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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/019,489	04/17/2024	8898260	CEL260	7021

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EXAMINER
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ART UNIT	PAPER NUMBER
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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. 90/019,489 .

PATENT UNDER REEXAMINATION 8898260 .

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)).

Order Granting Request For Ex Parte Reexamination	Control No. 90/019,489	Patent Under Reexamination 8898260	
	Examiner PENG KE	Art Unit 3992	AIA (FITF) Status No

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

The request for *ex parte* reexamination filed 04/17/2024 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.

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cc:Requester (if third party requester)

Decision on Request

A substantial new question of patentability affecting claims 1-18 of United States Patent Number 8,898,260 to Singh et al. ('260) is raised by the request for *ex parte* reexamination file on 04/17/2024. The '260 patent is filed on 06/05/2014 as application number 14/297,616, which is a continuation of 14/172,913 Patent Application filed on 02/05/2014, which is a continuation of 13/740,214 Patent Application filed on 01/13/2013, which is a continuation of 12/333,303 Patent Application filed on 12/11/2008, which claims priority to Provisional Applications 61/017,202 filed on 12/28/2007.

Reference cited in Request

1. Korean Patent KR100537818B1 to Sohn et al. ("Sohn");
2. Mobile Messaging Technologies and Services: SMS, EMS and MMS, 2TM Edition, Publish on 2005 by Gwenael Le Bodic ("Bodic");
3. Korean Patent KR100608841B1 to Jin ("Jin");
4. U.S. Patent 7,206,804 to Deshpande et al. ("Deshpande");
5. U.S. Patent 8,385,950 to Wagner et al. ("Wagner")

Availability of reference for patenting rejection:

References 1-5 are qualified as prior art under 35 USC. 102(a) and it is Patent Owner's burden to establish an earlier date of invention.

The 1-5 references were not applied in any rejection during the original prosecution, reexamination, or review of the '260 patent. Accordingly, they are be used to raise a Substantial New Question of Patentability.

Prosecution History

The 14/297,616 ('616) is the application to the '260 Patent. During the original prosecution of '616, on 10/10/2014, the Examiner made following amendment to claims 1, 7, 12, and 18:

“wherein the segment identifier corresponds to the content range of said file date that is being transferred in a given data segment...”

Examiner also cited this limitation as part of the reason for allowance.

Following the issuance of the '260 Patent, IPR2024-00760 was requested to challenge claims 1-18, in view of Aaltonen, Drescher, Takahashi, Na, and Lind.

Ground	Claims	103 Basis
1	1-18	Aaltonen, Drescher
2	1-18	Takahashi, Na
3	1-18	Takahashi, Na, and Lind

The PTAB has not yet decided whether or not to institute the *Inter Partes* Review of the '260 Patent.

Scope of Reexamination

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. 3030(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 the 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.

Substantial New Question of Patentability

For the purpose of determination, independent claim 1 is the only independent claim. The italicized sections 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.

Claim 1: A method of segmented file transfer from a Bluetooth enabled mobile device to a web service, the method comprising:

providing a software module on the Bluetooth enabled mobile device, the software module, performing;

determining size of a file to be transferred;

segmenting said file into data segments at an application layer level, wherein data in said data segments comprises one or more of said file data and data associated with said file data;

applying a segment identifier to each of said data segments at the application layer level,
wherein the segment identifier corresponds to the content range of said file data that is being transferred in a given data segment;

applying a user identifier to each of said data segments for the destination web service at the application layer level, wherein said user identifier uniquely identifies a particular user of the web service;

transferring a data segment along with said user identifier and said segment identifier to the web service;

receiving a reply message from the web service, corresponding to successful completion of said data segment transfer;

repeating the step of data segment transfer and the step of receiving the reply message, until all the data segments have been transferred to the web service successfully, wherein if segmented file transfer is interrupted, the software module further performs: sending, a synchronization request to the web service from the application layer level, corresponding to asking the web service about the segmented file data the web service has successfully received, for said user identifier, after a network connection to the web service is restored;

receiving, a synchronization reply back from the web service at the application layer level, corresponding to indicate segmented file data said web service has successfully received, for said user identifier; and resuming, the segmented file transfer based on the synchronization reply received, for said user identifier; receiving, at the web service, all the data segments along with said user identifier and segment identifiers for said file transfer; storing, at the web service, the received file data segments and segment identifiers for said user identifier; and making available,

at the web service, the segmented data received from the Bluetooth enabled mobile device for public or private consumption over the internet.

Issue I: Sohn

Sohn teaches splitting the multimedia messages to be transmitted from the mobile terminal into units of a certain size using the HTTP when the transmission of split messages is completed at intervals of a certain number, a message is received from the server regarding the success or failure of the transmission.” See p4. The Request shows that Sohn teach following limitations of claim 1 in ‘260 patent:

“...applying a segment identifier to each of said data segments at the application layer level, **wherein the segment identifier corresponds to the content range of said file data that is being transferred in a given data segment;...**” Sohn p 4-6 (Sohn discloses the preferred embodiment of the invention, HTTP message transmission and reception protocol of HTTP1.1 (RFC2616); and HTTP1.1 includes content range)

It is agreed that the consideration of Sohn raises an SNQ to at least claim 1 of patent ‘260 as pointed out above. There is a substantial likelihood that a reasonable examiner would consider the teachings of Sohn are important in deciding whether or not claim 1 is patentable.

Issue II: Bodic, Jin, Deshpande, and Wagner

Bodic reviews the mobile messaging technologies of SMS, EMS, and MMS. See Bodic p 10-17.

Jin teaches checking a response message from the receiving side each time a PDU segment is transmitted. See Jin p1 abstract.

Deshpande teaches transmitting large file by segmenting the data during the transmission. See Deshpande abstract.

Wagner teaches methods for automatically uploading media content from a mobile device to an online service provider. See Wagner abstract.

The requestor has asserted that Sohn in view of Bodic, Jin, Deshpande, Wagner raise a substantial new question with respect to the claims of 1-18. Sohn has shown SNQs as to claim 1 of patent '206. (see Issue I above). Accordingly, it is agreed that Sohn in combination with reference Bodic, Jin, Deshpande, and Wagner would raise a substantial new question of patentability with respect to the claims of 1-18.

Scope of Reexamination

Claims 1-18 of the '206 patent will be reexamined as requested in the Request.

325(d) Analysis

35 USC 325(d) states in part that “[i]n determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.”. Thus, in order for the Director to exercise discretion as to whether to Order a reexamination proceeding under chapter 30, the request must first be determined to be based on the same or substantially the same prior art or arguments that previously were presented to the Office.

A review of the post grant history of the ‘260 patent indicates that the patent was the subject of a single prior AIA petition. On April 1, 2024, petitioner TikTok, Inc. filed a petition seeking *inter partes* review of claims 1-18 of the ‘260 patent (IPR2024-00760). In the petition, petitioner asserted the following grounds as raising a reasonable likelihood in prevailing (RLP) in showing the unpatentability of the claims:

RLP #	Claims Challenged	35 USC §	References
1	1-18	103	Aaltonen and Drescher
2	1-18	103	Takahashi, Na
3	1-18	103	Takahashi, Na, Lind

The Patent Trial and Appeal Board (PTAB) has not yet issued a decision on the institution of *inter partes* review. Accordingly, the merits of the newly presented references of Aaltonen, Drescher, Takahashi, Na and Lind have not been addressed by the PTAB.

A comparison between the prior art and arguments presented in the current *ex parte* reexamination Request (90/019,489) and the prior *inter partes* review petition (IPR2024-00760) indicates that the instant request is not based on the same or substantially the same prior art or arguments as were previously presented to the Office.

As stated above, the instant request asserts the following grounds as raising an SNQ to claims 1-18 of the ‘757 patent:

SNQ #		Claims Challenged	Basis	References
1		1-18	103	Sohn
2		1-18	103	Sohn, Bodic
3		1-18	103	Sohn, Jin
4		1-18	103	Sohn, Bodic, Jin
5		1-18	103	Sohn, Deshpande
6		1-18	103	Sohn, Bodic, Deshpande
7		1-18	103	Sohn, Jin, Deshpande

8		1-18	103	Sohn, Bodic, Jin, Deshpande
9		1-18	103	Wagner, Sohn
10		1-18	103	Wagner, Sohn, Bodic
11		1-18	103	Wagner, Sohn, Jin
12		1-18	103	Wagner, Sohn, Bodic, Jin
13		1-18	103	Wagner, Sohn, Deshpande
14		1-18	103	Wagner, Sohn, Bodic, Deshpande
15		1-18	103	Wagner, Sohn, Jin, Deshpande
16		1-18	103	Wagner, Sohn, Bodic, Jin, Deshpande

As an initial matter, none of the grounds asserted as raising an SNQ in the current *ex parte* reexamination Request (90/019,489) are based on identical grounds asserted in the prior IPR petition and the arguments in the Request relate to these prior art combinations. Thus, the Request is not based on the same prior art or arguments previously presented to the Office.

In addition, the Request is also not based on substantially the same prior art or arguments as were previously presented to the Office. The prior art references of Sohn, Bodic, Jin, Deshpande and Wagner are materially different references than presented in the IPR petition, as noted above, and thus present different disclosures than the Aaltonen, Drescher, Takahashi, Na and Lind references presented in the prior IPR petition (IPR2024-00760).

However, to the extent that the references of Sohn, Bodic, Jin, Deshpande and Wagner presented in the current *ex parte* reexamination Request (90/019,489) are considered to be substantially similar to the references of Aaltonen, Drescher, Takahashi, Na and Lind presented in the prior IPR petition (IPR2024-00760), the Examiner as delegated by the Director declines to exercise discretion to reject this request in view of the following facts:

- 1.) The fact that there has been only one prior post grant challenge to the '260 patent and there has been no finding of serial abusive Office challenges to the '260 patent by Third Party Requester;

- 2.) The fact that the PTAB has not yet issued a decision on the institution of *inter partes* review in the IPR2024-00760 petition and therefore has not yet considered the merits of references presented in the IPR petition;
- 3.) The fact that there is minimal additional burden on the Office in examining the claims of the '260 patent in view of the grounds determined to raise an SNQ; and
- 4.) The fact that there is a strong public interest that the prior art references of Sohn, Bodic, Jin, Deshpande and Wagner, which are determined to raise an SNQ over claims 1-18 of the '260 patent, be fully considered by the Office to fully address the patentability of the challenged claims.

Accordingly, *Ex Parte* Reexamination is Ordered based on the determination that cited Sohn, Bodic, Jin, Deshpande and Wagner raise an SNQ to the '260 patent for the reasons set forth above.

Extension of Time

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 reexaminations 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).

Amendment in Reexamination Proceedings

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)-G), 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). See MPEP §2250(IV) for examples to assist in the preparation of proper proposed amendments in reexamination proceedings.

Service of Papers

After the filing of a request for reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party (or parties where two or more third party requester proceedings are merged) in the reexamination proceeding in the manner provided in 37 CFR 1.248. See 37 CFR 1.550.

Notification of Concurrent Proceedings

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. 8,898,260 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 proceedings 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 as follows:

By U.S. Postal Service Mail to:

Mail Stop Ex Parte Reexam
ATTN: Central Reexamination Unit Commissioner for Patents

Art Unit: 3992

P.O. Box 1450

Alexandria, VA 22313-1450

By FAX to:

(571) 273-9900

Central Reexamination Unit

By hand to:

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Randolph Building

401 Dulany St.

Alexandria, VA 22314

By EFS-Web:

Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at

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EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

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.

/PENG KE/

Primary Examiner, Art Unit 3992

Conferees:

/RSD/

/ALEXANDER J KOSOWSKI/

Supervisory Patent Examiner, Art Unit 3992