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90/010,532	06/10/2009	5,799,320	C0988.70004US01	7643

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INTELLECTUAL PROPERTY DEPARTMENT
370 SEVENTEENTH STREET
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DENVER, CO 80202-5647

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 08/28/2009

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



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/010,532.

PATENT NO. 5,799,320.

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 / Denying Request For Ex Parte Reexamination	Control No. 90/010,532	Patent Under Reexamination 5,799,320	
	Examiner Zoila E. Cabrera	Art Unit 3992	

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

The request for *ex parte* reexamination filed 10 June 2009 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

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

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

RESPONSE TIMES ARE SET AS FOLLOWS:

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

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

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

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

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

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

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cc:Requester (if third party requester)

DECISION GRANTING *EX PARTE* REEXAMINATION

A substantial new question of patentability affecting claim 21-48 of United States Patent Number 5,799,320 (hereafter "the '320 patent) is raised by the request for *ex parte* reexamination.

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(f).

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(f). The Patent Owner may consider using the following statement in a document waiving the right to file a Patent Owner Statement:

WAIVER OF RIGHT TO FILE PATENT OWNER STATEMENT

Patent Owner waives the right under 37 C.F.R. 1.530 to file a Patent Owner Statement.

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).

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.

Submissions

In order to insure full consideration of any amendments, affidavits or declarations or other documents as evidence of patentability, such documents must be submitted in response to the first Office action on the merits (which does not result in a close of prosecution). Submissions after the second Office action on the merits, which is intended to be a final action, will be governed by the requirements of 37 CFR 1.116, after final rejection and by 37 CFR 41.33 after appeal, which will be strictly enforced.

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 hereafter the '320 patent throughout the course of this reexamination proceeding. Likewise, if present, 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.

References cited in Request as allegedly raising a SNQ

Bartholomew et al., U.S. Pat. No. 4,939,509, issued July 3, 1990 (hereafter "**Bartholomew**");
Caro, U.S. Pat. No. 4,949,248, issued August 14, 1990 (hereafter "**Caro**");
Fujiwara, U.S. Pat. No. 4,999,836, issued March 12, 1991 (hereafter "**Fujiwara**");
Hui et al., U.S. Pat. No. 4,901,312, issued February 13, 1990 (hereafter "**Hui**");
Copeland, III, U.S. Pat. No. 4,862,167, issued August 29, 1989 (hereafter "**Copeland**");
Sarin, S., "Computer-based Real-Time Conferencing Systems"; A Book of Readings, published April 8, 1988, pp. 397-420 (hereafter "**Sarin**");

The '320 Patent

The '320 patent is generally directed to a computer file editing system for a plurality of users at different remote locations, comprising a host computer for coordinating the execution of file editing operations and for displaying the file editing

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operations to a plurality of personal computers so that a plurality of users are permitted to concurrently view a computer file and the users review and edit said given computer file on a substantially real-time basis (Claim 1, 30). The system further comprises voice communication means for transmitting audio signals representative of any user's voice to orally provide file editing instructions or discuss the given computer file (Claim 37 and 40).

Prosecution History

The '320 patent was issued on August 25, 1998 with 1-20 claims. During a previous *ex parte* reexamination Examiner rejected claims 1-4, 6, 9-10, 12-13, 17-18 and 20 as being anticipated by Sarin and also rejected the remaining dependent claims as being obvious over Sarin in view of Chamberlin and Whiting. In a response filed September 14, 2004 Patent Owner added more claims and argued the distinctions between "workstations" and PCs that existed in 1989 and submitted a Declaration of Gary J. Nutt. In a second office action mailed October 27, 2004, Examiner rejected all claims over Sarin in view of Hayden (US Pat. 4,953,159), Chamberlin and Whiting. After a request for reconsideration and supplemental responses Patent Owner argued, in a response of March 15, 2005, the combination of Sarin with the PCs of Hayden and submitted a second Declaration for support. A final rejection was mailed on July 7, 2005, Examiner rejected some claims under 112 stating that the specification did not have support for the newly added limitations "single user application program" and indicated claims 1, 3-4, 6, 8, 10-11, 13-42 as being allowable. After a Patent Owner response followed by an advisory action from the Examiner, the final office action of

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July 7, 2005 was withdrawn (see Interview Summary of 12/30/05). The Examiner rejected all the pending claims and after the response from the patent owner, a final rejection was mailed on August 29, 2007 rejecting claims 41 and 42 under 112 for failing to disclose "BIOS" in the specification and also rejecting some claims under 35 USC 305. In said final rejection the Examiner indicated claims 138-157 and 170-177 as being allowable over the prior art. A Notice of Intent to Issue a Reexam Certificate was mailed on January 23, 2009 wherein non-allowable claims were cancelled and claims 138-157 and 170-177 (renumbered as claims 41-48) were indicated to be allowable for the following reasons:

"Sarin discloses several embodiments of a file-sharing and editing system for multiple users of workstations. Sarin suggests access and manipulation of online information both remote and face-to-face (418/23-33) and discloses display means (410/32-35) with a multiple window display screen as well as means for utilizing a host computer (410/5- 8,413/2-10) and displaying changes on computers in the system.

The three embodiments include the virtual terminal embodiment, shown in FIG 15.3 below, wherein the user computers do not have access to application objects but rather an image (essentially a bitmap image) of such:

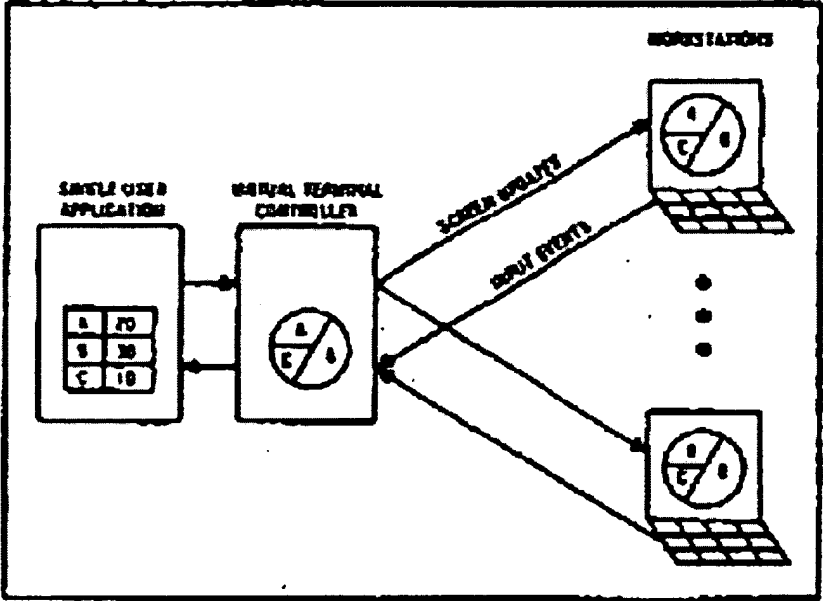


FIG 15.3(a), Virtual Terminal embodiment

As well as a central controller embodiment, wherein a host computer is able to operate a multiuser application between the user workstations...

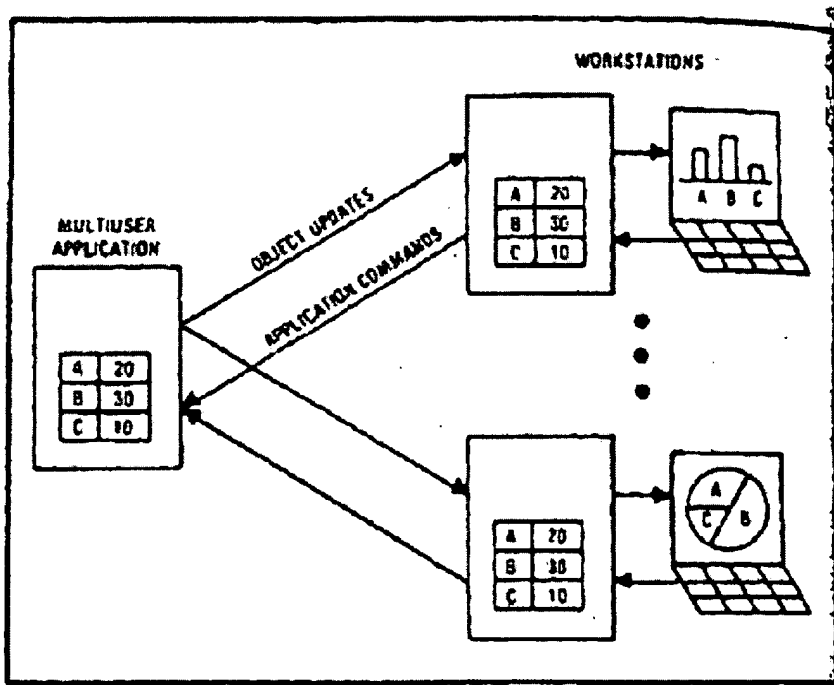


FIG 15.3(b), Central Controller embodiment

As well as an ability to connect merely a network of workstations using multicast transmissions, as described in pp. 415-417.

Sarin discloses workstations rather than PCs as required by the claims, and Patent Owner has provided various expert declarations showing that one of ordinary skill in the art would have foreseen the inability of certain applications of Sarin (such as the virtual terminal embodiment) host applications from running on a PC vs a Sun-class workstation or minicomputer. The Patent Owner also notes that the previous rejection from the Office essentially combined aspects of all three embodiments of Sarin, although the embodiments are indeed different.

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Thus, it appears from the record that the claims were allowed because the file editing operations are executed by one of the PCs using a single-user application program and also for the use of PCs to access the application program instead of "workstations".

Proposed Substantial New Question (SNQ)

The substantial new question of patentability (SNQ) is based on the following proposals:

- A. Claims 21, 22, 25, 28, 29-32, 34, 36, 37, 40, 43, 45, 46 and 48 are anticipated by Bartholomew. Request pp. 7-9; Exhibit A, pp. 30.
- B. Claims 21, 30, 43, 45, 46 and 48 are anticipated by Caro. Request pp. 10-13; Exhibit B, pp. 49.
- C. Claims 23, 24, 26, 33, 38 and 44 are obvious over Bartholomew in view of Fujiwara. Request pp. 13-15; Exhibit C, pp. 61.
- D. Claims 27 and 39 are obvious over Bartholomew in view of Copeland. Request pp. 15-16; Exhibit D, pp. 64.
- E. Claims 35 and 47 are obvious over Bartholomew in view of Sarin. Request pp. 16-17; Exhibit E, pp. 67.
- F. Claim 35 is obvious over Bartholomew in view of Hui. Request pp. 18-19; Exhibit F, pp. 70.
- G. Claims 23, 24, 26, 33, 38, 41, and 42 are obvious over Bartholomew in view of Admitted Prior Art (APA). Request pp. 19-20; Exhibit G, pp. 72.
- H. Claims 22, 25, 28, 29, 31, 32, 34 and 36 are obvious over Caro in view of Bartholomew. Request pp. 21-22; Exhibit H, pp. 76.
- I. Claims 23, 24, 26, 33, 38, and 44 are obvious over Caro in view of Sarin and further in view of Fujiwara. Request pp. 22-23; Exhibit I, pp. 98.
- J. Claims 27 and 39 are obvious over Caro in view of Bartholomew and further in view of Copeland. Request pp. 24; Exhibit J, pp. 101.

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- K. Claims 35 and 47 are obvious over Caro in view of Sarin. Request pp. 25-26; Exhibit K, pp. 104.
- L. Claim 35 is obvious over Caro in view Hui. Request pp. 27-28; Exhibit L, pp. 120.
- M. Claims 23, 24, 26, 33, 38, 41 and 42 are obvious over Caro in view of APA. Request pp. 28-29; Exhibit M, pp. 121.

The examiner agrees a SNQ is raised as to claims 41-48 of the '320 patent. A discussion of the specifics now follows:

Analysis of the Prior Art Provided in the Request

Proposals A and C-G:

It is agreed that the consideration of Bartholomew raises a SNQ as to Claims 21, 22, 25, 28, 29-32, 34, 36, 37, 40, 43, 45, 46 and 48 when considered alone (proposal A) and also raises a SNQ as to claims 23-24, 26-27, 33, 35, 38-39, 41-42, 44, and 47 when combined (Proposals C-G) with Fujiwara, Copeland, Sarin, Hui, or Admitted Prior Art (APA).

As pointed out in the request on pages 7-9 and 13-20, Bartholomew discloses a technique for connecting and controlling two or more personal computers to allow an application on one of the personal computers to be shared with users of the other personal computers (Fig. 1; Fig. 5; Col. 7, lines 20-19; Col. 9, lines 46-51).

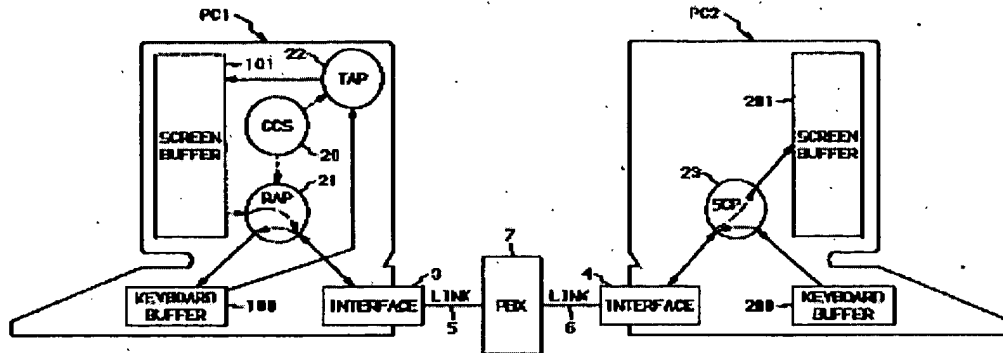


FIG. 1

Bartholomew discloses that keyboard input on both PCs 1 and 2 is entered as keyboard input of PC1 to TAP 22, while display output of TAP 22 generated in PC 1 is displayed on the screens of both PCs 1 and 2. Thus a conference by users of both PCs 1 and 2 with TAP 22 is established in real-time.

Bartholomew further discloses that the file editing operations are executed by one of said plurality of personal computers using a single user application program (Col. 3, lines 30-32, i.e., program 22 may be any program, for example, an application program such as a spread sheet or an editor).

The teaching of editing operations executed by one of a plurality of personal computers using a single user application program and the use of PCs by other users to access the application program was not present in the prosecution of the application which became the '320 Patent. Further, there is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not these claims are patentable.

Accordingly, Bartholomew raises a substantial new question of patentability as to Claims 21-48, which question has not been decided in a previous examination of the '320 Patent.

The teachings of Bartholomew either alone or as combined with other references in these Proposals are not cumulative to any written discussion on the record of the teachings of the prior art, were not previously considered nor addressed during a prior examination, and the same question was not the subject of a final holding of invalidity in the Federal Courts.

Proposals B and H-M:

It is agreed that the consideration of Caro raises a SNQ as to Claims 21, 30, 43, 45, 46 and 48 when considered alone (proposal B) and also raises a SNQ as to claims 22-29, 31-42, 44 and 47 when combined (Proposals H-M) with Bartholomew, Sarin, Fujiwara, Copeland, Hui, or Admitted Prior Art (APA).

As pointed out in the request on pages 10-13 and 21-29, Caro discloses a system of "IBM compatible" personal computers 301,302, 303 that are interconnected and controlled to allow an arbitrary application on one of the personal computers, i.e., computer 301, to be shared by the users of the other personal computers 302, 303. The personal computers 301,302, 303 in Caro are interconnected via a local area network (LAN) 300 (Fig. 3; Col. 4, lines 53-59; Col. 5, line 67 to Col. 8, line 2 and Col. 8, lines 8-9).

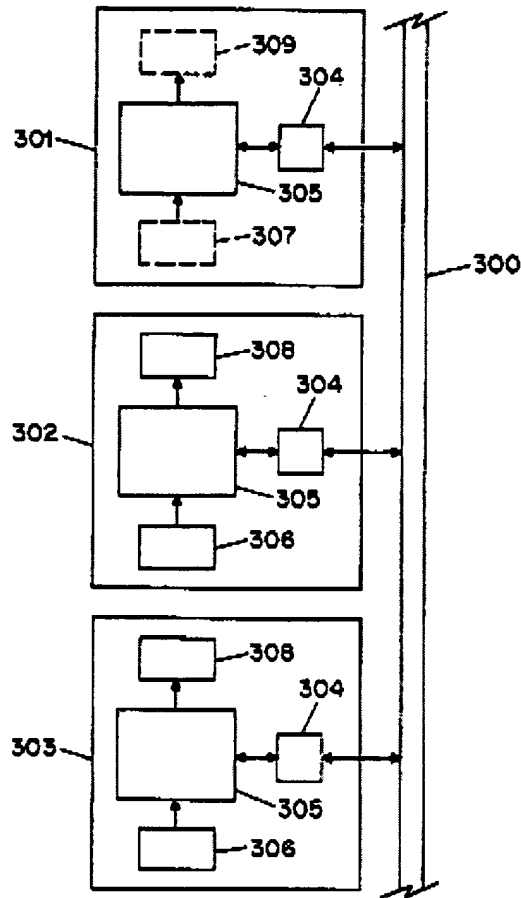


FIG. 3

Caro discloses that "From the point of view of the operator of the client computer, it is as if the applications program executing in the server were executing in the CPU 305 of the client computer. Keystrokes entered at the keyboard of the client give rise to the appropriate changes in the screen presentation on the display of the client, with little, if any perceptible delay. The applications program of the server is thus controlled by the operator of the client computer. (Col. 12, lines 8-16.)

Caro further discloses that the file editing operations are executed by one of said plurality of personal computers using a single user application program (Col. 7, line 67 to Col. 8, line 7, i.e., the "arbitrary program" corresponds to the single user application

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program). Caro discloses that "the applications program need not be modified to function in the server computer 301. The applications program in the server processes keystrokes entered from the keyboard of the client, just as it would process keystrokes entered from its own keyboard. The application program also provides screen presentations to the display of the client, just as it would provide screen presentations to its own display. Thus, the system of the exemplary embodiment provides transparent shared access and control of the applications program executing in the server." (Col. 12, lines 43-53).

The teaching of editing operations executed by one of a plurality of personal computers using a single user application program and the use of PCs by other users to access the application program was not present in the prosecution of the application which became the '320 Patent. Further, there is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not these claims are patentable.

Accordingly, Caro raises a substantial new question of patentability as to Claims 21-48, which question has not been decided in a previous examination of the '320 Patent.

The teachings of Caro either alone or as combined with other references in these Proposals are not cumulative to any written discussion on the record of the teachings of the prior art, were not previously considered nor addressed during a prior examination, and the same question was not the subject of a final holding of invalidity in the Federal Courts.

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Claims 21-48 will be reexamined as requested in the request.

Correspondence

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

By EFS: registered users may submit via the electronic filing system EFS-Web, at <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>.

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Alexandria, VA 22314

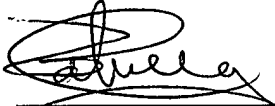
For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with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



Zoila E. Cabrera
Primary Examiner
Central Reexamination Unit 3992
(571) 272-3738

Conferees:

