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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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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/012,829*.

PATENT NO. *7822816*.

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)).

DETAILED ACTION

I. Summary

This office action is in response to the Patent Owner's response filed on November 13, 2013. Original claims 1-14 of the U. S. Patent 7,822,816 [hereinafter "the '816 Patent"] are pending in the present *ex parte* reexamination application.

II. Status of Claim(s)

The rejection of claims 1-14 is maintained.

III. Amendment to Claims 7 and 8

Patent Owner states that the amendments to claims 7 and 8 were made to correct typographical errors.

Examiner notes that claim 7 is amended to correct a typographical error because steps (j) and (k) are not recited in Claim 1, which Claim 7 is dependent from.

Claim 8 is also corrected to recite "placing said remote computer into **electronic** communication" instead of "**electrical** communication" in step (i). Examiner notes that step (l) of claim 8 recites "removing said remote computer from **electronic communication** with said second computer" [emphasis added]. Thus, since the amendments to these claims are only to correct typographical errors, the amendment has been entered herein.

IV. Claim Rejections

Claim Rejections - 35 USC § 103

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

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 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 negatived by the manner in which the invention was made.

Issue 1

2. Claims 1-3 and 5-14 are rejected under 35 U.S.C. 103(a) as being obvious over Rossmann in view of Rappaport (see pages 29-80 of the Request for Reexamination filed 04/03/2013, incorporated by reference).

These rejections on pages 29-80 of the Request for Reexamination filed 04/03/2013 are incorporated by reference.

Issue 2

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being obvious over Rossmann in view of Rappaport and Bowen (see pages 80-85 of the Request for Reexamination filed 04/03/2013, incorporated by reference).

The rejection for claim 4 on pages 80-85 of the Request for Reexamination filed 04/03/2013 are incorporated by reference.

Issue 3

4. Claims 1-14 are rejected under 35 U.S.C. 103 (a) as being obvious over Rossmann in view of Falls (see pages 85-170 of the Request for Reexamination filed 04/03/2013, incorporated by reference).

These rejections on pages 85-170 of the Request for Reexamination filed 04/03/2013 are incorporated by reference.

Issue 4

5. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being obvious over Benigno in view of Falls (see pages 170-277 of the Request for Reexamination 04/03/2013, incorporated by reference).

These rejections on pages 170-277 of the Request for Reexamination filed 04/03/2013 are incorporated by reference.

Issue 5

6. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being obvious over Benigno in view of Rappaport (see pages 277-349 of the Request for Reexamination 04/03/2013, incorporated by reference).

These rejections on pages 277-349 of the Request for Reexamination filed 04/03/2013 are incorporated by reference.

Issue 6

7. Claims 1, 2, 5, 7, 11, and 13-14 are rejected under 35 U.S.C. 103(a) as being obvious over Wright in view of Warthen, Rappaport, and Brookler, (see pages 349-390 of the Request for Reexamination 04/03/2013, incorporated by reference).

These rejections on pages 349-390 of the Request for Reexamination filed 04/03/2013 are incorporated by reference.

Issue 7

8. Claims 12 is rejected under 35 U.S.C. 103(a) as being obvious over Wright in view of Warthen, Rappaport, Brookler, and Rossmann (see page 384 of the Request for Reexamination 04/03/2013, incorporated by reference).

The rejection for claim 12 on page 384 of the Request for Reexamination filed 04/03/2013 is incorporated by reference.

Response to Arguments

9. Applicant's arguments filed November 13, 2013 have been fully considered but they are not persuasive.

Issue 1

Patent Owner

Regarding independent Claim 1, Patentee argues (PO Remarks, pp. 10-14) that Rappaport teaches a system and method for "maintaining connectivity" in a voice/data environment wherein voice is given priority over "time-insensitive" data streams. Patentee asserts that the term "server" cannot be found in Rappaport because the invention sits between the handheld and the server and is only designed to maintain connectivity between two devices that communicate over a network. Patentee further states that Rappaport's goal is maintaining continuously end-to-end network connectivity where possible so that the remote device is oblivious to being temporarily disconnected from the recipient of the communication.

With regards to the Rossmann's reference, Patentee argues that the word "disconnect" does not appear in Rossmann because while Fig. 8A shows a server connection in step 802, Rossmann does not handles the case where such a connection

is not available and, therefore, Rossmann does not provide for continuing with the operating logic until transmissions are sent and received from the server.

Patentee further argues that in the Request, p. 15, it is stated that "[f]urther, since each of the cards in the card deck can be transmitted through a single operation, the connection is effectively established and terminated with each transmission", but Patentee does not know what "effectively established and terminated" means because it appears that Requestor has created a "termination" in Rossmann where one is simply not disclosed. Patentee argues that "terminating" as recited in Claim 1 is not described in Rossmann because Rossmann's system would fail if the remote server is not available, i.e., if the connection to the remote server is not available via "termination". Patentee concludes that Rossmann does not teach "a method wherein when services are not available from a remote server, a questionnaire is executed on the local device", but instead Rossmann teaches continuous connectivity.

Patentee contends that combining Rossmann and Rappaport would provide a system wherein network connectivity between a mobile user and a remote computer is always present because both Rossmann and Rappaport teach abrupt failure of the associated program by active termination (Rappaport) or failure of program logic (Rossmann) if connectivity is not available and, therefore, the combination does not yield Patent Owner's invention.

Patentee disputes that Rappaport teaches a method of reconnection as stated in the obviousness statement (see non-final action, p. 20) because the only time a "reconnection" between the mobile user and the intended recipient can take place is if

the data transmission (or voice) is only temporarily suspended, but if the session is dismissed due to the unavailability of resources the connection is terminated and thereby no reconnection is possible. Patentee concludes that this is in contrast to his invention where "store and hold" during communication outages is explicit or at least inherent in the definition of "loosely networked".

Lastly, Patentee contends that the combination of Rossmann with Rappaport would be inoperable if Rossmann's connection to a remote computing device were actually terminated as is provided for in Rappaport. Patentee further contends that the combination of Rossmann and Rappaport is improver because Rappaport is non-analogous art.

Patentee concludes that Rossmann and Rappaport do not disclose, regarding claim 1, step (c) which requires a loosely networked connection; and step (h) which also requires a loosely networked connection and, therefore, claim 1 as well as dependent claims 2, 3, 6, and 7 are allowable over the cited prior art of record.

Regarding dependent claims 2, 3, 6, 7, Patentee states that for the same reasons stated above regarding claim 1, dependent claims 2, 3, 6, 7 are allowed.

As for dependent claims 5, Patentee states that for the same reasons that claim 1 is allowed, claim 5 is allowed as well. Patent Owner further argues that steps (a) and (d) of claim 5 are not disclosed since it requires transmitting an incremental change to a portion of the questionnaire and modifying the questionnaire.

As for independent claim 8, Patent Owner argues that steps (c) and (m) require "a loosely networked connection".

Patentee further argues that step (j) requires "transmitting incremental changes" and Patentee further argues that "there is no provision in Rossmann for transmitting changes to a card or a deck, only full decks". Patentee concludes that since neither Rossmann nor Rappaport disclose transmitting incremental updates of a card deck of Rossmann, there is no disclosure of incorporating such changes at the remote device [step (k)].

Regarding independent claim 11, Patent Owner argues that steps (d) and step (h) require "a loosely networked connection".

As for dependent claim 9-10, 12-14, Patentee states that for the same reasons stated above with respect to claims 8 and 11, these claims are allowed.

Examiner's response

Regarding Claim 1, in response to patentee's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). It is noted that Rossmann was relied upon for the limitation "server" [step (g) in Claim 1] and not Rappaport as argued by Patent Owner. It is further noted that Rappaport was relied upon for the teaching that when a connection fails…the device can reconnect and send the information upon reconnection (see non-final, p. 20) and not Rossmann as Patentee argues.

Regarding the argument of the statement on Page 15 of the Request, i.e., "[f]urther, since each of the cards in the card deck can be transmitted through a single operation, the connection is effectively established and terminated with each transmission" [emphasis added], it is clear from the statement that it is "the connection [that] is effectively established and terminated". Thus, Rossmann discloses "terminating…[a] connection" (see also Request, p. 36, Fig. 13, i.e. CONNECTION TERMINATED). Furthermore, the claims do not require, as patentee contends, "*a method wherein when services are not available from a remote server, a questionnaire is executed on the local device*". The claims merely require establishing a network connection, terminating a network connection and reestablishing a network connection.

As for the argument that combining Rossmann and Rappaport would provide a system wherein network connectivity between a mobile user and a remote computer is always present, Examiner respectfully disagrees because Rappaport teaches that when link failures occur between mobile users and a remote site, "users can continue to function essentially undisturbed by link failures since connectivity and reconnection procedures are managed by the network in a manner that is transparent to the end users" (Rappaport, Col. 2, ll. 44-58). Thus, Rappaport discloses a method of reconnection.

Patentee admits that Rappaport teaches a "reconnection" between the mobile user and the intended recipient, but argues that it takes place only when temporarily suspended. Examiner notes that the claims merely require reestablishing a network

connection and Rappaport teaches a method of reconnection (Rappaport, Col. 2, ll. 44-58).

With regards to the argument that Patentee's invention is to *"store and hold" during communication outages*, which is explicit or inherent in the definition of "*loosely networked*", Examiner would like to point out that these limitations are not recited in the claims. Further column 4, line 61-column 5, line 5 of the '816 patent states "With regard to the present invention, the term "loosely networked" is used to describe a networked computer system wherein devices on the network are tolerant of intermittent network connections and, in fact, tolerant of the type of network connection available. In particular, **if any communication connection is available between devices wishing to communicate, network transmissions occur normally, in real time**. If a network connection is unavailable at that moment, the information is temporarily stored in the device and later transmitted when the connection is restored. Unless otherwise specified, hereinafter the terms "network" or "networked" refer to loosely networked devices." This section allows a "loosely networked" connection to be "tolerant of the type of network connection available" including "if any communications connection is available between the devices wishing to communicate, network transmissions occur normally, in real time." Accordingly, the reference discloses that when connectivity is continuously available, a connection will exist. Communication will occur and be tolerant of the type of network connection available.

Further, the combination of Rossmann and Rapport still teach this limitation even as argued by the PO. As stated in the Request, "It would have been obvious to combine

Rossmann with Rappaport so that when a connection fails, as will predictably happen, the device can reconnect and send the information upon reconnection. This would motivate a person of skill in the art to make the combination since disconnections are a common occurrence and Rappaport teaches a method of reconnection. *See* Rappaport at Abstract." *Ex parte* Request at 27-28. The combination of Rappaport with Rossmann teaches a method that is tolerant of intermittent failures of a wireless connection.

With regards to Patentee's argument that the combination of Rossmann and Rappaport would be inoperable since if the connectivity is present the combination will work as Rossmann describes it, but in the instances for which the present invention was designed, i.e.,"loosely networked" connection, then the combination will fail, Examiner notes that "loosely networked" connection is not recited in the claims, however, as noted above, Rossmann and Rapport still teach this limitation because the combination of Rappaport with Rossmann teaches a method that is tolerant of intermittent failures of a wireless connection.

In response to patentee's argument that Rappaport is nonanalogous art, it has been held that a prior art reference must either be in the field of patentee's endeavor or, if not, then be reasonably pertinent to the particular problem with which the patentee was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both Rossmann and Rappaport are directed to two way data communication network for mobile terminals and a remote site (see Rossmann's and Rappapport's Abstracts).

Examiner respectfully disagrees with Patent Owner that Claim 1, step (c) and step (h) require “a loosely networked connection” because step (c) merely requires "establishing a...network connection" and steps (g)-(h) requires reestablishing a network connection.

Thus, for the above reasons the rejection of claims 1, 2-3, 6 and 7 is maintained.

Regarding independent claim 8, the Examiner disagrees that steps (c) and (m) requires “a loosely networked connection” because step (c) recites “***bringing a remote computer into electronic communication with said first computer***" and step (m) recites “***within said remote computer, using said modified tokenized questionnaire to obtain at least one additional user response***”.

Patent Owner admits that Rossmann transmits changes to full decks but not to a card or a deck (PO Remarks, p. 15). Examiner would like to point out that the claim as written it requires that the complete or full questionnaire is transmitted to the remote computer (see Claim 8, step (d)). Furthermore, Rossmann discloses that “to update an application requires only changes on the server computer and not changes in each two-way data communication device that communicates with that server computer. This invention eliminates the usual requirements for distribution of application software, and application software updates to the end user of the two-way data communication device” (see Request, p. 55, step (h), i.e., modifying…with incremental changes). Thus, Rossmann discloses “transmitting said incremental changes” as broadly recited in Claim

8, step (j) from the server to the user device because if a card deck is changed and transmitted then the incremental changes are also transmitted.

Furthermore, it is noted that Rossmann discloses that "the client process using the information transmitted from server computer 121, i.e., the cards, generates a wide-variety of user interfaces as illustrated in Figures 2A to 2H" (Rossmann, p. 11, ll. 15-16). Please note that Rossmann discloses, as shown in Figs. 2A-2H, that an initial card deck is transmitted to the user device as shown in Fig. 2A, and another card deck as shown in Fig. 2B and other card decks as shown in Fig. 2C-2H, respectively (Rossmann p. 9, l. 4 to p. 11, l. 20). Thus, every card deck transmitted shows incremental changes such as shown in Fig. 2G "Fax details to what number" and Fig. 2H shows "(415) 341-4473" (Rossmann, p. 9, l. 47 - p. 10, l. 3) and thereby making and transmitting incremental changes to a portion of a questionnaire.

Regarding independent claim 11, Examiner disagrees that steps (d) and step (h) requires "a loosely networked connection" because step (d) recites "***placing a handheld remote computing device into electronic communication with said first computer***" and step (h) recites "***placing said handheld remote computing device into electronic communication with a second computer***".

As for dependent claim 2, 3, 5-10, 12-14 for the same reasons stated above with respect to claims 1, 8, and 11 the rejection of claims 2-3, 5-10, 12-14 is maintained.

Issue 2

Patent Owner

Patentee argues that for the same reasons stated above with regards to claim 1, dependent claim 4 should be allowed or confirmed.

Examiner's response

Examiner incorporates by reference the reasoning presented above with respect to claim 1. Thus, the rejection of claim 4 is maintained.

Issue 3

Patent Owner

Patent Owner contends that the combination of Rossmann and Falls would be inoperable or unsuitable for its intended purpose and that Rossmann's approach teaches away. Patentee argues that Rossmann intends that the cards are fetched as needed due to reasons related to bandwidth and storage capacity of the phone and, therefore, Rossmann's cards are fetched when such are required by user's selections.

Patentee further argues that the Falls reference teaches synchronization of databases wherein changes that are made to one database will be communicated to another when the two are brought into electronic communication. Patentee concludes

that the teaching in Falls would frustrate the purpose of Rossmann which is a real-time application.

Patentee asserts that Rossmann assumes the connection will always be present and there is no provision for instances when the server cannot be reached and, therefore, the combination would be inoperable.

Patentee argues that combining Rossmann and Falls would result in an invention that synchronizes the cards between the server and the client device, but patentee argues that there is no mention of database synchronization between the server and the phone in Rossmann and there is no indication that a client would be able to accommodate synchronization of a server-side database.

Patentee concludes that Rossmann and Falls do not disclose, regarding claim 1, step (c) which requires a loosely networked connection; and step (h) which also requires a loosely networked connection and, therefore, claim 1 is allowable over the cited prior art of record.

Regarding dependent claims 2-7, Patentee states that for the same reasons stated above regarding claim 1, dependent claims 2-7 are allowed.

As for independent claim 8, Patent Owner argues that steps (c) and (m) require "a loosely networked connection".

Regarding independent claim 11, Patent Owner argues that steps (d) and step (h) require "a loosely networked connection".

As for dependent claim 9-10, 12-14, Patentee states that for the same reasons stated above with respect to claims 8 and 11, these claims are allowed.

Examiner's response

Regarding claim 1, Examiner notes that Patent Owner's arguments are not commensurate with the claimed invention. Specifically, Patent Owner's arguments that the combination would be inoperable because Falls invention is contrary to Rossmann's real-time application in that "Rossmann intends that the cards are fetched as needed" and that Rossmann's program would progress until a new card was required [or requirement of the connection always present] and then stop and, therefore, it would not continue until after it had been brought into electronic communication with the server, Examiner notes that these arguments are not commensurate with the recited limitations. Furthermore, please note that the argument that Rossmann does not mention "database synchronization between the server and the phone" is not persuasive since this statement is not related to any aspect of the claim.

The combination provides for a system that can encounter and recover from failed or terminated connections. Specifically, Falls teaches that mobile devices can terminate connections and then reestablish those connections. Falls at 3:16-35, 16:24-29, and 7:16-21. Upon reestablishment of the connection, any requests will be processed and transmitted. *Id.* Accordingly, the combination solves the problem of inevitable connection failure and does not change the principle operation of the primary reference or render the reference inoperable for its intended purpose.

Regarding independent claim 8, the Examiner disagrees that steps (c) and (m) requires "a loosely networked connection" because step (c) recites "***bringing a remote computer into electronic communication with said first computer***" and step (m) recites "***within said remote computer, using said modified tokenized questionnaire to obtain at least one additional user response***".

Regarding independent claim 11, Examiner disagrees that steps (d) and step (h) requires "a loosely networked connection" because step (d) recites "***placing a handheld remote computing device into electronic communication with said first computer***" and step (h) recites "***placing said handheld remote computing device into electronic communication with a second computer***".

As for dependent claim 2-7, 9-10, 12-14 for the same reasons stated above with respect to claims 1, 8, and 11 the rejection of claims 2-7, 9-10, 12-14 is maintained.

Issue 4

Patent Owner

Regarding claim 1, Patent Owner argues (PO Remarks, pp. 19-23) that there is no evidence that Benigno's questionnaire language is customizable to run on any other than a single platform whereas Patent Owner's "tokens" are designed to be device independent and "some of which must be executable on multiple types of clients". Patent Owner relies on the following portions of the '816 Patent specification for support of the previous statements as follows:

> "Any program developed under the inventive system will run on any handheld computer equipped with the OIS and files on one such handheld will transfer freely to any other handheld or any computer connected to the inventive system." ('816 Pat., Col. 7, lines 41-45)
>
> "The operating system provided in each computer device allows the use of a common instruction set in any such device, regardless of compatibility issues between the devices, wherein "instruction set" is used herein to mean the commands, tokens, etc., that are recognized by the operating system as valid instructions." *Id* at Col. 5, lines 12-17
>
> "Each token preferably corresponds to a logical, mathematical, or branching operation and is preferably selected and made a part of the questionnaire through a graphical user interface." *Id* Col. 8, lines 43-46.

Patentee argues that "device independent" is an inherent property of Patent Owner's "tokens" as cited above. Patentee further states that "at least some tokens...must correspond to programming functions, e.g., logical, mathematical, or branching operation.

Patent Owner concludes that Benigno's tokens are not patentee's tokens because Benigno's tokens are not designed to be device independent and, therefore, Benigno does not teach or suggest such a device independent approach.

Patent Owner further argues that Fig. 4 of Benigno and 46:4-9 indicate the same computer at each one and there is no support that Benigno was intended to be multiplatform. Patent Owner argues that the client computer 401 mentioned in

Benigno's specification was never taught or suggested that such computer could be other than the same platform. Patent Owner asserts that it would be simpler and more efficient to implement the questionnaire language on a single platform, rather than make it device independent.

Patent Owner argues that Benigno uses login/logout which suggests that the user is executing a program on the server, not downloading the program locally and executing it. Patentee addresses Figs. 1A and 2A of Benigno to show that a user queries a database on a remote server and the connection steps 102 and 105, i.e., “COMMUNICATE WITH HOMEOPT SERVER" cannot be said that are on the same computer. Patent Owner states that the claims require that the steps of establishing a connection, getting a questionnaire, executing the questionnaire must all be performed on the same device and it cannot be said that the questionnaire of Benigno is executed on the client computer because apparently Benigno's users execute a program on the server. Patent Owner states that in Benigno, if the connection fails, the information must be encoded manually and cites the following from Benigno:

> “Otherwise, step 128 is encountered. In step 128, an alert is set at the client computer 401, indicating that the transmission between the client computer 401 and server was unsuccessful, allowing the nurse to manually provide the data to the physician, or other personnel at the central location e.g., via voice telephone, etc.)” (Benigno at page 48, lines 1-4)

Patent Owner asserts that there is no indication that the client processes a questionnaire after connection with the remote server is terminated.

Lastly, Patent Owner argues that Benigno teaches away from a loosely networked connection and that Claim 1, steps (c) and (g) requires a loosely networked connection and further argues that there is no indication in Benigno that the tokens are executed on the client side or that the connection to the server is terminated during the questionnaire.

Regarding claims 2-14, Patent Owner repeats similar arguments as stated above with regards to claim 1.

Examiner's response

Regarding claim 1, in response to Patent Owner's argument that the references fail to show certain features of the invention, it is noted that the features upon which Patent Owner relies (i.e., *"tokens are designed to be device independent"; "some of [the tokens] must be executable on multiple types of clients"; "loosely networked connection"; "the connection to the server is terminated during the questionnaire")* are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

It is noted herein that Benigno's tokens are also executable tokens because correspond to a Questionnaire Language (QL) that contains logical operations (Benigno, p. 13, ll. 1-18; pp. 38-45, ll. 14-20).

Regarding the repeated Patent Owner's argument that Fig. 4 of Benigno and 46:4-9 indicate the same computer at each node, Examiner reiterates that Fig. 4 shows generic computers. Furthermore, contrary to Patent Owner's assertions, Benigno discloses that "[w]hile the present invention has been described in terms of particular data structures and data flow, **the computational steps could be carried out by any Von Neuman machine,*i.e.*, the processing means can be any programmable digital computer, whether imbedded into a device or not or whether part of a network or not**" [emphasis added] (Benigno, p. 20, ll. 14-17). Thus, Benigno suggests that any computer whether part of a network or not could be used in his invention and, therefore, being device independent.

With regards to the argument that there is no indication that the client processes a questionnaire after connection with the remote server is terminated, Examiner notes that Benigno discloses the following:

> "[i]n step 107 the nurse may carry out orders created by the physician and transmitted in steps 102 and/or 105 from the server 402 to the client computer 401. The results of such orders may generate a flow of care to be followed by the nurse, and/or may generate alerts, etc. In step 109, the nurse records in the client computer 401 compliance or non-compliance with the orders. If non-compliance, the reasons are also

> stored. [A]gain, **all such stored data may later be transmitted back to the server 402**.
>
> In step 110, **the client computer 401 communicates with the server 402, in order to update both the computer 401 and server 402 as in steps 102 and 105**"

(Benigno, p. 46, ll. 22-28).

Benigno teaches that the nurse records compliance or non-compliance with the orders or nurse inputs are all stored in the client computer 401 and may be later transmitted back to the server 402 such as in step 110 wherein both computers 401 and 402 update. The compliance or non-compliance inputs from the nurse correspond to part of the questionnaire, which data is stored in the client computer 401, and can be later transmitted back to the server. Thus, Benigno teaches that the client computer 401 processes the questionnaire after connection with remote server is terminated.

As for claims 2-14 for the same reasons stated above with respect to claims 1, the rejection of claims 2-14 is maintained.

Issue 5

Patent Owner makes the same arguments as presented above for Issue No. 4 (see PO Remarks, pp. 23-25). Thus, Examiner incorporates by reference the rebuttals as set forth in Issue 4. Furthermore, with regards to the argument that Rappaport's quote is aspirational and not consistent with the material presented in the application,

Examiner respectfully disagrees because Rappaport teaches that when link failures occur between mobile users and a remote site, "users can continue to function essentially undisturbed by link failures since connectivity and reconnection procedures are managed by the network in a manner that is transparent to the end users" (Rappaport, Col. 2, ll. 44-58). Thus, Rappaport discloses a method of reconnection.

For the above reasons, the rejection of claims 1-14 over Benigno in view of Rappaport is herein maintained.

Issue 6

Patent Owner

Regarding claim 1, Patent Owner contends (PO Remarks, p. 25-29) that Warthen's tokenizer merely separates a sentence into individual words or group of words and thereby Warthen token is just a word, but it does not represent the word. Patent Owner further argues that Warthen's operations occur locally on the server side and the results are used there and, therefore, there is no transmission of a tokenized questionnaire to a remote computing device. Patent Owner asserts that there is no motivation to combine and that neither Wright nor Warthen suggest a token may be executable.

With regards to the Rappaport Reference, Patent Owner argues that Rappaport is non-analogous art and that there is no teaching of "loosely networked". Patentee states that Rappaport does not discuss how his invention would keep any of the other

references from either hanging or returning a "not available" message when access to the network is made during his outages.

As for the Brookler reference, Patent Owner asserts that neither Fig. 1 nor Brookler at [033] support requestor's statement. However, Patent Owner admits that (Brookler, Fig. 1 and [033]) show that a respondent has a choice in the type of instrument used to respond and that a surveyor has a choice in the type of instrument used to review the results.

Patent Owner states that claim 1 step (c) requires a loosely networked connection which is not suggested in any of the cited references; step (d) requires transmitting tokens and Warthen teaches that his tokens are used internally; (f) requires executing at least a portion of said plurality of tokens which is not suggested by any of the cited references.

Patent Owner contends that the combination of Wright, Warthen, Rappaport, Brookler, and Rossmann is an application of hindsight reconstruction of Patent Owner's claimed invention.

Regarding dependent claims 2 and 6, Patent Owner states that for the reasons stated above with regards to claim, these claims should be allowable.

As for claims 5, 14, Patent Owner states that step (a) requires making an incremental change to apportion of the questionnaire which is not suggested in any of the cited references and, therefore, it cannot be tokening of the change, transmitting of the change or modification of the questionnaire.

As for claim 7, Patent Owner argues that this claim requires the tokens to be executable on multiple types of devices but none of the cited prior art support platform independence.

As for independent claim 11, Patent Owner states same arguments as presented above with regard to claim 1.

As for dependent claims 12-14, Patentee states that for the same reasons stated above with regards to claim 11 claims 12-14 should also be allowed.

Examiner's response

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

Patent Owner admits that Warthen teaches that "Tokenizer 150 converts the initial user query into a list of words and provides the list to parser 155" but argues that "[a] Warthen token is just a word: it does not represent the word". This argument is not persuasive because Warthen teaches that a system can have a "[t]okenizer 150 convert[] the initial user query into a list of words and provides the list to parser 155. One structure for conversion is an augmented transition network. Another approach to **tokenizing is to scan the initial user query and group the words into conceptual strings**, removing plurals and suffixes." [Emphasis added] Warthen at 5:28-33.

The claims recite "tokenizing said questionnaire; thereby producing a plurality of tokens representing said questionnaire." Specifically, the Warthen tokenizer "converts the user query into a list of words" via an "augmented transition network." So Warthen is converting, i.e., producing, a list of words, i.e., plurality of tokens, that provides a list, i.e., representing said questionnaire, to a parser. This is entirely consistent with what the '816 patent describes for tokens: "As the client enters questions and selects response types, server 24 builds a stack of questions and responses, and assigns indices, or tokens, which point to each question or response." '816 patent at 8:41-43.

Patentee further argues that "there is no transmission of a tokenized questionnaire to a remote computing device because Warthen's tokenizing operations occur locally on the server side". However, Wright was relied upon for transmitting a questionnaire to a remote computing device and Warthen was relied upon for the limitation "tokenizing said questionnaire".

In response to Patent Owner's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, Wright teaches the use of surveys and Warthen teaches it was known in the art to

tokenize a survey and, therefore, it would be obvious to combine the teachings of Wright with the tokenizing system of Warthen because it would provide an improved system for electronic surveys with feedback (see Wright, Abstract).

In response to Patent Owner argument that Wright or Warthen does not suggest that a token may be executable, Wright teaches that a form engine "interprets one field at a time." Wright at Abstract. For a question to be interpreted by a form engine, it must be executed, thereby being a "token" as argued by Patent Owner.

Claim 1 does not recite "loosely networked" as Patentee asserts. Further column 4, line 61-column 5, line 5 of the '816 patent states "With regard to the present invention, the term "loosely networked" is used to describe a networked computer system wherein devices on the network are tolerant of intermittent network connections and, in fact, tolerant of the type of network connection available. In particular, **if any communication connection is available between devices wishing to communicate, network transmissions occur normally, in real time**. If a network connection is unavailable at that moment, the information is temporarily stored in the device and later transmitted when the connection is restored. Unless otherwise specified, hereinafter the terms "network" or "networked" refer to loosely networked devices." This section allows a "loosely networked" connection to be "tolerant of the type of network connection available" including "if any communications connection is available between the devices wishing to communicate, network transmissions occur normally, in real time." Accordingly, the reference discloses that when connectivity is

continuously available, a connection will exist. Communication will occur and be tolerant of the type of network connection available.

Further, the combination of Wright, Warthen, and Rappaport still teach this limitation even as argued by the PO. As stated in the Request, "It would have been obvious to combine Wright and Warthen with Rappaport so that when a connection fails, as will predictably happen, the device can reconnect and send the information upon reconnection. This would motivate a person of skill in the art to make the combination since disconnections are a common occurrence and Rappaport teaches a method of reconnection. *See* Rappaport at Abstract." (see Request, pp. 349-350).

In response to Patent Owner's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Regarding claims 5, 7, 11 and 14, Patent Owner's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

As for claims 2, 6, 12-13, the same reasoning stated above with regards to independent claims 1 and 11 apply as well for these claims.

Thus, the rejection of claims 1, 2, 5, 7, 11, 12-14 is maintained herein for the reasons set forth above.

Secondary Considerations

Long-Felt but Unmet Need

Patent Owner contends (PO Remarks, pp. 30-31 and McGill's Declaration, par. 7-8) that wireless mobile data collection suffered from many shortcomings at the time of the present invention such as: very slow, low bandwidth connections; highly intermittent networks; data transmissions were unreliable and data loss was a risk; web access was unreliable and subject to data loss; programs were typically not device independent, programs for one type of device had to be recompiled, and partially rewritten, to adapt to a different device; an incremental change to a program required recompiling and reloading on the mobile devices, etc.

Patent Owner further asserts that the present invention addressed the limited bandwidth problem set forth above by the use of "tokenizing" as recited in claims 1, 4, 5, 8, and 11 and the use of a "loosely networked" environment to address unreliable connections and data loss as recited in claims 1 step (c) and (g), claim 8 steps (c), (i) and (n), and claim 11 steps (d) and (h). Patent Owner also contends that there was a need for "device independence" in order to execute the questionnaire on multiple types

of remote devices as recited in claim 7 and claim 8 and the ability to “incrementally update the questionnaire" (claim 5, claim 8 steps (h)-(m), and claim 14).

Examiner notes that this need was met by the prior art since the prior art used “tokenizing”, executing a questionnaire on multiple types of remote devices, and updating the questionnaire as shown in the rejections.

It is further noted that Patent Owner asserts that independent claims recite "loosely networked", however, as stated above claims 1, 8 and 11 do not recite the alleged limitation.

Thus, Patent Owner’s comments directed to Long-Felt Need are insufficient.

Professional Approval

Patent Owner contends (PO Remarks, p. 31 and McGill’s Declaration, par. 9-10) that in 2002 Macrosolve was able to secure an Exclusive Marketing Partnership Agreement with Palm, who was the recognized leader in handheld computing, based solely on the technology described in the ‘816 provisional patent application.

Patent Owner further contends that in 2003, Sprint was recognized as a data network market leader and Macrosolve was able to secure a loose partnership with Sprint in 2003, which became an exclusive relationship in early 2004. Due to this agreement, Macrosolve placed personnel in five regional Sprint offices to sell the REFORM product on which at least claim 1 of the ‘816 patent directly reads.

Examiner notes that Patent Owner has failed to provide factual evidence between the professional approval and the claims of the '816 patent and, therefore, Patent Owner arguments are unpersuasive.

Licensing

Patent Owner asserts (PO Remarks, p. 31 and McGill's Declaration, par. 11-12) that Macrosolve has licensed the '816 patent to at least 63 companies and generated more than $4.6 million in revenue from its licensing program and that the '816 patent and its progeny are presently the only patents in the Macrosolve patent license portfolio.

Examiner notes that Patent Owner comments are insufficient since Patent Owner has failed to provide a nexus between the licensing and the claimed subject matter supported by actual proof.

Copying by Others

Patent Owner further asserts (PO Remarks, p. 31 and McGill's Declaration, par. 13) that Macrosolve has identified at least 118 companies which Macrosolve alleges to infringe the '816 patent and further asserts that more than half of these companies have entered into license agreements with Macrosolve.

However, as Examiner noted above, Patent Owner has failed to provide a nexus between the licensing and the claimed subject matter supported by actual proof. Thus, Patent Owner's comments are insufficient and unpersuasive.

Commercial Success

Patent Owner contends (PO Remarks, p. 31 and McGill's Declaration, par. 14-16) that based directly and/or indirectly on using methods claimed in the '816 patent, Macrosolve entered contracts with companies that generated at least $17 million in revenue wherein indirect revenue includes hardware and program development services related to the patented process.

Patent Owner further asserts that the BAMA Company, Inc. and McDonald's entered into agreements for MacroSolve to produce software for use by secret shoppers by carrying a handheld device and answering a questionnaire wherein the questionnaire was created and tokenized on a server at MacroSolve. The tokenized questionnaire was downloaded to the appropriate secret shopper via a loosely network connection. At least some of the tokens were executed on the hand held device carried by a secret shopper. The responses to the questionnaires were transmitted back to a server at MacroSolve via a loosely networked connection, collected, and incorporated into reports delivered to the customer. These applications were covered by at least Claim 1 of the '816 patent.

Furthermore, Patent Owner states that Macrosolve also partnered with TGI Friday's, Inc., in the development of a location, coupon, and customer loyalty program still in use today. This application covered by at least claim 1 of the '816 patent.

Examiner notes that no factual evidence has been provided for the alleged commercial success. Furthermore, Patent Owner argues that tokenized questionnaire was downloaded to the shopper via a "loosely network connection", but as argued

above claim 1 does not recite such limitation and, therefore, the statement that these applications were covered by at least Claim 1 is improper.

Conclusion

10. **THIS ACTION IS MADE FINAL.**

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

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

Extensions of time in reexamination proceedings are provided for in 37 CFR 1.550(c). A request for extension of time must 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 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.

11. 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. 7,822,816 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.

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

By EFS: registered users may submit via the electronic filing system EFS-Web, at https://efs.uspto.gov/efile/myportal/efs-registered

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

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

By hand: Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the data of transmission, which is prior to the expiration of the set period of time in the Office action.

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

/Zoila Cabrera/
Reexamination Specialist
Central Reexamination Unit 3992

Conferees:

/Ovidio Escalante/

/ALEXANDER KOSOWSKI/

Supervisory Patent Examiner, Art Unit 3992