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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 03/05/2008

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



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MAR 05 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/008,972.

PATENT NO. 5,253,341

ART UNIT 3992.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

Order Granting / Denying Request For Ex Parte Reexamination	Control No. 90/008,972	Patent Under Reexamination 5,253,341	
	Examiner Majid Banakhah	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 21 December 2007 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

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

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

RESPONSE TIMES ARE SET AS FOLLOWS:

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

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

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

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

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

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

cc:Requester (if third party requester)

Art Unit: 3992

DECISION GRANTING EX PARTE REEXAMINATION

Substantial New Question of Patentability

1. A substantial new question of patentability affecting claim 17 of United States Patent Number 5,253,341 to Rozmanith is raised by the present request for *Ex Parte* reexamination.

Extension of Time

2. 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

3. 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. 5,253,341 throughout the course of this reexamination proceeding. Likewise, if present, the third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

Prior Art That Raises SNQ

4. In the request for reexamination, the third party requester alleges that '341 patent claims 17 is anticipated or rendered obvious in light of the following references:

- a) U.S. Patent No. 5,420,981 to Mark E. Ivie and John C. Schwebel, filed on December 10, 1992 as a continuation of U.S. Patent App. Ser. No. 07/414,871 (abandoned), which was filed on September 29, 1989 (Request, Exhibit C).
- b) Terry A. Welch, A Technique for High-Performance Data Compression, IEEE Computer, Vol. 17, No. 6, pages 8-19, June 1984 (Request, Exhibit D).

Art Unit: 3992

- c) H.C. Kotze and G. Kuhn, An Evaluation of the Lempel-Ziv-Welch Data Compression Algorithm, published in the Southern African Conference on Communications and Signal Processing, IEEE COMSIG 1989 Proceedings, pages 65-69, June 23, 1989 (Request, Exhibit E).
- d) Timothy C. Bell, Better OPM/L Text Compression, IEEE Transactions on Communications, Vol. 34, Issue 12, pages 1176-1182, December 1986, (Request, Exhibit F).
- e) Andrew Lippman and William Butera, Coding Image Sequences for Interactive Retrieval, Communications of the ACM, Volume 32, Issue 7, pp. 852-860, July 1989, (Request, Exhibit G).
- f) U.S. Patent No. 4,987,480 to Andrew B. Lippman and William J. Butera, which issued from an application filed on July 11, 1989 (Request, Exhibit H).
- g) Steve Rosenthal, JPEG Emerging as Standard for Compressing Image Files, MacWEEK Magazine, Vol. 4, No. 12, March 27, 1990 (Request, Exhibit I)
- h) U.S. Patent No. 5,113,496 to Karl W. McCalley, Steven D. Wilson and Victor J. Szeplaki, filed on March 8, 1989 as a division of U.S. Patent App. Ser. No. 07/271,086 (abandoned), which was filed on November 14, 1988 (Request, Exhibit J).
- i) Stephen Manes, The Road to Respect; Digital Video Interactive, PC Computing, Vol. 2, No. 3, pages 107-115, March 1989 (Request, Exhibit K).
- j) Michael Tinker, DVI Parallel Image Compression, Communications of the ACM, Vol. 32, Issue 7, pages 844-851, July 1989 (Request, Exhibit L).
- k) Charles Bowen and David Peyton, Getting the Most Out of CompuServe, Chapters 1 and 19, ages 1-6, 391-420, 4th ed. 1989, (Request, Exhibit M).
- l) U.S. Patent No. 4,506,387 to Howard F. Walter, filed on May 25, 1993 and issuing on March 19, 1985 (Request, Exhibit N).
- m) U.S. Patent No. 5,014,125 to Terrence H. Pocock, Rick McNorgan, Peter Coumons and Allan Lodberg and issuing from an application filed on May 5, 1989 (Request, Exhibit O).

Of the above references, except for U.S. Patent No. 4,506,387 to Walter and U.S. Patent No. 5,014,125 to Pocock, the other references were not of record in the prosecution history of the Rozmanith '341 patent and are not cumulative to the art of record. However, Walter and Pocock were previously considered and cited against claim 17 by the Examiner in the prior reexamination of the '341 patent.

Art Unit: 3992

Requester's Position

5. The request indicates that the third party requester considers:
- a) Claim 17 of the Rozmanith patent to be unpatentable over Ivie '981;
 - b) Claim 17 of the Rozmanith patent to be unpatentable over McCalley '496;
 - c) Claim 17 of the Rozmanith patent to be unpatentable over Charles brown & David Peyton, Getting the Most Out of CompuServe (4th ed. 1989), Chapter 19, pages 391-42;
 - d) Claim 17 of the Rozmanith patent to be unpatentable over Ivie '981 taken with Lippman '480;
 - e) Claim 17 of the Rozmanith patent to be unpatentable over Ivie '981 taken with Andrew Lippman and William Butera, Coding Image Sequences for Interactive Retrieval, Communications of the ACM, Volume 32, Issue 7, July 1989;
 - f) Claim 17 of the Rozmanith patent to be unpatentable over Ivie '981 taken with LZ77 and LZSS compression techniques disclosed in Timothy C. Bell;
 - g) Claim 17 of the Rozmanith patent to be unpatentable over Ivie '981 taken with the compression used by the Joint Photographic Experts Group (JPEG) for image compression as described in Steve Rosenthal, JPEG Emerging as Standard for Compressing Image Files, MacWEEK Magazine, Vol. 4, Issue 12, March 27, 1990;
 - h) Claim 17 of the Rozmanith patent to be unpatentable over Walter '387 taken with Lippman '480;
 - i) Claim 17 of the Rozmanith patent to be unpatentable over Walter '387 taken with Andrew Lippman and William Butera, Coding Image Sequences for Interactive Retrieval, Communications of the ACM, Volume 32, Issue 7, July 1989;
 - j) Claim 17 of the Rozmanith patent to be unpatentable over Walter '387 taken with Digital Video Interactive (DVI) disclosed in Stephen Manes, The Road to Respect; Digital Video Interactive, PC Computing, Vol. 2, No. 3, pages 107-115 (March 1989) and Michael Tinker, DVI Parallel Image Compression, Communications of the ACM, Vol. 32, Issue 7, pages 844- 851, July 1989;
 - k) Claim 17 of the Rozmanith patent to be unpatentable over Walter '387 taken with the compression used by the Joint Photographic Experts Group (JPEG) for image compression as described in Steve Rosenthal, JPEG Emerging as Standard for Compressing Image Files, published in MacWEEK Magazine, Vol. 4, Issue 12, March 27, 1990;
 - l) Claim 17 of the Rozmanith patent to be unpatentable over Walter '387 taken with view of the LZ77 and LZSS compression techniques disclosed in Timothy C.

Art Unit: 3992

- Bell, Better OPM/L Text Compression, IEEE Transactions on Communications, Vol. 34, Issue 12, pp. 1176-1182, December 1986;
- m) Claim 17 of the Rozmanith patent to be unpatentable over Walter '387 taken with the LZW compression technique disclosed in Terry A. Welch, A Technique for High-Performance Data Compression, IEEE Computer, Vol. 17, No. 6, pages 8-19 (June 1984) and H.C. Kotze and G. Kuhn, An Evaluation of the Lempel-Ziv-Welch Data Compression Algorithm, Southern African Conference on Communications and Signal Processing, IEEE COMSIG 1989 Proceedings, pages 65-69, June 23, 1989;
- n) Claim 17 of the Rozmanith patent to be unpatentable over Pocock '125 taken with Lippman '480;
- o) Claim 17 of the Rozmanith patent to be unpatentable over Pocock '125 taken with Andrew Lippman and William Butera, Coding Image Sequences for Interactive Retrieval, Communications of the ACM, Volume 32, Issue 7, July 1989;
- p) Claim 17 of the Rozmanith patent to be unpatentable over Pocock '125 taken with Digital Video Interactive (DVI) disclosed in Stephen Manes, The Road to Respect; Digital Video Interactive, PC Computing, Vol. 2, No. 3, pages 107-115 (March 1989) and Michael Tinker, DVI Parallel Image Compression, Communications of the ACM, Vol. 32, Issue 7, pages 844- 851, July 1989;
- q) Claim 17 of the Rozmanith patent to be unpatentable over Pocock '125 taken with the compression used by the Joint Photographic Experts Group (JPEG) for image compression as described in Steve Rosenthal, JPEG Emerging as Standard for Compressing Image Files, published in MacWEEK Magazine, Vol. 4, Issue 12, March 27, 1990;
- r) Claim 17 of the Rozmanith patent to be unpatentable over Pocock '125 taken with view of the LZ77 and LZSS compression techniques disclosed in Timothy C. Bell, Better OPM/L Text Compression, IEEE Transactions on Communications, Vol. 34, Issue 12, pp. 1176-1182, December 1986;
- s) Claim 17 of the Rozmanith patent to be unpatentable over Pocock '125 taken with the LZW compression technique disclosed in Terry A. Welch, A Technique for High-Performance Data Compression, IEEE Computer, Vol. 17, No. 6, pages 8-19 (June 1984) and H.C. Kotze and G. Kuhn, An Evaluation of the Lempel-Ziv-Welch Data Compression Algorithm, Southern African Conference on Communications and Signal Processing, IEEE COMSIG 1989 Proceedings, pages 65-69, June 23, 1989.

A Brief Prosecution History of the Rozmanith Patent

6. United States Patent Number 5,253,341 issued from an application with serial number 07/683,972 ("the '972 Application"). Said '341 application was a continuation-in-part (CIP) of an earlier application filed on Mar. 4, 1991, now abandoned.

During the original prosecution of the '341 patent, on September 8, 1992, an Office Action was issued, provisionally rejecting the claims on double-patenting grounds because similar claims were being pursued in the earlier pending application. No claims were rejected on basis of any prior art. Six month later, the applicants responded by informing the Examiner that the earlier application had been abandoned, rendering the double-patenting objection moot. No amendments were made to any claim, and a Notice of Allowability was issued to all 16 claims and the '341 patent was issued on October 12, 1993.

On June 9, 2000, a request for Ex Parte Reexamination was filed as to all 16 claims of the '341 patent. The request, filed on behalf of an anonymous real party in interest, cited a single prior art reference that was not considered during the original prosecution. Two months later, the PTO granted a reexamination as to all claims. After the first Office Action of February 23, 2001, in which the Examiner rejected all claims of the '341 patent in light of several references, including the one identified by the requester, the patent owner, in the response of filed April 23, 2001, canceled 12 of the originally issued 16 claims (1-8, 12-13, and 15-16) and rewrote the remaining 4 (claims 9-11, and 14), and proposed 76 new claims (claims 17-92), bringing the total number of claims to 92 (including 12 cancelled claims). After the Interview of May 22, 2001, the patent owner, in the supplemental response of June 12, 2001, in response to the February 23, 2001 Office Action and May 22, 2001 Interview in Reexamination, cancelled all the newly-added claims (17-92) and proposed twelve new claims (93-104).

Claim 101 of the patent owner's new claims was the only claim proposed by the patent owner that was confirmed, issuing as claim 17. In that claim, the patent owner introduced the concept of "asymmetric" compression and decompression techniques. Claim 101, which is the only confirmed claim after the first reexamination of '341 patent is provided as follows:

Art Unit: 3992

101. A method for downloading responsive data from a remote server comprising the steps:

(a) identifying a query via a data input means and inputting said query to remote query and data retrieval means;

(b) transmitting said query from said remote query and data retrieval means to a remote host via an input/output means;

(c) receiving a compressed or non-compressed response to said query at said remote query and data retrieval system from said remote host via said input/output means;

(d) displaying a presentation corresponding to said query response on output means;

(e) wherein said response is compressed prior to receipt at said remote server, and wherein said compressed response is decompressed at said remote query and data retrieval means using an asymmetric decompression technique corresponding to an inverse operation" of the technique used to compress said response

(underline added)

The proposed claim 101 is identical to claim 1 of the originally-issued patent but with the additional limitation (e) (shown *above* in underlining).

The Examiner, on November 6, 2001, issued an office Action rejecting all pending claims, which rejected claim 101 under 35 USC § 112 (1). The patent owner, in the response after the November 6, 2001 Office Action and amendment after final rejection pursuant to 37 C.F.R. § 1.116(b) (January 22, 2002), made minor amendments to claim 101 in an attempt to address the 112 issues raised by the Examiner. The Examiner subsequently rejected claim 101 again for substantially the same reasons as before, but added a rejection under 35 U.S.C. §102 in light of U.S. Patent Nos. 4,506,387 (Walter) and 5,014,125 (Pocock). The examiner identified where Walter and Pocock disclosed each limitation of claim 101 except the final limitation relating to asymmetric compression. The examiner did not cite any prior art relating to that limitation.

Following the examiner's final rejection, the patent owner filed a Notice of Appeal to the Board of Patent Appeals and Interferences ("BPAI"). On December 26, 2006, the BPAI issued its decision affirming the examiner's rejection of all pending claims except claim 101. With respect to claim 101, the BPAI agreed that the Walter and Pocock references cited by the

Art Unit: 3992

examiner disclosed limitations (a) through (d) of claim 101, but disagreed that they disclosed the final limitation relating to "asymmetric decompression." The BPAI found that neither Walter nor Pocock disclosed the "asymmetric decompression" limitation and that the Examiner had not shown that the feature was inherently disclosed or necessarily present in Walter or Pocock.

Substantial New Question vel non

7. A prior art patent or printed publication raises a substantial new question of patentability where there is:

- (A) 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, MPEP §2242 (I) and,
- (B) the same question of patentability as to the claim has not been decided in a previous or pending proceeding or in a final holding of invalidity by a federal court. See MPEP §2242 (III).

8. The substantial new questions of patentability with respect to Walter and Pocock for claim 17 is based solely on patents and/or printed publications already cited/considered in an earlier concluded reexamination of the patent being reexamined. On November 2, 2002, Public Law 107-273 was enacted. Title III, Subtitle A, Section 13105, part (a) of the Act revised the reexamination statute by adding the following new last sentence to 35 U.S.C. 303(a) and 312(a):

The existence of a substantial new question of patentability is not precluded by the fact that a patent or printed publication was previously cited by or to the Office or considered by the Office.

For any reexamination ordered on or after November 2, 2002, the effective date of the statutory revision, reliance on previously cited/considered art, i.e., "old art," does not necessarily preclude the existence of a substantial new question of patentability (SNQ) that is based exclusively on that old art. Rather, determinations on whether a SNQ exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis.

Art Unit: 3992

In the present instance, there exists a SNQ based on Walter and Pocock taken with other references. Walter and Pocock were applied and are now being looked at in a new light. In the prior reexamination of claim 17 (claim 101 before it was renumbered), the examiner argued that the use of asymmetric decompression technique corresponding to an inverse operation of the technique used to compress is inherent (Final rejection of April 15, 2003, Page 251, last Para. bridging through page 252, and page 253 1st Para.). Here in the present reexamination however, claim 17 is rejected based on the combination of Walter and/or Pocock and other references, showing that the asymmetric decompression technique is not taught by Walter and/or Pocock, rather by other references used in the 35 USC 103 rejection of claim 17. The reset of the references in section 4, *supra*, were not considered and were not used in rejection of claim 17 by the Office. A discussion of the specifics now follows:

RE: Ivie et al.

9. In the request for reexamination, the third party requester alleges Ivie '981 anticipates claim 17, of the '341 patent.

It is **agreed** that the consideration of Ivie '981 alone raises a substantial new question of patentability as to claim 17 of the '341 patent. Request page 17, through page 23, end of the claim chart for claim 17, are hereby incorporated by reference from the request for reexamination for their explanation of the teaching provided in Ivie '981 that was not present in the prosecution of the application which became the '341 patent. Further, there is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claim 17 is patentable. Accordingly, Ivie '981 raises a substantial new question of patentability as to claim 17, which question has not been decided in a previous examination of the '341 patent.

RE: MacCalley '496

10. In the request for reexamination, the third party requester alleges MacCalley '496 anticipates claim 17, of the '341 patent.

Art Unit: 3992

It is **agreed** that the consideration of MaCalley '496 alone raises a substantial new question of patentability as to claim 17 of the '341 patent. Request page 31, through page 39, end of the claim chart for claim 17, are hereby incorporated by reference from the request for reexamination for their explanation of the teaching provided in MaCalley '496 that was not present in the prosecution of the application which became the '341 patent. Further, there is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claim 17 is patentable. Accordingly, MaCalley '496 raises a substantial new question of patentability as to claim 17, which question has not been decided in a previous examination of the '341 patent.

RE: CompuServe (Bowen et al.)

11. In the request for reexamination, the third party requester alleges CompuServe (Bowen et al.) anticipates claim 17, of the '341 patent.

It is **agreed** that the consideration of CompuServe (Bowen et al.) alone raises a substantial new question of patentability as to claim 17 of the '341 patent. Request page 41, through page 43, end of the claim chart for claim 17, are hereby incorporated by reference from the request for reexamination for their explanation of the teaching provided in CompuServe (Bowen et al.) that was not present in the prosecution of the application which became the '341 patent. Further, there is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claim 17 is patentable. Accordingly, CompuServe (Bowen et al.) raises a substantial new question of patentability as to claim 17, which question has not been decided in a previous examination of the '341 patent.

RE: Ivie '981 Taken With Lippman '480

12. In the request for reexamination, the third party requester alleges Ivie '981 taken with Lippman '480, renders claim 17 of the '341 patent obvious.

Art Unit: 3992

It is **agreed** that the consideration of Ivie '981 taken with Lippman '480 raises a substantial new question of patentability as to claim 17 of the '341 patent. Request page 17, through page 23, end of the claim chart for claim 17, for the teaching of Ivie '981 and pages 27, section III.B.1, paragraph ending before the section III.B.2, are hereby incorporated by reference from the request for reexamination for their explanation of the teaching provided in Ivie '981 and Lippman '480 that was not present in the prosecution of the application which became the '341 patent. Further, there is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claim 17 is patentable. Accordingly, Ivie '981 taken with Lippman '480 raises a substantial new question of patentability as to claim 17, which question has not been decided in a previous examination of the '341 patent.

RE: Ivie '981 Taken With Andrew Lippman and William Butera

13. In the request for reexamination, the third party requester alleges Ivie '981 taken with Lippman '480, renders claim 17 of the '341 patent obvious.

It is **agreed** that the consideration of Ivie '981 taken with Andrew Lippman and William Butera raises a substantial new question of patentability as to claim 17 of the '341 patent. Request page 17, through page 23, end of the claim chart for claim 17, for the teaching of Ivie '981 and pages 27, section III.B.1, last paragraph, continued through page 28, for the teaching of asymmetric compression and decompression techniques, are hereby incorporated by reference from the request for reexamination for their explanation of the teaching provided in Ivie '981 and Andrew Lippman and William Butera that was not present in the prosecution of the application which became the '341 patent. Further, there is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claim 17 is patentable. Accordingly, Ivie '981 taken with Andrew Lippman and William Butera raises a substantial new question of patentability as to claim 17, which question has not been decided in a previous examination of the '341 patent.

Art Unit: 3992

RE: Ivie '981 Taken With Compression Techniques of Timothy C. Bell

14. In the request for reexamination, the third party requester alleges Ivie '981 taken with LZ77 and LZSS compression techniques disclosed in Timothy C. Bell, renders claim 17 of the '341 patent obvious.

It is **agreed** that the consideration of Ivie '981 taken with Timothy c. Bell raises a substantial new question of patentability as to claim 17 of the '341 patent. Request page 17, through page 23, end of the claim chart for claim 17, for the teaching of Ivie '981 and pages 26, section III.A.3, for the teaching of LZ77 and LZSS compression techniques, are hereby incorporated by reference from the request for reexamination for their explanation of the teaching provided in Ivie '981 and Timothy c. Bell that was not present in the prosecution of the application which became the '341 patent. Further, there is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claim 17 is patentable. Accordingly, Ivie '981 taken with LZ77 and LZSS compression techniques of Timothy c. Bell raises a substantial new question of patentability as to claim 17, which question has not been decided in a previous examination of the '341 patent.

RE: Ivie '981 Taken With JPEG

15. In the request for reexamination, the third party requester alleges Ivie '981 taken with compression techniques used by Joint Photographic Expert Group (JPEG) standard, renders claim 17 of the '341 patent obvious.

It is **agreed** that the consideration of Ivie '981 taken with JPEG raises a substantial new question of patentability as to claim 17 of the '341 patent. Request page 17, through page 23, end of the claim chart for claim 17, for the teaching of Ivie '981 and pages 28, through page 29, section III.B.2, for the teaching of compression techniques used by JPEG standard, are hereby incorporated by reference from the request for reexamination for their explanation of the teaching provided in Ivie '981 and JPEG standard that was not present in the prosecution of the application which became the '341 patent. Further, there is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claim 17

Art Unit: 3992

is patentable. Accordingly, Ivie '981 taken with JPEG standard compression techniques of Timothy c. Bell raises a substantial new question of patentability as to claim 17, which question has not been decided in a previous examination of the '341 patent.

RE: Walter '387 Taken With Lippman '480

16. In the request for reexamination, the third party requester alleges Walter '387 taken with Lippman '480, renders claim 17 of the '341 patent obvious.

It is **agreed** that the consideration of Walter '387 taken with Lippman '480 raises a substantial new question of patentability as to claim 17 of the '341 patent. Request page 43, through page 49, section III.E, are hereby incorporated by reference from the request for reexamination for their explanation of the teaching provided in Walter '387 and Lippman '480 that was not present in the prosecution of the application which became the '341 patent. Further, there is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claim 17 is patentable. Accordingly, Walter '387 taken with Lippman '480 raises a substantial new question of patentability as to claim 17, which question has not been decided in a previous examination of the '341 patent.

RE: Walter '387 Taken Andrew Lippman and William Butera

17. In the request for reexamination, the third party requester alleges Walter '387 taken with Andrew Lippman and William Butera, renders claim 17 of the '341 patent obvious.

It is **agreed** that the consideration of Walter '387 taken with Andrew Lippman and William Butera raises a substantial new question of patentability as to claim 17 of the '341 patent. Request page 43, through page 49, section III.E, are hereby incorporated by reference from the request for reexamination for their explanation of the teaching provided in Walter '387 and Andrew Lippman and William Butera that was not present in the prosecution of the application which became the '341 patent. Further, there is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claim 17

Art Unit: 3992

is patentable. Accordingly, Walter '387 taken with Andrew Lippman and William Butera raises a substantial new question of patentability as to claim 17, which question has not been decided in a previous examination of the '341 patent.

RE: Walter '387 Taken With Stephen Manes and Michael Tinker

18. In the request for reexamination, the third party requester alleges Walter '387 taken with Stephen Manes and Michael Tinker, renders claim 17 of the '341 patent obvious.

It is **agreed** that the consideration of Walter '387 taken with Stephen Manes and Michael Tinker raises a substantial new question of patentability as to claim 17 of the '341 patent. Request page 43, through page 49, section III.E, are hereby incorporated by reference from the request for reexamination for their explanation of the teaching provided in Walter '387 and Stephen Manes and Michael Tinker that was not present in the prosecution of the application which became the '341 patent. Further, there is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claim 17 is patentable. Accordingly, Walter '387 taken with Stephen Manes and Michael Tinker raises a substantial new question of patentability as to claim 17, which question has not been decided in a previous examination of the '341 patent.

RE: Walter '387 Taken With Joint Photographic Group Standard (JPEG)

19. In the request for reexamination, the third party requester alleges Walter '387 taken with JPEG, renders claim 17 of the '341 patent obvious.

It is **agreed** that the consideration of Walter '387 taken with JPEG raises a substantial new question of patentability as to claim 17 of the '341 patent. Request page 43, through page 49, section III.E, are hereby incorporated by reference from the request for reexamination for their explanation of the teaching provided in Walter '387 and JPEG that was not present in the prosecution of the application which became the '341 patent. Further, there is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding

Art Unit: 3992

whether or not claim 17 is patentable. Accordingly, Walter '387 taken with JPEG raises a substantial new question of patentability as to claim 17, which question has not been decided in a previous examination of the '341 patent.

RE: Walter '387 Taken With LZ77 and LZSS of Timothy C. Bell

20. In the request for reexamination, the third party requester alleges Walter '387 taken with LZ77 and LZSS of Timothy C. Bell, renders claim 17 of the '341 patent obvious.

It is **agreed** that the consideration of Walter '387 taken with LZ77 and LZSS of Timothy C. Bell raises a substantial new question of patentability as to claim 17 of the '341 patent. Request page 43, through page 49, section III.E, are hereby incorporated by reference from the request for reexamination for their explanation of the teaching provided in Walter '387 and LZ77 and LZSS of Timothy C. Bell that was not present in the prosecution of the application which became the '341 patent. Further, there is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claim 17 is patentable. Accordingly, Walter '387 taken with LZ77 and LZSS of Timothy C. Bell raises a substantial new question of patentability as to claim 17, which question has not been decided in a previous examination of the '341 patent.

RE: Walter '387 Taken With Terry A. Welch, and H.C. Kotze and G. Kuhn

21. In the request for reexamination, the third party requester alleges Walter '387 taken with compression techniques of Terry A. Welch and H. C. Kotze and G. Kuhn, renders claim 17 of the '341 patent obvious.

It is **agreed** that the consideration of Walter '387 taken with compression techniques of Terry A. Welch and H. C. Kotze and G. Kuhn raises a substantial new question of patentability as to claim 17 of the '341 patent. Request page 43, through page 49, section III.E, are hereby incorporated by reference from the request for reexamination for their explanation of the teaching provided in Walter '387 and Terry A. Welch and H. C. Kotze and G. Kuhn that was not

Art Unit: 3992

present in the prosecution of the application which became the '341 patent. Further, there is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claim 17 is patentable. Accordingly, Walter '387 taken Terry A. Welch and H. C. Kotze and G. Kuhn raises a substantial new question of patentability as to claim 17, which question has not been decided in a previous examination of the '341 patent.

RE: Pocock '125 Taken With Lippman '480

22. In the request for reexamination, the third party requester alleges Pocock '125 taken with Lippman '480, renders claim 17 of the '341 patent obvious.

It is **agreed** that the consideration of Pocock '125 taken with Lippman '480 raises a substantial new question of patentability as to claim 17 of the '341 patent. Request page 50, through page 56, section III.F, are hereby incorporated by reference from the request for reexamination for their explanation of the teaching provided in Pocock '125 and Lippman '480 that was not present in the prosecution of the application which became the '341 patent. Further, there is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claim 17 is patentable. Accordingly, Pocock '125 taken with Lippman '480 raises a substantial new question of patentability as to claim 17, which question has not been decided in a previous examination of the '341 patent.

RE: Pocock '125 Taken Andrew Lippman and William Butera

23. In the request for reexamination, the third party requester alleges Pocock '125 taken with Andrew Lippman and William Butera, renders claim 17 of the '341 patent obvious.

It is **agreed** that the consideration of Pocock '125 taken with Andrew Lippman and William Butera raises a substantial new question of patentability as to claim 17 of the '341 patent. Request page 50, through page 56, section III.F, are hereby incorporated by reference from the request for reexamination for their explanation of the teaching provided in Pocock '125 and Andrew Lippman and William Butera that was not present in the prosecution of the

Art Unit: 3992

application which became the '341 patent. Further, there is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claim 17 is patentable. Accordingly, Pocock '125 taken with Andrew Lippman and William Butera raises a substantial new question of patentability as to claim 17, which question has not been decided in a previous examination of the '341 patent.

RE: Pocock '125 Taken With Stephen Manes and Michael Tinker

24. In the request for reexamination, the third party requester alleges Pocock '125 taken with Stephen Manes and Michael Tinker, renders claim 17 of the '341 patent obvious.

It is **agreed** that the consideration of Pocock '125 taken with Stephen Manes and Michael Tinker raises a substantial new question of patentability as to claim 17 of the '341 patent. Request page 50, through page 56, section III.F, are hereby incorporated by reference from the request for reexamination for their explanation of the teaching provided in Pocock '125 and Stephen Manes and Michael Tinker that was not present in the prosecution of the application which became the '341 patent. Further, there is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claim 17 is patentable. Accordingly, Pocock '125 taken with Stephen Manes and Michael Tinker raises a substantial new question of patentability as to claim 17, which question has not been decided in a previous examination of the '341 patent.

RE: Pocock '125 Taken With Joint Photographic Group Standard (JPEG)

25. In the request for reexamination, the third party requester alleges Pocock '125 taken with JPEG, renders claim 17 of the '341 patent obvious.

It is **agreed** that the consideration of Pocock '125 taken with JPEG raises a substantial new question of patentability as to claim 17 of the '341 patent. Request page 50, through page 56, section III.F, are hereby incorporated by reference from the request for reexamination for their explanation of the teaching provided in Pocock '125 and JPEG that was not present in the

Art Unit: 3992

prosecution of the application which became the '341 patent. Further, there is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claim 17 is patentable. Accordingly, Pocock '125 taken with JPEG raises a substantial new question of patentability as to claim 17, which question has not been decided in a previous examination of the '341 patent.

RE: Pocock '125 Taken With LZ77 and LZSS of Timothy C. Bell

26. In the request for reexamination, the third party requester alleges Pocock '125 taken with LZ77 and LZSS of Timothy C. Bell, renders claim 17 of the '341 patent obvious.

It is **agreed** that the consideration of Pocock '125 taken with LZ77 and LZSS of Timothy C. Bell raises a substantial new question of patentability as to claim 17 of the '341 patent. Request page 50, through page 56, section III.F, are hereby incorporated by reference from the request for reexamination for their explanation of the teaching provided in Pocock '125 and LZ77 and LZSS of Timothy C. Bell that was not present in the prosecution of the application which became the '341 patent. Further, there is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claim 17 is patentable. Accordingly, Pocock '125 taken with LZ77 and LZSS of Timothy C. Bell raises a substantial new question of patentability as to claim 17, which question has not been decided in a previous examination of the '341 patent.

RE: Pocock '125 Taken With Terry A. Welch, and H.C. Kotze and G. Kuhn

27. In the request for reexamination, the third party requester alleges Pocock '125 taken with compression techniques of Terry A. Welch and H. C. Kotze and G. Kuhn, renders claim 17 of the '341 patent obvious.

It is **agreed** that the consideration of Pocock '125 taken with compression techniques of Terry A. Welch and H. C. Kotze and G. Kuhn raises a substantial new question of patentability as to claim 17 of the '341 patent. Request page 50, through page 56, section III.F, are hereby

Art Unit: 3992

incorporated by reference from the request for reexamination for their explanation of the teaching provided in Pocock '125 and Terry A. Welch and H. C. Kotze and G. Kuhn that was not present in the prosecution of the application which became the '341 patent. Further, there is a substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not claim 17 is patentable. Accordingly, Pocock '125 taken Terry A. Welch and H. C. Kotze and G. Kuhn raises a substantial new question of patentability as to claim 17, which question has not been decided in a previous examination of the '341 patent.

Art Unit: 3992

NOTICE RE PATENT OWNER'S CORRESPONDENCE ADDRESS

Effective May 16, 2007, 37 CFR 1.33(c) has been revised to provide that:

The patent owner's correspondence address for all communications in an *ex parte* reexamination or an *inter partes* reexamination is designated as the correspondence address of the patent.

Revisions and Technical Corrections Affecting Requirements for Ex Parte and Inter Partes Reexamination, 72 FR 18892 (April 16, 2007)(Final Rule)

The correspondence address for any pending reexamination proceeding not having the same correspondence address as that of the patent is, by way of this revision to 37 CFR 1.33(c), automatically changed to that of the patent file as of the effective date.

This change is effective for any reexamination proceeding which is pending before the Office as of May 16, 2007, including the present reexamination proceeding, and to any reexamination proceeding which is filed after that date.

Parties are to take this change into account when filing papers, and direct communications accordingly.

In the event the patent owner's correspondence address listed in the papers (record) for the present proceeding is different from the correspondence address of the patent, it is strongly encouraged that the patent owner affirmatively file a Notification of Change of Correspondence Address in the reexamination proceeding and/or the patent (depending on which address patent owner desires), to conform the address of the proceeding with that of the patent and to clarify the record as to which address should be used for correspondence.

Telephone Numbers for reexamination inquiries:

Reexamination and Amendment Practice	(571) 272-7703
Central Reexam Unit (CRU)	(571) 272-7705
Reexamination Facsimile Transmission No.	(571) 273-9900

Art Unit: 3992

How to Communicate with the USPTO

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:



Majid A. Banankhah
CRU Examiner
GAU 3992
(571) 272-3770

Conferee:



Conferee:



FORM PTO-1449
MODIFIED

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

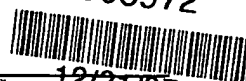
ATTY. DOCKET NO.

SERIAL NO.

PATENT NO.

5,253,341

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INFORMATION DISCLOSURE STATEMENT
BY THIRD PARTY *EX PARTE*
REEXAMINATION REQUESTOR

(Use several sheets if necessary)

APPLICANTS

Anthony I. Rozmanith, Neil Berinson

FILING DATE

April 11, 1991 (Original appl.)
June 9, 2000 (1st Reexam req.)

GROUP

12/21/07

U.S. PATENT DOCUMENTS

EXAMINER'S INITIALS	PATENT NUMBER	ISSUE DATE	NAME	CLASS	SUBCLASS	FILING DATE IF APPROPRIATE
MB	4,506,387	March 19, 1985	Walter			May 25, 1983
MB	4,987,480	January 22, 1991	Lippman			July 11, 1989
MB	5,014,125	May 7, 1991	Pocock			May 5, 1989
MB	5,113,496	May 12, 1992	McCalley			March 8, 1989
MB	5,420,981	May 30, 1995	Ivie			September 29, 1989

FOREIGN PATENT DOCUMENTS

	DOCUMENT NUMBER	PUBLICATION DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
						YES	NO*

OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)


MB	Terry A. Welch, A Technique for High-Performance Data Compression, IEEE Computer, Vol. 17, No. 6, pp. 8-19 (June 1984).
MB	H.C. Kotze and G. Kuhn, An Evaluation of the Lempel-Ziv-Welch Data Compression Algorithm, Southern African Conference on Communications and Signal Processing, IEEE COMSIG 1989 Proceedings, pages 65-69 (June 23, 1989).
MB	Timothy C. Bell, Better OPM/L Text Compression, IEEE Transactions on Communications, Vol. 34, Issue 12, pp. 1176-1182 (December 1986).
MB	Andrew Lippman and William Butera, Coding Image Sequences for Interactive Retrieval, Communications of the ACM, Volume 32, Issue 7, pp. 852-860 (July 1989).
MB	Steve Rosenthal, JPEG Emerging as Standard for Compressing Image Files, MacWEEK Magazine, Vol. 4, No. 12 (March 27, 1990).
MB	Stephen Manes, The Road to Respect; Digital Video Interactive, PC Computing, Vol. 2, No. 3, pages 107-115 (March 1989).
MB	Michael Tinker, DVI Parallel Image Compression, Communications of the ACM, Vol. 32, Issue 7, pp. 844-851 (July 1989).
MB	Charles Bowen and David Peyton, Getting the Most Out of CompuServe, Chapters 1 and 19 (4th ed. 1989).

EXAMINER

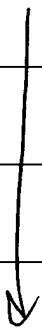
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*A concise statement of relevance is being submitted in lieu of a translation. 37 CFR § 1.98(b).
1449FORM (Rev. 7/15/1999)

Reexamination 	Application/Control No. 90/008,972	Applicant(s)/Patent Under Reexamination 5,253,341 C1
	Certificate Date	Certificate Number

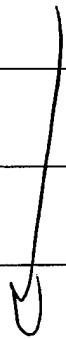
Requester	Correspondence Address:	<input type="checkbox"/> Patent Owner	<input checked="" type="checkbox"/> Third Party

LITIGATION REVIEW <input checked="" type="checkbox"/>	IMB\ <small>(examiner initials)</small>	<small>(date)</small>
Case Name	Director Initials	
U.S. District - Florida Southern, (West Palm Beach), 9:08cv80013, Global Patent Holdings, Llc v. Panthers Brhc Llc	<i>See Head for LHM</i>	
US District Court Civil Docket U.S. District- Nevada, (Las Vegas), 2:07cv1726, Zappos.Com, Inc v. Global Patent Holdings, Llc		
U.S. District- Florida Southern (West Palm Beach), 9:07cv81149, Global Patent Holdings, Llc v. Adt Security, Inc et A		
U.S. District - Illinois Northerr (Chicago), 1:07cv4476 Global Patent Holdings, Llc v. Cdw Corporation et al		
U.S. District - Illinois Northerrl, (Chicago), 1:00CV4623, Global Patent Holdings v. Green Bay Packers et a		

COPENDING OFFICE PROCEEDINGS	
TYPE OF PROCEEDING	NUMBER
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Reexamination 	Application/Control No. 90/008,972	Applicant(s)/Patent Under Reexamination 5,253,341 C1
	Certificate Date	Certificate Number

Requester Correspondence Address: <input type="checkbox"/> Patent Owner <input checked="" type="checkbox"/> Third Party

LITIGATION REVIEW <input checked="" type="checkbox"/>	IMB\ <small>(examiner initials)</small>	<small>(date)</small> Director Initials
Case Name		
U.S. District - Illinois Northern (Chicago), 1:00cv1207, Techsearch v. Sara Lee Corp, et al		<i>Eui Hoeseel for LMM</i>
U.S. District - Illinois Northern, (Chicago), 1:99CV7486, Techsearch Llc v. Walgreens Co, et al		
U.S. District- Illinois Northern (Chicago), 1:99cv6795, Techsearch Llc v. Ftd Corn Inc		
U.S. District - Massachusetts (Boston), 1:99cv11795 Healthgate Data Corp v. Techsearch Llc		
U.S. District - Illinois Northern, (Chicago), 1:99CV4550 I Techsearch Llc v. United Air Lines'Inc, et al		

COPENDING OFFICE PROCEEDINGS	
TYPE OF PROCEEDING	NUMBER
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