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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
10743476	12/23/2003	LEE ET AL.	678-1264

THE FARRELL LAW FIRM, LLP
290 Broadhollow Road
Suite 210E
Melville, NY 11747

EXAMINER

STEVEN B. THERIAULT

ART UNIT	PAPER
2179	20090619

DATE MAILED:

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

Commissioner for Patents

This communication is subsequent to the office communication mailed 06/09/2009 to specifically address in the record the IDS entered on 12/30/2008. As the examiner indicated on 06/09/2009, the IDS was considered and entered, however the record does not show the IDS with the examiners signature and initials on it and to prevent possible delays at the appeals center, this communication specifically identifies that the examiner considered the IDS and shows via signature that the IDS was considered.

/Steven B Theriault/
Primary Examiner
Art Unit: 2179

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EXAMINER

STEVEN B. THERIAULT

ART UNIT	PAPER
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2179	20090607
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DATE MAILED:

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

Commissioner for Patents

In response to the order returning the appeal to the Examiner, the Examiner hereby vacates the advisory action mailed 04/20/2009 as an improper response and this communication represents a proper response in accordance with MPEP 1208, part II. The reply brief filed 12/08/2008 has been entered and considered. The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal. The IDS entered on 04/20/2009 and considered with that advisory action was made a part of the record and therefore will not be remailed with this communication.

/Steven B Theriault/
Primary Examiner
Art Unit: 2179



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,476	12/23/2003	Jong-Goo Lee	678-1264	9615
66547	7590	06/01/2009	EXAMINER	
THE FARRELL LAW FIRM, LLP 290 Broadhollow Road Suite 210E Melville, NY 11747			THERIAULT, STEVEN B	
			ART UNIT	PAPER NUMBER
			2179	
			MAIL DATE	DELIVERY MODE
			06/01/2009	PAPER

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

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: JONG-GOO LEE, EYAL TOLEDANO, NATAN LINDER,
YARIV EISENBERG, AND RAN BEN-YAIR

Application No. 10/743,476
Technology Center 2100

Mailed: May 29, 2009

Before ERIC W. HAWTHORNE, *Supervisory Paralegal Specialist*
HAWTHORNE, *Supervisory Paralegal Specialist*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on April 21, 2009. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

PRIOR ORDER FOR RETURN

A prior “Order Returning Undocketed Appeal to Examiner” was mailed on April 8, 2009 wherein the Examiner was instructed that corrections were required. A review of the file finds that the required corrections have not been made or have not been made in entirety. The matters still requiring attention prior to docketing are identified below.

EXAMINER’S CONSIDERATION OF REPLY BRIEF

A Reply Brief was filed on December 8, 2008, in response to the Examiner’s Answer mailed October 7, 2008.

Title 37, Code of Federal Regulations, §41.43 states:

(a)(1)... the primary examiner must acknowledge receipt and entry of the reply brief. In addition, the primary examiner may withdraw the final rejection and reopen prosecution or may furnish a supplemental examiner’s answer responding to any new issue raised in the reply brief.

The Communication mailed April 20, 2009, was an improper acknowledgment of the Reply Brief, as it constitutes a Supplemental Examiner’s Answer as per MPEP§ 1208, part II. A Supplemental Examiner’s Answers requires a Director or designees approval.

CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) vacate the Communication mailed April 20, 2009;
- 2) generate and mail either:

Application No. 10/743,476

a) a revised Communication properly acknowledging to the Reply Brief dated December 8, 2009 in accordance with MPEP§ 1208, part II;

OR

b) issue a Supplemental Examiner's Answer with the required signature (Technology Center Director or designee), if appropriate, and;

3) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

EWH/nhl

THE FARRELL LAW FIRM, LLP
290 Broadhollow Road
Suite 210E
Melville NY 11747

Advisory Action After the Filing of an Appeal Brief	Application No.	Applicant(s)	
	10/743,476	LEE ET AL.	
	Examiner	Art Unit	
	STEVEN B. THERIAULT	2179	

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

The reply filed 08 December 2008 is acknowledged.

1. The reply filed on or after the date of filing of an appeal brief, but prior to a final decision by the Board of Patent Appeals and Interferences, will not be entered because:

a. The amendment is not limited to canceling claims (where the cancellation does not affect the scope of any other pending claims) or rewriting dependent claims into independent form (no limitation of a dependent claim can be excluded in rewriting that claim). See 37 CFR 41.33(b) and (c).

b. The affidavit or other evidence is not timely filed before the filing of an appeal brief. See 37 CFR 41.33(d)(2).

2. The reply is not entered because it was not filed within the two month time period set forth in 37 CFR 41.39(b), 41.50(a)(2), or 41.50(b) (whichever is appropriate). Extensions of time under 37 CFR 1.136(a) are not available.

Note: This paragraph is for a reply filed in response to one of the following: (a) an examiner's answer that includes a new ground of rejection (37 CFR 41.39(a)(2)); (b) a supplemental examiner's answer written in response to a remand by the Board of Patent Appeals and Interferences for further consideration of rejection (37 CFR 41.50(a)(2)); or (c) a Board of Patent Appeals and Interferences decision that includes a new ground of rejection (37 CFR 41.50(b)).

3. The reply is entered. An explanation of the status of the claims after entry is below or attached.

4. Other: See Continuation Sheet

/Steven B Theriault/
Primary Examiner
Art Unit: 2179

Continuation of 4 Other: a. The information disclosure statement filed 12/30/2008 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

b. The reply brief has been entered but contains substantially the same argument as presented in the appeal. It is clear applicant does not believe the rejection is a proper 102 and relies on two arguments. 1) applicant argues the rejection is based on multiple embodiments, which is improper according to the supplied netmoney decision. 2) applicant argues the rejection is based on multiple references and is improper. The answer filed 10/07/08 is clear as to the position of the office and does not agree with applicant. In response and in summary, a reference to specific paragraphs, columns, pages, or figures in a cited prior art reference is not limited to preferred embodiments or any specific examples. It is well settled that a prior art reference, in its entirety, must be considered for all that it expressly teaches and fairly suggests to one having ordinary skill in the art. Stated differently, a prior art disclosure reading on a limitation of Applicant's claim cannot be ignored on the ground that other embodiments disclosed were instead cited. Therefore, the Examiner's citation to a specific portion of a single prior art reference is not intended to exclusively dictate, but rather, to demonstrate an exemplary disclosure commensurate with the specific limitations being addressed. In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)). In re: Upsher-Smith Labs. v. Pamlab, LLC, 412 F.3d 1319, 1323, 75 USPQ2d 1213, 1215 (Fed. Cir. 2005); In re Fritch, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1782 (Fed. Cir. 1992); Merck & Co. v. Biocraft Labs., Inc., 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989); In re Fracalossi, 681 F.2d 792, 794 n.1, 215 USPQ 569, 570 n.1 (CCPA 1982); In re Lamberti, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976); In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). In this example, it appears applicant has not looked at the entire reference in terms of the user interface referred to and used in the cited section and figure 15. Column 85, lines 5-67 and Figure 15 were used in the initial rejection but other sections of the reference further teach the same embodiment and to ignore those sections is improper. For example, Figure 15, is described in Column 83 as a flow chart for a predictive user interface. Figure 15, contains a flow diagram for leading the user through a correct sequence of steps on the user interface displayed on the screen (See column 83, bottom, Column 84, top). Figure 15, shows two steps of "analyzing a program sequence to predict a next action" and then "displaying the predicted action", which are predictive interface steps. Column 83, bottom describes the preferred embodiment as a VCR interface. The cited column 85 used in the rejection refers to the same figure 15 and user interface for a VCR but also refers to the steps shown to the user in the interface. Column 97-98 also refer to "the interface" and the mechanism for interaction with the interface. Therefore, in spite of applicants assertion the rejection is based on the entire reference. There are multiple sections of the reference that refer to the same embodiment and should be considered by applicant. The user interface described column 97-98 is the same interface displayed to the user to program a user interface as shown in example 1 and in figure 15. While example 5 refers to an additional element of using an infrared input device that allows for wireless interaction, the user interface is the same user interface discussed in example 1 column 83 and 85. Clearly, column 97-98 are directed to "the interface". Therefore, the rejection not only points out the specific limitations in the same reference but also teaches the limitations as arranged in the claim. In the cited section, there is a user interface, there is a proactive alteration of the interface based on a system detected pattern, and there is an alteration of at least on function of the system based on the pattern. Turning to the second argument, the examiner answer and the rejection serve as a record for what is used by the examiner. The cited incorporated by reference patents are a part of the Hoffberg reference as if they were written in the document and should be considered by applicant as relevant prior art. The examiner referred to the cited art to show the state of the art at the time of filing. The rejection also cited column 10, lines 15-31 that expressly states the incorporated patents are relevant to pattern recognition and are relevant to the interface of the present invention. Therefore, the examiner did not use a multiple rejection 102 and 2131.01 does not apply. All of the incorporated references are a part of the Hoffberg reference and the examiner did not specifically cite any additional reference to teach the limitations of the claim. Moreover, 2163.07 applies as the cited patents are a part of the text of the application as filed and should be considered as such.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: JONG-GOO LEE, EYAL TOLEDANO, NATAN LINDER,
YARIV EISENBERG, and RAN BEN-YAIR

Application No. 10/743,476
Technology Center 2100

Mailed: April 8, 2009

Before Deborah L. Perry, Supervisory Paralegal Specialist, Review Team.
Perry, Supervisory Paralegal Specialist, Review Team.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on December 31, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

EXAMINER'S CONSIDERATION OF REPLY BRIEF

A Reply Brief was filed in this application on December 8, 2008. There is no evidence on the record indicating that the Examiner has considered the Reply Brief in accordance with 37 CFR § 41.43(a)(1) and MPEP § 1208, part II.

INFORMATION DISCLOSURE STATEMENT

Appellant filed an Information Disclosure Statement (IDS) dated December 30, 2008. There is no indication on the record that the Examiner has considered the above Information Disclosure Statement. MPEP § 609 requires the Examiner to consider any Information Disclosure Statement filed by Applicant if timely submitted. A written communication notifying Appellant of the Examiner's consideration of the above Information Disclosure Statement is required.

CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner to:

- 1) consider the Reply Brief filed December 8, 2008, as indicated above;
- 2) consider the Information Disclosure Statement filed December 30, 2008; and
- 3) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

Application No. 10/743,476

DLP/bar

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