EXHIBIT E

Order Granting / Denying Request For Ex Parte Reexamination	Control No.	Patent Under Reexamination	
	90/010,889	5958006	
	Examiner	Art Unit	
	ANDREW L. NALVEN	3992	

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

The request for *ex parte* reexamination filed *15 April 2010* 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: *Decision on Request*

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)).

cc:Requester (if third party requester)

DECISION GRANTING EX PARTE REEXAMINATION

A substantial new question of patentability affecting claims 1, 12, and 24-27 of United States Patent Number 5,958,006 (hereafter "the '006 patent") is raised by the request for *ex parte* reexamination submitted on April 15, 2010.

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).

Notification of Concurrent Proceedings

The patent owner is reminded of the continuing responsibility under 37 CFR 1.985 to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving the '006 patent throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP § 2686 and 2686.04.

PROSECUTION HISTORY

The '006 patent was issued on September 28, 1999 from an application filed December 19, 1995. The '006 patent is a continuation-in-part of application number 08/557,657 filed November 13, 1995.

During the prosecution of the '006 patent, the Examiner initially rejected all claims as being obvious over Boaz. In response to the rejection, Applicant amended the claims. Following the amendment, the Examiner rejected all claims as being obvious over Boaz in view of Amram. Applicant then amended claims 1, 9 (now 12), 22 (now 24), and 24 (now 26). In addition to the amendments, Applicant submitted remarks arguing that the cited prior art did not teach or suggest "the communication of any such identifying information parts to the communication unit for data units that have not passed the filter parameters" (*'006 patent, Response to Office Action of February 3, 1998*). A notice of allowance was then issued without additional comment by the Examiner. Accordingly, the record suggests that claims 1, 12, 24, and 26 of the '006 patent were issued because the cited prior art failed to teach or suggest the communication of any such identifying information parts to the communication unit for data units that have not passed the filter parameters.

A first Request for Reexamination was filed on September 16, 2008 seeking reexamination of claims 24-27. On May 15, 2009 claims 24-27 were rejected as unpatentable over US Patent No. 5,742,905 to Pepe et al, claims 24-25 were further rejected as unpatentable over Chang's "A Knowledge-Based Message Management System," and claims 26-27 were further rejected as unpatentable over Kaashock's "Dynamic Documents: Extensibility and Adaptability in the WWW."

Patent Owner responded by amending and disclaiming filtering at any location other than at the host. A Notice of Intent to Issue a Reexamination Certificate ("NIRC") was mailed on October 26, 2009. The NIRC stated the reasons for patentability and/or confirmation as follows:

Regarding claims 24 and 25, the cited prior art fails to teach or suggest "a communications server adapted for communicating with a host server and a communication unit including a processor, the communications server comprising a data transfer manager coupled with a user parameter store and adapted to control communication of data units between the communication unit and the host server including receiving individually filtered data units from the host server based on at least one user-definable filter parameter to identify whether a data unit is a qualifying or non-qualifying data unit, in combination with the remaining elements or features of the claimed invention." *NIRC, Pages 2-3.*

Regarding claims 26 and 27, the cited prior art fails to teach or suggest "a controller of a communication unit adapted for requesting data from a wireless communication channel from a further data processing host via a communications server comprising a summary store to store identifying information received from the host via the communications server about data units not sent from the host to the communication unit and not received at the communication unit, wherein said data units are individually filtered, prior to reception at the communication unit, based upon user definable filter parameters, in combination with the remaining elements or features of the claimed invention." *NIRC, Page 3.*

PROPOSED SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY

Third Party Requester ("Requester") requested reexamination of claims 1, 12, and 24-27 of the '006 patent based upon the following prior art patents and publications:

1. Hoshi et al., "A Mobile Pen-Based Computing System for Cellular Telephone Networks," IEEE (1993), Pub. No. 0-7803-0917-0/93 ("Hoshi");

2. Smith et al., "Trials of Wireless, Secure Electronic Mail," IEEE Personal Communications (August 1995), Pub. No. 1070-9916/95 ("Smith");

3. U.S. Patent No. 5,377,354 to Scannell et al., filed June 8, 1993 ("Scannell");

4. U.S. Patent No. 5,513,126 to Harkins et al., filed Oct. 4, 1993 ("Harkins");

5. Shi-Kuo Chang and L. Leung, "A Knowledge-Based Message Management System," ACM Transactions on Office Information Systems, Vol. 5, No. 3, July 1987, pp. 213-236 ("Chang");

6. M. Frans Kaashoek et al, "Dynamic Documents: Extensibility and Adaptability in the WWW," MIT Laboratory for Computer Science, September 15, 1994 ("Kaashoek").

Requestor has alleged a substantial new question of patentability in light of the proposed rejections:

Issue 1 - Claims 26 and 27 are anticipated by Hoshi under 35 U.S.C. §102(b).

Issue 2 - Claims 26 and 27 are rendered obvious by the combination of Hoshi in view of Chang under 35 U.S.C. 103(a).

Issue 3 - Claims 26 and 27 are anticipated by Smith under 35 U.S.C. §102(a).

Issue 4 - Claims 26 and 27 are rendered obvious by the combination of Smith in view of Chang under 35 U.S.C. 103(a).

Issue 5 - Claims 1, 12, and 24-25 are rendered obvious by the combination of Harkins in view of Scannell under 35 U.S.C. 103(a).

Issue 6 - Claims 1, 12, and 24-25 are rendered obvious by the combination of Harkins in view of Chang under 35 U.S.C. 103(a).

Issue 7 - Claims 26-27 are rendered obvious by the combination of Kaashoek in view of Scannell under 35 U.S.C. 103(a).

ANALYSIS OF SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY

Summary

Requestor has shown a substantial new question of patentability with regards to claims 1, 12, and 24-27 (all requested claims).

Analysis

A substantial new question of patentability 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. A substantial new question of patentability is not raised by prior art presented in a reexamination request if the Office has previously considered (in an earlier examination of the patent) the same question of patentability as to a patent claim favorable to 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).

The instant request for reexamination is the second request for reexamination on the '006 patent. Accordingly, MPEP provisions on second or subsequent requests for ex parte reexamination apply. MPEP § 2240 states:

> "If a second or subsequent request for ex parte reexamination is filed (by any party) while a first ex parte reexamination is pending, the presence of a substantial new question of patentability depends on the prior art (patents and printed publications) cited by the second or subsequent requester. If the requester includes in the second or subsequent request prior art which raised a substantial new question in the pending reexamination, reexamination should be ordered only if the prior art cited raises a substantial new question of patentability which is different from that raised in the pending reexamination proceeding. If the prior art cited raises the same substantial new question of patentability as that raised in the pending reexamination proceedings, the second or subsequent request should be denied."

Hoshi Reference

Hoshi raises a substantial new question of patentability regarding claims 26 and 27 as presented in Issues 1 and 2. Hoshi raises a substantial new question by providing new and non-cumulative teachings that a reasonable examiner would consider important in determining patentability of the claims.

During the first reexamination of the '006 patent, it was indicated that claim 26 was patentable because the cited prior art did not teach or suggest the distinguishing feature of "a summary store to store identifying information received from the host via the communications server about data units not sent from the host to the communication unit and not received at the communication unit, wherein said data units are individually filtered, prior to reception at the communication unit, based upon user definable filter parameters." The amended subject matter which prompted the confirmation of patentability was the inclusion of the limitation requiring that "said data units are individually filtered, prior to reception at the communication unit, based upon user definable filter parameters."

Hoshi raises a substantial new question by providing teachings that are relevant to the distinguishing feature of claim 26. For example, Hoshi discloses a mobile station that receives an email list that identifies each email that is received where the email list is constructed and filtered according to a rule customized by the user (*Hoshi, Page 382)*. This email list is stored at the mobile station and acts as a summary of the emails received. The mobile station can then request the full text of the email associated with a particular email identifier at the request of the user (*Hoshi, pages 381-382*). Further, Hoshi's filtering and constructing of the email list is performed by a mobile station server and is transmitted to the mobile station by way of a mobile station gateway (*Hoshi, page 381; Figure 1)*.

These teachings would be important to a reasonable examiner in deciding patentability because the reexamination history suggests that these features were the reason for allowance of the claims. Thus, there is a substantial likelihood that a reasonable examiner would consider Hoshi important in deciding whether or not the claims are patentable. Accordingly, Hoshi raises

a substantial new question of patentability as to claims 26 and 27 that has not been decided in a previous examination.

Smith Reference

Smith raises a substantial new question of patentability regarding claims 26 and 27 as presented in Issues 3 and 4. Smith raises a substantial new question by providing new and non-cumulative teachings that a reasonable examiner would consider important in determining patentability of the claims.

During the first reexamination of the '006 patent, it was indicated that claim 26 was patentable because the cited prior art did not teach or suggest the distinguishing feature of "a summary store to store identifying information received from the host via the communications server about data units not sent from the host to the communication unit and not received at the communication unit, wherein said data units are individually filtered, prior to reception at the communication unit, based upon user definable filter parameters." The amended subject matter which prompted the confirmation of patentability was the inclusion of the limitation requiring that "said data units are individually filtered, prior to reception at the communication unit, based upon user definable filter parameters."

Smith raises a substantial new question by providing teachings that are relevant to the distinguishing feature of claim 26. For example, Smith discloses a remote computer that downloads emails and lists of emails from a LAN Post Office by way of a mail server (*Smith, Figure 1; Page 30 – messages...would still reside at the LAN Post Office to be downloaded later*). A user of the remote computer can set up a filter that would determine which emails

would automatically be downloaded from the LAN Post Office to the remote computer (*Smith, Page 30)*. Smith teaches the use of a summary store that displays identifying information of the emails received from the host that details information about emails not received by teaching a list of emails including identifying information such as title, author, and length where a user may select the email to download it (*Smith, Page 30)*. Most importantly and most relevant to the distinguishing feature, Smith teaches that the filtering occurs at the LAN Post Office (host device) (*Smith, Figure 1; Page 30*).

These teachings would be important to a reasonable examiner in deciding patentability because the reexamination history suggests that these features were the reason for allowance of the claims. Thus, there is a substantial likelihood that a reasonable examiner would consider Smith important in deciding whether or not the claims are patentable. Accordingly, Smith raises a substantial new question of patentability as to claims 26 and 27 that has not been decided in a previous examination.

Harkins Reference

Harkins raises a substantial new question of patentability regarding claims 24 and 25 as presented in Issues 5 and 6. Harkins raises a substantial new question by providing new and non-cumulative teachings that a reasonable examiner would consider important in determining patentability of the claims.

During the first reexamination of the '006 patent, it was indicated that claim 24 was patentable because the cited prior art did not teach or suggest the distinguishing feature of "a data transfer manager coupled with a user parameter store and adapted to control communication of

data units between the communication unit and the host server including receiving individually filtered data units from the host server based on at least one user-definable filter parameter to identify whether a data unit is a qualifying or non-qualifying data unit."

Harkins raises a substantial new question by providing teachings that are relevant to the distinguishing feature of claims 24 and 25. For example, Harkins suggests receiving individually filtered data units from the host server based on at least one user-definable filter parameter to identify whether a data unit is a qualifying or non-qualifying data unit by teaching a device server and Communication Channel Admin Server applying filtering parameters before passing the data to the communication unit (*Harkins, column 12 lines 6-11; column 7 lines 52-54; column 8 lines 20-30*).

These teachings would be important to a reasonable examiner in deciding patentability because the reexamination history suggests that these features were the reason for allowance of the claims. Thus, there is a substantial likelihood that a reasonable examiner would consider Harkins important in deciding whether or not the claims are patentable. Accordingly, Harkins raises a substantial new question of patentability as to claims 24-25 that has not been decided in a previous examination.

Harkins does not independently raise a substantial new question of patentability for claims 1, 12 as presented in issues 5 and 6 because Harkins does not disclose the distinguishing features of those claims. Accordingly, Harkins would not be important to a reasonable examiner in determining the patentability of the claims.

Claims 1 and 12 were not previously the subject of reexamination. During the prosecution of the '006 patent, it was found that the distinguishing feature of claims 1 and 12 was the limitation requiring the communication of identifying information parts to the communication unit for data units that have not passed the filter parameters. The Request does not rely on Harkins to teach this feature. Instead, the Request relies on Scannell and Chang. Accordingly, the Request does not establish that Harkins teaches the distinguishing feature of claims 1 and 12.

Scannell Reference

Scannell raises a substantial new question of patentability regarding claims 1, 12, and 24-27 as presented in Issues 5 and 7. Scannell raises a substantial new question by providing new and non-cumulative teachings that a reasonable examiner would consider important in determining patentability of the claims.

Claims 1 and 12 were not previously the subject of reexamination. During the prosecution of the '006 patent, it was indicated that claims 1 and 12 were patentable because the cited prior art did not teach or suggest the distinguishing feature of communication of any such identifying information parts to the communication unit for data units that have not passed the filter parameters.

Further, during the first reexamination of the '006 patent, it was indicated that claim 24 was patentable because the cited prior art did not teach or suggest the distinguishing feature of "a data transfer manager coupled with a user parameter store and adapted to control communication of data units between the communication unit and the host server including receiving

individually filtered data units from the host server based on at least one user-definable filter parameter to identify whether a data unit is a qualifying or non-qualifying data unit."

Further, during the first reexamination of the '006 patent, it was indicated that claim 26 was patentable because the cited prior art did not teach or suggest the distinguishing feature of "a summary store to store identifying information received from the host via the communications server about data units not sent from the host to the communication unit and not received at the communication unit, wherein said data units are individually filtered, prior to reception at the communication unit, based upon user definable filter parameters." The amended subject matter which prompted the confirmation of patentability was the inclusion of the limitation requiring that "said data units are individually filtered, prior to reception at the communication unit, based upon user definable filter parameters."

Scannell raises a substantial new question by providing teachings that are relevant to the distinguishing feature of claims 1, 12 and 24. For example, Scannell discloses a system for prioritizing a plurality of incoming email messages for a user according to a user defined set of rules (*Scannell, Abstract*). Scannell teaches a determination as to whether a message is qualifying or non-qualifying in view of the user defined rules (*Scannell, Abstract)*. Most importantly, Scannell suggests the communication of identifying information to the communication unit for data units that have not passed the filter parameters by discussing the teachings of Chang whereby a short alert message is sent instead of the full text depending on filter rules (*Scannell, column 1 lines 44-56*). Thus, Scannell suggests that when a message is filtered, identifying information may be sent to the user identifying the filtered message, but without sending the full message.

These teachings would be important to a reasonable examiner in deciding patentability because the reexamination history suggests that these features were the reason for allowance of the claims. Thus, there is a substantial likelihood that a reasonable examiner would consider Scannell important in deciding whether or not the claims are patentable. Accordingly, Scannell raises a substantial new question of patentability as to claims 1, 12, and 24-25 that has not been decided in a previous examination.

However, Scannell does not raise a substantial new question for claims 26-27 because Scannell does not teach the distinguishing feature of "said data units are individually filtered, prior to reception at the communication unit, based upon user definable filter parameters." Scannell does not specifically teach a host computer performing the scanning. At most, Scannell teaches the functions being performed by a work station that could be implemented as a host computer shared by a number of users. Scannell's disclosure is not clear as to whether the host computer would filter messages for a work station or whether multiple users merely use the same work station. In addition, the claims set forth that the host server is the server who performs the filtering and forwards the data to a communication server who forwards the data to a communication unit. Scannell does not teach a host server in such a configuration.

Chang and Kaashoek References

As noted above, Hoshi, Scannell, Harkins, and Smith independently raise a substantial new question sufficient to grant reexamination of claims 1, 12, and 24-27. Thus, Issues 1-7 raise a substantial new question in light of the discussion above.

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.

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

Any inquiry concerning this communication or earlier communications from the Examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

Signed:

/Andrew Nalven/

Andrew Nalven
CRU Examiner
GAU 3992
(571) 272-3839

Conferee: EJK

Conferee: FDB