District Judge Rodney Gilstrap on 3/16/2020. (ch, ) (Entered: 03/17/2020)	
	Runner		03/19/2020	NOTICE of Hearing: TELEPHONIC Scheduling Conference RESET for 3/23/2020 11:00 AM before District Judge Rodney Gilstrap. ***The Court's telephone conference number is 877-336-1639 The Access Code is 5737419#. Participants should use a landline phone connection, unless use of a cellular connection is the only viable means available. Participants shall mute themselves upon joining the conference and stay muted unless speaking. Further participants shall identify themselves each and every time they speak.***(jm) (Entered: 03/19/2020)	

Availability	#	Date	Proceeding Text	Source
Runner		03/23/2020	Minute Entry for proceedings held before Judge Rodney Gilstrap: Scheduling Conference held via Teleconference on 3/23/2020. Counsel for the parties appeared and were asked if they consented to a trial before the United States Magistrate Judge. The Court then gave Markman and Jury Selection dates; and deadlines for submitting Agreed Scheduling and Discovery Orders (14 days). (Court Reporter Shelly Holmes, CSR-TCRR.) (klc, ) (Entered: 03/24/2020)	
Online	54	03/24/2020	SEALED RESPONSE in Opposition to Motion re 35 SEALED PATENT MOTION to Transfer Venue to The Northern District of California filed by AGIS Software Development LLC. (Attachments: # 1 Declaration of Vincent J. Rubino, III, # 2 Exhibit 1, # 3 Exhibit 2, # 4 Exhibit 3, # 5 Exhibit 4, # 6 Exhibit 5, # 7 Exhibit 6, # 8 Exhibit 7, # 9 Text of Proposed Order/Rubino, Vincent) (Entered: 03/24/2020)	
Online	55	03/24/2020	SEALED RESPONSE in Opposition to Motion re 38 SEALED PATENT MOTION to Transfer Venue to The Northern District of California filed by AGIS Software Development LLC. (Attachments: # 1 Declaration of Vincent J. Rubino, III, # 2 Exhibit 1, # 3 Exhibit 2, # 4 Exhibit 3, # 5 Exhibit 4, # 6 Exhibit 5, # 7 Text of Proposed Order/Rubino, Vincent) (Entered: 03/24/2020)	
Online	56	03/24/2020	SEALED RESPONSE in Opposition to Motion re 25 SEALED PATENT MOTION to Dismiss for Improper Venue filed by AGIS Software Development LLC. (Attachments: # 1 Declaration of Vincent J. Rubino, III, # 2 Exhibit A, # 3 Exhibit B, # 4 Exhibit C, # 5 Exhibit D, # 6 Exhibit E, # 7 Exhibit F, # 8 Exhibit G, # 9 Exhibit H, # 10 Exhibit I, # 11 Exhibit J, # 12 Exhibit K, # 13 Exhibit L, # 14 Exhibit M, # 15 Exhibit N, # 16 Exhibit O, # 17 Exhibit P, # 18 Exhibit Q, # 19 Exhibit R, # 20 Exhibit S, # 21 Exhibit T, # 22 Exhibit U, # 23 Exhibit V, # 24 Exhibit W, # 25 Exhibit X, # 26 Exhibit Y, # 27 Exhibit Z, # 28 Exhibit AA, # 29 Exhibit BB, # 30 Exhibit CC, # 31 Exhibit DD, # 32 Text of Proposed Order/Fabricant, Alfred) (Entered: 03/24/2020)	
Online	57	03/26/2020	REDACTION to 56 Sealed Response to Motion,, In Opposition to Google LLC's Motion to Dismiss for Improper Venue by AGIS Software Development LLC. (Attachments: # 1 Declaration of Vincent J. Rubino, III, # 2 Exhibit A, # 3 Exhibit B, # 4 Exhibit C, # 5 Exhibit D, # 6 Exhibit E, # 7 Exhibit F, # 8 Exhibit G, # 9 Exhibit H, # 10 Exhibit I, # 11 Exhibit J, # 12 Exhibit K, # 13 Exhibit L, # 14 Exhibit M, # 15 Exhibit N, # 16 Exhibit O, # 17 Exhibit P, # 18 Exhibit Q, # 19 Exhibit R, # 20 Exhibit S, # 21 Exhibit T, # 22 Exhibit U, # 23 Exhibit V, # 24 Exhibit W, # 25 Exhibit X, # 26 Exhibit Y, # 27 Exhibit Z, # 28 Exhibit AA, # 29 Exhibit BB, # 30 Exhibit CC, # 31 Exhibit DD, # 32 Text of Proposed Order/Fabricant, Alfred) (Entered: 03/26/2020)	
Online	58	03/26/2020	REDACTION to 54 Sealed Response to Motion, by AGIS Software Development LLC. (Attachments: # 1 Declaration of Vincent J. Rubino, III, # 2 Exhibit 1, # 3 Exhibit 2, # 4 Exhibit 3, # 5 Exhibit 4, # 6 Exhibit 5, # 7 Exhibit 6, # 8 Exhibit 7, # 9 Text of Proposed Order/Fabricant, Alfred) (Entered: 03/26/2020)	
Online	59	03/26/2020	REDACTION to 55 Sealed Response to Motion, by AGIS Software Development LLC. (Attachments: # 1 Declaration of Vincent J. Rubino, III, # 2 Exhibit 1, # 3 Exhibit 2, # 4 Exhibit 3, # 5 Exhibit 4, # 6 Exhibit 5, # 7 Text of Proposed Order/Fabricant, Alfred) (Entered: 03/26/2020)	
Online	60	04/01/2020	NOTICE of Attorney Appearance by Neil Phillip Sirota on behalf of Samsung Electronics Co., LTD, (Sirota, Neil) (Entered: 04/01/2020)	
Online	61	04/02/2020	NOTICE of Attorney Appearance by Timothy S Durst on behalf of Samsung Electronics America, Inc., Samsung Electronics Co., LTD, (Durst, Timothy) (Entered: 04/02/2020)	
Online	62	04/02/2020	NOTICE of Attorney Appearance by Katharine Mary Burke on behalf of Samsung Electronics America, Inc., Samsung Electronics Co., LTD, (Burke, Katharine) (Entered: 04/02/2020)	

Availability	#	Date	Proceeding Text	Source
Online	63	04/02/2020	NOTICE of Attorney Appearance by Sarah Gabrielle Hartman on behalf of AGIS Software Development LLC (Hartman, Sarah) (Entered: 04/02/2020)	
Online	64	04/06/2020	Joint MOTION for Entry of Disputed Docket Control Order by AGIS Software Development LLC. (Attachments: # 1 <u>Exhibit A - Joint Proposed Docket Control Order/Fabricant Affid</u> ) (Entered: 04/06/2020)	
Online	65	04/06/2020	Joint MOTION for Entry of Agreed Discovery Order by AGIS Software Development LLC. (Attachments: # 1 <u>Exhibit A - Proposed Discovery Order/Fabricant Affid</u> ) (Entered: 04/06/2020)	
Online	66	04/07/2020	NOTICE of Attorney Appearance - Pro Hac Vice by Andrew Bledsoe on behalf of Google LLC, Samsung Electronics America, Inc., Samsung Electronics Co., LTD., Waze Mobile Limited. Filing fee \$ 100, receipt number 0540-7742442. (Bledsoe, Andrew) (Entered: 04/07/2020)	
Online	67	04/07/2020	DISCOVERY ORDER granting 65 Joint MOTION for Entry of Agreed Discovery Order. Signed by District Judge Rodney Gilstrap on 4/7/2020. (ch, ) (Entered: 04/07/2020)	
Online	68	04/08/2020	DOCKET CONTROL ORDER - GRANTING 64 Joint MOTION for Entry of Disputed Docket Control Order. Pretrial Conference set for 2/24/2021 09:00 AM before District Judge Rodney Gilstrap., Amended Pleadings due by 7/17/2020., Jury Selection set for 4/5/2021 09:00AM before District Judge Rodney Gilstrap., Markman Hearing set for 10/2/2020 01:30 PM before District Judge Rodney Gilstrap., Motions due by 2/8/2021., Proposed Pretrial Order due by 2/19/2021.). Signed by District Judge Rodney Gilstrap on 4/8/2020. (ch, ) (Entered: 04/08/2020)	
Online	69	04/13/2020	Joint MOTION for Extension of Time to File Proposed Protective Order by Google LLC, Samsung Electronics America, Inc., Samsung Electronics Co., LTD., Waze Mobile Limited. (Attachments: # 1 <u>Text of Proposed Order(Mann, James)</u> ) (Entered: 04/13/2020)	
Online	70	04/14/2020	Unopposed MOTION for Leave to File Reply Brief in Support of Its Motion to Dismiss for Improper Venue by Google LLC. (Attachments: # 1 <u>Text of Proposed Order(Mann, James)</u> ) (Entered: 04/14/2020)	
Online	71	04/14/2020	SEALED REPLY to Response to Motion re 25 SEALED PATENT MOTION to Dismiss for Improper Venue filed by Google LLC. (Attachments: # 1 <u>Declaration of Mark Lingo</u> , # 2 <u>Exhibit 7</u> , # 3 <u>Exhibit 8</u> , # 4 <u>Exhibit 9</u> , # 5 <u>Exhibit 10</u> , # 6 <u>Exhibit 11</u> )(Mann, James) (Entered: 04/14/2020)	
Online	72	04/14/2020	ORDER granting 69 Joint MOTION for Extension of Time to File Proposed Protective Order. Signed by District Judge Rodney Gilstrap on 4/14/2020. (ch, ) (Entered: 04/14/2020)	
Online	73	04/14/2020	Unopposed MOTION for Leave to File Reply Brief in Support of Its Motion to Transfer Venue to The Northern District of California by Samsung Electronics America, Inc., Samsung Electronics Co., LTD., (Attachments: # 1 <u>Text of Proposed Order(Mann, James)</u> ) (Entered: 04/14/2020)	
Online	74	04/14/2020	SEALED REPLY to Response to Motion re 35 SEALED PATENT MOTION to Transfer Venue to The Northern District of California filed by Samsung Electronics America, Inc., Samsung Electronics Co., LTD., (Attachments: # 1 <u>Declaration of Bill Tracy</u> , # 2 <u>Exhibit 7</u> , # 3 <u>Exhibit 10</u> )(Mann, James) (Entered: 04/14/2020)	
Online	75	04/14/2020	Unopposed MOTION for Leave to File Reply Brief in Support of Its Motion to Transfer Venue to The Northern District of California by Waze Mobile Limited. (Attachments: # 1 <u>Text of Proposed Order</u> )(Mann, James) (Entered: 04/14/2020)	

Availability	#	Date	Proceeding Text	Source
Online	76	04/14/2020	SEALED REPLY to Response to Motion re 38 SEALED PATENT MOTION to Transfer Venue to The Northern District of California filed by Waze Mobile Limited. (Attachments: # 1 Declaration of Bill Tracy, # 2 Exhibit I, # 3 Exhibit Unlabeled James) (Entered: 04/14/2020)	
Online	77	04/16/2020	ORDER granting 76 Unopposed MOTION for Leave to File Reply Brief in Support of Its Motion to Dismiss for Improper Venue. Signed by District Judge Rodney Gilstrap on 4/16/2020. (ch, ) (Entered: 04/16/2020)	
Online	78	04/16/2020	ORDER granting 73 Unopposed MOTION for Leave to File Reply Brief in Support of Its Motion to Transfer Venue to The Northern District of California. Signed by District Judge Rodney Gilstrap on 4/16/2020. (ch, ) (Entered: 04/16/2020)	
Online	79	04/16/2020	ORDER granting 75 Unopposed MOTION for Leave to File Reply Brief in Support of Its Motion to Transfer Venue to The Northern District of California. Signed by District Judge Rodney Gilstrap on 4/16/2020. (ch, ) (Entered: 04/16/2020)	
Online	80	04/16/2020	REDACTION to 71 Sealed Reply to Response to Motion, to Dismiss for Improper Venue by Google LLC. (Attachments: # 1 Declaration of Mark Liang, # 2 Exhibit 7, # 3 Exhibit 8, # 4 Exhibit 9, # 5 Exhibit 10, # 6 Exhibit 11)(Mann, James) (Entered: 04/16/2020)	
Online	81	04/16/2020	REDACTION to 74 Sealed Reply to Response to Motion, to Transfer Venue to The Northern District of California by Samsung Electronics America, Inc., Samsung Electronics Co., LTD., (Attachments: # 1 Declaration of Bill Tracy, # 2 Exhibit 7, # 3 Exhibit Unlabeled James) (Entered: 04/16/2020)	
Online	82	04/16/2020	REDACTION to 76 Sealed Reply to Response to Motion, to Transfer Venue to The Northern District of California by Waze Mobile Limited. (Attachments: # 1 Declaration of Bill Tracy, # 2 Exhibit I, # 3 Exhibit Unlabeled James) (Entered: 04/16/2020)	
Online	83	04/16/2020	NOTICE by AGIS Software Development LLC of Compliance with Service of Initial Disclosures (Fabricant, Alfred) (Entered: 04/16/2020)	
Online	84	04/17/2020	Unopposed MOTION for Extension of Time for Plaintiff to File Its Sur-Replies In Further Opposition to Defendants Google's Motion to Dismiss (Dkt. 25) and Waze Mobile and Samsung's Motions for Transfer (Dkts. 38 and 39) by AGIS Software Development LLC. (Attachments: # 1 Text of Proposed Order)(Fabricant, Alfred) (Entered: 04/17/2020)	
Online	85	04/20/2020	ORDER granting 84 Unopposed MOTION for Extension of Time for Plaintiff to File Its Sur-Replies In Further Opposition to Defendants Google's Motion to Dismiss (Dkt. 25) and Waze Mobile and Samsung's Motions for Transfer (Dkts. 38 and 39). Signed by District Judge Rodney Gilstrap on 4/20/2020. (ch, ) (Entered: 04/20/2020)	
Online	86	04/20/2020	Joint MOTION for Entry of Agreed E-Discovery Order by AGIS Software Development LLC. (Attachments: # 1 Text of Proposed Order - Proposed E-Discovery Order)(Messing, Alessandra) (Entered: 04/20/2020)	
Online	87	04/20/2020	Joint MOTION for Entry of Disputed Protective Order by AGIS Software Development LLC. (Attachments: # 1 Text of Proposed Order - Proposed Protective Order)(Messing, Alessandra) (Entered: 04/20/2020)	
Online	88	04/21/2020	ORDER REGARDING E-DISCOVERY IN PATENT CASES granting 86 Joint MOTION for Entry of Agreed E-Discovery Order. Signed by District Judge Rodney Gilstrap on 4/21/2020. (ch, ) (Entered: 04/21/2020)	
Online	89	04/22/2020	PROTECTIVE ORDER 87 Joint MOTION for Entry of Disputed Protective Order. Signed by District Judge Rodney Gilstrap on 4/22/2020 (ch, ) (Entered: 04/23/2020)	



Availability	#	Date	Proceeding Text	Source
Online	90	04/28/2020	SEALED SUR-REPLY to Reply to Response to Motion In Further Opposition to Google LLC's SEALED PATENT MOTION to Dismiss for Improper Venue (Dkt. 25) filed by AGIS Software Development LLC. (Attachments: # 1 Declaration of Vincent J. Rubino, III, # 2 Exhibit 1)(Fabricant, Alfred) (Entered: 04/28/2020)	
Online	91	04/28/2020	SEALED SUR-REPLY to Reply to Response to Motion In Further Opposition to Samsung Defendants' SEALED PATENT MOTION to Transfer Venue to The Northern District of California (Dkt. 35) filed by AGIS Software Development LLC. (Attachments: # 1 Declaration of Vincent J. Rubino, III, # 2 Exhibit 6, # 3 Exhibit 8, # 4 Exhibit 10)(Fabricant, Alfred) (Entered: 04/28/2020)	
Online	92	04/28/2020	SEALED SUR-REPLY to Reply to Response to Motion In Further Opposition to Waze Mobile Limited's SEALED PATENT MOTION to Transfer Venue to The Northern District of California (Dkt. 36) filed by AGIS Software Development LLC. (Attachments: # 1 Declaration of Vincent J. Rubino, III, # 2 Exhibit 6, # 3 Exhibit 7, # 4 Exhibit 8)(Fabricant, Alfred) (Entered: 04/28/2020)	
Online	93	05/13/2020	Order Referring Case for Claim Construction Purposes Only. Signed by District Judge Rodney Gilstrap on 5/13/2020. (ch, ) (Entered: 05/13/2020)	
Runner		05/14/2020	NOTICE of Hearing:Markman Hearing RESET for 10/2/2020 09:00 AM before Magistrate Judge Roy S. Payne. (bga, ) (Entered: 05/14/2020)	

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Patents

Number	Title	Issued	Class	Subclass
8,213,970	Method of utilizing forced alerts for interactive remote communications	07/03/2012	455	466
9,408,055	Method to provide ad hoc and password protected digital and voice networks	08/02/2016	1	1
9,445,251	Method to provide ad hoc and password protected digital and voice networks	09/13/2016	1	1
9,467,032	Method to provide ad hoc and password protected digital and voice networks	10/11/2016	1	1
9,743,829	Method to provide ad hoc and password protected digital and voice networks	08/29/2017	1	1
9,820,123	Method to provide ad hoc and password protected digital and voice networks	11/14/2017	1	1

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1. Results list for:US PAT 8213970

Client/Matter: -None-

Terms: US PAT 8213970

Search Type: Natural Language

Narrowed by:

Content Type  
Dockets

Narrowed by  
Case Status: Open,Unknown,Closed

**Dockets**1. [2:17cv513. Agis Software Development Llc V. Huawei Device Usa Inc. Et Al](#)

... PATENT MOTION for Summary Judgment of Non-Infringement of U.S. Patent No. **8,213,970** by Apple, Inc.. (Attachments: # 1 Ex. 1 - US Patent **8,213,970** Ex. 1 - US Patent **8,213,970** ...  
... 01 - US 9,467,838 , # 3 Ex 02 - US **8,213,970** Ex 02 - US **8,213,970** , # 4 Ex 03 - Oxford Am Dictionary...  
... by Apple, Inc.. (Attachments: # 1 Ex. 16 - US Patent **8,213,970** Ex. 16 - US Patent **8,213,970** , # 2 Ex. 20 - AGISTX\_00007018-AGISTX\_00007034 Ex. 20 - AGISTX\_00007018-AGISTX\_00007034 ...  
... hoc and password protected digital and voice networks 2016-08-02 1 1 **8,213,970** Method of utilizing forced alerts for interactive remote communications 2012-07-03 455 ...  
... PATENT MOTION for Summary Judgment of Non-Infringement of U.S. Patent No. **8,213,970** by Apple, Inc.. (Attachments: # 1 Ex. 1 - US Patent **8,213,970** , # 2 ...  
... PATENT MOTION for Summary Judgment of Non-Infringement of U.S. Patent No. **8,213,970** filed by Apple, Inc.. (Attachments: # 1 Exhibit 11 , # ...

**Court:** Texas Eastern District Court | **Date:** Jun 21, 2017

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2. [2:17cv514. Agis Software Development Llc V. Htc Corporation](#)

... to Motion,, For Summary Judgment of Non-Infringement of U.S. Patent No. **8,213,970** [Dkt. 112] by AGIS Software Development LLC. (Attachments: # 1 Declaration ...  
... No Direct Infringement and No Indirect Infringement of U.S. Patent No. **8,213,970** by HTC Corporation. (Attachments: # 1 Text of Proposed Order , ...  
... SEALED MOTION for Summary Judgment of Non-Infringement of U.S. Patent No. **8,213,970** filed by AGIS Software Development LLC. (Attachments: # 1 Declaration of ...  
... hoc and password protected digital and voice networks 2016-08-02 1 1 **8,213,970** Method of utilizing forced alerts for interactive remote communications 2012-07-03 455 ...  
... SEALED MOTION for Summary Judgment of Non-Infringement of U.S. Patent No. **8,213,970** by LG Electronics, Inc.. (Attachments: # 1 Text of Proposed Order ...  
... No Direct Infringement and No Indirect Infringement of U.S. Patent No. **8,213,970** filed by AGIS Software Development LLC. (Attachments: # 1 Declaration of ...  
... to Motion, For Summary Judgment Of Non-Infringement Of US Patent No. **8,213,970** [Dkt. 112] by AGIS Software Development LLC. (Attachments: # 1 Declaration ...

**Court:** Texas Eastern District Court | **Date:** Jun 21, 2017

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3. [2:17cv515. Agis Software Development Llc V. Lg Electronics, Inc.](#)

... hoc and password protected digital and voice networks 2016-08-02 1 1 **8,213,970** Method of utilizing forced alerts for interactive remote communications 2012-07-03 455 ...

**Court:** Texas Eastern District Court | **Date:** Jun 21, 2017

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4. [2:17cv516. Agis Software Development Llc V. Apple, Inc.](#)

... hoc and password protected digital and voice networks 2016-08-02 1 1 **8,213,970** Method of utilizing forced alerts for interactive remote communications 2012-07-03 455 ...

**Court:** Texas Eastern District Court | **Date:** Jun 21, 2017

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5. [2:17cv517. Agis Software Development, Llc V. Zte Corporation Et Al](#)

... hoc and password protected digital and voice networks 2016-08-02 1 1 **8,213,970** Method of utilizing forced alerts for interactive remote communications 2012-07-03 455 ...

**Court:** Texas Eastern District Court | **Date:** Jun 21, 2017

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6. [2:19cv361. Agis Software Development Llc V. Google Llc](#)

... District Court for the Eastern District of TEXAS [LIVE] 2019-11-04 5X6G-C5D1-J9YR-S3M6-00000-00 **8,213,970** Method of utilizing forced alerts for interactive remote communications 2012-07-03 455 ...

**Court:** Texas Eastern District Court | **Date:** Nov 04, 2019

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7. [4:18cv6185. Zte \(Usa\) Inc. V. Agis Software Development Llc Et Al](#)

... Al US District Court for the California Northern District 2018-10-09 5TJJ-9GV1-DXDT-G2CC-00000-00 **8,213,970** Method of utilizing forced alerts for interactive remote communications 2012-07-03 455 ...

**Court:** California Northern District Court | **Date:** Oct 09, 2018

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8. [Agis Software Development Llc V. Apple, Inc](#)

... 2018 U.S. Dist. LEXIS 150749 **8,213,970** Method of utilizing forced alerts for interactive remote communications 2012-07-03 455 ...

**Court:** Florida Southern District Court | **Date:** Aug 17, 2018

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9. [Life360, Inc. V. Advanced Ground Information Systems, Inc.](#)

... Method of providing a cellular phone/PDA communication system 2012-03-06 455 437 **8,213,970** Method of utilizing forced alerts for interactive remote communications 2012-07-03 455 ...

**Court:** California Northern District Court | **Date:** Jan 12, 2015

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10. [Life360, Inc. V. Advanced Ground Information Systems, Inc.](#)

... Method of providing a cellular phone/PDA communication system 2012-03-06 455 437 **8,213,970** Method of utilizing forced alerts for interactive remote communications 2012-07-03 455 ...

**Court:** California Northern District Court | **Date:** Jan 12, 2015

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11. [Life360, Inc. V. Advanced Ground Information Systems, Inc.](#)

... Method of providing a cellular phone/PDA communication system 2012-03-06 455 437 **8,213,970** Method of utilizing forced alerts for interactive remote communications 2012-07-03 455 ...

**Court:** California Northern District Court | **Date:** Jan 12, 2015

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12. Zte Usa Inc. V. Agis Software Development Llc Et Al

... 7,031,728 Cellular phone/PDA communication system 2006-04-18 455 456.3 8,213,970 Method of utilizing forced alerts for interactive remote communications 2012-07-03 455 ...

**Court:** California Northern District Court | **Date:** Oct 09, 2018

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13. Zte Usa Inc. V. Agis Software Development Llc Et Al

... 7,031,728 Cellular phone/PDA communication system 2006-04-18 455 456.3 8,213,970 Method of utilizing forced alerts for interactive remote communications 2012-07-03 455 ...

**Court:** California Northern District Court | **Date:** Oct 09, 2018

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Diarios Oficiais - Brazil | Feb 28, 2020 | INTEGRA; Pg. 43 | 2603 words

... CIRCULANTE 6.814 6.814 PROVISÕES CONTINGÊNCIAS (NOTA 14) 6.814 6.814 PATRIMÔNIO LÍQUIDO (NOTA 15) 8.213.970 1.803.087 CAPITAL 12.263.529 10.059.852 De domiciliados no país 12.263.529 10.059.852 PREJUÍZOS ACUMULADOS ...  
 ... Lucro do Exercício - 4.207.206 4.207.206 Saldos em 31/12/2019 12.263.529 (4.049.559) 8.213.970 MUTAÇÕES NO PERÍODO 2.203.677 4.207.206 6.410.883 As notas explicativas são ...

2. U.S. Patents Awarded to Inventors in Florida (July 5)

Targeted News Service | Jul 05, 2012 | 4046 words | Targeted News Service Targeted News Service

... (12/324,122). The full-text of the patent can be found at <http://patft.uspto.gov/netacgi/nph-Parser?Sect1=PTO2&Sect2=HITOFF&p=1&u=%2Fnetacgi%2FPTO%2Fsearch-bool.html&r=1&f=G&l=50&co1=AND&d=PTXT&s1=8,213,970&OS=8,213,970&RS=8,213,970> Written by Satyaban Rath; edited by Hemanta Panigrahi. \*\*\* Cardiac Pacemakers ...  
 ... Information Systems, Jupiter , Fla., has been assigned a patent ( 8,213,970 ) developed by Malcolm K. Beyer, Jupiter Inlet Colony, Fla., for ...

3. No Headline In Original

Diarios Oficiais - Brazil | Feb 28, 2020 | INTEGRA; Pg. 45 | 1976 words

... Resultado do exercício 4.207.206 184.700 Resultado Acumulado (4.049.559) (8.256.765) Total do PL 8.213.970 1.803.087 (a.1) em outubro/2019 a acionista realizou aumento de capital, ...

4. Advanced Ground Information Systems Assigned Patent

Targeted News Service | Jul 05, 2012 | 370 words | Targeted News Service

... (12/324,122). The full-text of the patent can be found at <http://patft.uspto.gov/netacgi/nph-Parser?Sect1=PTO2&Sect2=HITOFF&p=1&u=%2Fnetacgi%2FPTO%2Fsearch-bool.html&r=1&f=G&l=50&co1=AND&d=PTXT&s1=8,213,970&OS=8,213,970&RS=8,213,970> Written by Satyaban Rath; edited by Hemanta Panigrahi. For more information ...

... Information Systems, Jupiter , Fla., has been assigned a patent ( **8,213,970** ) developed by Malcolm K. Beyer, Jupiter Inlet Colony, Fla. , ...

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5. No Headline In Original

Diarios Oficiais - Brazil | Dec 17, 2018 | PAGINAS SEM CADERNO; Pg. 114 | 1773 words

... EXTRATO DE DISPENSA DE LICITAÇÃO Nº DO DOCUMENTO 371/2018 PROCESSO Nº **8213970** /2018 / VIPROC/SESA; OBJETO: Aquisição de 08 caixas (com 100 comprimidos) ...

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6. Matthias-Sportcenter

GlobalAdSource (German) | Apr 16, 2010 | 32 words

... Matthias-Sportcenter ID **8213970** Price \$12.0 USD Media Type Print Country Germany Source LEIPZIGER VOLKSZEITUNG ...

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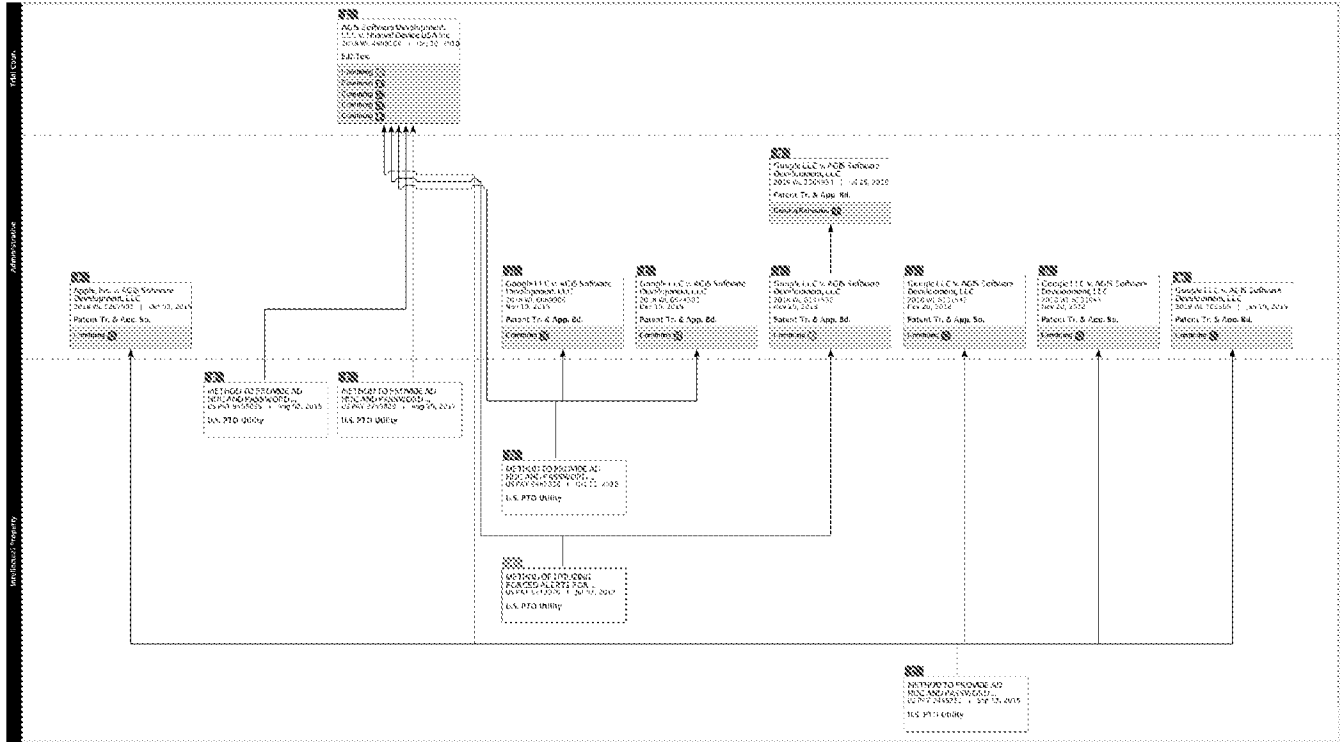
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






**History (30)**

**Direct History (18)**

1. METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS   
US PAT 8213970 , U.S. PTO Utility , July 03, 2012

*Construed by*

2. AGIS Software Development, LLC v. Huawei Device USA Inc.  
2018 WL 4908169 , E.D.Tex. , Oct. 10, 2018


*AND Construed by*

3. Google LLC v. AGIS Software Development, LLC  
2018 WL 6131538 , Patent Tr. & App. Bd. , Nov. 20, 2018

*Rehearing Denied by*

4. Google LLC v. AGIS Software Development, LLC  
2019 WL 3365934 , Patent Tr. & App. Bd. , July 25, 2019

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5. METHOD TO PROVIDE AD HOC AND PASSWORD PROTECTED DIGITAL AND VOICE NETWORKS   
US PAT 9408055 , U.S. PTO Utility , Aug. 02, 2016

*Construed by*

6. AGIS Software Development, LLC v. Huawei Device USA Inc.  
2018 WL 4908169 , E.D.Tex. , Oct. 10, 2018

*Construed by*

8. Apple, Inc. v. AGIS Software Development, LLC  
2018 WL 5267091 , Patent Tr. & App. Bd. , Oct. 03, 2018

*AND Construed by*

9. AGIS Software Development, LLC v. Huawei Device USA Inc.  
2018 WL 4908169 , E.D.Tex. , Oct. 10, 2018

*AND Construed by*

10. Google LLC v. AGIS Software Development, LLC  
2018 WL 6131542 , Patent Tr. & App. Bd. , Nov. 20, 2018

*AND Construed by*

11. Google LLC v. AGIS Software Development, LLC  
2018 WL 6131943 , Patent Tr. & App. Bd. , Nov. 20, 2018

*AND Construed by*

12. Google LLC v. AGIS Software Development, LLC  
2019 WL 165569 , Patent Tr. & App. Bd. , Jan. 10, 2019

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13. METHOD TO PROVIDE AD HOC AND PASSWORD PROTECTED DIGITAL AND VOICE NETWORKS  
US PAT 9467838 , U.S. PTO Utility , Oct. 11, 2016

14. AGIS Software Development, LLC v. Huawei Device USA Inc.  
2018 WL 4908169 , E.D.Tex. , Oct. 10, 2018

*AND Construed by*

15. Google LLC v. AGIS Software Development, LLC  
2018 WL 6069986 , Patent Tr. & App. Bd. , Nov. 19, 2018

*AND Construed by*

16. Google LLC v. AGIS Software Development, LLC  
2018 WL 6524383 , Patent Tr. & App. Bd. , Dec. 10, 2018

.....  
17. METHOD TO PROVIDE AD HOC AND PASSWORD PROTECTED DIGITAL AND VOICE NETWORKS  
US PAT 9749829 , U.S. PTO Utility , Aug. 29, 2017

*Construed by*

18. AGIS Software Development, LLC v. Huawei Device USA Inc.  
2018 WL 4908169 , E.D.Tex. , Oct. 10, 2018

**Related References (12)**

19. AGIS Software Development LLC v. Huawei Device USA Inc.  
2018 WL 2329752 , E.D.Tex. , May 23, 2018

20. Apple, Inc. v. AGIS Software Development, LLC  
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<b>REEXAMINATION - THIRD PARTY REQUESTER POWER OF ATTORNEY OR REVOCATION OF POWER OF ATTORNEY WITH A NEW POWER OF ATTORNEY AND CHANGE OF CORRESPONDENCE ADDRESS</b>	Control Number(s)	To Be Assigned
	Filing Date(s)	Herewith
	First Named Inventor	Malcolm K. Beyer
	Title	Method of Utilizing Forced Allocation
	Patent Number	8,213,970
	Examiner Name	To Be Assigned
	Attorney Docket No(s).	2525.993REX0

I hereby revoke all previous requester powers of attorney given in the above-identified reexamination proceeding control number(s).

A Power of Attorney is submitted herewith.

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I hereby appoint Practitioner(s) associated with the following Customer Number as my/our attorney(s) or agent(s) to prosecute the proceeding(s) identified above, and to transact all business in the United States Patent and Trademark Office connected therewith: 26111

**OR**

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Please recognize or change the correspondence address for the above-identified reexamination proceeding control number(s) (more than one may be changed **only** if they are merged proceedings) to be:

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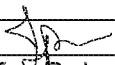
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Proof of authority to act on behalf of requester submitted herewith or filed on \_\_\_\_\_.

**SIGNATURE of Third Party Requester**

Signature		Date	4/29/2020
Name	Jennifer Poise	Telephone	
Title and Company	Director, Litigation Google LLC		

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# **Exhibit 1001**

(12) **United States Patent**  
**Beyer**

(10) **Patent No.:**      **US 8,213,970 B2**  
(45) **Date of Patent:**   **Jul. 3, 2012**

(54) **METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS**

(75) Inventor: **Malcolm K. Beyer**, Jupiter Inlet Colony, FL (US)

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(\* ) Notice:    Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 367 days.

(21) Appl. No.: **12/324,122**

(22) Filed:     **Nov. 26, 2008**

(65)           **Prior Publication Data**  
US 2009/0075685 A1    Mar. 19, 2009

**Related U.S. Application Data**

(63) Continuation-in-part of application No. 11/612,830, filed on Dec. 19, 2006, which is a continuation-in-part of application No. 11/308,648, filed on Apr. 17, 2006, now Pat. No. 7,630,724, which is a continuation-in-part of application No. 10/711,490, filed on Sep. 21, 2004, now Pat. No. 7,031,728.

(51) **Int. Cl.**  
**H04W 4/00**                   (2009.01)

(52) **U.S. Cl.**    .... **455/466**; 455/88; 455/404.2; 455/412.1; 455/412.2; 455/414.4; 455/415; 455/416; 455/418; 455/419; 455/420; 455/456.1; 455/456.3; 455/457; 455/458; 455/463; 455/500; 455/517; 455/518; 455/519; 455/556.2; 701/213; 701/482

(58) **Field of Classification Search** ..... 455/41.1, 455/416, 518, 519, 41.3, 88, 404.2, 412.1, 455/414.4, 415, 418, 419, 420, 456.1, 456.3, 455/457, 458, 463; 701/213, 482

See application file for complete search history.

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*Primary Examiner* — Nick Corsaro

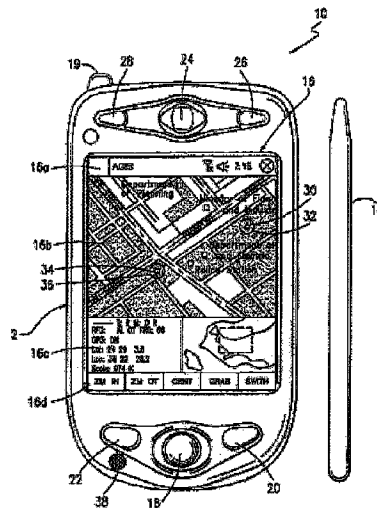
*Assistant Examiner* — Amanuel Lebassi

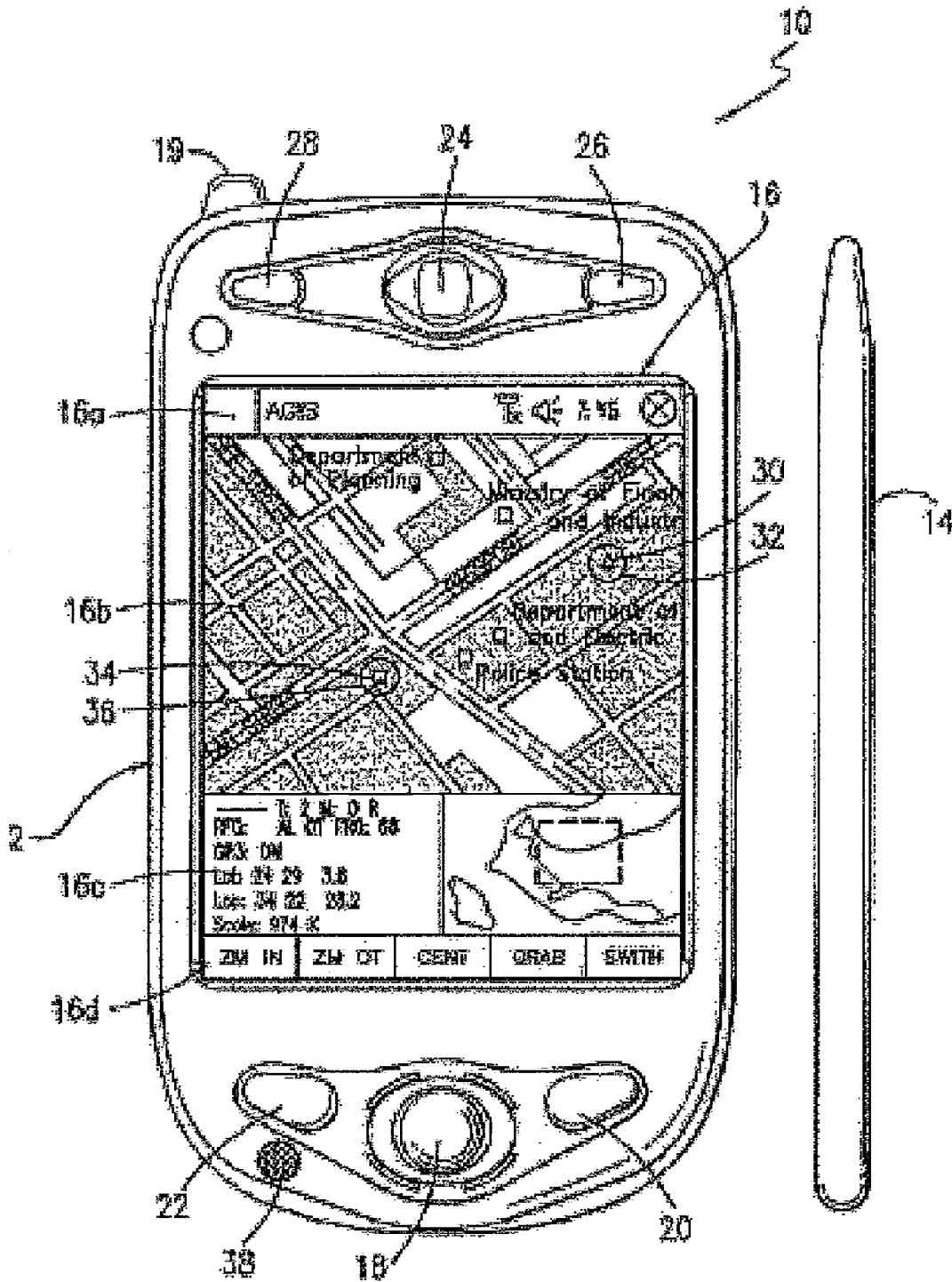
(74) *Attorney, Agent, or Firm* — Malin Haley Dimaggio Bowen & Lhota, P.A.

(57)           **ABSTRACT**

The system and method having a specialized software application on a personal computer or a PDA/cell phone that enables a participant to force an automatic acknowledgement and a manual response to a text or voice message from other participants within the same network. Each participant's PDA/cell phone includes a force message alert software application program for both creating and processing these forced message alerts. The system and method enabled by the force message alert software application program provides the ability to (a) allow an operator to create and transmit a forced message alert from a sender PDA/cell phone to one or more recipient PCs and PDA/cell phones within the communication network; (b) automatically transmit an acknowledgement of receipt to the sender PDA cell phone upon the receipt of the forced message alert; (c) periodically resend the message to the recipient PCs and PDA/cell phones that have not sent an acknowledgement; (d) provide an indication of which recipient PCs and PDA/cell phones have acknowledged the forced message alert; (e) provide a manual response list on the display of the recipient PC and PDA/cell phone's display that can only be cleared by manually transmitting a response; and (f) provide an indication on the sender PDA/cell phone of the status and content the manual responses.

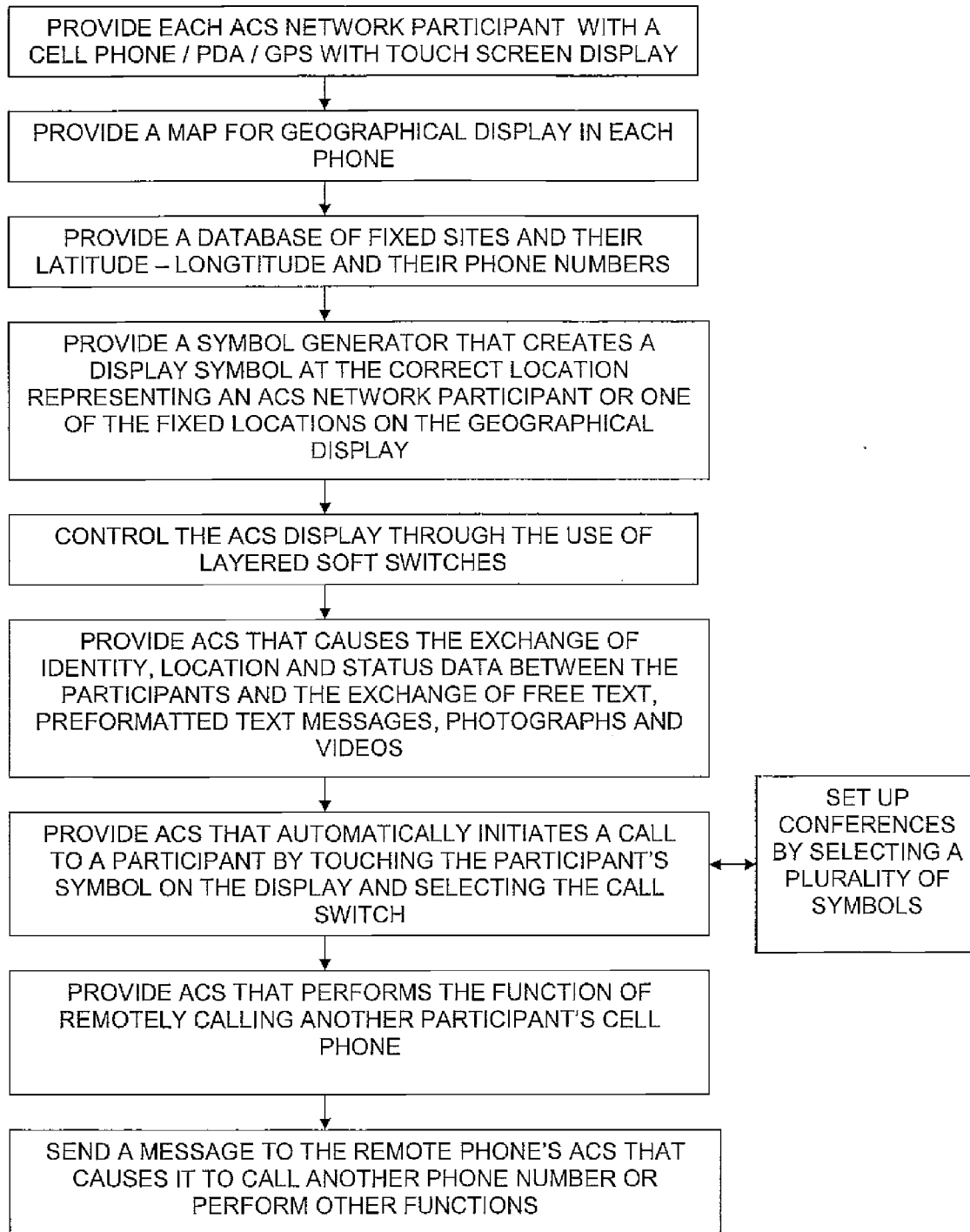
**13 Claims, 6 Drawing Sheets**





**Fig 1a**





***Fig 1b***

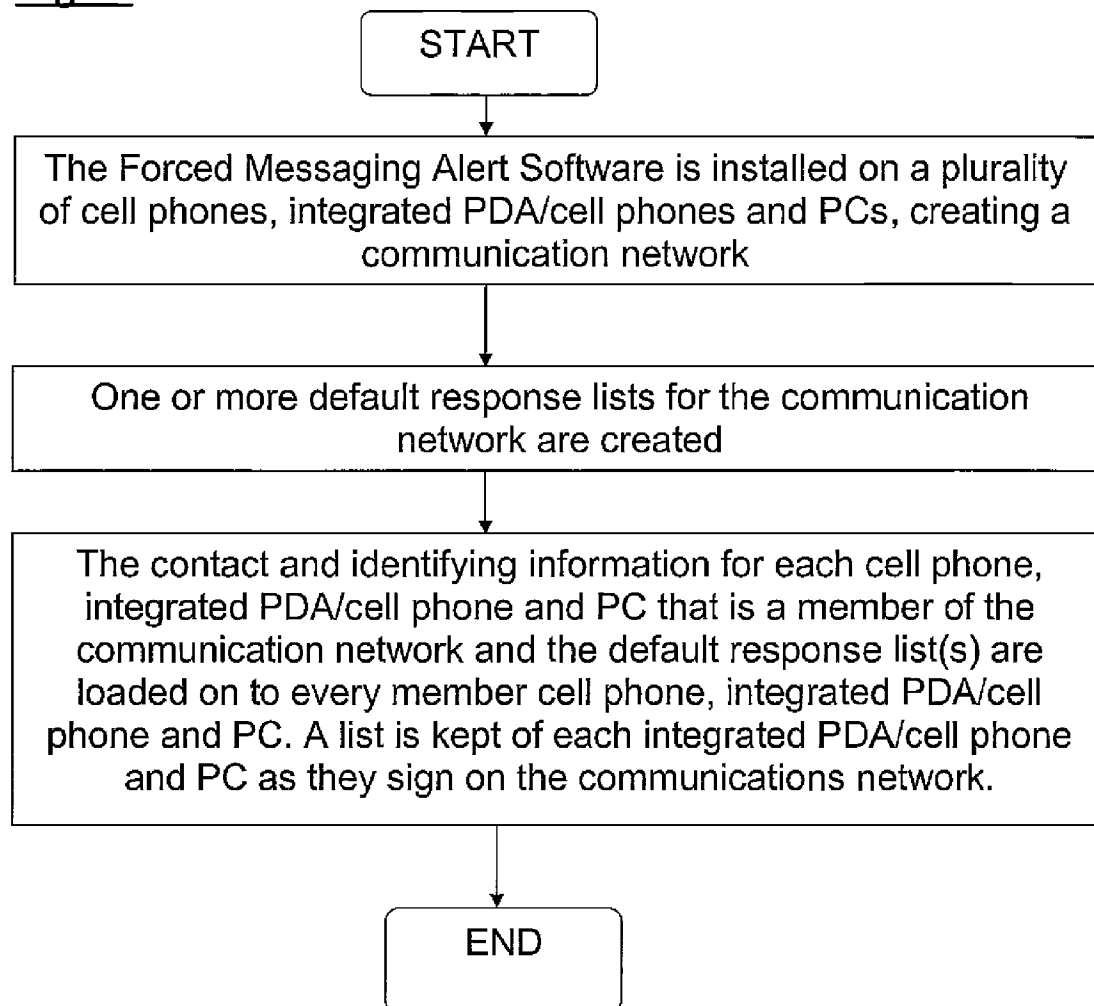
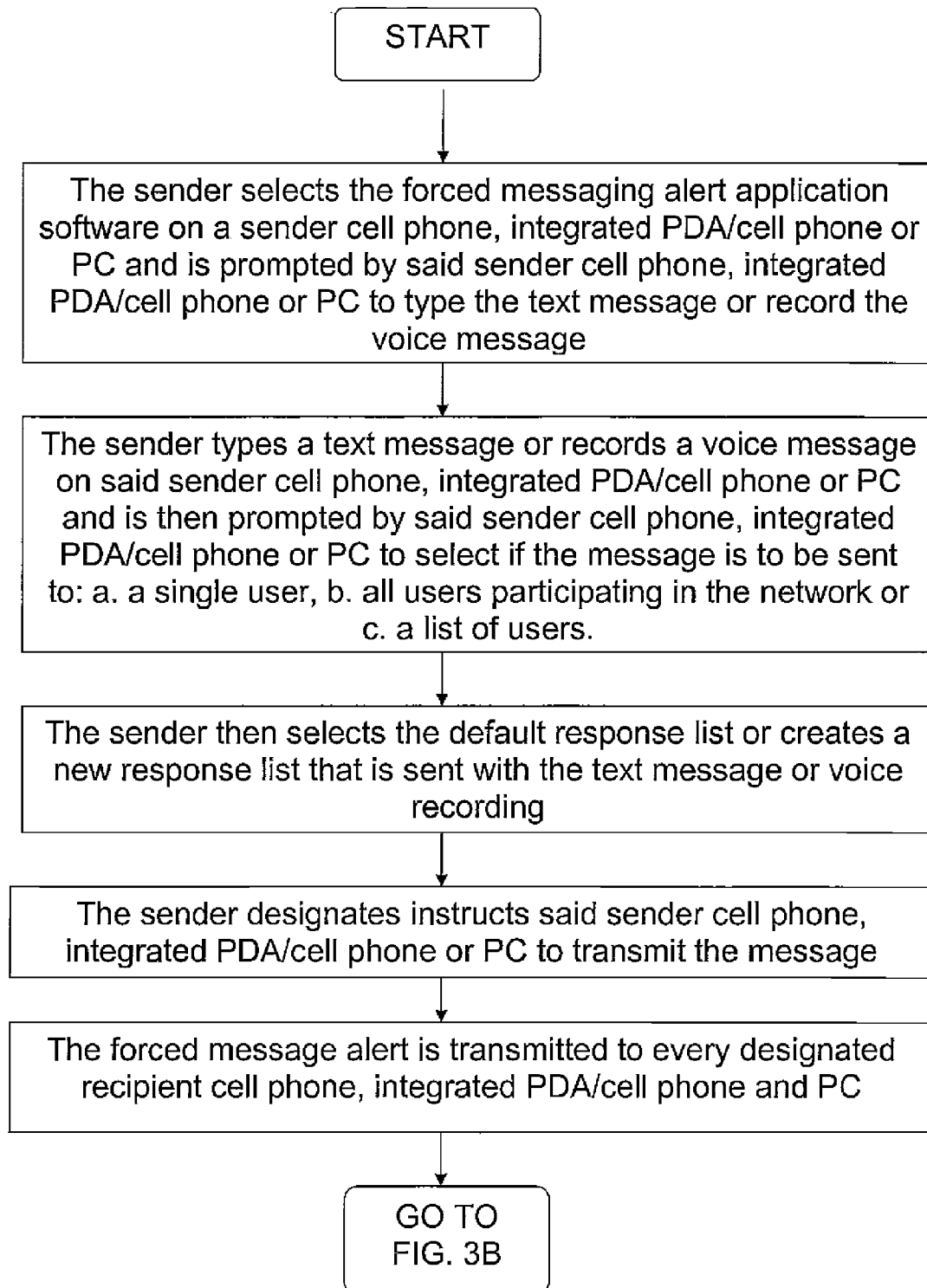
*Fig. 2*

Fig. 3A

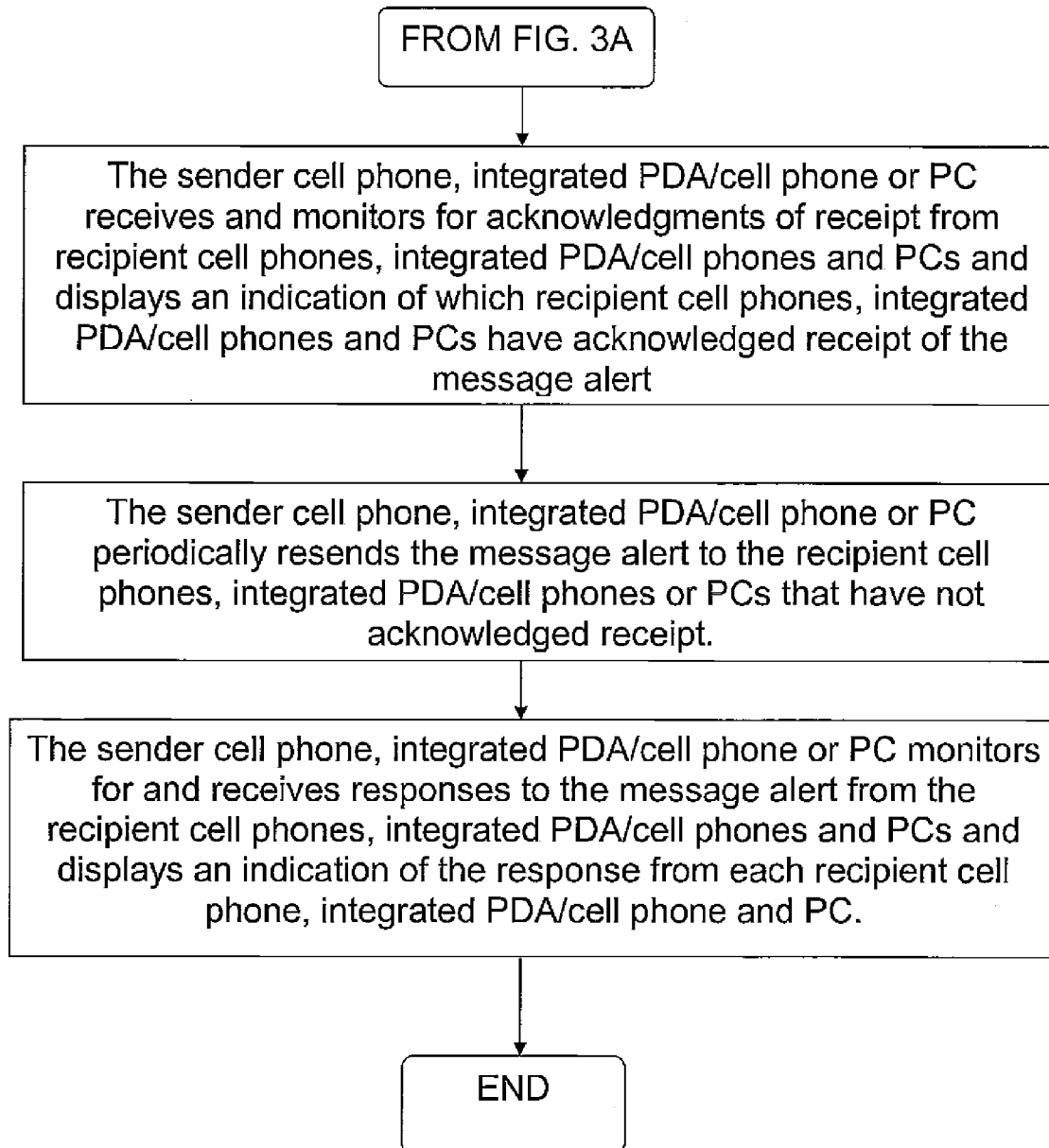
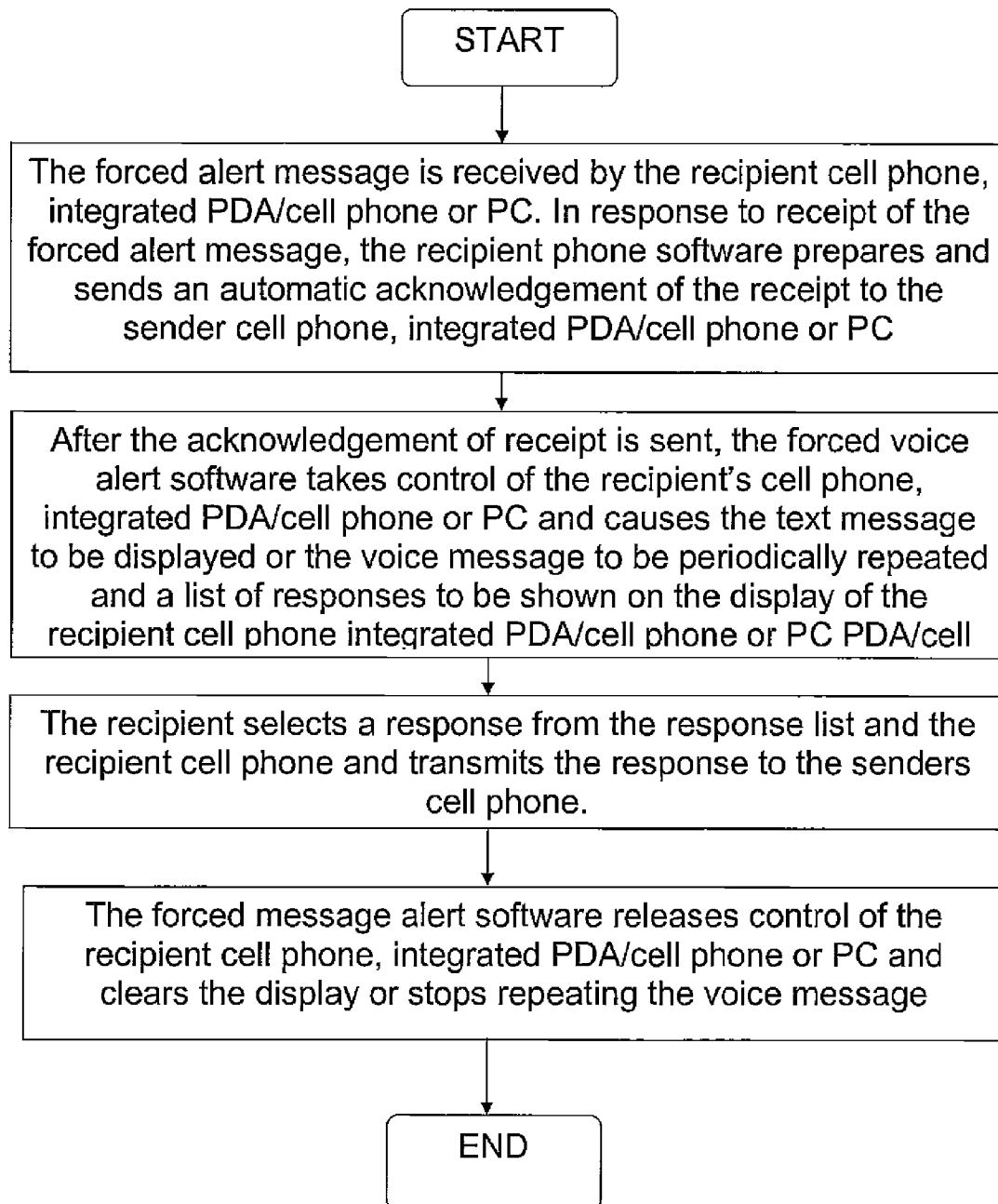
*Fig. 3B*

Fig. 4

**METHOD OF UTILIZING FORCED ALERTS  
FOR INTERACTIVE REMOTE  
COMMUNICATIONS**

This application is a continuation-in-part of U.S. patent application Ser. No. 11/612,830 filed on Dec. 19, 2006 which is a continuation-in-part of U.S. patent application Ser. No. 11/308,648 filed Apr. 17, 2006 which is a continuation-in-part of U.S. patent application Ser. No. 10/711,490 now U.S. Pat. No. 7,031,728.

BACKGROUND OF THE INVENTION

1. Field of the Invention

A communications system and method that uses a plurality of PCs and PDA/cell phones for the coordination of two or more people through the use of a communications network. The system and method provide each user with a PC or PDA/cell phone that has forced message alert software that enables a user to create and send a voice or text message alert that forces an automatic acknowledgement upon receipt and a manual response from the recipient.

2. Description of Related Art

The purpose of a communications system is to transmit information bearing digital messages from a source, located at one point, to a user destination, located at another point some distance away. A communications system is generally comprised of three basic elements: transmitter, information channel and receiver. One form of communication in recent years is cellular phone telephony. A network of cellular communication systems set up around an area such as the United States allows multiple users to talk to each other, either on individual calls or on group calls, with handheld devices. Some cellular phone services enable a cellular phone to engage in conference calls with a small number of users. Furthermore, cellular conference calls can be established through 800 number services. Cellular telephony also now includes the ability to access local WiFi connections, allowing the devices to utilize cellular phone data transmission technology as well as the data transmission ability of the Internet.

The method and operation of the integrated PDA/cell phones (cell phone/PDA/GPS with touch screen) used herein is described in U.S. Pat. No. 7,031,728, which is hereby incorporated by reference, pending U.S. patent application Ser. No. 11/308,648, and pending U.S. patent application Ser. No. 11/612,830, and are usually discussed herein as a cell phone.

In many situations it is desirable for a user to be able to simultaneously send a message to the cell phones or PCs of a large group of people. This can be typically accomplished using Digital SMS (Smart Message Service) and TCP/IP messages that are transmitted using cellular technology such as the various versions of GSM and CDMA or via a WiFi local area network. However, in some situations it is additionally desirable to know: (a) which people received the message on their cell phone or PC, (b) which people did not receive the message on their cell phone or PC, and (c) the response of each person receiving the message. Digital SMS and TCP/IP messages do not provide each of those functions. As a result, what is needed is a method in which a sender of a text or voice message can force an automatic acknowledgement upon receipt from a recipient's cell phone or PC and a manual response from the recipient via the recipient's cell phone or PC when sending the text or voice message.

SUMMARY OF THE INVENTION

Applicant's communication system and method described herein is embodied in the forced alert software developed by applicant and installed in the PCs and PDA/cell phones used herein.

A plurality of PCs and PDA/cell phones each having forced alert software installed providing a communication network of PCs and PDA/cell phones with the ability to: a) allow an operator to create and transmit (via TCP/IP or another digital transmission means) a forced voice alert, wherein said forced voice alert is comprised of a text or voice message file and a forced alert software packet, from a sender PC or PDA/cell phone to one or more recipient PCs and PDA/cell phones within said communication network; (b) automatically transmit an acknowledgement of receipt from said recipient PCs and PDA/cell phones to the sender PCs or PDA/cell phones upon receipt of the forced message alert by the recipient PCs and PDA/cell phones; (c) periodically resend the message to the recipient PCs and PDA/cell phones that have not sent an acknowledgement until an acknowledgement is received from every recipient PC and PDA/cell phone; (d) provide an indication on the display of the sender PC or PDA/cell phone of which recipient PCs and PDA/cell phones have acknowledged the forced message alert; (e) provide a manual response list on the display of the recipient PC and PDA/cell phone's display that can only be cleared by manually selecting and transmitting a response from the list or recording and transmitting a voice response after sending said automatic acknowledgment; and (f) provide an indication on the sender PC or PDA/cell phone of the status the manual response and the content of the manual response from each recipient PCs and PDA/cell phones.

A communication network server can act as a forwarder for TCP/IP communications between any combination of PC users or PDA/cell phone users. The server can also act as a forwarder of data addressed from one participant to one or more addressed participants, thus permitting the transmission of forced text or voice messages, other messages, photographs, video, E-mail and URL data from one network participant to other selected network participants.

The above functions can also be accomplished using WiFi, WiMax or other peer to peer communications. However, for use with cellular communications and to assure the level of security that cell phone companies require, a centralized static IP routable server is used.

It is the object of this invention provide to a method in which by sending a forced text or voice message to a recipient or a group of recipients, a sender can compel an automatic acknowledgement of receipt from each recipient's PC or PDA/cell phone and require a manual response from the recipient via the recipient's cell phone before the message can be cleared.

In accordance with these and other objects which will become apparent hereinafter, the instant invention will now be described with particular reference to the accompanying drawings.

BRIEF DESCRIPTION OF THE DRAWINGS

FIG. 1a shows a front elevational view of an integrated PDA/cell phone having a touch screen that includes forced message alert software described herein.

FIG. 1b shows a flow chart that explains the device shown in FIG. 1a.

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FIG. 2 shows the installation and set up of the forced message alert software on a communication network of cell phones, integrated PDA/cell phones, and PCs.

FIG. 3A shows the first section of a flow chart showing a process of sending a forced message alert to one or more recipients as well as for ascertaining which recipients received the forced message alert and which recipients responded to the forced message alert.

FIG. 3B shows the second section of a flow chart showing a process of sending a forced message alert to one or more recipients as well as for ascertaining which recipients received the forced message alert and which recipients responded to the forced message alert.

FIG. 4 shows a flow chart showing a process of receiving a forced message alert as well as providing an acknowledgment of receipt and a response by the recipient.

#### PREFERRED EMBODIMENT OF THE INVENTION

A communication system and method that joins participants in a communications network using personal computers ("PC") and handheld cell phones having integrated personal digital assistant ("PDA/cell phone") with a forced message alert software application program that allows a participant to send a text or voice message to a group of people and force an automatic acknowledgment of receipt and a manual response.

Each PDA/cell phone described herein for the participant network has its own individual on/off power and can function just as any other cell phone. It can also function with its PDA. To operate on the network, obviously the PDA/cell phone power switch has to be on. If the PDA/cell phone is completely turned off, then it is not part of the participating network and cannot send or receive any forced message alerts. In addition to its own on and off power switch, it has the forced message alert software application program that is activated manually when preparing to send a text or voice message or is activated automatically when receiving a forced message alert from another PC or PDA/cell phone.

Each PC described herein is like any other contemporary PC, except that it has the forced message alert software application program installed on it. To operate on the network, obviously the PC must be on and have an active connection to the Internet or other digital transmission means. If the PC is completely turned off, then it is not part of the participating network and cannot send or receive any forced message alerts. The forced message alert software application program on the PC is activated manually when preparing to send a text or voice message or is activated automatically when receiving a forced message alert from another PC or PDA/cell phone.

The communication system also includes a server that acts as a forwarder for IP communications between any combination of PDA/cell phone users and/or PC based users. Network participant location, identity and status messages are sent to the server by each user. The users are the network participants. Network participant entered tracks are also sent to the server. Because this data is of interest to all the network participants, the server forwards the data received from one participant to all other participants, thus providing the information necessary for all network participants to know the identity, location and status of all other network participants. In addition, the server keeps all of the network participants updated on information kept in its databases, such as all of the participants' telephone numbers, E-mail addresses and other information necessary to carry on the communications described herein.

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The server also acts as a forwarder of data addressed from one participant to one or more addressed participants, thus permitting the transmission of forced message alerts, other text and voice messages, photographs, video, E-mail and URL data from one network participant to other selected network participants.

The above functions can also be accomplished using WiFi, WiMax, or other peer to peer communications. However, for use with cellular communications and to assure the level of security that cell phone companies require, a centralized static IP routable server is used.

Referring now to the drawings and, in particular, FIGS. 1a and 1b, a small handheld cellular phone 10 is shown that includes a PDA integrated in housing 12 that includes an on/off power switch 19, a microphone 38, and an LCD display 16 that is also a touch screen system. The small area 16a is the navigation bar that depicts the telephone, GPS and other status data and the active software. Each cell phone includes a CPU and databases that store information useful in the communication network. With the touch screen 16, data can be entered through the operator using a stylus 14 (or operator finger) by manipulatively directing the stylus 14 to literally touch display 16. Soft switches 16d displayed on the display 16 are likewise activated by using a stylus 14 and physically and manipulatively directing the stylus to literally touch display 16. The display x, y coordinates of the touched point are known by a CPU in the PDA section of the communication system in housing 12 that can coordinate various information contained in the PDA relative to the x, y coordinate position on the display 16. Inside housing 12 is contained the conventional cellular phone elements including a modem, a CPU for use with a PDA and associated circuitry connected to speaker 24 and microphone 38. Conventional PDA/cellular phones are currently on sale and sold as a unit that can be used for cellular telephone calls and sending cellular SMS and TCP/IP or other messages using the PDA's display 16 and CPU. The device 10 includes a pair of cellular phone hardware activating buttons 20 to turn the cellular phone on and 22 to turn the cellular phone off. Navigation pad actuator 18 is similar to a joy or force stick in that the actuator 18 manually provides movement commands that can be used by the PDA's software to move a cursor on display 16. Switches 26 and 28 are designed to quickly select an operator specified network software program. Speaker 24 and microphone 38 are used for audio messages. Switch 19 at the top left of device 10 is the power on and power off switch for the entire device.

The heart of the invention lies in the forced message alert software application program provided in each PC or PDA/cell phone. The forced message alert software application program is activated through use of a screen drawn soft switch or by clicking on an icon on the PC or PDA/cell phone display screen or when a forced message alert transmission is received by another PC or PDA/cell phone. The display 16 is mounted within the housing 12 as part of the PDA and the CPU (not shown). The internal CPU includes databases and software application programs that provide for a geographical map and georeferenced entities that are shown as display portion 16b that includes as part of the display various areas of interest in the particular local map section.

When looking at display 16, the software switches (soft switches) which appear at the very bottom of the display 16d are used to control by touch many of the software driven functions of the PDA/cell phone. The soft switches are activated through the operator's use of the navigation pad 18, or a small track ball, force stick or similar hardware display cursor pointing device. Alternatively, the operator may choose to activate the software switches by touching the

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screen with a stylus **14** (or finger) at the switches' **16d** locations. When some of the software switches are activated, different software switches appear. The bar display **16d** shows the software switches "ZM IN (zoom in)," "ZM OT (zoom out)," "CENT (center)" and "GRAB (pan/grab)" at the bottom of the screen. These software switches enable the operator to perform these functions. The "SWITH (switch)" software switch at the lower right causes a matrix of layered software switches (soft switches) to appear above the bottom row of switches. Through use of the software switches, the operator can also manipulate the geographical map **16b** or chart display. When looking at FIG. **1a**, display symbols depict permanent geographical locations and buildings are shown. For example, the police station is shown and, when the symbol is touched by the stylus or finger, the latitude and longitude of the symbol's location, as shown in display section **16c**, is displayed at the bottom left of the screen. The bottom right side of display **16c** is a multifunction inset area that can contain a variety of information including: a) a list of the communication link participants; b) a list of received messages; a) a map, aerial photograph or satellite image with an indication of the zoom and offset location of the main map display, which is indicated by a square that depicts the area actually displayed in the main geographical screen **16b**; d) applicable status information; and e) a list of the communication net participants. Each participant user would have a device **10** shown in FIGS. **1a** and **1b**.

Also shown on the display screen **16**, specifically the geographical display **16b**, is a pair of different looking symbols **30** and **34**, a small triangle and a small square, which are not labeled. These symbols **30** and **34** can represent communication net participants having cellular phones in the displayed geographical area that are part of the overall cellular phone communications net, each participant having the same device **10** used. The latitude and longitude of symbol **30** is associated within a database with a specific cell phone number and, if available, its IP address and E-mail address. The screen display **16b**, which is a touch screen, provides x and y coordinates of the screen **16b** to the CPU's software from a map in a geographical database. The software has an algorithm that relates the x and y coordinates to latitude and longitude and can access a communications net participant's symbol or a fixed or movable entity's symbol as being the one closest to that point.

In order to initiate a telephone call to the PDA/cell phone user (communication net participant) represented by symbol (triangle) **30** at a specific latitude and longitude displayed on chart **16b**, the operator touches the triangle **30** symbol with the stylus **14**. The operator then touches a "call" software switch from a matrix of displayed soft switches that would overlay the display area **16c**. Immediately, the PDA/cell phone will initiate a cellular telephone call to the PDA/cell phone user at the geographical location shown that represents symbol **30**. A second PDA/cell phone user (communication net participant) is represented by symbol **34** which is a small square (but could be any shape or icon) to represent an individual cellular phone device in the display area. The ring **32** around symbol **30** indicates that the symbol **30** has been touched and that a telephone call can be initiated by touching the soft switch that says "call." When this is done, the telephone call is initiated. Other types of symbolic elements on the display **16** can indicate that a cellular phone call is in effect. Additionally, the operator can touch both symbol **34** and symbol **30** and can activate a conference call between the two cellular phones and users represented by symbols **30** and **34**. Again, a symbolic ring around symbol **34** indicates that a call has been initiated.

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Equally important, an operator/user with a PDA/cell phone call the police station or any other specific geographical facility displayed on the cell display map, including: buildings, locations of people, vehicles, facilities, restaurants, and the like, whose PDA/cell phone numbers and, if available, E-mail addresses, IP addresses and their URLs are previously stored in the database, by touching a specific facility location on the map display using the stylus **14** and then touching the cellular phone call switch. As an example, the operator/user can touch and point to call a restaurant using a soft switch by touching the restaurant location on the display with a stylus and then touching the call soft switch. The cellular phone will then call the restaurant. Thus, using the present invention, each participant can touch and point to call to one or more other net participants symbolically displayed on the map, each of whom has a device as shown in FIG. **1a** and can also point to call facilities and regular phone numbers that had been previously stored in the phone's database. Furthermore, this symbol hooking and soft switch technique can be used to go to a fixed facility's website or to automatically enter the fixed facility's E-mail address in an e-mail.

Each PDA/cell phone user device is identified on the map display of the other participants users' phone devices by a display symbol that is generated on each user phone display to indicate each user's identity. Each symbol is placed at the correct geographical location on the user display and is correlated with the map on the display. The operator of each PDA/cell phone device may also enter one or more other fixed entities (buildings, facilities, restaurants, police stations, etc.) and geo-referenced events such as fires, accidents, or other events into its database. This information can be likewise transmitted to all the other participants on the communications net. The map, fixed entities, events and PDA/cell phone device communication net participants' latitude and longitude information is related to the "x" and "y" location on the touch screen display map by a mathematical correlation algorithm.

When the PDA/cell phone device user uses a stylus or finger to touch one or more of the symbols or a location displayed on the cellular phone map display, the system's software causes the status and latitude and longitude information concerning that symbol or location to be displayed. In order to hook a symbol or "track" such as another net participant which represents an entity on the geo-referenced map display, or a fixed geographical entity such as a restaurant, police station or a new entity observed by a cell phone user which is discussed below, the operator points at or near the location of a geo-referenced symbol appearing on the PDA/cell phone display that represents a specific track or specific participant or other entity. The hook application software determines that the stylus is pointed close to or at the location of the symbol and puts a circle, square or other indication around the symbol indicating that amplification information concerning the symbol is to be displayed and indicating that additional data or change in data can be made to the indicated symbol. The hook application code then sends a message to the display application code to display the net participant, facility or entity's amplifying data. The display application code retrieves the primary data and amplification data concerning the symbol or entity from the database and displays the information at the correct screen location. The operator can then read the amplification data that relates to that specific symbol at the specific location. The PDA/cell phone operator can also select soft switches on the touch screen display to change the primary data and amplification data. Furthermore, the operator can use a similar method of hooking and selecting to activate particular soft switches to take other actions



which could include: making cellular phone calls, conference calls, 800 number calls; sending a free text message, operator selected preformatted messages, photographs or videos to the hooked symbol; or to drop a entered symbol.

Each known net participant has a PDA/cell phone number, IP address and, if available, E-mail address that is stored in each participant's device database.

Referring now to FIG. 2, in order to set up a communication network that utilizes the forced message alert system, the forced message alert software application program must be installed on a plurality of PCs and/or PDA/cell phones. The application will provide for a forced alert message that can be designated for transmission according to several criteria: a.) A single PC and/or PDA/cell phone, b.) The list of users currently participating in the network, and c.) A user or administrator predefined list of network participants.

A required response list which will be either preinstalled in the phone application software or sent with the forced message alert will be presented to the user operator upon receipt of the forced message. When the forced text or voice alert is received, the user operator is presented with the required response list. In order to clear the forced text message alert from the user operator's PC or PDA/cell phone display, the user operator is required to select a reply from this list. If the alert is a voice message, the message keeps repeating at a defined rate until the user operator selects from the required response list. A military default response list would typically consist of choices such as, "will comply," "will not comply," and "have complied." However, depending on the nature of the industry in which the users in the communication network are in, this default response list could vary significantly.

The contact and identifying information for each PC and PDA/cell phone that is anticipated to be a member of the communication network and the default response list is loaded on to every member PC and PDA/cell phone in the preferred embodiment. This step makes sure the each user of the communication network has, in addition to the necessary software, the necessary information to send a forced message alert to any and every known member of the communication network. When operating in an open network mode where all that know the password can join the network, the default list is created or expanded as new members join.

Referring now to FIG. 3A and FIG. 3B, the process of sending a forced message alert from a PC or PDA/cell phone begins with a sender selecting the forced message alert software application program on a sender PC or PDA/cell phone. The sender can then select by said sender PC or PDA/cell phone to type a text message or record a voice message or select the text alert or voice alert from a list. Once the sender types a text message or records a voice message or selects a voice or text message on said PC or PDA/cell phone, the sender can then use a soft switch or selection from a list to send the forced alert to: a.) Another network participant, b.) The current PC or PDA/cell phone network participants or c.) A user or administrator predefined list of network participants. The response list from which the message receiver must select can either be included in the forced alert message or be preloaded in each phone. The forced alert message is then transmitted via TCP/IP or other digital transmission means to every PC or PDA/cell phone designated to receive the forced message alert either directly or through a server whose function is to retransmit the messages to the correct users in the communications network.

After the forced message alert is transmitted, the sender PC or PDA/cell phone monitors for and receives electronic transmissions with acknowledgments of receipt from the PCs or PDA/cell phones that have received the forced message alert.

Then, the sender PC or PDA/cell phone provides an indication of which of the PC or PDA/cell phone that the forced message alert was sent to have acknowledged receipt and which of the PC or PDA/cell phone that the forced message alert was sent to have not acknowledged receipt on its display. The sender PC or PDA/cell phone will then periodically resend the forced message alert to the PC or PDA/cell phone that have not acknowledged receipt.

The sender PC or PDA/cell phone also monitors for and receives electronic transmissions with manual responses to the forced message alert from the PC or PDA/cell phone that received the message. As these electronic transmissions with manual responses are received, the sender PC or PDA/cell phone displays an indication of the response from each recipient cell phone, integrated PDA/cell phone and PC.

Referring now to FIG. 4, the process of receiving, acknowledging and responding to a forced message alert from the sender PC or PDA/cell phone begins when an electronic transmission is received by a recipient PC or PDA/cell phone. When the electronic transmission is received by the recipient PC or PDA/cell phone, the recipient PC or PDA/cell phone identifies the transmission as a forced message alert and the forced message alert software application program on the recipient PC or PDA/cell phone separates the text or voice message and the forced message alert software packet. Immediately following the detection of the forced message alert, the forced message alert software application program on the recipient PC or PDA/cell phone prepares and electronically transmits an automatic acknowledgement of receipt to the sender PC or PDA/cell phone. However, if the recipient PC or PDA/cell phone is powered off or is not able to receive electronic transmissions, the forced message alert is not received by the recipient PC or PDA/cell phone and no acknowledgement is transmitted. If no acknowledgement is received, the sender PC or PDA/cell phone continues to transmit the forced alert at a predefined rate until acknowledged.

After the acknowledgement of receipt is transmitted, the forced voice alert software application program effectively takes control of the recipient PC or PDA/cell phone. If a text message was received, the forced voice alert software application program causes the text message and the response list to be shown on the display of the recipient PC or PDA/cell phone until a manual response is selected from the response list. Upon selection of the desired response, the forced alert text data is cleared from the recipient PC or PDA/cell phone display. If a voice message was received, the forced voice alert software application program causes the voice message to be periodically repeated using the speakers of the recipient PC or PDA/cell phone while the response list is shown on the display. This voice message cannot be stopped from repeating until one of the entries on the response list is selected.

Once a response is selected or recorded and transmitted to the sender PC or PDA/cell phone, the forced message alert software application program releases effective control of the recipient PC or PDA/cell phone, clears the display, and stops repeating the voice message and transmits the response to the force alert sender.

The instant invention has been shown and described herein in what is considered to be the most practical and preferred embodiment. It is recognized, however, that departures may be made there from within the scope of the invention and that obvious modifications will occur to a person skilled in the art.

What is claimed is:

1. A communication system for transmitting, receiving, confirming receipt, and responding to an electronic message, comprising:

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a predetermined network of participants, wherein each participant has a similarly equipped PDA/cell phone that includes a CPU and a touch screen display a CPU and memory;

a data transmission means that facilitates the transmission of electronic files between said PDA/cell phones in different locations;

a sender PDA/cell phone and at least one recipient PDA/cell phone for each electronic message;

a forced message alert software application program including a list of required possible responses to be selected by a participant recipient of a forced message response loaded on each participating PDA/cell phone;

means for attaching a forced message alert software packet to a voice or text message creating a forced message alert that is transmitted by said sender PDA/cell phone to the recipient PDA/cell phone, said forced message alert software packet containing a list of possible required responses and requiring the forced message alert software on said recipient PDA/cell phone to transmit an automatic acknowledgment to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone;

means for requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display;

means for receiving and displaying a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have not automatically acknowledged the forced message alert;

means for periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced message alert; and

means for receiving and displaying a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert and details the response from each recipient PDA/cell phone that responded.

2. The system as in claim 1, wherein the forced message alert software application program on the recipient PDA/cell phone includes:

means for transmitting the acknowledgment of receipt to said sender PDA/cell phone immediately upon receiving a forced message alert from the sender PDA/cell phone;

means for controlling of the recipient PDA/cell phone upon transmitting said automatic acknowledgment and causing, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PDA/cell phone or causes, in cases where the forced message alert is a voice message, the voice message being periodically repeated by the speakers of the recipient PDA/cell phone while said response list is shown on the display;

means for allowing a manual response to be manually selected from the response list or manually recorded and transmitting said manual response to the sender PDA/cell phone; and

means for clearing the text message and a response list from the display of the recipient PDA/cell phone or stopping the repeating voice message and clearing the response list from the display of the recipient PDA/cell phone once the manual response is transmitted.

3. The system as in claim 1, wherein said data transmission means is TCP/IP or another communications protocol.

4. The system as in claim 1, wherein the response list that is transmitted within the forced message alert software packet

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is a default response list that is embedded in the forced message alert software application program.

5. The system as in claim 1, wherein the response list that is transmitted within the forced message alert software packet is a custom response list that is created at the time the specific forced message alert is created on the sender PDA/cell phone.

6. A method of sending a forced message alert to one or more recipient PDA/cell phones within a predetermined communication network, wherein the receipt and response to said forced message alert by each intended recipient PDA/cell phone is tracked, said method comprising the steps of:

- accessing a forced message alert software application program on a sender PDA/cell phone;
- creating the forced message alert on said sender PDA/cell phone by attaching a voice or text message to a forced message alert application software packet to said voice or text message;
- designating one or more recipient PDA/cell phones in the communication network;
- electronically transmitting the forced message alert to said recipient PDA/cell phones;
- receiving automatic acknowledgements from the recipient PDA/cell phones that received the message and displaying a listing of which recipient PDA/cell phones have acknowledged receipt of the forced message alert and which recipient PDA/cell phones have not acknowledged receipt of the forced message alert;
- periodically resending the forced message alert to the recipient PDA/cell phones that have not acknowledged receipt;
- receiving responses to the forced message alert from the recipient PDA/cell phones and displaying the response from each recipient PDA/cell phone; and
- providing a manual response list on the display of the recipient PDA/cell phone that can only be cleared by the recipient providing a required response from the list;
- clearing the recipient's display screen or causing the repeating voice alert to cease upon recipient selecting a response from the response list required that can only be cleared by manually selecting and transmitting a response to the manual response list.

7. The method as in claim 6, wherein each PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it.

8. The method as in claim 6, wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program.

9. The method as in claim 6, wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PDA/cell phone.

10. A method of receiving, acknowledging and responding to a forced message alert from a sender PDA/cell phone to a recipient PDA/cell phone, wherein the receipt, acknowledgment, and response to said forced message alert is forced by a forced message alert software application program, said method comprising the steps of:

- receiving an electronically transmitted electronic message;
- identifying said electronic message as a forced message alert, wherein said forced message alert comprises of a voice or text message and a forced message alert application software packet, which triggers the activation of the forced message alert software application program within the recipient PDA/cell phone;

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transmitting an automatic acknowledgment of receipt to the sender PDA/cell phone, which triggers the forced message alert software application program to take control of the recipient PDA/cell phone and show the content of the text message and a required response list on the display recipient PDA/cell phone or to repeat audibly the content of the voice message on the speakers of the recipient PDA/cell phone and show the required response list on the display recipient PDA/cell phone; and  
transmitting a selected required response from the response list in order to allow the message required response list to be cleared from the recipient's cell phone display, whether said selected response is a chosen option from the response list, causing the forced message alert software to release control of the recipient PDA/cell phone and stop showing the content of the text message and a response list on the display recipient PDA/cell phone and or stop repeating the content of the voice message on the speakers of the recipient PDA/cell phone;

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displaying the response received from the PDA cell phone that transmitted the response on the sender of the forced alert PDA/cell phone; and  
providing a list of the recipient PDA/cell phones have automatically acknowledged receipt of a forced alert message and their response to the forced alert message.  
11. The method as in claim 10, wherein each PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it.  
12. The method as in claim 10, wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program.  
13. The method as in claim 10, wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PDA/cell phone.

\* \* \* \* \*

# **Exhibit 1002**

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

<b>Application Data Sheet 37 CFR 1.76</b>		Attorney Docket Number	10963.3819
		Application Number	
Title of Invention	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS		
<p>The application data sheet is part of the provisional or nonprovisional application for which it is being submitted. The following form contains the bibliographic data arranged in a format specified by the United States Patent and Trademark Office as outlined in 37 CFR 1.76. This document may be completed electronically and submitted to the Office in electronic format using the Electronic Filing System (EFS) or the document may be printed and included in a paper filed application.</p>			

**Secrecy Order 37 CFR 5.2**

<input type="checkbox"/>	Portions or all of the application associated with this Application Data Sheet may fall under a Secrecy Order pursuant to 37 CFR 5.2 (Paper filers only. Applications that fall under Secrecy Order may not be filed electronically.)
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**Applicant Information:**

<b>Applicant 1</b>					<input type="button" value="Remove"/>
<b>Applicant Authority</b>		<input checked="" type="radio"/> Inventor		<input type="radio"/> Legal Representative under 35 U.S.C. 117	
				<input type="radio"/> Party of Interest under 35 U.S.C. 118	
<b>Prefix</b>	<b>Given Name</b>	<b>Middle Name</b>	<b>Family Name</b>	<b>Suffix</b>	
	Malcom	K.	Beyer	Jr.	
<b>Residence Information (Select One)</b>					
		<input checked="" type="radio"/> US Residency		<input type="radio"/> Non US Residency	
				<input type="radio"/> Active US Military Service	
<b>City</b>	Jupiter Inlet Colony	<b>State/Province</b>	FL	<b>Country of Residence i</b>	US
<b>Citizenship under 37 CFR 1.41(b) i</b>		US			
<b>Mailing Address of Applicant:</b>					
<b>Address 1</b>	92 Lighthouse Drive				
<b>Address 2</b>					
<b>City</b>	Jupiter Inlet Colony	<b>State/Province</b>	FL		
<b>Postal Code</b>	33469-3504	<b>Country i</b>	US		
All Inventors Must Be Listed - Additional Inventor Information blocks may be generated within this form by selecting the <b>Add</b> button.					<input type="button" value="Add"/>

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Enter either Customer Number or complete the Correspondence Information section below. For further information see 37 CFR 1.33(a).			
<input type="checkbox"/> An Address is being provided for the correspondence information of this application.			
<b>Customer Number</b>	22235		
<b>Email Address</b>	info@mhdpatents.com	<input type="button" value="Add Email"/>	<input type="button" value="Remove Email"/>

**Application Information:**

<b>Title of the Invention</b>	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS		
<b>Attorney Docket Number</b>	10963.3819	<b>Small Entity Status Claimed</b>	<input checked="" type="checkbox"/>
<b>Application Type</b>	Nonprovisional		
<b>Subject Matter</b>	Utility		
<b>Suggested Class (if any)</b>		<b>Sub Class (if any)</b>	
<b>Suggested Technology Center (if any)</b>			
<b>Total Number of Drawing Sheets (if any)</b>		<b>Suggested Figure for Publication (if any)</b>	

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<b>Application Data Sheet 37 CFR 1.76</b>		Attorney Docket Number	10963.3819
		Application Number	
Title of Invention	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS		

**Publication Information:**

<input checked="" type="checkbox"/>	Request Early Publication (Fee required at time of Request 37 CFR 1.219)
<input type="checkbox"/>	<b>Request Not to Publish.</b> I hereby request that the attached application not be published under 35 U.S.C. 122(b) and certify that the invention disclosed in the attached application <b>has not and will not</b> be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication at eighteen months after filing.

**Representative Information:**

Representative information should be provided for all practitioners having a power of attorney in the application. Providing this information in the Application Data Sheet does not constitute a power of attorney in the application (see 37 CFR 1.32). Enter either Customer Number or complete the Representative Name section below. If both sections are completed the Customer Number will be used for the Representative Information during processing.			
Please Select One:	<input checked="" type="radio"/> Customer Number	<input type="radio"/> US Patent Practitioner	<input type="radio"/> Limited Recognition (37 CFR 11.9)
Customer Number	22235		

**Domestic Benefit/National Stage Information:**

This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) or indicate National Stage entry from a PCT application. Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and 37 CFR 1.78(a)(2) or CFR 1.78(a)(4), and need not otherwise be made part of the specification.					
Prior Application Status	Pending		<a href="#">Remove</a>		
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)		
	Continuation in part of	11612830	2006-12-19		
Prior Application Status	Pending		<a href="#">Remove</a>		
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)		
11612830	Continuation in part of	11308648	2006-04-17		
Prior Application Status	Patented		<a href="#">Remove</a>		
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)	Patent Number	Issue Date (YYYY-MM-DD)
11308648	Continuation in part of	10711490	2004-09-21	7031728	2006-04-18
Additional Domestic Benefit/National Stage Data may be generated within this form by selecting the <b>Add</b> button.					<a href="#">Add</a>

**Foreign Priority Information:**

This section allows for the applicant to claim benefit of foreign priority and to identify any prior foreign application for which priority is not claimed. Providing this information in the application data sheet constitutes the claim for priority as required by 35 U.S.C. 119(b) and 37 CFR 1.55(a).
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<b>Application Data Sheet 37 CFR 1.76</b>		Attorney Docket Number	10963.3819
		Application Number	
Title of Invention	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS		

<input type="button" value="Remove"/>			
Application Number	Country <sup>i</sup>	Parent Filing Date (YYYY-MM-DD)	Priority Claimed
			<input checked="" type="radio"/> Yes <input type="radio"/> No
Additional Foreign Priority Data may be generated within this form by selecting the Add button.			<input type="button" value="Add"/>

**Assignee Information:**

Providing this information in the application data sheet does not substitute for compliance with any requirement of part 3 of Title 37 of the CFR to have an assignment recorded in the Office.				
<b>Assignee 1</b>				<input type="button" value="Remove"/>
If the Assignee is an Organization check here. <input type="checkbox"/>				
Prefix	Given Name	Middle Name	Family Name	Suffix
<b>Mailing Address Information:</b>				
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Country <sup>i</sup>		Postal Code		
Phone Number		Fax Number		
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**Signature:**

A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature.					
<b>Signature</b>	/barry l haley/			Date (YYYY-MM-DD)	2008-11-26
First Name	Barry L.	Last Name	Haley	Registration Number	25339

This collection of information is required by 37 CFR 1.76. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 23 minutes to complete, including gathering, preparing, and submitting the completed application data sheet form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.



## METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS

### BACKGROUND OF THE INVENTION

5 This application is a continuation-in-part of U.S. Patent Application Serial No. 11/612830 filed on December 19, 2006 which is a continuation-in-part of U.S. Patent Application Serial No. 11/308,648 filed April 17, 2006 which is a continuation-in-part of U.S. Patent Application Serial No. 10/711,490 now U.S. Patent No. 7,031,728.

10 1. Field of the Invention

A communications system and method that uses a plurality of PCs and PDA/cell phones for the coordination of two or more people through the use of a communications network. The system and method provide each user with a PC or PDA/cell phone that has forced message alert software that enables a user to create and send a voice or text message alert that forces an automatic acknowledgement upon receipt and a manual response from the recipient.

15 2. Description of Related Art

The purpose of a communications system is to transmit information bearing digital messages from a source, located at one point, to a user destination, located at another point some distance away. A communications system is generally comprised of three basic elements: transmitter, information channel and receiver. One form of communication in recent years is cellular phone telephony. A network of cellular communication systems set up around an area such as the United States allows multiple users to talk to each other, either on individual calls or on group calls, with handheld devices. Some cellular phone services enable a cellular phone to engage in conference calls with a small number of users. Furthermore,

cellular conference calls can be established through 800 number services. Cellular telephony also now includes the ability to access local WiFi connections, allowing the devices to utilize cellular phone data transmission technology as well as the data transmission ability of the Internet.

5           The method and operation of the integrated PDA/cell phones (cell phone/PDA/GPS with touch screen) used herein is described in U.S. Patent 7,031,728, which is hereby incorporated by reference, pending U.S. Patent Application Serial No. 11/308,648, and pending U.S. Patent Application Serial No. 11/612,830, and are usually discussed herein as a cell phone.

10           In many situations it is desirable for a user to be able to simultaneously send a message to the cell phones or PCs of a large group of people. This can be typically accomplished using Digital SMS (Smart Message Service) and TCP/IP messages that are transmitted using cellular technology such as the various versions of GSM and CDMA or via a WiFi local area network. However, in some situations it is additionally desirable to know: (a) which people received the  
15   message on their cell phone or PC, (b) which people did not receive the message on their cell phone or PC, and (c) the response of each person receiving the message. Digital SMS and TCP/IP messages do not provide each of those functions. As a result, what is needed is a method in which a sender of a text or voice message can force an automatic acknowledgement upon receipt from a recipient's cell phone or PC and a manual response from the recipient via  
20   the recipient's cell phone or PC when sending the text or voice message.

### SUMMARY OF THE INVENTION

Applicant's communication system and method described herein is embodied in the forced alert software developed by applicant and installed in the PCs and PDA/cell phones  
5 used herein.

A plurality of PCs and PDA/cell phones each having forced alert software installed providing a communication network of PCs and PDA/cell phones with the ability to: a) allow an operator to create and transmit (via TCP/IP or another digital transmission means) a forced voice alert, wherein said forced voice alert is comprised of a text or voice message file and a  
10 forced alert software packet, from a sender PC or PDA/cell phone to one or more recipient PCs and PDA/cell phones within said communication network; (b) automatically transmit an acknowledgement of receipt from said recipient PCs and PDA/cell phones to the sender PCs or PDA/cell phones upon receipt of the forced message alert by the recipient PCs and PDA/cell phones; (c) periodically resend the message to the recipient PCs and PDA/cell  
15 phones that have not sent an acknowledgement until an acknowledgement is received from every recipient PC and PDA/cell phone; (d) provide an indication on the display of the sender PC or PDA/cell phone of which recipient PCs and PDA/cell phones have acknowledged the forced message alert; (e) provide a manual response list on the display of the recipient PC and PDA/cell phone's display that can only be cleared by manually selecting and transmitting a  
20 response from the list or recording and transmitting a voice response after sending said automatic acknowledgment; and (f) provide an indication on the sender PC or PDA/cell phone

of the status the manual response and the content of the manual response from each recipient PCs and PDA/cell phones.

A communication network server can act as a forwarder for TCP/IP communications between any combination of PC users or PDA/cell phone users. The server can also act as a  
5 forwarder of data addressed from one participant to one or more addressed participants, thus permitting the transmission of forced text or voice messages, other messages, photographs, video, E-mail and URL data from one network participant to other selected network participants.

The above functions can also be accomplished using WiFi, WiMax or other peer to  
10 peer communications. However, for use with cellular communications and to assure the level of security that cell phone companies require, a centralized static IP routable server is used.

It is the object of this invention provide to a method in which by sending a forced text or voice message to a recipient or a group of recipients, a sender can compel an automatic acknowledgement of receipt from each recipient's PC or PDA/cell phone and require a manual  
15 response from the recipient via the recipient's cell phone before the message can be cleared.

In accordance with these and other objects which will become apparent hereinafter, the instant invention will now be described with particular reference to the accompanying drawings.

### BRIEF DESCRIPTION OF THE DRAWINGS

Figure 1a shows a front elevational view of an integrated PDA/cell phone having a touch screen that includes forced message alert software described herein.

Figure 1b shows a flow chart that explains the device shown in Figure 1a.

5        Figure 2 shows the installation and set up of the forced message alert software on a communication network of cell phones, integrated PDA/cell phones, and PCs.

Figure 3A shows the first section of a flow chart showing a process of sending a forced message alert to one or more recipients as well as for ascertaining which recipients received the forced message alert and which recipients responded to the forced message alert.

10        Figure 3B shows the second section of a flow chart showing a process of sending a forced message alert to one or more recipients as well as for ascertaining which recipients received the forced message alert and which recipients responded to the forced message alert.

Figure 4 shows a flow chart showing a process of receiving a forced message alert as well as providing an acknowledgment of receipt and a response by the recipient.

15

## PREFERRED EMBODIMENT OF THE INVENTION

A communication system and method that joins participants in a communications network using personal computers ("PC") and handheld cell phones having integrated  
5 personal digital assistant ("PDA/cell phone") with a forced message alert software application program that allows a participant to send a text or voice message to a group of people and force an automatic acknowledgment of receipt and a manual response.

Each PDA/cell phone described herein for the participant network has its own individual on/off power and can function just as any other cell phone. It can also function  
10 with its PDA. To operate on the network, obviously the PDA/cell phone power switch has to be on. If the PDA/cell phone is completely turned off, then it is not part of the participating network and cannot send or receive any forced message alerts. In addition to its own on and off power switch, it has the forced message alert software application program that is activated manually when preparing to send a text or voice message or is activated automatically when  
15 receiving a forced message alert from another PC or PDA/cell phone.

Each PC described herein is like any other contemporary PC, except that it has the forced message alert software application program installed on it. To operate on the network, obviously the PC must be on and have an active connection to the Internet or other digital transmission means. If the PC is completely turned off, then it is not part of the participating  
20 network and cannot send or receive any forced message alerts. The forced message alert software application program on the PC is activated manually when preparing to send a text or

voice message or is activated automatically when receiving a forced message alert from another PC or PDA/cell phone.

The communication system also includes a server that acts as a forwarder for IP communications between any combination of PDA/cell phone users and/or PC based users.

5 Network participant location, identity and status messages are sent to the server by each user.

The users are the network participants. Network participant entered tracks are also sent to the server. Because this data is of interest to all the network participants, the server forwards the data received from one participant to all other participants, thus providing the information necessary for all network participants to know the identity, location and status of all other

10 network participants. In addition, the server keeps all of the network participants updated on information kept in its databases, such as all of the participants' telephone numbers, E-mail addresses and other information necessary to carry on the communications described herein.

The server also acts as a forwarder of data addressed from one participant to one or more addressed participants, thus permitting the transmission of forced message alerts, other

15 text and voice messages, photographs, video, E-mail and URL data from one network participant to other selected network participants.

The above functions can also be accomplished using WiFi, WiMax, or other peer to peer communications. However, for use with cellular communications and to assure the level of security that cell phone companies require, a centralized static IP routable server is used.

20 Referring now to the drawings and, in particular, Figure 1a and 1b, a small handheld cellular phone 10 is shown that includes a PDA integrated in housing 12 that includes an

on/off power switch 19, a microphone 38, and an LCD display 16 that is also a touch screen system. The small area 16a is the navigation bar that depicts the telephone, GPS and other status data and the active software. Each cell phone includes a CPU and databases that store information useful in the communication network. With the touch screen 16, data can be  
5 entered through the operator using a stylus 14 (or operator finger) by manipulatively directing the stylus 14 to literally touch display 16. Soft switches 16d displayed on the display 16 are likewise activated by using a stylus 14 and physically and manipulatively directing the stylus to literally touch display 16. The display x, y coordinates of the touched point are known by a CPU in the PDA section of the communication system in housing 12 that can coordinate  
10 various information contained in the PDA relative to the x, y coordinate position on the display 16. Inside housing 12 is contained the conventional cellular phone elements including a modem, a CPU for use with a PDA and associated circuitry connected to speaker 24 and microphone 38. Conventional PDA/cellular phones are currently on sale and sold as a unit that can be used for cellular telephone calls and sending cellular SMS and TCP/IP or other  
15 messages using the PDA's display 16 and CPU. The device 10 includes a pair of cellular phone hardware activating buttons 20 to turn the cellular phone on and 22 to turn the cellular phone off. Navigation pad actuator 18 is similar to a joy or force stick in that the actuator 18 manually provides movement commands that can be used by the PDA's software to move a cursor on display 16. Switches 26 and 28 are designed to quickly select an operator specified  
20 network software program. Speaker 24 and microphone 38 are used for audio messages.



Switch 19 at the top left of device 10 is the power on and power off switch for the entire device.

The heart of the invention lies in the forced message alert software application program provided in each PC or PDA/cell phone. The forced message alert software application program is activated through use of a screen drawn soft switch or by clicking on an icon on the PC or PDA/cell phone display screen or when a forced message alert transmission is received by another PC or PDA/cell phone. The display 16 is mounted within the housing 12 as part of the PDA and the CPU (not shown). The internal CPU includes databases and software application programs that provide for a geographical map and georeferenced entities that are shown as display portion 16b that includes as part of the display various areas of interest in the particular local map section.

When looking at display 16, the software switches (soft switches) which appear at the very bottom of the display 16d are used to control by touch many of the software driven functions of the PDA/cell phone. The soft switches are activated through the operator's use of the navigation pad 18, or a small track ball, force stick or similar hardware display cursor pointing device. Alternatively, the operator may choose to activate the software switches by touching the screen with a stylus 14 (or finger) at the switches' 16d locations. When some of the software switches are activated, different software switches appear. The bar display 16d shows the software switches "ZM IN (zoom in)," "ZM OT (zoom out)," "CENT (center)" and "GRAB (pan/grab)" at the bottom of the screen. These software switches enable the operator to perform these functions. The "SWITH (switch)" software switch at the lower right causes a

matrix of layered software switches (soft switches) to appear above the bottom row of switches. Through use of the software switches, the operator can also manipulate the geographical map 16b or chart display. When looking at Figure 1a, display symbols depict permanent geographical locations and buildings are shown. For example, the police station is shown and, when the symbol is touched by the stylus or finger, the latitude and longitude of the symbol's location, as shown in display section 16c, is displayed at the bottom left of the screen. The bottom right side of display 16c is a multifunction inset area that can contain a variety of information including: a) a list of the communication link participants; b) a list of received messages; c) a map, aerial photograph or satellite image with an indication of the zoom and offset location of the main map display, which is indicated by a square that depicts the area actually displayed in the main geographical screen 16b; d) applicable status information; and e) a list of the communication net participants. Each participant user would have a device 10 shown in Figure 1a and 1b.

Also shown on the display screen 16, specifically the geographical display 16b, is a pair of different looking symbols 30 and 34, a small triangle and a small square, which are not labeled. These symbols 30 and 34 can represent communication net participants having cellular phones in the displayed geographical area that are part of the overall cellular phone communications net, each participant having the same device 10 used. The latitude and longitude of symbol 30 is associated within a database with a specific cell phone number and, if available, its IP address and E-mail address. The screen display 16b, which is a touch screen, provides x and y coordinates of the screen 16b to the CPU's software from a map in a

geographical database. The software has an algorithm that relates the x and y coordinates to latitude and longitude and can access a communications net participant's symbol or a fixed or movable entity's symbol as being the one closest to that point.

In order to initiate a telephone call to the PDA/cell phone user (communication net  
5 participant) represented by symbol (triangle) 30 at a specific latitude and longitude displayed on chart 16b, the operator touches the triangle 30 symbol with the stylus 14. The operator then touches a "call" software switch from a matrix of displayed soft switches that would overlay the display area 16c. Immediately, the PDA/cell phone will initiate a cellular telephone call to the PDA/cell phone user at the geographical location shown that represents symbol 30. A  
10 second PDA/cell phone user (communication net participant) is represented by symbol 34 which is a small square (but could be any shape or icon) to represent an individual cellular phone device in the display area. The ring 32 around symbol 30 indicates that the symbol 30 has been touched and that a telephone call can be initiated by touching the soft switch that says "call." When this is done, the telephone call is initiated. Other types of symbolic elements on  
15 the display 16 can indicate that a cellular phone call is in effect. Additionally, the operator can touch both symbol 34 and symbol 30 and can activate a conference call between the two cellular phones and users represented by symbols 30 and 34. Again, a symbolic ring around symbol 34 indicates that a call has been initiated.

Equally important, an operator/user with a PDA/cell phone call the police station or  
20 any other specific geographical facility displayed on the cell display map, including: buildings, locations of people, vehicles, facilities, restaurants, and the like, whose PDA/cell phone

numbers and, if available, E-mail addresses, IP addresses and their URLs are previously stored in the database, by touching a specific facility location on the map display using the stylus 14 and then touching the cellular phone call switch. As an example, the operator/user can touch and point to call a restaurant using a soft switch by touching the restaurant location  
5 on the display with a stylus and then touching the call soft switch. The cellular phone will then call the restaurant. Thus, using the present invention, each participant can touch and point to call to one or more other net participants symbolically displayed on the map, each of whom has a device as shown in Figure 1a and can also point to call facilities and regular phone numbers that had been previously stored in the phone's database. Furthermore, this symbol  
10 hooking and soft switch technique can be used to go to a fixed facility's website or to automatically enter the fixed facility's E-mail address in an e-mail.

Each PDA/cell phone user device is identified on the map display of the other participants users' phone devices by a display symbol that is generated on each user phone display to indicate each user's identity. Each symbol is placed at the correct geographical  
15 location on the user display and is correlated with the map on the display. The operator of each PDA/cell phone device may also enter one or more other fixed entities (buildings, facilities, restaurants, police stations, etc.) and geo-referenced events such as fires, accidents, or other events into its database. This information can be likewise transmitted to all the other participants on the communications net. The map, fixed entities, events and PDA/cell phone  
20 device communication net participants' latitude and longitude information is related to the "x" and "y" location on the touch screen display map by a mathematical correlation algorithm.

When the PDA/cell phone device user uses a stylus or finger to touch one or more of the symbols or a location displayed on the cellular phone map display, the system's software causes the status and latitude and longitude information concerning that symbol or location to be displayed. In order to hook a symbol or "track" such as another net participant which represents an entity on the geo-referenced map display, or a fixed geographical entity such as a restaurant, police station or a new entity observed by a cell phone user which is discussed below, the operator points at or near the location of a geo-referenced symbol appearing on the PDA/cell phone display that represents a specific track or specific participant or other entity. The hook application software determines that the stylus is pointed close to or at the location of the symbol and puts a circle, square or other indication around the symbol indicating that amplification information concerning the symbol is to be displayed and indicating that additional data or change in data can be made to the indicated symbol. The hook application code then sends a message to the display application code to display the net participant, facility or entity's amplifying data. The display application code retrieves the primary data and amplification data concerning the symbol or entity from the database and displays the information at the correct screen location. The operator can then read the amplification data that relates to that specific symbol at the specific location. The PDA/cell phone operator can also select soft switches on the touch screen display to change the primary data and amplification data. Furthermore, the operator can use a similar method of hooking and selecting to activate particular soft switches to take other actions which could include: making cellular phone calls, conference calls, 800 number calls; sending a free text message, operator

selected preformatted messages, photographs or videos to the hooked symbol; or to drop a entered symbol.

Each known net participant has a PDA/cell phone number, IP address and, if available, E-mail address that is stored in each participant's device database.

5 Referring now to Figure 2, in order to set up a communication network that utilizes the forced message alert system, the forced message alert software application program must be installed on a plurality of PCs and/or PDA/cell phones. The application will provide for a forced alert message that can be designated for transmission according to several criteria: a.) A single PC and/or PDA/cell phone, b.) The list of users currently participating in the network,  
10 and c.) A user or administrator predefined list of network participants.

A required response list which will be either preinstalled in the phone application software or sent with the forced message alert will be presented to the user operator upon receipt of the forced message. When the forced text or voice alert is received, the user operator is presented with the required response list. In order to clear the forced text message alert from  
15 the user operator's PC or PDA/cell phone display, the user operator is required to select a reply from this list. If the alert is a voice message, the message keeps repeating at a defined rate until the user operator selects from the required response list. A military default response list would typically consist of choices such as, "will comply," will not comply," and "have complied." However, depending on the nature of the industry in which the users in the  
20 communication network are in, this default response list could vary significantly.

The contact and identifying information for each PC and PDA/cell phone that is anticipated to be a member of the communication network and the default response list is loaded on to every member PC and PDA/cell phone in the preferred embodiment. This step makes sure the each user of the communication network has, in addition to the necessary software, the necessary information to send a forced message alert to any and every known member of the communication network. When operating in an open network mode where all that know the password can join the network, the default list is created or expanded as new members join.

Referring now to Figure 3A and Figure 3B, the process of sending a forced message alert from a PC or PDA/cell phone begins with a sender selecting the forced message alert software application program on a sender PC or PDA/cell phone. The sender can then select by said sender PC or PDA/cell phone to type a text message or record a voice message or select the text alert or voice alert from a list. Once the sender types a text message or records a voice message or selects a voice or text message on said PC or PDA/cell phone, the sender can then use a soft switch or selection from a list to send the forced alert to: a.) Another network participant, b.) The current PC or PDA/cell phone network participants or c.) A user or administrator predefined list of network participants. The response list from which the message receiver must select can either be included in the forced alert message or be preloaded in each phone. The forced alert message is then transmitted via TCP/IP or other digital transmission means to every PC or PDA/cell phone designated to receive the forced

message alert either directly or through a server whose function is to retransmit the messages to the correct users in the communications network.

After the forced message alert is transmitted, the sender PC or PDA/cell phone monitors for and receives electronic transmissions with acknowledgments of receipt from the  
5 PCs or PDA/cell phones that have received the forced message alert. Then, the sender PC or PDA/cell phone provides an indication of which of the PC or PDA/cell phone that the forced message alert was sent to have acknowledged receipt and which of the PC or PDA/cell phone that the forced message alert was sent to have not acknowledged receipt on its display. The sender PC or PDA/cell phone will then periodically resend the forced message alert to the PC  
10 or PDA/cell phone that have not acknowledged receipt.

The sender PC or PDA/cell phone also monitors for and receives electronic transmissions with manual responses to the forced message alert from the PC or PDA/cell phone that received the message. As these electronic transmissions with manual responses are received, the sender PC or PDA/cell phone displays an indication of the response from each  
15 recipient cell phone, integrated PDA/cell phone and PC.

Referring now to Figure 4, the process of receiving, acknowledging and responding to a forced message alert from the sender PC or PDA/cell phone begins when an electronic transmission is received by a recipient PC or PDA/cell phone. When the electronic transmission is received by the recipient PC or PDA/cell phone, the recipient PC or PDA/cell  
20 phone identifies the transmission as a forced message alert and the forced message alert software application program on the recipient PC or PDA/cell phone separates the text or



voice message and the forced message alert software packet. Immediately following the detection of the forced message alert, the forced message alert software application program on the recipient PC or PDA/cell phone prepares and electronically transmits an automatic acknowledgement of receipt to the sender PC or PDA/cell phone. However, if the recipient PC  
5 or PDA/cell phone is powered off or is not able to receive electronic transmissions, the forced message alert is not received by the recipient PC or PDA/cell phone and no acknowledgment is transmitted. If no acknowledgement is received, the sender PC or PDA/cell phone continues to transmit the forced alert at a predefined rate until acknowledged.

After the acknowledgement of receipt is transmitted, the forced voice alert software  
10 application program effectively takes control of the recipient PC or PDA/cell phone. If a text message was received, the forced voice alert software application program causes the text message and the response list to be shown on the display of the recipient PC or PDA/cell phone until a manual response is selected from the response list. Upon selection of the desired response, the forced alert text data is cleared from the recipient PC or PDA/cell phone display.  
15 If a voice message was received, the forced voice alert software application program causes the voice message to be periodically repeated using the speakers of the recipient PC or PDA/cell phone while the response list is shown on the display. This voice message cannot be stopped from repeating until one of the entries on the response list is selected.

Once a response is selected or recorded and transmitted to the sender PC or PDA/cell  
20 phone, the forced message alert software application program releases effective control of the

recipient PC or PDA/cell phone, clears the display, and or stops repeating the voice message and transmits the response to the force alert sender.

The instant invention has been shown and described herein in what is considered to be the most practical and preferred embodiment. It is recognized, however, that departures may  
5 be made there from within the scope of the invention and that obvious modifications will occur to a person skilled in the art.

CLAIMS

What is claimed is:

1. A communication system for transmitting, receiving, confirming receipt, and responding to an electronic message, comprising:

5 a predetermined network of participants, wherein each participant has a similarly equipped PC or PDA/cell phone that includes a CPU and a touch screen display a CPU and memory;

a data transmission means that facilitates the transmission of electronic files between said PCs and said PDA/cell phones in different locations;

10 a sender PC or PDA/cell phone and at least one recipient PC or PDA/cell phone for each electronic message; and

a forced message alert software application program loaded on each participating PC or PDA/cell phone.

2. The system as in claim 1, wherein the forced message alert software application  
15 program on the sender PC or PDA/cell phone:

means for attaching a forced message alert software packet to a voice or text message creating a forced message alert that is transmitted by said sender PC or PDA/cell phone to the recipient PC or PDA/cell phone, wherein said forced message alert software packet contains a response list and requires the forced message alert software on said recipient PC or PDA/cell  
20 phone to transmit an automatic acknowledgment to the sender PC or PDA/cell phone as soon as said forced message alert is received by the recipient PC or PDA/cell phone;

means for receiving and displaying a listing of which recipient PCs or PDA/cell phones have automatically acknowledged the forced message alert and which recipient PCs or PDA/cell phones have not automatically acknowledged the forced message alert;

means for periodically resending said forced message alert to said recipient PCs  
5 or PDA/cell phones that have not automatically acknowledged the forced message alert; and

means for receiving and displaying a listing of which recipient PCs or PDA/cell phones have transmitted a manual response to said forced message alert and details the response from each recipient PC or PDA/cell phone that responded.

3. The system as in claim 1, wherein the forced message alert software application  
10 program on the recipient PC or PDA/cell phone:

means for transmitting the acknowledgment of receipt to said sender PC or PDA/cell phone immediately upon receiving a forced message alert from the sender PC or PDA/cell phone;

means for controlling of the recipient PC or PDA/cell phone upon transmitting  
15 said automatic acknowledgment and causes, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PC or PDA/cell phone or causes, in cases where the force message alert is a voice message, the voice message to be periodically repeated by the speakers of the recipient PC or PDA/cell phone while said response list is shown on the display;

means for allowing a manual response to be manually selected from the response list or manually recorded and transmits said manual response to the sender PC or PDA/cell phone; and

means for clearing the text message and a response list from the display of the recipient PC or PDA/cell phone or stops the repeating voice message and clears the response list from the display of the recipient PC or PDA/cell phone once the manual response is transmitted.

4. The system as in claim 1, wherein said data transmission means is TCP/IP or another communications protocol.

5. The system as in claim 1, wherein the response list that is transmitted within the forced message alert software packet is a default response list that is embedded in the forced message alert software application program.

6. The system as in claim 1, wherein the response list that is transmitted within the forced message alert software packet is a custom response list that is created at the time the specific forced message alert is created on the sender PC or PDA/cell phone.

7. A method of sending a forced message alert to one or more recipient PCs or PDA/cell phones within a predetermined communication network, wherein the receipt and response to said forced message alert by each intended recipient PC or PDA/cell phone is tracked, said method comprising the steps of:

accessing a forced message alert software application program on a sender PC or PDA/cell phone;

creating the forced message alert on said sender PC or PDA/cell phone by attaching a voice or text message to a forced message alert application software packet to said voice or text message;

designating one or more recipient PCs or PDA/cell phones in the  
5 communication network;

electronically transmitting the forced message alert to said recipient PCs or PDA/cell phones;

receiving automatic acknowledgements from the recipient PCs or PDA/cell phones that received the message and displaying a listing of which recipient PCs or PDA/cell  
10 phones have acknowledged receipt of the forced message alert and which recipient PCs or PDA/cell phones have not acknowledged receipt of the forced message alert;

periodically resending the forced message alert to the recipient PCs or PDA/cell phones that have not acknowledged receipt;

receiving responses to the forced message alert from the recipient PCs or  
15 PDA/cell phones and displaying the response from each recipient PC or PDA/cell phone; and

clearing the receiver's display screen or causing the repeating voice alert to cease upon selecting a response.

8. The method as in claim 7, wherein each PC or PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert  
20 software application program loaded on it.

9. The method as in claim 7, wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program.

10. The method as in claim 7, wherein said forced message alert application  
5 software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PC or PDA/cell phone.

11. A method of receiving, acknowledging and responding to a forced message alert from a sender PC or PDA/cell phone to a recipient PC or PDA/cell phone, wherein the  
10 receipt, acknowledgment, and response to said forced message alert is forced by a forced message alert software application program, said method comprising the steps of:

receiving an electronically transmitted electronic message;

15 identifying said electronic message as a forced message alert, wherein said forced message alert consists of a voice or text message and a forced message alert application software packet, which triggers the activation of the forced message alert software application program within the recipient PC or PDA/cell phone;

transmitting an automatic acknowledgment of receipt to the sender PC or PDA/cell phone, which triggers the forced message alert software application program to take control of the recipient PC or PDA/cell phone and show the content of the text message and a  
20 response list on the display recipient PC or PDA/cell phone or to repeat audibly the content of

the voice message on the speakers of the recipient PC or PDA/cell phone and show the response list on the display recipient PC or PDA/cell phone; and

transmitting a selected response, whether said selected response is a chosen option from the response list, causing the forced message alert software to release control of  
5 the recipient PC or PDA/cell phone and stop showing the content of the text message and a response list on the display recipient PC or PDA/cell phone and or stop repeating the content of the voice message on the speakers of the recipient PC or PDA/cell phone;

displaying the response received from the PC or PDA cell phone that transmitted the response on the sender of the forced alert PC or PDA/cell phone; and

10 providing a list of the recipient PC or PDA/cell phones have automatically acknowledged receipt of a forced alert message and their response to the forced alert message.

12. The method as in claim 11, wherein each PC or PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it.

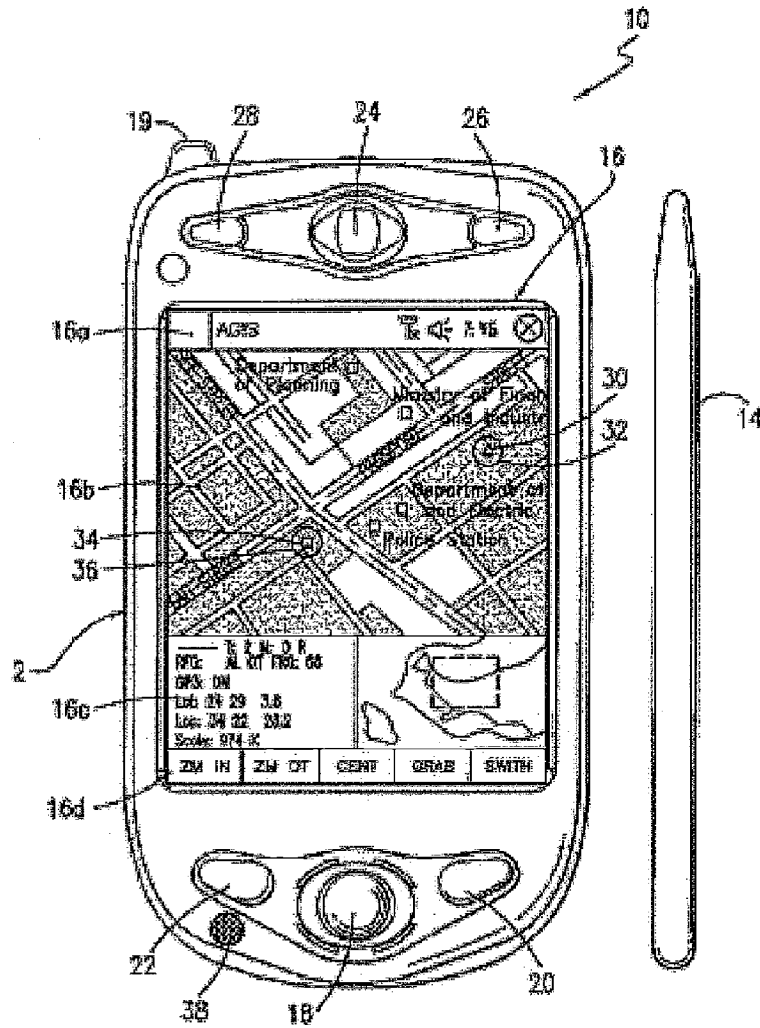
15 13. The method as in claim 11, wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program.

14. The method as in claim 11, wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list  
20 that is created at the time the specific forced message alert is created on the sender PC or PDA/cell phone.

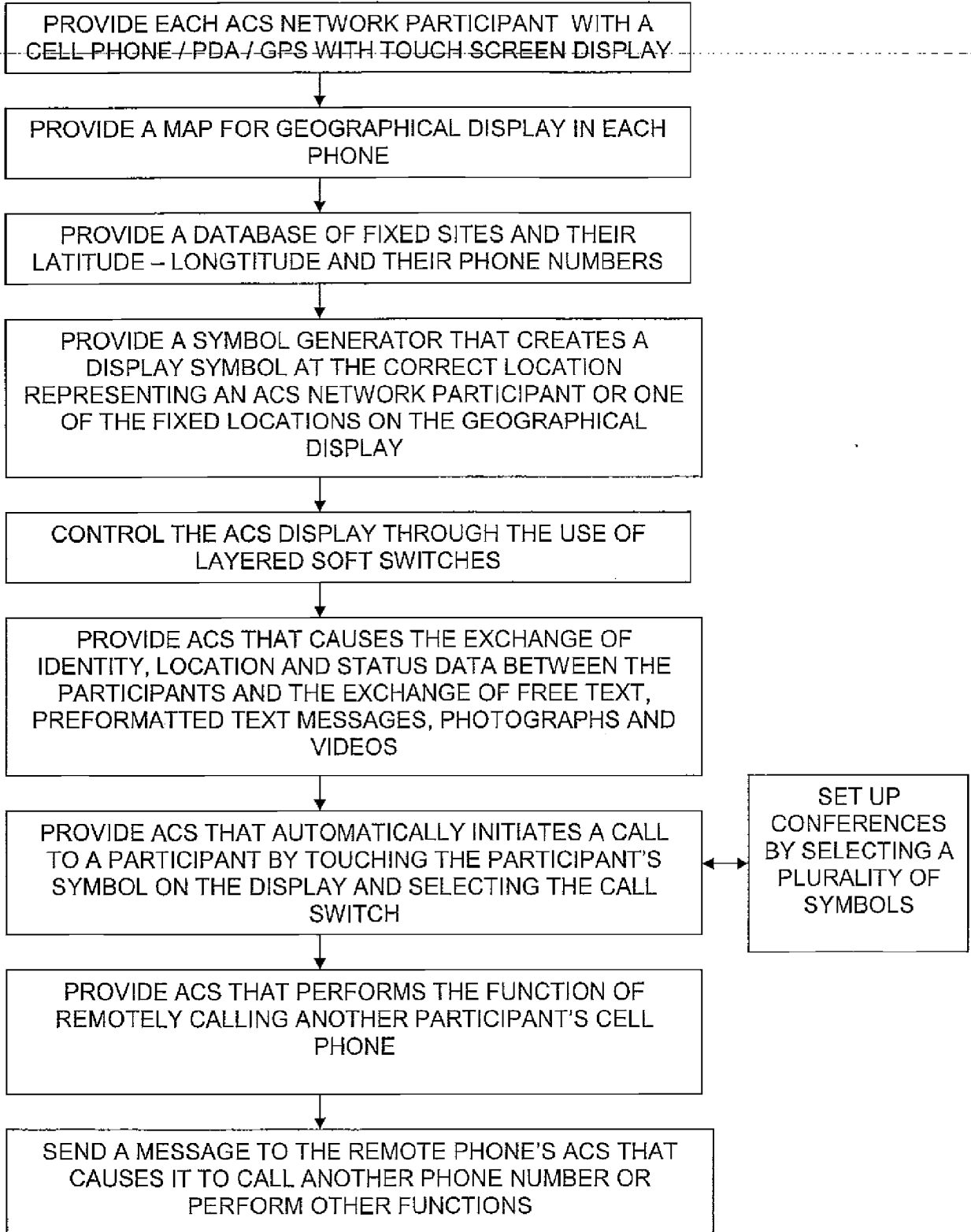


ABSTRACT OF THE DISCLOSURE

The system and method having a specialized software application on a personal computer or a PDA/cell phone that that enables a participant to force an automatic acknowledgement and a manual response to a text or voice message from other participants within the same network. Each participant's PC or PDA/cell phone includes a force message alert software application program for both creating and processing these forced message alerts. The system and method enabled by the force message alert software application program provides the ability to (a) allow an operator to create and transmit a forced message alert from a sender PC or PDA/cell phone to one or more recipient PCs and PDA/cell phones within the communication network; (b) automatically transmit an acknowledgement of receipt to the sender PC or PDA cell phone upon the receipt of the forced message alert; (c) periodically resend the message to the recipient PCs and PDA/cell phones that have not sent an acknowledgement; (d) provide an indication of which recipient PCs and PDA/cell phones have acknowledged the forced message alert; (e) provide a manual response list on the display of the recipient PC and PDA/cell phone's display that can only be cleared by manually transmitting a response; and (f) provide an indication on the sender PC or PDA/cell phone of the status and content the manual responses



**Fig 1a**



***Fig 1b***

Fig. 2

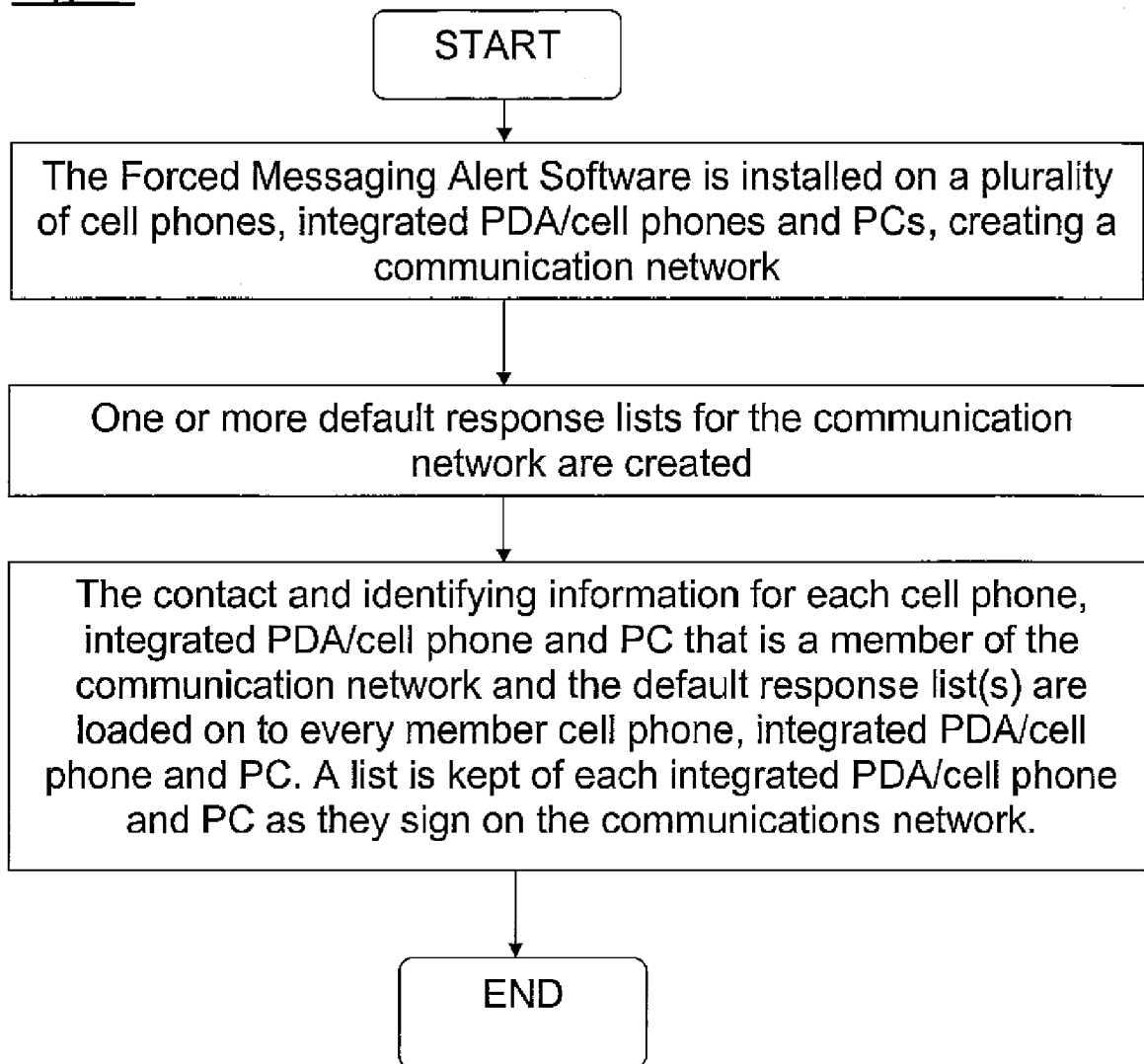


Fig. 3A

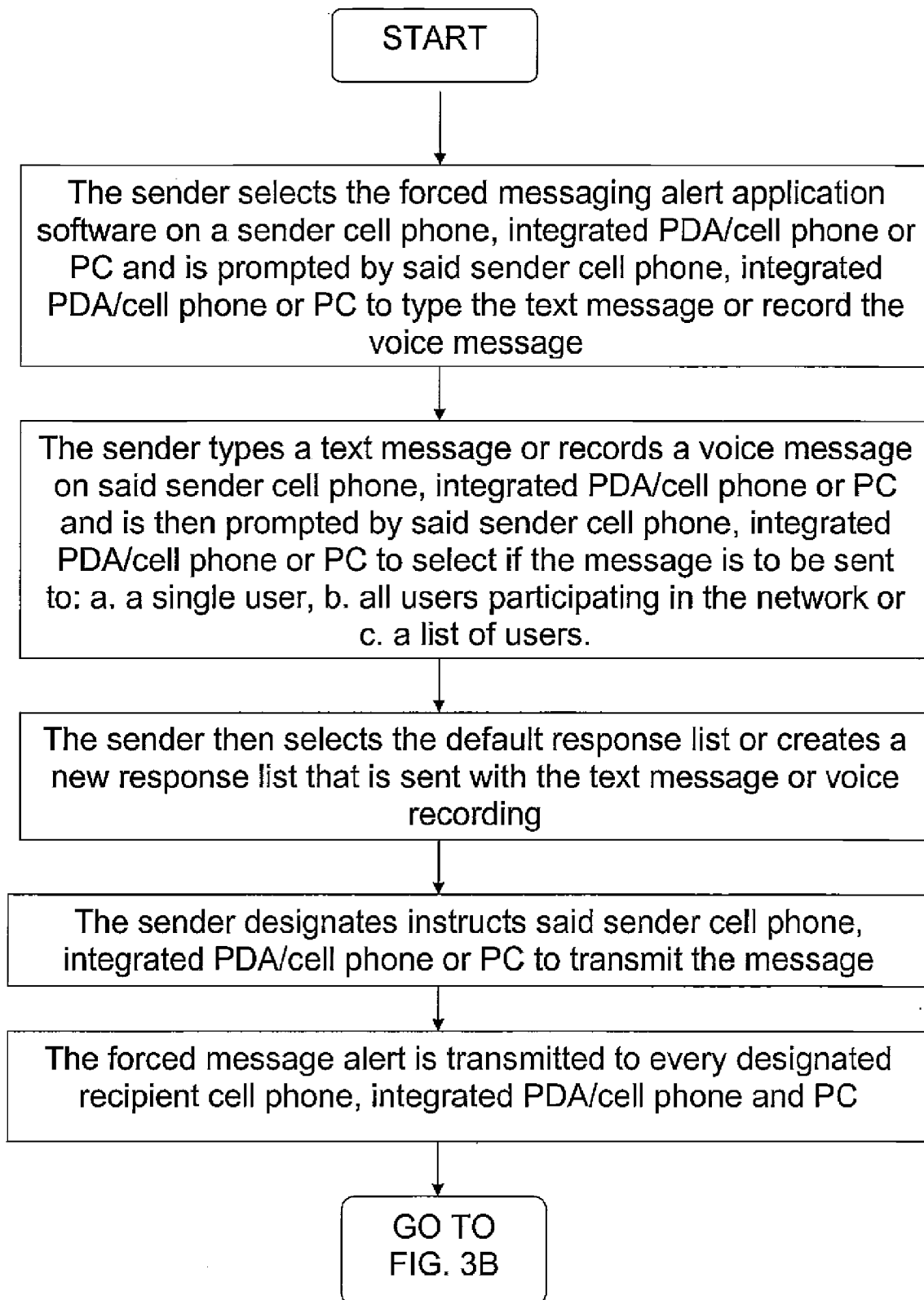


Fig. 3B

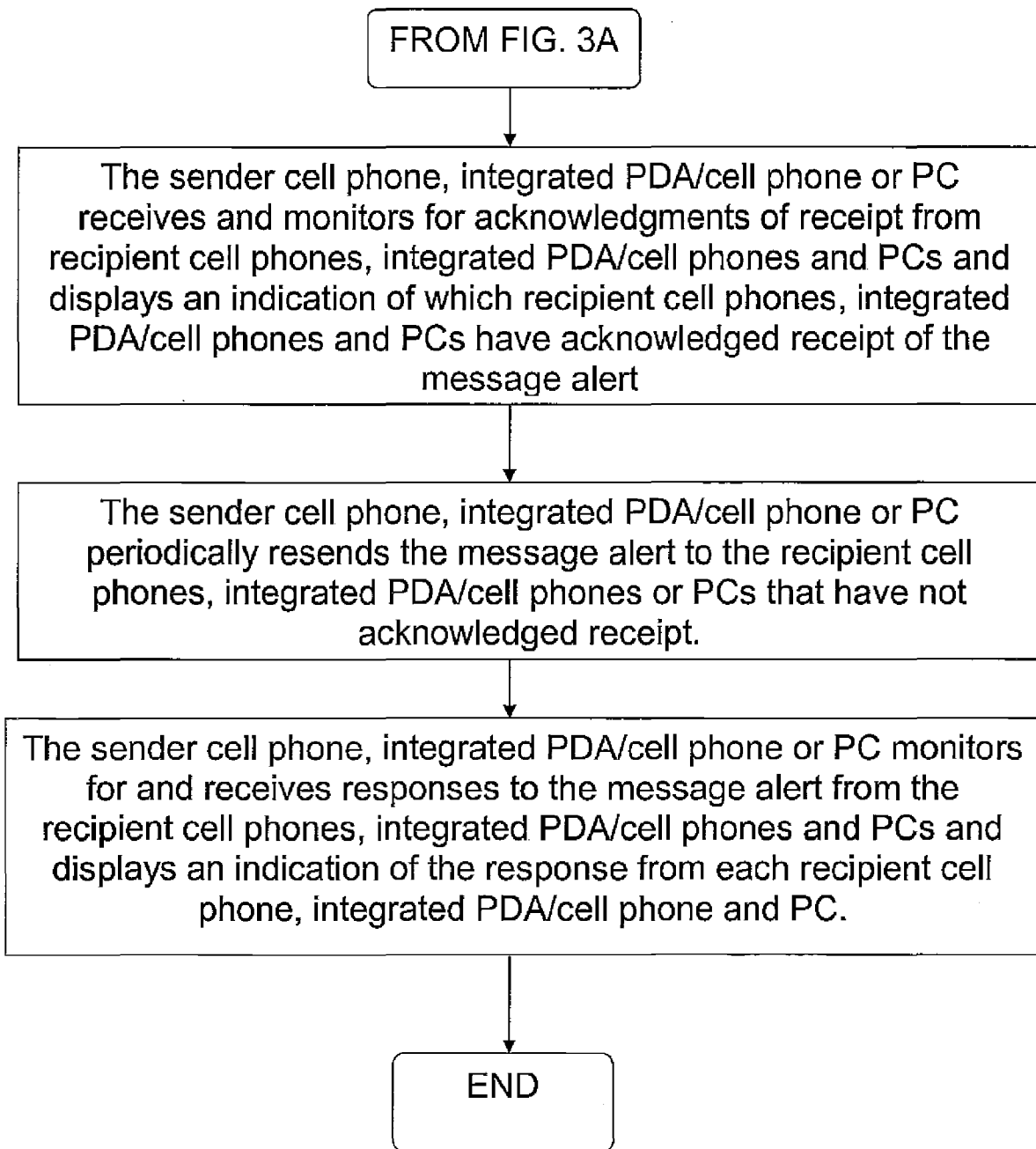
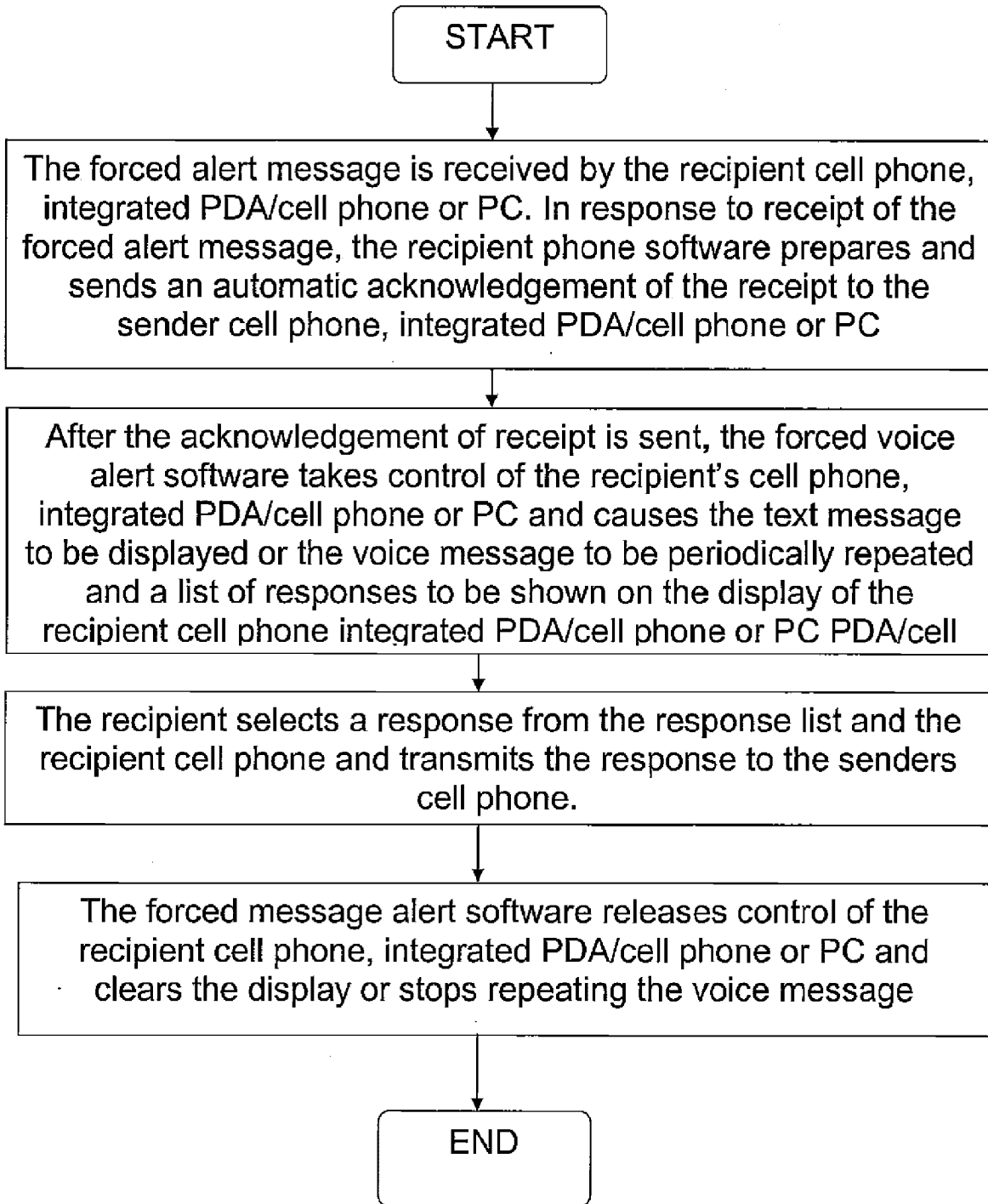


Fig. 4



**DECLARATION AND POWER OF ATTORNEY FOR PATENT APPLICATION**  
**(English Language Declaration)**

Our File No.: 10963.3819

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled: **METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS**, the specification of which (check one):

is attached hereto  
 was filed on \_\_\_\_\_ as Serial No. \_\_\_\_\_ and was amended on \_\_\_\_\_ (if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose to the Office all information known to me to be material to patentability, as defined in Title 37, Code of Federal Regulations §1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, Section 119 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

<u>Prior Foreign Application(s)</u>		<u>Priority Claimed</u>	
<u>Number</u>	<u>Country</u>	<u>Day/Month/Year</u>	<u>Yes No</u>

I hereby claim the benefit under Title 35, United States Code, Section 120, of any United States application(s) or PCT international application(s) designating the United States of America listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, Section 112, I acknowledge the duty to disclose to the Office all information known to me to be material to patentability as defined in Title 37, Code of Federal Regulations 1.56, which occurred between the filing date of the prior application and the national or PCT international filing date of this application:

<u>Serial No.</u>	<u>Filing Date</u>	<u>Status</u>
11/612,830	December 19, 2006	
11/308,648	April 17, 2006	Pending
10/711,490	September 21, 2004	Issued (U.S. Patent No. 7,031,728)

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.



**POWER OF ATTORNEY**

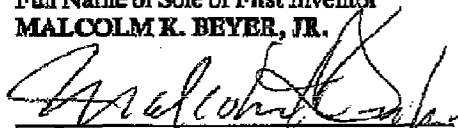
As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith along with any and all foreign applications filed and foreign patents issued therefrom.

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(954) 763-3303

Full Name of Sole or First Inventor MALCOLM K. BEYER, JR. Citizenship UNITED STATES OF AMERICA

  
Inventor's Signature

Sept 11, 2008  
Date

Residence  
Jupiter Inlet Colony, Florida

Post Office Address  
92 Lighthouse Drive  
Jupiter Inlet Colony, Florida 33469-3504

Full Name of Second Joint Inventor Citizenship

\_\_\_\_\_  
Second Inventor's Signature Date

Residence

Post Office Address

D:\10893\fm\3819\declaration

## Electronic Patent Application Fee Transmittal

<b>Application Number:</b>				
<b>Filing Date:</b>				
<b>Title of Invention:</b>	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS			
<b>First Named Inventor/Applicant Name:</b>	Malcom K. Beyer, Jr.			
<b>Filer:</b>	Barry Lee Haley			
<b>Attorney Docket Number:</b>	10963.3819			
Filed as Small Entity				
<b>Utility under 35 USC 111(a) Filing Fees</b>				
<b>Description</b>	<b>Fee Code</b>	<b>Quantity</b>	<b>Amount</b>	<b>Sub-Total in USD(\$)</b>
<b>Basic Filing:</b>				
Utility filing Fee (Electronic filing)	4011	1	82	82
Utility Search Fee	2111	1	270	270
Utility Examination Fee	2311	1	110	110
<b>Pages:</b>				
<b>Claims:</b>				
<b>Miscellaneous-Filing:</b>				
<b>Petition:</b>				
<b>Patent-Appeals-and-Interference:</b>				

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
<b>Post-Allowance-and-Post-Issuance:</b>				
<b>Extension-of-Time:</b>				
<b>Miscellaneous:</b>				
<b>Total in USD (\$)</b>				<b>462</b>

## Electronic Acknowledgement Receipt

<b>EFS ID:</b>	4362702
<b>Application Number:</b>	12324122
<b>International Application Number:</b>	
<b>Confirmation Number:</b>	9036
<b>Title of Invention:</b>	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS
<b>First Named Inventor/Applicant Name:</b>	Malcom K. Beyer, Jr.
<b>Customer Number:</b>	22235
<b>Filer:</b>	Barry Lee Haley
<b>Filer Authorized By:</b>	
<b>Attorney Docket Number:</b>	10963.3819
<b>Receipt Date:</b>	26-NOV-2008
<b>Filing Date:</b>	
<b>Time Stamp:</b>	15:16:33
<b>Application Type:</b>	Utility under 35 USC 111(a)

### Payment information:

Submitted with Payment	yes
Payment Type	Deposit Account
Payment was successfully received in RAM	\$462
RAM confirmation Number	2080
Deposit Account	131130
Authorized User	

The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows:

Charge any Additional Fees required under 37 C.F.R. Section 1.21 (Miscellaneous fees and charges)

<b>File Listing:</b>					
<b>Document Number</b>	<b>Document Description</b>	<b>File Name</b>	<b>File Size(Bytes)/ Message Digest</b>	<b>Multi Part /.zip</b>	<b>Pages (if appl.)</b>
1	Application Data Sheet	3819Ads.pdf	1685926 b27df136d29b2f60ba1bea36a6dba31fa7e4b541	no	4
<b>Warnings:</b>					
<b>Information:</b>					
2		3819application.pdf	866380 810f2429d9d42bb1d2ced1228c2d0bdfc7ca132	yes	33
	<b>Multipart Description/PDF files in .zip description</b>				
	<b>Document Description</b>		<b>Start</b>	<b>End</b>	
	Specification		1	18	
	Claims		19	24	
	Abstract		25	25	
	Drawings-only black and white line drawings		26	31	
	Oath or Declaration filed		32	33	
<b>Warnings:</b>					
<b>Information:</b>					
3	Fee Worksheet (PTO-06)	fee-info.pdf	33183 03dceb97e3360ef3a08a09a4506746fe7683d6f7	no	2
<b>Warnings:</b>					
<b>Information:</b>					
<b>Total Files Size (in bytes):</b>			2585489		

**This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.**

**New Applications Under 35 U.S.C. 111**

**If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.**

**National Stage of an International Application under 35 U.S.C. 371**

**If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.**

**New International Application Filed with the USPTO as a Receiving Office**

**If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.**

Filing Date: 11/26/08

Approved for use through 7/31/2006. OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>PATENT APPLICATION FEE DETERMINATION RECORD</b> Substitute for Form PTO-875	Application or Docket Number <b>12/324,122</b>
---	---

APPLICATION AS FILED – PART I			SMALL ENTITY		OR		OTHER THAN SMALL ENTITY	
(Column 1) (Column 2)								
FOR	NUMBER FILED	NUMBER EXTRA	RATE (\$)	FEE (\$)			RATE (\$)	FEE (\$)
BASIC FEE (37 CFR 1.16(a), (b), or (c))	N/A	N/A	N/A	82			N/A	
SEARCH FEE (37 CFR 1.16(k), (l), or (m))	N/A	N/A	N/A	270			N/A	
EXAMINATION FEE (37 CFR 1.16(o), (p), or (q))	N/A	N/A	N/A	110			N/A	
TOTAL CLAIMS (37 CFR 1.16(l))	14	minus 20 =	x\$26				x\$52	
INDEPENDENT CLAIMS (37 CFR 1.16(h))	3	minus 3 =	x\$110				x\$220	
APPLICATION SIZE FEE (37 CFR 1.16(s))	If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$270 (\$135 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR							
MULTIPLE DEPENDENT CLAIM PRESENT (37 CFR 1.16(j))			195				390	
			<b>TOTAL</b>	<b>462</b>			<b>TOTAL</b>	

\* If the difference in column 1 is less than zero, enter "0" in column 2.

APPLICATION AS AMENDED – PART II					SMALL ENTITY		OR		OTHER THAN SMALL ENTITY	
(Column 1) (Column 2) (Column 3)										
AMENDMENT A		CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE (\$)	ADDITIONAL FEE (\$)	RATE (\$)	ADDITIONAL FEE (\$)	
	Total (37 CFR 1.16(i))	*	Minus	**	=	X =		X =		
	Independent (37 CFR 1.16(h))	*	Minus	***	=	X =		X =		
	Application Size Fee (37 CFR 1.16(s))									
	FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))					N/A		N/A		
					<b>TOTAL</b>		<b>TOTAL</b>			
					ADD'T FEE		ADD'T FEE			

AMENDMENT B		CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE (\$)	ADDITIONAL FEE (\$)	RATE (\$)	ADDITIONAL FEE (\$)
	Total (37 CFR 1.16(i))	*	Minus	**	=	X =		X =	
	Independent (37 CFR 1.16(h))	*	Minus	***	=	X =		X =	
	Application Size Fee (37 CFR 1.16(s))								
	FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))					N/A		N/A	
					<b>TOTAL</b>		<b>TOTAL</b>		
					ADD'T FEE		ADD'T FEE		

\* If the entry in column 1 is less than the entry in column 2, write "0" in column 3.

\*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20".

\*\*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3".

The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.

This collection of information is required by 37 CFR 1.16. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



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Table with 7 columns: APPLICATION NUMBER, FILING or 371(c) DATE, GRP ART UNIT, FIL FEE REC'D, ATTY.DOCKET.NO, TOT CLAIMS, IND CLAIMS. Row 1: 12/324,122, 11/26/2008, 2617, 462, 10963.3819, 14, 3

CONFIRMATION NO. 9036

22235
MALIN HALEY AND DIMAGGIO, PA
1936 S ANDREWS AVENUE
FORT LAUDERDALE, FL 33316

FILING RECEIPT



Date Mailed: 12/10/2008

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections

Applicant(s)

Malcolm K. Beyer JR., Jupiter Inlet Colony, FL;

Power of Attorney:

Barry Haley--25339
Dale Di Maggio--31823
David Lhota--39275
Mark Bowen--39914

Domestic Priority data as claimed by applicant

This application is a CIP of 11/612,830 12/19/2006
which is a CIP of 11/308,648 04/17/2006
which is a CIP of 10/711,490 09/21/2004 PAT 7,031,728

Foreign Applications

If Required, Foreign Filing License Granted: 12/08/2008

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US 12/324,122

Projected Publication Date: 03/19/2009

Non-Publication Request: No

Early Publication Request: No

\*\* SMALL ENTITY \*\*



**Title**

METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS

**Preliminary Class**

455

**PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES**

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at <http://www.uspto.gov/web/offices/pac/doc/general/index.html>.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, <http://www.stopfakes.gov>. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

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page 2 of 3

set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

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**NOT GRANTED**

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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
12/324,122	11/26/2008	Malcolm K. Beyer JR.	10963.3819

CONFIRMATION NO. 9036

22235  
MALIN HALEY AND DIMAGGIO, PA  
1936 S ANDREWS AVENUE  
FORT LAUDERDALE, FL 33316

NOTICE



Date Mailed: 12/10/2008

NOTICE OF INFORMAL APPLICATION

This application is considered to be informal since it does not comply with the regulations for the reason(s) indicated below. The period within to correct the informalities noted below and avoid abandonment is set in the accompanying Office action.

**Items Required To Avoid Processing Delays:**

The item(s) indicated below are also required and should be submitted with any reply to this notice to avoid further processing delays.

- Early Pre-grant Publication has been requested, however the early Pre-GRANT Publication Fee of \$300 as required by 37 CFR 1.18(d) has not been paid. The application will be published as per the normal publication schedule.

<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> ( Not for submission under 37 CFR 1.99)	Application Number	12324122
	Filing Date	2008-11-26
	First Named Inventor	Malcolm K. Beyer JR.
	Art Unit	
	Examiner Name	
	Attorney Docket Number	10963.3819

**U.S.PATENTS**

Examiner Initial*	Cite No	Patent Number	Kind Code <sup>1</sup>	Issue Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear
	1	7031728		2006-04-18	Beyer, Jr.	

If you wish to add additional U.S. Patent citation information please click the Add button.

**U.S.PATENT APPLICATION PUBLICATIONS**

Examiner Initial*	Cite No	Publication Number	Kind Code <sup>1</sup>	Publication Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear
	1	20080076410		2008-03-27	Beyer	
	2	20060199612		2006-09-07	Beyer, JR. et al.	

If you wish to add additional U.S. Published Application citation information please click the Add button.

**FOREIGN PATENT DOCUMENTS**

Examiner Initial*	Cite No	Foreign Document Number <sup>3</sup>	Country Code <sup>2</sup> j	Kind Code <sup>4</sup>	Publication Date	Name of Patentee or Applicant of cited Document	Pages,Columns,Lines where Relevant Passages or Relevant Figures Appear	T <sup>5</sup>
	1							<input type="checkbox"/>

If you wish to add additional Foreign Patent Document citation information please click the Add button

**NON-PATENT LITERATURE DOCUMENTS**

<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> ( Not for submission under 37 CFR 1.99)	Application Number		12324122
	Filing Date		2008-11-26
	First Named Inventor	Malcolm K. Beyer JR.	
	Art Unit		
	Examiner Name		
	Attorney Docket Number		10963.3819

Examiner Initials*	Cite No	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, pages(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>5</sup>
	1		<input type="checkbox"/>

If you wish to add additional non-patent literature document citation information please click the Add button

**EXAMINER SIGNATURE**

Examiner Signature		Date Considered	
--------------------	--	-----------------	--

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

<sup>1</sup> See Kind Codes of USPTO Patent Documents at [www.USPTO.GOV](http://www.USPTO.GOV) or MPEP 901.04. <sup>2</sup> Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>3</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>4</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>5</sup> Applicant is to place a check mark here if English language translation is attached.

<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> ( Not for submission under 37 CFR 1.99)	Application Number	12324122
	Filing Date	2008-11-26
	First Named Inventor	Malcolm K. Beyer JR.
	Art Unit	
	Examiner Name	
	Attorney Docket Number	10963.3819

**CERTIFICATION STATEMENT**

Please see 37 CFR 1.97 and 1.98 to make the appropriate selection(s):

That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(1).

**OR**

That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(2).

See attached certification statement.

Fee set forth in 37 CFR 1.17 (p) has been submitted herewith.

None

**SIGNATURE**

A signature of the applicant or representative is required in accordance with CFR 1.33, 10.18. Please see CFR 1.4(d) for the form of the signature.

Signature	/barry l haley/	Date (YYYY-MM-DD)	2009-02-19
Name/Print	Barry L. Haley	Registration Number	25,339

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

## Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
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6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

## Electronic Acknowledgement Receipt

<b>EFS ID:</b>	4820668
<b>Application Number:</b>	12324122
<b>International Application Number:</b>	
<b>Confirmation Number:</b>	9036
<b>Title of Invention:</b>	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS
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<b>Attorney Docket Number:</b>	10963.3819
<b>Receipt Date:</b>	19-FEB-2009
<b>Filing Date:</b>	26-NOV-2008
<b>Time Stamp:</b>	13:24:27
<b>Application Type:</b>	Utility under 35 USC 111(a)

### Payment information:

Submitted with Payment	no
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### File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Information Disclosure Statement (IDS) Filed (SB/08)	3819lds.pdf	863891 <small>a6fab4ae304cfdad4db53502e4153941577 c7fdb</small>	no	4

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Table with 4 columns: APPLICATION NUMBER (12/324,122), FILING OR 371(C) DATE (11/26/2008), FIRST NAMED APPLICANT (Malcolm K. Beyer JR.), ATTY. DOCKET NO./TITLE (10963.3819)

CONFIRMATION NO. 9036

PUBLICATION NOTICE

22235
MALIN HALEY AND DIMAGGIO, PA
1936 S ANDREWS AVENUE
FORT LAUDERDALE, FL 33316



Title:METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS

Publication No.US-2009-0075685-A1

Publication Date:03/19/2009

NOTICE OF PUBLICATION OF APPLICATION

The above-identified application will be electronically published as a patent application publication pursuant to 37 CFR 1.211, et seq. The patent application publication number and publication date are set forth above.

The publication may be accessed through the USPTO's publically available Searchable Databases via the Internet at www.uspto.gov. The direct link to access the publication is currently http://www.uspto.gov/patft/.

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In addition, information on the status of the application, including the mailing date of Office actions and the dates of receipt of correspondence filed in the Office, may also be accessed via the Internet through the Patent Electronic Business Center at www.uspto.gov using the public side of the Patent Application Information and Retrieval (PAIR) system. The direct link to access this status information is currently http://pair.uspto.gov/. Prior to publication, such status information is confidential and may only be obtained by applicant using the private side of PAIR.

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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
12/324,122 11/26/2008 Malcolm K. Beyer JR. 10963,3819 9036

22235 7590 09/20/2010
MALIN HALEY DIMAGGIO BOWEN & LHOTA, P.A.
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EXAMINER
LEBASSI, AMANUEL

ART UNIT 2617
PAPER NUMBER

NOTIFICATION DATE 09/20/2010
DELIVERY MODE ELECTRONIC

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

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. 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 –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1, 4 and 6 are rejected under 35 U.S.C. 102(e) as being unpatentable by Keating et al. US 20040082352.

Regarding claim 1, Keating discloses A communication system for transmitting, receiving, confirming receipt, and responding to an electronic message (**see abstract - selecting a group of mobile stations to participate in the wireless group call and causing an invitation message to be transmitted to the group of mobile stations**). Keating discloses a predetermined network of participants, wherein each participant has a similarly equipped PC or PDA/cell phone that includes a CPU and a touch screen display a CPU and memory (**paragraph [0016] where participants are mobile stations such as 16a and 16b and so on**). Keating discloses a data transmission means that facilitates the transmission of electronic files between said PCs and said PDA/cell phones in different locations (**paragraph [0020] where wireless data controller controls transmission of data therefore a data transmission means that facilitates the transmission of electronic files**). Keating discloses a sender PC or PDA/cell phone and at least one recipient PC or

PDA/cell phone for each electronic message (**paragraph [0022] where a group call originator, or leader, initiates set-up of a group call through his or her mobile station y choosing or selecting a group call participant list therefore a sender PC or PDA/cell phone and at least one recipient PC or PDA).**

Keating discloses a forced message alert software application program loaded on each participating PC or PDA/cell phone (**paragraph [0025] where an alert message is queued in the mobile stations therefore a message alert software application program).**

Regarding claim 4, Keating discloses wherein said data transmission means is TCP/IP or another communications protocol (paragraph [0020] - **Internet Protocol (IP)).**

Regarding claim 6, Keating discloses wherein the response list that is transmitted Within the forced message alert software packet is a custom response list that is created at the time the specific forced message alert is created on the sender PC or PDA/cell phone (**see Fig. 2).**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 2, 3, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keating et al. US 20040082352 in view of Esler et al. US 20050241026.

Regarding claim 2, the combination of above discloses wherein the forced message alert software application program on the sender PC or PDA/cell phone :means for attaching a forced message alert software packet to a voice or text message creating a forced message alert that is transmitted by said sender PC or PDA/cell phone to the recipient PC or PDA/cell phone, wherein said forced message alert software packet contains a response list and requires the forced message alert software on said recipient PC or PDA/cell phone to transmit an automatic acknowledgment to the sender PC or PDA/cell phone as soon as said forced message alert is received by the recipient PC or PDA/cell phone; means for receiving and displaying a listing of which recipient PCs or PDA/cell phones have automatically acknowledged the forced message alert and which recipient PCs or PDA/cell phones have not automatically acknowledged the

forced message alert; means for periodically resending said forced message alert to said recipient PCs or PDA/cell phones that have not automatically acknowledged the forced message alert; and means for receiving and displaying a listing of which recipient PCs or PDA/cell phones have transmitted a manual response to said forced message alert and details the response from each recipient PC or PDA/cell phone that responded (see above).

Regarding claim 3, Keating modified by Esler discloses wherein the forced message alert software application program on the recipient PC or PDA/cell phone: means for transmitting the acknowledgment of receipt to said sender PC or PDA/cell phone immediately upon receiving a forced message alert from the sender PC or PDA/cell phone (**paragraph [0027] where Keating discloses where a message is sent to inform the mobile stations that the group call is set to begin**). Keating modified by Esler discloses means for controlling of the recipient PC or PDA/cell phone upon transmitting said automatic acknowledgment and causes, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PC or PDA/cell phone or causes, in cases where the force message alert is a voice message, the voice message to be periodically repeated by the speakers of the recipient PC or PDA/cell phone while said response list is shown on the display (**paragraph [0027] where the message is displayed on the participating mobile phones**). Keating modified by Esler discloses means for



allowing a manual response to be manually selected from the response list or manually recorded and transmits said manual response to the sender PC or PDA/cell phone (**paragraph [0027]**) and means for clearing the text message and a response list from the display of the recipient PC or PDA/cell phone or stops the repeating voice message and clears the response list from the display of the recipient PC or PDA/cell phone once the manual response is transmitted (**paragraph [0028] where the message is cleared**).

Regarding claim 5, Keating modified by Esler discloses wherein the response list that is transmitted within the forced message alert software packet is a default response list that is embedded in the forced message alert software application program (**paragraph [0027]**).

3. Claim 7-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keating et al. US 20040082352 in view of Dalton et al. US 20040192365.

Regarding claim 7, Keating discloses a method of sending a forced message alert to one or more recipient PCs or PDA/cell phones within a predetermined communication network, wherein the receipt and response to said forced message alert by each intended recipient PC or PDA/cell phone is tracked, said method comprising the steps of: accessing a forced message alert software application program on a sender PC or PDA/cell phone (**paragraph**

**[0025] where an alert message is queued in the mobile stations therefore a forced message alert software application program ).** Keating discloses creating the forced message alert on said sender PC or PDA/cell phone by attaching a voice or text message to a forced message alert application software packet to said voice or text message (**paragraph [0022]**). Keating discloses designating one or more recipient PCs or PDA/cell phones in the communication network (**paragraph [0022] where a group call originator, or leader, initiates set-up of a group call through his or her mobile station y choosing or selecting a group call participant list**). Keating discloses electronically transmitting the forced message alert to said recipient PCs or PDA/cell phones (**paragraph [0022]**). Keating discloses receiving automatic acknowledgements from the recipient PCs or PDA/cell phones that received the message and displaying a listing of which recipient PCs or PDA/cell phones have acknowledged receipt of the forced message alert and which recipient PCs or PDA/cell phones have not acknowledged receipt of the forced message alert (**see Fig. 2 - steps 42 and 43 where acknowledgements are received from the recipient mobile phones**). Keating discloses periodically resending the forced message alert to the recipient PCs or PDA/cell phones that have not acknowledged receipt (**see Fig. 2**). Keating discloses receiving responses to the forced message alert from the recipient PCs or PDA/cell phones and displaying the response from each recipient PC or PDA/cell phone and clearing

the receiver's display screen or causing the repeating voice alert to cease upon selecting a response (**paragraph [0028] where the message is cleared**).

Keating is silent responses to the forced message alert from the recipient PCs or PDA/cell phones and displaying the response from each recipient PC or PDA/cell phone and clearing the receiver's display screen or causing the repeating voice alert to cease upon selecting a response. However, Dalton teaches responses to the forced message alert from the recipient PCs or PDA/cell phones and displaying the response from each recipient PC or PDA/cell phone and clearing the receiver's display screen or causing the repeating voice alert to cease upon selecting a response (**paragraph [0014] where each active mobile device responds to the predetermined message and performs a specific function related to the predetermined message**).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify the invention of Keating with that of Dalton, thereby **integrating plurality of mobile devices as taught by Dalton (paragraph [0001])**.

Regarding claim 8, Keating discloses herein each PC or PDA]cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it (**paragraph [0016] where participants are mobile stations such as 16a and 16b and so on which are similarly equipped**).

Regarding claim 9, Keating modified by Dalton discloses wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program (**paragraph [0027]**).

Regarding claim 10, Keating discloses wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PC or PDA/cell phone (**paragraph [0027]**).

Regarding claim 11, Keating discloses a method of receiving, acknowledging and responding to a forced message alert from a sender PC or PDA/cell phone to a recipient PC or PDA/cell phone, wherein the receipt, acknowledgment, and response to said forced message alert is forced by a forced message alert software application program (**paragraph [0027] where Keating discloses where a message is sent to inform the mobile stations that the group call is set to begin**), said method comprising the steps of: receiving an electronically transmitted electronic message (**Fig. 2 step 34 where message is received after being transmitted**). Keating discloses identifying said electronic message as a forced message alert, wherein said forced message alert consists of a voice or text message and a forced message alert

application software packet, which triggers the activation of the forced message alert software application program within the recipient PC or PDA/cell phone (abstract where **an invitation message to be transmitted to the group of mobile stations**). Keating discloses transmitting an automatic acknowledgment of receipt to the sender PC or PDA/cell phone, which triggers the forced message alert software application program to take control of the recipient PC or PDA/cell phone and show the content of the text message and a response list on the display recipient PC or PDA/cell phone or to repeat audibly the content of the voice message on the speakers of the recipient PC or PDA/cell phone and show the response list on the display recipient PC or PDA/cell phone (**see Fig. 2 - steps 42 and 43 where acknowledgements are received from the recipient mobile phones**) and transmitting a selected response, whether said selected response is a chosen option from the response list, causing the forced message alert software to release control of tile recipient PC or PDA/cell phone and stop showing the content of the text message and a response list on the display recipient PC or PDA/cel1 phone and or stop repeating the content of the voice message on the speakers of the recipient PC or PDA/cell phone (**paragraph [0028] where a message is responded**). Keating discloses displaying the response received from the PC or PDA cell phone that transmitted the response on the sender of the forced alert PC or PDA/cell phone (**see Fig. 2 step 36 where list of responsive participants is displayed upon request**) and providing a list of the recipient PC or PDA/cell phones have automatically

acknowledged receipt of a forced alert message (**see Fig. 2 step 43 where group members allow communication therefore automatically acknowledged receipt of a forced alert message**).

Keating is silent their response to the forced alert message. . However, Dalton teaches responses to the forced message alert (**paragraph [0014] where each active mobile device responds to the predetermined message and performs a specific function related to the predetermined message**).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify the invention of Keating with that of Dalton, thereby **integrating plurality of mobile devices as taught by Dalton (paragraph [0001])**.

Regarding claim 12, Keating discloses wherein each PC or PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it (**paragraph [0016] where participants are mobile stations such as 16a and 16b and so on**).

Regarding claim 13, Keating discloses wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program

**(paragraph [0027] where the message is displayed on the participating mobile phones).**

Regarding claim 14, Keating discloses wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PC or PDA/cell phone **(see Fig. 2)**.

#### ***Conclusion***

1. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Amanuel Lebassi, whose telephone number is (571) 270-5303. The Examiner can normally be reached on Monday-Thursday from 8:00am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Nick Corsaro can be reached at (571) 272-7876. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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*Amanuel Lebassi*  
/A. L/  
09092010

/NICK CORSARO/  
Supervisory Patent Examiner, Art Unit 2617



<b>Notice of References Cited</b>	Application/Control No. 12/324,122	Applicant(s)/Patent Under Reexamination BEYER, MALCOLM K.	
	Examiner AMANUEL LEBASSI	Art Unit 2617	Page 1 of 1

**U.S. PATENT DOCUMENTS**

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A US-2004/0082352	04-2004	Keating et al.	455/519
*	B US-2005/0241026	10-2005	Esler et al.	D24/100
*	C US-2004/0192365	09-2004	Dalton et al.	455/517
	D US-			
	E US-			
	F US-			
	G US-			
	H US-			
	I US-			
	J US-			
	K US-			
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**FOREIGN PATENT DOCUMENTS**

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	N				
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**NON-PATENT DOCUMENTS**

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
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	U				
	V				
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Receipt date: 02/19/2009

12324122 - GAI: 2617

Doc code: IDS

Doc description: Information Disclosure Statement (IDS) Filed

Approved for use through 02/28/2009. OMB 0651-0031

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<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> ( Not for submission under 37 CFR 1.99)	Application Number	12324122
	Filing Date	2008-11-26
	First Named Inventor	Malcolm K. Beyer JR.
	Art Unit	
	Examiner Name	
	Attorney Docket Number	10963.3819

**U.S. PATENTS**

Examiner Initial*	Cite No	Patent Number	Kind Code <sup>1</sup>	Issue Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear
	1	7031728		2006-04-18	Beyer, Jr.	

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**U.S. PATENT APPLICATION PUBLICATIONS**

Examiner Initial*	Cite No	Publication Number	Kind Code <sup>1</sup>	Publication Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear
	1	20080076410		2008-03-27	Beyer	
	2	20060199612		2006-09-07	Beyer, JR. et al.	

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**FOREIGN PATENT DOCUMENTS**

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<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> ( Not for submission under 37 CFR 1.99)	Application Number		12324122	12324122 - GAU: 2617	
	Filing Date		2008-11-26		
	First Named Inventor	Malcolm K. Beyer JR.			
	Art Unit				
	Examiner Name				
	Attorney Docket Number		10963.3819		

Examiner Initials*	Cite No	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, pages(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>5</sup>
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Examiner Signature	/Amanuel Lebassi/	Date Considered	09/09/2010
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<sup>1</sup> See Kind Codes of USPTO Patent Documents at [www.USPTO.GOV](http://www.USPTO.GOV) or MPEP 901.04. <sup>2</sup> Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>3</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>4</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>5</sup> Applicant is to place a check mark here if English language translation is attached.

## EAST Search History

## EAST Search History (Prior Art)

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
L1	9425	(alert) with (participat \$3 ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit)))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	ON	2010/09/09 17:09
L2	9425	(message alert software) and L1	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	ON	2010/09/09 17:09
L3	9425	(message alert software) and L1	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	ON	2010/09/09 17:17
L4	1	(message alert software) and L1	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:17
L5	192	(message near2 software) and L1	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:17
L6	26	(alert software) and L1	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:17
L7	26	L6	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:18

L8	5	(alert) with (participat \$3 ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit)))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	NEAR	ON	2010/09/09 17:19
L9	1	(message near2 software) and L8	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:19
L10	5	(alert\$3) with (participat \$3 ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit)))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	NEAR	ON	2010/09/09 17:22
L11	0	(buzz\$3) with (participat \$3 ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit)))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	NEAR	ON	2010/09/09 17:22
L12	0	(message alert software) same mobiles	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:25
L13	1	(message alert software) with ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:26
L14	1	(message alert software) same((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:27

L15	1	(message alert software) and ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:27
L16	3756	(message near2 software) and ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:27
L17	659	(message near2 software) same((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:27
L18	0	(alrt software) same ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:27
L19	9	(alert software) same ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:28
L20	1	forced message alert software application	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:32
L21	1	message alert software application	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:32

L22	14	message alert application	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2010/09/09 17:33
S1	1	12/324,122	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2010/09/08 19:27
S2	12	(Malcolm near3 Beyer). in.	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2010/09/09 11:02
S3	2	11/612,830	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2010/09/09 11:03
S4	1	12/324,122	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2010/09/09 11:03
S5	1	S2 and forced alert	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2010/09/09 11:25
S6	5	S2 and alert	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2010/09/09 11:25
S7	9	("6204844" "6662016" "6868337" "20030139150" "20030200259" "20040192331" "20040204070" "20040266456" "20060031927").pn.	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	OFF	2010/09/09 11:32
S8	2	S7 and alert	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	OFF	2010/09/09 11:32


S9	1413	(alert) with (participat \$3 PDA)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	OFF	2010/09/09 12:03
S10	0	S9 same participants	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	OFF	2010/09/09 12:04
S11	55	S9 same participants	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	OFF	2010/09/09 12:04
S12	29	S9 with participants	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	ON	2010/09/09 12:04
S13	9425	(alert) with (participat \$3 ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit)))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	ON	2010/09/09 12:25
S14	75	S13 with participants	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	ON	2010/09/09 12:26
S15	9425	(alert) with (participat \$3 ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit)))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	ON	2010/09/09 14:55
S16	75	S15 with participants	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	ON	2010/09/09 14:55
S17	75	S16	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	ON	2010/09/09 14:55



S18	21	S17 and "455"/\$.cls.	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	ON	2010/09/09 14:55
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9/ 9/ 2010 6:38:49 PM


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<b>Index of Claims</b> 	<b>Application/Control No.</b> 12324122	<b>Applicant(s)/Patent Under Reexamination</b> BEYER, MALCOLM K.
	<b>Examiner</b> AMANUEL LEBASSI	<b>Art Unit</b> 2617

✓	<b>Rejected</b>	-	<b>Cancelled</b>	N	<b>Non-Elected</b>	A	<b>Appeal</b>
=	<b>Allowed</b>	÷	<b>Restricted</b>	I	<b>Interference</b>	O	<b>Objected</b>

Claims renumbered in the same order as presented by applicant
  CPA
  T.D.
  R.1.47

CLAIM		DATE									
Final	Original	09/09/2010									
	1	✓									
	2	✓									
	3	✓									
	4	✓									
	5	✓									
	6	✓									
	7	✓									
	8	✓									
	9	✓									
	10	✓									
	11	✓									
	12	✓									
	13	✓									
	14	✓									

<b>Search Notes</b>  	<b>Application/Control No.</b>  12324122	<b>Applicant(s)/Patent Under Reexamination</b>  BEYER, MALCOLM K.
	<b>Examiner</b>  AMANUEL LEBASSI	<b>Art Unit</b>  2617

<b>SEARCHED</b>			
<b>Class</b>	<b>Subclass</b>	<b>Date</b>	<b>Examiner</b>
455	41.1, 416, 518, 519	9/9/2010	AL

<b>SEARCH NOTES</b>		
<b>Search Notes</b>	<b>Date</b>	<b>Examiner</b>
Inventor Search	9/9/2010	AL

<b>INTERFERENCE SEARCH</b>			
<b>Class</b>	<b>Subclass</b>	<b>Date</b>	<b>Examiner</b>

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**BIB DATA SHEET**
**CONFIRMATION NO. 9036**

SERIAL NUMBER	FILING or 371(c) DATE	CLASS	GROUP ART UNIT	ATTORNEY DOCKET NO.	
12/324,122	11/26/2008	455	2617	10963.3819	
<b>RULE</b>					
<b>APPLICANTS</b> Malcolm K. Beyer JR., Jupiter Inlet Colony, FL;					
<b>** CONTINUING DATA *****</b> This application is a CIP of 11/612,830 12/19/2006 which is a CIP of 11/308,648 04/17/2006 PAT 7,630,724 which is a CIP of 10/711,490 09/21/2004 PAT 7,031,728					
<b>** FOREIGN APPLICATIONS *****</b>					
<b>** IF REQUIRED, FOREIGN FILING LICENSE GRANTED ** ** SMALL ENTITY **</b> 12/08/2008					
Foreign Priority claimed <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No		STATE OR COUNTRY	SHEETS DRAWINGS	TOTAL CLAIMS	INDEPENDENT CLAIMS
35 USC 119(a-d) conditions met <input type="checkbox"/> Yes <input type="checkbox"/> No					
Verified and /AMANUEL LEBASSI/ Acknowledged Examiner's Signature		FL	6	14	3
		Met after Allowance			
		Initials			
<b>ADDRESS</b> MALIN HALEY DIMAGGIO BOWEN & LHOTA, P.A. 1936 S ANDREWS AVENUE FORT LAUDERDALE, FL 33316 UNITED STATES					
<b>TITLE</b> METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS					
<b>FILING FEE RECEIVED</b> 462	FEES: Authority has been given in Paper No. _____ to charge/credit DEPOSIT ACCOUNT No. _____ for following:	<input type="checkbox"/> All Fees			
		<input type="checkbox"/> 1.16 Fees (Filing)			
		<input type="checkbox"/> 1.17 Fees (Processing Ext. of time)			
		<input type="checkbox"/> 1.18 Fees (Issue)			
		<input type="checkbox"/> Other _____			
		<input type="checkbox"/> Credit _____			

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Malcolm K. Beyer, Jr.	)	
	)	
Serial No.: 12/324,122	)	Confirmation No: 9036
	)	
Filed: November 26, 2008	)	Group Art Unit: 2617
	)	
Entitled: METHOD OF UTILIZING	)	Examiner: LEBASSI, Amanuel
FORCED ALERTS FOR	)	
INTERACTIVE REMOTE	)	
COMMUNICATIONS	)	
_____	)	

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

December 17, 2010  
*Filed Electronically*

**RESPONSE AND AMENDMENT**

Dear Sir:

In response to the Office Action dated September 20, 2010, please amend the above referenced patent application as follows and consider the remarks below. This Response is believed to be timely. However, in the event that any further extension of time is required, please consider this a request therefor. The Commissioner is authorized to charge any additional fees due or credit any overpayment to Deposit Account 13-1130.

Please amend the claims as shown on pages 2-7.

Remarks begin on page 8.

**CLAIM AMENDMENTS**

Please amend the claims (~~strike through~~ indicating deletion and underline indicating insertion) as follows:

1. (Cancelled)

2. (Currently Amended) A communication system for transmitting, receiving, confirming receipt, and responding to an electronic message, comprising:

a predetermined network of participants, wherein each participant has a similarly equipped PC or PDA/cell phone that includes a CPU and a touch screen display a CPU and memory;

a data transmission means that facilitates the transmission of electronic files between said PCs and said PDA/cell phones in different locations;

a sender PC or PDA/cell phone and at least one recipient PC or PDA/cell phone for each electronic message; and

a forced message alert software application program loaded on each participating PC or PDA/cell phone [.] ;

~~The system as in claim 1, wherein the forced message alert software application program on the sender PC or PDA/cell phone:~~

means for attaching a forced message alert software packet to a voice or text message creating a forced message alert that is transmitted by said sender PC or PDA/cell phone to the recipient PC or PDA/cell phone, ~~wherein~~ said forced message alert software packet ~~contains~~ containing a response list and ~~requires~~ requiring the forced message alert software on said recipient PC or PDA/cell phone to transmit an automatic acknowledgment to the sender PC or

PDA/cell phone as soon as said forced message alert is received by the recipient PC or PDA/cell phone;

means for receiving and displaying a listing of which recipient PCs or PDA/cell phones have automatically acknowledged the forced message ~~azlet~~ alert and which recipient PCs or PDA/cell phones have not automatically acknowledged the forced message alert;

means for periodically resending said forced message alert to said recipient PCs or PDA/cell phones that have not automatically acknowledged the forced message alert; and

means for receiving and displaying a listing of which recipient PCs or PDA/cell phones have transmitted a manual response to said forced message alert and details the response from each recipient PC or PDA/cell phone that responded.

3. (Currently Amended) The system as in claim 1 ~~2~~ 2 , wherein the forced message alert software application program on the recipient PC or PDA/cell phone includes:

means for transmitting the acknowledgment of receipt to said sender PC or PDA/cell phone immediately upon receiving a forced message alert from the sender PC or PDA/cell phone;

means for controlling of the recipient PC or PDA/cell phone upon transmitting said automatic acknowledgment and ~~causes~~ causing, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PC or PDA/cell phone or causes, in cases where the force message alert is a voice message, the voice message ~~to be~~ being periodically repeated by the speakers of the recipient PC or PDA/cell phone while said response list is shown on the display;

means for allowing a manual response to be manually selected from the response list or manually recorded and ~~transmits~~ transmitting said manual response to the sender PC or PDA/cell phone; and

means for clearing the text message and a response list from the display of the recipient PC or PDA/cell phone or ~~stops~~ stopping the repeating voice message and ~~clears~~ clearing the response list from the display of the recipient PC or PDA/cell phone once the manual response is transmitted.

4. (Currently Amended) The system as in claim ~~1~~ 2, wherein said data transmission means is TCP/IP or another communications protocol.

5. (Currently Amended) The system as in claim ~~1~~ 2, wherein the response list that is transmitted within the forced message alert software packet is a default response list that is embedded in the forced message alert software application program.

6. (Currently Amended) The system as in claim ~~1~~ 2, wherein the response list that is transmitted within the forced message alert software packet is a custom response list that is created at the time the specific forced message alert is created on the sender PC or PDA/cell phone.

7. (Currently Amended) A method of sending a forced message alert to one or more recipient PCs or PDA/cell phones within a predetermined communication network, wherein the receipt and response to said forced message alert by each intended recipient PC or PDA/cell phone is tracked, said method comprising the steps of:

accessing a forced message alert software application program on a sender PC or PDA/cell phone;



creating the forced message alert on said sender PC or PDA/cell phone by attaching a voice or text message to a forced message alert application software packet to said voice or text message;

designating one or more recipient PCs or PDA/cell phones in the communication network;

electronically transmitting the forced message alert to said recipient PCs or PDA/cell phones;

receiving automatic acknowledgements from the recipient PCs or PDA/cell phones that received the message and displaying a listing of which recipient PCs or PDA/cell phones have acknowledged receipt of the forced message alert and which recipient PCs or PDA/cell phones have not acknowledged receipt of the forced message alert;

periodically resending the forced message alert to the recipient PCs or PDA/cell phones that have not acknowledged receipt;

receiving responses to the forced message alert from the recipient PCs or PDA/cell phones and displaying the response from each recipient PC or PDA/cell phone; and

providing a manual response list on the display of the recipient PC or PDA/cell phone;

clearing the receiver's display screen or causing the repeating voice alert to cease upon selecting a response that can only be cleared by manually selecting and transmitting a response to the manual response list.

8. (Original) The method as in claim 7, wherein each PC or PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it.

9. (Original) The method as in claim 7, wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program.

10. (Original) The method as in claim 7, wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PC or PDA/cell phone.

11. (Currently Amended) A method of receiving, acknowledging and responding to a forced message alert from a sender PC or PDA/cell phone to a recipient PC or PDA/cell phone, wherein the receipt, acknowledgment, and response to said forced message alert is forced by a forced message alert software application program, said method comprising the steps of:

receiving an electronically transmitted electronic message;

identifying said electronic message as a forced message alert, wherein said forced message alert ~~consists~~ comprises of a voice or text message and a forced message alert application software packet, which triggers the activation of the forced message alert software application program within the recipient PC or PDA/cell phone;

transmitting an automatic acknowledgment of receipt to the sender PC or PDA/cell phone, which triggers the forced message alert software application program to take control of the recipient PC or PDA/cell phone and show the content of the text message and a response list on the display recipient PC or PDA/cell phone or to repeat audibly the content of the voice message on the speakers of the recipient PC or PDA/cell phone and show the response list on the display recipient PC or PDA/cell phone; and

transmitting a selected response, whether said selected response is a chosen option from the response list, causing the forced message alert software to release control of the recipient PC or PDA/cell phone and stop showing the content of the text message and a response list on the display recipient PC or PDA/cell phone and or stop repeating the content of the voice message on the speakers of the recipient PC or PDA/cell phone;

displaying the response received from the PC or PDA cell phone that transmitted the response on the sender of the forced alert PC or PDA/cell phone; and

providing a list of the recipient PC or PDA/cell phones have automatically acknowledged receipt of a forced alert message and their response to the forced alert message.

12. (Original) The method as in claim 11, wherein each PC or PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it.

13. (Original) The method as in claim 11, wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program.

14. (Original) The method as in claim 11, wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PC or PDA/cell phone

**REMARKS**

The Office Action mailed September 20, 2010 has been received and reviewed. By the present Response and Amendment, Claim 1 is canceled, Claims 2-7 and 11 have been amended and claims 2-14 remain. No new matter is introduced.

***Claim Rejections – 35 USC § 102***

The Examiner's rejection of Claims 1, 4 and 6 under 35 U.S.C. § 102(e) as being anticipated by Keating et al. (US 2004/0082352) is respectfully traversed. It is elementary patent law that to sustain a rejection based on anticipation, each and every element recited in the claims that are rejected must be present in the reference cited by the Examiner. Claim 1 has been canceled. Remaining claims 4 and 6 have been amended to depend from amended claim 2. The Keating *et al.* patent is very specific about being a system and method to develop accurate billing for Push To Talk (PTT) phones. The described technique sets up a group of mobile stations based on digital replies automatically received from the group of mobile stations. Applicant's invention is about sending commands to individuals using any communications means that require a manual response from the individual to whom the command was issued, in much the same manner that when a U.S. Marine issues a command and he demands a "Yes Sir" or "No Sir" response from the person to whom the command was issued. Additionally, there is no use of remote or automatically generated voice commands that demand a response being sent in Keating *et al.* The Keating *et al.* reference does not disclose a forced message alert software application program loaded on each participating PC or PDA/cell phone as required in amended independent claim 2 from which claims 4 and 6 depend. The system in the Keating *et al.* reference is completely different in purpose and methodology and in other words structure and

function. The purpose of the system in the Keating *et al.* reference is to enable accurate billing of multiple call participants in a wireless group. There is no discussion or suggestion in Keating *et al.* to provide a forced message alert which is described in Applicant's specification. The Examiner states in the rejection that "Keating *et al.* discloses a forced message alert software application program loaded on each participating PC in paragraph (0025)". A review of paragraph (0025) of the Keating *et al.* reference shows that the leader sends a message to a wireless data controller that requests a list of participants that have responded that want to participate in a group call. This is not the forced message alert as described in applicant's specification and recited in amended claim 2. In the Keating *et al.* reference if there is no response then the recipient is not added to the group. Applicant's forced message alert forces a recipient to respond with an appropriate predetermined response. Again, the whole purpose of the Keating *et al.* invention is to make sure that there is an accurate billing among the receipt members. See paragraph (0005) of Keating *et al.*; the Keating *et al.* reference does not anticipate amended claim 2 from which claims 4 and 6 depend and therefore claims 4 and 6 are allowable.

***Claim Rejections – 35 U.S.C. § 103***

The Examiner's rejection of Claims 2, 3 and 5 under 35 U.S.C. 103(a) as being unpatentable over Keating *et al.* (US 2004/0082352) in view of Esler *et al.* (US 2005/0241026) is respectfully traversed. As stated above, with respect to the Keating *et al.* reference, the structure, methodology, and purpose of the Keating *et al.* reference are completely different than those in Applicant's claimed invention. Applicant's Claim 2 has been amended to distinguish the forced message alert. Esler *et al.* shows a device and method for storing data message alerts on medical devices. The medical device can be interrogated with a programmer. The method in

Esler's patent is the reverse of Applicant's patent claims. In the Esler patent, the individuals automatically provide unsolicited data to a remote computer which periodically polls for health data. There is no command sent to the participant to manually respond. There is no voice command involved. The method may also include communicating the data message alert by the programmer in response to detecting the data message alert stored in a dedicated alert field of a medical device. It is difficult to understand how a person of ordinary skill in the art that deals with the communication network that has forced message alerts would even consider the combination of device and method disclosed in the Keating *et al.* reference in conjunction with the method disclosed in Esler *et al.* since the two methods and systems are completely different and offer no suggestion or motivation to arrive at Applicant's claimed invention. It is Applicant's position that even if one combined or attempted to combine the method and systems described in Keating *et al.* with the method and systems described in Esler *et al.*, one would not arrive at Applicant's claimed invention. Since the references even if combined do not provide a prima facie obviousness rejection of these claims, it is Applicant's position that these claims are allowable over the references cited by the examiner.

The Examiner's rejection of Claims 7 – 14 under 35 U.S.C. § 103(a) as being unpatentable over Keating *et al.* (US 2004/0082352) in view of Dalton *et al.* (US 2004/0192365) is respectfully traversed. Applicant hereby asserts the arguments made above as to why Keating *et al.* is not an appropriate reference with respect to Applicant's claimed invention and claims 7 through 14. Applicant's claim 7 has been amended to include the steps of providing a manual response list on the display of the recipient PC/PDA and providing that clearing of the receiver's display screen in order to get the alert to cease can only be cleared by manually selecting and transmitting a response to the manual response list. Additionally, there is no use of remote or

automatically generated voice commands that demand a response being sent in Dalton *et al.* The steps are not taught or suggested in the references when viewed together cited by the Examiner. Dalton *et al.* shows a communications system and method that includes a data concentrator computer and a gateway device that allows direct communication between first and second mobile data acquisition devices. Again, it is Applicant's position that even if the method and reference device shown in Keating *et al.* were somehow to be combined with the system and method shown in Dalton *et al.*, Applicant's claimed invention cannot result based on the amendments to claim 7. Therefore, the Examiner has failed to present a prima facie case of obviousness under 35 U.S.C. § 103 with respect to claim 7. Therefore, it is Applicant's position that claims 7-14 are allowable over the art of record.

Claim 1 is canceled. Claims 2 through 14 are believed allowable over the art record for the reasons stated above.

**CONCLUSION**

In view of the amendments submitted herein and the above comments, it is believed that all grounds of rejection are overcome and that the application has now been placed in full condition for allowance. Accordingly, Applicant earnestly solicits early and favorable action. Should there be any further questions or reservations, the Examiner is urged to telephone Applicant's undersigned attorney at (954) 763-3303.

Respectfully submitted,

s/ Barry L. Haley  
Barry L. Haley, Esq. (Reg. No. 25,339)

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## Electronic Acknowledgement Receipt

<b>EFS ID:</b>	9059437
<b>Application Number:</b>	12324122
<b>International Application Number:</b>	
<b>Confirmation Number:</b>	9036
<b>Title of Invention:</b>	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS
<b>First Named Inventor/Applicant Name:</b>	Malcolm K. Beyer
<b>Customer Number:</b>	22235
<b>Filer:</b>	Barry Lee Haley/Amy Allen
<b>Filer Authorized By:</b>	Barry Lee Haley
<b>Attorney Docket Number:</b>	10963.3819
<b>Receipt Date:</b>	17-DEC-2010
<b>Filing Date:</b>	26-NOV-2008
<b>Time Stamp:</b>	11:08:29
<b>Application Type:</b>	Utility under 35 USC 111(a)

### Payment information:

Submitted with Payment	no
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### File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1		05_RespToOAMailed09-20-10.pdf	63928 0e8c749e22c36b948ecc0f3c8f173befe5004523	yes	12

<b>Multipart Description/PDF files in .zip description</b>		
<b>Document Description</b>	<b>Start</b>	<b>End</b>
Amendment/Req. Reconsideration-After Non-Final Reject	1	1
Claims	2	7
Applicant Arguments/Remarks Made in an Amendment	8	12
<b>Warnings:</b>		
<b>Information:</b>		
<b>Total Files Size (in bytes):</b>	63928	
<p><b>This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.</b></p> <p><b><u>New Applications Under 35 U.S.C. 111</u></b>  <b>If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.</b></p> <p><b><u>National Stage of an International Application under 35 U.S.C. 371</u></b>  <b>If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.</b></p> <p><b><u>New International Application Filed with the USPTO as a Receiving Office</u></b>  <b>If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.</b></p>		

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>PATENT APPLICATION FEE DETERMINATION RECORD</b> Substitute for Form PTO-875					Application or Docket Number <b>12/324,122</b>	Filing Date <b>11/26/2008</b>	<input type="checkbox"/> To be Mailed			
<b>APPLICATION AS FILED – PART I</b>					OTHER THAN					
(Column 1)		(Column 2)		SMALL ENTITY <input checked="" type="checkbox"/>	OR	SMALL ENTITY				
FOR	NUMBER FILED	NUMBER EXTRA		RATE (\$)	FEE (\$)	RATE (\$)	FEE (\$)			
<input type="checkbox"/> BASIC FEE <small>(37 CFR 1.16(a), (b), or (c))</small>	N/A	N/A		N/A		N/A				
<input type="checkbox"/> SEARCH FEE <small>(37 CFR 1.16(k), (l), or (m))</small>	N/A	N/A		N/A		N/A				
<input type="checkbox"/> EXAMINATION FEE <small>(37 CFR 1.16(o), (p), or (q))</small>	N/A	N/A		N/A		N/A				
TOTAL CLAIMS <small>(37 CFR 1.16(i))</small>	minus 20 =	*		X \$ =		OR	X \$ =			
INDEPENDENT CLAIMS <small>(37 CFR 1.16(h))</small>	minus 3 =	*		X \$ =		OR	X \$ =			
<input type="checkbox"/> APPLICATION SIZE FEE <small>(37 CFR 1.16(s))</small>	If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).									
<input type="checkbox"/> MULTIPLE DEPENDENT CLAIM PRESENT <small>(37 CFR 1.16(j))</small>										
* If the difference in column 1 is less than zero, enter "0" in column 2.				TOTAL		TOTAL				
<b>APPLICATION AS AMENDED – PART II</b>					OTHER THAN					
(Column 1)		(Column 2)		(Column 3)		SMALL ENTITY	OR	SMALL ENTITY		
AMENDMENT	<b>12/17/2010</b>	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE (\$)	ADDITIONAL FEE (\$)	RATE (\$)	ADDITIONAL FEE (\$)	
	Total <small>(37 CFR 1.16(j))</small>	* 13	Minus	** 20	= 0	X \$26 =	0	OR	X \$ =	
	Independent <small>(37 CFR 1.16(h))</small>	* 3	Minus	*** 3	= 0	X \$110 =	0	OR	X \$ =	
	<input type="checkbox"/> Application Size Fee <small>(37 CFR 1.16(s))</small>							OR		
	<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM <small>(37 CFR 1.16(j))</small>							OR		
						TOTAL ADD'L FEE	<b>0</b>	OR	TOTAL ADD'L FEE	
AMENDMENT		CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE (\$)	ADDITIONAL FEE (\$)	RATE (\$)	ADDITIONAL FEE (\$)	
	Total <small>(37 CFR 1.16(j))</small>	*	Minus	**	=	X \$ =		OR	X \$ =	
	Independent <small>(37 CFR 1.16(h))</small>	*	Minus	***	=	X \$ =		OR	X \$ =	
	<input type="checkbox"/> Application Size Fee <small>(37 CFR 1.16(s))</small>							OR		
	<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM <small>(37 CFR 1.16(j))</small>							OR		
						TOTAL ADD'L FEE		OR	TOTAL ADD'L FEE	
* If the entry in column 1 is less than the entry in column 2, write "0" in column 3.					Legal Instrument Examiner: /STANLEY JORDAN/					
** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20".										
*** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3".										
The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.										

This collection of information is required by 37 CFR 1.16. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: **Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.

22235 7590 03/11/2011
MALIN HALEY DIMAGGIO BOWEN & LHOTA, P.A.
1936 S ANDREWS AVENUE
FORT LAUDERDALE, FL 33316

EXAMINER
LEBASSI, AMANUEL

ART UNIT PAPER NUMBER
2617

NOTIFICATION DATE DELIVERY MODE
03/11/2011 ELECTRONIC

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.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

info@mhdpatents.com

<b>Office Action Summary</b>	<b>Application No.</b> 12/324,122	<b>Applicant(s)</b> BEYER, MALCOLM K.	
	<b>Examiner</b> AMANUEL LEBASSI	<b>Art Unit</b> 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 17 December 2010.
- 2a)  This action is **FINAL**.
- 2b)  This action is non-final.
- 3)  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.

**Disposition of Claims**

- 4)  Claim(s) 2-14 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 2-14 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on 26 November 2008 is/are: a)  accepted or b)  objected to by the Examiner.
  - Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
  - Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    - a)  All    b)  Some \*    c)  None of:
      - 1.  Certified copies of the priority documents have been received.
      - 2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
      - 3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5)  Notice of Informal Patent Application
- 6)  Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments with respect to claims 2-14 have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 2-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keating et al. US 20040082352 in view of Maggenti et al. US 20020061762.

Regarding claim 2, Keating discloses a communication system for transmitting, receiving, confirming receipt, and responding to an electronic message (**see abstract - selecting a group of mobile stations to participate in the wireless group call and causing an invitation message to be transmitted to the group of mobile stations**). Keating discloses a predetermined network of participants, wherein each participant has a similarly equipped PC or PDA/cell phone that includes a CPU and a touch screen display a CPU and memory (**paragraph [0016] where participants are mobile stations such as 16a and 16b and so on**). Keating disclose a data transmission means that facilitates the transmission of electronic files between said PCs and said

PDA/cell phones in different locations (**paragraph [0020] where wireless data controller controls transmission of data therefore a data transmission means that facilitates the transmission of electronic files**). Keating discloses a sender PC or PDA/cell phone and at least one recipient PC or PDA/cell phone for each electronic message (**paragraph [0022] where a group call originator, or leader, initiates set-up of a group call through his or her mobile station y choosing or selecting a group call participant list therefore a sender PC or PDA/cell phone and at least one recipient PC or PDA**).

Keating discloses a forced message alert software application program loaded on each participating PC or PDA/cell phone (**paragraph [0025] where an alert message is queued in the mobile stations therefore a message alert software application program**). Keating discloses an alert message but is silent on disclosing means for attaching a forced message alert software packet to a voice or text message creating a forced message alert that is transmitted by said sender PC or PDA/cell phone to the recipient PC or PDA/cell phone, wherein said forced message alert software packet contains containing a response list and requires requiring the forced message alert software on said recipient PC or PDA/cell phone to transmit an automatic acknowledgment to the sender PC or PDA/cell phone as soon as said forced message alert is received by the recipient PC or PDA/cell phone; means for receiving and displaying a listing of which recipient PCs or PDA/cell phones have automatically acknowledged the forced message ~ alert and which recipient PCs or PDA/cell

phones have not automatically acknowledged the forced message alert; means for periodically resending said forced message alert to said recipient PCs or PDA/cell phones that have not automatically acknowledged the forced message alert; and means for receiving and displaying a listing of which recipient PCs or PDA/cell phones have transmitted a manual response to said forced message alert and details the response from each recipient PC or PDA/cell phone that responded.

Maggenti teaches means for attaching a forced message alert software packet to a voice or text message creating a forced message alert that is transmitted by said sender PC or PDA/cell phone to the recipient PC or PDA/cell phone, wherein said forced message alert software packet contains containing a response list and requires requiring the forced message alert software on said recipient PC or PDA/cell phone to transmit an automatic acknowledgment to the sender PC or PDA/cell phone as soon as said forced message alert is received by the recipient PC or PDA/cell phone (**paragraph [0120] and [0129] where an alert message is transmitted and upon receiving the request where the communication device acknowledges the response**). Maggenti teaches means for receiving and displaying a listing of which recipient PCs or PDA/cell phones have automatically acknowledged the forced message alert and which recipient PCs or PDA/cell phones have not automatically acknowledged the forced message alert (**paragraph [0141] where communication devices confirm the invitation by sending acknowledgements therefore list of**



**recipients have or not automatically acknowledged the forced message alert).** Maggenti teaches means for periodically resending said forced message alert to said recipient PCs or PDA/cell phones that have not automatically acknowledged the forced message alert (**paragraph [0129] where the alert is resend therefore periodically resending said forced message alert to said recipient**) and means for receiving and displaying a listing of which recipient PCs or PDA/cell phones have transmitted a manual response to said forced message alert and details the response from each recipient PC or PDA/cell phone that responded (**paragraph [0153] where server responds by resending the lost message response**).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify the invention of Keating with that of Maggenti, thereby determining participants in a net within a group communication network as taught by Maggenti (**paragraph [0004]**).

Regarding claim 3, Maggenti teaches wherein the forced message alert software application program on the recipient PC or PDA/cell phone includes: means for transmitting the acknowledgment of receipt to said sender PC or PDA/cell phone immediately upon receiving a forced message alert from the sender PC or PDA/cell phone (**paragraph [0120] and [0129]**). Maggenti teaches means for controlling of the recipient PC or PDA/cell phone upon transmitting

said automatic acknowledgment and causing, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PC or PDA/cell phone or causes, in cases where the force message alert is a voice message, the voice message being periodically repeated by the speakers of the recipient PC or PDA/cell phone while said response list is shown on the display (**paragraph [0141]**) and means for allowing a manual response to be manually selected from the response list or manually recorded and transmitting said manual response to the sender PC or PDA/cell phone and means for clearing the text message and a response list from the display of the recipient PC or PDA/cell phone or stopping the repeating voice message and clearing the response list from the display of the recipient PC or PDA/cell phone once the manual response is transmitted (**paragraph [0153]**).

Regarding claim 4, Keating discloses wherein said data transmission means is TCP/IP or another communications protocol (paragraph [0020] - **Internet Protocol (IP)**).

Regarding claim 5, Keating discloses wherein the response list that is transmitted within the forced message alert software packet is a default response list that is embedded in the forced message alert software application program (**paragraph [0027]**).

Regarding claim 6, Keating discloses wherein the response list that is transmitted within the forced message alert software packet is a custom response list that is created at the time the specific forced message alert is created on the sender PC or PDA/cell phone (**see Fig. 2**).

Regarding claim 7, Keating discloses A method of sending a forced message alert to one or more recipient PCs or PDA/cell phones within a predetermined communication network, wherein the receipt and response to said forced message alert by each intended recipient PC or PDA/cell phone is tracked, said method comprising the steps of: accessing a forced message alert software application program on a sender PC or PDA/cell phone **paragraph [0025] where an alert message is queued in the mobile stations therefore a forced message alert software application program** ). Keating discloses creating the forced message alert on said sender PC or PDA/cell phone by attaching a voice or text message to a forced message alert application software packet to said voice or text message (**paragraph [0022]**). Keating discloses designating one or more recipient PCs or PDA/cell phones in the communication network (**paragraph [0022] where a group call originator, or leader, initiates set-up of a group call through his or her mobile station y choosing or selecting a group call participant list**). Keating discloses electronically transmitting the forced message alert to said recipient PCs or PDA/cell phones (**paragraph [0022]**). Keating discloses receiving automatic acknowledgements

from the recipient PCs or PDA/cell phones that received the message and displaying a listing of which recipient PCs or PDA/cell phones have acknowledged receipt of the forced message alert and which recipient PCs or PDA/cell phones have not acknowledged receipt of the forced message alert **(see Fig. 2 - steps 42 and 43 where acknowledgements are received from the recipient mobile phones)**. Keating discloses periodically resending the forced message alert to the recipient PCs or PDA/cell phones that have not acknowledged receipt **(see Fig. 2)**. Keating discloses receiving responses to the forced message alert from the recipient PCs or PDA/cell phones and displaying the response from each recipient PC or PDA/cell phone and clearing the receiver's display screen or causing the repeating voice alert to cease upon selecting a response that can only be cleared by manually selecting and transmitting a response to the manual response list **(paragraph [0028] where the message is cleared)**.

Keating is silent providing a manual response list on the display of the recipient PC or PDA/cell phone. Maggenti teaches providing a manual response list on the display of the recipient PC or PDA/cell phone **(paragraph [0011]** where the communication device sends a response to the message within a predetermined time period).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify the invention of Keating with that of Maggenti,

thereby determining participants in a net within a group communication network as taught by Maggenti (**paragraph [0004]**).

Regarding claim 8, Keating discloses wherein each PC or PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it (**paragraph [0016] where participants are mobile stations such as 16a and 16b and so on which are similarly equipped**).

Regarding claim 9, Keating discloses wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program (**paragraph [0027]**).

Regarding claim 10, Keating discloses wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PC or PDA/cell phone (**paragraph [0027]**).

3. Claim 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keating et al. US 20040082352 in view of Dalton et al. US 20040192365.

Regarding claim 11, Keating discloses a method of receiving, acknowledging and responding to a forced message alert from a sender PC or PDA/cell phone to a recipient PC or PDA/cell phone, wherein the receipt, acknowledgment, and response to said forced message alert is forced by a forced message alert software application program (**paragraph [0027] where Keating discloses where a message is sent to inform the mobile stations that the group call is set to begin**), said method comprising the steps of: receiving an electronically transmitted electronic message (**Fig. 2 step 34 where message is received after being transmitted**). Keating discloses identifying said electronic message as a forced message alert, wherein said forced message alert comprises of a voice or text message and a forced message alert application software packet, which triggers the activation of the forced message alert software application program within the recipient PC or PDA/cell phone (abstract where **an invitation message to be transmitted to the group of mobile stations**). Keating discloses transmitting an automatic acknowledgment of receipt to the sender PC or PDA/cell phone, which triggers the forced message alert software application program to take control of the recipient PC or PDA/cell phone and show the content of the text message and a response list on the display recipient PC or PDA/cell phone or to repeat audibly the content of the

voice message on the speakers of the recipient PC or PDA/cell phone and show the response list on the display recipient PC or PDA/cell phone (**see Fig. 2 - steps 42 and 43 where acknowledgements are received from the recipient mobile phones**) and transmitting a selected response, whether said selected response is a chosen option from the response list, causing the forced message alert software to release control of the recipient PC or PDA/cell phone and stop showing the content of the text message and a response list on the display recipient PC or PDA/cell phone and or stop repeating the content of the voice message on the speakers of the recipient PC or PDA/cell phone (**paragraph [0028] where a message is responded**). Keating discloses displaying the response received from the PC or PDA cell phone that transmitted the response on the sender of the forced alert PC or PDA/cell phone (**see Fig. 2 step 36 where list of responsive participants is displayed upon request**) and providing a list of the recipient PC or PDA/cell phones have automatically acknowledged receipt of a forced alert message (**see Fig. 2 step 43 where group members allow communication therefore automatically acknowledged receipt of a forced alert message**).

Keating is silent their response to the forced alert message. . However, Dalton teaches responses to the forced message alert (**paragraph [0014] where each active mobile device responds to the predetermined message and performs a specific function related to the predetermined message**).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify the invention of Keating with that of Dalton, thereby integrating plurality of mobile devices as taught by Dalton (**paragraph [0001]**).

Regarding claim 12, Keating discloses wherein each PC or PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it (**paragraph [0016] where participants are mobile stations such as 16a and 16b and so on**).

Regarding claim 13, Keating discloses wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program (**paragraph [0027] where the message is displayed on the participating mobile phones**).

Regarding claim 14, Keating discloses wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PC or PDA/cell phone(**see Fig. 2**).



**Conclusion**

1. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Amanuel Lebassi, whose telephone number is (571) 270-5303. The Examiner can normally be reached on Monday-Thursday from 8:00am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Nick Corsaro can be reached at (571) 272-7876. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

*Amanuel Lebassi*  
/A. L./  
3/01/2011

/HUY PHAN/  
Primary Examiner, Art Unit 2617

<b>Notice of References Cited</b>	Application/Control No. 12/324,122	Applicant(s)/Patent Under Reexamination BEYER, MALCOLM K.	
	Examiner AMANUEL LEBASSI	Art Unit 2617	Page 1 of 1

**U.S. PATENT DOCUMENTS**

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A US-2004/0082352	04-2004	Keating et al.	455/519
*	B US-2002/0061762	05-2002	Maggenti et al.	455/519
*	C US-2004/0192365	09-2004	Dalton et al.	455/517
	D US-			
	E US-			
	F US-			
	G US-			
	H US-			
	I US-			
	J US-			
	K US-			
	L US-			
	M US-			

**FOREIGN PATENT DOCUMENTS**

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N				
	O				
	P				
	Q				
	R				
	S				
	T				

**NON-PATENT DOCUMENTS**

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)				
	U				
	V				
	W				
	X				

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

<b>Index of Claims</b>  <b>*1232412</b>  <b>2*</b>	<b>Application/Control No.</b>  12324122	<b>Applicant(s)/Patent Under Reexamination</b>  BEYER, MALCOLM K.
	<b>Examiner</b>  AMANUEL LEBASSI	<b>Art Unit</b>  2617

✓	<b>Rejected</b>	-	<b>Cancelled</b>	N	<b>Non-Elected</b>	A	<b>Appeal</b>
=	<b>Allowed</b>	÷	<b>Restricted</b>	I	<b>Interference</b>	O	<b>Objected</b>

Claims renumbered in the same order as presented by applicant
  CPA
  T.D.
  R.1.47

CLAIM		DATE								
Final	Original	09/09/2010	02/23/2011							
	1	✓	-							
	2	✓	✓							
	3	✓	✓							
	4	✓	✓							
	5	✓	✓							
	6	✓	✓							
	7	✓	✓							
	8	✓	✓							
	9	✓	✓							
	10	✓	✓							
	11	✓	✓							
	12	✓	✓							
	13	✓	✓							
	14	✓	✓							

<b>Search Notes</b>  <b>*1232412</b>  <b>2*</b>	<b>Application/Control No.</b>  12324122	<b>Applicant(s)/Patent Under Reexamination</b>  BEYER, MALCOLM K.
	<b>Examiner</b>  AMANUEL LEBASSI	<b>Art Unit</b>  2617

<b>SEARCHED</b>			
<b>Class</b>	<b>Subclass</b>	<b>Date</b>	<b>Examiner</b>
455	41.1, 416, 518, 519	9/9/2010	AL

<b>SEARCH NOTES</b>		
<b>Search Notes</b>	<b>Date</b>	<b>Examiner</b>
Inventor Search	9/9/2010	AL

<b>INTERFERENCE SEARCH</b>			
<b>Class</b>	<b>Subclass</b>	<b>Date</b>	<b>Examiner</b>

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## EAST Search History

## EAST Search History (Prior Art)

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
S49	1	"20040082352".pn.	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/02 14:42
S50	1	(forced near3 (message alert software))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/02 16:28
S51	71	(forced near3 ( alert ))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/02 16:28
S52	1496	(alert) with (participat \$3 PDA)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	OFF	2011/02/02 16:29
S53	2	S51 and S52	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/02 16:29
S54	7748	(alert) with (participat \$3 ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit)))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	OFF	2011/02/02 16:32
S55	7340	(alert) with (((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit)))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	OFF	2011/02/02 16:32

S56	7748	(alert) with (participat\$3 (((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit))))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	OFF	2011/02/02 16:33
S57	20	S51 and S56	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/02 16:33
S58	3	S57 and (ACK or Acknowledge)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/02 16:34
S59	18128	(alert\$4) same (participat\$3 ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit))))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	OFF	2011/02/02 16:35
S60	2480	S59 and (ACK or Acknowledge)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/02 16:35
S61	5	S59 and automatic (ACK or Acknowledge)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/02 16:36
S62	5	S59 and (automatic (ACK or Acknowledge))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/02 16:36
S63	7	(forced near3 (alert \$4)) same (participat\$3 (((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit))))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	OR	OFF	2011/02/02 16:37

S65	1	(automatic\$5 acknowledg\$3 receipt) and (forced alert message)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/02 17:35
S66	1	(automatic\$5 acknowledg\$3) and (forced alert message)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/02 17:35
S67	1	(automatic\$5 acknowledg\$3) and (forced alert )	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/02 17:35
S68	1	(automatic\$5 near2 acknowledg\$3) and (forced alert )	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/02 17:35
S69	1	(automatic\$5 near2 acknowledg\$3 ) and (forced near2 alert )	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/02 17:39
S70	1	(automatic\$5 near2 acknowledg\$3 ) and (forced near2 alert\$4 )	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/02 17:39
S71	324	(automatic\$5 near2 acknowledg\$3 ) and (alert\$4 )	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/02 17:39
S72	48	S71 and S59	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/02 17:40
S73	46	S72 and S60	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/02 17:40

S74	20	"455"/\$.ocls. and S73	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/02 18:04
S75	1	12/324,122	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 14:37
S76	1704	(alert near2 message) with (voice or text)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 15:04
S77	3	(alert) with (participat \$3 ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit)))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/08 15:04
S78	24	(alert) with (participat \$3 near4 ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit)))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/08 15:05
S79	76	(alert\$3) same (participat\$3 near4 ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit)))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/08 15:05
S80	5	S76 and S78	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/08 15:05
S81	21	S76 and S79	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/08 15:05



S82	2	((@prad < "20040921") or (@rlad < "20040921") or (@ad< "20040921")) and S81	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 15:20
S83	22	((@prad < "20040921") or (@rlad < "20040921") or (@ad< "20040921")) and S79	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 15:58
S84	151	(alert near2 message) with (acknowledge or ACK)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 16:20
S85	0	S84 and (participat\$3 near4 ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit)))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/08 16:21
S86	100	S84 and ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	ON	2011/02/08 16:22
S87	78	((@prad < "20040921") or (@rlad < "20040921") or (@ad< "20040921")) and S86	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 16:22
S88	24	"455"/\$.ccls. and S87	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 16:23
S89	10	periodic\$4 with (resend \$3 or re-send\$3 or retransmit\$4) with alert	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 17:00
S90	2	S84 and S89	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 17:00

S91	0	S89 same (ACK or acknowledge)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 17:01
S92	2	S89 and (ACK or acknowledge)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 17:01
S93	79	periodic\$4 same (resend\$3 or re-send\$3 or retransmit\$4) same alert\$3	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 17:02
S94	12	S93 same (ACK or acknowledge)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 17:02
S95	10	((@prad < "20040921") or (@rlad < "20040921") or (@ad< "20040921")) and S94	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 17:02
S96	647	(periodic\$4 same (resend\$3 or re-send\$3 or retransmit\$4)) and alert\$3	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 17:04
S97	229	S96 and (ACK or acknowledge)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 17:04
S98	168	((@prad < "20040921") or (@rlad < "20040921") or (@ad< "20040921")) and S97	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 17:04
S99	40	"455"/\$.cls. and S98	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/08 17:05

S100	1	"20020061762".pn. and (respon\$4 with participant\$3)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2011/02/23 16:22
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: BEYER, JR., Malcolm K.	)	
	)	
Serial No.: 12/324,122	)	
	)	Confirmation No: 9036
Filed: November 26, 2008	)	
	)	Group Art Unit: 2617
Entitled: METHOD OF UTILIZING	)	
FORCED ALERTS FOR	)	Examiner: LEBASSI, Amanuel
INTERACTIVE REMOTE	)	
COMMUNICATIONS	)	
_____	)	

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

September 9, 2011  
*Filed Electronically*

**RESPONSE AND AMENDMENT**

Dear Sir:

In response to the Office Action dated March 11, 2011, please amend the above referenced patent application as follows and consider the remarks below. This Response is filed within six months of the mailing date of the Office Action; therefore, a petition for a three-month extension of time is submitted herewith. In the event that any further extension of time is required, please consider this a request therefor. The Commissioner is authorized to charge any additional fees due or credit any overpayment to Deposit Account 13-1130.

Please amend the claims as shown on pages 2-7.

Remarks begin on page 8.

### CLAIM AMENDMENTS

Please amend the claims (~~strike through~~ indicating deletion and underline indicating insertion) as follows:

1. (Cancelled)

2. (Currently amended) A communication system for transmitting, receiving, confirming receipt, and responding to an electronic message, comprising:

a predetermined network of participants, wherein each participant has a similarly equipped PC or PDA/cell phone that includes a CPU and a touch screen display a CPU and memory;

a data transmission means that facilitates the transmission of electronic files between said PCs and said PDA/cell phones in different locations;

a sender PC or PDA/cell phone and at least one recipient PC or PDA/cell phone for each electronic message;

a forced message alert software application program including a list of required possible responses to be selected by a participant recipient of a forced message response loaded on each participating PC or PDA/cell phone;

means for attaching a forced message alert software packet to a voice or text message creating a forced message alert that is transmitted by said sender PC or PDA/cell phone to the recipient PC or PDA/cell phone, said forced message alert software packet containing a list of possible required responses ~~response list~~ and requiring the forced message alert software on said recipient PC or PDA/cell phone to transmit an automatic acknowledgment to the sender PC or PDA/cell phone as soon as said forced message alert is received by the recipient PC or PDA/cell phone;

means for requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display;

means for receiving and displaying a listing of which recipient PCs or PDA/cell phones have automatically acknowledged the forced message alert and which recipient PCs or PDA/cell phones have not automatically acknowledged the forced message alert;

means for periodically resending said forced message alert to said recipient PCs or PDA/cell phones that have not automatically acknowledged the forced message alert; and

means for receiving and displaying a listing of which recipient PCs or PDA/cell phones have transmitted a manual response to said forced message alert and details the response from each recipient PC or PDA/cell phone that responded.

3. (Currently amended) The system as in claim 2, wherein the forced message alert software application program on the recipient PC or PDA/cell phone includes:

means for transmitting the acknowledgment of receipt to said sender PC or PDA/cell phone immediately upon receiving a forced message alert from the sender PC or PDA/cell phone;

means for controlling of the recipient PC or PDA/cell phone upon transmitting said automatic acknowledgment and causing, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient PC or PDA/cell phone or causes, in cases where the ~~force~~ forced message alert is a voice message, the voice message being periodically repeated by the speakers of the recipient PC or PDA/cell phone while said response list is shown on the display;

means for allowing a manual response to be manually selected from the response list or manually recorded and transmitting said manual response to the sender PC or PDA/cell phone; and

means for clearing the text message and a response list from the display of the recipient PC or PDA/cell phone or stopping the repeating voice message and clearing the response list from the display of the recipient PC or PDA/cell phone once the manual response is transmitted.

4. (Previously presented) The system as in claim 2, wherein said data transmission means is TCP/IP or another communications protocol.

5. (Previously presented) The system as in claim 2, wherein the response list that is transmitted within the forced message alert software packet is a default response list that is embedded in the forced message alert software application program.

6. (Previously presented) The system as in claim 2, wherein the response list that is transmitted within the forced message alert software packet is a custom response list that is created at the time the specific forced message alert is created on the sender PC or PDA/cell phone.

7. (Currently amended) A method of sending a forced message alert to one or more recipient PCs or PDA/cell phones within a predetermined communication network, wherein the receipt and response to said forced message alert by each intended recipient PC or PDA/cell phone is tracked, said method comprising the steps of:

accessing a forced message alert software application program on a sender PC or PDA/cell phone;

creating the forced message alert on said sender PC or PDA/cell phone by attaching a voice or text message to a forced message alert application software packet to said voice or text message;

designating one or more recipient PCs or PDA/cell phones in the communication network;

electronically transmitting the forced message alert to said recipient PCs or PDA/cell phones;

receiving automatic acknowledgements from the recipient PCs or PDA/cell phones that received the message and displaying a listing of which recipient PCs or PDA/cell phones have acknowledged receipt of the forced message alert and which recipient PCs or PDA/cell phones have not acknowledged receipt of the forced message alert;

periodically resending the forced message alert to the recipient PCs or PDA/cell phones that have not acknowledged receipt;

receiving responses to the forced message alert from the recipient PCs or PDA/cell phones and displaying the response from each recipient PC or PDA/cell phone; and

providing a manual response list on the display of the recipient PC or PDA/cell phone that can only be cleared by the recipient providing a required response from the list;

clearing the ~~receiver's~~ recipient's display screen or causing the repeating voice alert to cease upon recipient selecting a response from the response list required that can only be cleared by manually selecting and transmitting a response to the manual response list.

8. (Original) The method as in claim 7, wherein each PC or PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it.



9. (Original) The method as in claim 7, wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program.

10. (Original) The method as in claim 7, wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PC or PDA/cell phone.

11. (Currently amended) A method of receiving, acknowledging and responding to a forced message alert from a sender PC or PDA/cell phone to a recipient PC or PDA/cell phone, wherein the receipt, acknowledgment, and response to said forced message alert is forced by a forced message alert software application program, said method comprising the steps of:

receiving an electronically transmitted electronic message;

identifying said electronic message as a forced message alert, wherein said forced message alert comprises of a voice or text message and a forced message alert application software packet, which triggers the activation of the forced message alert software application program within the recipient PC or PDA/cell phone;

transmitting an automatic acknowledgment of receipt to the sender PC or PDA/cell phone, which triggers the forced message alert software application program to take control of the recipient PC or PDA/cell phone and show the content of the text message and a required response list on the display recipient PC or PDA/cell phone or to repeat audibly the content of the voice message on the speakers of the recipient PC or PDA/cell phone and show the required response list on the display recipient PC or PDA/cell phone; and

transmitting a selected required response from the response list in order to allow the message required response list to be cleared from the recipient's cell phone display, whether said selected response is a chosen option from the response list, causing the forced message alert software to release control of the recipient PC or PDA/cell phone and stop showing the content of the text message and a response list on the display recipient PC or PDA/cell phone and or stop repeating the content of the voice message on the speakers of the recipient PC or PDA/cell phone;

displaying the response received from the PC or PDA cell phone that transmitted the response on the sender of the forced alert PC or PDA/cell phone; and

providing a list of the recipient PC or PDA/cell phones have automatically acknowledged receipt of a forced alert message and their response to the forced alert message.

12. (Original) The method as in claim 11, wherein each PC or PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it.

13. (Original) The method as in claim 11, wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program.

14. (Original) The method as in claim 11, wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender PC or PDA/cell phone

**REMARKS**

The Office Action mailed March 11, 2011 has been received and reviewed. By the present Response and Amendment, Claims 2, 3, 7 and 11 have been amended. No new matter is introduced. Claim 1 has been cancelled previously.

***Claim Rejections – 35 U.S.C. § 103***

The Examiner's rejection of Claims 2-10 under U.S.C. § 103(a) as being unpatentable over Keating et al. (US 2004/0082352) in view of Maggenti et al. (US 2002/0061762) is respectfully traversed.

The Keating (US 2004/0082352) reference describes an enhanced group call implementation having nothing to do with Applicant's claimed invention providing a forced message alert and requiring a specific response from a recipient selected from the prepared list of responses prior to the recipients display being cleared of the message and required response.

Figures 2 and 4 of Keating show flowcharts delineating the essence of the communication system disclosed in Keating. The flowcharts are described in detail in paragraphs 0022 and 0031 of Keating. There is no discussion or disclosure that would suggest the system and method recited in amended Claims 2, 7 and 11 concerning the initiation of a required response from a recipient which is automatically transmitted by the recipient's device and the requirement in response to the forced message alert that the recipient must respond with a particular answer selected from previously provided list of potential answers especially before the recipient's display screen can be cleared. In fact, Keating is concerned with the accurate billing that reflects specific time spent by the mobile station participating in a group call. See paragraph 0030 Keating. The purpose and function of the group calling system in Keating is

completely different than Applicant's claimed system and methods recited in the amended Claims 2, 7 and 11. The statement of the Examiner that “Keating discloses a forced message alert software application program” Applicant respectfully submits is incorrect and has a stretched interpretation of what is actually disclosed in Keating.

The Maggenti et al. (US 2002/0061762) reference discloses a method for sending a message to a communication device to determine whether the communication device wishes to be a participant and then lists the communication device as a participant if there is a response to a message within a predetermined time. See paragraphs 0010 and 0011. There is no teaching or disclosure of Applicant’s claimed system and method in Maggenti et al.

The communication system recited in amended Claims 7 and 11 includes a forced message alert software system that requires a response from the recipient of a specific answer from a selected list before the recipient can clear the recipient’s display. This is completely different in function and structure than a system asking whether a participant wants to stay as a participant in the net.

It is Applicant's position – even if a person of ordinary skill in the art were to combine the Keating reference with the Maggenti et al. reference, Applicant's claimed invention as recited in the amended Claims 2 and 7 at issue could not possibly result because of the lack of relevant disclosure in the references when combined. Therefore, the Examiner has not established a *prima facie* case of obviousness under 35 U.S.C. § 103 with respect to Claims 2 - 10.

The Examiner's rejection of Claims 11 - 14 under 35 U.S.C. § 103(a) as being unpatentable over Keating et al. (US 2004/0082352) in view of Dalton et al. (US 2004/0192365) is respectfully traversed.

The Dalton (US 2004/0192365) communication system is a completely different system than Applicant's claimed communication system and method recited in Claims 11 - 14. A key element in Dalton is a data concentrator computer with a gateway device for communicating with the data concentrator computer so that the gateway device provides communications data between a first mobile data acquisition device and a second mobile data acquisition device without communication with the data concentrator computer. Paragraphs 0010, 0014 and 0015 in Dalton describe a system to manage two or more mobile devices forming a business data collection and to communicate asynchronously in the operational needs of a business application. None of the functions described in the Dalton reference have anything to do with providing a forced message alert as required in Claims 11 - 14 as amended. Applicant reiterates the comments above with respect to the Keating reference. Again, the combination of Keating and Dalton cannot result in Applicant's claimed invention because the references together fail to suggest Applicant's claimed invention. It is Applicant's position that the Examiner has failed to establish a *prima facie* case of obviousness with respect to Claims 11 - 14.

As an initial matter, the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. MPEP § 2143. A claim is obvious under 35 U.S.C. §103 if and only if the references relied on teach or suggest each and every element of the claimed invention, and it would be obvious to one skilled in the art to combine the references so relied on. A rationale to support a conclusion that a claim would have been obvious is that *all the claimed elements were known in the prior art* and one skilled in the art could have combined the

elements as claimed by known methods with no change in their respective known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 401 (2007); see also, *KSR International Co. v. Teleflex Inc.*, 550 U.S. at 415-417 (2007) citing *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152 (1950), *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63 (1969), and *Sakraida v. AG Pro., Inc.*, 425 U.S. 273, 282 (1976).

In determining the differences between the prior art and the claims, the question under 35 U.S.C. §103 is not whether the differences themselves would have been obvious, but whether the claimed invention *as a whole* would have been obvious. § MPEP 2141.02; *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). Additionally, an obviousness rejection cannot be based on a reference or combination of references that are non-analogous to the invention at issue. MPEP § 2141.01(a).

**CONCLUSION**

In view of the amendments submitted herein and the above comments, it is believed that all grounds of rejection are overcome and that the application has now been placed in full condition for allowance. Accordingly, Applicant earnestly solicits early and favorable action. Should there be any further questions or reservations, the Examiner is urged to telephone Applicant's undersigned attorney at (954) 763-3303.

Respectfully submitted,

/Barry L. Haley/  
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Under the paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(a)</b> <b>FY 2009</b> <i>(Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).)</i>		Docket Number (Optional) 10963.3819	
Application Number 12/324,122		Filed November 26, 2008	
For <b>METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS</b>			
Art Unit 2617		Examiner <b>LEBASSI, Amanuel</b>	
This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above identified application. The requested extension and fee are as follows (check time period desired and enter the appropriate fee below):			
		<u>Fee</u>	<u>Small Entity Fee</u>
<input type="checkbox"/>	One month (37 CFR 1.17(a)(1))	\$130	\$65      \$ _____
<input type="checkbox"/>	Two months (37 CFR 1.17(a)(2))	\$490	\$245      \$ _____
<input checked="" type="checkbox"/>	Three months (37 CFR 1.17(a)(3))	\$1110	\$555      \$ <u>555</u>
<input type="checkbox"/>	Four months (37 CFR 1.17(a)(4))	\$1730	\$865      \$ _____
<input type="checkbox"/>	Five months (37 CFR 1.17(a)(5))	\$2350	\$1175      \$ _____
<input checked="" type="checkbox"/>	Applicant claims small entity status. See 37 CFR 1.27.		
<input type="checkbox"/>	A check in the amount of the fee is enclosed.		
<input type="checkbox"/>	Payment by credit card. Form PTO-2038 is attached.		
<input type="checkbox"/>	The Director has already been authorized to charge fees in this application to a Deposit Account.		
<input checked="" type="checkbox"/>	The Director is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number <u>13-1130</u> .		
<b>WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</b>			
I am the	<input type="checkbox"/> applicant/inventor.		
	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed (Form PTO/SB/96).		
	<input checked="" type="checkbox"/> attorney or agent of record. Registration Number <u>25,339</u>		
	<input type="checkbox"/> attorney or agent under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		
	<u>/barry l. haley/</u>	<u>September 9, 2011</u>	
	Signature	Date	
	<u>Barry L. Haley</u>	<u>(954) 763-3303</u>	
	Typed or printed name	Telephone Number	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input type="checkbox"/>	Total of _____ forms are submitted.		

This collection of information is required by 37 CFR 1.136(a). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 6 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



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The information provided by you in this form will be subject to the following routine uses:

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3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

## Electronic Patent Application Fee Transmittal

<b>Application Number:</b>	12324122			
<b>Filing Date:</b>	26-Nov-2008			
<b>Title of Invention:</b>	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS			
<b>First Named Inventor/Applicant Name:</b>	Malcolm K. Beyer			
<b>Filer:</b>	Barry Lee Haley/Amy Allen			
<b>Attorney Docket Number:</b>	10963.3819			
Filed as Small Entity				
<b>Utility under 35 USC 111(a) Filing Fees</b>				
<b>Description</b>	<b>Fee Code</b>	<b>Quantity</b>	<b>Amount</b>	<b>Sub-Total in USD(\$)</b>
<b>Basic Filing:</b>				
<b>Pages:</b>				
<b>Claims:</b>				
<b>Miscellaneous-Filing:</b>				
<b>Petition:</b>				
<b>Patent-Appeals-and-Interference:</b>				
<b>Post-Allowance-and-Post-Issuance:</b>				
<b>Extension-of-Time:</b>				
Extension - 3 months with \$0 paid	2253	1	555	555

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
<b>Miscellaneous:</b>				
<b>Total in USD (\$)</b>				<b>555</b>

## Electronic Acknowledgement Receipt

<b>EFS ID:</b>	10916464
<b>Application Number:</b>	12324122
<b>International Application Number:</b>	
<b>Confirmation Number:</b>	9036
<b>Title of Invention:</b>	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS
<b>First Named Inventor/Applicant Name:</b>	Malcolm K. Beyer
<b>Customer Number:</b>	22235
<b>Filer:</b>	Barry Lee Haley/Amy Allen
<b>Filer Authorized By:</b>	Barry Lee Haley
<b>Attorney Docket Number:</b>	10963.3819
<b>Receipt Date:</b>	09-SEP-2011
<b>Filing Date:</b>	26-NOV-2008
<b>Time Stamp:</b>	16:11:18
<b>Application Type:</b>	Utility under 35 USC 111(a)

### Payment information:

Submitted with Payment	yes
Payment Type	Deposit Account
Payment was successfully received in RAM	\$555
RAM confirmation Number	3059
Deposit Account	131130
Authorized User	

The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows:

Charge any Additional Fees required under 37 C.F.R. Section 1.16 (National application filing, search, and examination fees)

Charge any Additional Fees required under 37 C.F.R. Section 1.21 (Miscellaneous fees and charges)

<b>File Listing:</b>					
<b>Document Number</b>	<b>Document Description</b>	<b>File Name</b>	<b>File Size(Bytes)/ Message Digest</b>	<b>Multi Part /.zip</b>	<b>Pages (if appl.)</b>
1		07_RespToOAMailed03-11-11.pdf	66770 094aaaf83fc85c934be3185de237ee43542bde01	yes	12
<b>Multipart Description/PDF files in .zip description</b>					
<b>Document Description</b>			<b>Start</b>	<b>End</b>	
Amendment/Req. Reconsideration-After Non-Final Reject			1	1	
Claims			2	7	
Applicant Arguments/Remarks Made in an Amendment			8	12	
<b>Warnings:</b>					
<b>Information:</b>					
2	Extension of Time	08_3MthEOT.pdf	316002 ab3e6dce7c00ee217aa08701dcd9c18780f603fe	no	2
<b>Warnings:</b>					
<b>Information:</b>					
3	Fee Worksheet (SB06)	fee-info.pdf	30328 f1a1fbc74475a0c036f5b840a28e02121d975995	no	2
<b>Warnings:</b>					
<b>Information:</b>					
<b>Total Files Size (in bytes):</b>			413100		
<p><b>This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.</b></p> <p><b><u>New Applications Under 35 U.S.C. 111</u></b>  <b>If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.</b></p> <p><b><u>National Stage of an International Application under 35 U.S.C. 371</u></b>  <b>If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.</b></p> <p><b><u>New International Application Filed with the USPTO as a Receiving Office</u></b>  <b>If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.</b></p>					

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>PATENT APPLICATION FEE DETERMINATION RECORD</b> Substitute for Form PTO-875				Application or Docket Number <b>12/324,122</b>		Filing Date <b>11/26/2008</b>		<input type="checkbox"/> To be Mailed			
<b>APPLICATION AS FILED – PART I</b>						<b>OTHER THAN</b>					
(Column 1)		(Column 2)		<b>SMALL ENTITY</b> <input checked="" type="checkbox"/>		OR		<b>SMALL ENTITY</b>			
FOR	NUMBER FILED	NUMBER EXTRA	RATE (\$)	FEE (\$)		RATE (\$)	FEE (\$)				
<input type="checkbox"/> BASIC FEE (37 CFR 1.16(a), (b), or (c))	N/A	N/A	N/A			N/A					
<input type="checkbox"/> SEARCH FEE (37 CFR 1.16(k), (j), or (m))	N/A	N/A	N/A			N/A					
<input type="checkbox"/> EXAMINATION FEE (37 CFR 1.16(o), (p), or (q))	N/A	N/A	N/A			N/A					
TOTAL CLAIMS (37 CFR 1.16(i))	minus 20 =	*	X \$ =		OR	X \$ =					
INDEPENDENT CLAIMS (37 CFR 1.16(h))	minus 3 =	*	X \$ =			X \$ =					
<input type="checkbox"/> APPLICATION SIZE FEE (37 CFR 1.16(s))	If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).										
<input type="checkbox"/> MULTIPLE DEPENDENT CLAIM PRESENT (37 CFR 1.16(j))											
* If the difference in column 1 is less than zero, enter "0" in column 2.			TOTAL			TOTAL					
<b>APPLICATION AS AMENDED – PART II</b>						<b>OTHER THAN</b>					
(Column 1)		(Column 2)		(Column 3)		<b>SMALL ENTITY</b>		OR		<b>SMALL ENTITY</b>	
<b>AMENDMENT</b>	<b>09/09/2011</b>	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE (\$)	ADDITIONAL FEE (\$)		RATE (\$)	ADDITIONAL FEE (\$)	
	Total (37 CFR 1.16(j))	* 12	Minus	** 20	= 0	X \$26 =	0	OR	X \$ =		
	Independent (37 CFR 1.16(h))	* 3	Minus	***3	= 0	X \$110 =	0	OR	X \$ =		
	<input type="checkbox"/> Application Size Fee (37 CFR 1.16(s))										
	<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))										
			TOTAL ADD'L FEE	<b>0</b>		TOTAL ADD'L FEE					
(Column 1)		(Column 2)		(Column 3)		<b>SMALL ENTITY</b>		OR		<b>SMALL ENTITY</b>	
<b>AMENDMENT</b>		CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE (\$)	ADDITIONAL FEE (\$)		RATE (\$)	ADDITIONAL FEE (\$)	
	Total (37 CFR 1.16(j))	*	Minus	**	=	X \$ =		OR	X \$ =		
	Independent (37 CFR 1.16(b))	*	Minus	***	=	X \$ =		OR	X \$ =		
	<input type="checkbox"/> Application Size Fee (37 CFR 1.16(s))										
	<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))										
			TOTAL ADD'L FEE			TOTAL ADD'L FEE					
* If the entry in column 1 is less than the entry in column 2, write "0" in column 3.						Legal Instrument Examiner: /KAREN VESTAL/					
** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20".											
*** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3".											
The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.											

This collection of information is required by 37 CFR 1.16. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.

22235 7590 10/07/2011
MALIN HALEY DIMAGGIO BOWEN & LHOTA, P.A.
1936 S ANDREWS AVENUE
FORT LAUDERDALE, FL 33316

EXAMINER
LEBASSI, AMANUEL

ART UNIT 2617
PAPER NUMBER

NOTIFICATION DATE 10/07/2011
DELIVERY MODE ELECTRONIC

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.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

info@mhdpatents.com

<b>Advisory Action Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 12/324,122	<b>Applicant(s)</b> BEYER, MALCOLM K.
	<b>Examiner</b> AMANUEL LEBASSI	<b>Art Unit</b> 2617

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 09 September 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1.  The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a)  The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b)  The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2.  The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3.  The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because

- (a)  They raise new issues that would require further consideration and/or search (see NOTE below);
- (b)  They raise the issue of new matter (see NOTE below);
- (c)  They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d)  They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: The amendment of Independent claims 2, 7 and 11 raise new issues and require further search & considerations. (See 37 CFR 1.116 and 41.33(a)).

4.  The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5.  Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.

6.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7.  For purposes of appeal, the proposed amendment(s): a)  will not be entered, or b)  will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: \_\_\_\_\_.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8.  The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9.  The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10.  The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11.  The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.

12.  Note the attached Information *Disclosure Statement(s)*. (PTO/SB/08) Paper No(s). \_\_\_\_\_

13.  Other: \_\_\_\_\_.

/NICK CORSARO/  
Supervisory Patent Examiner, Art Unit 2617



DO NOT ENTER: /A.L./

Serial No.: 12/324,122  
Attorney Docket No.: 10963.3819  
PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: BEYER, JR., Malcolm K.	)	
	)	
Serial No.: 12/324,122	)	
	)	Confirmation No: 9036
Filed: November 26, 2008	)	
	)	Group Art Unit: 2617
Entitled: METHOD OF UTILIZING	)	
FORCED ALERTS FOR	)	Examiner: LEBASSI, Amanuel
INTERACTIVE REMOTE	)	
COMMUNICATIONS	)	
_____	)	

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

September 9, 2011

*Filed Electronically*

**RESPONSE AND AMENDMENT**

Dear Sir:

In response to the Office Action dated March 11, 2011, please amend the above referenced patent application as follows and consider the remarks below. This Response is filed within six months of the mailing date of the Office Action; therefore, a petition for a three-month extension of time is submitted herewith. In the event that any further extension of time is required, please consider this a request therefor. The Commissioner is authorized to charge any additional fees due or credit any overpayment to Deposit Account 13-1130.

Please amend the claims as shown on pages 2-7.

Remarks begin on page 8.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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Alexandria, Virginia 22313-1450
www.uspto.gov

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.

22235 7590 02/03/2012
MALIN HALEY DIMAGGIO BOWEN & LHOTA, P.A.
1936 S ANDREWS AVENUE
FORT LAUDERDALE, FL 33316

EXAMINER
LEBASSI, AMANUEL

ART UNIT PAPER NUMBER
2617

NOTIFICATION DATE DELIVERY MODE
02/03/2012 ELECTRONIC

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.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

info@mhdpatents.com

<b>Applicant-Initiated Interview Summary</b>	<b>Application No.</b> 12/324,122	<b>Applicant(s)</b> BEYER, MALCOLM K.	
	<b>Examiner</b> AMANUEL LEBASSI	<b>Art Unit</b> 2617	

All participants (applicant, applicant's representative, PTO personnel):

- (1) AMANUEL LEBASSI. (3)\_\_\_\_\_.
- (2) Attorney Barry L. Haley, Esq. (Reg. No. 25,339). (4)\_\_\_\_\_.

Date of Interview: 12/15/2011.

Type:  Telephonic  Video Conference  
 Personal [copy given to:  applicant  applicant's representative]

Exhibit shown or demonstration conducted:  Yes  No.  
If Yes, brief description: \_\_\_\_\_.

Issues Discussed 101 112 102 103 Others  
(For each of the checked box(es) above, please describe below the issue and detailed description of the discussion)

Claim(s) discussed: \_\_\_\_\_.

Identification of prior art discussed: \_\_\_\_\_.

**Substance of Interview**

(For each issue discussed, provide a detailed description and indicate if agreement was reached. Some topics may include: identification or clarification of a reference or a portion thereof, claim interpretation, proposed amendments, arguments of any applied references etc...)

Applicant received an advisory instead of final office action. Therefore the examiner agreed the last office acti will be vacated.

**Applicant recordation instructions:** The formal written reply to the last Office action must include the substance of the interview. (See MPEP section 713.04). If a reply to the last Office action has already been filed, applicant is given a non-extendable period of the longer of one month or thirty days from this interview date, or the mailing date of this interview summary form, whichever is later, to file a statement of the substance of the interview

**Examiner recordation instructions:** Examiners must summarize the substance of any interview of record. A complete and proper recordation of the substance of an interview should include the items listed in MPEP 713.04 for complete and proper recordation including the identification of the general thrust of each argument or issue discussed, a general indication of any other pertinent matters discussed regarding patentability and the general results or outcome of the interview, to include an indication as to whether or not agreement was reached on the issues raised.

Attachment

## Summary of Record of Interview Requirements

### Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

### Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

#### 37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,  
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

### Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.



UNITED STATES DEPARTMENT OF COMMERCE

**U.S. Patent and Trademark Office**

Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

<b>APPLICATION NO./ CONTROL NO.</b>	<b>FILING DATE</b>	<b>FIRST NAMED INVENTOR / PATENT IN REEXAMINATION</b>	<b>ATTORNEY DOCKET NO.</b>
12/324,122	26 November, 2008	BEYER, MALCOLM K.	10963.3819

MALIN HALEY DIMAGGIO BOWEN & LHOTA, P.A. 1936 S ANDREWS AVENUE FORT LAUDERDALE, FL 33316	<b>EXAMINER</b>	
	AMANUEL LEBASSI	
	<b>ART UNIT</b>	<b>PAPER</b>
	2617	20120124

DATE MAILED:

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

Commissioner for Patents

Applicant received an advisory on 10/07/2011 instead of final action. The final rejection of 3/11/2011 should be entered as non final on edan. Therefore the previous office action dated "03/11/2011" is hereby vacated.

Attached: Interview summary date "12/15/2011"

/Amanuel Lebassi/  
Examiner, Art Unit 2617

/Nick Corsaro/ SPE AU2617



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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NOTICE OF ALLOWANCE AND FEE(S) DUE

22235 7590 04/25/2012
MALIN HALEY DIMAGGIO BOWEN & LHOTA, P.A.
1936 S ANDREWS AVENUE
FORT LAUDERDALE, FL 33316

EXAMINER

LEBASSI, AMANUEL

ART UNIT PAPER NUMBER

2617

DATE MAILED: 04/25/2012

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
12/324,122 11/26/2008 Malcolm K. Beyer JR. 10963.3819 9036

TITLE OF INVENTION: METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS

Table with 7 columns: APPLN. TYPE, SMALL ENTITY, ISSUE FEE DUE, PUBLICATION FEE DUE, PREV. PAID ISSUE FEE, TOTAL FEE(S) DUE, DATE DUE
nonprovisional YES \$870 \$300 \$0 \$1170 07/25/2012

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

- A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.
B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

- A. Pay TOTAL FEE(S) DUE shown above, or
B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted. If an equivalent of Part B is filed, a request to reapply a previously paid issue fee must be clearly made, and delays in processing may occur due to the difficulty in recognizing the paper as an equivalent of Part B.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

**PART B - FEE(S) TRANSMITTAL**

**Complete and send this form, together with applicable fee(s), to: Mail Mail Stop ISSUE FEE  
 Commissioner for Patents  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
 or Fax (571)-273-2885**

**INSTRUCTIONS:** This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

22235 7590 04/25/2012  
**MALIN HALEY DIMAGGIO BOWEN & LHOTA, P.A.**  
 1936 S ANDREWS AVENUE  
 FORT LAUDERDALE, FL 33316

**Certificate of Mailing or Transmission**

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

_____ (Depositor's name)
_____ (Signature)
_____ (Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/324,122	11/26/2008	Malcolm K. Beyer JR.	10963.3819	9036

TITLE OF INVENTION: METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	YES	\$870	\$300	\$0	\$1170	07/25/2012

EXAMINER	ART UNIT	CLASS-SUBCLASS
LEBASSI, AMANUEL	2617	455-424000

<p>1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).</p> <p><input type="checkbox"/> Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.</p> <p><input type="checkbox"/> "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev. 03-02 or more recent) attached. <b>Use of a Customer Number is required.</b></p>	<p>2. For printing on the patent front page, list</p> <p>(1) the names of up to 3 registered patent attorneys or agents OR, alternatively, _____ 1</p> <p>(2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed. _____ 2</p> <p>_____ 3</p>
--	---

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE \_\_\_\_\_ (B) RESIDENCE: (CITY and STATE OR COUNTRY) \_\_\_\_\_

Please check the appropriate assignee category or categories (will not be printed on the patent):  Individual  Corporation or other private group entity  Government

<p>4a. The following fee(s) are submitted:</p> <p><input type="checkbox"/> Issue Fee</p> <p><input type="checkbox"/> Publication Fee (No small entity discount permitted)</p> <p><input type="checkbox"/> Advance Order - # of Copies _____</p>	<p>4b. Payment of Fee(s): (Please first reapply any previously paid issue fee shown above)</p> <p><input type="checkbox"/> A check is enclosed.</p> <p><input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.</p> <p><input type="checkbox"/> The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment, to Deposit Account Number _____ (enclose an extra copy of this form).</p>
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5. Change in Entity Status (from status indicated above)

a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27.  b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature \_\_\_\_\_ Date \_\_\_\_\_

Typed or printed name \_\_\_\_\_ Registration No. \_\_\_\_\_

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
12/324,122 11/26/2008 Malcolm K. Beyer JR. 10963.3819 9036

22235 7590 04/25/2012
MALIN HALEY DIMAGGIO BOWEN & LHOTA, P.A.
1936 S ANDREWS AVENUE
FORT LAUDERDALE, FL 33316

EXAMINER

LEBASSI, AMANUEL

ART UNIT PAPER NUMBER

2617

DATE MAILED: 04/25/2012

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)
(application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 254 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 254 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (http://pair.uspto.gov).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.



## Privacy Act Statement

**The Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

<b>Notice of Allowability</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	12/324,122	BEYER, MALCOLM K.	
	<b>Examiner</b>	<b>Art Unit</b>	
	AMANUEL LEBASSI	2617	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1.  This communication is responsive to 09/09/2011.
2.  An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
3.  The allowed claim(s) is/are 2-14.
4.  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All    b)  Some\*    c)  None    of the:
    1.  Certified copies of the priority documents have been received.
    2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_ .
    3.  Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_.

Applicant has **THREE MONTHS FROM THE "MAILING DATE"** of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5.  A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6.  CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a)  including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1)  hereto or 2)  to Paper No./Mail Date \_\_\_\_.
    - (b)  including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).**
7.  DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |  |  |
|--|--|
| <ol style="list-style-type: none"> <li>1. <input type="checkbox"/> Notice of References Cited (PTO-892)</li> <li>2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</li> <li>3. <input type="checkbox"/> Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date ____</li> <li>4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material</li> </ol> | <ol style="list-style-type: none"> <li>5. <input type="checkbox"/> Notice of Informal Patent Application</li> <li>6. <input type="checkbox"/> Interview Summary (PTO-413), Paper No./Mail Date ____ .</li> <li>7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment</li> <li>8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance</li> <li>9. <input type="checkbox"/> Other ____.</li> </ol> |
|--|--|

/A. L./  
Examiner, Art Unit 2617

4/17/2012

**DETAILED ACTION**  
**EXAMINER'S AMENDMENT**

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with **Attorney Barry L. Haley Reg. No. 25,339** on **4/17/2012**.

**The application has been amended as follows:**

1. (Cancelled)
2. (Currently Amended) A communication system for transmitting, receiving, confirming receipt, and responding to an electronic message, comprising:
  - a predetermined network of participants, wherein each participant has a similarly equipped ~~PC or~~ PDA/cell phone that includes a CPU and a touch screen display a CPU and memory;
  - a data transmission means that facilitates the transmission of electronic files between ~~said PCs and~~ said PDA/cell phones in different locations;
  - a sender ~~PC or~~ PDA/cell phone and at least one recipient ~~PC or~~ PDA/cell phone for each electronic message;

a forced message alert software application program including a list of required possible responses to be selected by a participant recipient of a forced message response loaded on each participating ~~PC or~~ PDA/cell phone;

means for attaching a forced message alert software packet to a voice or text message creating a forced message alert that is transmitted by said sender ~~PC or~~ PDA/cell phone to the recipient ~~PC or~~ PDA/cell phone, said forced message alert software packet containing a list of possible required responses and requiring the forced message alert software on said recipient ~~PC or~~ PDA/cell phone to transmit an automatic acknowledgment to the sender ~~PC or~~ PDA/cell phone as soon as said forced message alert is received by the recipient ~~PC or~~ PDA/cell phone;

means for requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display;

means for receiving and displaying a listing of which recipient ~~PCs or~~ PDA/cell phones have automatically acknowledged the forced message alert and which recipient ~~PCs or~~ PDA/cell phones have not automatically acknowledged the forced message alert;

means for periodically resending said forced message alert to said recipient ~~PCs or~~ PDA/cell phones that have not automatically acknowledged the forced message alert; and

means for receiving and displaying a listing of which recipient ~~PCs or~~ PDA/cell phones have transmitted a manual response to said forced message alert and details the response from each recipient ~~PC or~~ PDA/cell phone that responded.

3. (Currently amended) The system as in claim 2, wherein the forced message alert software application program on the recipient ~~PC or~~ PDA/cell phone includes:

means for transmitting the acknowledgment of receipt to said sender ~~PC or~~ PDA/cell phone immediately upon receiving a forced message alert from the sender ~~PC or~~ PDA/cell phone;

means for controlling of the recipient ~~PC or~~ PDA/cell phone upon transmitting said automatic acknowledgment and causing, in cases where the force message alert is a text message, the text message and a response list to be shown on the display of the recipient ~~PC or~~ PDA/cell phone or causes, in cases where the forced message alert is a voice message, the voice message being periodically repeated by the speakers of the recipient ~~PC or~~ PDA/cell phone while said response list is shown on the display;

means for allowing a manual response to be manually selected from the response list or manually recorded and transmitting said manual response to the sender ~~PC or~~ PDA/cell phone; and

means for clearing the text message and a response list from the display of the recipient ~~PC or~~ PDA/cell phone or stopping the repeating voice message and clearing the response list from the display of the recipient ~~PC or~~ PDA/cell phone once the manual response is transmitted.

4. (Previously presented) The system as in claim 2, wherein said data transmission means is TCP/IP or another communications protocol.

5. (Previously presented) The system as in claim 2, wherein the response list that is transmitted within the forced message alert software packet is a default response list that is embedded in the forced message alert software application program.

6. (Currently Amended) The system as in claim 2, wherein the response list that is transmitted within the forced message alert software packet is a custom response list that is created at the time the specific forced message alert is created on the sender ~~PC or~~ PDA/cell phone.

7. (Currently amended) A method of sending a forced message alert to one or more recipient ~~PCs or~~ PDA/cell phones within a predetermined communication network, wherein the receipt and response to said forced message alert by each intended recipient ~~PC or~~ PDA/cell phone is tracked, said method comprising the steps of:

accessing a forced message alert software application program on a sender ~~PC or~~ PDA/cell phone;

creating the forced message alert on said sender ~~PC or~~ PDA/cell phone by attaching a voice or text message to a forced message alert application software packet to said voice or text message;

designating one or more recipient ~~PCs or~~ PDA/cell phones in the communication network;

electronically transmitting the forced message alert to said recipient ~~PCs or~~ PDA/cell phones;

receiving automatic acknowledgements from the recipient ~~PCs or~~ PDA/cell phones that received the message and displaying a listing of which recipient ~~PCs or~~ PDA/cell phones have acknowledged receipt of the forced message alert and which recipient ~~PCs or~~ PDA/cell phones have not acknowledged receipt of the forced message alert;

periodically resending the forced message alert to the recipient ~~PCs or~~ PDA/cell phones that have not acknowledged receipt;

receiving responses to the forced message alert from the recipient ~~PCs or~~ PDA/cell phones and displaying the response from each recipient ~~PC or~~ PDA/cell phone; and

providing a manual response list on the display of the recipient ~~PC or~~ PDA/cell phone that can only be cleared by the recipient providing a required response from the list;

clearing the recipient's display screen or causing the repeating voice alert to cease upon recipient selecting a response from the response list required that can only be cleared by manually selecting and transmitting a response to the manual response list.

8. (Currently Amended) The method as in claim 7, wherein each ~~PC or~~ PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it.

9. (Original) The method as in claim 7, wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program.

10. (Currently Amended) The method as in claim 7, wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender ~~PC or~~ PDA/cell phone.

11. (Currently amended) A method of receiving, acknowledging and responding to a forced message alert from a sender ~~PC or~~ PDA/cell phone to a recipient ~~PC or~~ PDA/cell phone, wherein the receipt, acknowledgment, and response to said forced message alert is forced by a

forced message alert software application program, said method comprising the steps of: receiving an electronically transmitted electronic message; identifying said electronic message as a forced message alert, wherein said forced message alert comprises of a voice or text message and a forced message alert application software packet, which triggers the activation of the forced message alert software application program within the recipient ~~PC or~~ PDA/cell phone;

transmitting an automatic acknowledgment of receipt to the sender ~~PC or~~ PDA/cell phone, which triggers the forced message alert software application program to take control of the recipient ~~PC or~~ PDA/cell phone and show the content of the text message and a required response list on the display recipient ~~PC or~~ PDA/cell phone or to repeat audibly the content of the voice message on the speakers of the recipient ~~PC or~~ PDA/cell phone and show the required response list on the display recipient ~~PC or~~ PDA/cell phone; and

transmitting a selected required response from the response list in order to allow the message required response list to be cleared from the recipient's cell phone display, whether said selected response is a chosen option from the response list, causing the forced message alert software to release control of the recipient ~~PC or~~ PDA/cell phone and stop showing the content of the text message and a response list on the display recipient ~~PC or~~ PDA/cell phone and or stop repeating the content of the voice message on the speakers of the recipient ~~PC or~~ PDA/cell phone;



displaying the response received from the ~~PC or~~ PDA cell phone that transmitted the response on the sender of the forced alert ~~PC or~~ PDA/cell phone; and

providing a list of the recipient ~~PC or~~ PDA/cell phones have automatically acknowledged receipt of a forced alert message and their response to the forced alert message. 12. (Original)

12. (Currently amended) The method as in claim 11, wherein each ~~PC or~~ PDA/cell phone within a predetermined communication network is similarly equipped and has the forced message alert software application program loaded on it.

13. (Original) The method as in claim 11, wherein said forced message alert application software packet contains a response list, wherein said response list is a default list embedded in the forced message alert software application program.

14. (Currently amended) The method as in claim 11, wherein said forced message alert application software packet contains a response list, wherein said response list is a custom response list that is created at the time the specific forced message alert is created on the sender ~~PC or~~ PDA/cell phone.

*Allowable Subject Matter*

1. Claims 2-14 are allowed.
2. The following is an **examiner's statement of reasons for allowance:**

The following is an examiner's statement of reasons for allowance: claims 2-14 have been found to be novel and the inventive because prior art record fails to show or teach means for attaching a forced message alert software packet to a voice or text message creating a forced message alert that is transmitted by said sender PDA/cell phone to the recipient PDA/cell phone, said forced message alert software packet containing a list of possible required responses and requiring the forced message alert software on said recipient PDA/cell phone to transmit an automatic acknowledgment to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone; means for requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display; means for receiving and displaying a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have not automatically acknowledged the forced message alert.

2. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

1. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Amanuel Lebassi, whose telephone number is (571) 270-5303. The Examiner can normally be reached on Monday-Thursday from 8:00am to 5:00pm.

Application/Control Number: 12/324,122  
Art Unit: 2617

Page 10


If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Nick Corsaro can be reached at (571) 272-7876. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

*Amanuel Lebassi*  
/A. L/  
4/17/2012

/NICK CORSARO/  
Supervisory Patent Examiner, Art Unit 2617

<b>Search Notes</b>  	<b>Application/Control No.</b>  12324122	<b>Applicant(s)/Patent Under Reexamination</b>  BEYER, MALCOLM K.
	<b>Examiner</b>  AMANUEL LEBASSI	<b>Art Unit</b>  2617

<b>SEARCHED</b>			
Class	Subclass	Date	Examiner
455	41.1, 416, 518, 519	9/9/2010	AL
455	41.3, 88, 404.2, 412.1, 412.2, 414.4, 415, 416, 418, 419, 420, 456.1, 456.3, 457, 458, 463	4/17/2012	AL
701	213, 482	4/17/2012	AL

<b>SEARCH NOTES</b>		
Search Notes	Date	Examiner
Inventor Search	9/9/2010	AL
Updated Search	4/17/2012	AL

<b>INTERFERENCE SEARCH</b>			
Class	Subclass	Date	Examiner
455	41.3, 88, 404.2, 412.1, 412.2, 414.4, 415, 416, 418, 419, 420, 456.1, 456.3, 457, 458, 463	4/17/2012	AL


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**EAST Search History**

**EAST Search History (Prior Art)**

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
S100	1	12/324,122	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2012/04/17 13:14
S101	67	(Beyer near2 Jr\$1).in.	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2012/04/17 15:29
S102	42	(Beyer near2 Jr\$1).in.	USPAT	ADJ	OFF	2012/04/17 15:29
S103	0	455/41.3, "88", "404.2", "412.1", "412.2", "414.4", "415", "416", "418", "419", "420", "456.1", "456.3", "457", "458", "463".ccls.	USPAT	ADJ	OFF	2012/04/17 15:54
S104	0	455/41.3,88,404.2,412.1,412.2,414.4 "415,416,418,419,420,456"" ""1,456"" ""3,457,458,463".ccls.	USPAT	ADJ	OFF	2012/04/17 15:55
S105	11944	455/41.3,88,404.2,412.1,412.2,414.4,415,416,418,419,420,456.1,456.3,457,458,463.ccls.	USPAT	ADJ	OFF	2012/04/17 15:56
S106	756	(periodic\$4 same (resend\$3 or re-send\$3 or retransmit\$4)) and alert\$3	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2012/04/17 15:57
S107	268	S106 and (ACK or acknowledge)	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2012/04/17 15:57
S108	180	((@prad < "20040921") or (@rlad < "20040921") or ( @ad< "20040921")) and S107	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2012/04/17 15:57
S109	0	(forced near3 (alert\$4)) same (participat\$3 ((mobile or portable or wireless or cell\$4 or handheld) adj (telephone or phone or terminal or station or device or unit)))	US-PGPUB; USPAT; USOCR; FPRS; EPO; JPO	ADJ	OFF	2012/04/17 15:58

4/ 17/ 2012 6:13:24 PM  
 C:\Users\alebassi\Documents\EAST\Workspaces\12324122.wsp

<b>Issue Classification</b> 	<b>Application/Control No.</b> 12324122	<b>Applicant(s)/Patent Under Reexamination</b> BEYER, MALCOLM K.
	<b>Examiner</b> AMANUEL LEBASSI	<b>Art Unit</b> 2617

ORIGINAL						INTERNATIONAL CLASSIFICATION											
CLASS		SUBCLASS				CLAIMED				NON-CLAIMED							
455		466				H	0	4	W	4 / 00 (2009.01.01)							
<b>CROSS REFERENCE(S)</b>																	
CLASS	SUBCLASS (ONE SUBCLASS PER BLOCK)																
455	88	404.2	412.1	412.2	414.4												
455	415	416	418	419	420												
455	456.1	456.3	457	458	463												
455	500	517	518	519	556.2												
701	213	482															

Claims renumbered in the same order as presented by applicant
  CPA
  T.D.
  R.1.47

Final	Original	Final	Original	Final	Original	Final	Original	Final	Original	Final	Original	Final	Original	Final	Original
	1														
1	2														
2	3														
3	4														
4	5														
5	6														
6	7														
7	8														
8	9														
9	10														
10	11														
11	12														
12	13														
13	14														

/AMANUEL LEBASSI/ Examiner.Art Unit 2617  (Assistant Examiner)	4/17/2012  (Date)	<b>Total Claims Allowed:</b> 13	
/NICK CORSARO/ Supervisory Patent Examiner.Art Unit 2617  (Primary Examiner)	04/19/2012  (Date)	O.G. Print Claim(s) 2	O.G. Print Figure Fig. 1a

**EAST Search History**

**EAST Search History (Interference)**

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
S110	12074	455/41.3,88,404.2,412.1,412.2,414.4,415,416,418,419,420,456.1,456.3,457,458,463.ccls.	USPAT; UPAD	ADJ	OFF	2012/04/17 15:56
S111	0	S110 and ( requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display).clm.	USPAT; UPAD	ADJ	OFF	2012/04/17 15:57
S112	0	S110 and ( requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display).clm.	USPAT; UPAD	AND	OFF	2012/04/17 15:57
S113	0	S110 and ( requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient'\$1 cell phone display).clm.	USPAT; UPAD	AND	OFF	2012/04/17 15:57
S114	0	S110 and ( requiring a required manual response from the response list by the recipient in order to clear recipient\$1 response list from recipient\$1 cell phone display).clm.	USPAT; UPAD	AND	OFF	2012/04/17 15:57

4/ 17/ 2012 6:13:42 PM

C:\Users\alebassi\Documents\EAST\Workspaces\12324122.wsp

**PART B - FEE(S) TRANSMITTAL**

**Complete and send this form, together with applicable fee(s), to: Mail Mail Stop ISSUE FEE  
 Commissioner for Patents  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
 or Fax (571)-273-2885**

**INSTRUCTIONS:** This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

22235 7590 04/25/2012  
**MALIN HALEY DIMAGGIO BOWEN & LHOTA, P.A.**  
 1936 S ANDREWS AVENUE  
 FORT LAUDERDALE, FL 33316

**Certificate of Mailing or Transmission**

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

(Depositor's name)
Filed Electronically (Signature)
(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/324,122	11/26/2008	Malcolm K. Beyer JR.	10963.3819	9036

TITLE OF INVENTION: METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	YES	\$870	\$300	\$0	\$1170	07/25/2012

EXAMINER	ART UNIT	CLASS-SUBCLASS
LEBASSI, AMANUEL	2617	455-424000

<p>1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).</p> <p><input type="checkbox"/> Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.</p> <p><input type="checkbox"/> "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev. 03-02 or more recent) attached. <b>Use of a Customer Number is required.</b></p>	<p>2. For printing on the patent front page, list</p> <p>(1) the names of up to 3 registered patent attorneys or agents OR, alternatively,</p> <p>(2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.</p>	<p>1. <u>MALIN HALEY DIMAGGIO</u></p> <p>2. <u>BOWEN &amp; LHOTA, P.A.</u></p> <p>3. _____</p>
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3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE: Advanced Ground Information Systems, Inc.

(B) RESIDENCE: (CITY AND STATE OR COUNTRY) Jupiter, Florida

Please check the appropriate assignee category or categories (will not be printed on the patent):  Individual  Corporation or other private group entity  Government

<p>4a. The following fee(s) are submitted:</p> <p><input checked="" type="checkbox"/> Issue Fee</p> <p><input type="checkbox"/> Publication Fee (No small entity discount permitted)</p> <p><input checked="" type="checkbox"/> Advance Order - # of Copies <u>10</u></p>	<p>4b. Payment of Fee(s): (Please first reapply any previously paid issue fee shown above)</p> <p><input type="checkbox"/> A check is enclosed.</p> <p><input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.</p> <p><input checked="" type="checkbox"/> The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment, to Deposit Account Number <u>13-1130</u> (enclose an extra copy of this form).</p>
---	--

5. Change in Entity Status (from status indicated above)

a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27.  b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature /barry l. haley/ Date May 24, 2012

Typed or printed name Barry L. Haley Registration No. 25,339

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.



## Electronic Patent Application Fee Transmittal

<b>Application Number:</b>	12324122				
<b>Filing Date:</b>	26-Nov-2008				
<b>Title of Invention:</b>	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS				
<b>First Named Inventor/Applicant Name:</b>	Malcolm K. Beyer				
<b>Filer:</b>	Barry Lee Haley/Amy Allen				
<b>Attorney Docket Number:</b>	10963.3819				
Filed as Small Entity					
<b>Utility under 35 USC 111(a) Filing Fees</b>					
<b>Description</b>	<b>Fee Code</b>	<b>Quantity</b>	<b>Amount</b>	<b>Sub-Total in USD(\$)</b>	
<b>Basic Filing:</b>					
<b>Pages:</b>					
<b>Claims:</b>					
<b>Miscellaneous-Filing:</b>					
<b>Petition:</b>					
<b>Patent-Appeals-and-Interference:</b>					
<b>Post-Allowance-and-Post-Issuance:</b>					
Utility Appl issue fee	2501	1	870	870	
<b>Extension-of-Time:</b>					

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
<b>Miscellaneous:</b>				
Printed copy of patent - no color	8001	10	3	30
<b>Total in USD (\$)</b>				<b>900</b>

## Electronic Acknowledgement Receipt

<b>EFS ID:</b>	12854129
<b>Application Number:</b>	12324122
<b>International Application Number:</b>	
<b>Confirmation Number:</b>	9036
<b>Title of Invention:</b>	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS
<b>First Named Inventor/Applicant Name:</b>	Malcolm K. Beyer
<b>Customer Number:</b>	22235
<b>Filer:</b>	Barry Lee Haley/Amy Allen
<b>Filer Authorized By:</b>	Barry Lee Haley
<b>Attorney Docket Number:</b>	10963.3819
<b>Receipt Date:</b>	24-MAY-2012
<b>Filing Date:</b>	26-NOV-2008
<b>Time Stamp:</b>	11:11:08
<b>Application Type:</b>	Utility under 35 USC 111(a)

### Payment information:

Submitted with Payment	yes
Payment Type	Deposit Account
Payment was successfully received in RAM	\$900
RAM confirmation Number	10940
Deposit Account	131130
Authorized User	

The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows:

Charge any Additional Fees required under 37 C.F.R. Section 1.20 (Post Issuance fees)

Charge any Additional Fees required under 37 C.F.R. Section 1.21 (Miscellaneous fees and charges)

<b>File Listing:</b>					
<b>Document Number</b>	<b>Document Description</b>	<b>File Name</b>	<b>File Size(Bytes)/ Message Digest</b>	<b>Multi Part /.zip</b>	<b>Pages (if appl.)</b>
1	Issue Fee Payment (PTO-85B)	10_IssueFeeTransmittal.pdf	141692 3f2c967da2a77726b3f872de20f7a91a3927b82f	no	1
<b>Warnings:</b>					
<b>Information:</b>					
2	Fee Worksheet (SB06)	fee-info.pdf	31994 61febb4bd13c1ffa7c44e4236805f9ab3e08db3	no	2
<b>Warnings:</b>					
<b>Information:</b>					
<b>Total Files Size (in bytes):</b>			173686		
<p><b>This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.</b></p> <p><b><u>New Applications Under 35 U.S.C. 111</u></b>  <b>If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.</b></p> <p><b><u>National Stage of an International Application under 35 U.S.C. 371</u></b>  <b>If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.</b></p> <p><b><u>New International Application Filed with the USPTO as a Receiving Office</u></b>  <b>If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.</b></p>					

## Electronic Patent Application Fee Transmittal

<b>Application Number:</b>	12324122
<b>Filing Date:</b>	26-Nov-2008
<b>Title of Invention:</b>	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS
<b>First Named Inventor/Applicant Name:</b>	Malcolm K. Beyer
<b>Filer:</b>	Barry Lee Haley/Amy Allen
<b>Attorney Docket Number:</b>	10963.3819

Filed as Large Entity

### Utility under 35 USC 111(a) Filing Fees

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
<b>Basic Filing:</b>				
<b>Pages:</b>				
<b>Claims:</b>				
<b>Miscellaneous-Filing:</b>				
<b>Petition:</b>				
<b>Patent-Appeals-and-Interference:</b>				
<b>Post-Allowance-and-Post-Issuance:</b>				
Publ. Fee- early, voluntary, or normal	1504	1	300	300

**Extension-of-Time:**

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
<b>Miscellaneous:</b>				
<b>Total in USD (\$)</b>				<b>300</b>

## Electronic Acknowledgement Receipt

<b>EFS ID:</b>	12858491
<b>Application Number:</b>	12324122
<b>International Application Number:</b>	
<b>Confirmation Number:</b>	9036
<b>Title of Invention:</b>	METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS
<b>First Named Inventor/Applicant Name:</b>	Malcolm K. Beyer
<b>Customer Number:</b>	22235
<b>Filer:</b>	Barry Lee Haley/Amy Allen
<b>Filer Authorized By:</b>	Barry Lee Haley
<b>Attorney Docket Number:</b>	10963.3819
<b>Receipt Date:</b>	24-MAY-2012
<b>Filing Date:</b>	26-NOV-2008
<b>Time Stamp:</b>	15:16:58
<b>Application Type:</b>	Utility under 35 USC 111(a)

### Payment information:

Submitted with Payment	yes
Payment Type	Deposit Account
Payment was successfully received in RAM	\$ 300
RAM confirmation Number	1651
Deposit Account	131130
Authorized User	

The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows:

Charge any Additional Fees required under 37 C.F.R. Section 1.20 (Post Issuance fees)

Charge any Additional Fees required under 37 C.F.R. Section 1.21 (Miscellaneous fees and charges)

<b>File Listing:</b>					
<b>Document Number</b>	<b>Document Description</b>	<b>File Name</b>	<b>File Size(Bytes)/ Message Digest</b>	<b>Multi Part /.zip</b>	<b>Pages (if appl.)</b>
1	Fee Worksheet (SB06)	fee-info.pdf	30373 <small>ca3132211ac0f96780f83e7d56a7c5bc840a a8d1</small>	no	2
<b>Warnings:</b>					
<b>Information:</b>					
<b>Total Files Size (in bytes):</b>			30373		
<p><b>This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.</b></p> <p><b><u>New Applications Under 35 U.S.C. 111</u></b>  <b>If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.</b></p> <p><b><u>National Stage of an International Application under 35 U.S.C. 371</u></b>  <b>If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.</b></p> <p><b><u>New International Application Filed with the USPTO as a Receiving Office</u></b>  <b>If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.</b></p>					





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Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Table with 5 columns: APPLICATION NO., ISSUE DATE, PATENT NO., ATTORNEY DOCKET NO., CONFIRMATION NO.
Row 1: 12/324,122, 07/03/2012, 8213970, 10963.3819, 9036

22235 7590 06/13/2012
MALIN HALEY DIMAGGIO BOWEN & LHOTA, P.A.
1936 S ANDREWS AVENUE
FORT LAUDERDALE, FL 33316

ISSUE NOTIFICATION

The projected patent number and issue date are specified above.

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)
(application filed on or after May 29, 2000)

The Patent Term Adjustment is 367 day(s). Any patent to issue from the above-identified application will include an indication of the adjustment on the front page.

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (http://pair.uspto.gov).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Application Assistance Unit (AAU) of the Office of Data Management (ODM) at (571)-272-4200.

APPLICANT(s) (Please see PAIR WEB site http://pair.uspto.gov for additional applicants):

Malcolm K. Beyer JR., Jupiter Inlet Colony, FL;

<b>TO:</b> <p style="text-align: center;"><b>Mail Stop 8</b>  <b>Director of the U.S. Patent and Trademark Office</b>  <b>P.O. Box 1450</b>  <b>Alexandria, VA 22313-1450</b></p>	<b>REPORT ON THE          FILING OR DETERMINATION OF AN          ACTION REGARDING A PATENT OR          TRADEMARK</b>
--	--

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court for the Eastern District of Texas - Marshall Division on the following

Trademarks or  Patents. (  the patent action involves 35 U.S.C. § 292.)

DOCKET NO. 2:17-cv-00517-JRG	DATE FILED June 21, 2017	U.S. DISTRICT COURT Eastern District of Texas - Marshall Division
PLAINTIFF AGIS Software Development LLC		DEFENDANT ZTE Corporation , et al.
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 8,213,970	July 3, 2012	AGIS Software Development LLC
2 9,408,055	August 2, 2016	AGIS Software Development LLC
3 9,445,251	September 13, 2016	AGIS Software Development LLC
4 9,467,838	October 11, 2016	AGIS Software Development LLC
5		

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1		
2		
3		
4		
5		

In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT
--------------------

CLERK	(BY) DEPUTY CLERK	DATE
-------	-------------------	------

Copy 1—Upon initiation of action, mail this copy to Director    Copy 3—Upon termination of action, mail this copy to Director  
 Copy 2—Upon filing document adding patent(s), mail this copy to Director    Copy 4—Case file copy

TO: <b>Mail Stop 8</b> <b>Director of the U.S. Patent and Trademark Office</b> <b>P.O. Box 1450</b> <b>Alexandria, VA 22313-1450</b>	<b>REPORT ON THE</b> <b>FILING OR DETERMINATION OF AN</b> <b>ACTION REGARDING A PATENT OR</b> <b>TRADEMARK</b>
---	---

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court for the Eastern District of Texas - Marshall Division on the following

Trademarks or  Patents. (  the patent action involves 35 U.S.C. § 292.):

DOCKET NO. 2:17-cv-00515-JRG	DATE FILED June 21, 2017	U.S. DISTRICT COURT Eastern District of Texas - Marshall Division
PLAINTIFF AGIS Software Development LLC		DEFENDANT LG Electronics, Inc.
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 8,213,970	July 3, 2012	AGIS Software Development LLC
2 9,408,055	August 2, 2016	AGIS Software Development LLC
3 9,445,251	September 13, 2016	AGIS Software Development LLC
4 9,467,838	October 11, 2016	AGIS Software Development LLC
5		

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1		
2		
3		
4		
5		

In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT
--------------------

CLERK	(BY) DEPUTY CLERK	DATE
-------	-------------------	------

Copy 1—Upon initiation of action, mail this copy to Director    Copy 3—Upon termination of action, mail this copy to Director  
 Copy 2—Upon filing document adding patent(s), mail this copy to Director    Copy 4—Case file copy

<b>TO:</b> Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	<b>REPORT ON THE                  FILING OR DETERMINATION OF AN                  ACTION REGARDING A PATENT OR                  TRADEMARK</b>
---	--

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court for the Eastern District of Texas - Marshall Division on the following

Trademarks or  Patents. (  the patent action involves 35 U.S.C. § 292.);

DOCKET NO. 2:17-cv-00513-JRG	DATE FILED June 21, 2017	U.S. DISTRICT COURT Eastern District of Texas - Marshall Division
PLAINTIFF AGIS Software Development LLC		DEFENDANT Huawei Device USA Inc., et al.
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 8,213,970	July 3, 2012	AGIS Software Development LLC
2 9,408,055	August 2, 2016	AGIS Software Development LLC
3 9,445,251	September 13, 2016	AGIS Software Development LLC
4 9,467,838	October 11, 2016	AGIS Software Development LLC
5		

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

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In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court for the Eastern District of Texas - Marshall Division on the following

Trademarks or  Patents. (  the patent action involves 35 U.S.C. § 292.);

DOCKET NO. 2:17-cv-00516-JRG	DATE FILED June 21, 2017	U.S. DISTRICT COURT Eastern District of Texas - Marshall Division
PLAINTIFF AGIS Software Development LLC		DEFENDANT Apple, Inc.
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 8,213,970	July 3, 2012	AGIS Software Development LLC
2 9,408,055	August 2, 2016	AGIS Software Development LLC
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Trademarks or  Patents. (  the patent action involves 35 U.S.C. § 292.):

DOCKET NO. 2:17-cv-00514-JRG	DATE FILED June 21, 2017	U.S. DISTRICT COURT Eastern District of Texas - Marshall Division
PLAINTIFF AGIS Software Development LLC		DEFENDANT HTC Corporation
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 8,213,970	July 3, 2012	AGIS Software Development LLC
2 9,408,055	August 2, 2016	AGIS Software Development LLC
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Trademarks or  Patents. (  the patent action involves 35 U.S.C. § 292.);

DOCKET NO. 2:17-cv-00515-JRG	DATE FILED June 21, 2017	U.S. DISTRICT COURT Eastern District of Texas - Marshall Division
PLAINTIFF AGIS Software Development LLC		DEFENDANT LG Electronics, Inc.
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 8,213,970	July 3, 2012	AGIS Software Development LLC
2 9,408,055	August 2, 2016	AGIS Software Development LLC
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PLAINTIFF AGIS Software Development LLC		DEFENDANT Huawei Device USA Inc., et al.
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PLAINTIFF AGIS Software Development LLC		DEFENDANT HTC Corporation
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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Trademarks or  Patents. (  the patent action involves 35 U.S.C. § 292.);

DOCKET NO. 2:17-cv-00517-JRG	DATE FILED June 21, 2017	U.S. DISTRICT COURT Eastern District of Texas - Marshall Division
PLAINTIFF AGIS Software Development LLC		DEFENDANT ZTE Corporation , et al.
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 8,213,970	July 3, 2012	AGIS Software Development LLC
2 9,408,055	August 2, 2016	AGIS Software Development LLC
3 9,445,251	September 13, 2016	AGIS Software Development LLC
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# **Exhibit 1003**

UNITED STATES PATENT AND TRADEMARK OFFICE

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GOOGLE LLC,  
Requestor

---

U.S. Patent No. 8,213,970

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**DECLARATION OF DAVID HILLIARD WILLIAMS IN SUPPORT OF  
REEXAMINATION REQUEST FOR U.S. PATENT NO. 8,213,970**

**Mail Stop “*Ex Parte* Reexam”**  
Attn: Central Reexamination Unit  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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**EXHIBIT LIST**

<b>Exhibit No.</b>	<b>Description</b>
<b>1001</b>	U.S. Patent No. 8,213,970 B2 to Beyer (“’970 patent”)
<b>1002</b>	Prosecution History of U.S. Patent No. 8,213,970 (Application No. 12/324,122) (“’970 Prosecution History”)
<b>1003</b>	Declaration of David H. Williams
<b>1004</b>	<i>Curriculum Vitae</i> of David H. Williams
<b>1005</b>	U.S. Patent Application Publication No. 2006/0218232 to Kubala <i>et al.</i> (“Kubala”)
<b>1006</b>	U.S. Patent No. 6,854,007 to Hammond (“Hammond”)
<b>1007</b>	U.S. Patent No. 5,325,310 to Johnson <i>et al.</i> (“Johnson”)
<b>1008</b>	U.S. Patent No. 5,742,905 to Pepe <i>et al.</i> (“Pepe”)
<b>1009</b>	U.S. Publication No. 2003/0128195 to Banerjee <i>et al.</i> (“Banerjee”)
<b>1010</b>	<i>Simon Says “Here’s How!” Simon™ Mobile Communications Made Simple</i> , Simon Users Manual, IBM Corp., 1994. (“Simon”)
<b>1011</b>	Prosecution History of U.S. Patent Application No. 10/711,490 (“’490 application”)
<b>1012</b>	Prosecution History of U.S. Application No. 11/308,648 (“’648 application”)
<b>1013</b>	Prosecution History of U.S. Application No. 11/612,830 (“’830 application”)
<b>1014</b>	McKinsey & Company, <i>The McKinsey Report: FDNY 9/11 Response</i> (2002) (“The McKinsey Report”)
<b>1015</b>	<i>Apple Newton</i> , Wikipedia.com, <a href="https://en.wikipedia.org/wiki/Apple_Newton">https://en.wikipedia.org/wiki/Apple_Newton</a> (last visited May 10, 2018) (“Apple”)
<b>1016</b>	<i>From touch displays to the Surface: A brief history of touchscreen technology</i> , Arstechnica.com <a href="https://arstechnica.com/gadgets/2013/04/from-touch-displays-to-the-surface-a-brief-history-of-touchscreen-technology/">https://arstechnica.com/gadgets/2013/04/from-touch-displays-to-the-surface-a-brief-history-of-touchscreen-technology/</a> (last visited May 10, 2018) (“Arstechnica”)
<b>1017</b>	Reexamination Control No. 90/006,572 (Decision dated June 30, 2010) (“’572 Reexamination Decision”)
<b>1018</b>	Reexamination Control No. 90/013,808 (Decision dated June 15, 2018) (“’808 Reexamination Decision”)
<b>1019</b>	Reexamination Control No. 90/014,071 (Decision dated November 13, 2018) (“’071 Reexamination Decision”)
<b>1020</b>	Reexamination Control No. 95/000,185 (Decision dated August 22, 2008 (“’185 Reexamination Decision”)

*Request for Reexamination of  
U.S. Patent No. 8,213,970*

<b>Exhibit No.</b>	<b>Description</b>
<b>1021</b>	<i>SDI Technologies v. Bose Corp.</i> , IPR2013-00350, Paper 36, Final Written Decision (P.T.A.B. Nov. 7, 2014)
<b>1022</b>	<i>Google LLC v. AGIS Software Development, LLC</i> , IPR2018-01079, Paper 2, Petition (P.T.A.B. May 15, 2018)
<b>1023</b>	<i>Google LLC v. AGIS Software Development, LLC</i> , IPR2018-01079, Paper 8, Petitioner's Reply (P.T.A.B. Sept. 19, 2018)
<b>1024</b>	<i>Google LLC v. AGIS Software Development, LLC</i> , IPR2018-01079, Paper 34, Final Written Decision (P.T.A.B. Nov. 19, 2019)

**I. Introduction**

I, David Hilliard Williams, declare as follows:

1. I have been retained on behalf of Google LLC for the above-captioned *ex parte* reexamination proceeding. I understand that this proceeding involves U.S. Patent No. 8,213,970 (“the ’970 patent”), titled “Method of Utilizing Forced Alerts for Interactive Remote Communications” by Malcolm K. Beyer, and that the ’970 patent is currently assigned to AGIS Software Development, LLC.

2. I have reviewed and am familiar with the specification of the ’970 patent. I understand that the application that issued as the ’970 patent was filed on November 26, 2008, and claims priority to U.S. Patent Application No. 10/711,490 (“’490 application”), filed September 21, 2004. I understand that the ’970 patent has been provided as Exhibit 1001, and that the ’490 application has been provided as Exhibit 1011.

3. I have reviewed and am familiar with the file history of the ’970 patent. I understand that the prosecution file history has been provided as Exhibit 1002.

4. I understand that the ’970 patent has an actual filing date of November 26, 2008. I also understand that the ’970 patent claims priority to three earlier-filed applications: (i) U.S. Application No. 10/711,490 (Ex. 1011, ’490 application), filed on September 21, 2004; (ii) U.S. Application No. 11/308,648 (Ex. 1012, “’648 application”), filed on April 17, 2006; and (iii) U.S. Application No. 11/612,830 (Ex. 1013, “’830 application”), filed on December 19, 2006. I have been asked to provide my opinion as to whether these earlier-filed applications disclose the claimed “forced message alert software application program.” As explained in more detail below, it is my opinion that these earlier-filed applications do not disclose this claim limitation. Because support for the “forced message alert software application program” does not appear in any of the parent continuation-in-part applications either, I am informed that the priority date of the ’970 patent is the actual filing date of the ’970 patent, November 26, 2008. But, out of an abundance of caution, the opinions in this Declaration will address both the November 26, 2008 and September 21, 2004 priority dates. I understand that this Declaration has been provided as Exhibit 1003.

## II. List of Documents Considered in Formulating My Opinion

5. I have also reviewed and am familiar with the following prior art used in the Request for *ex parte* Reexamination and/or in my declaration below. I understand that the request for reexamination is requested of claims 2 and 10-13 of the '970 patent. These claims can be referred to individually, or collectively, as the "Requested Claims" or claims or the claims subject to reexamination.

**U.S. Patent Application Publication No. 2006/0218232** to Kubala *et al.*, titled "Method and System for Accommodating Mandatory Responses in Electronic Messaging" ("Kubala"). Kubala was published on September 28, 2006 and was filed on March 24, 2005, and both dates are prior to the *actual* filing date of the '970 patent. I understand that Kubala has been provided as Exhibit 1005. This reference was not cited or applied in the original prosecution of the '970 patent. But the Final Written Decision (FWD) of *Google LLC v. AGIS Software Dev., LLC*, IPR2018-01079, determined that Kubala (in combination with Hammond below) rendered claims 1 and 3-9 of the '970 patent unpatentable. Kubala is being applied to the Requested Claims for the first time here.

**U.S. Patent No. 6,854,007** to Hammond, titled "Method and System for Enhancing Reliability of Communication with Electronic Messages" ("Hammond"). Hammond issued as a patent on February 8, 2005, more than one year before the *actual* filing date of the '970 patent. I understand that Hammond has been provided as Exhibit 1006. This reference was not cited or applied in the original prosecution of the '970 patent. But the FWD of IPR2018-01079 determined that Hammond (in combination with Kubala) renders claims 1 and 3-9 of the '970 patent unpatentable.

The FWD of IPR2018-01079 states, however, that the Petition, (*Google*, IPR2018-01079, Pet. (P.T.A.B. May 15, 2018) (EX1022)), did not specify what portion of Hammond discloses a "forced message alert software packet" as recited in independent claim 1 and a "forced message alert application software packet" as recited in independent claim 6. Google disagreed and even explained, in the Petitioner's Reply (*id.*, Pet. Reply at 19 (EX1023)), how the Petition showed that

Hammond teaches these claim elements. But the P.T.A.B. did not consider these teachings in issuing the FWD with regard to the combination of Hammond, Johnson, and Pepe. (*Id.*, FWD, at 71-75 (EX1024).) The explanations are included in this reexamination Request. Hammond is being applied to the Requested Claims for the first time here.

**U.S. Patent No. 5,325,310** to Johnson *et al.*, titled “Method and System for Persistent Electronic Mail Reply Processing” (“Johnson”). Johnson issued on June 28, 1994, more than fourteen years before the *actual* filing date of the ’970 patent. Johnson was filed on June 26, 1992. I understand that Johnson has been provided as Exhibit 1007. This reference was not cited or applied in the original prosecution. The FWD of IPR2018-01079 states that the Petition, (*Google*, IPR2018-01079, Pet.), did not specify what portion of Johnson discloses a “forced message alert software packet” as recited in independent claim 1 and a “forced message alert application software packet” as recited in independent claim 6. Google disagreed and even explained, in the Petitioner’s Reply, (*id.*, Pet. Reply at 19), how the Petition showed that Johnson teaches these claim elements. But the P.T.A.B. did not consider these teachings in issuing the FWD with regard to the combination of Hammond, Johnson, and Pepe. (*Id.*, FWD at 71-75.) The explanations are included in this reexamination Request. Johnson is being applied to the Requested Claims for the first time here.

**U.S. Patent No. 5,742,905** to Pepe *et al.*, titled “Personal Communications Internetworking” (“Pepe”). Pepe issued on April 21, 1998, over ten years prior to the *actual* filing date of the ’970 patent. Pepe was filed on September 19, 1994. I understand that Pepe has been provided as Exhibit 1008. This reference was not cited or applied in the original prosecution. The FWD of IPR2018-01079 states that the Petition, (*Google*, IPR2018-01079, Pet.), did not specify what portion of Hammond or Johnson discloses a “forced message alert software packet” as recited in independent claim 1 and a “forced message alert application software packet” as recited in independent claim 6. Google disagreed and even explained, in the Petitioner’s Reply, (*id.*, Pet. Reply at 19), how the Petition showed that both

Hammond and Johnson teach these claim elements. But the P.T.A.B. did not consider these teachings in issuing the FWD with regard to the combination of Hammond, Johnson, and Pepe. (*Id.*, FWD at 71-75.) The explanations are included in this reexamination Request. Pepe is being applied to the Requested Claims for the first time here.

*U.S. Patent Publication No. 2003/0128195* to Banerjee *et al.*, titled “Touchscreen User Interface: Bluetooth™ Stylus for Performing Right Mouse Clicks” (“Banerjee”). Banerjee published on July 10, 2003, and Banerjee issued as a patent on October 4, 2005, more than three years before the *actual* filing date of the ’970 patent. Banerjee was filed on January 8, 2002. I understand that Banerjee has been provided as Exhibit 1009.

6. I have also reviewed and am familiar with the following other prior art documents:

*Simon Says “Here’s How!” Simon™ Mobile Communications Made Simple*, Simon Users Manual, IBM Corp., 1994 (“Simon”). I understand that the Simon Users Manual has been provided as Exhibit 1010.

7. The ’970 patent is directed to sending and receiving responses to “forced message alerts.” (’970 patent, 1:16-23.) The ’970 patent explains, “[t]he heart of the invention lies in the forced message alert software application program provided in each PC or PDA/cell phone.” (*Id.*, 4:47-49.) This software application program is loaded on each PDA in a network. (*Id.*, 7:8-16.) The ’970 patent describes the process for sending the forced message alerts (*see id.*, 7:43-8:15, FIGS. 3A, 3B) and for responding to the forced message alerts (*see id.*, 8:16-57, FIG. 4). I am familiar with the technology described in the ’970 patent as of its November 26, 2008 actual filing date as well as its September 21, 2004 earliest possible priority date.

8. I have been asked to provide my technical review, analysis, insights, and opinions regarding the ’970 patent and the above-noted references that form the basis for the grounds of rejection set forth in the Request for *ex parte* Reexamination of the ’970 patent.

### **III. Qualifications**

9. In formulating my opinions, I have relied upon my training, knowledge, and experience in the relevant art. A copy of my current *curriculum vitae* is provided as Exhibit 1004, and it provides a comprehensive description of my academic and employment history over the last thirty-plus years.

10. I am currently the President and Founder of the company E911-LBS Consulting that began in 2002. As the President of E911-LBS Consulting, I provide services across the entire wireless value chain, particularly with respect to technology and business strategic planning and product design and development associated with Location Based Services (LBS), Global Positioning Satellite (GPS) systems, Wireless 911 (E911), Real-Time Location Systems (RTLs), Radio Frequency Identification (RFID), beacon, and other location determination and sensing technologies and services.

11. I have very extensive expertise in all aspects of Location Based Service delivery across the wireless location ecosystem including enabling network, map data, geospatial platform, chipset, data management, device, and location determination infrastructure and integration providers. I am expert in all related aspects of LBS, including data privacy and security management.

12. For example, I managed the development and launch of several consumer-oriented LBS applications including mobile social networking, family tracking and local search for a major wireless carrier. This work included the development of corporate-wide location data privacy policies and their systemic implementation for all LBS customers. My work in both data privacy and mobile social networking resulted in my co-inventing a patent in this field titled "Method and apparatus for providing mobile social networking privacy." (U.S. Patent Number 8,613,109, issued on December 17, 2013).

13. In another example, I developed the LBS product/technology strategy for a leading North American carrier. This work resulted in some of the earliest LBS applications into the U.S. market, and included extensive research into the potential use of presence technologies in providing location-based services.

14. I have authored multiple books on wireless location, including:

- The Definitive Guide to GPS, RFID, Wi-Fi, and Other Wireless Location-Based Services (2005 and 2009 versions);

- The Definitive Guide to Wireless E911; and
- The Definitive Guide to Mobile Positioning and Location Management (co-author).

15. I received a B.S. degree in Electrical Engineering from Purdue University in 1983. I received a MBA degree in Information Systems Management from University of Texas, Austin in 1987.

16. My *curriculum vitae* contains further details on my education, experience, publications, and other qualifications to render an expert opinion. My work on this case is being billed at a rate of \$350 per hour. My compensation is not contingent upon the outcome of the Request for *ex parte* Reexamination.

#### **IV. My Understanding of Claim Construction**

17. I understand that, during an *ex parte* reexamination, claims are to be given their broadest reasonable construction in light of the specification as would be read by a person of ordinary skill in the art (“POSA”) at the time of the priority date, which means that the words of the claims should be given their broadest possible meaning consistent with the specification of the ’970 patent.

18. I understand that the broadest reasonable interpretation that the PTO may give means-plus-function language is that mandated by the statute. I understand that the construction of a means-plus-function limitation is a two-step process. The first step is to determine the function of the means-plus-function limitation. The second step is to determine the corresponding structure described in the specification and equivalents thereof.

19. For computer-implemented means-plus-function limitations, I understand that the disclosed structure is not a general-purpose computer, but rather the special-purpose computer programmed to perform the disclosed algorithm. I understand that the algorithm may be disclosed as a mathematical formula, in prose, or as a flow chart, or in any other manner that provides sufficient structure.

#### **V. My Understanding of Obviousness**

20. I understand that a patent claim is invalid if the claimed invention would have been obvious to a person of ordinary skill in the field at the time the application was filed. This means that even if all of the requirements of the claim cannot be found expressly in a single prior-art reference that would anticipate the claim, the claim can still be invalid.



21. It is my understanding that, to obtain a patent, a claimed invention must have, as of the priority date, been nonobvious in view of the prior art in the field. I understand that an invention is obvious when the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious to a POSA at the time the invention was made.

22. I understand that to prove that prior art or a combination of prior art renders a patent obvious, it is necessary to (1) identify the particular references that, singly or in combination, make the patent obvious; (2) specifically identify which elements of the patent claim appear in each of the asserted references; and (3) explain how the prior art references could have been combined in order to create the inventions claimed in the asserted claim.

23. Additionally, when considering issues of obviousness, I have been told that I am to do the following:

- determine the scope and content of the prior art;
- ascertain the differences between the prior art and the claims at issue;
- resolve the level of ordinary skill in the pertinent art; and
- consider evidence of secondary indicia of non-obviousness (if available).

24. With respect to determining the proper scope of prior art to examine, I understand that in order for a prior art reference to be properly used in an obviousness ground under 35 U.S.C. § 103, the prior art reference must be analogous art to the claimed invention. I have been told that a reference is analogous art to the claimed invention only if: (1) the reference is from the same field of endeavor as the claimed invention; or (2) the reference is reasonably pertinent to the particular problem solved by the inventor.

25. I understand that factors relevant to determining the proper field of endeavor include the inventor's explanations of the subject matter (including the patent specification), as well as the claimed invention's structure and function. And I further understand that, to be reasonably pertinent to the particular problem solved by the inventor, a prior art reference must logically commend itself to the inventor's attention in considering his or her problem.

26. I have been told that an analogous reference may be modified or combined with other analogous references or with the POSA's own knowledge if the person would have found the modification or combination obvious. I have also been told that a POSA is presumed to know