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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,408	08/13/2010	7440565	51783-2 (565)	6029

52450   7590   10/21/2010

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ESCALANTE, OVIDIO

ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
10/21/2010	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.

PTOL-90A (Rev. 04/07)

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OCT 2 1 2010

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NUMBER *95/001,408*.

PATENT NUMBER *7,440,565*.

TECHNOLOGY CENTER *3900*.

ART UNIT *3992*.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it <u>cannot</u> be extended. See also 37 CFR 1.947.

If an *ex parte* reexamination has been merged with the *inter partes* reexamination, no responsive submission by any *ex parte* third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

ORDER GRANTING/DENYING REQUEST FOR INTER PARTES REEXAMINATION	Control No.	Patent Under Reexamination	
	95/001,408	7440565	
	Examiner	Art Unit	
	OVIDIO ESCALANTE	3992	

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

The request for *inter partes* reexamination has been considered. Identification of the claims, the references relied on, and the rationale supporting the determination are attached.

Attachment(s): ☒ PTO-892 ☐ PTO/SB/08 ☒ Other: <u>Decision</u>

1. ☒ The request for *inter partes* reexamination is GRANTED.

  ☒ An Office action is attached with this order.

  ☐ An Office action will follow in due course.

2. ☐ The request for *inter partes* reexamination is DENIED.

This decision is not appealable. 35 U.S.C. 312(c). Requester may seek review of a denial by petition to the Director of the USPTO within ONE MONTH from the mailing date hereof. 37 CFR 1.927. EXTENSIONS OF TIME ONLY UNDER 37 CFR 1.183. In due course, a refund under 37 CFR 1.26(c) will be made to requester.

All correspondence relating to this *inter partes* reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Order.

DECISION GRANTING *INTER PARTES* REEXAMINATION

1.   A substantial new question of patentability affecting claims 1-18 of United States Patent

Number 7,440,565 is raised by the request for *inter partes* reexamination.

References Cited in the Request

2.   The Request identifies the following printed publications as providing teachings relevant

to the claims of the '565 patent.

1.   Singh et al., CINEMA: Columbia InterNet Extensible Multimedia Architecture, *Columbia University Technical Report CUCS-011-02,* New York, NY, May 2002 ("**CINEMA**")

2.   **Ram** et al. U.S. Patent 6,625,258

3.   Jonathan Michael Lennox, *Services for Internet Telephony,* PhD Thesis Columbia University, 2004 ("**Lennox**")

4.   **Hakusui** U.S. Patent 7,248,577

5.   Hariri et al. U.S. Patent 7,379,543, (hereinafter **Hariri '543**)

6.   Hariri U.S. Patent 7,092,498, (hereinafter **Hariri '498**)

7.   Archer et al. U.S. Patent 6,683,870

8.   H. Schulzrinne et al., The Session Initiation Protocol: Providing Advanced Telephony Services Across the Intent, Bell Labs Technical Journal Oct.-Dec. 1998 ("**Schulzrinne**")

9.   Schulzrinne U.S. Patent 7,610,384, (hereinafter **Schulzrinne '384**)

10.   **Leung** U.S. Patent 6,005,870

11.   AT&T's Personal Reach™ Service: Features and Benefits ("**Personal Reach**")

12.   **Homan** U.S. Patent 6,233,317

13.   **Singh** U.S. Patent 7,257,201

14.   **Wood** et al. U.S. Patent Publication 2002/0111990

15.   **Burg** et al. U.S. Patent 6,587,458

16.   Hanson et al. U.S. Patent Application No. 2005/0069097 (hereinafter **Hanson '097**)

17.   Hanson et al. U.S. Patent Application No. 2005/0074109 (hereinafter **Hanson '109**)

Issues Raised in the Request

3.   Requester asserts that the cited references raise SNQs in the following manner:

Issue 1   CINEMA is asserted as rendering claims 1, 3-8, 11, 14-16 and 18 anticipated.

CINEMA in view of Homan is asserted as rendering claim 1 obvious.

CINEMA in view of Schulzrinne '384 is asserted as rendering claims 1, 5-8, 11, 12, 14, 15, 17 and 18 obvious.

CINEMA in view of Wood is asserted as rendering claims 1, 6, 8, 11, 12, 14, 15 and 17 obvious.

CINEMA in view of SINGH is asserted as rendering claims 1, 3, 4 and 8 obvious.

CINEMA in view Burg, Hanson '097 and Hanson '109 is asserted as rendering claims 1, 3-8, 11, 14 and 15 obvious.

CINEMA in view of Archer is asserted as rendering claims 3 and 4 obvious.

CINEMA in view of Schulzrinne is asserted as rendering claim 3 obvious.

CINEMA in view of Hakusui is asserted as rendering claims 4, 7, 11 and 12 obvious.

CINEMA in view of HTML 4.01 Specification is asserted as rendering claims 4, 11, 14, 15, 17 and 18 obvious.

CINEMA is asserted as rendering claims 12 and 17 obvious.

CINEMA in view of Burg is asserted as rendering claims 12 and 17 obvious.

Issue 2   Ram is asserted as rendering claim 1-11, 14, 15 and 16 anticipated

Ram in view of Singh is asserted as rendering claim 2 obvious.

Ram in view of Burg and further in view of Hanson '097 and Hanson '109 is asserted as rendering claim 2 obvious.

Ram in view of Hakusui is asserted as rendering claims 9 and 10 obvious.

Ram is asserted as rendering claims 12 and 17 obvious.

Ram in view of Schulzrinne '384 is asserted as rendering claim 16 obvious.

Ram in view of Wood is asserted as rendering claim 16 obvious.

Ram in view of HTML 4.01 Specification is asserted as rendering claim 16 obvious.

Issue 3   Lennox is asserted as rendering claim 1-8, 11, 14, 15 and 16 anticipated.

Lennox in view of Singh is asserted as rendering claim 2 obvious.

Lennox in view of Burg, Hanson '097 and Hanson '109 is asserted as rendering claim 2 obvious.

Issue 4   Hariri is asserted as rendering claims 1, 3-6, 8, 11 and 13-16 anticipated.

Hariri is asserted as rendering claims 12 and 13 obvious.

Hariri in view of Singh is asserted as rendering claim 13 obvious.

Hariri in view of Singh and further in view of CINEMA is asserted as rendering claim 13 obvious.

Hariri in view of Singh and further in view of Ram is asserted as rendering claim 13 obvious.

Hariri in view of Singh and further in view of Lennox is asserted as rendering claim 13 obvious.

Hariri in view of Singh and further in view of Burg, Hanson '097 and Hanson '109 is asserted as rendering claim 13 obvious.

Issue 5   Hakusui is asserted as rendering claims 14, 15 and 16 anticipated.

Hakusui is asserted as rendering claim 17 obvious.

Issue 6   Archer is asserted as rendering claims 14, 15 and 16 anticipated.

Issue 7   Schulzrinne is asserted as rendering claims 14 and 15 anticipated.

Prosecution History

As set forth in the Notice of Allowance during the prosecution of the application which became the 565 patent, the Examiner stated "[r]egarding claims 1 and 9, in combination with other limitations of the claims, the prior art of record fails to disclose or specifically suggested a voicemail email application configured to automatically generate an email notification that is sent to a designated email account indicating receipt of a voicemail message." In addition, it was noted "[r]egarding claim 15, in combination with other limitations of the claims, the "prior art of record fails to disclose or specifically suggested a web browser based control panel allowing a user to correlate a plurality of contact numbers to a primary contact number."[1]

Substantial New Question of Patentability Statement

As noted on page 6 of the Request, the cited references disclose the use of voicemail email applications and web browser control panels in a one numbers system. The Request notes that these features were indicated as being the allowable subject matter in the '565 Patent claims. The Examiner will address each of the primary references as it is presented by the Request.

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[1] The Examiner notes that claim 9 and 15 during prosecution were renumbered as claims 8 and 14 respectively.

ISSUE 1 - CINEMA

As per claims 1 and 8:

As set forth in the request, CINEMA discloses a voicemail email application configured to automatically generate an email notification sent to the user's designated email account indicating receipt or attachment of a voicemail message. In addition CINEMA discloses that a web browser based control panel allowing a user to correlate a plurality of contact numbers to a primary contact number, as well as to update or modify such contact numbers.

The Request states CINEMA discloses a voicemail email application that is configured to automatically generate an email notification, which is sent to a designated email account and indicates receipt of a voicemail message, (page 38).

CINEMA's preferred embodiment uses "uses SIP for signaling and RTSP for storage and retrieval of voice messages as described in [38]. <u>The user gets an email notification when a new message arrives.</u> The user messages are also listed on a web page as shown in Fig. 20, where they can be played by just a mouse-click. Alternatively, an RTSP client such as Apple's QuickTime can be used to play back the message. Using streaming media to deliver voicemail avoids having to download the whole message while traveling, for example."

As per claim 14:

The Request asserts CINEMA discloses a web browser based control panel that permits a user to correlate a plurality of contact numbers to a primary contact number, (pages 5-6, 11, 16, 20-22, 38, and 64).

The Examiner notes that for example, on page 6, CINEMA discloses that Alice has a contact number of "alice@office.com". It is further disclosed that an additional contact number is

correlated to this contact number. In this case "alice@school.edu". In addition it is noted that

here desk phone and other contact number are correlated with here main number, (page 7).

The teaching of "a voicemail email application configured to automatically generate an

email notification that is sent to a designated email account indicating receipt of a voicemail

message" and "a web browser based control panel allowing a user to correlate a plurality of

contact numbers to a primary contact number" was not considered or discussed on the record

during the prosecution of the application which became the '565 patent. **Therefore, it is agreed**

that CINEMA raises a SNQ over at least claims 1, 3-8, 11, 14-16, 17 and 18 of the instant

'656 Patent.

Several other SNQs were raised as noted in the Request. These SNQs all rely upon

CINEMA and thus they raise a SNQ for at least the reasons noted above with respect to

CINEMA.

ISSUE 2 - RAM

As per claims 1 and 8:

As set forth in the Request, RAM discloses the VAS sends an email notification if a

voicemail message is received by Ram's system. The email notification can be sent, at the user's

option, to a designated email account. For example: "If subscriber A is unavailable, or elects not

to receive the call, the VAS 102 routes the call to a voice mail service of the message services

106 so that the caller may leave a message. <u>If a message is left, the VAS 102 may then send a</u>

notification to subscriber A in the form of a page, email message, or other notification

communication. However, alternatively, no notification is provided"(col. 5, lines 35-43).

As per claim 14:

The Request notes Ram's Virtual Assistant System (VAS) includes one or more

information pages that provide the ability to edit and manage a user's personal information.

These information pages can include a web browser based control panel that allows a user to

correlate the user's various contact numbers with a primary number.

For example:

> "In a particular example of operation of the VAS, the subscriber establishes/alters his or
> her personal information. The personal information includes the name of the subscriber,
> the home address of the subscriber, the home phone number of the subscriber, the
> subscriber's VAS personal number, the subscriber's work phone number, the subscriber's
> mobile phone number, the subscriber's pager number, the subscriber's email address and
> the subscriber's personal IP address. The subscriber may alter any of this information
> from a personal information page provided by the VAS,"

(col. 14, lines 40-50).

In addition, Ram discloses a set of profile services 108 that uniquely identify each

subscriber and provide contact information for that subscriber. The profile services include a

lookup application configured to query Ram's database to retrieve a plurality of contact numbers

as a function of a user's primary contact number and in response to a session invite sent by a

caller.

For example:

> "A user's profile includes personal information for a corresponding subscriber, such
> personal information including the subscriber's name, the subscriber's address, and all
> pertinent contact information for the subscriber, e.g., home phone number(s), work phone

> number(s), mobile phone number(s), email address(es), IP address(es), pager number(s)
> and other information that may be employed to contact the subscriber. The profile also
> includes a plurality of reach lists for the subscriber, each reach list including a set of
> contact numbers/addresses for the subscriber. Corresponding to each reach list is a
> schedule that indicates when the reach list is active. All communications for the
> subscriber are received via a single telephone number, IP address (network address)
> and/or email address. Based upon the content of the reach lists and corresponding
> schedules, the VAS routes communications and messages to the subscriber and
> also notifies the subscriber of incoming communications."

Col. 4, line 50- col. 5, line 15.

The teaching of "a voicemail email application configured to automatically generate an

email notification that is sent to a designated email account indicating receipt of a voicemail

message" and "a web browser based control panel allowing a user to correlate a plurality of

contact numbers to a primary contact number" was not considered or discussed on the record

during the prosecution of the application which became the '565 patent. **Therefore, it is agreed**

that RAM raises a SNQ over at least claims 1-12 and 14-17 of the instant '565 Patent.

Several other SNQs were raised as noted in the Request. These SNQs all rely upon Ram

and thus they raise a SNQ for at least the reasons noted above with respect to Ram.

ISSUE 3 - LENNOX

As per claim 1,

As set forth in the Request, Lennox discloses a voicemail email application that alerts a

user that an incoming call that has been sent to voicemail and redirects the user to a voicemail

server to record a voicemail message, (pages 49-50) ("Forward to e-mail: When a call arrives at a

server, the CGI script looks up the callee in a database and obtains their e-mail address. The

script then sends e-mail to the user, containing the caller, time of call, and call subject. The caller

is redirected to a voicemail server to record a message.").

As per claim 14

The Request notes that Lennox states, *inter alia*, that its system may access a Uniform

Resource Locator (URL) that provides that information. As is known in the art, URL's are

addresses of web-pages. The web browser based control panel allowing a user to correlate a

plurality of contact numbers to a primary contact number.

For example:

"Signaling servers also normally maintain information about user location. Whether by
means of registrations (SIP REGISTER or H.323 RAS messages), static configuration, or
dynamic searches, signaling servers must have some means by which they can determine
what destinations are currently associated with a user, in order to make intelligent choices
about their proxying or redirection behavior. Signaling servers are usually general-
purpose, Internet-located computers. As such, telephony services can take advantage of
all the functionality that such devices are capable of, for example to store information for
later retrieval, or to initiate or participate in other Internet-based activities."

(pages 10-11).

"CPL also must interoperate with existing location mechanisms. This is the primary
motivation for the location set model. Early on, an approach was considered in which
locations were explicit arguments to the proxy and redirect nodes. However, it was not at
all clear how to associate this model with SIP's REGISTER method, through which a
user's end points announce their locations to a signaling server. Thus, instead, the implicit
location set was created, which allows REGISTERed locations to be added using the
lookup node."

page 86, 1st full Paragraph.

"Location Lookup: Locations can also be looked up through external means, through the
use of location lookups. The node, described by the tag lookup, specifies a source for the
list of locations. Two types of sources are defined. The registration source indicates that

the Destination's list of registered locations should be added to the location set. Alternately, a list of locations can be specified by a URL, indicating an external source to query for locations. This node also has an optional attribute, timeout, which specifies the time the script is willing to wait for the lookup to be performed. Lookup has three outputs: success, notfound, and failure. Notfound is taken if the lookup process succeeded but did not find any locations; failure is taken if the lookup failed for some reason, including that specified timeout was exceeded. Location Removal: A CPL script can also explicitly remove locations from the location set. The remove- location tag performs this action, and takes one tag arguments, location, specifying the location to remove."

page 71, 1st Two Paragraphs.

The teaching of "a voicemail email application configured to automatically generate an email notification that is sent to a designated email account indicating receipt of a voicemail message" and "a web browser based control panel allowing a user to correlate a plurality of contact numbers to a primary contact number" was not considered or discussed on the record during the prosecution of the application which became the '565 patent. **Therefore, it is agreed that Lennox raises a SNQ over at least claims 1-8, 11 and 14-16 of the instant '565 Patent.**

In addition, several other SNQs were raised. These SNQs relied upon Lennox as the primary reference and raises an SNQ for at least the reasons noted above.

ISSUE 4 - HARIRI

As per claims 1 and 8:

As set forth in the Request, Hariri discloses a voicemail email application configured to automatically generate an email notification that is sent to a designated email account indicating receipt of a voicemail message -specifically, an application which provides for the caller to

record a voicemail message and then sends that voicemail message by email to the user or to a

message box on the user's server, (col. 8, lines 39-59; Fig. 6C).

As per claim 14:

Hariri discloses *inter alia,* a universal point of contact system that associates a plurality

of contact numbers with a primary contact number assigned to a user, (col. 2, lines 22-55, col. 3,

lines 54-65 & Figs. 2, 4, and 7).

The teaching of "a voicemail email application configured to automatically generate an

email notification that is sent to a designated email account indicating receipt of a voicemail

message" and "a web browser based control panel allowing a user to correlate a plurality of

contact numbers to a primary contact number" was not considered or discussed on the record

during the prosecution of the application which became the '565 patent. **Therefore, it is agreed**

that Hariri raises a SNQ over at least claims 1, 3-6, 8 and 11-16 of the instant '565 Patent.

In addition, several other SNQs were raised. These SNQs relied upon Hariri as the

primary reference and raises an SNQ for at least the reasons noted above.

ISSUE 5 - Hakusui

As per claim 14:

The Request notes Hakusui's web-browser control panel permits "a user to designate

a plurality of contact numbers correlated to a primary contact number assigned to said user." In

Hakusui's Figure 3, a primary contact number is correlated to multiple extension contact

numbers, see col. 5, lines 31-39; col. 7, lines 40-44 & Fig. 3.

The teaching of "a web browser based control panel allowing a user to correlate a

plurality of contact numbers to a primary contact number" was not considered or discussed on

the record during the prosecution of the application which became the '565 patent. **Therefore, it**

is agreed that Hakusui raises a SNQ over at least claims 14-17 of the instant '565 Patent.

In addition, several other SNQs were raised. These SNQs relied upon Hakusui as the

primary reference and raises an SNQ for at least the reasons noted above.

ISSUE 6 - Archer

As per claim 14,

As set forth in the Request, Archer teaches that its database contains a plurality of contact

numbers correlated to a primary contact number assigned to the user may be accessed by the user

at any time, including by logging on to the Internet, (col. 7, lines 44-50). Archer further teaches

that the user, using a computer to log on to the Internet (i.e., the "web"), can change or add

telephone numbers where he can be reached.

The teaching of "a web browser based control panel allowing a user to correlate a

plurality of contact numbers to a primary contact number" was not considered or discussed on

the record during the prosecution of the application which became the '565 patent. **Therefore, it**

is agreed that Archer raises a SNQ over at least claims 14-16 of the instant '565 Patent.

In addition, several other SNQs were raised. These SNQs relied upon Archer as the

primary reference and raises an SNQ for at least the reasons noted above.

ISSUE 7 - Schulzrinne

As per claim 14,

As set forth in the Request Schulzrinne discloses that SIP can be used very easily with

web browsers to support various services including the network services of personal mobility,

700 services, call screening, forwarding and transfer.

For example:

> "As a result, SIP would integrate extremely well with Web browsers, uniting the Web
> and telephony to produce new, powerful services." "Because its strength is in flexible
> user location and name mapping features, SIP provides a good framework for services
> such as personal mobility; 700, 800, and 900 services; call screening; forward and
> transfer; and multiparty calls. (Note that billing in general is outside the scope of SIP,
> including 700, 800, and 900 services.) Each of these is essentially based on programmed
> call routing and thus fits well within SIP." (pages 150-151).

Schulzrinne also discloses that SIP allows a plurality of contact numbers to be correlated

to a primary contact number for a user in a database. (page 151).

The teaching of "a web browser based control panel allowing a user to correlate a

plurality of contact numbers to a primary contact number" was not considered or discussed on

the record during the prosecution of the application which became the '565 patent. **Therefore, it**

is agreed that Schulzrinne raises a SNQ over at least claims 14-15 of the instant '565

Patent.

In addition, several other SNQs were raised. These SNQs relied upon Schulzrinne as the

primary reference and raises an SNQ for at least the reasons noted above.

Scope of Reexamination

4.   Claims 1-18 will be reexamined as requested in the request.

Conclusion

5.   Extensions of time under 37 CFR 1.136(a) will not be permitted in *inter partes*

reexamination proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant"

and not to the patent owner in a reexamination proceeding. Additionally, 35 U.S.C. 314(c)

requires that inter partes reexamination proceedings "will be conducted with special dispatch"

(37 CFR 1.937). Patent owner extensions of time in inter partes reexamination proceedings are

provided for in 37 CFR 1.956. Extensions of time are not available for third party requester

comments, because a comment period of 30 days from service of patent owner's response is set

by statute. 35 U.S.C. 314(b)(3).

6.   The Patent Owner is reminded of the continuing responsibility under 37 CFR 1.985(a) to

apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving the

US Patent 7,440,565 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 through the course of this reexamination proceeding. See MPEP § 2686 and

2686.04.

All correspondence relating to this *inter partes* 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 *Inter Partes* Reexam

               Attn: Central Reexamination Unit
               Commissioner for Patents
               United States Patent & Trademark Office
               P.O. Box 1450
               Alexandria, Virginia 22313-1450

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

By hand: Customer Service Window
               Attn: Central Reexamination Unit
               Randolph Building, Lobby Level
               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 data 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.

/Ovidio Escalante/
Ovidio Escalante
Primary Examiner
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Conferee: Conferee: