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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: 06/22/2009

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



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**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/009,099.

PATENT NO. 5761662.

ART UNIT 3992.

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

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

**Notice of Intent to Issue  
Ex Parte Reexamination Certificate**

<b>Control No.</b> 90/009,099	<b>Patent Under Reexamination</b> 5761662	
<b>Examiner</b> Deandra M. Hughes	<b>Art Unit</b> 3992	

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

1.  Prosecution on the merits is (or remains) closed in this *ex parte* reexamination proceeding. This proceeding is subject to reopening at the initiative of the Office or upon petition. Cf. 37 CFR 1.313(a). A Certificate will be issued in view of
- (a)  Patent owner's communication(s) filed: 14 May 2009.
  - (b)  Patent owner's late response filed: \_\_\_\_\_.
  - (c)  Patent owner's failure to file an appropriate response to the Office action mailed: \_\_\_\_\_.
  - (d)  Patent owner's failure to timely file an Appeal Brief (37 CFR 41.31).
  - (e)  Other: \_\_\_\_\_.

Status of *Ex Parte* Reexamination:

- (f) Change in the Specification:  Yes  No
- (g) Change in the Drawing(s):  Yes  No
- (h) Status of the Claim(s):

- (1) Patent claim(s) confirmed: ~~1, 4, 8, 11, 17 and 20-25~~
- (2) Patent claim(s) amended (including dependent on amended claim(s)): 1, 4-8, 11, 17, 20-25 ESK
- (3) Patent claim(s) cancelled: \_\_\_\_\_.
- (4) Newly presented claim(s) patentable: 27-32.
- (5) Newly presented cancelled claims: \_\_\_\_\_.

2.  Note the attached statement of reasons for patentability and/or confirmation. Any comments considered necessary by patent owner regarding reasons for patentability and/or confirmation must be submitted promptly to avoid processing delays. Such submission(s) should be labeled: "Comments On Statement of Reasons for Patentability and/or Confirmation."
3.  Note attached NOTICE OF REFERENCES CITED (PTO-892).
4.  Note attached LIST OF REFERENCES CITED (PTO/SB/08).
5.  The drawing correction request filed on \_\_\_\_\_ is:  approved  disapproved.
6.  Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
- a)  All b)  Some\* c)  None of the certified copies have
  - been received.
  - not been received.
  - been filed in Application No. \_\_\_\_\_.
  - been filed in reexamination Control No. \_\_\_\_\_.
  - been received by the International Bureau in PCT Application No. \_\_\_\_\_.
- \* Certified copies not received: \_\_\_\_\_.
7.  Note attached Examiner's Amendment.
8.  Note attached Interview Summary (PTO-474).
9.  Other: \_\_\_\_\_.

/Deandra M Hughes/ Primary Examiner, Art Unit 3992		
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**EX PARTE REEXAMINATION NIRC**

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**")

***After-Final Amendment***

5. The after-final amendment filed May 14, 2009 will not be entered because they do not comply with CFR §1.530. However, the Supplemental Declaration filed by Vasanthan S. Dasan on May 14, 2009 has been entered.

Although the after-final amendment filed May 14, 2009 has not been entered, the issue is moot because the claim amendments filed 10/15/2008 comply with CFR §1.530. Since the claim amendments with the proper markings (claim amendments of 10/15/08) have been previously entered in the file jacket, no action is required by the Patent Owner with respect to this issue.

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***Supplemental Declaration filed May 14, 2009***

6. The Supplemental Declaration filed on May 14, 2008 under 37 CFR 1.131 by Vasanthan S. Dasan has been considered and is effective 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 accompany and form part of the affidavit or supplemental 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 Supplemental Declaration alleges *conception* of the invention prior **July 1, 1994** (pg. 2; ¶7) and *reduction to practice* of the invention on **July 2, 1994** (pg. 2, ¶5)

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). "

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 claimed invention is filed. The filing of a patent application serves as conception

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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.

#### 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 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)

In the **Declaration filed Oct. 7, 2008**, the Inventor submitted evidence of

*conception* of the invention prior to July 1, 1994 :

- 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);

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- a file mews.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);

In the **Supplemental Declaration filed May 14, 2009**, the Inventor submitted evidence of diligence from *conception of the invention on July 1, 1994* (Dec. filed Oct. 7, 2008; Exhibits A-I) to *reduction to practice of the invention on July 2, 1994* (Dec. filed May 14, 2009; see ¶5 and Exhibits A-B).

The **Supplemental Declaration filed May 14, 2009** alleges that the programming statements of ¶¶10-17 are "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:

- ¶10-12 provides evidence of a Common Gateway Interface which "allows the client program to direct the server to commence execution of a specified program within the server."
- ¶14-16 provides evidence of a second computer system retaining the state of the newsgroups user's profile; and
- ¶17 provides evidence that the program was operational on a server computer.

For the reasons set forth above, the **Supplemental Declaration filed on May 14, 2009** under 37 CFR 1.131 by Vasanthan S. Dasan is effective to overcome the Spero reference.

#### ***Claim Rejections - 35 USC § 103***

7. **Claims 1, 4-8, 11-17, 20-25, and 27-32** are ~~allowed~~ <sup>either</sup> patentable as amended or newly presented patentable claims

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8. The said claims are <sup>patentable</sup> ~~allowed~~ because the Supplemental Declaration filed on May 14, 2009 is effective to overcome the **Spero** reference thereby successfully traversing the rejection of claims 1, 4-8, 11-17, 20-25, and 27-32 under 35 U.S.C. 103(a) as being unpatentable over **Ojala** in view of **HTTP Internet Draft** and **Spero**.

### **Conclusion**

9. 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

10. 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 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.

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11. 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:

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

Conferees:

/A. J. G./  
Primary Examiner, Art Unit 3992

*ESK*