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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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90/015,063

06/23/2022

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Workman Nydegger

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EXAMINER

HENEGHAN, MATTHEW E

ART UNIT

PAPER NUMBER

3992

MAIL DATE

DELIVERY MODE

02/02/2023

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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***EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/015,063 .

PATENT UNDER REEXAMINATION 7233790 .

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)).

Office Action in Ex Parte Reexamination	Control No. 90/015,063	Patent Under Reexamination 7233790	
	Examiner MATTHEW E HENEGHAN	Art Unit 3992	AIA (FITF) Status No

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

- a. ☐ Responsive to the communication(s) filed on _____.
☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.

b. ☐ This action is made FINAL.

c. ☒ A statement under 37 CFR 1.530 has not been received from the patent owner.

A shortened statutory period for response to this action is set to expire 2 month(s) from the mailing date of this letter.
Failure to respond within the period for response will result in termination of the proceeding and issuance of an *ex parte* reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**
If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|--|---|
| 1. ☐ Notice of References Cited by Examiner, PTO-892. | 3. ☐ Interview Summary, PTO-474. |
| 2. ☐ Information Disclosure Statement, PTO/SB/08. | 4. ☐ _____. |

Part II SUMMARY OF ACTION

- 1a. ☒ Claims 1-2,4 and 8-9 are subject to reexamination.
 - 1b. ☒ Claims 3,5-7 and 10-14 are not subject to reexamination.
 2. ☐ Claims _____ have been canceled in the present reexamination proceeding.
 3. ☒ Claims 2,4 and 9 are patentable and/or confirmed.
 4. ☒ Claims 1 and 8 are rejected.
 5. ☐ Claims _____ are objected to.
 6. ☐ The drawings, filed on _____ are acceptable.
 7. ☐ The proposed drawing correction, filed on _____ has been (7a) ☐ approved (7b) ☐ disapproved.
 8. ☐ Acknowledgment is made of the priority claim under 35 U.S.C. 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the certified copies have
 - 1 ☐ been received.
 - 2 ☐ not been received.
 - 3 ☐ been filed in Application No. _____.
 - 4 ☐ been filed in reexamination Control No. _____.
 - 5 ☐ been received by the International Bureau in PCT application No. _____.
- * See the attached detailed Office action for a list of the certified copies not received.
9. ☐ Since the proceeding appears to be in condition for issuance of an *ex parte* reexamination certificate except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte* Quayle, 1935 C.D. 11, 453 O.G. 213.
 10. ☐ Other: _____

cc: Requester (if third party requester)

ORDER GRANTING EX PARTE REEXAMINATION

Notice of Pre-AIA or AIA Status

The present application is being examined under the pre-AIA first to invent provisions.

Ex Parte Reexamination

A third party, Unified Patents, LLC, has requested *ex parte* reexamination of claims 1, 2, 4, 8, and 9 of U.S. Patent No. 7,233,790.

A substantial new question of patentability affecting claims 1, 2, 4, 8, and 9 of United States Patent Number 7,233,790 is raised by the request for *ex parte* reexamination. See Order Granting *Ex Parte* Reexamination, mailed 17 August 2022.

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. 7,233,790 (hereinafter the '790 patent) 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.

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 *ex parte* reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extensions of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

Patent owner is notified that any proposed amendment to the specification and/or claims in this reexamination proceeding must comply with 37 CFR 1.530(d)-(j), must be formally presented pursuant to 37 CFR 1.52(a) and (b), and must contain any fees required by 37 CFR 1.20(c).

In order to ensure full consideration of any amendments, affidavits or declarations, or other documents as evidence of patentability, such documents must be submitted in response to this Office action. Submissions after the next Office action, which is intended to be a final action, will be governed by the requirements of 37 CFR 1.116, after final rejection and 37 CFR 41.33 after appeal, which will be strictly enforced.

Claims 1, 2, 4, 8, and 9 have been examined.

References

The following references have been supplied by the third party requester for proposed grounds of rejection:

U.S. Patent Application Publication No. 2002/0078178 to Senoh (hereinafter (Senoh)

U.S. Patent No. 6,035,339 to Agraharam et al. (hereinafter Agraharam)

U.S. Patent No. 6,421,726 to Kenner et al. (hereinafter Kenner)

U.S. Patent No. 6,345,279 to Li et al. (hereinafter Li)

Claim Rejections - 35 USC § 103

In the event the determination of the status of the application as subject to AIA 35 U.S.C. 102 and 103 (or as subject to pre-AIA 35 U.S.C. 102 and 103) is incorrect, any correction of the statutory basis for the rejection will not be considered a new ground of rejection if the prior art relied upon, and the rationale supporting the rejection, would be the same under either status.

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, 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 negated by the manner in which the invention was made.

Claims 1 and 8 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Senoh in view of Agraharam.

Regarding claim 1, Senoh discloses a method of providing access to content for use on wireless communication devices (content distribution using a cellular phone as a terminal, see abstract and paragraph 60), the method comprising: receiving and storing a plurality of items of content to be made available for use in wireless communication devices used by a plurality of wireless services subscribers (performed at a relay server to subscribers via cellular, see figure 4 and paragraphs 43-45); and maintaining a product catalog containing a description of the items of content (maintained at the relay server to subscribers via cellular, see figure 4 and paragraphs 43-45).

Senoh does not teach the receiving of a plurality of different implementations of at least one of the items of content, where each implementation of any given item of content corresponds to a different set of device capabilities; or that the product catalog includes, in association with each item of content, a reference to each implementation of said item of content. Senoh further notes that "a problem arises... when the specifications of the distributed content differ from the specifications of content that is viewable on the user's terminal or monitor (see paragraph 8).

Agraharam discloses a network information delivery system in which a network information delivery device (which corresponds to Senoh's relay server) receives and stores content from an information source (see column 2, lines 52-58), which may be formatted into a plurality of formats and are grouped according to the items of content (see figure 4 and column 4, lines 31-57). Agraharam further states that this addresses a problem where "if none of the predetermined formats are suitable for information

reproduction by the user terminal, the user terminal reproduces the information in an undesirable manner” (see column 1, lines 28-31).

Therefore it would have been obvious to one of ordinary skill in the art the time the invention was made to modify Senoh to store and make available an item of content in a plurality of formats in its catalog, as per Agraharam, to help ensure that the mobile device does not reproduce the information in an undesirable format.

Regarding claim 8, Senoh discloses a system (see abstract) comprising: a network interface through which to communicate over a communication network (see paragraph 29); and a download manager to receive and store a plurality of items of content to be made available for use in wireless communication devices used by a plurality of wireless telecommunications subscribers (Senoh’s relay server, see paragraphs 43-45, constitutes a download manager that services users; these users may be using cellular phones, see paragraph 60); and maintains a product catalog containing a description of the items of content (maintained at the relay server to subscribers via cellular, see figure 4 and paragraphs 43-45).

Senoh does not teach the receiving of a plurality of different implementations of at least one of the items of content, where each implementation of any given item of content corresponds to a different set of device capabilities; or that the product catalog includes, in association with each item of content, a reference to each implementation of said item of content. Senoh further notes that “a problem arises... when the specifications of the distributed content differ from the specifications of content that is viewable on the user’s terminal or monitor (see paragraph 8).

Agraharam discloses a network information delivery system in which a network information delivery device (which corresponds to Senoh's relay server) receives and stores content from an information source (see column 2, lines 52-58), which may be formatted into a plurality of formats/capabilities and are grouped according to the items of content (see figure 4 and column 4, lines 31-57). Agraharam further states that this addresses a problem where "if none of the predetermined formats are suitable for information reproduction by the user terminal, the user terminal reproduces the information in an undesirable manner" (see column 1, lines 28-31).

Therefore it would have been obvious to one of ordinary skill in the art the time the invention was made to modify Senoh to store and make available an item of content in a plurality of formats in its catalog, as per Agraharam, to help ensure that the mobile device does not reproduce the information in an undesirable format.

Allowable Subject Matter

Claims 2, 4, and 9 are confirmed.

The following is a statement of reasons for the indication of confirmed subject matter:

Regarding claims 2 and 9, the only primary reference considered, Senoh, explicitly teaches away from "selecting a portion of the product catalog to be presented to the subscriber, based on device capabilities of the wireless device used by the subscriber; and presenting the selected portion of the product catalog to the subscriber

via a wireless network, such that the selected portion, as presented to the subscriber, provides only a single description of each item of digital content in said portion, regardless of the number of implementations of each said item,” as recited in claims 2 and 9. Senoh specifically states that it is an objective to enable a viewer terminal to enjoy content in the format of a display device that is different from the specifications of the user terminal (see paragraphs 8 and 15). Neither Kenner nor Li have been presented in such a way that one skilled in the art would be motivated to modify Senoh in a manner that would completely teach to the claimed inventions, as they would remove this critical functionality from Senoh’s invention.

Claim 4 is confirmed based upon its dependence upon base claim 2.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW E HENEGHAN whose telephone number is (571)272-3834. The examiner can normally be reached M-F 8-5.

Examiner interviews are available via telephone, in-person, and video conferencing using a USPTO supplied web-based collaboration tool. To schedule an interview, applicant is encouraged to use the USPTO Automated Interview Request (AIR) at <http://www.uspto.gov/interviewpractice>.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Michael Fuelling can be reached on (571)270-1367. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of published or unpublished applications may be obtained from Patent Center. Unpublished application information in Patent Center is available to registered users. To file and manage patent submissions in Patent Center, visit: <https://patentcenter.uspto.gov>. Visit <https://www.uspto.gov/patents/apply/patent-center> for more information about Patent Center and <https://www.uspto.gov/patents/docx> for information about filing in DOCX format. For additional questions, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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