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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,657	12/24/2009	5828402	143201.90	2086

720 7590 03/02/2010

EXAMINER

OLIFF & BERRIDGE, PLC
P O BOX 320850
ALEXANDRIA, VA 22320-4850

ART UNIT PAPER NUMBER

DATE MAILED: 03/02/2010

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



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EXAMINER

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

Order Granting / Denying Request For Ex Parte Reexamination	Control No. 90/009,657	Patent Under Reexamination 5828402	
	Examiner JOSEPH R. POKRZYWA	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 24 December 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: PTO-1449

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)

DETAILED ACTION

Response to Request for *ex parte* Reexamination

1. Reexamination has been requested for claims 7-15 of United States Patent Number 5,828,402.
2. A substantial new question of patentability affecting claims 7-15 of U.S. Patent Number 5,828,402 (hereafter "the '402 Patent") is raised by the Third Party's request for *ex parte* reexamination.
3. The '402 Patent originally issued Oct. 27, 1998, with patented claims 1-15, filed as U.S. Application 08/761,091 on Dec. 5, 1996, being a continuation-in-part of U.S. Application 08/667,030, filed June 20, 1996, and also claiming foreign priority to the Canadian Patent Application 2,179,474, dated June 19, 1996.

Listing of Prior Art

4. In the request for reexamination, the Third Party Requester alleges that the '402 Patent's claims 7-15 are unpatentable in light of the following references:

- a. General Instrument, "System Information Description", ATSC T3/S8, May 17, 1995, pages 7, 15, 33-34, 50-52, 63-64, 74-76 (referred to as "GI");
- b. U.S. Patent Number 4,685,131, issued to Horne *et al.* (referred to as "Horne");
and
- c. Tim Collings, "Violence and Television: The Canadian Example", June 16-18, 1994, pages 4-5, 8, 9, and 10 (referred to as "VT").

5. Continuing, the aforementioned cited references of the GI reference, Horne, and the VT reference are not of record in the file of the '402 Patent and are not cumulative to the art of record in the original file.

Requester's Position

6. The request indicates that the Third Party Requester alleges that:

SNQ#1. Claims 7-15 to be anticipated by the GI reference; and

SNQ #2. Claims 7-15 to be unpatentable over the GI reference in view of Horne,
further in view of the VT reference.

Review of Prosecution History

7. First, the examiner notes that claims 7-15 were requested to be reexamined by the Third Party Requester, of which, only claim 7 is independent. With this, upon review of the prosecution history of U.S. Application 08/761,091, which matured into the '402 Patent, the examiner notes that the examiner at the time offered no explanation as to the features that were expressly deemed to be allowable for independent claim 7, at issue for this reexamination proceeding.

8. Particularly, upon inspection of the file, in an Office action dated 1/16/1998, claim 7 was rejected under 35 U.S.C. 112, second paragraph, whereby claim 7 included a couple of terms within the limitations that had no antecedent basis. However, claim 7 was not rejected based on any prior art, nor was the claim discussed with respect to any prior art, as there is no discussion as to any features deemed to be patentable. In the file, the only art rejection was of original claim 16, which was rejected as being unpatentable over the references of West *et al.* (U.S. Patent 5,550,575), Elam *et al.* (U.S. Patent 4,554,584), Vogel' 160 (U.S. Patent 4,930,160), and/or Lemelson (U.S. Patent 5,387,942), as well as being unpatentable over an obvious-type double patenting rejection. But in response to these rejections in the Office action dated 1/16/1998, claim 7 was amended to overcome the 35 U.S.C. 112 rejection and claim 16 was canceled. Subsequently, a Notice of Allowability was mailed on 5/18/1998, but did not contain any Reasons for Allowance.

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9. Thus, the examiner will look at the features that are included within claim 7 that were not present in original claim 16 in the file, which was rejected by prior art references. Claim 7 and original claim 16 are worded differently, but some of the features appear to be similar. However, claim 7 of the '402 Patent includes the limitations a) through d), which were not required in original claim 16, whereby these limitations of claim 7 of the '402 Patent state:

a) receiving first configuration information embedded in a first television channel, said first configuration information describing a first informational scheme, said first configuration information specifying, at least, numbers of levels in a first group of one or more multi-level categories of labels, in said first informational scheme;

b) storing said first configuration information in a memory;

c) receiving second configuration information embedded in a second television channel, said second configuration information describing a second informational scheme, said second configuration information specifying, at least, numbers of levels in a second group of one or more multi-level categories of labels, in said second informational scheme;

d) storing said second configuration information in a memory.

10. Therefore, because there was no explanation as to the features that were expressly deemed to be allowable for independent claim 7 in the original prosecution of the '402 Patent, these limitations are being viewed as the patentable features of claim 7 (and subsequently, dependent claims 8-15) of the original '402 Patent.

Substantial New Question of Patentability

11. First, the examiner notes that MPEP 2240 [R-5] states, in part:

37 CFR 1.515. Determination of the request for *ex parte* reexamination.

(a) Within three months following the filing date of a request for an *ex parte* reexamination, an examiner will consider the request and determine whether or not a substantial new question of patentability **affecting any claim of the patent** is raised by the request and the prior art cited therein, with or without consideration of other patents or printed publications. The examiner's determination will be based on the claims in effect at the time of the determination, will become a part of the official file of the patent, and will be mailed to the patent owner at the address as provided for in § 1.33(c) and to the person requesting reexamination. [Emphasis added.]

12. With respect to the Third Party Requester's proposed SNQ#1, it is agreed that the consideration the reference of GI raises a substantial new question of patentability as to claims 7-15 of the '402 Patent. Particularly, the reference of GI is seen as teaching of a method of selectively blocking video signals [see page 15, wherein "The user interface, which allows the user to set ceilings on each of the various dimensions, is table driven from the RTT..."; also see pages 50 and 75], comprising steps of:

a) receiving first configuration information embedded in a first television channel, said first configuration information describing a first informational scheme, said first configuration information specifying, at least, numbers of levels in a first group of one or more multi-level categories of labels, in said first informational scheme [see page 15, wherein "Program ratings for a given program are carried in the PROGRAM INFORMATION message. As many as six ratings dimensions are defined, each having a range up to fifteen levels. The number of dimensions for a given ratings region, as well as the name of the dimension, the number of levels

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defined in each dimension, and the textual name for each level are defined within the Ratings Text Table (RTT), delivered in the NETWORK TEXT message.”; also see pages 50, and Figure 5-7; also see page 71];

b) storing said first configuration information in a memory [see pages 15 and 50, wherein the Ratings Text Table and the Rating System Table appear to be inherently stored in the Decoders; further, as read on page 33, “The Decoder, upon reception of any of the segments may allocate RAM to build an image of the reassembled message, fill in the message header (the part that precedes the message body), and fill in one fraction (one Nth) of the message body.”];

c) receiving second configuration information embedded in a second television channel, said second configuration information describing a second informational scheme, said second configuration information specifying, at least, numbers of levels in a second group of one or more multi-level categories of labels, in said second informational scheme; d) storing said second configuration information in a memory [as noted above, the Decoders appear to allow various configuration data to be entered., for instance on page 15, “As many as six ratings dimensions are defined, each having a range up to fifteen levels.”].

13. As noted above, these features appear to be the claimed patentable subject matter of patented claim 7 in the original prosecution of the ‘402 Patent. Therefore, the GI reference is seen to raise a substantial new question of patentability as to independent claim 7. Continuing, the additional passages pointed out by the Third Party Requester in the Request dated 12/24/2009 on page 12, line 2 through page 19, line 22, as well as on page 28, line 3 through page 32, line 40, with respect to the reference of GI, are hereby incorporated by reference from the request for

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reexamination for their explanation of the teaching provided in the GI reference that was not present in the prosecution of the application which became the '402 Patent. There is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claims 7-15 were patentable. Accordingly, the GI reference raises a substantial new question of patentability as to claims 7-15, which question has not been decided in a previous examination of the '402 Patent.

14. Continuing, with respect to the Third Party Requester's proposed SNQ#2, as noted above, it is agreed that the consideration of the GI reference raises a substantial new question of patentability as to claims 7-15 of the '402 Patent. With this, for the same reasons discussed above with respect to the GI reference, the examiner agrees that the combination of GI in view of Home and the VT reference also raises a substantial new question of patentability as to claims 7-15 of the '402 Patent, which question has not been decided in a previous examination of the '402 Patent.

Waiver of Right to File Patent Owner Statement

15. 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.

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Extensions of Time

16. 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

17. 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

18. 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.

Conclusion

19. **Claims 7-15** of U.S. Patent Number 5,828,402 are subject to reexamination.

20. Since requester did not request reexamination of **claims 1-6**, and did not assert the existence of a substantial new question of patentability (SNQ) for such claims (see 35 U.S.C. § 302); see also 37 CFR 1.510b and 1.515), such claims will not be reexamined. This matter was squarely addressed in *Sony Computer Entertainment America Inc. et al. v. Jon W. Dudas*, Civil Action No. 1:05CV1447 (E.D.Va. May 22, 2006), Slip Copy, 2006 WL 1472462. The District Court upheld the Office's discretion to not reexamine claims in a reexamination proceeding other than those claims for which reexamination had specifically been requested. The Court stated:

“To be sure, a party may seek, and the PTO may grant, ...review of each and every claim of a patent. Moreover, while the PTO in its discretion may review claims for which ...review was not requested, nothing in the statute compels it to do so. To ensure that the

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PTO considers a claim for ...review, ... requires that the party seeking reexamination demonstrate why the PTO should reexamine each and every claim for which it seeks review. Here, it is undisputed that **Sony** did not seek review of every claim under the '213 and '333 patents. Accordingly, **Sony** cannot now claim that the PTO wrongly failed to reexamine claims for which **Sony** never requested review, and its argument that AIPA compels a contrary result is unpersuasive.”

21. 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 Patent No. 5,828,402 throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

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22. ALL correspondence relating to this ex parte reexamination proceeding should be directed as follows:

Please mail any communications to:

Attn: Mail Stop "Ex Parte Reexam"
Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

Please FAX any communications to:

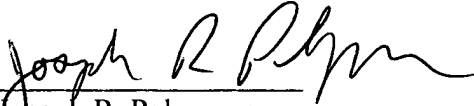
(571) 273-9900
Central Reexamination Unit

Please hand-deliver any communications to:

Customer Service Window
Attn: Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314


Any inquiry concerning this communication or earlier communications from the Reexamination 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.

Signed:



Joseph R. Pokrzywa
Primary Examiner
Central Reexamination Unit 3992
(571) 272-7410

Conferees: /Albert J Gagliardi/
Examiner, Art Unit 3992


OPQA