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ART UNIT	PAPER NUMBER
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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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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/012,829*.

PATENT NO. *7822816*.

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)).

Office Action in Ex Parte Reexamination	Control No. 90/012,829	Patent Under Reexamination 7822816	
	Examiner RACHNA DESAI	Art Unit 3992	AIA (First Inventor to File) Status No

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

a. ☒ Responsive to the communication(s) filed on *6/24/2013 by PO and 8/26/2013 by 3PR* .
☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.

b. ☐ This action is made FINAL.

c. ☐ A statement under 37 CFR 1.530 has not been received from the patent owner.

A shortened statutory period for response to this action is set to expire *2* month(s) from the mailing date of this letter. Failure to respond within the period for response will result in termination of the proceeding and issuance of an *ex parte* reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).** If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.

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

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Information Disclosure Statement, PTO/SB/08.
3. ☐ Interview Summary, PTO-474.
4. ☐ _____.

Part II SUMMARY OF ACTION

1a. ☒ Claims *1-14* are subject to reexamination.

1b. ☐ Claims _____ are not subject to reexamination.

2. ☐ Claims _____ have been canceled in the present reexamination proceeding.

3. ☐ Claims _____ are patentable and/or confirmed.

4. ☒ Claims *1-14* are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ The drawings, filed on _____ are acceptable.

7. ☐ The proposed drawing correction, filed on _____ has been (7a) ☐ approved (7b) ☐ disapproved.

8. ☐ Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of the certified copies have

1 ☐ been received.

2 ☐ not been received.

3 ☐ been filed in Application No. _____ .

4 ☐ been filed in reexamination Control No. _____.

5 ☐ been received by the International Bureau in PCT application No. _____.

* See the attached detailed Office action for a list of the certified copies not received.

9. ☐ Since the proceeding appears to be in condition for issuance of an *ex parte* reexamination certificate except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte* Quayle, 1935 C.D. 11, 453 O.G. 213.

10. ☐ Other: _____

cc: Requester (if third party requester)

Reexamination

1. The present application is being examined under the pre-AIA first to invent provisions.

2. An Ex Parte Reexamination has been granted for claims 1-14 of U.S. 7,822,816 B2. See Order, mailed April 23, 2013. Patent Owner filed a PO Statement in Response to the Order on 06/24/2013 and the Requester filed a reply to the PO's Statement on 08/26/2013.

References Submitted by Requester

3. The following references have been cited in the proposed rejections by the Requester:

U.S. Patent No. 5,704,029 to Wright ("Wright")

U.S. Patent No. 6,477,373 to Rappaport et al. ("Rappaport")

U.S. Patent No. 6,584,464 to Warthen ("Warthen")

U.S. Patent App. No. 2002/0007303 to Brookler et al. ("Brookler")

European Patent Application EP 0779,759 to Rossmann ("Rossmann")

PCT Published Application WO 99/33390 to Benigno ("Benigno")

U.S. Patent No. 5,991,771 to Falls et al. ("Falls")

U.S. Patent No. 5,442,786 to Bowen ("Bowen")

Claim Rejections - 35 USC § 103

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

Issue 1

5. Claims 1-3 and 5-14 are rejected under 35 U.S.C. 103(a) as being obvious over Rossmann in view of Rappaport (see pages 29-80 of the Request for Reexamination filed 04/03/2013, incorporated by reference).

These rejections on pages 29-80 of the Request for Reexamination filed 04/03/2013 are incorporated by reference.

Issue 2

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being obvious over Rossmann in view of Rappaport and Bowen (see pages 80-85 of the Request for Reexamination filed 04/03/2013, incorporated by reference).

The rejection for claim 4 on pages 80-85 of the Request for Reexamination filed 04/03/2013 are incorporated by reference.

Issue 3

7. Claims 1-14 are rejected under 35 U.S.C. 103 (a) as being obvious over Rossmann in view of Falls (see pages 85-170 of the Request for Reexamination filed 04/03/2013, incorporated by reference).

These rejections on pages 85-170 of the Request for Reexamination filed 04/03/2013 are incorporated by reference.

Issue 4

8. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being obvious over Benigno in view of Falls (see pages 170-277 of the Request for Reexamination 04/03/2013, incorporated by reference).

These rejections on pages 170-277 of the Request for Reexamination filed 04/03/2013 are incorporated by reference.

Issue 5

9. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being obvious over Benigno in view of Rappaport (see pages 277-349 of the Request for Reexamination 04/03/2013, incorporated by reference).

These rejections on pages 277-349 of the Request for Reexamination filed 04/03/2013 are incorporated by reference.

Issue 6

10. Claims 1, 2, 5, 7, 11, and 13-14 are rejected under 35 U.S.C. 103(a) as being obvious over Wright in view of Worthen, Rappaport, and Brookler, (see pages 349-390 of the Request for Reexamination 04/03/2013, incorporated by reference).

These rejections on pages 349-390 of the Request for Reexamination filed 04/03/2013 are incorporated by reference.

Issue 7

11. Claims 12 is rejected under 35 U.S.C. 103(a) as being obvious over Wright in view of Worthen, Rappaport, Brookler, and Rossman (see page 384 of the Request for Reexamination 04/03/2013, incorporated by reference).

The rejection for claim 12 on page 384 of the Request for Reexamination filed 04/03/2013 is incorporated by reference.

Response to Arguments

PO's Response:

Issue 1

PO argues it is noted that the Rossmann reference assumes that a connection to the server will always be available. PO refers to Declaration of John C. Hale Under 37 C.F.R. § 1.132 (hereinafter "Hale Declaration"), paragraph 6. PO argues there is no suggestion or provision in this reference for the method of Rossmann to continue if connectivity is not available.

On the other hand, PO argues the method of the '816 Patent specifically contemplates that connectivity to a central server will not be continuously available (Hale Declaration, paragraph 7). As such, it is intended to be operational within a loosely networked environment as that term is defined in the patent ('816 Patent at Col. 4, Line 16 to Col. 5, Lines 1-5).

PO argues the Rapport Reference teaches a method of maintaining connectivity of mobile terminals (Hale Declaration, paragraph 8). It teaches maintaining connectivity. It does not teach handling interruptions in connectivity (Hale Declaration, paragraph 9).

PO argues combining the Rossmann Reference and the Rappaport Reference does not yield a method that is robustly intolerant of failures in connectivity as is taught by the '816 Patent. Instead, PO argues a reference that requires connectivity has been paired with a method for maintaining connectivity, which does not yield the method of the '816 Patent (Hale Declaration, paragraph 10).

As such, PO argues Rossmann and Rappaport fail to raise a substantial new question of patentability regarding claims 1-3 and 5-14.

Issue 2

PO argues as was noted previously with respect to Issue 1 that combining Rappaport and Rossmann does not yield a method that is robustly intolerant of failures in connectivity. Further, PO argues supplying the Bowen reference does not change the basic combination. As such, it is believed that these references do not raise a substantial new question of patentability with respect to claim 4.

Issue 3

Regarding Rossmann in view of Falls raising a substantial new question of patentability regarding claims 1-14 under 35 U.S.C. §103(a), PO argues as was stated above, the Rossmann reference assumes a connection to a server will always be available (Hale Declaration, paragraph 6). There is no provision in this reference for the method of Rossmann to continue if connectivity is not available.

The Falls reference includes a system and method for synchronizing transactions in a disconnectable network. The Falls reference specifically contemplates disconnection between a mobile computer and a network (Hale Declaration, paragraph 14).

PO argues combining the Rossmann reference with the Falls reference will result in an inoperable combination (Hale Declaration, paragraph 15). More particularly, PO argues Rossmann assumes that the server will always be available and that additional decks or cards can be fetched if needed. PO argues combining the Rossmann reference with Falls does not provide a solution when additional decks are needed and there is no connectivity. As such, the combination is inoperable.

In view of the foregoing, Rossmann and Falls do not raise a substantial new question of patentability regarding claims 1-14.

Issue 4

Regarding Benigno in view of Falls raising a substantial new question of patentability under 35 U.S.C. §103(a) for Claims 1-14, PO argues the instance of "tokenizing" said to correspond to Patentee's "tokens" in the subject claims (Hale Declaration, paragraph 17) fails because Benigno's "tokens" are not patentee's tokens. By way of explanation, Patentee clearly indicates that tokens of the '816 Patent are designed to be executed "...on any device, regardless of hardware differences or native operating system differences among the plurality of the devices." '816 Patent at column 4, lines 55-60 (Hale Declaration, paragraph 19).

However, PO argues there is no evidence whatsoever that Benigno's "tokens" have this property. In fact, PO argues the evidence points to the opposite conclusion, i.e., that Benigno's "tokens" are customized to run on a single platform. *See,* for example, Figure 4 of Benigno and its associated text (p. 46, lines 4-9) which indicates a homogeneous computer network (Hale Declaration, paragraph 20).

PO argues it is improper to conclude that just because Benigno happens to use the same term as patentee that the term is used the same way. In short, PO argues the Examiner has failed to find anything in Benigno that teaches this particular aspect of the instant invention. Thus, Benigno in view of Falls does not raise a substantial new question of patentability with respect to claim 1-14.

Issue 5

PO essentially repeats the same arguments presented above with respect to Issue 4 regarding Issue 5.

Issue 6

PO argues in the Warten Reference the term "tokenizing" merely means to take a search query which has been entered into a computer program and convert it into a list of words. That is all that the Warthen Reference teaches regarding tokenization. A syntactic structure is derived from the list of words which is in turn reformed into canonical forms by replacing synonyms with a canonical term (Warthen at Col. 5, Lines 45-47). The canonical structure is then matched against a semantic network to obtain

well-formed questions which are representative of the possible meanings for the initial user query.

In contrast, PO argues Patentee's use of the word "token" is much different than that of Warthen. In Patentee's claims 1, 2, 5-7, and 11-14, a plurality of tokens are transmitted to a remote computing device and then at least a portion of them are executed. Thus, tokens are executed by a remote device to implement the questionnaire. The "token" of Patentee's claims is not a list of words as defined by the Warthen Reference. As such, PO argues the Warthen Reference does not teach tokenizing as is recited in Patentee's specification and claims.

Other Arguments

PO argues the reexamination should not go forward because the parties are in litigation and cites several reasons why reexamination should not proceed (pages 8-10 of response).

Third Party Requester's Response:

Issue 1

Regarding PO's argument that "the method of the '816 Patent specifically contemplates that connectivity to a central server will not be continuously available. As such, it is intended to be operational within a loosely networked environment as that

term is defined in the patent ...." Patent Owner Statement at 3. Requester argues this is not an argument for patentability, as it is not required by the claims. Specifically, Requester argues claims 8-14 don't even mention the word "network" much less a "loosely networked environment," so any effort to limit claims 8-14 to a "loosely networked environment, is merely reading limitations from the specification into the claims. Reading limitations into the claims is prohibited by at least MPEP §2111.01. Further, claims 1-7 only require a "network" not a "loosely networked environment". Requester argues the '816 patent states:

With regard to the present invention, the term "loosely networked" is used to describe a networked computer system wherein devices on the network are tolerant of intermittent network connections and, in fact, tolerant of the type of network connection available. In particular, if any communication connection is available between devices wishing to communicate, network transmissions occur normally, in real time. If a network connection is unavailable at that moment, the information is temporarily stored in the device and later transmitted when the connection is restored. Unless otherwise specified, hereinafter the terms "network" or "networked" refer to loosely networked devices. '816 at 4:61-5:5.

Requester notes that the explicit statement in the ' 816 patent that the Patent Owner refers to allows a "loosely networked" connection to be "tolerant of the type of network connection available" including "if any communications connection is available between the devices wishing to communicate, network transmissions occur normally, in real time."

Accordingly, Requester argues it is irrelevant if the '816 patent "contemplates that connectivity to a central server will not be continuously available" because the reference discloses that when connectivity is continuously available, a connection will exist. Communication will occur and be tolerant of the type of network connection available.

Requester argues the limitations of the claims as well as the explicit definitions provided in the '816 patent, render the Patent Owner's arguments with respect to Issue No. 1 moot.

However, Requester argues should the Office disagree and require that the "loosely networked environment" only operates as argued by Patent Owner in the Patent Owner Statement, the combination of Rossmann and Rapport still teach this limitation. As stated in the Request and accepted by the Office in the Order, "It would have been obvious to combine Rossmann with Rappaport so that when a connection fails, as will predictably happen, the device can reconnect and send the information upon reconnection. This would motivate a person of skill in the art to make the combination since disconnections are a common occurrence and Rappaport teaches a method of reconnection. *See* Rappaport at Abstract." *Ex parte* Request at 27-28.

Requester argues despite Patent Owner's suggestion to the contrary, the combination of Rappaport with Rossman teaches a method that is tolerant of intermittent failures of a wireless connection.

Issue 2

Requester argues, as stated with respect to Issue No. 1, above, the claims do not require a method that is "robustly intolerant of failures in connectivity." Instead, the claims recite a "network" (claims 1-7) and "electronic communication" (claims 8-14). Requester argues Rappaport in view of Rossman teaches both a "network" and "electronic communication," and therefore, render the claims obvious. Requester argues Patent Owner has provided no argument to the contrary, and in fact, does not dispute the combination provides the feature of resuming connectivity upon a disconnection event. The claims do not recite multiple disconnection events, only connection, disconnection, followed by reconnection.

Issue 3

For Issue No. 3, Patent Owner raises nearly the same dispute of Issue No. 1, except to further argue that the combination would be "inoperable." Patent Owner Statement at 4. Requester argues Patent Owner's argument is based on an unsupported assertion by their expert, Dr. Hale. Requester argues if the declaration is considered, all that is stated is that the combination is inoperable because "[c]ombining the Rossmann reference with Falls does not provide a solution when additional decks are needed and there is no connectivity." Patent Owner Statement at 4. Requester argues this statement is not related to any aspect of the claim and is tantamount to an admission that Rossman in view of Falls teaches each limitation of the claims. Requester argues Patent Owner presents a hypothetical that the combination is not

operable in a situation where no connectivity exists, yet additional decks are needed. Requester argues the claims do not recite the argued "need" for additional decks and the prior art need only disclose that which is claimed.

Requester argues the combination provides for a system that can encounter and recover from failed or terminated connections. Specifically, Requester argues Falls teaches that mobile devices can terminate connections and then reestablish those connections. Falls at 3:16-35, 16:24-29, and 7:16-21. Upon reestablishment of the connection, any requests will be processed and transmitted. *Id.* Accordingly, the combination solves the problem of inevitable connection failure. Requester argues nothing Patent Owner argues changes this fact, and reliance on Dr. Hale's testimony is not warranted by the contents of the declaration. Since the only "evidence" of inoperability is assertion, with no actual factual basis in the record, and Patent Owner has basically admitted that all the elements of the claims are taught by the combination, a rejection is proper in this instance.

Issue 4

Initially, Patent Owner states that the following quote is a definition of "tokenization" as used within the claims:

In a preferred embodiment, a server is loosely networked to a plurality of computers (handheld, laptop, or desktop). Each computer is equipped with an operating system which allows common programming to execute on any device,

regardless of hardware differences or native operating system differences among the plurality of devices. '816 patent at 4:55-60.

However, Requester argues tokens are not mentioned at all in this paragraph. It is not clear how this is an express definition of tokenizing. Patent Owner also argues that "there is no evidence whatsoever that Benigno's 'tokens' have this property - operable when there exist hardware and operating system differences. Patent Owner Statement at 5 (citing Benigno at FIG. 4 and 46:4-9). Requester fails to see any indication that the system is "customized to run on a single platform" as argued by Patent Owner. Figure 4, the basis of this statement, merely shows generic computers. Patent Owner also cites to Benigno at 46:4-9, which reads:

In step 101, a nurse logs into a client computer 401. In step 102, the nurse, using the client computer 401 (Figure 4) communicates with the server 402, in order to obtain updated pathway instructions, etc., regarding what steps to perform during visit(s) for one or more patient(s). The communication can take place via modern and standard phone lines, via wireless transmission (e.g., cellular, etc.), via the Internet, or via any other communication link.

Requester fails to see any indication that the "tokens" of Benigno are "customized to run on a single platform" in the quoted section.

Finally, Patent Owner argues that "mere coincidence of vocabulary does not raise a substantial new question of patentability." Patent Owner Statement at 5.

Requester argues Benigno specifically discloses that the questionnaire tokens represent pathway instructions. Requester argues Patent Owner fails to consider the teachings of the references as a whole in reaching its conclusion that the questionnaire features disclosed by the combination do not disclose the tokenizing feature recited in the claims.

Issue 5

The Patent Owner makes that same argument for Issue No. 5 as was made with respect to Issue No. 4. Since there are no new arguments presented by Patent Owner and the arguments are still not persuasive, Requester refers to the rebuttals provided for Issue No. 4.

Issue 6

Patent Owner argues that "in the Warthen Reference the term 'tokenizing' merely means to take a search query which has been entered into a computer program and convert it into a list of words." Patent Owner Statement at 7. Requester argues Patent Owner does not actually make a substantive argument as to the differences between the tokens taught by Warthen versus the tokens recited in the claims. The purported difference argued is that "Patentee' s use of the word 'token' is much different than that of Warthen. In Patentee' s claims ... a plurality of tokens are transmitted to a remote computing device and then at least a portion of them are executed." Patent Owner Statement at 7. Requester argues devoid from this statement is any citation or proof

that the definition provided by Patent Owner is anything but attorney argument. Requester argues merely saying that something is different is not sufficient to prevent an obviousness rejection.

Requester argues Warthen teaches that a system can have a "[t]okenizer 150 convert[] the initial user query into a list of words and provides the list to parser 155. One structure for conversion is an augmented transition network. Another approach to tokenizing is to scan the initial user query and group the words into conceptual strings, removing plurals and suffixes." Warthen at 5:28-33.

Requester argues the claims recite "tokenizing said questionnaire; thereby producing a plurality of tokens representing said questionnaire." Specifically, the Warthen tokenizer "converts the user query into a list of words" via an "augmented transition network." So Warthen is converting, *i.e.,* producing, a list of words, *i.e.,* plurality of tokens, that provides a list, *i.e.,* representing said questionnaire, to a parser. This is entirely consistent with what the '816 patent describes for tokens: "As the client enters questions and selects response types, server 24 builds a stack of questions and responses, and assigns indices, or tokens, which point to each question or response." '816 patent at 8:41-43.

Requester argues Patent Owner provides no argument distinguishing the Warthen tokens from the tokens of the claims at issue. Instead, merely saying that tokens are not "a list of words" is not evidence that the tokenizing of the claims is not taught by Warthen.

Further, Requester argues the Warthen reference is combined with Wright. Wright teaches that a form engine "interprets one field at a time." Wright at Abstract. Requester argues for a question to be interpreted by a form engine, it must be executed, thereby being a "token" as argued by Patent Owner. Importantly, Requester argues Patent Owner "cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references." MPEP §2145(IV).

Accordingly, the combination of Wright in view of Rappaport, Warthen, Brookler, and Rossmann render claims 1, 2, 5-7, and 11-14 of the '816 patent obvious.

Other Arguments

Regarding PO's arguments that the reexamination should not go forward because the parties are in litigation, Requester disagrees and argues the Office must proceed with special dispatch (pages 7-8 of the Requester's Response).

Examiner's Response:

Issue 1

Regarding PO and Declarant arguments that Rossmann assumes a connection to the server is always available and Rappaport teaches a method of maintaining

connectivity and the combination does not yield a method that is robustly intolerant of failures in connectivity, Examiner disagrees.

Initially, the claims do not require a method be “robustly intolerant of failures in connectivity”. The claims merely require establishing a network connection, terminating a network connection and reestablishing a network connection.

Regarding PO's argument that "the method of the '816 Patent specifically contemplates that connectivity to a central server will not be continuously available. As such, it is intended to be operational within a loosely networked environment as that term is defined in the patent ...." Patent Owner Statement at 3. A "loosely networked environment," is also not required by the claims.

Further column 4, line 61-column 5, line 5 of the ‘816 patent states “With regard to the present invention, the term "loosely networked" is used to describe a networked computer system wherein devices on the network are tolerant of intermittent network connections and, in fact, tolerant of the type of network connection available. In particular, **if any communication connection is available between devices wishing to communicate, network transmissions occur normally, in real time**. If a network connection is unavailable at that moment, the information is temporarily stored in the device and later transmitted when the connection is restored. Unless otherwise specified, hereinafter the terms "network" or "networked" refer to loosely networked devices.” This section allows a "loosely networked" connection to be "tolerant of the type of network connection available" including "if any communications connection is available between the devices wishing to communicate, network transmissions occur

normally, in real time." Accordingly, the reference discloses that when connectivity is continuously available, a connection will exist. Communication will occur and be tolerant of the type of network connection available.

Further, the combination of Rossmann and Rapport still teach this limitation even as argued by the PO. As stated in the Request, "It would have been obvious to combine Rossmann with Rappaport so that when a connection fails, as will predictably happen, the device can reconnect and send the information upon reconnection. This would motivate a person of skill in the art to make the combination since disconnections are a common occurrence and Rappaport teaches a method of reconnection. *See* Rappaport at Abstract." *Ex parte* Request at 27-28. The combination of Rappaport with Rossman teaches a method that is tolerant of intermittent failures of a wireless connection. As to PO's argument that Rappaport only teaches maintaining connectivity, Examiner disagrees. See column 7, lines 44-63 and column 2, lines 44-58.

Issue 2

The claimed method does not recite a method that is "robustly intolerant of failures in connectivity." Instead, the claims recite a "network" (claims 1-7) and "electronic communication" (claims 8-14). Rappaport in view of Rossman teaches both a "network" and "electronic communication," and therefore, render the claims obvious. The combination provides the feature of resuming connectivity upon a disconnection event. The claims do not recite multiple disconnection events, only connection, disconnection, followed by reconnection.

Issue 3

For Issue No. 3, Patent Owner and Declarant raise nearly the same dispute of Issue No. 1, except to further argue that the combination would be "inoperable." Regarding the argument that the combination is inoperable because "combining the Rossmann reference with Falls does not provide a solution when additional decks are needed and there is no connectivity", Examiner notes this statement is not related to any aspect of the claim. The claims do not recite the argued "need" for additional decks.

The combination provides for a system that can encounter and recover from failed or terminated connections. Specifically, Falls teaches that mobile devices can terminate connections and then reestablish those connections. Falls at 3:16-35, 16:24-29, and 7:16-21. Upon reestablishment of the connection, any requests will be processed and transmitted. *Id.* Accordingly, the combination solves the problem of inevitable connection failure and does not change the principle operation of the primary reference or render the reference inoperable for its intended purpose.

Issue 4 and Issue 5

Patent Owner and Declarant argue Benigno's tokens are not patentee's tokens. Patent Owner states that the following quote is a definition of "tokenization" as used within the claims:

> In a preferred embodiment, a server is loosely networked to a plurality of computers (handheld, laptop, or desktop). Each computer is equipped with an operating system which allows common programming to execute on any device, regardless of hardware differences or native operating system differences among the plurality of devices. '816 patent at 4:55-60.

Tokens are not mentioned in this paragraph. This is not an express definition of tokenizing. Patent Owner also argues that "there is no evidence whatsoever that Benigno's 'tokens' have this property - operable when there exist hardware and operating system differences. Patent Owner Statement at 5 (citing Benigno at FIG. 4 and 46:4-9). Examiner does not find that Benigno's system is "customized to run on a single platform" as argued by Patent Owner. Figure 4, the basis of this statement, shows generic computers. Regarding PO's citation to Benigno at 46:4-9, Examiner does not see any indication that the "tokens" of Benigno are "customized to run on a single platform".

Finally, Regarding PO's argument that "mere coincidence of vocabulary does not raise a substantial new question of patentability." Examiner notes Benigno specifically discloses that the questionnaire tokens represent pathway instructions.

The Patent Owner makes that same argument for Issue No. 5 as was made with respect to Issue No. 4. Since there are no new arguments presented by Patent Owner and the arguments are still not persuasive, Examiner refers to the rebuttals provided directly above.

Issue 6

Patent Owner argues that "in the Warthen Reference the term 'tokenizing' merely means to take a search query which has been entered into a computer program and convert it into a list of words." PO argues "Patentee' s use of the word 'token' is much different than that of Warthen. PO argues in Patentee' s claims ... a plurality of tokens are transmitted to a remote computing device and then at least a portion of them are executed."

Examiner disagrees.

Warthen teaches that a system can have a "[t]okenizer 150 convert[] the initial user query into a list of words and provides the list to parser 155. One structure for conversion is an augmented transition network. Another approach to tokenizing is to scan the initial user query and group the words into conceptual strings, removing plurals and suffixes." Warthen at 5:28-33.

The claims recite "tokenizing said questionnaire; thereby producing a plurality of tokens representing said questionnaire." Specifically, the Warthen tokenizer "converts the user query into a list of words" via an "augmented transition network." So Warthen is converting, *i.e.,* producing, a list of words, *i.e.,* plurality of tokens, that provides a list, *i.e.,* representing said questionnaire, to a parser. This is entirely consistent with what the '816 patent describes for tokens: "As the client enters questions and selects

response types, server 24 builds a stack of questions and responses, and assigns indices, or tokens, which point to each question or response." '816 patent at 8:41-43.

Further, Warthen is combined with Wright in addition to other references. Wright teaches that a form engine "interprets one field at a time." Wright at Abstract. For a question to be interpreted by a form engine, it must be executed, thereby being a "token" as argued by Patent Owner.

Other Arguments

Regarding PO's arguments that the reexamination should not go forward because the parties are in litigation, Examiner notes 35 USC 305 requires all reexamination proceedings under this section, including any appeal to the Board of Patent Appeals and Interferences, will be conducted with special dispatch within the Office. Any cases involved in litigation, whether they are reexamination proceedings or reissue applications, will have priority over all other cases. See MPEP 2261. 35 U.S.C. 302 permits a request for *ex parte* reexamination to be filed "at any time." Requests for *ex parte* reexamination are frequently filed where the patent for which reexamination is requested is involved in concurrent litigation. Accordingly, reexamination will proceed.

Conclusion

Submissions

12. In order to ensure full consideration of any amendments, affidavits or declarations, or other documents as evidence of patentability, such documents must be submitted in response to this Office action. Submissions after the next Office action, which is intended to be a final action, will be governed by the requirements of 37 CFR 1.116, after final rejection and 37 CFR 41.33 after appeal, which will be strictly enforced.

Notification of Concurrent Proceedings

13. 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. 7,822,816 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 §§ 2207, 2282 and 2286.

Extension of Time

14. 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 reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extension of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

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

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

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

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at:

https://efs.uspto.gov/efile/myportal/efs-registered

EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are “soft scanned”

(i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

Any inquiry concerning this communication should be directed to the Central Reexamination Unit at telephone number 571-272-7705.

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

Conferees:

/JDC/

/Alexander J Kosowski/

Supervisory Patent Examiner, Art Unit 3992