

I. The Rejections Are Unsupported and Should be Withdrawn.

As set forth in the prior response, the cited references (the continuation parent Katz ‘739 patent and the later related Katz ‘984 patent) are not prior art to the ‘134 patent claims because the ‘134 patent claims are properly supported by the specification of the parent ‘739 patent. The Patent Owner respectfully disagrees with the Examiner’s contrary assertions and provides the following response to the new arguments and statements provided in the final office action. (See also Brody ¶¶ 1-17.)

A. Claims 1, 4, and 5 Are Entitled To the ‘739 Patent Priority Date.

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

The Examiner asserts that the “prequalification” embodiment does not disclose the claimed cue suppression. (FR at 28-32.) The Patent Owner respectfully disagrees, and maintains the showing of written description support set forth in the prior response.

The Examiner asserts that in the pre-qualification operation, “there is no explicit disclosure indicating what steps are performed . . . or how the preliminary arrangements/cues were provided.” (FR at 29.) The Examiner further queries whether the pre-qualification information was obtained through the telephonic interface, as opposed to being provided “via postal mail” or some other way. (*Id.*) The Examiner also wonders whether the “same preregistration cue or cues” are suppressed, because the patent does not explicitly describe all of the preregistration cues. (*Id.* at 31.) Finally, the Examiner raises a new issue that the alleged “single species” of cue suppression disclosed in the ‘739 patent does not disclose the so-called “genus” of cue suppression as claimed. (*Id.* at 32.)

Respectfully, the Examiner’s queries miss the point and do not appreciate the express disclosure of the ‘739 patent. It is not necessary for the patent to explicitly describe the specific questions/prompts that are provided. The ‘739 patent discloses the concept—the “genus” in the Examiner’s words—of cue suppression as claimed, where certain qualified callers have cues suppressed. (Brody ¶¶ 5-10.) As set forth in the prior response, the relevant disclosure in the ‘739 patent is that the system must prompt the caller to provide pre-qualification information, and in response the caller provides authorization information to the system, such as described at col. 14:39-58, 16:58-17:6, and 16:43-50. The patent expressly describes that the pre-

qualification is performed using the telephonic interface system: “persons wishing to participate in the auction sale would make preliminary arrangements involving *utilization of the system to establish authorization data for qualified bidders in cells C1-Cn of the memory 98* (FIG. 4),” and “*in the case of preregistration for a participant . . . 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,*” and “*prior to participating in an actual game show, interested participants interface the system as depicted in FIG. 1, and in the course of an exchange as described above, the qualification unit 93 and the designation unit 96 cooperate with the processing unit 92 to accomplish preliminary data on potential participants in cells of the memory 96.*” As discussed in the prior response, these passages clearly teach that the caller interfaces with the system—being prompted to provide information in an “exchange” with the telephonic interface—to achieve the pre-registration. (Brody ¶ 7.)

Then, “at the time of the show, callers are qualified simply by reference to their assigned memory cell data for a verification.” (‘739 col. 18:7-38.) The pre-registration prompts are not provided, and instead, the system avoids providing those prompts to the certain qualified callers who have been pre-registered. Furthermore, after the cue suppression operation, “[t]hereafter, the callers exchange information to supplement their data as with respect to the play which follows”—which necessarily involves prompts to the callers for the callers to exchange information with the telephonic interface system. ‘739 patent, col. 17:1-11 (emphasis added). (Brody ¶ 9.)

This discloses the cue suppression limitations to a person of skill in the art at the time of the invention. This is not mere disclosure of one “species” but rather disclosure of the invention. (Brody ¶¶ 7-10.)

Moreover, there is no “enablement” issue here as the Examiner suggests (page 35). First, as a legal matter, the Patent Owner maintains that an enablement challenge is not a proper inquiry in this reexamination proceeding. The Examiner does not cite any legal authority providing for examination of an alleged enablement issue in *ex parte* reexamination. (Brody ¶¶ 15-16.)

Further, on the merits, the ‘739 patent specification fully describes and enables the concept of cue suppression as claimed in the ‘134 patent. (Brody ¶¶ 6-17.) The disclosed

method provides certain cues to certain callers (those who undertake the pre-registration process), and then suppresses those cues for the same certain qualified callers (those who have been pre-registered). Once the inventive concept is conceived and disclosed as it is in the '739 patent, no undue experimentation would be required for a skilled artisan to achieve the simple task of deciding which cues to provide and then suppress later based on the caller's identification data, as a straightforward matter of design choice. (Brody ¶¶ 15-16.)

There is no requirement under the law that a specification must describe every possible embodiment, such as every possible example of cues that could be provided and suppressed or every set of certain callers who could be subject to cue suppression. The Examiner's suggestion to the contrary relies on a misreading of patent law that would effectively invalidate virtually every patent the Office has ever issued. No patent attempts to describe every detail of every possible embodiment, nor is there any legal requirement to do so. This case is nothing like the *LizardTech* case, a fact-specific outlier case where the specification disclosed only one narrow DWT technique, and one patent claim was directed specifically to that technique, but another claim recited a broader, generic concept that would cover other available, but non-disclosed, DWT techniques. *LizardTech v. Earth Resource Mapping, Inc.*, 424 F.3d 1336 (Fed. Cir. 2005). Nor is it like the *Sitrick* case, where a narrow disclosure regarding video game video signals did not enable the full scope of the claims to cover movies, where video game and movie video signals were shown to be substantially different. *Sitrick v. Dreamworks, LLC*, 516 F.3d 993, 999-1001 (Fed. Cir. 2008). Here, the specification robustly discloses the cue suppression concept in the context of automated telephony, not to be applied to a different medium outside of the telephony context. Furthermore, the '739 patent disclosure does not evidence an intent to limit the inventive disclosure to one specific set or type of cues that are provided and suppressed, one specific technical operation or software or hardware structure for avoiding the cues, or one type of caller—the specification broadly discloses the concept that the same certain callers who have previously received cues (during pre-registration during an initial call) will have those same cues suppressed later (in a later call at the time of the live show or auction). (Brody ¶¶ 7-14.)

In sum, the record shows that the '739 patent specification amply discloses and enables cue suppression as claimed. Reconsideration is respectfully requested.

2. **The '739 patent discloses the “utilizing” limitation in avoiding repetition of cues in the game show embodiment.**

The Examiner also discusses the second embodiment disclosing cue suppression. (FR at 36-37.) The Examiner asserts that the “avoidance is based on geographical area and does not relate to previously provided cues,” and “discloses all of the cues/questions being asked in sequence during the one caller session,” with allegedly “no explicit disclosure in the ‘739 patent of the caller calling back to participate in the contest.” (*Id.*) The Patent Owner respectfully maintains that this second embodiment does disclose the cue suppression limitations as well. As previously set forth in the prior response, the game show format involves presenting questions to callers, who then attempt to answer the questions correctly. A qualified caller who was provided certain game questions in a first call will not be provided the same questions in a second call to the same format—this is the “selectivity” of questions “on the basis of calling numbers,” as explicitly described in the ‘739 patent. Thus, in addition to the “prequalification” cue suppression explained above, the game show format itself also involves cue suppression, as previously-provided cues are avoided based on the identification data of qualified callers—“on the basis of calling numbers.” (Brody ¶¶ 7-16.)

II. Conclusion

For the foregoing reasons, the Patentee respectfully submits that the cited references do not disclose or render obvious the invention recited in claims 1, 4, and 5 of the ‘134 patent. The Patentee respectfully requests that the Examiner withdraw the rejections and confirm the patentability of these claims.

Respectfully submitted,

COOLEY LLP

Dated: December 4, 2013

By: /Frank V. Pietrantonio/
Frank V. Pietrantonio
Registration No. 32,289

Cooley LLP
1299 Pennsylvania Avenue, NW, Suite 700
ATTN: Patent Department
Washington, DC 20004-2400
(202) 842-7800

SUPPLEMENTAL DECLARATION OF DR. ARTHUR BRODY, PH.D

I, DR. ARTHUR BRODY, declare as follows:

1. I have been retained by Cooley LLP (“Cooley”), counsel for Plaintiff Ronald A. Katz Technology Licensing, L.P. (“Patent Owner”), in connection with certain litigation proceedings and in connection with the present reexamination proceeding.

2. I provide my opinions herein as to why claims 1, 4, and 5 of U.S. Patent No. 6,349,134 are disclosed in the parent patent specification of U.S. Patent No. 4,845,739 from the standpoint of a person of ordinary skill in the art (“POSITA”) at the time of the claimed inventions.

3. I hereby incorporate by reference, as if fully incorporated herein, my April 1, 2013 Declaration submitted in the present reexamination proceeding and the materials submitted therewith.

4. I provide the following further opinions in response to the Examiner’s statements in the Final Office Action.

5. The Examiner asserts that in the pre-qualification operation, “there is no explicit disclosure indicating what steps are performed . . . or how the preliminary arrangements/cues were provided.” (FR at 29.) The Examiner further questions whether the pre-qualification information was obtained through the telephonic interface, as opposed to being provided “via postal mail” or some other way. (*Id.*) The Examiner also questions whether the “same preregistration cue or cues” are suppressed, because the patent does not explicitly describe all of the preregistration cues. (*Id.* at 31.) The Examiner also states that the alleged “single species” of cue suppression disclosed in the ‘739 patent does not disclose the so-called “genus” of cue suppression as claimed. (*Id.* at 32.)

6. I respectfully disagree with the Examiner. In my opinion, a person of ordinary skill in the art would recognize that the invention—including the ‘134 patent claim limitations relating to “cue suppression” as discussed in my prior declaration—is fully disclosed in the ‘739

patent. In addition to my previously expressed opinions, I note that a person of ordinary skill in the art would recognize that the '739 patent discloses the pre-qualification steps, the pre-qualification information was obtained through the telephonic interface, that the "same preregistration cue or cues" are suppressed, and that the '739 patent does disclose the so-called "genus" of cue suppression as claimed.

7. As set forth in my prior declaration, the relevant disclosure in the '739 patent includes disclosure that the system must prompt the caller to provide pre-qualification information, and in response the caller provides authorization information to the system, such as described at col. 14:39-58, 16:43-50 and 16:58-17:6. The patent expressly describes and discloses to the POSITA that that the pre-qualification is performed using the telephonic interface system: "persons wishing to participate in the auction sale would make preliminary arrangements involving *utilization of the system to establish authorization data for qualified bidders in cells C1-Cn of the memory 98 (FIG. 4),*" and "*in the case of preregistration for a participant . . . 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,*" and "*prior to participating in an actual game show, interested participants interface the system as depicted in FIG. 1, and in the course of an exchange as described above, the qualification unit 93 and the designation unit 96 cooperate with the processing unit 92 to accomplish preliminary data on potential participants in cells of the memory 96.*" As discussed in my prior declaration, these passages clearly disclose to the POSITA that the caller interfaces with the system—being prompted to provide information in an "exchange" with the telephonic interface—to achieve the pre-registration.

8. Then, "at the time of the show, callers are qualified simply by reference to their assigned memory cell data for a verification." ('739 col. 18:7-38.) The POSITA understands from this disclosure that the pre-registration prompts are not provided, and instead, the system avoids providing those prompts to the certain qualified callers who have been pre-registered.

Furthermore, after the cue suppression operation, “[t]hereafter, the callers exchange information to supplement their data as with respect to the play which follows”—which necessarily involves prompts to the callers for the callers to exchange information with the telephonic interface system. ‘739 patent, col. 17:1-11 (emphasis added).

9. This embodiment, and the Cue Selectivity embodiment I previously discussed, discloses the cue suppression limitations to a person of skill in the art at the time of the invention. The POSITA would understand that these robust disclosures are not mere disclosure of one “species” but rather disclosure of the invention as claimed. The POSITA would understand that this disclosure is not intended to limit the scope of the described invention to one specific embodiment, but is illustrative of the scope of the invention as one exemplary embodiment.

10. The Examiner further questions whether the “same” pre-registration cues are later avoided. The specification amply discloses to a POSITA that the same pre-registration cues that are provided (which may be various specific questions as a matter of design choice) are later avoided at the time of the show or auction when the pre-registered caller calls the system again. Furthermore, in the context of the ‘739 patent disclosure, a POSITA would understand to normally reuse that which they have previously coded, if the same information is required for pre-registration or for qualification during the instant call as the ‘739 patent describes. The Examiner’s assertions would assume that a POSITA would go against their training to somehow avoid “different” cues, particularly when that is not what the ‘739 patent discloses.

11. Similarly in the context of avoiding cues in the Cue Selectivity embodiment of the ‘739 patent that I previously discussed, the POSITA would understand that the same cue or cues are avoided, according to a cue suppression operation as claimed in the ‘134 patent. A POSITA would have understood it would be illogical that the inventor’s goal would be solely to eliminate questions between different callers from different regions. The expressly stated goal in the ‘739 patent disclosure—selectivity on the basis of calling numbers (see ‘739 patent at col. 18:35-

42)—is achieved by the disclosed cue suppression operation. Moreover, the goal is also to eliminate unfair advantage by a particular caller hearing the same question more than once, whether that caller heard it directly over the phone while placing a call, or heard it first from a friend who called earlier and then heard it over a phone while placing a call. This is a broader cue suppression than eliminating questions to a repeat caller regardless of region. The former would logically contain the latter.

12. The Examiner further queries about “certain callers” being subjected to cue suppression, and alleges there is some lack of description or enablement. (FR at paragraph 97.) I respectfully disagree. First, the Examiner’s assertion does not address the second cue suppression embodiment (Cue Selectivity), which discloses the certain callers being subjected to cue suppression, such as on the basis of selectivity obtained by calling numbers. Furthermore, in the pre-registration embodiment, the POSITA would understand that the same callers who are preregistered are the certain callers that will have their cues suppressed. The Examiner appears to assume that all callers must be pre-qualified or must participate in that process. That is incorrect. The patent describes: “Preregistration may be deployed, but is not essential.” ‘739 col. 17:46-47. Similarly, at col. 17:39-60, the specification explains: “Alternatively, players could participate by providing their credit card for billing or billed through the ‘pay-to-dial’ network.” Therefore, some callers may preregister, others may not. But the same certain callers who receive the initial prompts (during the pre-qualification process) and then later call to participate and are qualified, will have those previously-provided prompts suppressed (and will receive one or more additional cues during the call process), disclosing to the POSITA the full concept of cue suppression as claimed.

13. Similarly, ‘739 patent column 17:39-60 discusses “a specific time or geographic ‘window,’” where callers may or may not be preregistered. Callers may then be pre-registered or not pre-registered for the cue suppression for different geographic regions as I discussed in my previous declaration at paragraphs 38-41. The patent provides a robust and broad disclosure of

the claimed concepts, which the POSITA would understand is fully descriptive and illustrative and not limited to one narrow or exclusive embodiment.

14. I note that the Examiner appears to discount the second embodiment disclosing cue suppression in the '739 patent, what I called the "Cue Selectivity" embodiment. (See FR at paragraph 96, citing "only one example"). I stand by my previously expressed opinions. As I previously discussed and reiterate herein, the POSITA would understand that the selectivity on the basis of calling numbers, and the goal of preventing unfair advantage to callers learning a question and then calling (perhaps a second or third time) to take the same quiz, fully supports the POSITA's understanding of the disclosure of the inventive features.

15. The Examiner's assertions that the patent disclosure does not enable multiple embodiments are also incorrect. In my opinion, the '739 patent disclosure provides ample information to enable the skilled artisan at the time of the invention to practice the invention without undue experimentation. The illustrative embodiments of the pre-registration and cue selectivity embodiments, each of which separately discloses the cue suppression inventive features, in the context of the full disclosure of the '739 patent including its detailed structural and process descriptions (see Figures 1-9 and their associated components, and associated textual description), more than amply enabled a skilled artisan at the time to perform cue suppression.

16. The Examiner does not allege that the patent description is lacking any particular information that a POSITA would need to practice the full scope of the cue suppression invention. In my opinion, the patent disclosure provides ample information showing the structure and operation of interface components (such as interface 20) and memory cells in record structures (such as depicted in the figures), which the POSITA would understand can be used to build embodiments within the scope of the invention, including cue suppression, without undue experimentation. The selection of which cues are to be provided in a pre-registration process or in a game show or other cue-selectivity process, and the determination of which callers those cues will be provided based on caller identification information, and the process by

which those cues are later avoided based on the caller's identification information in a subsequent call, would be understood by a POSITA to be a straightforward matter of design and implementation without unexpected difficulty.

17. For the foregoing reasons, it remains my opinion that the invention recited '134 patent claims 1, 4, and 5, including each limitation therein, is disclosed and supported in the '739 patent specification.

I declare that all statements made herein of my knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the patent.

Executed in Short Hills, New Jersey on December 4, 2013.

By


DR. ARTHUR BRODY

Certificate of Service

RE: Reexamination Proceedings of: Katz
PTO Control Number: 90/012,404
U.S. Patent No. 6,349,134

I certify that a copy of RESPONSE BY PATENTEE TO FINAL OFFICE ACTION IN EX PARTE RE-EXAMINATION PURSUANT TO 37 C.F.R. § 1.550(E) , and Supplemental Declaration of Dr. Arthur Brody, PH.D., was served today via First Class Mail on the date identified below to:

Novak Druce & Quigg LLP
1000 Louisiana, 53rd Floor
Houston, TX 77002

Respectfully submitted,

Dated: December 4, 2013

By: /Frank V. Pietrantonio/
Frank V. Pietrantonio
Registration No. 32,289

Cooley LLP
1299 Pennsylvania Avenue, NW, Suite 700
ATTN: Patent Department
Washington, DC 20004-2400
(202) 842-7800

Electronic Acknowledgement Receipt

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Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Reexam Response to Final Rejection	A2DL-005-00US_Katz_134_reexam_response_to_final_action.pdf	140159 <small>4066aaa6884f/d95cb88f0654adffd8782af1748</small>	no	5

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2	Reexam Miscellaneous Incoming Letter	A2DL-005-00US_Supplemental_Brody_declaration.pdf	130102 df8eb0662c0f2c5846d6cf096bb8460f737c0727e	no	7
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Warnings:

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3	Reexam Certificate of Service	A2DL-005_00US_Certificate_of_Service_for_response_to_final_rejection.pdf	62893 ed8a142a7e3b5846a61804b0f0a18199c439d8eb	no	1
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