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Reichman Jorgensen Lehman & Feldberg LLP
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EXAMINER

SORRELL, ERON J

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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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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

June 5, 2024

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. : 90019162
PATENT NO. : 07233978
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)).



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In re Overton et al. :
Ex Parte Reexamination Proceeding : DECISION ON
Control No. 90/019,162 : PETITION UNDER
Filed: February 16, 2023 : 37 CFR 1.515(c) and 1.181
For: U.S. Patent No. 7,233,978 :

This is a decision on a petition filed by Third Party Requester (hereinafter also called “Petitioner”) on June 5, 2023, (hereinafter “Petition”). Petitioner seeks review of the “***Order Granting Request For Ex Parte Reexamination***” which denied the request for reexamination of claims 3, 10 and 14 of U.S. Patent No. 7,233,978 (hereinafter “the ’978 patent”). The Petition was timely filed.

The Petition is before the Director of the Central Reexamination Unit (CRU) for decision.

The Petition is **GRANTED** for the reasons set forth below.

REVIEW OF RELEVANT FACTS

1. On June 19, 2007, the ’978 patent issued to Overton et al.
2. On February 16, 2023, Third Party Requester filed a request for *ex parte* reexamination of the ’978 patent. The resulting reexamination proceeding was assigned Control No. 90/019,162 (hereinafter “the ’162 proceeding”). Reexamination was requested for claims 3, 6, 10 and 14 of the ’978 patent.

3. On February 23, 2023 a “**NOTICE OF REEXAMINATION REQUEST FILING DATE**” (hereinafter “Notice”) was mailed for the ’162 proceeding. The Notice indicated that the filing date of the request for reexamination is February 17, 2023.
4. On May 16, 2023, the Examiner issued an “***Order Granting Request For Ex Parte Reexamination***” (hereinafter “Order”). Reexamination was granted as to claim 6, but was denied as to claims 3, 10 and 14.
5. On June 5, 2023, Third Party Requester filed a petition for review of the order denying the request as to claims 3, 10 and 14.

DISCUSSION

I. Standard of Review

37 C.F.R. § 1.515(c) provides for the filing of a petition under 37 C.F.R. § 1.181 to review an Examiner’s determination refusing to order *ex parte* reexamination. The CRU Director’s review on petition is *de novo*. Therefore, this review will determine whether the Examiner’s refusal to order reexamination for the claims was correct, and will not necessarily indicate agreement or disagreement with every aspect of the examiner’s rationale for the denial of the request to order reexamination for the claims of the ’111 patent.

The following rules and procedures are applicable to this review:

35 U.S.C. § 303(c) provides:

A determination by the Director pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Director may refund a portion of the reexamination fee required under section 302 of this title.

37 C.F.R. § 1.515(c) provides:

The requester may seek review by a petition to the Director under 37 C.F.R. § 1.181 within one month of the mailing date of the examiner's determination refusing *ex parte* reexamination. Any such petition must comply with 37 C.F.R. § 1.181(b). If no petition is timely filed or if the decision on petition affirms that no substantial new question of patentability has been raised, the determination shall be final and nonappealable.

MPEP § 2242(II)(A) provides, in pertinent part:

In a decision to order reexamination made on or after November 2, 2002, reliance on old art does not necessarily preclude the existence of a substantial new question of patentability that is based exclusively on that old art. See Public Law 107-273, 116 Stat.

1758, 1899-1906 (2002), which expanded the scope of what qualifies for a substantial new question of patentability upon which a reexamination may be based. Determinations on whether a substantial new question of patentability exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis. For example, a substantial new question of patentability may be based solely on old art where the old art is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier examination(s), in view of a material new argument or interpretation presented in the request. Such material new argument or interpretation may be based solely on claim scope of the patent being reexamined.

MPEP § 2248 provides, in pertinent part:

If a petition seeking review of the examiner's determination refusing reexamination is filed, it is forwarded (together with the reexamination file) to the Office of the CRU Director for decision. Where a petition is filed, the CRU Director will review the examiner's determination that a substantial new question of patentability has not been raised. The CRU Director's review will be *de novo*. Each decision by the CRU Director will conclude with the paragraph:

This decision is final and nonappealable. See 35 U.S.C. § 303(c) and 37 C.F.R. § 1.515(c). No further communication on this matter will be acknowledged or considered.

If the petition is granted, the decision of the CRU Director should include a sentence setting a 2-month period for filing a statement under 37 CFR 1.530, the reexamination file will then be returned to the CRU Supervisory Patent Examiner (SPE) of the art unit that will handle the reexamination for consideration of reassignment to another examiner.

II. The Legal Standard for Ordering Reexamination

A review of 35 U.S.C. §§ 302 and 303 reveals that, by statute, *ex parte* reexamination of a United States Patent is only authorized when a consideration of prior art consisting of patents or printed publications establishes that a substantial new question of patentability exists with respect to one or more claims of that patent. 35 U.S.C. § 302 requires that a request for *ex parte* reexamination be based upon prior art as set forth in 35 U.S.C. § 301, that is, prior art consisting of patents or printed publications, while 37 C.F.R. § 1.510(b)(1) requires that a request for *ex parte* reexamination include "a statement pointing out each substantial new question of patentability based on the cited patents and printed publications." A substantial new question of patentability (SNQ) is raised by a cited patent or printed publication when there is a substantial likelihood that a reasonable examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable. If the prior art patents and printed publications relied upon in the request raise a substantial question of patentability, then a "substantial new question of patentability" is present, unless the same question of patentability has already been decided by a final court holding of invalidity after all appeals, or by the Office in an earlier examination or in a reexamination of a patent. If a substantial new question of

patentability is found to be raised, an order granting *ex parte* reexamination of the patent is issued.

An SNQ is not raised by the old prior art if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to the patent and has decided that question in favor of the patent owner based on the same prior art patents or printed publications. *In re Recreative Technologies*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996).

Looking to the legislative history for the original reexamination statute,¹ Congress stated:

“Section I provides for a system of administrative reexamination of patents within the patent office. This new procedure will permit any party to petition the patent office to review the efficacy of a patent, subsequent to its issuance, on the basis of **new information about preexisting technology which may have escaped review at the time of the initial examination of the patent application**. H.R. Rep. No. 96-1307, 96th Cong., 2d Sess. 3 (1980), reprinted in 1980 U.S.C.C.A.N. 6460, 6461, 6462.” [Emphasis added]

Reexamination is limited to review of new information about preexisting technology that may have escaped review at the time of the initial examination of the patent application. It was not designed for harassment of a patent owner by review of old information about preexisting technology, even if a third party feels the Office’s conclusion based on that old information was erroneous. The Office may assume jurisdiction over a patent for which reexamination is requested in order to review the patentability of one or more claims of that patent only if such new information about preexisting technology is presented in a request for reexamination.² Absent establishment of at least one SNQ, the Office does not have jurisdiction to revisit the issue of claim patentability.

In accordance with this legislative history, MPEP 2242, part II.A. was drafted to require, in order to raise an SNQ for old art, that the old art must be “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.”^{3,4} This new light must be in terms of how to interpret the state of the “pre-existing technology,” as was envisioned by the authors of the original reexamination statute, and left unchanged by the 2002 enactment. For example, a reference may be read in a “new light” if the requester draws attention to a portion of the reference that was not relied upon, or otherwise addressed, in a rejection during the earlier concluded examination of the patent for which reexamination is requested. Similarly, a reference may be interpreted in a new light, or in a different way, by defining a term of art used in the reference, where the definition of the term of art had not been previously presented in the earlier concluded examination of the patent. Additionally, a substantial new question of patentability may be based solely on old art where the old art is being presented/viewed in a new

¹ Public Law 96-517, enacted on December 12, 1980.

² This requirement is not applicable to Director ordered reexaminations.

³ See: *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351 (Bd. Pat. App. & Inter. 1984).

⁴ For additional discussion regarding technical teachings viewed “in a new light, see: *In re Melvin J. Swanson et al*, 540 F.3d 1368,1376, 2008 U.S. APP. Lexis 18928, **16-17 (citing H.R. Rep. No. 96-1307 (1980) and H.R. Rep. No. 107-120, at 2-3).

light, or in a different way, as compared with its use in the earlier examination(s), in view of a material new argument or interpretation presented in the request. Such material new argument or interpretation may be based solely on claim scope of the patent being reexamined.

III. Summary of the Patent Prosecution History

The '978 patent issued to **Econnectix, LLC** on June 19, 2007 from application number 09/872,736, filed June 1, 2001. The '978 patent was a continuation-in-part of application 09/661,222, filed September 13, 2000, and issued as U.S. Patent No. 7,103,640, which was a continuation-in-part of application 09/503,441, filed February 14, 2000, now abandoned, which was a continuation-in-part of application 09/367,461, filed August 13, 1999, now abandoned, which was a continuation-in-part of application 09/111,896, filed July 8, 1988, now abandoned.

The '736 application was filed with claims 1-45. On December 6, 2004, the Office issued a Requirement for Restriction to the invention of Group I (claims 1-23 and 45, drawn to a computer-to-computer data addressing) or the invention of Group II (claims 24-44, drawn to generating database or database structure). On January 6, 2005, Applicants responded by electing the invention of Group II (claims 24-44) with traverse.

On August 22, 2005, the Office issued a first action on the merits, withdrawing claims 1-23 from consideration and rejecting claims 24-45. Claims 24-26, 29-38 and 40-45 were rejected under 35 U.S.C. § 102(e) as anticipated by **Lumelsky et al.** (U.S. Patent No. 6,466,980), claims 27-28 and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over **Lumelsky et al.** in view of **Bowman-Amuah** (U.S. Patent No. 6,578,068).

On February 22, 2006, Applicants filed a response presenting arguments but without claim amendments. Specifically, Applicants argued that "Lumelsky disclosed using location information in service of optimizing distribution of multimedia objects whereas Applicant's claims recite managing location information separately from the data to which the location information pertains."

The Office mailed a final rejection on June 1, 2006. The rejections set forth in the Office action mailed August 22, 2005 were maintained.

A Request for Continued Examination (RCE) under 37 C.F.R. § 1.114 was filed on November 1, 2006. The claims were amended and Applicants argued that the claim amendments defined the invention over the applied prior art reference of Lumelsky. Applicants also argued that claims 1-23, which had been withdrawn and were amended with the November 1, 2006 RCE, were introduced in view of the claim amendments and an interview with the Examiner on August 9, 2006.

The Office issued a Notice of Allowance on February 13, 2007. The Examiner stated in the Reasons for Allowance that “Lumelsky does not teach a system and a method for management of location information separate from the data to which the location information pertains, but instead relates to manipulation of the actual data (multimedia objects in Lumelsky) rather than just the location information for that data.”

IV. Related Proceedings

The application which issued as the ‘978 patent was application no. 09/872,736 (“the ‘736 application”).

The ‘736 application is a continuation-in-part of application 09/661,222 (“the ‘222 application”), which issued as U.S. Patent 7,103,640 (“the parent ‘640 patent”). *Ex Parte* Reexamination was requested on February 17, 2023 for the parent ‘640 patent and was assigned control no. 90/019,166. Reexamination was ordered on April 4, 2023.

Additionally, a continuation application was filed from the ‘222 application, 11/354,224 which issued as U.S. Patent 7,814,170 (“the child ‘170 patent”). *Ex Parte* Reexamination was requested on February 17, 2023 for the child 170 patent and was assigned control no. 90/019,165. Reexamination was ordered on March 29, 2023.

V. De Novo Review of the Request for Reexamination - Findings and Analysis

The request was denied as to claims 3, 10 and 14 in the Order granting the request for *Ex Parte* Reexamination, mailed May 16, 2023, wherein the Examiner maintained that a substantial new question of patentability or SNQ was not raised, with respect to claims 3, 10 and 14, by the references cited in the request.

In accordance with the requirements of the reexamination statute and rules, a review of the record as it appeared before the Examiner at the time of the Order has been undertaken prior to the preparation of this decision. A *de novo* determination has been made as to whether the request for *ex parte* reexamination raises at least one substantial new question of patentability or SNQ. This review will focus on the correctness of the ultimate decision to grant or deny reexamination and will not review specific findings in the Order denying reexamination. The Director has reviewed the entire record, and has determined that there is at least one substantial new question of patentability presented by the teachings of the prior art references submitted with the request for the reasons set forth below.

In the February 17, 2023 request for *ex parte* reexamination of the ‘978 patent, Third Party Requester asserted the following substantial new questions of patentability (SNQ):

SNQ 1: Claims 3, 6, 10 and 14 in view of the U.S. Patent No. 6,473,781 (Skagerwall) or in view of Skagerwall and U.S. Patent No. 6,185,601 (Wolff).

SNQ 2: Claims 3, 6, 10 and 14 in view of OracleNamesAdminGuide or in view of OracleUnleashed and/or Steen.

SNQ 3: Claims 3, 6, 10 and 14 in view of Steen or in view of Wolff and/or Skagerwall.

None of the Skagerwall, Wolff, OracleNamesAdminGuide, Oracle Unleashed or Steen were cited during the prosecution of the application that led to the issuance of the '978 patent.

Petitioner contends that the Examiner incorrectly determined that the cited prior art did not teach the limitation of a "redirect message comprising information for finding a location server known to have location information relevant to the location query," as set forth in claims 3, 10 and 14 of the '978 patent. Petitioners argue that Wolff and Steen specifically teach this feature. Petition at 22-23. A review of the Wolff reference reveals that Wolff specifically discloses re-mapping in response to a redirection command (see Wolff at col. 5, lines 25-38). In addition, a review of the Steen reference reveals that Steen teaches that knowledge should be stored on each node to avoid extra requests on the network, thus teaching the use of a redirect message (see Steen at page 108). The teachings in both Wolff and Steen present new non-cumulative technical teachings relative to the claims of the '978 patent that a reasonable Examiner would consider important in determining the patentability of the claims of the '978 patent. Accordingly, the combination of at least Wolff and Steen alone or with other references cited in the request raise a substantial new question of patentability or SNQ with respect to the claims 3, 10 and 14 of the '978 patent.

CONCLUSION

1. Based on a *de novo* review of the record as a whole, the Petition is **GRANTED**. Accordingly, the request for *ex parte* reexamination of the '978 patent is granted, and reexamination is hereby ordered for claims 3, 10 and 14 (in addition to reexamination being ordered for claim 6).
2. The decision is final and nonappealable. See 35 U.S.C. § 303(c) and 37 C.F.R. § 1.151(c).
3. An Examiner will be assigned to this ordered reexamination proceeding pursuant to MPEP § 2248, and the proceeding will be forwarded to this Examiner for further action.
4. **RESPONSE TIMES ARE SET TO EXPIRE AS FOLLOWS:**

For Patent Owner's Statement (optional): TWO months from the mailing date of this decision. Any statement filed by the Patent Owner shall clearly point out why the subject matter as claimed is not anticipated or rendered obvious by the prior art patents and publications cited in the request, either alone or in any reasonable combination. Any statements filed must be served upon the reexamination requester in accordance with section 1.248. EXTENSIONS OF TIME ARE GOVERNED BY 37 C.F.R. § 1.550(c).

Waiver of Patent Owner Statement Period: Patent Owner may expedite the reexamination proceeding by filing a paper that indicates that the Patent Owner waives the filing of a statement under 37 C.F.R. § 1.530 and serving the waiver on the Requester. This will permit reexamination of the proceeding to proceed pursuant to 37 C.F.R. § 1.550(a).

For Requestor's reply (optional): TWO MONTHS from the date of service of any Patent Owner's Statement. 37 C.F.R. § 1.535. NO EXTENSION OF TIME IS PERMITTED. If Patent Owner does not file a timely Statement under 37 C.F.R. § 1.530(c), no reply by the Requestor is permitted.

5. Telephone inquiries related to this decision should be directed to Stephen J. Stein, Managing Quality Assurance Specialist, at (571) 272-1544.

/David P. Ruschke/

David P. Ruschke

Director, Central Reexamination Unit