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COOLEY LLP ATTN: Patent Group 777 - 6th Street, NW Suite 1100 WASHINGTON, DC 20001				RALIS, STEPHEN J
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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. 90/012,679.

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)).

<i>Order Granting / Denying Request For Ex Parte Reexamination</i>	Control No.	Patent Under Reexamination
	90/012,679 Examiner STEPHEN RALIS	5128984 Art Unit 3992

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

The request for *ex parte* reexamination filed 15 September 2012 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a) PTO-892, b) PTO/SB/08, c) Other: _____

1. The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 (c) will be made to requester:

- a) by Treasury check or,
- b) by credit to Deposit Account No. _____, or
- c) by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

cc:Requester (if third party requester)		
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DECISION

A substantial new question of patentability affecting claims 15 and 16 of United States Patent Number 5,128,984 (hereinafter the '984 patent) is raised by the Request for *ex parte* reexamination (hereinafter "the Request"), filed 15 September 2012.

Since requester did not request reexamination of claims 1-14 and 17-23 and did not assert the existence of a substantial new question of patentability (SNQ) for such claims, such claims will not be reexamined. See *Sony Computer Entertainment America, Inc. v. Dudas*, 85 USPQ2d 1594, 1601-02 (E.D. Va. 2006) ("[T]he scope of the PTO's investigation extends only to those claims (i) for which reexamination has been requested; and (ii) for which the PTO has determined there exists a substantial question of validity.") (discussing *inter partes*, but equally applicable to *ex parte*). See also MPEP 2243.

References Cited in Request

A total of five references, in certain combinations, have been asserted in the Request as providing teachings relevant to the claim of the '984 patent. The proposed references which make up the combinations are as follows:

Barger et al. (U.S. Patent No. 4,071,698)

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

Brad Wendkos, "The New World of Voice Technology", Telemarketing, August 1986, pp 59-61, Vol. 5/No. 2 (hereinafter "**Wendkos**")

Bally, "Name That Tune" an operator's manual for the Bally Sente arcade game, publication number MD51-00139- A001, March 1986, online Arcade Museum archive compiled by the "International Arcade Museum®.", http://www.arcademuseum.com/game_data.php?game_id=8828 (hereinafter "**Bally**")

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

Identification of Every Claim for Which Reexamination is Requested

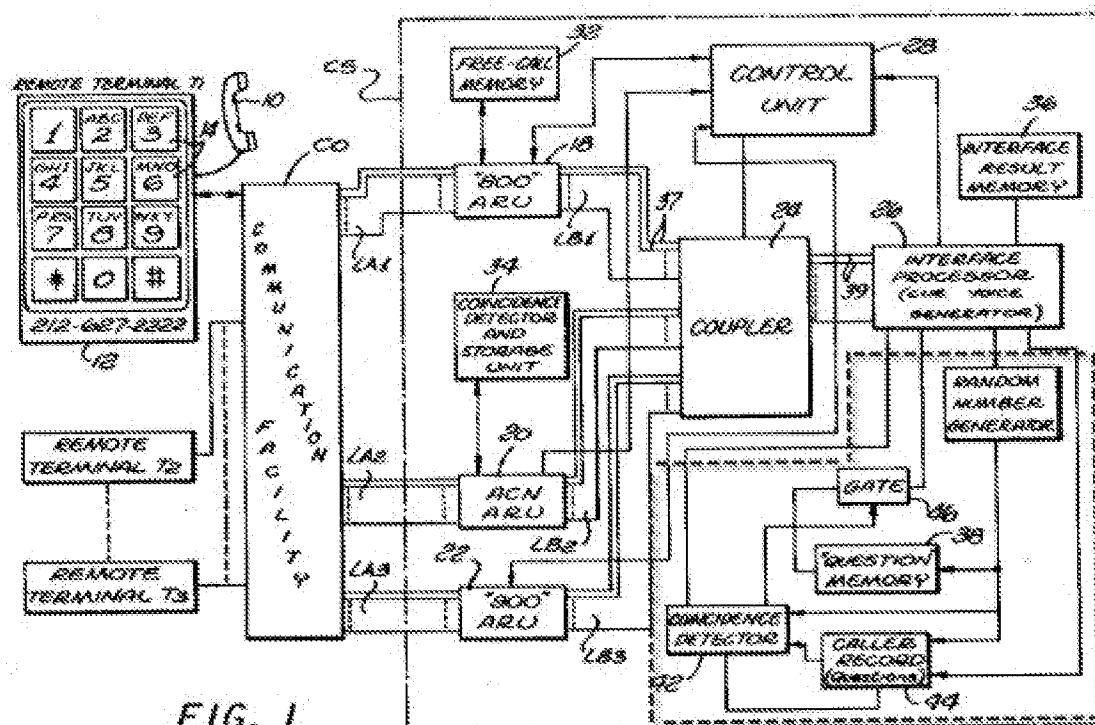
The five references cited above are discussed in the Request as reading on claims 15 and 16 of the '984 patent. Pages 14-69 of the Request detail out proposed substantial new questions of patentability in light of the combination of the five references cited above.

Prosecution History

The '984 patent was assigned serial number 07/425,779 (hereinafter the '779 application) is a continuation in part of U.S. Patent Application No. 07/312,792 (hereinafter the '792 application), filed 21 February 1989. However, the limitations of claims 15 and 16, specifically,

means for selecting a current caller cue (emphasis added)

were first recited in the '779 application (see dotted section of Figure 1 of '779 application below).



Accordingly, the concept of a **means for selecting a current caller cue** does **not** have priority back to 21 February 1989. Based upon the above evidence, claims 15 and 16 of the '984 patent has an earliest priority date of **23 October 1989**, as set forth above.

In the original prosecution, the original examiner issued a first Office action on 21 March 1991 rejecting claims 1, 6-9 and 13-16 under 35 U.S.C. § 102(b) as being anticipated by Fodale (U.S. Patent No. 4,756,020); claim 10 as being unpatentable under 35 U.S.C. § 103 over Fodale and Katz (International Publication No. WO 87/00375); claim 11 as being unpatentable under 35 U.S.C. § 103 over Scanlon (U.S. Patent No. 4,922,522); and objecting to claims

2-5 and 12 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim amendment and arguments submitted 24 June 1991 provided amendments to claims 1-5, 7-9, 11 and 13-16, cancelation of claims 6 and 12, and additionally introduced new claims 17-28

(**NOTE:** Application claims 17-19 correspond to independent claim 15 and dependent claims 16 of the '984 patent). The arguments submitted 24 June 1991 provided distinction over Fodale and Scanlon in that the references do not teach "cue suppression". In that regard, Owner states,

The structure of a second distinguishing element might be called "**cue selection**". The structural element operates to selectively provide a cue, phrase or question that has not previously been provided to a caller. Of course, the structure is incorporated in the interface system as specified by other elements in the combination claims. The above distinction (cue selection) was recognized as patentable by the indicated allowability of claim 12 (Paper No. 2, paragraph 6). **Details of the structure are provided in the specification at: page 5, line 28, and page 17, line 25.** Current claims reciting the distinction are: 11, 13 and 17- 23. (Page 12, last paragraph – page 3, third paragraph; emphasis added.)

The original examiner issued a Final Office Action on 17 September 1991 (herein after "the Final rejection") rejecting claims 17 and 20 as being unpatentable under 35 U.S.C. § 102(e) over Szlam; and claim 27 under 35 U.S.C. § 102(e) as being anticipated by Scanlon. The original examiner further asserted that,

Claims **18-19, 21-23, 28 are objected to** as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims (emphasis added); and

Claims 1-5, 7-11, 13-16, 24-26 **are allowable** over the prior art of record.

An amendment after Final included claim amendments canceling claims 17, 20 and 27 and amending claims 11, 14, 15, 16, **18**, 21, 23 and 28. The amendment to claim 18, now independent claim 15 of the '984 patent, includes both the limitations of claims 17 and 18. The original examiner issued a "Notice of Allowance" with no specificity of allowance. While the examiner did not specifically provide a particular portion of claim 18, now independent claim 15 of the '984 patent, as evidence of a reason for allowance, the original examiner deems that Szlam does not teach,

said means for providing identification signals comprising means for providing at least a portion of the digits associated with a remote terminal for identification,

In addition, the original examiner concedes that Szlam teaches a "**means for selecting a current caller cue**" as evidenced by the Final rejection, however, provides no analysis with respect to the structure required to perform the "means-plus-function." In that regard, column 8, line 55 – column 9, line 29 of the '984 patent states,

With the receipt of a call at the interface processor 26, a voice generator may be actuated to specifically inform a caller, depending upon the specific format employed. Essentially, digital signals are provided to actuate a voice generator within the processor 26. Accordingly, an audio message is provided through the coupler 24, the associated audio response unit, and the communication facility CO to the connected remote terminal. Thus, the caller may be further informed or cued.

In the disclosed embodiment, concurrently with the operation of further informing the caller, the interface processor 26 actuates the random number generator 40 to provide a random address for the question memory

38. The process step is illustrated in FIG. 2 by the block 66.

The random number (identifying a question in the memory 38) is also provided to the coincidence detector 42 to test for the previous use of the question to the calling terminal. In that regard, the interface processor 26 provides the caller telephone number (ANI) to the caller record 44 which may simply take the form of a look-up table addressed by calling numbers and revealing the identification of previous questions propounded. The addresses of questions previously recorded for a calling number are supplied to the coincidence detector 42 for comparison with the current tentative question identification number. The process step is illustrated by the query block 68 in FIG. 2.

If the tentative question has been previously used for the calling terminal, a signal is provided from the coincidence detector 42 to the interface processor prompting a repeat operation by the random number generator 40 to select another question.

Alternatively, if the tentative question is not a repeat, then the coincidence detector 42 qualifies the gate 46 and the tentative question is supplied to the interface processor 26 for actual use. Note that upon the occurrence of an approved question, the coincidence detector also supplies a signal to the call record 44 which records the identification number of the question. The process step is illustrated in FIG. 2 by the block 70.

Clearly, a random number generator **38** in combination with the processor **26** and memory **38** provides the required structure for "selecting a current caller from said memory means for one of said currently active callers ... under control of said identification signals ... and said use indications." This structure or its equivalent is not presented by the original examiner. Moreover, the Third Party Requester states,

Accordingly, the only plausible explanation for the claims' allowance is the Applicant's argument regarding "**cue selection**." As discussed above, Applicant argued that the cue selection "**element operates to selectively provide a cue, phrase or question that has not previously been provided to a caller.**" [Amendment dated June 24, 1991]. Arguably, **this limitation is also disclosed by Szlam - indeed, the original Examiner appears to have rejected the claims based on Szlam for this reason.** However, given the very explicit teaching in Szlam of the use of the automatic number identification (ANI) service to identify callers, **Applicant's "cue selection" argument supplies the most likely reason for allowance.** (Request, Page 9, first full paragraph)

Szlam clearly teaches a means for providing **at least a portion** of the digits associated with a remote terminal for identification (see column 11, line 52 – column 12, line 66; emphasis added) with at least a portion being interpreted as including the whole number itself.

Thus, the concept of a "**means for selecting a current caller cue**" for "selecting a current caller from said memory means for one of said currently active callers ... under control of said identification signals ... and said use indications" is deemed the "**most likely reason for allowance**," as set forth above.

A Notice of *Ex Parte* Reexam was published on 19 June 2006 and assigned a serial/control number 90/008,103 (i.e. reexam of U.S. Patent No. 5,128,984). A reexam examiner determined that no Substantial New Question (SNQ) of patentability was present for claim 1 and a Denial was issued on 11 August 2006 stating,

Perdue fails to teach the claim 1 feature, "**second call mode**", in the context of claim 1 of the '984 patent within the broadest reasonable interpretation of "**second call mode**". (Page 4, fourth paragraph; emphasis added);

Perdue fails to disclose the "**second call mode**" feature and therefore, alone, fails to raise a substantial new question of patentability as to claim 1. For this reason, Perdue is a **worse** reference than Fodale, the reference applied to reject the originally proposed claim 1 in the '779 application (*supra*). Furthermore, there is a substantial likelihood that a reasonable examiner **would not consider this teaching important** in deciding whether or not the claims are patentable, since Perdue fails to disclose the critical feature of a system capable of receiving calls in, at least, first and second call modes. (Page 6, fourth paragraph; emphasis added);

Requester appears to suggest that PR Newswire makes up for the deficiency of the 900 call mode lacking in Perdue; however, this is not a limitation having patentable weight in claim 1. While not disputing the fact that PR Newswire discloses a 900 call mode, this is the **only** call mode; therefore, PR Newswire fails to disclose a "second call mode" consistent with the context of claim 1 of the '984 patent. (Page 6, fifth paragraph; emphasis added);

Therefore, simply combining one reference disclosing only one single call mode with another reference disclosing only one single call mode, albeit different, to arrive at a single system capable of handling plural call modes, can only be achieved by taking the '984 patent into account. Why? **Because the inventive concept of a single system capable of handling plural call modes is lacking in each of Perdue and PR Newswire.** (Page 6, last paragraph - page 7, first paragraph; emphasis added);

... the Request **fails to raise a substantial new question of patentability** as to claims 1 and 4 of the '984 patent and the request for reexamination is therefore DENIED. (Page 7, sixth paragraph; emphasis added).

Another Notice of *Ex Parte* Reexam was published on 13 November 2006 and assigned a serial/control number 90/008,325 (i.e. reexam of U.S. Patent No. 5,128,984). A reexam examiner determined that a Substantial New Question (SNQ) of patentability was present for claims 1 and 4 and an Order was granted on 02 February 2007. A first Office action was issued on 11 July 2008, by the reexam examiner, rejecting claims 1 and 4 under 35 U.S.C. § 102(b) as being anticipated by Perdue, as evidenced by Kushnick, or, in the alternative under 35 "U.S.C. § 103(a) as being unpatentable over Perdue in view of Kushnick; and under 35 "U.S.C. § 103(a) as being unpatentable over Perdue in view of Brown. Owner provided reply/arguments, submitted 22 September 2008, with respect to claim interpretation, i.e. how Perdue, as evidenced by Kushnick, does not anticipate handling calls in both 800 and 900 calling modes. The Owner provided similar arguments to the rejections of Perdue in view of Kushnick or Brown. The Office issued a Final Office action maintain the outstanding rejections with the reexam examiner disagreeing with the Owner stating,

Patentee was required to provide evidence that the AT&T Conversant™ I IVR system does not somehow handle calls in both 800 and 900 calling modes -- especially in light of the evidence of Kushnick that it does, in fact, handle calls in these modes. Therefore, Patentee's argument is entirely without merit. (See MPEP 2112.) (Page 16, second paragraph).

The Owner clearly did not provide the reexam examiner with proper evidence to the fact that the AT&T Conversant™ I IVR system does not somehow handle

calls in both 800 and 900 calling modes. The Owner filed an amendment after-Final on 26 June 2009 with similar arguments and the Office issued an Advisory action on 17 July maintaining the rejections as set forth above. Owner filed a Notice of Appeal on 27 July 2009 with the same argument as before stating "during reexamination of an expired patent, a "narrower claim construction..., that will render the claim valid should be favored over a broad construction . . . that will render the claim invalid" (pages 6-16; Appeal Brief filed 28 September 2009) as well as similar arguments to Perdue, as evidenced by Kushnick, not anticipating handling calls in both 800 and 900 calling modes. A reexam Examiner's Answer, mailed 17 December 2009, asserted that "Examiner used as narrow an interpretation of the claim terms as required by precedent, perhaps more narrow than required. If a reference reads on the AT&T Court's narrow interpretation of a claim term, the reference must also read on the broadest reasonable interpretation" (see Examiner's Answer mailed Dec. 17, 2009). The case has been docketed to Board of Appeals on 02 November 2011 with an Oral Hearing having been held on 04 April 2012. The rejections stand outstanding pending a decision for the Board.

NOTE: It is important to note that the limitations of claims 1 and 4, particularly the "second call mode" limitation, is not recited in either claim 15 or 16 of the '984 patent.

Substantial New Questions (SNQ) of Patentability

The original prosecution history of the '984 patent, will be utilized to show why the newly cited references above do or do not create a substantial new question (SNQ) of patentability.

For purposes of determination, independent claim 15 is used as the representative claim for the various proposed prior art listed below. The italicized/underlined sections of the claim below are utilized by the examiner to show how specific teachings of the proposed references create a substantial new question of patentability in light of the original prosecution history above.

Claim 15:

A telephone interface system for individually interfacing callers at a multitude or remote terminals for voice-digital communication through a telephone communication facility, said system comprising:

communication means for establishing telephone communication with currently active callers at certain of said terminals through said telephone communication facility;

means for providing identification signals to said communication means indicative of said currently active callers, said means for providing identification signals comprising means for providing at least a portion of the digits associated with a remote terminal for identification;

memory means for storing caller cues and use indications for said caller cues in relation to said callers as identified by said identification signals;

cue means for receiving said caller cues to provide voice signals through said communication means to prompt responses from said currently active of said callers in the form of digital data signals; an

means for selecting a current caller cue from said memory means for one of said currently active callers for application to said cue means under control of said identification signals for said one of said currently active callers and said use indications in said memory means for said one of said currently active callers.

Barger et al., Szlam et al., Wendkos, Bally and Masaki

Barger et al., Szlam et al. and Wendkos teach a telephone interface system for individually interfacing callers at a multitude of remote terminals.

The Request appears to show that Barger et al., Szlam et al. and Wendkos, for claim 15, teaches a telephone interface system for individually interfacing callers at a multitude of remote terminals for voice-digital communications through a telephone communication facility (see Request pages 15-19, 22-27, 30-41; see Prieve declaration pages 4-7, 10; see Claim Chart A, pages 1-12).

Similarly, the Request appears to show that Bally teaches, for claim 15, a random generating process within a computer for selecting topics for a trivia game. (See Request pages 20-21, 27-30, 45; see Prieve declaration pages 7-8, 11; see Claim Chart A, page 14)

Moreover, Masaki, for claim 15, teaches a "means for selecting a current caller from said memory means for one of said currently active callers ... under control of said identification signals ... and said use indications" (i.e. with the "means for selecting a current caller cue" being a random number generator in combination with the processor and memory, as set forth above and in light of Owner's invocation of 35 U.S.C. § 112, sixth paragraph, as further evidenced by Owner's disclosure; see column 8, line 55 – column 9, line 29). (See Request pages 21-22, 28-30, 41-44; see Prieve declaration pages 9, 11; see Claim Chart A, pages 12-16).

The above substantial new question of patentability is based solely on patents and/or printed publications already cited/considered in an earlier concluded examination of the patent being reexamined. On November 2, 2002, Public Law 107-273 was enacted. Title III, Subtitle A, Section 13105, part (a) of the Act revised the reexamination statute by adding the following new last sentence to 35 U.S.C. 303(a) and 312(a):

“The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.”

For any reexamination ordered on or after November 2, 2002, the effective date of the statutory revision, reliance on previously cited/considered art, i.e., “old art,” does not necessarily preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on that old art. Rather, determinations on whether a SNQ exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis.

In the present instance, there exists a SNQ based solely on the publication of Barger et al. when taken with Szlam et al., the Wendkos publication, and Masaki and/or the Bally publication. A discussion of the specifics now follows:

Barger et al. was not present before the examiner during the original examination. Moreover, Barger et al. was present before the reexam examiner during the reexamination (Control No. 90/008,325), however, not utilized in any rejection since claims 18 and 19 (i.e. now claims 15 and 16) were not examined in the reexamination proceedings.

In addition, Szlam et al. was present before the examiner during the original examination of the '984 patent, as set forth above, however, was not relied upon to reject the limitations of claim 18 (i.e. now claim 15 of the '984 patent), as is evidenced by the issued "Notice of Allowance" when claims 17 and 18 were merged in the amendment (see discussion above in Prosecution History). In addition, the original examiner deemed Szlam et al. as not reading on the limitations of claim 18 (i.e. now claim 15 of the '984 patent). Moreover, Szlam et al. was present before the reexam examiner during the reexamination (Control No. 90/008,325), however, not utilized in any rejection since claims 17 and 18 (i.e. now claims 1 and 2) were not examined in the reexamination proceedings. However, Szlam et al. is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier concluded examination(s), in view of a material new argument or interpretation presented in the request. See *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351 (Bd. Pat. App. & Inter. 1984).

Moreover, Wendkos was not present before the examiner during the original examination of the '984 patent and not relied upon to reject any claim limitations (i.e. as indicated by the initialed information disclosure). Moreover, Wendkos was also not present before the examiner during the reexamination

proceedings of the '984 patent (i.e. as indicated by the initialed information disclosures).

Similarly, Bally was not present before the examiner during the original examination of the '984 patent and not relied upon to reject any claim limitations (i.e. as indicated by the initialed information disclosure). Moreover, Bally was also not present before the examiner during the reexamination proceedings of the '984 patent (i.e. as indicated by the initialed information disclosures).

Furthermore, Masaki was not present before the examiner during the original examination of the '984 patent and not relied upon to reject any claim limitations (i.e. as indicated by the initialed information disclosure). Moreover, Masaki was also not present before the examiner during the reexamination proceedings of the '984 patent (i.e. as indicated by the initialed information disclosures).

Therefore, it is agreed that the consideration of Barger et al. and Szlam et al., Wendkos, and Masaki and/or the Bally publication Registration presents different issues and combinations in a different way than that presented to and considered by the examiner during the original examination and the previous reexamination and raises a substantial new question of patentability of at least claim 15 as pointed out above. There is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not these claims are patentable.

Thus, claims 15 and 16 of the '984 patent will be reexamined as requested
in the Order.

Conclusion

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extension of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

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. 5,128,984 throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

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

By Mail to: Mail Stop *Ex Parte* Reexam
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United States Patent & Trademark Office
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Any inquiry concerning this communication or earlier communications from the Reexamination 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.

/Stephen J Ralis/
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Conferee

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