

EXHIBIT I



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,557	02/25/2011	7856474	18027-0012RX1	3461

42640 7590 10/14/2011
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EXAMINER

DESAI, RACHNA SINGH

ART UNIT	PAPER NUMBER
3992	

3992

MAIL DATE	DELIVERY MODE
10/14/2011	PAPER

10/14/2011

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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OCT 14 2011

CENTRAL REEXAMINATION UNIT

**Transmittal of Communication to Third Party Requester
Inter Partes Reexamination**

REEXAMINATION CONTROL NUMBER 95/001,557.

PATENT NUMBER 7,856,474.

TECHNOLOGY CENTER _____.

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 cannot 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.

ACTION CLOSING PROSECUTION (37 CFR 1.949)	Control No.	Patent Under Reexamination
	95/001,557	7856474
	Examiner	Art Unit
	RACHNA DESAI	3992

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

Responsive to the communication(s) filed by:

Patent Owner on 31 May, 2011
Third Party(ies) on 24 June, 2011

Patent owner may once file a submission under 37 CFR 1.951(a) within 1 month(s) from the mailing date of this Office action. Where a submission is filed, third party requester may file responsive comments under 37 CFR 1.951(b) within 30-days (not extendable- 35 U.S.C. § 314(b)(2)) from the date of service of the initial submission on the requester. **Appeal cannot be taken from this action.** Appeal can only be taken from a Right of Appeal Notice under 37 CFR 1.953.

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 Office action.

PART I. THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892
2. Information Disclosure Citation, PTO/SB/08
3. _____

PART II. SUMMARY OF ACTION:

- 1a. Claims 1-56 are subject to reexamination.
- 1b. Claims _____ are not subject to reexamination.
2. Claims _____ have been canceled.
3. Claims _____ are confirmed. [Unamended patent claims]
4. Claims _____ are patentable. [Amended or new claims]
5. Claims 1-56 are rejected.
6. Claims _____ are objected to.
7. The drawings filed on _____ are acceptable are not acceptable.
8. The drawing correction request filed on _____ is: approved. disapproved.
9. Acknowledgment is made of the claim for priority under 35 U.S.C. 119 (a)-(d). The certified copy has:
 been received. not been received. been filed in Application/Control No _____
10. Other _____

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Action Closing Prosecution

1. This action is on the claims for which a substantial new question of patentability has been requested and determined to exist; that is claims 1-56 of U.S. 7,856,474 B2 (hereafter the '474 patent).
2. This action responds to Patent Owner's submission filed on 05/31/2011 and the Third Party Requester's submission filed on 06/24/2011.

Information Disclosure Statement

3. MPEP 2656 states in pertinent part,

Where patents, publications, and other such items of information are submitted by a party (Patent Owner or Requester) in compliance with the requirements of the rules, the requisite degree of consideration to be given to such information will be normally limited by the degree to which the party filing the information citation has explained the content and relevance of the information. The initials of the examiner placed adjacent to the citations on the form PTO/SB/08A and 08B or its equivalent, without an indication to the contrary in the record, do not signify that the information has been considered by the examiner any further than to the extent noted above. (emphasis added)

In concert with MPEP 2656, the references submitted in the IDS have been considered only to the extent that the content and relevance of the references have been explained. Documents which fail to constitute patents or printed publications have been lined through on the Form PTO/SB/08a so as not to be published on the reexamination certificate, but have been considered by the examiner to the extent noted above.

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Claim Status

- (1) Claims active: 1-56
- (2) Claims amended: claim 20

The References

EP Application Publication No. EP 0,665,504 to Church, et al. (hereafter "Church").

US Patent No. 5,392,447 to Schlack, et al. (hereafter "Schlack").

US Patent No. 5,717,940 to Peairs (hereafter "Peairs").

US Patent No. 5,632,002 to Hashimoto et al. (hereafter "Hashimoto").

Claim Rejection Paragraphs

- 3. The following are quotations from the MPEP regarding the types of rejections to be utilized below:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Status of Grounds of Rejection

Issue 1:

Claims 1-3, 5, 7-18, 30-34, 36-44, 47-56 are rejected under 35 U.S.C. 103(a) as being obvious over Church in view of Schlack. **ADOPTION MAINTAINED (as previously modified).**

Claims 20-27 are rejected under 35 U.S.C. 103(a) as being obvious over Church in view of Schlack. This rejection is **ADOPTED with additional modification**. The modification is to provide additional citations with respect to amended claim limitations.

With respect to amended claim 20, Examiner incorporates the claim chart with respect to claim 20 on pages 13-14 of the Request filed 02/25/2011. Additionally, Examiner modifies the rejection in light of the claim amendment. Specifically the amended feature, "***by a comparison of at least a portion of the data from the reference document and scanning data*** based on the captured information, ***as corresponding to the document***" is taught by Church at column 2, line 53 to column 3, line 19 where Church discloses comparing a scanned sample of a document to information in a repository. Specifically, Church discloses *it was well known in the art that a text-based information may be searched for on the basis of a series of keywords related to particular information, the title of a specific piece of information...as well as a narrative or sample document related to the requested information. In the case of a search based upon a narrative or sample document, the particular search parameters may be arrived at by applying term weighting techniques to the text...In this particular information retrieval system, processor*

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104 is adapted to recognize machine printed or handwritten text characters within a received bitmap, reconstitute the full text of the scanned representation, and perform a search based upon term weighting techniques.

Issue 2:

Claims 4, 6, 19, 29, and 46 are rejected under 35 U.S.C. 103(a) as being obvious over Church in view of Schlack and further in view of Peairs. **ADOPTION MAINTAINED (as previously modified).**

Issue 3:

Claims 28, 35, and 45 are rejected under 35 U.S.C. 103(a) as being obvious over Church in view of Schlack and further in view of Hashimoto. **ADOPTION MAINTAINED (as previously modified).**

Discussion of Issues

“Identifying step”

Patent Owner Arguments:

4. On pages 16-19 of the Response filed on 05/31/2011, PO argues Church fails to teach the “identifying” step of claim 1. PO argues the preferred embodiment of the

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present invention was to automatically identify a reference document in a repository as the document scanned or otherwise captured by a user's handheld device and forwarding a copy of the identified document to the user. PO cites several section of the '474 patent and concludes that the prior art does not teach a system for identifying a document scanned or otherwise captured by a handheld device.

PO argues the method in Church is to retrieve related information responsive to a user query. PO states Church uses term weighting techniques to generate the search parameters from a sample document, for example, and utilizes the parameters in a search engine to retrieve information from the repository that is related to the query generated but that Church makes no suggestion that the responsive information is an identification of the source document comprising the query itself. Thus, PO argues it is impossible for Church to be showing or suggesting a system and method of "identifying" the document scanned or otherwise captured using the handheld device, when Church is devoid of any disclosure that the query document itself is ever identified.

PO argues Church's disclosure of information conforming to the search is retrieved from database 105 and transmitted in bitmap form from processor to fax machine makes no mention of identifying information as a reference document corresponding to the document data received from the handheld device. PO argues Church teaches a database information retrieval system is merely retrieving information conforming to search parameters generated from the query document and makes no attempt to identify the search query sample document.

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PO argues the information retrieved in the methodology of Church is based on search parameters relating to a term weighing analysis of the query text to generate information relevant to the query, but fails to identify a document corresponding to the document data. PO concludes by stating Church fails to disclose or render obvious a methodology for identifying...the reference documents corresponding to the document data received from the handheld device.

PO makes similar arguments with respect to independent claims 14, 20, 30, 40, 47 and dependent claims 2-13, 15-19, 21-29, 31-34, 41-46, and 48-56.

Third Party Requester's Comments

5. On pages 5-7 of the Response, the Requester argues Church does teach the "identifying" step.

Requester argues PO repeatedly argues that Church cannot be relied upon because Church fails to describe limitations that do not actually appear in the claims and which are not properly imported into the claims under the broadest reasonable construction standard. Specifically, PO argues the term "reference document" appears without qualification. Requester argues PO advocates "document" should be restricted despite the absences of limiting claim terms. For example, Requester argues the reference document does not need to be "captured by a handheld device". Further, PO argues claim 1 does not require identification of a source document and instead only requires identification of a reference document, with for which reference data is stored

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and compared. Requester argues none of the narrowing features are recited by the claim and it would be improper to construe the claim language in the manner promoted by the PO.

Requester further states that even if the PO incorporated such features, Church describes the same operations as the '474 patent. Specifically, Requester argues Church describes scanning data from a received document (Abstract), and otherwise identifying a document by using a title, a narrative, or a sample document (column 2, lines 50-55). Requester states Church notes it was well-known in the art that text-based information may be searched for on the basis of a series of keywords related to particular information, the title of a specific piece of information, the database address of a specific piece of information, as well as a narrative or sample document related to the requested information (col. 2, lines 55-60).

Requester argues these operations are identical to the operations described in the '474 patent which notes various types of information can be capture from the document and stored in the handheld device. Suitable information includes title of the document, author, publication name, and date of publication for the document. The captured information can include one or more of these types of information and/or other types of information (column 3, lines 50-55). Requester further argues the '474 Patent is replete with references to using a narrative or sample document such as in the abstract which notes that at least a portion of the received document data is extracted as scanning data.

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Examiner's Response:

6. The "identifying" step in claim 1 recites, *identifying, when the step of comparing the scanning data with the retrieved reference data indicates the scanning data matches at least a portion of the retrieved reference data, one or more reference documents associated with said matched reference data as the reference documents corresponding to the document data received from the handheld device.*

The term "reference document" in this limitation refers to reference documents *associated with said matched reference data*. In other words a reference document is any reference document that is associated with reference data. Column 3, lines 50-55 of the '474 patent states that *suitable information includes title of the document, author, publication name, and date of publication for the document. The captured information can include one or more of these types of information and/or other types of information* (column 3, lines 50-55).

Examiner agrees with the Requester that the claim does not require the reference document to be either "captured by a handheld device" or require identification of a source document. Examiner further agrees that the reference document only requires identification of a reference document, with for which reference data is stored and compared. Reference documents need only be "*associated with said matched reference data*". As information captured from the document and stored in the handheld device may include the title of the document, author, publication name, and date of publication for the document (as in column 3, lines 50-55 of the '474 patent), the

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identification of the reference document is any document that may be "associated with matched reference data". The matched reference data is data which matches the information captured from the document including the title of the document, author, publication name, and date of publication for the document.

Further, as pointed out by the Requester, even if the claim did require an identification of a source document or the document captured by a handheld device, Church discloses this feature. Church notes it was well-known in the art that text-based information may be searched for on the basis of a series of keywords related to particular information, the title of a specific piece of information, the database address of a specific piece of information, **as well as a narrative or sample document related to the requested information** (col. 2, lines 55-60). In other words, the reference document is searched for based on a sample or narrative document. Examiner also agrees with the Requester that the '474 Patent is replete with references to using a narrative or sample document such as in the abstract which notes that at least a portion of the received document data is extracted as scanning data.

Regarding PO's arguments that Church is related to retrieving related information responsive to a user query and does not identify the source document comprising the query itself, Examiner disagrees. Initially, Examiner agrees with Requester that a reference document does not need to be the source document comprising a query, but rather a reference document *associated* with matched reference data. A reference document can be associated with matched reference data without being the source document comprising the query. However, Examiner further agrees with the Requester

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that the Church reference discloses this feature. Specifically, Church discloses searching text-based information on the basis of a narrative or sample document related to the requested information. See column 2, lines 53-column 3, line 1. In the case of a search based upon a narrative or sample document, the particular search parameters may be arrived at by applying term weighting techniques to the text. The processor is adapted to recognize machine printed or handwritten text characters within a received bitmap, reconstitute the full text of the scanned representation, and perform a search based upon term weighting techniques. Processor performs a term weighting analysis upon the text reconstituted from the received bitmap to formulate appropriate search parameters, and then executes a search of the database based upon these parameters. Information conforming to the search is retrieved from the database and transmitted from processor to fax machine. The user is then provided with a hard copy of the retrieved information. See column 3, lines 1-42. See also column 1, lines 7-14 where Church discloses a query can include a narrative description describing the information to be retrieved. In response to the query, the information retrieval system returns to the user an electronic version of the information contained within the database that conforms to the query. In other words, when the database is queried with a sample or narrative document related to the requested information, the source document comprising the query itself can be retrieved. Thus, Examiner finds that Church is able to retrieve the source document when a narrative or sample document is used as the basis for the query.

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PO makes similar arguments with respect to independent claims 14, 20, 30, 40, 47 and dependent claims 2-13, 15-19, 21-29, 31-34, 41-46, and 48-56. The arguments above are also applicable to independent claims 14, 20, 30, 40, 47 and dependent claims 2-13, 15-19, 21-29, 31-34, 41-46, and 48-56.

Motivation to combine Schlack

Patent Owner's Response:

7. PO argues there is no motivation to combine Schlack with Church because they are in unrelated technologies. PO argues Church is directed to information retrieval technologies and Schlack is related to an electronic organizer. PO argues a skilled artisan would not receive motivation to combine the two as they are in different classification groups.

Third Party Requester's Comments:

8. The Requester argues the motivation to combine Church and Schlack is proper as one of ordinary skill would naturally consider Schlack's wireless scanner as inputs to the processor 104 and database 105 described in Church. The Requester argues the

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classification has no bearing on whether one of ordinary skill would view a wireless scanner in the context of system that processes scanned images.

Examiner's Response:

9. Examiner finds that Church and Schlack are properly combinable. Schlack teaches it was well known at the time of the invention to use a wireless interface to permit commands and data to be entered directly into and retrieved from the OS of a handheld device. Schlack further disclosed a handheld electronic organizer having a scanner. Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention to substitute Church's connection between a scanner and a server through a telephone network with Schlack's handheld scanner included within a handheld organizer and connected to a server via a wireless network with a reasonable expectation of success and the results would have been predictable. It was desirable to use wireless communication in lieu of hard wired connections at the time of the invention as it provided more flexibility and benefits than hard wired connections. Thus, Examiner agrees with the Requester that Schlack and Church are combinable.

Regarding PO's argument that the two are classified in different categories and thus are not combinable, Examiner disagrees that the references cannot be combined. Both Church and Schlack are related to transmitting information from a scanning device to a server. Church accomplishes this using a hard-wired connection while Schlack accomplishes this using a wireless connection. Thus, one of ordinary skill would have

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considered Schlack and Church to be concerned with similar subject matter in that both deal with transmitting information from a scanner to a server.

Conclusion

10. Accordingly, the rejection of claims 1-19 and 30-56 remain **ADOPTED** as previously modified. The rejection of claims 20-29 are **ADOPTED** with modification in light of the claim amendments to independent claim 20.

Conclusion

11. **This is an ACTION CLOSING PROSECUTION (ACP);** see MPEP § 2671.02.

(1) Pursuant to 37 CFR 1.951(a), the patent owner may once file written comments limited to the issues raised in the reexamination proceeding and/or present a proposed amendment to the claims which amendment will be subject to the criteria of 37 CFR 1.116 as to whether it shall be entered and considered. Such comments and/or proposed amendments must be filed within a time period of 30 days or one month (whichever is longer) from the mailing date of this action. Where the patent owner files such comments and/or a proposed amendment, the third party requester may once file comments under 37 CFR 1.951(b) responding to the patent owner's submission within 30 days from the date of service of the patent owner's submission on the third party requester.

(2) If the patent owner does not timely file comments and/or a proposed amendment pursuant to 37 CFR 1.951(a), then the third party requester is precluded from filing comments under 37 CFR 1.951(b).

(3) Appeal **cannot** be taken from this action, since it is not a final Office action.

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).

12. 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 Patent No. 7,856,474 B2 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.

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

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Any inquiry concerning this communication should be directed to Examiner Rachna Desai at telephone number 571-272-4099.

/Rachna S Desai/
Primary Examiner
Central Reexamination Unit – Art Unit 3992

Conferees:

K.P.

ATK