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THE LAW OFFICE OF JONATHAN M. WALDMAN LLC P.O. BOX 4124 MEADOWBROOK, PA 19046			EXAMINER WASSUM, LUKE S	
			ART UNIT 3992	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS  
KING & SPALDING LLP  
P.O. BOX 889  
BELMONT, CA 94002-0889

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SEP 28 2011

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000639  
PATENT NO. : 7222078  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

<b>Transmittal of Communication to Third Party Requester Inter Partes Reexamination</b>	Control No.	Patent Under Reexamination
	95/000,639	7222078
	Examiner	Art Unit
	LUKE S. WASSUM	3992

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

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Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

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**ORDER GRANTING/DENYING  
REQUEST FOR INTER PARTES  
REEXAMINATION**

Control No.

95/000,639

Examiner

LUKE S. WASSUM

Patent Under Reexamination

7222078

Art Unit

3992

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

The request for *inter partes* reexamination has been considered. Identification of the claims, the references relied on, and the rationale supporting the determination are attached.

Attachment(s): ☐ PTO-892 ☐ PTO/SB/08 ☒ Other: PTO-1449

1. ☒ The request for *inter partes* reexamination is GRANTED.

☒ An Office action is attached with this order.

☐ An Office action will follow in due course.

2. ☐ The request for *inter partes* reexamination is DENIED.

This decision is not appealable. 35 U.S.C. 312(c). Requester may seek review of a denial by petition to the Director of the USPTO within ONE MONTH from the mailing date hereof. 37 CFR 1.927. EXTENSIONS OF TIME ONLY UNDER 37 CFR 1.183. In due course, a refund under 37 CFR 1.26(c) will be made to requester.

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

## DECISION GRANTING INTER PARTES REEXAMINATION

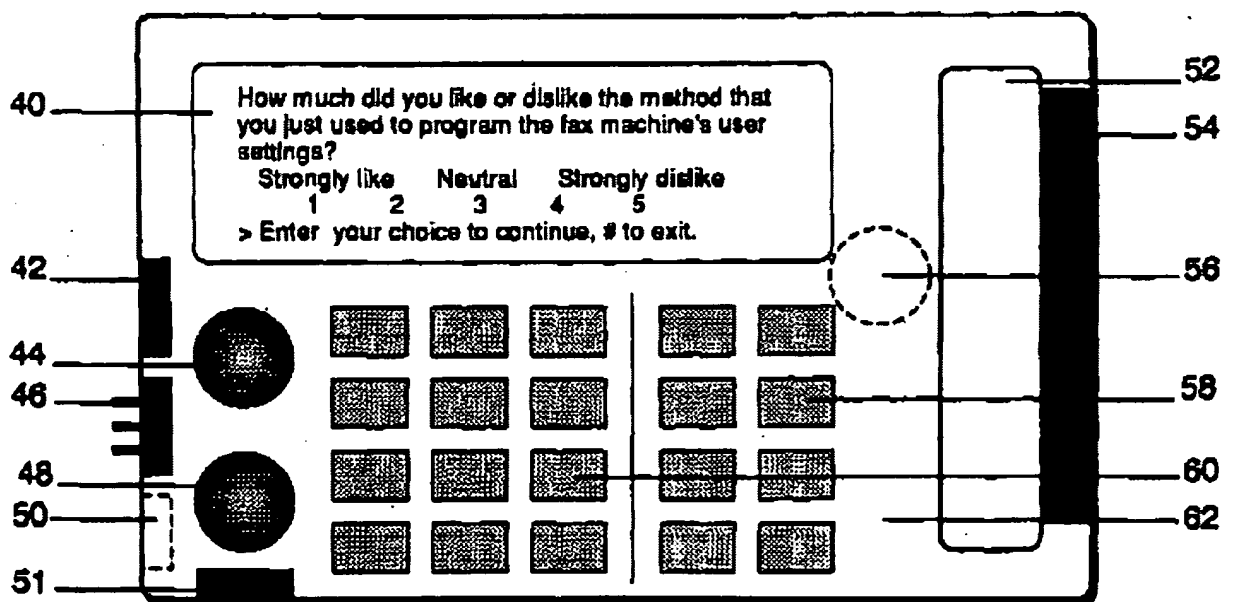
A substantial new question of patentability affecting claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of U.S. Patent Number 7,222,078 is raised by the request for *inter partes* reexamination filed 12 August 2011. Claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 are subject to reexamination.

### *Prosecution History*

U.S. Patent 7,222,078 ("the '078 patent") issued on 22 May 2007, from application number 10/734,201, filed 10 December 2003. The patent is a continuation of application 09/370,663, filed 6 August 1999, which was a continuation of application 08/934,457, filed 19 September 1997, now U.S. Patent 5,999,908 ("the '908 patent"), which was a continuation of application 08/243,638, filed 16 May 1994, which was a continuation-in-part of application 07/926,333, filed 6 August 1992.

The '078 patent is drawn to a system having the ability to obtain action and behavioral information during the actual use of products, services and information systems in order to aid in product design decisions (col. 1, lines 50-57), and to learn interactively and iteratively from the users of products and information systems

anywhere in the world while they are in use - without having to travel to their sites and without having to bring them to a testing laboratory (see col. 2, lines 36-41). It includes a Customer-Based Product Design Module (CB-PD Module) which produces a continuous source of Aggregated Customer Desires (ACD) and Defined Customer Desires (DCD) from customers and users while they are using these products and services, and allows vendors to continuously listen to Customers and understand their performance, their needs and their expectations (see col. 9, lines 40-50). One embodiment of the invention is illustrated in drawing Figure 2.



**FIG. 2**

The patent application was filed with 47 claims, including independent claims 1, 23 and 43. A preliminary amendment was filed, canceling claims 1-47, and adding new claims 48-139, including independent claims 48, 90, 98, 108, 109, 110, 118, 119, 120, 121 and 135.

#### First Action

In the first Office action, the examiner rejected all claims 48-139 in view of prior art.

#### First Amendment

In their response, the Patent Owner canceled claim 102 and added new claim 140. They also made a number of clarifying amendments which did not substantially alter the scope of the claims.

In addition, the Patent Owner argued that, regarding claim 48, the prior art failed to teach

“...units of a commodity that are used by respective users in different locations,

A user interface which is part of each of the units of the commodity, provides a medium for two-way local interaction between one of the users and the corresponding unit of the commodity, and is configured to elicit, from a user, information about the user's perception of the commodity...”

The Patent Owner further argued that, regarding claim 98, that the prior art failed to teach

“a user interface...[that] is configured to elicit information about (i) steps that a vendor of the commodity could take to improve the user’s satisfaction or (ii) training or support provided for users of the commodity”

The Patent Owner also argued that, regarding claim 135, the prior art failed to teach

“eliciting users for their perceptions of respective units of commodity”

#### Final Rejection

In the Final Rejection, the examiner allowed independent claims 48, 98 and 135, and their respective dependent claims. Claims 90, 91, 93-96, 108-121, 130 and 134 were rejected in view of newly applied prior art, while claims 92 and 97 were cited as including allowable subject matter.

There was also an obviousness-type double patenting rejection made of claim 48, based upon claim 1 of the '908 patent.



After Final Amendment

The Patent Owner filed an after final amendment, seeking to more substantially amend the claims. Also filed was a Terminal Disclaimer directed to the '908 patent, which was subsequently approved.

Advisory Action

The examiner refused entry of the Patent Owner's after final amendment, as changing the scope and requiring additional search and consideration.

Request for Continuing Examination

The Patent Owner filed an RCE, requesting entry of the previously submitted after final amendment.

The amendment canceled claims 91, 92, 108-121, 130 and 134. The features of canceled claim 92 were incorporated into independent claim 90.

Non-Final Rejection

The examiner allowed independent claims 48, 90 and 98, along with their respective dependent claims. Independent claim 135 and dependent claims 136-140 were rejected as indefinite under 35 U.S.C. § 112, second paragraph.

Amendment

The Patent Owner amended claims 135 to address the issue raised by the examiner; no other claims were amended.

Notice of Allowance

The examiner allowed independent claims 48, 90, 98 and 135, as well as their respective independent claims.

The examiner indicated the following reasons for allowance which are relevant to this reexamination proceeding:

Regarding claim 48 (which issued as claim 1), the prior art fails to teach:

“a user interface which is part of each of the units of the commodity, configured to provide a medium for two-way local interaction between one of the users and the corresponding unit of the commodity, and further configured to elicit, from a user, information about the user's perception of the commodity, and a memory within each of the units of the commodity capable of storing results of the two-way local interaction, the results including the elicited information about user perception of the commodity”

Regarding claim 135 (which issued as claim 69), the prior art fails to teach:

“eliciting user perceptions of respective units of the commodity through interactions at a user interface of the respective unit, and collecting and storing the received information at the remote database”

### *The Substantial New Question*

At the time of allowance, the examiner cited clear reasons for allowance for independent claims 48 (issued claim 1) and 135 (issued claim 69), pointing out those features not taught in the prior art made of record during prosecution of the application.

Prior art which teaches or suggests these features would therefore raise a substantial new question of patentability.

### *Prior Art*

The following prior art is cited by the Third Party Requester in alleging a substantial new question of patentability:

U.S. Patent 5,003,384 to Durden et al. (“**Durden**”)

U.S. Patent 5,077,582 to Kravette et al. (“**Kravette**”)

U.S. Patent 4,992,940 to Dworkin et al. (“**Dworkin**”) \*

U.S. Patent 5,477,262 to Banker et al. (“**Banker**”)

U.S. Patent 5,956,505 to Manduley ("**Manduley**")

\* Cited during prosecution of the '078 patent.

*Proposed Substantial New Questions of Patentability*

The Third Party Requester has requested reexamination of claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent, based upon the following allegations of a substantial new question or patentability based upon the following proposed rejections:

Issue 1: Claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 are anticipated under 35 U.S.C. § 102(b) by **Durden**.

Issue 2: Claims 1-7, 10, 15, 16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 are anticipated under 35 U.S.C. § 102(e) by **Kravette**.

Issue 3: Claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 are anticipated under 35 U.S.C. § 102(b) by **Dworkin**.

Issue 4: Claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 are anticipated under 35 U.S.C. § 102(e) by **Banker**.

Issue 5: Claims 1-7, 10, 15, 16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 are anticipated under 35 U.S.C. § 102(e) by **Manduley**.

### *Analysis*

The examiner agrees that based upon the following analysis, the teachings of the cited prior art raises a substantial new question of patentability with regard to claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent.

#### **Preliminary Issue: Claim Construction**

The claims at issue in the '078 patent include some terms which require clarification in order to correctly analyze the prior art's applicability in determining a Substantial New Question of Patentability. In particular, the terms 'unit of a commodity' and 'user' will be considered.

#### **Commodity**

The term 'commodity' appears in the Abstract and the claims, but nowhere in the body of the specification.

A survey of the parent and other preceding applications shows that the term 'commodity' was first introduced in a preliminary amendment to the parent application, 09/370,663. The originally filed claims used the terms 'product', but a preliminary amendment filed concurrently with the application canceled the original claims and added new claims which used the term 'units of a commodity' in place of 'product'. The change in terminology from 'product' to 'units of a commodity' was therefore not necessitated in order to distinguish over prior art.

The independent claims of the '078 patent, for the most part, use the term 'units of a commodity'. The exception is independent claim 54, which uses the term 'units of a facsimile equipment'. Dependent claim 8 also includes the feature that the commodity is a facsimile machine. In light of these claims, 'facsimile equipment' is presumably one example of a commodity.

Dependent claim 6 includes the feature that the unit of a commodity comprises 'telephone extension equipment'. Claim 11 includes the feature that the unit of a commodity comprises 'consumer television equipment'. Claim 50 includes the feature that the commodity is a 'demonstration unit'.

In the Background of the Invention, the invention is characterized as a Customer-Based Product Design Module (see col. 2, line 22 et seq.), in which case the 'commodity'

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cited in the claims would equate to a 'product'. More generally, the claimed commodity is referred to in the Background variously as 'products, services and information systems' (see col. 1, lines 50-52), 'products and services' (see col. 2, line 25), and 'products, equipment, tools and toys' (col. 2, lines 46-49). A number of other examples are disclosed at col. 11, line 5 through col. 12, line 37.

Additionally, drawing Figure 1 comprises a flow chart of the Customer Design System (CDS), and includes the 'product or service' terminology.

Based upon this information, the term 'commodity' will be interpreted as a product or service, and a 'unit of a commodity' will be interpreted as a single instance of a product, or a single use of a service.

#### User

The term 'user' can be found throughout the claims and specification.

There is no explicit language in the specification which can be used to derive a definition, so the term should be given the ordinary meaning that the term would have to an ordinary artisan in the art in question at the time of the invention. "Absent an express intent to impart a novel meaning to a claim term, the words take on the

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ordinary and customary meanings attributed to them by those of ordinary skill in the art." *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 (Fed Cir. 2003).

In the context of the specification and claims, a 'user' would be understood by an ordinary artisan as a person who uses a product or service.

#### **Issue 1: Durden**

Durden does not raise a substantial new question of patentability with regard to claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent, for the reasons discussed below.

**Durden** teaches an impulse pay-per-view (IPPV) system, whereby in a cable television system, a subscriber is allowed to order a premium program (for which said subscriber is billed an additional amount) at the last minute (see col. 1, lines 6-16).

**Durden** discloses the fact that each subscriber in the cable system is provided with a set-top terminal (STT), and that each STT is equipped with an IPPV module which allows the subscriber to authorize his STT to receive a pay-per-view event, store the data associated with the purchase of that event in memory, and transmit that stored data to the cable operator via a telephone network (see col. 6, lines 43-62). **Durden**



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additionally discloses the use of a hand-held remote by the subscriber to communicate with the set-top terminal (see col. 11, line 66 through col. 12, line 2).

In the Request, it is alleged that **Durden** raises a Substantial New Question of Patentability of claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent, because **Durden** anticipates these claims under 35 U.S.C. § 102(b).

As discussed above, with regard to independent claim 1, a reference would have to teach the following features in order to raise an SNQ:

“a user interface which is part of each of the units of the commodity, configured to provide a medium for two-way local interaction between one of the users and the corresponding unit of the commodity, and further configured to elicit, from a user, information about the user's perception of the commodity, and  
a memory within each of the units of the commodity capable of storing results of the two-way local interaction, the results including the elicited information about user perception of the commodity”

Similarly, with regard to independent claim 69, a reference would have to teach the following features in order to raise an SNQ:

“eliciting user perceptions of respective units of the commodity through interactions at a user interface of the respective unit, and  
collecting and storing the received information at the remote database”

With respect to claim 1, the Requestor maps the set-top terminal (STT) disclosed by **Durden** to the claimed *unit of a commodity* (see page 36 of the Request).

The Requestor also maps the hand-held remote control disclosed in **Durden** to the claimed *user interface* (see page 37 of the Request).

The Requestor further maps **Durden's** disclosure of the subscriber's use of the hand-held remote control to authorize a purchase of a pay-per-view program to the claimed *eliciting, from a user, information about the user's perception of the commodity* (see pages 38 and 39 of the Request).

However, this mapping of features of **Durden** to claim 1 of the '078 patent does not support the Requester's alleged anticipation of the claim.

The Requestor has mapped the set-top terminal to the *unit of the commodity*, but mapped the selection of a desired pay-per-view program to *information about the user's perception of the commodity*.

The selection by a subscriber of a desired pay-per-view program reflects information about the subscriber's perception of content conveyed by the cable system through the set-top terminal, not the user's perception of the set-top terminal. In order to anticipate claim 1, **Durden** would have to disclose a user interface to elicit

information from the subscriber about the subscriber's perception of the set-top terminal.

The same analysis applies to the Requestor's proposed rejection of independent claim 69 of the '078 patent over **Durden** (see pages 66-75 of the Request).

The Requester's proposed rejection is actually analogous to the rejection made by the examiner in the first action during prosecution of the '078 patent. This rejection was successfully rebutted by the Patent Owner in their response (see Patent Owner's response, filed 29 September 2005, pages 26-27).

The rejection was based upon U.S. Patent 5,237,157 to **Kaplan**. **Kaplan** disclosed a music kiosk that included a user interface to allow a user to preview music and provide feedback in the form of a rating.

The Patent Owner successfully argued the following points:

1. If the examiner equated the music CDs with the units of the commodity, the rejection cannot be sustained, because the music CDs do not each contain a user interface; and

2. If the examiner equated the music kiosk with the unit of the commodity, the rejection cannot be sustained, because the user is providing feedback on their perception of the music CDs, and not on their perception of the music kiosk.

Regarding the system disclosed by **Kaplan**, the disclosed system could not anticipate the claimed invention, because the user was providing feedback on content being delivered by the unit of the commodity, and not on the unit of the commodity itself.

The rejections proposed by the Requestor based on **Durden** are analogously flawed, and cannot be sustained.

In light of these teachings, a reasonable examiner would not consider **Durden** important in deciding whether or not claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent are patentable. Therefore, **Durden** does not raise a substantial new question of patentability with respect to claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent.

**Issue 2: Kravette**

Kravette raises a substantial new question of patentability with regard to claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent, for the reasons discussed below.

Kravette teaches a system for monitoring paper processing devices, such as photocopiers (see Abstract). In accordance with the disclosed invention, photocopiers generate diagnostic signals when a malfunction is detected, or when maintenance such as toner or paper refill is required (see col. 4, lines 42-46). Said diagnostic signals are translated to a signal usable by an offsite end user to determine the condition of the photocopier (see col. 4, lines 50-55).

Upon receipt of a diagnostic signal a central station then dispatches a service person and informs the service person of the nature of the problem (see col. 9, lines 36-40). Each service person may be equipped with a portable hand held input/output device in the form of a keypad/display which may become part of the monitoring system through the use of an auxiliary input of the monitoring CPU (see col. 9, lines 41-44). The service person at the job site may also communicate with the central station through a modem by becoming part of the monitoring system through an input/output device; the service person would input his time of arrival at the job site, the work

completed, parts replaced and needed, and the time of completion of the job (see col. 9, lines 49-55).

The central station may also communicate with the service person directly through the photocopier monitoring system (see col. 9, lines 59-67).

In the Request, it is alleged that **Kravette** raises a Substantial New Question of Patentability of claims 1-7, 10, 15, 16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent, because **Kravette** anticipates these claims under 35 U.S.C. § 102(e).

As discussed above, with regard to independent claim 1, a reference would have to teach the following features in order to raise an SNQ:

“a user interface which is part of each of the units of the commodity, configured to provide a medium for two-way local interaction between one of the users and the corresponding unit of the commodity, and further configured to elicit, from a user, information about the user's perception of the commodity, and a memory within each of the units of the commodity capable of storing results of the two-way local interaction, the results including the elicited information about user perception of the commodity”

Similarly, with regard to independent claim 69, a reference would have to teach the following features in order to raise an SNQ:

“eliciting user perceptions of respective units of the commodity through interactions at a user interface of the respective unit, and

collecting and storing the received information at the remote database”

With respect to claim 1, the Requestor maps the photocopier disclosed by **Kravette** to the claimed *unit of a commodity* (see page 76 of the Request).

The Requestor also maps the portable hand held input/output device 34 disclosed in **Kravette** to the claimed *user interface* (see page 77 of the Request).

The Requestor further maps **Kravette's** disclosure of the service person's use of the portable hand held input/output device 34 to input and retrieve diagnostic and maintenance information from the monitoring system to the claimed *eliciting, from a user, information about the user's perception of the commodity* (see page 79 of the Request).

Three issues must be resolved with regard to this proposed rejection.

1. Does the service person disclosed by **Kravette** qualify as a 'user'?

Given the broad interpretation given the term 'user' as described above with respect to claim construction, the service person, 'using' the monitoring system to input and retrieve diagnostic data and service information (see col. 9, lines 14-20), as well as to communicate with the central station (see col. 9, lines 49-52), would qualify as a 'user'.

2. Does the user interface elicit information about the user's perception of the commodity?

**Kravette** discloses the service person providing input to the monitoring system regarding at least maintenance information, such as data related to recent service and data as to when certain copier parts were replaced (see col. 9, lines 14-20). The service person also inputs information regarding his time of arrival at the job site, the work completed, parts replaced and needed, and the time of completion of the job (see col. 9, lines 52-55).

Of this information disclosed by **Kravette** as being submitted by the service provider through portable hand held input/output device 34, *at least information regarding parts replaced and needed* would anticipate the claimed feature of 'information about the user's perception of the commodity', since this information about parts replaced and needed by the photocopier must be perceived by the service person.

3. Is the user interface 'part of each of the units of the commodity', as required by claim 1?

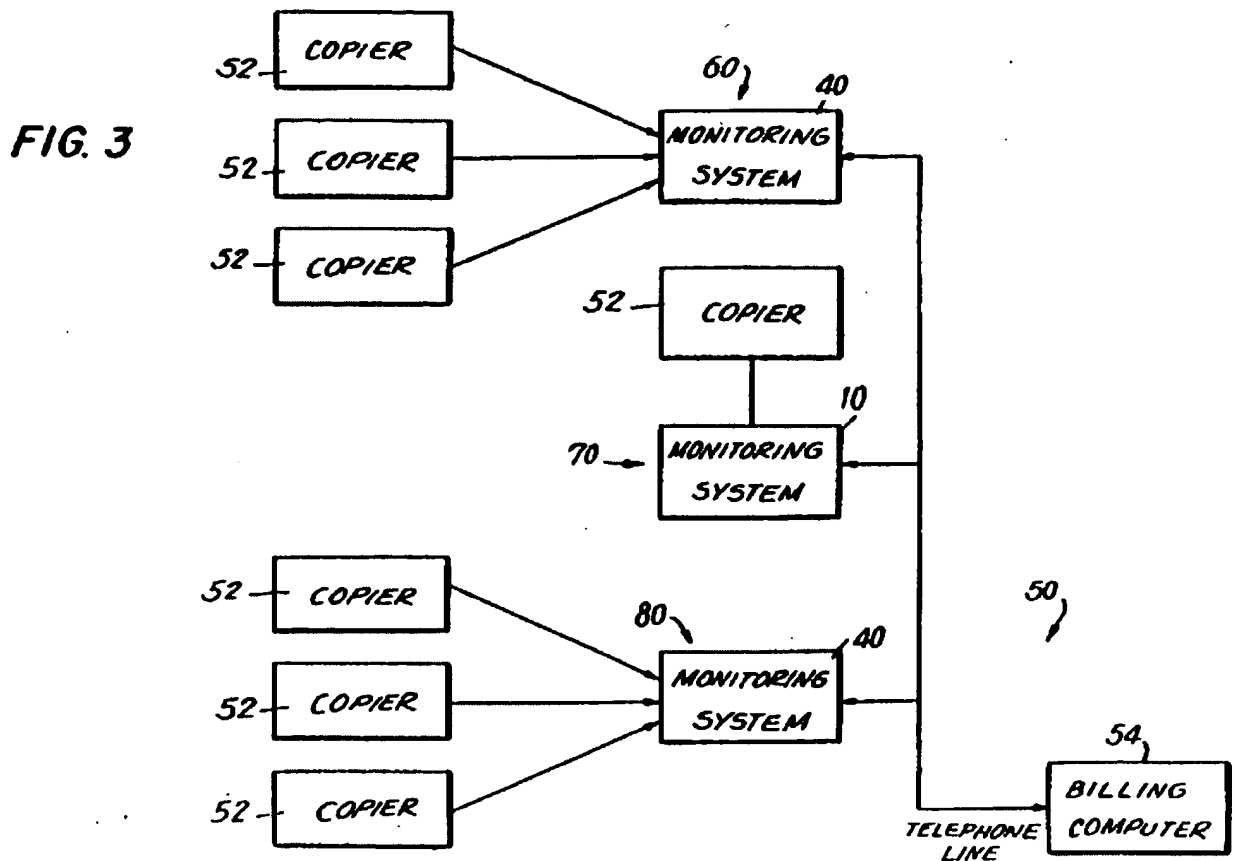
Throughout the specification and drawings of **Kravette**, the photocopier monitoring system 10 is depicted as separate from the photocopier. See, for example,



drawing Figures 1, 2, 3 and 4. See also, for example, disclosure that Interface 12 of the photocopier monitoring system "receives signals from a copier (not shown)", col. 5, lines 12-13.

Given this disclosure, **Kravette** could not be relied upon to anticipate claim 1, since the portable hand held input/output device (the user interface) becomes part of the *monitoring system*, but elicits information from the user regarding the user's perceptions of the photocopier (the unit of the commodity); anticipation would require the user to input information regarding the user's perception of the *monitoring system*.

However, at col. 11, lines 1-4, **Kravette** discloses monitoring system 60, which includes a plurality of copiers 52 and a photocopier monitoring system 40. This is illustrated in drawing Figure 3:



When monitoring system 60 (encompassing both the photocopier monitoring system 40 and all attached copiers 52) is mapped to the claimed 'unit of the commodity', **Kravette** then anticipates claim 1, since the user interface becomes part of the unit of the commodity (the monitoring system 60), and elicits information regarding the user's perception of the unit of the commodity (since the copier is part of monitoring system 60).

In fact, **Kravette** additionally discloses a more analogous embodiment of the disclosed invention. **Kravette** discloses one embodiment where "...the entire monitoring system is manufactured internal to the photocopier to which it is to be applied" (see col. 15, lines 18-21). In this embodiment, the portable hand held input/output device (the user interface) becomes part of the photocopier (by virtue of becoming part of the monitoring system), and elicits information from the user regarding the user's perceptions of the photocopier, thus anticipating this feature of claim 1 of the '078 patent.

The same analysis applies to the Requestor's proposed rejection of independent claim 69 of the '078 patent over **Kravette** (see pages 108-116 of the Request).

Thus, with respect to independent claim 1, **Kravette** teaches those features which were cited by the examiner as reasons for allowance during prosecution of the '078 patent.

**Kravette** teaches a user interface which is part of each of the units of the commodity (see disclosure of the portable hand held input/output device 34 becoming part of the monitoring system 10, col. 9, lines 41-44; see also disclosure of an embodiment where the monitoring system is manufactured internal to the photocopier,

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col. 15, lines 18-21), configured to provide a medium for two-way local interaction between one of the users and the corresponding unit of the commodity, and further configured to elicit, from a user, information about the user's perception of the commodity (see disclosure that the service person can input time of arrival at the job site, the work completed, parts replaced and needed, and the time of completion of the job, col. 9, lines 52-55), and

a memory within each of the units of the commodity capable of storing results of the two-way local interaction, the results including the elicited information about user perception of the commodity (see disclosure that the diagnostic data of the photocopier can be stored in RAM 29, which can also store maintenance information, such as data related to recent service and data as to when certain copier parts were replaced, col. 9, lines 14-18).

With respect to independent claim 69, **Kravette** teaches those features which were cited by the examiner as reasons for allowance during prosecution of the '078 patent.

**Kravette** teaches eliciting user perceptions of respective units of the commodity through interactions at a user interface of the respective unit (see disclosure that the

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service person can input time of arrival at the job site, the work completed, parts replaced and needed, and the time of completion of the job, col. 9, lines 52-55), and collecting and storing the received information at the remote database (see disclosure that the service person can communicate with the central station by inputting his time of arrival, work completed, parts replaced and needed, and the time of completion of the job, col. 9, lines 49-55; see also disclosure that the billing or other computer at the central station sends a status inquiry signal to the monitoring system 10 to output the diagnostic data and maintenance information for storage on said billing or other computer, col. 9, lines 23-28).

In light of these teachings, there is a substantial likelihood that a reasonable examiner would consider **Kravette** important in deciding whether or not claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent are patentable.

The teachings of **Kravette** are new and non-cumulative with respect to the teachings of the prior art applied during the prosecution of the '078 patent. Furthermore, the teachings of **Kravette** have not been considered in a final holding of invalidity by a federal court. Accordingly, **Kravette** raises a substantial new question of patentability with regard to claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 that has not been decided in a previous examination.

**Issue 3: Dworkin**

**Dworkin** raises a substantial new question of patentability with regard to claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent, for the reasons discussed below.

**Dworkin** teaches an automated system for assisting a user in locating and purchasing products or services having desired characteristics, and also having the best available price (see col. 1, lines 63-65). The user tells the system the general type of product or service desired, and in response the system displays a template which gives various technical criteria for the product or service (see col. 2, lines 6-11). The user fills out entries on the template to define the minimum requirements for the product or service, and the system locates and displays information regarding products or services meeting these requirements (see col. 2, lines 11-18).

The system also allows the user to communicate complaints or suggestions to management or a particular supplier, or to receive help in using the system (see col. 2, lines 42-46; see also col. 4, lines 56-58; see also col. 10, lines 9-17).

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In the Request, it is alleged that **Dworkin** raises a Substantial New Question of Patentability of claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent, because **Dworkin** anticipates these claims under 35 U.S.C. § 102(b).

As discussed above, with regard to independent claim 1, a reference would have to teach the following features in order to raise an SNQ:

“a user interface which is part of each of the units of the commodity, configured to provide a medium for two-way local interaction between one of the users and the corresponding unit of the commodity, and further configured to elicit, from a user, information about the user's perception of the commodity, and  
a memory within each of the units of the commodity capable of storing results of the two-way local interaction, the results including the elicited information about user perception of the commodity”

Similarly, with regard to independent claim 69, a reference would have to teach the following features in order to raise an SNQ:

“eliciting user perceptions of respective units of the commodity through interactions at a user interface of the respective unit, and  
collecting and storing the received information at the remote database”

With respect to claim 1, the Requestor maps the terminals disclosed by **Dworkin** to the claimed *unit of a commodity* (see page 121 of the Request).

The Requestor also maps the main menu on the user's terminal disclosed in **Dworkin** to the claimed *user interface* (see page 122 of the Request).

The Requestor further maps **Dworkin's** disclosure of the user's selection of menu item 8 in order to communicate with management in order to submit complaints or offer suggestions for improvements to the claimed *eliciting, from a user, information about the user's perception of the commodity* (see pages 124-125 of the Request).

Under such an interpretation, **Dworkin** would fail to anticipate the relevant features of the '078 patent, because the claims require the system to elicit the user's information about their perception of *the commodity*, which in this case would be the terminal.

That being said, when the automated system for assisting a user in locating and purchasing desired products or services is interpreted as the unit of the commodity, **Dworkin would** anticipate the relevant features, since the disclosed complaints and suggestions (the elicited information) refer to the system, said system being the unit of the commodity.

The same analysis applies to the Requestor's proposed rejection of independent claim 69 of the '078 patent over **Dworkin** (see pages 154-160 of the Request).



Thus, with respect to independent claim 1, **Dworkin** teaches those features which were cited by the examiner as reasons for allowance during prosecution of the '078 patent.

**Dworkin** teaches a user interface which is part of each of the units of the commodity (see disclosure of the Main Menu, which is part of the automated system for assisting a user in locating and purchasing desired products or services, col. 4, lines 43-61; see also drawing Figure 3), configured to provide a medium for two-way local interaction between one of the users and the corresponding unit of the commodity, and further configured to elicit, from a user, information about the user's perception of the commodity (see disclosure of item number 8 of the Main Menu, which allows the user to communicate complaints or suggestions to management or a particular supplier, or to receive help in using the system, col. 2, lines 42-46; see also col. 4, lines 56-58; see also col. 10, lines 9-17), and

a memory within each of the units of the commodity capable of storing results of the two-way local interaction, the results including the elicited information about user perception of the commodity (see disclosure that the user-supplied communication, comprising complaints or suggestions, can be embodied in an electronic mail message,

said electronic mail message inherently requiring memory for storage prior to transmission, col. 9, lines 9-12).

With respect to independent claim 69, **Dworkin** teaches those features which were cited by the examiner as reasons for allowance during prosecution of the '078 patent.

**Dworkin** teaches eliciting user perceptions of respective units of the commodity through interactions at a user interface of the respective unit (see disclosure of item number 8 of the Main Menu, which allows the user to communicate complaints or suggestions to management or a particular supplier, or to receive help in using the system, col. 2, lines 42-46; see also col. 4, lines 56-58; see also col. 10, lines 9-17), and

collecting and storing the received information at the remote database (see disclosure that the user-supplied communication, comprising complaints or suggestions, can be embodied in an electronic mail message transmitted to an electronic mailbox, col. 9, lines 9-12).

In light of these teachings, there is a substantial likelihood that a reasonable examiner would consider **Dworkin** important in deciding whether or not claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent are patentable.

The teachings of **Dworkin** are new and non-cumulative with respect to the teachings of the prior art applied during the prosecution of the '078 patent. **Dworkin** was cited during prosecution of the '078 patent, but was never applied in any claim rejections.

Furthermore, the teachings of **Dworkin** have not been considered in a final holding of invalidity by a federal court. Accordingly, **Dworkin** raises a substantial new question of patentability with regard to claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 that has not been decided in a previous examination.

#### **Issue 4: Banker**

**Banker** does not raise a substantial new question of patentability with regard to claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent, for the reasons discussed below.

**Banker** teaches an impulse pay-per-view (IPPV) system, whereby in a cable television system, a subscriber is allowed to order a premium program (for which said subscriber is billed an additional amount) at the last minute (see col. 12, lines 6-14).

**Banker** discloses the fact that each subscriber in the cable system is provided with a subscriber terminal 300, and that each subscriber terminal is equipped with an IPPV module which allows the subscriber to authorize his subscriber terminal to receive a pay-per-view event, store the data associated with the purchase of that event in memory, and transmit that stored data to the system operator via a telephone return path or radio frequency return path through the cable distribution system (see col. 12, lines 6-14).

In the Request, it is alleged that **Banker** raises a Substantial New Question of Patentability of claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent, because **Banker** anticipates these claims under 35 U.S.C. § 102(e).

However, the impulse pay-per-view system disclosed by **Banker** is analogous to the impulse pay-per-view system disclosed by **Durden** with respect to Issue 1 above.

As with the Requester's proposed rejection of claims 1 and 69 based on **Durden**, the Requester maps the subscriber terminals of **Banker** to the claimed 'units of the commodity' (see page 165 of the Request), and maps the selection of a pay-per-view program to the claimed 'eliciting from a user information about the user's perception of the commodity'.

As analogously discussed above regarding Issue 1 and **Durden**, the proposed rejection based on **Banker** cannot be supported, because the information elicited from the user is information regarding the user's perception of the content to be delivered by the IPPV system [the commodity], and not information regarding the user's perception of the IPPV system itself.

In light of these teachings, a reasonable examiner would not consider **Banker** important in deciding whether or not claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent are patentable. Therefore, **Banker** does not raise a substantial new question of patentability with respect to claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent.

#### **Issue 5: Manduley**

**Manduley raises a substantial new question of patentability** with regard to claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent, for the reasons discussed below.

**Manduley** teaches a method for activating an optional feature in a data processing device (see Abstract). The data processing device includes a display, keyboard and user interface software that allows a user to input data into the data processing device, and also allows the user to access application manager software which enables and controls access to the various applications resident in the data processing device (see col. 3, lines 41-44 and 57-65).

The data processing device includes a mechanism for allowing an authorized user to request activation of optional applications or features (see drawing Figures 3A through 3D; see also col. 5, line 2 through col. 7, line 39, and particularly col. 6, lines 1-8).

In the Request, it is alleged that **Manduley** raises a Substantial New Question of Patentability of claims 1-7, 10, 15, 16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent, because **Manduley** anticipates these claims under 35 U.S.C. § 102(e).

As discussed above, with regard to independent claim 1, a reference would have to teach the following features in order to raise an SNQ:

“a user interface which is part of each of the units of the commodity, configured to provide a medium for two-way local interaction between one of the users and the corresponding unit of the commodity, and further configured to elicit, from a user, information about the user's perception of the commodity, and

a memory within each of the units of the commodity capable of storing results of the two-way local interaction, the results including the elicited information about user perception of the commodity”

Similarly, with regard to independent claim 69, a reference would have to teach the following features in order to raise an SNQ:

“eliciting user perceptions of respective units of the commodity through interactions at a user interface of the respective unit, and collecting and storing the received information at the remote database”

With respect to claim 1, the Requestor maps the data processing devices disclosed by **Manduley** to the claimed *unit of a commodity* (see page 207 of the Request).

The Requestor also maps display 26 and keyboard 28 on the data processing devices disclosed in **Manduley** to the claimed *user interface* (see page 209 of the Request).

The Requestor further maps **Manduley**’s disclosure of the user’s request for activation of an optional application program or their various features to the claimed *eliciting, from a user, information about the user’s perception of the commodity* (see page 210 of the Request).

The same analysis applies to the Requestor's proposed rejection of independent claim 69 of the '078 patent over **Manduley** (see pages 235-238 of the Request).

Thus, with respect to independent claim 1, **Manduley** teaches those features which were cited by the examiner as reasons for allowance during prosecution of the '078 patent.

**Manduley** teaches a user interface which is part of each of the units of the commodity (see disclosure of the data processing device [unit of the commodity] which includes a display, keyboard and user interface software [collectively, the user interface] that allows a user to input data into the data processing device, and also allows the user to access application manager software which enables and controls access to the various applications resident in the data processing device (see col. 3, lines 41-44 and 57-65), configured to provide a medium for two-way local interaction between one of the users and the corresponding unit of the commodity, and further configured to elicit, from a user, information about the user's perception of the commodity (see disclosure of the receipt of an optional application or feature activation request, col. 2, lines 63-67 et seq.), and

a memory within each of the units of the commodity capable of storing results of the two-way local interaction, the results including the elicited information about user



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perception of the commodity (see disclosure of the storage of request codes identifying the requested features and/or applications, as well as any required hardware, prior to transmission of the request to the data center, col. 6, lines 10-50 and 55-60).

With respect to independent claim 69, **Manduley** teaches those features which were cited by the examiner as reasons for allowance during prosecution of the '078 patent.

**Manduley** teaches eliciting user perceptions of respective units of the commodity through interactions at a user interface of the respective unit (see disclosure of the receipt of an optional application or feature activation request, col. 2, lines 63-67 et seq.), and

collecting and storing the received information at the remote database (see disclosure that the data center receives request codes from users or devices, col. 7, lines 40-45; see also disclosure that upon activation of the requested application or feature, the data center updates the customer's file to reflect activation of the requested programs or features and addition of any ordered hardware, col. 8, lines 18-21).

In light of these teachings, there is a substantial likelihood that a reasonable examiner would consider **Manduley** important in deciding whether or not claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent are patentable.

The teachings of **Manduley** are new and non-cumulative with respect to the teachings of the prior art applied during the prosecution of the '078 patent.

Furthermore, the teachings of **Manduley** have not been considered in a final holding of invalidity by a federal court. Accordingly, **Manduley** raises a substantial new question of patentability with regard to claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 that has not been decided in a previous examination.

### *Conclusion*

Extensions of time under 37 CFR 1.136(a) will not be permitted in *inter partes* reexamination proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to the patent owner in a reexamination proceeding. Additionally, 35 U.S.C. 314(c) requires that *inter partes* reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.937). Patent owner extensions of time in *inter partes* reexamination proceedings are provided for in 37 CFR 1.956. Extensions of time are not available for third party requester comments, because a comment period of 30 days from service of patent owner's response is set by statute. 35 U.S.C. 314(b)(3).

The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 7,222,078 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.

All correspondence relating to this *inter partes* reexamination proceeding should be directed:

By EFS-Web: Registered Users may submit correspondence via EFS-Web, at <https://efs.uspto.gov/efile/myportal/efs-registered>.

By Mail to: Mail Stop *Inter Partes* 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

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EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft-scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submission after the "soft scanning" process is complete.

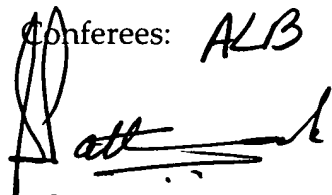
Art Unit: 3992

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



Luke S. Wassum  
Primary Examiner  
Art Unit 3992

Conferees: ALB



SUDHANSHU C. PATHAK  
SPE, CRU 3992

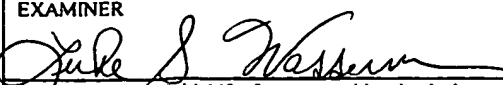
lsw

20 September 2011

<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> Form PTO-SB08 (Use several sheets if necessary)				COMPLETE IF KNOWN	
				Application Number	Not Yet Assigned 95/000 639
				Confirmation Number	Not Yet Assigned
				Filing Date	December 10, 2003
				First Named Inventor	Daniel H. Abelow
				Group Art Unit	Not Yet Assigned
Examiner Name	Not Yet Assigned				
Sheet	1	of	1	Attorney Docket No.	13557-105161.R1

U.S. PATENT DOCUMENTS						
Examiner Initials*	Cite No.	U.S. Patent or Application		Name of Patentee or Inventor of Cited Document	Date of Publication or Filing Date of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		NUMBER	Kind Code (if known)			
DPN	AA	5,003,384		Durden	03-26-1991	
	BA	5,077,582		Kravette	12-31-1991	
	CA	4,992,940		Dworkin	02-12-1991	
	DA	5,477,262		Banker	12-19-1995	
✓	EA	5,956,505		Manduley	09-21-1999	

FOREIGN PATENT DOCUMENTS								
Exami ner Initials*	Cite No.	Foreign Patent or Application			Name of Patentee or Applicant of Cited Document	Date of Publication or Filing Date of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T
		Office	NUMBER	Kind Code (if known)				

EXAMINER 	DATE CONSIDERED 9 September 2011
*EXAMINER: Initial if reference considered, whether or not criteria 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 application(s).	




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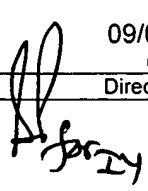
## BIB DATA SHEET

CONFIRMATION NO. 3851

<b>SERIAL NUMBER</b> 95/000,639	<b>FILING or 371(c) DATE</b> 08/12/2011 <b>RULE</b>	<b>CLASS</b> 705	<b>GROUP ART UNIT</b> 3992	<b>ATTORNEY DOCKET NO.</b> 13557-105161.R1
<b>APPLICANTS</b> 7222078, Residence Not Provided; LODSYS, LLC(OWNER), MARSHALL, TX; GOOGLE INC.(3RD.PTY.REQ.), MOUNTAIN VIEW, CA; GOOGLE INC.(REAL PTY IN INTEREST), MOUNTAIN VIEW, CA; KING & SPALDING LLP, BELMONT, CA				
<b>** CONTINUING DATA *****</b> This application is a REX of 10/734,102 12/10/2003 PAT 7,222,078 which is a CON of 09/370,663 08/06/1999 ABN which is a CON of 08/934,457 09/19/1997 PAT 5,999,908 which is a CON of 08/243,638 05/16/1994 ABN which is a CIP of 07/926,333 08/06/1992 ABN				
<b>** FOREIGN APPLICATIONS *****</b>				
<b>** IF REQUIRED, FOREIGN FILING LICENSE GRANTED **</b>				
Foreign Priority claimed <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No 35 USC 119(a-d) conditions met <input checked="" type="checkbox"/> Yes <input type="checkbox"/> No Verified and Acknowledged <i>[Signature]</i> Examiner's Signature	<input type="checkbox"/> Met after Allowance Initials	<b>STATE OR COUNTRY</b>	<b>SHEETS DRAWINGS</b>	<b>TOTAL CLAIMS</b>
<b>INDEPENDENT CLAIMS</b>				
<b>ADDRESS</b> THE LAW OFFICE OF JONATHAN M. WALDMAN LLC P.O. BOX 4124 MEADOWBROOK, PA 19046 UNITED STATES				
<b>TITLE</b> METHODS AND SYSTEMS FOR GATHERING INFORMATION FROM UNITS OF A COMMODITY ACROSS A NETWORK				
<b>FILING FEE RECEIVED</b>	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	

<b>Reexamination</b> 	<b>Application/Control No.</b> 95000639	<b>Applicant(s)/Patent Under Reexamination</b> 7222078
	<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>
KING & SPALDING LLP P.O. BOX 889 BELMONT, CA 94002-0889		

<b>LITIGATION REVIEW</b> <input checked="" type="checkbox"/>	/lsw/ (examiner initials)	09/02/2011 (date)
Case Name	Director Initials	
Numerous; 13 open pending litigations. See Litigation Search.		

COPENDING OFFICE PROCEEDINGS	
TYPE OF PROCEEDING	NUMBER

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<b>Search Notes</b> 	<b>Application/Control No.</b> 95000639	<b>Applicant(s)/Patent Under Reexamination</b> 7222078
	<b>Examiner</b> LUKE S WASSUM	<b>Art Unit</b> 3992

SEARCHED			
Class	Subclass	Date	Examiner

SEARCH NOTES		
Search Notes	Date	Examiner
Reviewed Prosecution History/File Wrapper of application 10/734,102	9-12 September 2011	lsw

INTERFERENCE SEARCH			
Class	Subclass	Date	Examiner

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/000,639	08/12/2011	7222078	13557-105161.R1	3851
70646 7590 09/28/2011 THE LAW OFFICE OF JONATHAN M. WALDMAN LLC P.O. BOX 4124 MEADOWBROOK, PA 19046			EXAMINER WASSUM, LUKE S	
			ART UNIT 3992	PAPER NUMBER
			MAIL DATE 09/28/2011	DELIVERY MODE 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  
KING & SPALDING LLP  
P.O. BOX 889  
BELMONT, CA 94002-0889

Date: **MAILED**

**SEP 28 2011**

**CENTRAL REEXAMINATION UNIT**

**Transmittal of Communication to Third Party Requester  
Inter Partes Reexamination**

REEXAMINATION CONTROL NO. : 95000639  
PATENT NO. : 7222078  
TECHNOLOGY CENTER : 3999  
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified Reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

<b>OFFICE ACTION IN INTER PARTES REEXAMINATION</b>	Control No.	Patent Under Reexamination
	95/000,639	7222078
	Examiner	Art Unit
	LUKE S. WASSUM	3992

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

Responsive to the communication(s) filed by:

Patent Owner on \_\_\_\_\_

Third Party(ies) on 12 August, 2011

**RESPONSE TIMES ARE SET TO EXPIRE AS FOLLOWS:**

*For Patent Owner's Response:*

2 MONTH(S) from the mailing date of this action. 37 CFR 1.945. EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.956.

*For Third Party Requester's Comments on the Patent Owner Response:*

30 DAYS from the date of service of any patent owner's response. 37 CFR 1.947. NO EXTENSIONS OF TIME ARE PERMITTED. 35 U.S.C. 314(b)(2).

**All correspondence** relating to this inter partes 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.

This action is not an Action Closing Prosecution under 37 CFR 1.949, nor is it a Right of Appeal Notice under 37 CFR 1.953.

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

1. ☐ Notice of References Cited by Examiner, PTO-892
2. ☐ Information Disclosure Citation, PTO/SB/08
3. ☒ PTO-1449

**PART II. SUMMARY OF ACTION:**

- 1a. ☒ Claims See Continuation Sheet are subject to reexamination.
- 1b. ☒ Claims 8, 9, 17, 19-21, 23, 26-29, 33-37, 39-45, 49 and 54-68 are not subject to reexamination.
2. ☐ Claims \_\_\_\_\_ have been canceled.
3. ☒ Claims 7, 12-15, 18 and 70 are confirmed. [Unamended patent claims]
4. ☐ Claims \_\_\_\_\_ are patentable. [Amended or new claims]
5. ☒ Claims 1-6, 10, 11, 16, 22, 24, 25, 30-32, 38, 46-48, 50-53, 69 and 71-74. are rejected.
6. ☐ Claims \_\_\_\_\_ are objected to.
7. ☐ The drawings filed on \_\_\_\_\_ ☐ are acceptable ☐ are not acceptable.
8. ☐ The drawing correction request filed on \_\_\_\_\_ is: ☐ approved. ☐ disapproved.
9. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119 (a)-(d). The certified copy has:  
☐ been received. ☐ not been received. ☐ been filed in Application/Control No 95000639.
10. ☐ Other \_\_\_\_\_

<b>Transmittal of Communication to Third Party Requester Inter Partes Reexamination</b>	Control No.	Patent Under Reexamination
	95/000,639	7222078
	Examiner	Art Unit
	LUKE S. WASSUM	3992

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

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

**All correspondence** relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

## DETAILED ACTION

### *Inter Partes Reexamination*

This Office action addresses claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of U.S. Patent Number 7,222,078, subject to reexamination in accordance with the accompanying Order Granting Inter Partes Reexamination.

The examiner notes that independent claim 1 has dependent claims that are not subject to reexamination.

The Patent Owner is reminded that in order to avoid unnecessary narrowing of the current scope of those dependent claims not subject to reexamination, any amendments to independent claim 1 should be made by:

- Canceling independent claim 1;
- Adding an amended version of independent claim 1 as a new claim; and
- Amending those dependent claims subject to reexamination to depend from the new claim.

See MPEP § 2260.01.

*Prior Art*

The following prior art raises a Substantial New Question of Patentability, as discussed in the Order Granting Inter Partes Reexamination:

U.S. Patent 5,077,582 to Kravette et al. ("**Kravette**")

U.S. Patent 4,992,940 to Dworkin et al. ("**Dworkin**")

U.S. Patent 5,956,505 to Manduley ("**Manduley**")

*Relevant Statutes*

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 –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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:

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(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.

### *Proposed Rejections*

The Third Party Requester has proposed the following rejections of claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 of the '078 patent:

1. The request proposes that claims 1-7, 10, 15, 16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 are anticipated under 35 U.S.C. § 102(e) by **Kravette**.
2. The request proposes that claims 1-7, 10-16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 are anticipated under 35 U.S.C. § 102(b) by **Dworkin**.
3. The request proposes that claims 1-7, 10, 15, 16, 18, 22, 24, 25, 30-32, 38, 46-48, 50-53 and 69-74 are anticipated under 35 U.S.C. § 102(e) by **Manduley**.

The proposed rejections 1, 2 and 3 are adopted, as modified, for the reasons set forth below.

### *Claim Rejections - 35 USC § 102*



Claims 1-3, 5, 6, 16, 22, 25, 30-32, 38, 46-48, 50-53, 69, 71, 72 and 74 are anticipated under 35 U.S.C. § 102(e) by **Kravette**.

The Third Party Requester has provided a detailed analysis and mapping of the features of **Kravette** to the claim elements of the '078 patent (see Request, pages 76-120, as well as Exhibit CC-B). The Requester's analysis and rationale for rejection of claims 1-3, 5, 6, 16, 22, 25, 30-32, 38, 46-48, 50-53, 69, 71, 72 and 74 is adopted by the examiner and is incorporated by reference, with the following modifications.

The Requester's proposed rejections of claims 4, 7, 10, 15, 18, 24, 70 and 73 are **not** adopted.

Regarding claims 1 and 69 (and their respective dependent claims), the Requester maps the plurality of copiers (see col. 11, lines 1-4 and drawing Figure 3 et seq.) to the claimed 'units of a commodity' (see Request, pages 76 [claim 1] and 108 [claim 69], as well as Exhibit CC-B, pages 1 [claim 1] and 25 [claim 69]). The examiner modifies this element by instead citing the monitoring system 60, which encompasses said plurality of copiers and a photocopier monitoring system, as corresponding to the claimed 'units of a commodity'. The examiner also cites the embodiment disclosed at col. 15, lines 18-21, whereby the entire monitoring system is manufactured internal to the photocopier, as corresponding to the claimed 'units of a commodity'.

Further regarding claims 1 and 69 (and their respective dependent claims), the Requester maps the transmission of billing data to the billing computer (see col. 3, lines 30-33) to the claimed 'results of the two-way local interaction carried from the units of the commodity to a central location' (see Request, pages 85 [claim 1] and 114-116 [claim 69], as well as Exhibit CC-B, pages 9-10 [claim 1] and 31-33 [claim 69]). The examiner clarifies the rejection by noting that billing information does not necessarily qualify as 'results of the two-way local interaction including elicited information about user perception of the commodity', since billing information is automatically accumulated at each copier, and is not input by the user. Only the information received from the service person via the portable hand held input/output device, including diagnostic data and maintenance information, such as data related to recent service and data as to when certain copier parts were replaced (see col. 9, lines 14-20 and 52-59) would qualify as the claimed 'results of the two-way local interaction including elicited information about user perception of the commodity'.

Regarding claims 2 and 3, the examiner notes that the 'user behavior' which triggers the two-way interaction would not include the pressing of the 'print' button, as cited by the Requester (see Request, pages 86-89 and Exhibit CC-B, pages 11-13) but would be limited to the service person's actions taken in connection with the portable

hand held input/output device [the user interface], such as physically connecting the device, turning the device on, and submitting commands to input/retrieve data to/from the RAM of the copier (see col. 9, lines 14-20 and 41-59 et seq.).

Regarding claim 4, the claim requires the system of claim 1 in which the user interface comprises part of a functional user interface of the unit of the commodity that can be used to control features of the commodity. The Requester has mapped Interface 104, illustrated in drawing Figures 4 and 6, to the claimed 'functional user interface of the unit of the commodity that can be used to control features of the commodity' (see Request, pages 89-90; see also Exhibit CC-B, pages 13-14).

Interface 104 is a hardware interface which intercepts signals from the copier, and formats the signal as necessary to make them compatible with monitoring CPU and RAM 102 (see col. 12, lines 21-61). Since the user cannot interact with Interface 104, this cannot be considered a *user* interface, and so cannot be mapped to the claimed 'functional user interface'.

Furthermore, the 'user interface' has been mapped to **Kravette's** portable hand-held input/output device 34, which clearly is not part of Interface 104.

The Requester's proposed rejection of claim 4 in view of **Kravette** is not adopted.

Regarding claim 5, the Requester maps the service person's communication with the central station (see col. 9, lines 49-52) to the claimed 'communication element [which] also carries information from a passive probe that monitor's the user's use of the commodity' (see Request, page 90; see also Exhibit CC-B, page 14). The examiner clarifies the rejection with the following remarks.

Previously, with regard to claim 1, modem 14 was mapped to the claimed 'communication element'. At col. 6, lines 40-48, **Kravette** discloses count detector 18 (the claimed 'passive probe that monitors the user's use of the commodity'), and the transmission of resulting count data to the billing center at predetermined intervals via model 14. This disclosure anticipates the features of claim 5.

Regarding claim 7, the claim requires that the results of the interactions are forwarded from the central location to a remote server for analysis. Previously, with regard to claim 1, **Kravette's** central station was mapped to the claimed 'central location'.

The Requester maps this claim to the transmission of information entered into the system by the service person to the central station (see Request, pages 92-93; see also Exhibit CC-B, pages 15-16). However, the claim requires the results of the interaction to be forwarded *from* the central location (**Kravette's** central station) to a remote server.

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There is no disclosure in **Kravette** analogous to the claimed 'remote server', nor a forwarding of accumulated interaction information to said remote server for analysis.

The Requester's proposed rejection of claim 7 in view of **Kravette** is not adopted.

Regarding claim 10, the claim requires that the two-way interaction provides instructions on how to use the commodity. Previously, with respect to claim 1, the two-way interaction was mapped to the service person's interaction with the copier through the use of the portable hand held input/output device.

The Requester maps the claim to the service person's receipt of 'further instructions' from the central station (see Request, page 93; see also Exhibit CC-B, page 16). However, a service person presumably would not need to contact the central station for instructions on how to service the copier, as argued by the Requester. Even if, *arguendo*, the disclosed 'further instructions' were interpreted as instructions on how to service the copier, this is still different from instructions on how to *use* the copier.

The Requester's proposed rejection of claim 10 in view of **Kravette** is not adopted.

Regarding claim 15, the claim requires the two-way interaction to be mediated by a publicly or privately accessible on-line computerized information service.

The Requester maps this claim to the transmission of diagnostic information, preventative maintenance information and end of service contract information to the billing computer (see Request, page 94; see also Exhibit CC-B, pages 16-17). However, **Kravette** discloses only a telephone connection between the modems of the copier and the billing computer at the central station (see drawing Figures 1, 2, 3 and 4 et seq.). There is no disclosure of the two-way interaction being 'mediated' in any way, and no disclosure of anything analogous to an on-line computerized information service.

The Requester's proposed rejection of claim 15 in view of **Kravette** is not adopted.

Regarding claim 18, the claim requires the user interface to present information in hypertext.

The Requester maps this claim to **Kravette's** disclosure of displaying messages to the service provider on the LED or LCD display of the portable hand held input/output device 34 (see Request, pages 95-96; see also Exhibit CC-B, pages 17-18). However, there is no disclosure in **Kravette** which mentions displaying information in any specific style, and no disclosure of the use of hypertext.

The Requester's proposed rejection of claim 18 in view of **Kravette** is not adopted.

Regarding claim 22, the claim requires the elicited information to be about the user's needs with respect to use of the commodity.

The Requester maps this feature to the entry of identification manually into the billing software program (see Request, pages 96-97; see also Exhibit CC-B, page 18). However, this action takes place at the central station, and cannot be performed by the service person (the claimed 'user') through a user interface that is part of the copier (the claimed 'unit of the commodity').

**Kravette**, however, does disclose the service person's ability to input maintenance information, including data such as when copier parts were replaced and what parts are needed (see col. 9, lines 14-20 and 49-55).

The input of data regarding parts needed by the copier anticipates the claimed 'elicited information about the user's needs with respect to use of the commodity'.

Regarding claim 24, the claim requires the interactions to comprise a transaction for sale of a product or a service contract for the commodity.

The Requester maps the claim to the disclosure of billing data and end of service contract data being transmitted from the photocopier monitoring system to the central station (see Request, page 97; see also Exhibit CC-B, pages 18-19). However, this data is

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transmitted automatically by the photocopier monitoring system; billing and end of service contract data is not interaction information which is elicited from the service person (the claimed 'user'), as required by the claim.

The Requester's proposed rejection of claim 24 in view of **Kravette** is not adopted.

Regarding claim 25, the claim requires that the interactions comprise a request for servicing of the commodity by the user.

The Requester maps the claim to **Kravette's** disclosure of the transmission of internally generated signals to report maintenance requirements such as toner and paper refill (see Request, page 98; see also Exhibit CC-B, page 19). However, to the extent that these may be automatically-generated signals from the copier, and not generated from interactions with the service person (the 'user'), this disclosure fails to anticipate the claim.

**Kravette**, however, does disclose the service person's ability to input maintenance information, including data such as when copier parts were replaced and what parts are needed (see col. 9, lines 14-20 and 49-55).

The input of data regarding parts needed by the copier anticipates the claimed 'interactions comprise a request for servicing of the commodity by the user'.



Regarding claim 32, this claim requires the component [for managing the interactions of the users in different locations] to provide access to the collection of interaction results to the vendors of the commodity.

The Requester maps this claim to the receipt of photocopier diagnostic, preventative maintenance and end of service contract information (see Request, pages 100-101; see also Exhibit CC-B, page 20). However, to the extent that these may be automatically-generated signals from the copier, and not generated from interactions with the service person (the 'user'), this disclosure fails to anticipate the claim.

**Kravette**, however, does disclose the service person's ability to input maintenance information, including data such as when copier parts were replaced and what parts are needed (see col. 9, lines 14-20 and 49-55), and the transmission of this information to the central station (the vendors of the commodity).

The compilation of interaction data from service persons (users) at various locations in the billing or other computers at the central station (the vendors of the commodity) anticipates the claimed 'component [for managing the interactions of the users in different locations] to provide access to the collection of interaction results to the vendors of the commodity'.

Regarding claim 47, the claim requires that the interaction information relate to a perception of a problem relating to the use of the product.

The Requestor maps this claim to the disclosure that the internal diagnostic circuits are monitored for signals indicating a malfunction to the copier has occurred, as well as the manual entry of updated data in the billing software program (see Request, pages 103-104; see also Exhibit CC-B, pages 22-23). However, to the extent that the monitored signals may be automatically-generated signals from the copier, and not generated from interactions with the service person (the 'user'), this disclosure fails to anticipate the claim. Furthermore, the updating of data on the billing system occurs at the central station; the data is not a result of interaction with the service person (the user), and so cannot anticipate the claim.

**Kravette**, however, does disclose the service person's ability to input maintenance information, including data such as when copier parts were replaced and what parts are needed (see col. 9, lines 14-20 and 49-55), and the transmission of this information to the central station.

The ability of service persons (users) to input maintenance information, such as required parts for the copier, anticipates the claimed 'interaction information relate[d] to a perception of a problem relating to the use of the product'.

Regarding claim 50, the examiner notes that using the unit of the commodity as a demonstration unit does not place any further limits on the claimed invention; any copier (unit of a commodity) disclosed could be used as a demonstration unit with no changes to functionality or use.

Regarding claim 53, the claim requires the component further managing a collection of the results of the interactions along with information about a trigger event that initiated each respective interaction.

The Requestor maps this limitation to the storage of count data, triggered by the pressing of the start button (see Request, pages 107-108; see also Exhibit CC-B, pages 24-25). However, the pressing of a start button is not information regarding a user's perception of the commodity, as required.

**Kravette**, however, does disclose the service person's ability to input maintenance information, including data such as when copier parts were replaced and what parts are needed, and the time of arrival and completion of the job (see col. 9, lines 14-20 and 49-55), and the transmission of this information to the central station.

The ability of service persons (users) to input maintenance information, such as the time of arrival, the work completed, the parts replaced and needed, and the time of completion of the job, anticipates the claimed 'component further managing a collection

of the results of the interactions along with information about a trigger event that initiated each respective interaction', the trigger event being the copier problem itself and the information about the repair conducted constituting the information regarding the trigger event.

Regarding claim 70, this claim requires that the users of the commodities are enabled to access the received information [at the remote database].

The Requester maps this claim to the ability of the service person to retrieve diagnostic and maintenance information (see Request, page 116; see also Exhibit CC-B, page 33).

However, the claimed 'received information' is the information from the user regarding the user's perception of the unit of the commodity, received at the remote server and stored in a remote database. There is no disclosure in **Kravette** which is analogous to providing the users to the information received and stored at the remote database.

**Kravette's** citation that the service person's ability to retrieve diagnostic and maintenance information as being 'particularly useful where communication with the central station is disrupted' further emphasizes the fact that this must be a retrieval of

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data from the local system, and is not a retrieval of the received information from the remote database.

The Requester's proposed rejection of claim 70 in view of **Kravette** is not adopted.

Regarding claims 71 and 72, the Requester maps the received information to signals generated by the copier to report maintenance requirements such as toner and paper refill (see Request, pages 117-118; see also Exhibit CC-B, page 34). However, to the extent that the monitored signals may be automatically-generated signals from the copier, and not generated from interactions with the service person (the 'user'), this disclosure fails to anticipate the claims.

**Kravette**, however, does disclose the service person's ability to input maintenance information, including data such as when copier parts were replaced and what parts are needed, and the time of arrival and completion of the job (see col. 9, lines 14-20 and 49-55), and the transmission of this information to the central station.

The transmission of this data to the service center anticipates the claimed enabling of third party vendors to access the received information.

Regarding claim 73, this claim requires the further step of making a design change using the received information, or marketing the commodity using the received information.

The Requester maps the automatic transmission of a preventative maintenance signal to the service center (see Request, pages 118-119; see also Exhibit CC-B, pages 34-35). However, there is no disclosure in **Kravette** which is analogous to the claimed use of received information for product redesign or marketing.

The Requester's proposed rejection of claim 73 in view of **Kravette** is not adopted.

Regarding claim 74, the examiner notes that the disclosed input of maintenance information such as parts replaced and needed (see col. 9, lines 14-20 and 49-55) anticipates the claimed 'elicited perception information about steps that a vendor of the commodity could take to improve user satisfaction, and support provided for users of the commodity'.

Claims 1-6, 10, 11, 16, 22, 25, 30-32, 38, 46-48, 50-52, 69, 71, 72 and 74 are anticipated under 35 U.S.C. § 102(b) by **Dworkin**.

The Third Party Requester has provided a detailed analysis and mapping of the features of **Dworkin** to the claim elements of the '078 patent (see Request, pages 121-163, as well as Exhibit CC-C). The Requester's analysis and rationale for rejection of claims 1-6, 10, 11, 16, 22, 25, 30-32, 38, 46-48, 50-52, 69, 71, 72 and 74 is adopted by the examiner and is incorporated by reference, with the following modifications.

The Requester's proposed rejections of claims 7, 12-15, 18, 24, 53, 70 and 73 are not adopted.

Regarding claims 1 and 69 (and their respective dependent claims), the Requestor maps the disclosed database 3, as well as information stored about each user to the claimed 'memory within each of the units of the commodity capable of storing results of the two-way local interaction, the results including elicited information about user perception of the commodity' (see Request, page 125; see also Exhibit CC-C, page 5).

However, **Dworkin** teaches that database 3 contains information about products and/or services, and the vendors who sell them, and that the database is the equivalent of thousands of catalogs of individual suppliers (see col. 3, lines 63-68). Catalog information is not analogous to the claimed 'results of the two-way local interaction, the results including elicited information about user perception of the commodity'.

Furthermore, **Dworkin's** 'information stored about each user' is disclosed as including only information to allow the user to bypass the step of entering a name and address each time an order is placed (see col. 8, lines 20-24). Once again, this type of information is not analogous to the claimed 'results of the two-way local interaction, the results including elicited information about user perception of the commodity'.

**Dworkin** does disclose, however, the results of the two-way local interaction, the results including elicited information about user perception of the commodity, at col. 10, lines 9-14, whereby the user can communicate with the management of the system to note complaints about the system or to offer suggestions for improvements to the system. The information can be conveyed by electronic mail. In this case, the memory capable of storing the information about user perception of the commodity would be the memory storing the message as the user types it, or alternately be the ubiquitous 'sent mail' mailbox present in contemporary electronic mail applications.

Further regarding claims 1 and 69, the Requestor maps database 3 to the claimed 'component capable of managing the interactions of the users in different locations and collecting the results of the interactions at the central location' (see Request, pages 126-128; see also Exhibit CC-C, pages 7-8).



However, as discussed above, **Dworkin** teaches that database 3 contains information about products and/or services, and the vendors who sell them, and that the database is the equivalent of thousands of catalogs of individual suppliers (see col. 3, lines 63-68). Catalog information is not analogous to the claimed 'results of the two-way local interaction, the results including elicited information about user perception of the commodity'.

**Dworkin** does disclose, however, the results of the two-way local interaction, the results including elicited information about user perception of the commodity, at col. 10, lines 9-14, whereby the user can communicate with the management of the system to note complaints about the system or to offer suggestions for improvements to the system. The information can be conveyed by electronic mail. In this case, the electronic mail 'in box' at the management location would anticipate the claimed 'component capable of managing the interactions of the users in different locations and collecting the results of the interactions at the central location'.

Regarding claims 2 and 3, the Requestor maps the user's selection of any menu item as being the trigger for two-way interactions with the user (see Request, pages 128-131; see also Exhibit CC-C, pages 8-10). The examiner points out that only the user's selection of menu item 8 Communicate With Management will trigger the claimed two-

way interactions with the user [eliciting information about the user's perception of the commodity].

Regarding claim 7, the claim requires that the results of the interactions are forwarded from the central location to a remote server for analysis. The Requester maps this claim to the disclosed placing of orders with suppliers (see Request, page 134; see also Exhibit CC-C, pages 11-12). However, the claim requires the results of the interaction to be forwarded *from* the central location to a remote server.

While the placement of orders may result in the transmission of information from the central server to remote servers, the information is order information, and not information regarding the user's perception of the unit of the commodity, as required. Furthermore, while **Dworkin** does disclose the ability for the user to submit complaints or suggestions regarding a vendor, which would logically be forwarded to the appropriate vendor's remote server, the claimed information about a user's perception of the unit of the commodity [the ordering system itself] would not be forwarded to a vendor's remote server.

There is no disclosure in **Dworkin** analogous to the forwarding of accumulated interaction information to a remote server for analysis.

The Requester's proposed rejection of claim 7 in view of **Dworkin** is not adopted.

Regarding claim 10, this claim requires that the two-way interaction provides instructions on how to use the commodity.

The Requestor maps this claim to the user's use of the Main Menu as providing instructions for use (see Request, page 135; see also Exhibit CC-C, page 12). However, the claimed two-way interaction corresponds only to the user's selection of item 8 of the menu Communicate With Management.

**Dworkin** does, however, disclose that the communication with management can allow the user to receive help in using the system (see col. 2, lines 42-46).

The disclosure of the use of electronic mail to receive help in using the system anticipates the claimed two-way interaction which provides instructions on how to use the commodity.

Regarding claim 12 (and claims 13 and 14 dependent thereon), the claim requires that two-way interaction comprises posing questions to a user on a television screen concerning use of the commodity, and receiving answers from the user expressed through a keypad or a handheld remote.

The Requestor maps this claim to the display of templates of technical criteria pertaining to selected products (see Request, pages 136-137; see also Exhibit CC-C, pages 13-14). However, this type of exchange does not qualify as 'concerning use of the commodity', as required.

The Requester's proposed rejection of claims 12-14 in view of **Dworkin** is not adopted.

Regarding claim 15, the claim requires the two-way interaction to be mediated by a publicly or privately accessible on-line computerized information service.

The Requester maps this claim to the purchasing of goods and services by the user (see Request, pages 139-140; see also Exhibit CC-C, pages 14-15). However, **Dworkin** discloses that the claimed two-way interaction can be embodied by an electronic mailbox (see col. 10, lines 9-17). There is no disclosure of the two-way interaction being 'mediated' in any way, and no disclosure of anything analogous to an on-line computerized information service.

The Requester's proposed rejection of claim 15 in view of **Dworkin** is not adopted.

Regarding claim 18, the claim requires the user interface to present information in hypertext.

The Requester maps this claim to **Dworkin's** disclosure of displaying templates and detailed specifications for a chosen product or service (see Request, page 141; see also Exhibit CC-C, page 16). However, there is no disclosure in **Dworkin** which mentions displaying information in any specific style, and no disclosure of the use of hypertext.

The Requester's proposed rejection of claim 18 in view of **Dworkin** is not adopted.

Regarding claim 24, the claim requires the interactions to comprise a transaction for sale of a product or a service contract for the commodity.

The Requester maps the claim to the disclosure of the user's orders for goods or services (see Request, page 143; see also Exhibit CC-C, page 17). However, this disclosure does not refer to the user's interactions regarding the user's perception of the commodity [embodied in **Dworkin** as an electronic mail message], as required by the claim.

The Requester's proposed rejection of claim 24 in view of **Dworkin** is not adopted.

Regarding claim 25, the claim requires that the interactions comprise a request for servicing of the commodity by the user.

The Requester maps the claim to **Dworkin's** disclosure of the user's purchase of products or services sold by a variety of vendors or suppliers (see Request, page 144; see also Exhibit CC-C, pages 17-18). However, the user's purchase of goods or services is not accomplished through a user's interactions eliciting the user's perception of the unit of the commodity, and thus this disclosure fails to anticipate the claim.

**Dworkin**, however, does disclose the user's ability to communicate with management, for instance by offering suggestions to improve the system (see col. 2, lines 42-48; see also col. 10, lines 9-17).

The submission of suggestions for improvement of the system anticipates the claimed 'interactions comprise a request for servicing of the commodity by the user'.

Regarding claim 32, this claim requires the component [for managing the interactions of the users in different locations] to provide access to the collection of interaction results to the vendors of the commodity.

The Requester maps this claim to the forwarding of the user's order to the vendors which will supply the purchased product or service (see Request, pages 146-

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147; see also Exhibit CC-C, page 19). However, information regarding the user's order does not constitute the claimed information elicited from the user regarding the user's perception of the unit of the commodity, and thus this disclosure fails to anticipate the claim.

**Dworkin**, however, does disclose the submission of the user's elicited information regarding the user's perception of the commodity, through the use of an electronic mail message transmitted to the system manager [the vendor of the commodity] (see col. 10, lines 9-17).

The compilation of interaction data from users at various locations in the electronic mailbox of management (the vendors of the commodity) anticipates the claimed 'component [for managing the interactions of the users in different locations] to provide access to the collection of interaction results to the vendors of the commodity'.

Regarding claim 50, the examiner notes that using the unit of the commodity as a demonstration unit does not place any further limits on the claimed invention; any system (unit of a commodity) disclosed could be used as a demonstration unit with no changes to functionality or use.

Regarding claim 53, the claim requires the component further managing a collection of the results of the interactions along with information about a trigger event that initiated each respective interaction.

The Requestor maps this limitation to the user's selection of menu items in searching for desired products or services (see Request, pages 153-154; see also Exhibit CC-C, pages 22-23). However, the user's selection of menu items for performing a search is not information about a trigger event that initiated an interaction regarding a user's perception of the commodity, as required.

**Dworkin** does disclose the user's ability to submit complaints or suggestions regarding the system (see col. 10, lines 9-17), and the transmission of this information to the electronic mailbox of management.

However, there is no disclosure in **Dworkin** which is analogous to the claimed management of information about a trigger event that initiated each respective interaction.

The Requester's proposed rejection of claim 53 in view of **Dworkin** is **not adopted**.

Regarding claim 70, this claim requires that the users of the commodities are enabled to access the received information [at the remote database].



The Requester maps this claim to the selection of menu items by the users, and the ability to enter specification information for a search and receiving the search results (see Request, pages 160-161; see also Exhibit CC-C, page 29).

However, the claimed 'received information' is the information from the user regarding the user's perception of the unit of the commodity, received at the remote server and stored in a remote database. There is no disclosure in **Dworkin** which is analogous to providing the users access to the information received and stored at the remote database.

The Requester's proposed rejection of claim 70 in view of **Dworkin** is **not adopted**.

Regarding claims 71 and 72, the Requester maps the received information to the user's orders for products or services (see Request, pages 161-162; see also Exhibit CC-C, page 30). However, the user's information in ordering products or services does not constitute the claimed information elicited from the user regarding the user's perception of the unit of the commodity, and so this disclosure fails to anticipate the claims.

**Dworkin**, however, does disclose the submission of the user's elicited information regarding the user's perception of the commodity, through the use of an

electronic mail message transmitted to the system manager [the vendor of the commodity] (see col. 10, lines 9-17).

The transmission of this data to the electronic mailbox of management [the third party vendor of the commodity] anticipates the claimed enabling of third party vendors to access the received information.

Regarding claim 73, this claim requires the further step of making a design change using the received information, or marketing the commodity using the received information.

The Requester maps the claim to the submission of a user's suggestions for improvement of the system (see Request, pages 162-163; see also Exhibit CC-C, pages 30-31). However, there is no disclosure in **Dworkin** which is analogous to the claimed use of received information for product redesign or marketing.

The Requester's proposed rejection of claim 73 in view of **Dworkin** is not adopted.

Claims 1-6, 10, 16, 22, 24, 25, 30-32, 38, 46-48, 50-53, 69 and 71-74 are anticipated under 35 U.S.C. § 102(e) by **Manduley**.

The Third Party Requester has provided a detailed analysis and mapping of the features of **Manduley** to the claim elements of the '078 patent (see Request, pages 76-120, as well as Exhibit CC-E). The Requester's analysis and rationale for rejection of claims 1-6, 10, 16, 22, 24, 25, 30-32, 38, 46-48, 50-53, 69 and 71-74 is adopted by the examiner and is incorporated by reference, with the following modifications.

The Requester's proposed rejections of claims 7, 15, 18 and 70 are **not adopted**.

Regarding claims 1 and 69 (and their respective dependent claims), the Requester maps the data center receiving request codes from users or devices (see col. 7, lines 40-45) to the claimed 'component capable of managing the interactions of the users in different locations and collecting the results of the interactions at the central location' [claim 1] and the claimed 'collecting and storing the received information at the remote database' [claim 69] (see Request, pages 207-212; see also Exhibit CC-E, pages 1-7 and 21-24).

The examiner additionally points out **Manduley's** disclosure of the maintenance of customer files which store information regarding a customer and which features are activated on the customer's device (see col. 7, line 61 through col. 8, line 35).

Regarding claim 7, the claim requires that the results of the interactions are forwarded from the central location to a remote server for analysis. The Requester maps this claim to the disclosed data center (see Request, page 218; see also Exhibit CC-E, page 10). However, the claim requires the results of the interaction to be forwarded *from* the central location to a remote server.

There is no disclosure in **Manduley** analogous to the forwarding of accumulated interaction information to a remote server for analysis.

The Requester's proposed rejection of claim 7 in view of **Manduley** is not adopted.

Regarding claim 15, the claim requires the two-way interaction to be mediated by a publicly or privately accessible on-line computerized information service.

The Requester maps this claim to the AddressRight and STAR 200 parcel manifest systems (see Request, pages 219-220; see also Exhibit CC-E, page 11). However, the disclosed systems, while perhaps qualifying as information services, seem to operate completely independent of the two-way interaction eliciting information regarding the user's perception of the unit of the commodity.

The Requester's proposed rejection of claim 15 in view of **Manduley** is not adopted.

Regarding claim 18, the claim requires the user interface to present information in hypertext.

The Requester maps this claim to **Manduley's** disclosure of displaying menu items (see Request, page 222; see also Exhibit CC-E, page 12). However, there is no disclosure in **Manduley** which mentions displaying information in any specific style, and no disclosure of the use of hypertext.

The Requester's proposed rejection of claim 18 in view of **Manduley** is not adopted.

Regarding claim 46, the claim requires that the two-way local interaction enables the user to request help or support.

The examiner notes that similar to claim 25 (the two-way local interaction comprises a request for servicing of the commodity), the disclosed request by the user for activation of an application or feature (see col. 5, lines 7-8 et seq.) would also qualify as a request for help or support.

Regarding claim 47, this claim requires that the information [about the user's perception of the commodity] relates to perception of a problem relating to use of the commodity.

The examiner notes that the disclosed request by the user for activation of an application or feature (see col. 5, lines 7-8 et seq.) would also qualify as information about the user's perception of the commodity related to perception of a problem relating to use of the commodity; the problem being that desired functionality (the application or feature) has not been enabled.

Regarding claim 48, this claim requires that the two-way local interaction [about the user's perception of the commodity] includes suggestions of the user to solve the problem.

The examiner notes that the disclosed request by the user for activation of an application or feature (see col. 5, lines 7-8 et seq.) would also qualify as suggestions of the user to solve the problem, through the selection of a specific application or feature whose activation would solve the perceived problem relating to the use of the commodity.

Regarding claim 50, the examiner notes that using the unit of the commodity as a demonstration unit does not place any further limits on the claimed invention; any data processing device (unit of a commodity) disclosed could be used as a demonstration unit with no changes to functionality or use.

Regarding claim 53, this claim requires that the component [for collecting results of interactions at a central location] also manages collection of the results of the interactions along with information about a trigger event that initiated each respective interaction.

The examiner notes that the disclosed customer file, storing information about which applications and features have been activated for a given customer (see col. 7, line 61 through col. 8, line 35) would qualify as the claimed component which manages collection of the results of the interactions along with information about a trigger event that initiated each respective interaction, the trigger event being the customer's request for activation of a specific application or feature.

Regarding claim 70, this claim requires that the users of the commodities are enabled to access the received information [at the remote database].

The Requester maps this claim to the display to the user of the integrated request code, and the display of information advising the user as to how to request activation of an application or feature (see Request, page 239; see also Exhibit CC-E, pages 24-25).

However, the claimed 'received information' is the information from the user regarding the user's perception of the unit of the commodity, received at the remote server and stored in a remote database (the customer's file, col. 7, line 61 through col. 8, line 35). There is no disclosure in **Manduley** which is analogous to providing the users access to the information received and stored at the remote database.

The Requester's proposed rejection of claim 70 in view of **Manduley** is not adopted.

Regarding claim 73, this claim requires the further step of making a design change using the received information, or marketing the commodity using the received information.

The Requester maps the claim to the disclosed submission of request codes by the user to the data center (see Request, pages 241-242; see also Exhibit CC-E, page 26). The examiner notes additionally the disclosure that based upon information received regarding users' perception of the unit of the commodity (the requests for activation of applications or features), the system determines if there are any alternative or



compatible functions that have not been activated, but are available, and if so, displays a suggestion to the user that there are one or more unactivated functions available on the device, a listing of said unactivated functions, and a description of the advantages of those unactivated functions (see col. 10, line 37 through col. 11, line 5; see also drawing Figure 5).

The display of suggestions of potentially desirable but not yet activated features to the user (the claimed marketing of the commodity) based upon the received information (the users' requests to activate specific applications or features) anticipates the claimed 'making a design change using the received information, or marketing the commodity using the received information'.

*Claim Rejections - 35 USC § 103*

Claim 73 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Dworkin**.

Regarding claim 73, **Dworkin** teaches a system wherein the user can provide suggestions for improvements of the system to the management (see col. 10, lines 9-17).

While **Dworkin** does not explicitly teach the suggestions being used by management to implement a design change, using submitted user suggestions for the

purposes of implementing design changes to the system would be the only reason to accept such suggestions from the users.

#### 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:

##### Claim 7

Regarding claim 7, the claim requires that the results of the interactions are forwarded from the central location to a remote server for analysis.

The Requester maps this claim to **Kravette's** transmission of information entered into the system by the service person to the central station (see Request, pages 92-93; see also Exhibit CC-B, pages 15-16). Previously, with regard to claim 1, **Kravette's** central station was mapped to the claimed 'central location'. However, the claim requires the results of the interaction to be forwarded *from* the central location (**Kravette's** central station) to a remote server. There is no disclosure in **Kravette** analogous to the claimed 'remote server', nor a forwarding of accumulated interaction information to said remote server for analysis.

The Requester also maps claim 7 to **Dworkin's** disclosed placing of orders with suppliers (see Request, page 134; see also Exhibit CC-C, pages 11-12). However, the claim requires the results of the interaction to be forwarded *from* the central location to a remote server.

While the placement of orders may result in the transmission of information from the central server to remote servers, the information is order information, and not information regarding the user's perception of the unit *of the commodity*, as required. Furthermore, while **Dworkin** does disclose the ability for the user to submit complaints or suggestions regarding a vendor, which would logically be forwarded to the appropriate vendor's remote server, the claimed information about a user's perception of the unit of the commodity [the ordering system itself] would not be forwarded to a vendor's remote server.

There is no disclosure in **Dworkin** analogous to the forwarding of accumulated interaction information to a remote server for analysis.

The Requester also maps claim 7 to **Manduley's** disclosed data center (see Request, page 218; see also Exhibit CC-E, page 10). However, the claim requires the results of the interaction to be forwarded *from* the central location to a remote server.

There is no disclosure in **Manduley** analogous to the forwarding of accumulated interaction information to a remote server for analysis.

#### **Claims 12-14**

Regarding claim 12 (and claims 13 and 14 dependent thereon), the claim requires that two-way interaction comprises posing questions to a user on a television screen concerning use of the commodity, and receiving answers from the user expressed through a keypad or a handheld remote.

The Requestor maps this claim to **Dworkin's** display of templates of technical criteria pertaining to selected products (see Request, pages 136-137; see also Exhibit CC-C, pages 13-14). However, this type of exchange does not qualify as 'questions...concerning use of the commodity', as required.

#### **Claim 15**

Regarding claim 15, the claim requires the two-way interaction to be mediated by a publicly or privately accessible on-line computerized information service.

The Requester maps this claim to **Kravette's** transmission of diagnostic information, preventative maintenance information and end of service contract information to the billing computer (see Request, page 94; see also Exhibit CC-B, pages

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16-17). However, **Kravette** discloses only a telephone connection between the modems of the copier and the billing computer at the central station (see drawing Figures 1, 2, 3 and 4 et seq.).

There is no disclosure of the two-way interaction being 'mediated' in any way, and no disclosure of anything analogous to an on-line computerized information service.

The Requester also maps claim 15 to **Dworkin's** purchasing of goods and services by the user (see Request, pages 139-140; see also Exhibit CC-C, pages 14-15). However, **Dworkin** discloses only that the claimed two-way interaction can be embodied by an electronic mailbox (see col. 10, lines 9-17).

The Requester also maps claim 15 to **Manduley's** AddressRight and STAR 200 parcel manifest systems (see Request, pages 219-220; see also Exhibit CC-E, page 11). However, the disclosed systems, while perhaps qualifying as information services, seem to operate completely independent of the two-way interaction eliciting information regarding the user's perception of the unit of the commodity.

There is no disclosure of the two-way interaction being 'mediated' in any way.

**Claim 18**

Regarding claim 18, the claim requires the user interface to present information in hypertext.

The Requester maps this claim to **Kravette's** disclosure of displaying messages to the service provider on the LED or LCD display of the portable hand held input/output device 34 (see Request, pages 95-96; see also Exhibit CC-B, pages 17-18). However, there is no disclosure in **Kravette** which mentions displaying information in any specific style, and no disclosure of the use of hypertext.

The Requester also maps claim 18 to **Dworkin's** disclosure of displaying templates and detailed specifications for a chosen product or service (see Request, page 141; see also Exhibit CC-C, page 16). However, there is no disclosure in **Dworkin** which mentions displaying information in any specific style, and no disclosure of the use of hypertext.

The Requester also maps claim 18 to **Manduley's** disclosure of displaying menu items (see Request, page 222; see also Exhibit CC-E, page 12). However, there is no disclosure in **Manduley** which mentions displaying information in any specific style, and no disclosure of the use of hypertext.

**Claim 70**

Regarding claim 70, this claim requires that the users of the commodities are enabled to access the received information [at the remote database].

The Requester maps this claim to **Kravette's** disclosure of the ability of the service person to retrieve diagnostic and maintenance information (see Request, page 116; see also Exhibit CC-B, page 33).

However, the claimed 'received information' is the information from the user regarding the user's perception of the unit of the commodity, received at the remote server and stored in a remote database. There is no disclosure in **Kravette** which is analogous to providing the users to the information received and stored at the remote database.

**Kravette's** citation that the service person's ability to retrieve diagnostic and maintenance information as being 'particularly useful where communication with the central station is disrupted' further emphasizes the fact that this must be a retrieval of data from the local system, and is not a retrieval of the received information from the remote database.

The Requester also maps claim 70 to **Dworkin's** selection of menu items by the users, and the ability to enter specification information for a search and receiving the search results (see Request, pages 160-161; see also Exhibit CC-C, page 29).

However, the claimed 'received information' is the information from the user regarding the user's perception of the unit of the commodity, received at the remote server and stored in a remote database. There is no disclosure in **Dworkin** which is analogous to providing the users access to the information received and stored at the remote database.

The Requester also maps claim 70 to the display to the user of the integrated request code, and the display of information advising the user as to how to request activation of an application or feature (see Request, page 239; see also Exhibit CC-E, pages 24-25).

However, the claimed 'received information' is the information from the user regarding the user's perception of the unit of the commodity, received at the remote server and stored in a remote database (the customer's file, col. 7, line 61 through col. 8, line 35). There is no disclosure in **Manduley** which is analogous to providing the users access to the information received and stored at the remote database.



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*

The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 7,222,078 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 §§ 2686 and 2686.04.

The Patent Owner is reminded that any proposed amendment to the specification and/or claims in the reexamination proceeding must comply with the provisions of 37 C.F.R. § 1.530(d)-(j), must be formally presented pursuant to 37 C.F.R. § 1.52(a) and (b), and must include any fees required by 37 C.F.R. § 1.20(c). See MPEP §

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2250(IV) for examples to assist in the preparation of proper amendments in reexamination proceedings.

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 an Action Closing Prosecution (ACP), will be governed by 37 CFR 1.116(b) and (d), which will be strictly enforced.

All correspondence relating to this *inter partes* reexamination proceeding should be directed:

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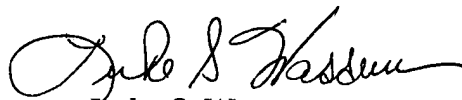
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Any inquiry concerning this communication should be directed to the Central

Reexamination Unit at telephone number 571-272-7705.



Luke S. Wassum

Primary Examiner

Art Unit 3992

Conferees: AKB



SUDHANSHU C. PATNAK  
SPE, 3992

lsw

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