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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/012,679	09/15/2012	5128984	A2DL-001/49US 305918-2033	4711
58249	7590	03/14/2014	EXAMINER	
COOLEY LLP ATTN: Patent Group 1299 Pennsylvania Avenue, NW Suite 700 Washington, DC 20004			MENEFE, JAMES A	
			ART UNIT	PAPER NUMBER
			3992	
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			03/14/2014	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)

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**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/012,679.

PATENT NO. 5128984.

ART UNIT 3992.

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

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

<b>Notice of Intent to Issue Ex Parte Reexamination Certificate</b>	<b>Control No.</b>	<b>Patent Under Reexamination</b>	
	90/012,679	5128984	
	<b>Examiner</b>	<b>Art Unit</b>	<b>AIA (First Inventor to File) Status</b>
JAMES MENEFFEE	3992	No	

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

1.  Prosecution on the merits is (or remains) closed in this *ex parte* reexamination proceeding. This proceeding is subject to reopening at the initiative of the Office or upon petition. Cf. 37 CFR 1.313(a). A Certificate will be issued in view of
  - (a)  Patent owner's communication(s) filed: 29 May 2013.
  - (b)  Patent owner's failure to file an appropriate timely response to the Office action mailed: \_\_\_\_\_.
  - (c)  Patent owner's failure to timely file an Appeal Brief (37 CFR 41.31).
  - (d)  The decision on appeal by the  Board of Patent Appeals and Interferences  Court dated \_\_\_\_\_
  - (e)  Other: \_\_\_\_\_.
2. The Reexamination Certificate will indicate the following:
  - (a) Change in the Specification:  Yes  No
  - (b) Change in the Drawing(s):  Yes  No
  - (c) Status of the Claim(s):
    - (1) Patent claim(s) confirmed: 15 and 16.
    - (2) Patent claim(s) amended (including dependent on amended claim(s)): \_\_\_\_\_
    - (3) Patent claim(s) canceled: \_\_\_\_\_.
    - (4) Newly presented claim(s) patentable: \_\_\_\_\_.
    - (5) Newly presented canceled claims: \_\_\_\_\_.
    - (6) Patent claim(s)  previously  currently disclaimed: \_\_\_\_\_
    - (7) Patent claim(s) not subject to reexamination: 2,3,5-14 and 17-23.
3.  A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on \_\_\_\_\_.
4.  Note the attached statement of reasons for patentability and/or confirmation. Any comments considered necessary by patent owner regarding reasons for patentability and/or confirmation must be submitted promptly to avoid processing delays. Such submission(s) should be labeled: "Comments On Statement of Reasons for Patentability and/or Confirmation."
5.  Note attached NOTICE OF REFERENCES CITED (PTO-892).
6.  Note attached LIST OF REFERENCES CITED (PTO/SB/08 or PTO/SB/08 substitute).
7.  The drawing correction request filed on \_\_\_\_\_ is:  approved  disapproved.
8.  Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All b)  Some\* c)  None of the certified copies have
    - been received.
    - not been received.
    - been filed in Application No. \_\_\_\_\_.
    - been filed in reexamination Control No. \_\_\_\_\_.
    - been received by the International Bureau in PCT Application No. \_\_\_\_\_.

\* Certified copies not received: \_\_\_\_\_.
9.  Note attached Examiner's Amendment.
10.  Note attached Interview Summary (PTO-474).
11.  Other: See Continuation Sheet.

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

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cc: Requester (if third party requester)

Continuation of 10. Other: claims 1 and 4 were cancelled in a previous proceeding.

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### **Notice of Intent to Issue Reexamination Certificate**

This is an *ex parte* reexamination of claims 15 and 16 of U.S. Patent No. 5,128,984 (“the ‘984 patent”). The Office determined a substantial new question of patentability was raised as to those claims by the request filed 9/15/2012 (“Request”). Claims 1 and 4 were cancelled in a reexamination certificate issued 10/8/2013. Reexamination was not requested of claims 2, 3, 5-14 and 17-23, therefore they will not be reexamined. MPEP 2243. This action is responsive to patent owner’s response filed 5/29/2013 (“Response”) and the errata filed 5/30/2013. This action will at times reference the previous Office action mailed 3/29/2013 (“First Action”).

### ***References Cited in Request***

U.S. Patent No. 4,071,698 to Barger, Jr. et al. (“Barger”).

U.S. Patent No. 4,797,911 to Szlam et al. (“Szlam”).

U.S. Patent No. 4,792,934 to Masaki (“Masaki”).

Wendkos, The New World of Voice Technology, Telemarketing, August 1986 (“Wendkos”).

Bally, Name That Tune Operator’s Manual, March 1986 (“Bally”).

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### ***Priority***

The examiner determined previously that claims 15 and 16 have an earliest effective filing date of 10/23/1989. Patent owner states that it does not agree but does not dispute that Barger, Szlam, Wendkos, and Masaki are prior art. Response p. 4. In light of the findings as to Bally, the issue of priority therefore need not be discussed further at this time.

### ***Claim Construction***

#### **Expired Patent Claims**

The '984 patent expired on 10/23/2009. Claims of an expired patent are generally construed in reexamination consistently with principles set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). See *Ex parte Ronald A. Katz Tech Licensing L.P.*, Appeal 2008-005127 (B.P.A.I. Mar. 15, 2010) (Decision on Request for Rehearing, Expanded Panel); MPEP 2258(G). In the prior action, the examiner on occasion (in the rejections) referenced the broadest reasonable interpretation standard in connection with claim terms. Such references are deemed to be typographical errors, as the examiner clearly was aware of and stated he was applying the correct standard. In any event, the actual construction does not change herein.

#### **Particular Claim Terms**

The examiner in the prior action construed several claim terms, including means plus function limitations. These particular claim constructions do not appear to be in dispute; therefore the constructions are maintained but need not be repeated here.

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

Claims 15 and 16 are confirmed. The following is an examiner's statement of reasons for patentability and/or confirmation of the claims found patentable in this reexamination proceeding:

There is not taught or disclosed in the prior art a telephone interface system as claimed including, *inter alia*, memory means for storing caller cues and use indications for said caller cues in relation to said callers identified by said identification signals, and means for selecting a current caller cue for an active caller under control of said identification signals and said use indications for that caller.

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.

#### ***Response to Arguments***

Patent owner's arguments filed with the Response are partially persuasive.

##### **A. Means For Providing at Least a Portion of the Digits . . .**

Patent owner first argues that the references do not disclose "means for providing at least a portion of the digits associated with a remote terminal for identification." Response p. 5.

Patent owner states that the action relies on Barger for this feature, but Barger does not meet the claim. But the previous rejection specifically stated that Barger lacks this feature, and instead

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relied upon Szlam to meet the limitation. See First Action p. 22. As patent owner did not address the actual rejection there is nothing more to rebut.

#### B. Memory Means for Storing Caller Cues and Use Indications

Patent owner next argues that the references do not describe “memory means for storing caller cues and use indications for said caller cues in relation to said caller.” Response pp. 5-6. The rejection relied on Barger for this, with the examiner stating that Barger describes memory in RAM and disks to store cues as well as memory in general utilized to store customer’s transactions to cues. While the current examiner agrees that this seems to correspond to the structure of the “memory means,” these elements of Barger must also perform the claimed function to meet the claim. The examiner finds that Barger does not sufficiently show “storing use indications” as claimed.

“Use indications” is included in patent claims 15, 17, and 19, but is not found in the specification of the ‘984 patent. The term appears to have been added in an amendment filed 6/24/1991 during the original prosecution, with then numbered claims 17-23, which were added in response to a first Office action. In that response, the applicant argued, *inter alia*, that the previously applied references are distinguished from claims using “cue selection.” Applicant explained that this element provides a cue that has not previously been provided to the caller, and is found in the specification at page 5 line 28, page 17, line 25, and claims 11, 13, and 17-23. Those passages of the specification correspond to col. 3 line 25 and col. 8 line 65 of the ‘984 patent, and seem to refer to the control of overzealous callers by using the random number generator, and then using a coincidence detector for testing for previous use of a cue by the

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particular calling terminal. Claim 11 of the amendment (now patent claim 10), referenced by patent owner as having this feature, has no "use indication." But the claim included a test means for testing selected questions against a record to test for coincidence, and inhibiting a selection if that question had already been asked of that particular terminal. Claim 13 was merely dependent on claim 11.

Claims 17-23 of the 6/24/1991 amendment, which were also said to include this "cue selection" feature, do not have such language similar to claim 11. Claim 17 (which, along with the limitations of claim 18, became patent claim 15) does have memory means storing caller cues and use indications for those cues in relation to particular callers, and a particular current caller cue is selected under control of the use indications. This is the only part of the claim that could provide the "cue selection" feature that applicant explained was in the claim. Again, the cue selection was said by applicant to provide a cue that has not previously been provided to the caller. It is therefore apparent, given this context, that "use indications" as used in the claim is something that indicates whether that particular cue has been used by that particular caller. This is done in the '984 patent by the system recording the identification number of the question in the call record when it is used. Col. 9 lines 21-29. Thus, the recording of the identification number of the question is a use indication.

This is consistent with the claim as well. Again, the "means for selecting a current caller cue" selects a cue from the memory means under control of the use indications and the identification signals of the caller. In other words, it selects a cue based on whether the "use indication" indicates that cue has been used for that caller. To summarize, a "use indication" of claim 15 somehow indicates that a particular cue has been used for a particular caller.

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Turning back to Barger, nothing in the reference describes a “use indication” as claimed. There is no suggestion that the cues are somehow selected based on whether a caller used or heard that cue before. The closest thing might be the free loader algorithm of Barger. This checks whether the caller has called before, and if so, it checks how many selections of songs he has made; if over a certain number without a purchase, the system will require assistance by an operator. See Fig. 4, col. 11 lines 37-47. Not much explanation is given, but it appears that the system does not necessarily care about use *of any particular cue*, just whether the caller is using *the system* without making a purchase. The examiner cannot say that there is any stored “use indication.”

It is noted that the examiner during the original prosecution found that Szlam anticipated claim 17 in a final rejection mailed 9/17/1991. The examiner did not provide item matching to the claim, and did not explain how Szlam discloses storage of use indications, merely noting that the caller is queried with a message based on how the caller identifies himself and whether he has an account, citing col. 12 line 9 to col. 13 line 18. For example, different cues may be provided to established account holders, versus those wishing to open an account. This does not provide any storage of use indications as described herein, and the current examiner finds nothing in Szlam that teaches storage of use indications.

It is further noted that Masaki may describe storage of use indications, as a bit corresponding to a tune is set to 1 when that tune is played. Col. 4 lines 11-15. It is unclear why or how this would correspond to Barger such that an obviousness rejection would be made, modifying Barger. That is, it is not clear that storing whether a song on a compact disk has been played would give reason to modify Barger so that we would store whether cues in an automated

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telephone system have been played to a particular caller. Additionally, Masaki is determined herein to be non-analogous art.

Bally and Wendkos also clearly lack use indications, and no further explanation is needed.

### C. Selecting Cues Based on Identification Signals and Use Indications

Patent owner next argues that Barger lacks selecting a cue based upon identification signals and use indications. Response p. 6. The examiner agrees, for the reasons given in the previous section, as Barger lacks use indications.

### D. Reasons to Combine

Patent owner argues that there is no reason to combine Barger and Szlam because it would not have been obvious to use ANI in Barger's system. Response pp. 6-7. The examiner disagrees. The Board has already found that ANI may be combined with Barger in a reexamination of a related patent. *Ex parte Ronald A. Katz Technology Licensing L.P.*, Appeal 2010-008287 at 15-20 (B.P.A.I. Jul. 5, 2011) (Control No. 90/010,045). In addition, Szlam involves a customer service system using a voice response unit to receive orders from callers. Szlam is thus comparable to Barger and would involve the same "problems" with using ANI, yet there is no apparent difficulty in using ANI with Szlam. In any event, as the rejections are withdrawn this point need not be discussed further.

Patent owner next argues that there is no reason to combine Wendkos with Barger and Szlam. Patent owner first argues that "it was particularly not obvious to use ANI with Wendkos

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as the rejection posits . . . .” Response p. 8. Patent owner explains that Wendkos is interested in looking for new customers, not servicing existing customers, therefore “[i]t would have made no sense to use ANI to identify callers in the Wendkos context.” *Id.* Patent owner further argues that Wendkos is fully automated, as opposed to Szlam which has live operators, and “[i]t would have made no sense to use this live-operator functionality in the context of Wendkos' completely automated promotions.” *Id.* Each of these arguments fundamentally mischaracterizes the rejection. The rejection was not using ANI in Wendkos, or using live operator functionality in Wendkos. The point of this portion of the rejection was to modify the Barger/Szlam combined system such that it uses Wendkos' functionality. The examiner did not propose to use Szlam's functionality in Wendkos. There is no modification of Wendkos; there is modification, of the others, using the teaching of Wendkos.

Patent owner finally argues that there is no reason to combine with Masaki, arguing in part that Masaki is not analogous art. Response p. 8. The examiner agrees, and this issue deserves its own section.

#### Masaki – Analogous Art

Patent owner argues that Masaki is not analogous art, stating that it is not in the same field of endeavor as the other references, nor is it pertinent to the problem of Barger. Response pp. 8-9; Brody Decl. ¶¶ 28-32. This is actually not the correct issue. The question is not whether Masaki is analogous art to Barger or Wendkos; the question is whether Masaki is analogous art to the '984 patent. “A reference qualifies as prior art for an obviousness determination under § 103 only when it is analogous to the claimed invention.” *In re Klein*, 98 USPQ2d 1991, 1993

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(Fed. Cir. 2011) (emphasis added). A reference is analogous art, and useable in an obviousness rejection, if it (1) is from the same field of endeavor, regardless of problem addressed, and (2) if not within the inventor's field or endeavor, if the reference is reasonably pertinent to the particular problem with which the inventor is involved. *Id.* To determine the appropriate field of endeavor, the Office must look to the specification, including the embodiments, function, and structure of the claimed invention. *In re Bigio*, 72 USPQ2d 1209, 1212 (Fed. Cir. 2004). "A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem . . . . If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection . . . . If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it." *In re Clay*, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992) (quoted in *Klein*, 98 USPQ2d at 1993)).

As to the field of endeavor, the Katz system is clearly and unequivocally drawn to a telephone system. All embodiments, discussion, and the claims occur in the context of describing the interface that is met by a caller when making a call to a particular telephone system. Masaki is drawn to a multi-disk music player. There is not described any telephone functionality whatsoever. Masaki is not drawn to the same field of endeavor as the '984 patent, and this is not a close question.

The issue of whether Masaki is reasonably pertinent to the problem to be solved by the '984 patent is a much closer question. As relevant to Masaki, col. 2 lines 18-25 of the '984

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patent suggests that one problem with quiz telephone contests is overzealous participants.

Someone might call repeatedly to learn the questions, research the answers, then call again with knowledge of the correct answers. It is further noted that a point of the system is to limit such repeat-call advantages. Col. 2 lines 26-30. One way that this is done is by randomizing the cues given to the caller, so that he does not hear the same questions each time he calls.

Masaki is a multi-disk player for playing songs on compact disks. The system randomly selects a song to be played. It also keeps a record, in memory, of the songs that have already been played. When it is time to select the next song, the system will select a song that has not yet been played.

The '984 patent and Masaki therefore seem to have different purposes. The point of Masaki is to provide variety on the assumption that it provides more entertainment value. The '984 patent attempts to dissuade multiple uses and cheating in a contest. The purposes here are not really related, even if there is a similar solution.

Masaki is therefore not reasonably pertinent to the problem solved by the '984 patent. Masaki does provide a similar solution as that of the '984 patent. It is clear, however, that the fact that a reference might incidentally be able to solve the same problem posed by the inventor does not mean that it is reasonably pertinent to the problem solved. In *Klein*, cited above, the invention was drawn to a container for mixing nectar for feeding birds with a moveable divider so that different quantities of water and sugar could easily be added depending on the type of bird. *Klein*, 98 USPQ2d at 1991-92. Various references described containers with moveable dividers, though their point was to keep the contents thereof separate. *Id.* at 1993-95. The court agreed with *Klein* that in light of these different purposes, the references would not have been

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considered by the inventor and were not analogous art. *Id.* at 1995. Even though the references could solve the same problem, they were not drawn to the same problem, so they were not analogous.

Similarly here, there is no real reason that Masaki would have logically commended itself to the inventor's attention in considering this problem. The problem is "we want to prevent telephone contest entrants from calling over and over, essentially cheating by researching the contest questions." Masaki says "we can randomly select songs that haven't been played from compact disks." There is no reason for someone to look to Masaki when considering the inventor's problem. Masaki is therefore not analogous art and does not qualify as prior art for obviousness purposes. Both rejections relied on Masaki, and Masaki is essential because no other reference relied upon might even conceivably include use indications. The rejections are therefore withdrawn.

#### Bally – Printed Publication

Bally is relied upon in one of the two rejections. Patent owner states that nothing in Bally shows that it qualifies as a printed publication. Response p. 9. The examiner agrees.

A document is available as prior art only if it is a printed publication, which means that it has been shown to be disseminated or otherwise made available to the interested public. See MPEP 2128. The burden is on the proponent of the reference to show when it was available. *In re Hall*, 781 F.2d 897 (Fed. Cir. 1986). The Federal Circuit has held that specific evidence identifying when the specific document became available is not always needed. *Constant v. Advanced Micro-Devices, Inc.*, 7 USPQ2d 1057, 1062 (Fed. Cir. 1988) (evidence regarding

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company's normal treatment of certain class of documents sufficient to show when a particular document was accessible to public). But there must be *some* evidence that tends to show when the document was publicly available. Here, Bally is dated, but there is no evidence of when, if ever, it was made available to the public.

The argument is apparently that Bally was available with the Name That Tune arcade game console to any member of the public who purchased the console. The requester states that the game was released in 1986, the manual includes printed dates of 3/20/1986 and further includes a handwritten, barely legible date of 3/27/1986 above the note "Released for Production." Request p. 20. The requester further cites to an online Arcade Museum archive compiled by the "International Arcade Museum" as showing a 1986 date for the game. While this web page does include some manuals for other game consoles, there are none for Name That Tune. It is not known where the document provided with the Request came from. There is also no evidence that this document actually did come with the product.

An additional problem is that it is not clear that the entirety of what requester calls Bally is a single document, all having the same date. Yes, several pages include a March 1986 date. But one page has a 12/12/1985 date. And many other pages, including the page relied upon in the rejection, do not include any date. A "Parts List" is provided in the pages (at pp. 8-9) and many of the pages have different part numbers than other pages. The page relied upon in the rejection is part no. M051-00E54-A006; a wiring schematic labeled SAC 1A, having a 3/20/1986 date, has part no. M051-00C47-A003. Were these different parts a part of a single manual? Or were they made available at different times? It is not clear, and there is no explanation by requester.

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The examiner finds there is insufficient evidence to prove that the Bally manual, or the page relied upon in the rejection, was ever disseminated or otherwise made available to the public, and if it was, on what date that occurred. There is simply no evidence about the document provided by the requester, including where it came from and when it may have been made available. The dates, several printed and one handwritten, provide no proof in and of themselves. One can date a document and place it in a safe deposit box; it does not become a publication.<sup>1</sup> Furthermore, the fact that the product was apparently available to the public in 1986 provides little proof because we do not know that *this particular document* was made available with the product. It is possible that the document was a draft or a revised version that was never actually disseminated, even if some other version was. It is possible that a completely different version was actually disseminated with the product. It is possible that no manual was disseminated with the product. It is possible that the document is a complete fabrication. It is possible that the manual was made available only privately to the company's own installers.<sup>2</sup> There is simply no evidence on this record on which to base any conclusion. With no evidence, the Office cannot meet its burden in proving the document is a printed publication. The rejection based on Bally is withdrawn.

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<sup>1</sup> Even a document with a dated copyright registration is not a printed publication if it was not meaningfully disseminated or made available, for example by being indexed in searchable databases. *In re Lister*, 92 USPQ2d 1225 (Fed. Cir. 2009).

<sup>2</sup> This is not an instruction manual, for example explaining to users how to play the game. It is an operation manual, with information as to wiring, programming, and the like.

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***Conclusion***

All correspondence relating to this *ex parte* reexam proceeding should be directed as follows:

By U.S. Postal Service Mail to:

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

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

By hand to: Customer Service Window  
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Alexandria, VA 22314

Registered users of EFS-Web may alternatively submit correspondence via the electronic filing system at <https://efs.uspto.gov/efile/myportal/efs-registered>

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

Signed:

/James Menefee/  
Primary Examiner  
Central Reexamination Unit 3992  
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March 13, 2014

Conferees:

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Supervisory Patent Examiner, Art Unit 3992