

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Katz)	Customer No.: 35,554
)	
Re-examination Proceeding:)	Confirmation No.: 3202
)	
Control No. 90/012,400)	Group Art Unit: 3992
)	
Filed: July 20, 2012)	Examiner: Stephen J. Ralis
)	
For: Telephone interface call processing)	
system with call selectivity)	
(U.S. Patent No. 5,974,120))	
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RESPONSE IN EX PARTE REEXAMINATION

Mail Stop Ex Parte Reexam
Commissioner for Patents
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This communication is in response to the Final Office Action (“FOA”) mailed September 4, 2013. The FOA maintains the rejections of claim 61 of U.S. Patent No. 5,974,120. The Patent Owner respectfully maintains the positions set forth in the Patent Owner’s March 18, 2013 response to the prior non-final action, including the expert declaration of Dr. Arthur T. Brody, Ph.D. submitted therewith (collectively “Prior Response”).

The Prior Response is hereby incorporated by reference in its entirety. The Patent Owner respectfully urges reconsideration of the rejections.

The Patent Owner also further responds to the FOA as set forth herein.

I. FIRST GROUND OF REJECTION: CLAIM 61 UNDER 35 U.S.C. § 103 IN VIEW OF CALABRESE AND STUDENT REGISTRATION.

The Patent Owner respectfully maintains that the first ground of rejection of claim 61 is unsupported and should be withdrawn for the reasons set forth in the Prior Response.

The Prior Response established that Calabrese is not prior art because claim 61 is entitled to a priority date no later than May 16, 1988, the filing date of the '739 patent. The FOA does not change that showing. The Patent Owner responds to the FOA as follows.

A. The FOA does not properly account for the expert opinion evidence.

The FOA asserts that the “Declaration provided by Dr. Brody does not provide any further evidence as to the possession of ‘cue suppression’ in the ‘739 patent in order to establish an earlier priority date (i.e. 16 May 1988),” and “does not provide evidentiary support to overcome the prima facie rejections of . . . Claim 61.” (FOA at 36.) The Patent Owner respectfully disagrees. While Dr. Brody may cite some of the same passages from the ‘739 patent and the asserted references as the Patent Owner cites, the declaration provides new relevant evidence, in the form of expert opinions, regarding the understanding of a person of ordinary skill in the art at the time of the invention.

B. The ‘739 patent discloses the “utilizing” step in a “preregistration” or “prequalification” process.

The FOA first addresses the “prequalification” embodiment disclosed in the ‘739 patent. The FOA acknowledges that “a cue or prompt is not provided for a ‘prequalified’ or ‘preregistered’ caller due to information already having been entered.” (FOA at 40.) However, the FOA asserts that “the caller is still not qualified when the cue or cues are avoided.” (FOA at 40.)

The FOA’s interpretation of the prequalification embodiment is unfounded. As previously set forth in the Prior Response, after the prequalification process in an earlier call, at the time of the subject call the preregistered caller is permitted to continue based on a test of their identification information (such as ANI or caller-entered telephone number). Based on this test of caller identification data, the system determines that the caller is qualified for participation (e.g., the caller was already pre-qualified and may continue in the call to participate in the process). The process accordingly satisfies the claim language:

120:56[e]	testing said identification signals relating to the callers to determine whether to qualify the callers for access to at least a portion of operations of the system;
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120:56[f]	utilizing, for qualified callers, the identification signals relating to the callers, to avoid prompting certain callers with a certain previously provided cue or cues; and
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The FOA asserts that when the system avoids providing the previously provided cue or cues, the avoidance is only for “non-qualified callers’, since the caller’s identification signals have not yet been tested.” (FOA at 40.) That is incorrect. First, the FOA does not appreciate that the specification expressly describes that the “preregistration” process is performed to ensure that the caller is “qualified” for the subsequent event (e.g., telephonic auction).

The specification states: “in the case of preregistration for a participant, as in the case of the auction sale, the memory 98 is involved with the qualification unit 93 through the processing unit 92 *to establish a data cell C1-Cn for each **qualified** participant.* Thus, *each potential participant to be **qualified*** interfaces with the processing unit 92 during a preliminary interval of operation to provide data in one of the cells C1-CN to facilitate **qualification** for participation during a real-time game show.” ‘739 col. 16:55-17:6 (emphasis added). Then, “[a]t the time of the show, callers are qualified simply by reference to their assigned memory cell data for a verification.” ‘739 col. 17:7-9.

Thus, the system avoids the preregistration cues for qualified callers. At the time of the auction, the caller dials in and the system tests the caller’s identification data. The only way the system can know that the caller is “preregistered” is by testing the caller’s identification information. Based on that testing, the system determines that the caller is qualified, and thus the system avoids providing to that qualified caller the cues that were previously provided in the preregistration process.

C. The ‘739 patent discloses the “utilizing” step in avoiding repetition of cues in the game show embodiment.

The FOA also addresses the game show embodiment, which is a separate and independent disclosure of the “cue suppression” limitations. The FOA asserts that “[t]here is no explicit disclosure in the ‘739 patent of the caller calling back to participate in the contest.” (FOA at 42.) But the FOA overlooks the express description that the system checks “*to determine whether or not an excessive number of calls have originated from the designated*

number.” ‘739 col. 18:35-38 (emphasis added). As discussed in the Prior Response, this expressly discloses that some callers will call back multiple times to participate in the contest.

The FOA further asserts that if a caller were to call back, “there is no disclosure of any randomly generated previously presented cue or cues not being presented to the caller of the same geographical area.” (FOA at 42.) But again, the FOA overlooks the express description, in the same paragraph immediately following the discussion of the “excessive number of calls,” that “*addressing may obtain selectivity on the basis of calling numbers.*” ‘739 patent, col. 18:38-42 (emphasis added). As discussed in the Prior Response, the system tests to determine where a single caller who has not done an “excessive number of calls” from the caller’s calling number, as explained above, would be given different questions. This exhibits the “selectivity on the basis of calling numbers” that the specification teaches as cited above. As discussed in the Prior Response, inherently, because each caller may call and play the game multiple times, the “different questions” provided to the caller necessarily avoid giving each qualified caller the same questions that were previously provided to that caller, based on the caller’s telephone number.

Because Calabrese is not prior art, the rejection of claim 61 is not supported and the Patent Owner respectfully requests that it be withdrawn.

II. SECOND GROUND OF REJECTION: CLAIM 61 UNDER 35 U.S.C. § 103 IN VIEW OF MOOSEMILLER, STUDENT REGISTRATION, AND SZLAM.

The FOA’s only further discussion of the second ground of rejection is to discuss the alleged motivation to combine Student Registration, Szlam, and Moosemiller. (FOA at 46-49.) The Patent Owner maintains the Prior Response, which sets forth why the rejection is not supported, and further responds to selected points in the FOA as follows.

The FOA repeats the assertion that (1) Moosemiller and Student Registration would have been obvious to combine, and (2) that Szlam’s asserted “utilization of ANI information to automatically provide account information” supports obviousness. (FOA at 47-48.) But the Patent Owner maintains that this piecemeal approach, separately proposing individual sub-combinations, does not demonstrate obviousness of the complete invention.

The FOA seems to suggest that “automation in any way, shape, or form” by using ANI instead of caller-entered data would have been obvious. (FOA at 48.) But the FOA’s reasoning

is not supported by the evidence. With respect to Szlam and ANI in particular, the FOA does not address at all—much less substantially rebut—the Patent Owner’s evidence and explanation as to why it would not have been obvious to use ANI in the Student Registration context in the manner the Examiner has asserted. As set forth in the Prior Response, in the context of the student registration system at issue, using ANI would not enhance the caller’s experience, but would in fact be detrimental to the calling student’s experience and would have decreased the practicability and efficiencies of the system. The Student Registration system instead used the calling student’s ID number to identify the student—a much more suitable way to identify the student in the applicable context. The Patent Owner’s evidence and reasoning, showing why the proposed combination was not obvious, remains substantially un-rebutted.

In sum, it remains the case that it would not have been obvious to combine these three disparate references to achieve the invention of claim 61. Withdrawal of the rejection is earnestly solicited.

III. CONCLUSION

In sum, Appellant respectfully submits that claim 61 of the ‘120 patent is non-obvious in view of the asserted art. Therefore, the Examiner’s rejections should be withdrawn.

Respectfully submitted,

COOLEY LLP

Dated: November 4, 2013

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Certificate of Service

RE: Reexamination Proceedings of: Katz
PTO Control Number: 90/012,400
U.S. Patent No. 5,974,120

I certify that a copy of RESPONSE IN EX PARTE RE-EXAMINATION was served today via First Class Mail on the date identified below to:

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Houston, TX 77002

Dated: November 4, 2013

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Electronic Acknowledgement Receipt

EFS ID:	17303203
Application Number:	90012400
International Application Number:	
Confirmation Number:	3202
Title of Invention:	TELEPHONE INTERFACE CALL PROCESSING SYSTEM WITH CALL SELECTIVITY
First Named Inventor/Applicant Name:	5974120
Customer Number:	58249
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File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Reexam Response to Final Rejection	90012400_Response_to_Final_Office_Action.pdf	268665 a71088c6c509387e130b796c096cc896e9de3cda	no	5

Warnings:

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2	Reexam Certificate of Service	90012400_Certificate_of_Service.pdf	22900 <small>779b97f1cd08a0e863c24ef40bfce87ede4a199</small>	no	1
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