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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 90/019,499      | 04/30/2024  | 8904030              | 50348.124           | 9544             |

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| EXAMINER |
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ESCALANTE, OVIDIO

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| ART UNIT | PAPER NUMBER |
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3992

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| MAIL DATE | DELIVERY MODE |
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07/25/2024

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. 90/019,499 .

PATENT UNDER REEXAMINATION 8904030 .

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)).

|                                                              |                                     |                                              |                                |
|--------------------------------------------------------------|-------------------------------------|----------------------------------------------|--------------------------------|
| <b>Order Granting Request For<br/>Ex Parte Reexamination</b> | <b>Control No.</b><br>90/019,499    | <b>Patent Under Reexamination</b><br>8904030 |                                |
|                                                              | <b>Examiner</b><br>OVIDIO ESCALANTE | <b>Art Unit</b><br>3992                      | <b>AIA (FITF) Status</b><br>No |

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

The request for *ex parte* reexamination filed 04/30/2024 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 )

## ORDER GRANTING EX PARTE REXAMINATION

### I. Review of Facts

1. A request for *ex parte* reexamination of claims 1, 2, 4-7, 9-18 of U.S. Patent 8,904,030 issued to Singh et al. on December 2, 2014 (hereinafter the '030 patent) was filed on April 30, 2024 and assigned control number 90/019,499 ("the '499 Request").
2. The '030 patent was filed on June 4, 2014 and is based upon U.S. Patent Application No. 14/295,353.
3. On May 2, 2024, the Office mailed a "Notice of Assignment of Reexamination Request" indicating the '499 Request was granted a filing date.

### II. Pertinent History of the '030 Patent.

4. The '030 patent was filed as U.S. Patent application No. 14/295,353 ("the '353 application") on June 4, 2014.
5. On July 8, 2014 the Examiner issued a non-final office action which provisionally rejected claims 1-20 under nonstatutory obviousness-type double patenting. Claims 1, 2, 4 -20 were rejected as being obvious over Kenney US Patent Pub. 2003/0157960 and Vesuna US Patent Pub. 2008/0272185. Claim 3 was rejected as being unpatentable over Kennedy, Vesuna and Hong US Patent Pub. 2006/0264176. Claims 1-2 and 4-20 were also rejected as being unpatentable over Kenney and Behzad US Patent Pub. 2009/0023428 and claim 3 was rejected as being unpatentable over Kennedy, Behzad and Hong.
6. In response to the non-final office action, an interview was held on July 9, 2014 in which proposed claim amendments were discussed. No formal agreement was reached during the interview.

7. On August 5, 2014, the Applicant filed a response with claimed amendments. The claims were amended to recite *inter alia*, that the connection between the mobile device and data capture device was a “secure” connection that “uses cryptographic encryption key,” that the mobile device received “encrypted data,” and that the data was transferred “along with a user identifier”. The Applicant argued that Kennedy does not disclose that his intermediate electronic device 50 sends a request to his portable electronic device 75 to enable event notifications which notify the availability of new data in the portable electronic device 75 for transfer or encryption over a Bluetooth connection. .

Specifically, the Applicant stated that Kennedy and the other relied upon prior art did not disclose the following limitations:

“receiving a request to enable event notifications for new data on the Bluetooth enabled data capture device, from the Bluetooth enabled mobile device, over the established paired secure Bluetooth connection” in claim 1; and

“enabling event notification on the Bluetooth enabled data capture device, corresponding to new data” in claim 1; and

“determining existence of the new data for transfer”; and

“sending event notification as a signal to the Bluetooth enabled mobile device, corresponding to existence of new data for transfer, over the established paired secure Bluetooth connection, wherein the Bluetooth enabled mobile device listens for the event notification sent from the Bluetooth enabled data capture device” in claim 1; and

“transferring the encrypted data from the Bluetooth enabled data capture to the Bluetooth enabled mobile device, over the paired secure Bluetooth connection,... wherein the Bluetooth enabled mobile device is configured to receive the encrypted data, obtain the new data from the encrypted data using cryptographic encryption key...” in claim 1.

“sending a message to the Bluetooth enabled data capture device, over the established paired secure Bluetooth connection, to enable event notifications on the Bluetooth enabled data capture device corresponding to new data” in claim 12.

“enabling event notification listening on Bluetooth enabled mobile device, to listen for event notifications sent from the Bluetooth enabled data capture device, over the established paired secure Bluetooth connection” in claim 12.

“receiving, from the Bluetooth enabled data capture device, an event notification corresponding to existence of new data for transfer, over the established paired secure Bluetooth connection” in claim 12.

“receiving, by the Bluetooth enabled mobile device, encrypted data corresponding to the new data over the established Bluetooth paired secure wireless connection and obtaining new data from the received encrypted data using cryptographic encryption key” in claim 12.

“wherein the pair secure Bluetooth connection uses cryptographic encryption key” in claim 1 and 12.

“receiving a message from the Bluetooth enabled mobile device, over the established paired secure Bluetooth connection, to register for data signal notifications, wherein the data signal notification correspond to existence of new data for transfer on the Bluetooth enabled data capture device”, in claim 6.

“creating a new data object on the Bluetooth enabled data capture device, wherein the new data object comprises new data, data associated with new data and a data signal notification, wherein data signal notification is a time-stamp attribute inside the data object, wherein the data signal notification corresponds to existence of new data for transfer” in claim 6.

“encrypting, using cryptographic encryption key, the new data object in the Bluetooth enabled data capture device” in claim 6

“transferring the encrypted data object from the Bluetooth enabled data capture device to the Bluetooth enabled mobile device, over the established paired secure Bluetooth connection” in claim 6.

As to claim 16, the Applicant states that claim 16 recites several steps which are also recited in claim 12 and maintains that Kennedy, Vesuna and Behzad do not teach those same limitations.

In response to Applicant's arguments and amendment, an Interview was held on September 23, 2014 in which a further amendment to claim 1 was made. The Examiner stated that the amendment would place the application in condition for allowance.

Specifically, the Examiner's Amendment amended the claim by further reciting "sending a message to the Bluetooth enabled mobile device, correspond to supported data capability of the Bluetooth enabled data capture device" and "wherein the Bluetooth enabled mobile device is configured to apply action setting and destination web address of a remote internet server to the obtained new data, wherein action setting comprising one of a remote procedure call (RPC) method and hypertext transfer protocol (HTTP) method...".

Claim 6 was further amended to recite "wherein the time-stamp corresponds to a time when new data was acquired" and "wherein the Bluetooth enabled mobile device is configured to apply action setting and destination web address of a remote internet server to the obtained new data, wherein action setting comprising one of a remote procedure call (RPC) method and hypertext transfer protocol (HTTP) method...".

Claim 12 was further amended to recite "receiving a message from the Bluetooth enabled data capture device, corresponding to supported data capability of the Bluetooth enabled data capture device" and "configuring the obtained new data to comprise an action setting and destination web address of a remote internet server, wherein action setting comprises one of a remote procedure call (RPC) method and hypertext transfer protocol (HTTP) method...".

Claim 16 was further amended to recite "wherein the time-stamp corresponds to a time when new data was acquired" and "configuring the obtained new data to comprise an action setting and destination web address of a remote internet server, wherein action setting comprises one of a remote procedure call (RPC) method and hypertext transfer protocol (HTTP) method...".

The Examiner also provided the following statement of reasons for the indication of allowable subject matter:

None of the prior art of the record explicitly teaches or fairly suggests all of the claimed limitation, especially the limitation wherein performing at a Bluetooth enabled data capture device: establishing a paired secure Bluetooth connection between the Bluetooth enabled data capture device and the Bluetooth enabled mobile device, wherein the paired secure Bluetooth connection uses cryptographic encryption key; acquiring new data in the Bluetooth enabled data capture device, wherein new data is data acquired after the paired secure Bluetooth connection is established; sending a message to the Bluetooth enabled mobile device, corresponding to supported data capability of the Bluetooth enabled data capture device; detecting and signaling the new data for transfer, to the Bluetooth enabled mobile device, wherein detecting and signaling the new data for transfer comprises: receiving a request to get new data, at the Bluetooth enabled data capture device, from the Bluetooth enabled mobile device, over the established paired Bluetooth connection; receiving a request to enable event notifications for new data on the Bluetooth enabled data capture device, from the Bluetooth enabled mobile device, over the established paired secure Bluetooth connection; enabling event notification on Bluetooth enabled data capture device, corresponding to new data; determining existence of the new data for transfer; and sending event notification as a signal to the Bluetooth enabled mobile device, corresponding to existence of new data for transfer, over the established paired secure Bluetooth connection, wherein the Bluetooth enabled mobile device listens for the event notification sent from the Bluetooth enabled data capture device; encrypting, using cryptographic

encryption key, the new data acquired in the Bluetooth enabled data capture device; and transferring the encrypted data from the Bluetooth enabled data capture to the Bluetooth enabled mobile device, over the paired secure Bluetooth connection, wherein the Bluetooth enabled mobile device has access to the internet, wherein the Bluetooth enabled mobile device is configured to receive the encrypted data[[.]] and obtain the new data from the encrypted data using cryptographic encryption key, wherein the Bluetooth enabled mobile device is configured to apply action setting and destination web address of a remote internet server to the obtained new data, wherein action setting comprises one of a remote procedure call (RPC) method and hypertext transfer protocol (HTTP) method, wherein the Bluetooth enabled mobile device is configured to send the obtained new data along with a user identifier to a remote internet server, wherein the user identifier uniquely identifies a particular user of internet service provided by the remote internet server.

The Applicant provided a further response on October 9, 2024 which amended claim 1 to further recite “sending a message to the Bluetooth enabled mobile device, corresponding to supported data capability of the Bluetooth enabled data capture device”.

### III. The ‘030 Patent.

8. The ‘030 Patent is directed to a method and system for utilizing a digital data capture device in conjunction with a Bluetooth enabled mobile device for publishing data and multimedia content on one or more websites.

Independent claim 1 of the ’030 patent is repeated below:

1. A method for transferring data from a Bluetooth enabled data capture device to a remote internet server via a Bluetooth enabled mobile device comprising:

performing at a Bluetooth enabled data capture device:

establishing a paired secure Bluetooth connection between the Bluetooth enabled data capture device and the Bluetooth enabled mobile device, wherein the paired secure Bluetooth connection uses cryptographic encryption key;

sending a message to the Bluetooth enabled mobile device, corresponding to supported data capability of the Bluetooth enabled data capture device;

acquiring new data in the Bluetooth enabled data capture device, wherein new data is data acquired after the paired secure Bluetooth connection is established;

detecting and signaling the new data for transfer, to the Bluetooth enabled mobile device, wherein detecting and signaling the new data for transfer comprises:

receiving a request to get new data, at the Bluetooth enabled data capture device, from the Bluetooth enabled mobile device, over the established paired Bluetooth connection;

receiving a request to enable event notifications for new data on the Bluetooth enabled data capture device, from the Bluetooth enabled mobile device, over the established paired secure Bluetooth connection;

enabling event notification on Bluetooth enabled data capture device, corresponding to new data; determining existence of the new data for transfer; and

sending event notification as a signal to the Bluetooth enabled mobile device, corresponding to existence of new data for transfer, over the established paired secure Bluetooth connection, wherein the Bluetooth enabled mobile device listens for the event notification sent from the Bluetooth enabled data capture device;

encrypting, using cryptographic encryption key, the new data acquired in the Bluetooth enabled data capture device; and

transferring the encrypted data from the Bluetooth enabled data capture to the Bluetooth enabled mobile device, over the paired secure Bluetooth connection, wherein the Bluetooth enabled mobile device has access to the internet, wherein the Bluetooth enabled mobile device is configured to receive the encrypted data and obtain the new data from the encrypted data using cryptographic encryption key, wherein the Bluetooth enabled mobile device is configured to apply action setting and destination web address of a remote internet server to the obtained new data, wherein action setting comprises one of a remote procedure call (RPC) method and hypertext transfer protocol (HTTP) method, wherein the Bluetooth enabled mobile device is configured to send the obtained new data along with a user identifier to a remote internet server, wherein the user identifier uniquely identifies a particular user of internet service provided by the remote internet server.

#### **IV. Determination of the '499 Request**

9. Claims 1, 2, 4-7, and 9-18 of the '030 patent will be the basis for deciding whether or not a "substantial new question of patentability" (SNQ) is present. See 37 CFR 1.620(a).

#### **V. Criteria for the '499 Request Determination**

10. Whether a substantial new question of patentability (SNQ) affecting any of claims 1, 2, 4-7, and 9-18 of the '030 patent is raised by the prior art references presented in the '499 Request. See 35 U.S.C. 257(a), MPEP §2242.

#### **VI. Prior Art References**

11. The '499 Request requests *ex parte* reexamination in view of the following cited prior art references, submitted with the '499 Request and re-cited below:

- 1) Morón et al., “J2ME and smart phones as platform for a Bluetooth Body Area Network for Patient-telemonitoring.”
- 2) Bluetooth Specification, “Specification of the Bluetooth System”.
- 3) Otto US Patent 7,843,325
- 4) RFC 2616, “Hypertext Transfer Protocol –HTTP/1.1”

#### **VI.A. Information Disclosure Statement**

10. With respect to the Information Disclosure Statement submitted on April 30, 2024 along with the Request for Reexamination, the information cited has been considered as described in the MPEP. Note that MPEP 2256 and 2656 indicate that degree of consideration to be given to such information will be normally limited by the degree to which the party filing the information citation has explained the content and relevance of the information. Information that does not appear to be "patents or printed publications" as identified in 35 U.S.C. 301 or publications which have not been dated as required have been considered to the same extent (unless otherwise noted), but have been lined through and will not be printed on any resulting reexamination certificate.

#### **VII. Prior Art Analysis**

11. SNQ standard as set forth in MPEP 2242:

For “a substantial new question of patentability” to be present, it is only necessary that: (A) the prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the (prior art) patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and (B) the same question of patentability as to the claim has not been decided by the Office in an earlier concluded examination or review of the patent, raised to or by the Office in a pending reexamination or supplemental examination of the patent, or decided in a final holding of invalidity (after all appeals) by a

federal court in a decision on the merits involving the claim. If a reexamination proceeding was terminated/vacated without resolving the substantial question of patentability question, it can be re-presented in a new reexamination request. It is not necessary that a "*prima facie*" case of unpatentability exist as to the claim in order for "a substantial new question of patentability" to be present as to the claim. Thus, "a substantial new question of patentability" as to a patent claim could be present even if the examiner would not necessarily reject the claim as either fully anticipated by, or obvious in view of, the prior art patents or printed publications.

In addition, as set forth in MPEP 2216, "[t]he legal standard for ordering ex parte reexamination, as set forth in 35 U.S.C. 303(a), requires a substantial new question of patentability. The substantial new question of patentability may be based on art previously considered by the Office if the reference is presented in a new light or a different way that escaped review during earlier examination."

#### **VIII. Prior Art References Raising a Substantial Question of Patentability**

As identified above during the examination of the underlying patent application, the teachings directed to any of "receiving a request to enable event notifications for new data on the Bluetooth enabled data capture device, from the Bluetooth enabled mobile device, over the established paired secure Bluetooth connection", "enabling event notification on the Bluetooth enabled data capture device, corresponding to new data", "determining existence of the new data for transfer", "sending event notification as a signal to the Bluetooth enabled mobile device, corresponding to existence of new data for transfer, over the established paired secure Bluetooth connection, wherein the Bluetooth enabled mobile device listens for the event notification sent from the Bluetooth enabled data capture device" and "transferring the encrypted data from the Bluetooth enabled data capture to the Bluetooth enabled mobile device, over the paired secure Bluetooth connection, ... wherein the Bluetooth enabled mobile device is configured to receive the encrypted data, obtain the new data from the encrypted data using cryptographic encryption

key...” as recited in at least claim 1 will be the basis for determining whether the cited references raise a SNQ as to claims 1, 2, 4-7, and 9-18.

As set forth above, during the original prosecution, these limitations were considered important in determining the patentability of the claims over the relied upon prior art.

**Ground 1 (Claims 1-2, 4-7, 9-18):**

**Morón, Bluetooth Specification, Otto and RFC 2616**

As to “establishing a paired secure Bluetooth connection between the Bluetooth enabled data capture device and the Bluetooth enabled mobile device, wherein the paired secure Bluetooth connection uses cryptographic encryption key” As detailed in Moron:

“An application in the IN manages the Bluetooth piconet and the CCS connections. When it is automatically started, the following steps are carried out: (1) inquiry procedure, (2) services search, (3) connection establishment with the pulsioximeter and GPS device, (4) pulsioximeter configuration and (5) server connection and user registration. As the IN receives data from iBAN nodes, it stores them during a period which can be remotely configured.”

Morón pp. 2792-93 (Section III.A).

Morón’s provides a “connection establishment” between the smart phone (IN) (see page 2793 Section IV) and the Bluetooth pulsioximeter.

Bluetooth Specification discloses a pairing procedure between two Bluetooth devices as part of “Connection Establishment.” For example, Bluetooth Specification, Part C, Section 4, is titled “Connection Establishment.” Bluetooth (E), p. 232. This Connection Establishment procedure includes an LMP (link manager protocol) procedure for “pairing”.

The connection establishment technique in Bluetooth Specification includes LMP procedures for “authentication.” Section 3.2 of Part C of the Bluetooth Specification is titled “Authentication” and states:

“The authentication procedure is based on a challenge-response scheme as described in Baseband Specification Section 14.4, on page 168. The verifier sends an LMP\_au\_rand PDU which contains a random number (the challenge) to the claimant. The claimant calculates a response, which is a function of the challenge, the claimant's BD ADDR and a secret key. The response is

sent back to the verifier, which checks if the response was correct or not. How the response should be calculated is described in Baseband Specification Section 14.5.1, on page 170. A successful calculation of the authentication response requires that two devices share a secret key.”

See Bluetooth Specification p. 194.

Bluetooth Specification further states:

“The entity authentication used in Bluetooth uses a challenge-response scheme in which a claimant’s knowledge of a secret key is checked through a 2-move protocol using symmetric secret keys.”

Bluetooth Specification, p. 168.

Additionally, Figure 4.1 (p. 232), shows a procedure for “encryption.” Section 3.6 of Part C of the Bluetooth Specification states: “If at least one authentication has been performed encryption may be used.” Bluetooth Specification, p. 201. Further, Bluetooth Specification states: “User information can be protected by encryption of the packet payload; the access code and the packet header are never encrypted.” Bluetooth Specification p. 158.

See also Section 14 pages 148-149

As to **“receiving a request to enable event notifications for new data on the Bluetooth enabled data capture device, from the Bluetooth enabled mobile device, over the established paired secure Bluetooth connection”** and **“enabling event notification on Bluetooth enabled data capture device”**, Morón’s intelligent node, a Bluetooth smart phone, receives data from the Bluetooth pulsioximeter, a Bluetooth enabled data capture device. Bluetooth Specification teaches that communications in a Bluetooth system occur over the established paired secure Bluetooth connection.

Morón states: “An application in the IN manages the Bluetooth piconet and the CCS connections. When it is automatically started, the following steps are carried out: (1) inquiry procedure, (2) services search, (3) connection establishment with the pulsioximeter and GPS device, (4) pulsioximeter

configuration and (5) server connection and user registration. As the IN receives data from iBAN nodes, it stores them during a period which can be remotely configured.” Morón pp. 2792-93.

Otto teaches:

“In one embodiment, during assignment of sensors 103-106 with body locations, the control logic 204 dynamically reconfigures each sensor 103-106 to perform a function specific to the location on which the sensor 103-106 was placed. For example, the sensor 103-106 that is placed on the chest is dynamically reconfigured, for example, to monitor heart rate.”

Otto at 7:19-22.

“In this regard, the control logic 204 transmits commands to the sensors 103- 106 specifying particular algorithms to use.”

Otto at 7:27-29.

“The raw data samples are also provided as input to application specific sensor logic 804, and the sensor logic 804 employs event detection algorithms 1301 for detecting a pre-defined event, for example an arrhythmic occurrence if the sensor logic 804 is designed to process heartbeat signals.”

Otto at 15:45-50.

When the sensing device 806 detects an arrhythmic event, the sensor logic 804 transmits data indicative of the arrhythmic event 1402 to the controller 102.”

Otto 16:7-10.

“In another embodiment, the body area network 101 is implemented with Bluetooth®. ‘Bluetooth’ refers to another set of specifications for communication protocols for a personal area networks (PAN).”

Otto at 4:10-13.

As set forth above, Otto’s teaching of transmitting “commands” to the sensors, which include algorithms for the sensors to use, is a request to enable event notifications for new data on the Bluetooth enabled data capture device. See col. 7, lines 19-36. These commands enable event notifications on the

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Bluetooth enabled data capture device corresponding to new data, for example, an “arrhythmic occurrence”.

As to **“determining existence of the new data for transfer; and sending event notification as a signal to the Bluetooth enabled mobile device, corresponding to existence of new data for transfer,**

As shown in element 1402 of Figure 14 of Otto, an “arrhythmic event [is] detected by sensor.” Further, as Otto explains: “When the sensing device 806 detects an arrhythmic event, the sensor logic 804 transmits data indicative of the arrhythmic event 1402 to the controller 102.” Otto at 16:7-10.

Otto further discloses “When the sensing device 806 detects an arrhythmic event, the sensor logic 804 transmits data indicative of the arrhythmic event 1402 to the controller 102.” Otto at 16:7-9. See Figure 14

As to **“transferring the encrypted data from the Bluetooth enabled data capture to the Bluetooth enabled mobile device, over the paired secure Bluetooth connection, wherein the Bluetooth enabled mobile device has access to the internet, wherein the Bluetooth enabled mobile device is configured to receive the encrypted data and obtain the new data from the encrypted data using cryptographic encryption key, wherein the Bluetooth enabled mobile device is configured to apply action setting and destination web address of a remote internet server to the obtained new data, wherein action setting comprising one of a remote procedure call (RPC) method and hypertext transfer protocol (HTTP) method**

Morón teaches transferring the obtained new data ... to a remote internet server: “The communication between the CSS and patient iBAN can be established with two protocols: (a) HTTP: data are sent in a HTTP request.” Morón p. 2793.

Morón discloses:

“A midlet running in the smart phone compiles information about patient’s location and health status. The midlet encrypts and retransmits it to the server through 802.11 or GPRS/UMTS.”

Morón p. 2791.

“The physician can access the system from any point with Internet access, using a navigator with RMI (Remote Method Invocation) support by means of a Java Applet (J Applet).”

Morón p. 2793.

“A central coordinator node that communicates with sensors and, simultaneously, acts as an Internet gateway to other networks (GSM/GPRS/UMTS or WLAN) in order to transmit sensors biosignals (or medical alarms) and to receive control information.”

Morón p. 2791; see also at 2794 (“CCS is an Apache web server”).

Otto teaches a “medical server 109 ... communicatively coupled to the controller 102 via a network 108” and that the network may be, for example, a “digital cellular” or “WiMax” network (Otto 4:17-23).

In addition, Morón describes that a Mobile Control Monitoring Unit (MCMU) carried by a physician may receive an alert, which includes a patient identifier. “The generated MMS contains a text with the patient identifier and the values of the sensed health parameter, a patient’s photograph and a sound clip with a message from the patient (to describe a sensation or any indication of disease).” Morón p. 2793. Morón teaches that data is communicated using an HTTP request: “The communication between the CSS and patient iBAN can be established with two protocols: (a) HTTP: data are sent in a HTTP request.” Morón p. 2793

RFC 2616 shows that HTTP requests include a “method token” which “indicates the method to be performed.” RFC 2616, p. 35. Further, RFC 2616, which states the request includes a “URI” which includes a web address. RFC 2616, p. 24.

As to **“encrypting, using cryptographic encryption key, the new data acquired in the Bluetooth enabled data capture device”** as shown in Figure 8.4 of Bluetooth Specification, data is encrypted before transmission: “User information can be protected by encryption of the packet payload; the access code and the packet header are never encrypted. The encryption of the payloads is carried out with a stream cipher called EO that is re-synchronized for every payload.” Bluetooth Specification at p. 158.

Additionally, as shown in Bluetooth Specification section 14.3.2, individually addressed traffic is encrypted using a “semi-permanent link key” or a “master key”.

Morón discloses:

“An application in the IN manages the Bluetooth piconet and the CCS connections. When it is automatically started, the following steps are carried out: (1) inquiry procedure, (2) services search, (3) connection establishment with the pulsioximeter and GPS device, (4) pulsioximeter configuration and (5) server connection and user registration. As the IN receives data from iBAN nodes, it stores them during a period which can be remotely configured.” Morón pp. 2792-93.

Otto teaches the controller receiving the raw data from the sensor:

“In response to the request 1404, the sensor logic 804 then transmits raw data 1403 to the controller 102 so that the user can review the actual raw data that is being obtained by the sensing device 806.”

Otto at 16:11-14

The Examiner notes that the above citations, which addresses teachings directed to **Morón**, **Bluetooth Specification**, **Otto** and **RFC 2616** with respect to at least the above identified limitations were not previously cited during the original prosecution of the underlying patent. In addition, no concluded review of this combination was previously set forth on the record. Accordingly, a reasonable examiner would consider this teaching important in determining the patentability of claims 1, 2, 4-7, and 9-18.

Accordingly, **Morón**, **Bluetooth Specification**, **Otto** and **RFC 2616** raise a Substantial New Question of Patentability.

### IX. 325(d) Analysis<sup>1</sup>

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 ‘030 patent indicates that the patent was the subject of a single prior AIA petition. On April 5, 2024, petitioner TikTok, Inc. filed a petition seeking *inter partes* review of claims 1-18 of the ‘030 patent (IPR2024-00770). 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     | 1-2, 4-7, 9-18    | 103      | Hiroishi, Takahashi, Bluetooth |
| 2     | 1-2, 4-7, 9-18    | 103      | Hiroishi, Kahn, Bluetooth      |
| 3     | 1-2, 4-7, 9-14    | 103      | Singh129, Bluetooth            |
| 4     | 15-18             | 103      | Singh129, Bluetooth, Takahashi |

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 Hiroishi, Takahashi, Bluetooth, Kahn and Singh129 have not been addressed by the PTAB.

A comparison between the prior art and arguments presented in the current *ex parte* reexamination Request (90/019,499) and the prior *inter partes* review petition (IPR2024-00770) indicates

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<sup>1</sup> It is noted that on July 20, 2024, Patent Owner filed a petition under 37 CFR 1.182 seeking to have the Director reject this Request under her discretionary authority pursuant to 35 USC § 325(d). However, this petition was filed over 2 ½ months after the reexamination request was served on Patent Owner and just 10 days before the statutory deadline for making a decision on the reexamination request. This petition was not received in sufficient time for entry and consideration by the Central Reexamination Unit (CRU) in making the determination on the request. Accordingly, this petition will be treated by the Office after the issuance of this Order.

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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, 2, 4-7 and 9-18 of the '030 patent:

| SNQ # |  | Claims Challenged | Basis | References                                     |
|-------|--|-------------------|-------|------------------------------------------------|
| 1     |  | 1, 2, 4-7, 9-18   | 103   | Morón, Bluetooth Specification, Otto, RFC 2616 |

As an initial matter, none of the grounds asserted as raising an SNQ in the current *ex parte* reexamination Request (90/019,499) 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 Morón, Bluetooth Specification, Otto and RFC 2616 are materially different references than presented in the IPR petition, as noted above, and thus present different disclosures than the Hiroishi, Takahashi, Bluetooth, Kahn and Singh129 references presented in the prior IPR petition (IPR2024-00770). It is also noted that a review of the Bluetooth reference presented in the prior IPR petition (IPR2024-00770) and the Bluetooth Specification reference presented in the current *ex parte* reexamination Request (90/019,499) indicates that they are two distinct references that are materially different with different disclosures.

Accordingly, because the Request is not based on the same or substantially the same art or arguments as were previously presented to the Office, the statutory threshold for the Director to exercise discretion to reject this request is not met.

However, to the extent that the references of Morón, Bluetooth Specification, Otto and RFC 2616 presented in the current *ex parte* reexamination Request (90/019,499) are considered to be substantially

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similar to the references of Hiroishi, Takahashi, Bluetooth, Kahn and Singh<sup>129</sup> presented in the prior IPR petition (IPR2024-00770), such the statutory threshold under 35 USC 325(d) is met, 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 '030 patent and there has been no finding of serial abusive Office challenges to the '030 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 IPR2024-00770 petition and therefore has not yet considered the merits of the references presented in the IPR petition;
- 3.) The fact that there is minimal additional burden on the Office in examining the claims of the '030 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 Morón, Bluetooth Specification, Otto and RFC 2616, which are determined to raise an SNQ over claims 1, 2, 4-7 and 9-18 of the '030 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 Morón, Bluetooth Specification, Otto and RFC 2616 references raise an SNQ to the '030 patent for the reasons set forth above.

## **X. Conclusion**

**12. For the reasons given above, the present request for ex parte reexamination raises a substantial new question affecting claims 1, 2, 4-7, and 9-18 of the '030 patent.**

13. Claims 1, 2, 4-7, and 9-18 were not subject to a final holding of invalidity by a federal court or by the Office in a previous examination over the same issue.

### **Extension of Time**

Extensions 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 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).

### **Waiver of Right to File Patent Owner Statement**

In a reexamination proceeding, Patent Owner may waive the right under 37 C.F.R. 1.530 to file a Patent Owner Statement. The document needs to contain a statement that Patent Owner waives the right under 37 C.F.R. 1.530 to file a Patent Owner Statement and proof of service in the manner provided by 37 C.F.R. 1.248, if the request for reexamination was made by a third party requester, see 37 C.F.R. 1.550. The Patent Owner may consider using the following statement in a document waiving the right to file a Patent Owner Statement: Patent Owner waives the right under 37 C.F.R. 1.530 to file a Patent Owner Statement.

### **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)-(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). 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

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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

**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. 8,904,030 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.

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

Electronically: Registered users may submit via Patent Center at <https://patentcenter.uspto.gov/>.

By Mail to: Mail Stop *Ex Parte* Reexam  
Central Reexamination Unit  
Commissioner for Patents  
United States Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900  
Central Reexamination Unit

By hand: Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

For electronic transmissions, 37 CFR 1.8(a)(1)(i)(C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the USPTO patent electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence

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stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

Any inquiry by the patent owner concerning this communication or earlier communications from the 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.

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