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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,099	03/28/2008	5761662	112056-0512	3018

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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 03/30/2009

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

Office Action in Ex Parte Reexamination	Control No. 90/009,099	Patent Under Reexamination 5761662	
	Examiner Deandra M. Hughes	Art Unit 3992	

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

- a Responsive to the communication(s) filed on 15 October 2008. b This action is made FINAL.
c A statement under 37 CFR 1.530 has not been received from the patent owner.

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

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

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

Part II SUMMARY OF ACTION

- 1a. Claims 1,4-8,11-17 and 20-32 are subject to reexamination.
1b. Claims _____ are not subject to reexamination.
2. Claims 2,3,9,10,18,19 and 26 have been canceled in the present reexamination proceeding.
3. Claims _____ are patentable and/or confirmed.
4. Claims 1,4-8,11-17 and 20-32 are rejected.
5. Claims _____ are objected to.
6. The drawings, filed on _____ are acceptable.
7. The proposed drawing correction, filed on _____ has been (7a) approved (7b) disapproved.
8. Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some* c) None of the certified copies have
1 been received.
2 not been received.
3 been filed in Application No. _____
4 been filed in reexamination Control No. _____
5 been received by the International Bureau in PCT application No. _____
* See the attached detailed Office action for a list of the certified copies not received.
9. Since the proceeding appears to be in condition for issuance of an *ex parte* reexamination certificate except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte* Quayle, 1935 C.D. 11, 453 O.G. 213.
10. Other: _____

cc: Requester (if third party requester)



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

James A. Blanchette
88 Black Falcon Avenue
Boston, MA 02210

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/009,099.

PATENT NO. 5761662.

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Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

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EX PARTE REEXAMINATION FINAL ACTION

1. This is an *ex parte* reexamination of U.S. Patent No. **5,761,662**. Amended patent claims 1, 4-8, 11-17, and 20-25 and newly added patent claims 27-32 are under examination. Original patent claims 2-3, 9-10, 18-19, and 26 have been cancelled in the amendment filed Oct. 15, 2008.

References Cited in this Action

2. **Ojala**, Marydee. SDIs: The Star Wars of Business Searching. Database; Dec. 1988; 11, 6. ("**Ojala**")
3. Berners-Lee, Tim. Hypertext Transfer Protocol. A Stateless Search, Retrieve and Manipulation Protocol. 5 Nov. 1993. ("**HTTP Internet Draft**")
4. **Spero**, Simon. Binary Gateway Interface-An API for dynamically extensible HTTP servers. July 1, 1994. ("**Spero**")

Amendment/Remarks Filed Oct. 15, 2008

5. The amendment filed Oct. 15, 2008 has been entered and the remarks have been considered. Applicant's arguments with respect to claims 1, 4-8, 11-17, 20-25, 27-32 have been considered but are moot in view of the new ground(s) of rejection.

Declaration

6. The declaration filed on Oct. 7, 2008 under 37 CFR 1.131 by Vasanthan S. Dasan has been considered but is ineffective to overcome the **Spero** reference.

CFR 1.131(b) states in part, "The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must

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accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained”

The **Spero** reference was published July 1, 1994. The effective filing date of the patent under reexamination (**USP 5,761,662**) is Dec. 20, 1994. The declaration alleges conception prior to July 1, 1994. (pg. 1; §2). In addition, the declaration alleges that the inventor began to implement his conceived invention prior to July 1, 1994. (pg. 1, §§7-11). Further, the inventor alleges that he “worked diligently to reduce the invention to practice and a working prototype was developed prior to December 20, 1994, which was the filing date of the ‘662 Patent.” (pg.2; §12).

Conception

MPEP §2138.04 states in part, "Conception has been defined as "the complete performance of the mental part of the inventive act" and it is "the formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention as it is thereafter to be applied in practice...." Townsend v. Smith, 36 F.2d 292, 295, 4 USPQ 269, 271 (CCPA 1930). "[C]onception is established when the invention is made sufficiently clear to enable one skilled in the art to reduce it to practice without the exercise of extensive experimentation or the exercise of inventive skill." Hiatt v. Ziegler, 179 USPQ 757, 763 (Bd. Pat. Inter. 1973). Conception has also been defined as a disclosure of an invention which enables one skilled in the art to reduce the invention to a practical form without "exercise of the inventive faculty." Gunter v. Stream, 573 F.2d 77, 197 USPQ 482 (CCPA 1978). "

Here, the Inventor has submitted evidence of:

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- a file entitled newsprof.c that "performs the task of pre processing incoming news...as an offline application in-real time. (pg. 1, §4);
- a file cmd entitled that quickly invokes "the tracing program for debugging the system." (pg. 2, §5);
- a file xpress.c that a file that "reads the device driver inputs into ascii format" (pg. 2, §7);
- a file rnews.c that "reads the raw news feed and converts it to net news format." (pg. 2, §8);
- a file xn2h.c, v that "reads the net news file and converts it to html format for the web." (pg. 2, §9);
- a file Makefile, v which "is a command file to compile the entire program" (pg. 2, §10);

However, the submitted evidence is insufficient to establish that the invention was made "sufficiently clear to enable one skilled in the art to reduce it to practice without the exercise of extensive experimentation or the exercise of inventive skill" because the evidence does not disclose a Common Gateway Interface which "allows the client program to direct the server to commence execution of a specified program within the server." (USP 5,761,662; col.4:33-37). None of the submitted files discloses evidence of execution of a specified program *within the server*. In addition, the submitted evidence does not disclose conception of a second computer system retaining the state of the newsgroups user's profile. (col. 4:38-41). As a result, the submitted evidence is insufficient to establish conception of the invention prior to July 1, 1994.

Reduction to Practice

MPEP §2138.05 states "Reduction to practice may be an actual reduction or a constructive reduction to practice which occurs when a patent application on the

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claimed invention is filed. The filing of a patent application serves as conception and constructive reduction to practice of the subject matter described in the application. Thus the inventor need not provide evidence of either conception or actual reduction to practice when relying on the content of the patent application. *Hyatt v. Boone*, 146 F.3d 1348, 1352, 47 USPQ2d 1128, 1130 (Fed. Cir. 1998). A reduction to practice can be done by another on behalf of the inventor. *De Solms v. Schoenwald*, 15 USPQ2d 1507, 1510 (Bd. Pat. App. & Inter. 1990). "While the filing of the original application theoretically constituted a constructive reduction to practice at the time, the subsequent abandonment of that application also resulted in an abandonment of the benefit of that filing as a constructive reduction to practice. The filing of the original application is, however, evidence of conception of the invention." *In re Costello*, 717 F.2d 1346, 1350, 219 USPQ 389, 392 (Fed. Cir. 1983)(The second application was not co-pending with the original application and it did not reference the original application. Because of the requirements of 35 U.S.C. 120 had not been satisfied, the filing of the original application was not recognized as constructive reduction to practice of the invention.

For the reasons set forth above regarding the insufficiency of the evidence submitted to support conception prior to July 1, 1994, the declaration fails to demonstrate reduction to practice.

Reasonable Diligence

A declarant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not

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enough.); In re Harry, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. In re Mulder, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); Fitzgerald v. Arbib, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959). The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. Rebstock v. Flouret, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); Rieser v. Williams, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958) (see MPEP 2138.06)

Here, the declaration merely states that the inventor worked diligently to reduce the invention to practice prior to Dec. 20, 1994 without proffering evidence to support said statement. (pg. 2, §10). Consequently, the declarant has not accounted for the entire period during which diligence is required.

For the reasons set forth above, the declaration filed on Oct. 7, 2008 under 37 CFR 1.131 by Vasanthan S. Dasan is ineffective to overcome the **Spero** reference.

Claim Rejections - 35 USC § 103

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
8. Claims 1, 4-8, 11-17, 20-25, and 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ojala** in view of **HTTP Internet Draft** and **Spero**.

The disclosures of **Ojala** are outlined in the non-final office action dated Aug. 8, 2008 and are here incorporated by reference. **Ojala** does not specifically disclose a

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HTTP browser active on a 1st computer system establishing communication with a server comprising a HTTP server application program active on a 2nd computer system wherein said HTTP server application program communicates with said 1st application program active on said 2nd computer program via CGI. However, **HTTP Internet Draft** teaches a HTTP stateless search, retrieve, and manipulation protocol. (Abstract)

Although the HTTP protocol is stateless, **Spero** teaches modifying the HTTP protocol from a stateless protocol to output dynamic information, which requires a *stateful* protocol (i.e. retaining the state of the user's profile). In particular, **Spero** teaches:

"Many HTTP servers currently support an interface protocol allowing them to pass requests on external scripts. This protocol is known as CGI....In this paper we discuss an alternative approach to server extensibility and propose an alternative interface protocol *based on dynamically linked functions.*" (emphasis added; Abstract)

As **Spero** teaches, the Common Gateway Interface (CGI) is a method for interfacing external applications with information servers, such as HTTP. As **HTTP Internet Draft** discloses, a plain HTML document that the Web daemon **retrieves** is **static**, which means it exists in a constant state, i.e. a text file that does not change. However, as **Spero** teaches, a CGI program is executed in real-time, so that it can output dynamic information. For example, if one of ordinary skill in the art wanted to connect his news database to the World Wide Web so that people can query it via an HTTP connection, then he would need to create a CGI program, as taught by **Spero**, so that the Web daemon will execute to transmit information to the database engine, and receive the results back and display them to the client.

Ojala explicitly notes the need to retrieve only the most recent information (pg. 84, col. 1, 3rd paragraph, last line; and pg. 89, col. 2) and **HTTP Internet Draft** provides the teaching of applying HTTP servers to databases. Further, **Spero** teaches the application of CGI to HTTP servers to provide dynamically linked information. As a result, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the newserver of **Ojala** with the teachings of **HTTP Internet Draft** and **Spero** for the advantage of a real-time updated database of news articles matching the user's profile.

Conclusion

9. Patent owner's amendment filed Oct. 15, 2008 necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

A shortened statutory period for response to this action is set to expire 2 from the mailing date of this action.

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

Extensions of time in reexamination proceedings are provided for in 37 CFR 1.550(c). A request for extension of time must be filed on or before the day on which a response to this action is due, and it must be accompanied by the petition fee

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set forth in 37 CFR 1.17(g). The mere filing of a request will not effect any extension of time. An extension of time will be granted only for sufficient cause, and for a reasonable time specified.

The filing of a timely first response to this final rejection will be construed as including a request to extend the shortened statutory period for an additional month, which will be granted even if previous extensions have been granted. In no event, however, will the statutory period for response expire later than SIX MONTHS from the mailing date of the final action. See MPEP § 2265.

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

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

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

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

11. Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at:

<https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>.

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

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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 submissions after the "soft scanning" process is complete.

12. Any inquiry concerning this communication or earlier communications from the examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

Signed:

Conferees: /LHB/

/Deandra M. Hughes/

ESK

Deandra M. Hughes
Primary Examiner
Central Reexamination Unit 3992
(571) 272-6982

March 23, 2009