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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/012,729 ✝ 90/012790	11/29/2012	6445777	140-030	6523

61834 7590 03/11/2014

Meister Seelig & Fein LLP
2 Grand Central Tower
140 East 45th Street
NEW YORK, NY 10017

EXAMINER	
ESCALANTE, OVIDIO	
ART UNIT	**PAPER NUMBER**
3992	
MAIL DATE	**DELIVERY MODE**
03/11/2014	PAPER

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/012,790 ✓ 90/012729	02/06/2013	6445777	140-032	3035

61834 7590 03/11/2014

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/012,790; 90/012,729*.

PATENT NO. *6445777*.

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)).

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Notice of Intent to Issue Ex Parte Reexamination Certificate	Control No.	Patent Under Reexamination	
	90/012,729 90/012,790	6445777	
	Examiner	Art Unit	AIA (First Inventor to File) Status
	OVIDIO ESCALANTE	3992	No

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

1. ☒ Prosecution on the merits is (or remains) closed in this *ex parte* reexamination proceeding. This proceeding is subject to reopening at the initiative of the Office or upon petition. *Cf.* 37 CFR 1.313(a). A Certificate will be issued in view of
   (a) ☒ Patent owner's communication(s) filed: *24 February 2014*.
   (b) ☐ Patent owner's failure to file an appropriate timely response to the Office action mailed: _____.
   (c) ☐ Patent owner's failure to timely file an Appeal Brief (37 CFR 41.31).
   (d) ☐ The decision on appeal by the ☐ Board of Patent Appeals and Interferences ☐ Court dated _____
   (e) ☐ Other: _____.
2. The Reexamination Certificate will indicate the following:
   (a) Change in the Specification: ☐ Yes ☒ No
   (b) Change in the Drawing(s): ☐ Yes ☒ No
   (c) Status of the Claim(s):
      (1) Patent claim(s) confirmed: *1-21,29-36,38-82 and 104-106*.
      (2) Patent claim(s) amended (including dependent on amended claim(s)): *22-28,37,83-103 and 107-109*
      (3) Patent claim(s) canceled: _____.
      (4) Newly presented claim(s) patentable: 110.
      (5) Newly presented canceled claims: _____.
      (6) Patent claim(s) ☐ previously ☐ currently disclaimed: _____
      (7) Patent claim(s) not subject to reexamination: _____.
3. ☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.
4. ☒ Note the attached statement of reasons for patentability and/or confirmation. Any comments considered necessary by patent owner regarding reasons for patentability and/or confirmation must be submitted promptly to avoid processing delays. Such submission(s) should be labeled: "Comments On Statement of Reasons for Patentability and/or Confirmation."
5. ☐ Note attached NOTICE OF REFERENCES CITED (PTO-892).
6. ☒ Note attached LIST OF REFERENCES CITED (PTO/SB/08 or PTO/SB/08 substitute).
7. ☐ The drawing correction request filed on _____ is: ☐ approved ☐ 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
   ☐ been received.
   ☐ not been received.
   ☐ been filed in Application No. _____.
   ☐ been filed in reexamination Control No. _____.
   ☐ been received by the International Bureau in PCT Application No. _____.

   * Certified copies not received: _____.
9. ☒ Note attached Examiner's Amendment.
10. ☒ Note attached Interview Summary (PTO-474).
11. ☐ Other: _____.

All correspondence relating to this reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

Ovidio Escalante
Primary Examiner
Art Unit: 3992

cc: Requester (if third party requester)

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

NOTICE OF INTENT TO ISSUE REEXAMINATION CERTIFICATE

2. This office action is in response to the Patent Owner's response filed on February 24, 2014.

Status of the Claims

3. Original claims 1-21, 29-36, 38-82, 104-106 are confirmed.

Original amended claims 22-28, 37, 83-103, 107-109 are patentable.

New claim 110 is allowed.

Information Disclosure Statement

4. With respect to the Information Disclosure Statements (PTO/SB/08A and 08B or its equivalent) filed on February 25, 2014, the material has been considered with this action, the information cited thereon has been considered to the extent suggested in the MPEP. Note that MPEP §§ 2256 and 2656 indicate that degree of consideration to be given to such information will be normally limited by the degree to which the party filing the information citation has explained the content and relevance of the information.

Any duplicate citations noticed by the examiner or citations which are not dated have been lined through.

Examiner's Amendment

5. An examiner's amendment to the record appears below. The changes made by this examiner's amendment will be reflected in the reexamination certificate to issue in due course. This amendment was authorized by Antonio Papageorgiou on March 7, 2014.

Replace claim 109 with the following:

109. The [telecomputer] network [system] of claim 28, wherein the wireless LAN is within an on-site radius of the mobile vehicle or portable field unit.

STATEMENT OF REASONS FOR PATENTABILITY AND/OR CONFIRMATION

The following is an examiner's statement of reasons for patentability and/or confirmation of the claims found patentable in this reexamination proceeding:

Mobile Unit/Mobile Hub Station/Portable Field Unit

The Patent Owner contends that the term mobile hub/portable field unit configured as a single nomadic transmission/reception point requires that the hub/unit is capable of communicating, in this instance, with the satellite communication subsystem and the wireless LAN while traveling."

The examiner notes that the following discussion pertains to defining the claimed "nomadic" within the claimed "mobile hub/portable field unit configured as a single nomadic transmission/reception point".

Claims of the '777 Patent

The patent owner contends that the unit according to claim 1 must be both mobile and nomadic. In addition, the patent owner states that the unit according to claim 48 must be mobile, nomadic, and portable.

The patent owner maintains that the term "**mobile**" refers to the ability of such units to move between locations and, if communicatively enabled, to communicate at each location.

The patent owner maintains that "**portable**" refers to the size of the unit.

As per "**nomadic**", the patent owner acknowledges that there is no express definition for the term nomadic in the specification and therefore must take on the ordinary and customary meaning attributed to those of ordinary skill in the art.

Nomadic – "transfer broadband information as a single nomadic transmission/reception point"

The Kleinrock Reference

The patent owner refers to the following statements with the Kleinrock reference:

> "nomadicity may be defined as the system support need to provide a rich set of computing and communication capabilities and services to nomads as they move from place to place in a transparent and integrated and convenient form." Kleinrock at p. 2 ¶5

The patent owner further asserts the following:

> Moreover, Kleinrock identifies independence of motion as a key characteristic of nomadicity. *Id.* at p. 2, ¶7. He explains that independence is not merely a reference to the quality of service while in motion, "but rather to perception of a computing environment that automatically adjusts to the processing, communications, and access available at the moment." *Id.* at 3, ¶ (emphasis added). An illustrative example is provided thereafter that indicates that nomadicity with regard to these types of devices (i.e., computing and communication devices) refers to the ability of these devices to compute and/or

> communicate while in transit. *Id.* Specifically, Kleinrock illustrates that a Personal Digital Assistant (a portable device) may experience such changes (e.g., processing, communication, access, etc.) that the support system must address "while in travel." *Id.* (emphasis added).

The Katz Reference (Adaptation and Mobility in Wireless Information Systems – filed 11/18/2013)

The patent owner maintains that Katz states "[n]omadic computing [as] the ability to compute as the user relocates from one support environment to another." Katz at p. 8.

The patent owner maintains that Katz defines the term "nomadic" in the context of "computing". The patent owner states that "nomadic communication would be the ability to communicate as the user relocates from one support environment to another. The patent owner explains that this is consistent with the definition provided by Kleinrock.

McNally Declaration

McNally opines "that the term 'nomadic transmission/reception point' used in conjunction with a mobile and/or portable communication unit had an established, technical meaning in the art of mobile communications at the time of the invention." "Specifically, a 'nomadic transmission/reception point' is [one that is] capable of providing communications services while stationary and while in transit." *Id*

Other Patent References

The patent owner cites to several additional references for support that the term nomadic refers to the capability of the devices to communicate while traveling.

"Both time and communication overhead are required to locate and deliver information to users who move from place to place in personal communication services (PCS) systems. Such users are referred to as nomadic users. Systems with nomadic users differ from cellular telephone systems in that as nomadic end users move, the communication services provided to them also move ...." (US5606596, col. 1, 11. 18-21)

"A nomadic user to subscribe to, activate, and use personal communication services anywhere and at any time without interoperability problems ...." (US5537467, col. 1, 11.9-12)

"For example, the ability to connect to a network will often depend on the location from which a user is accessing the network and the destination a user is trying to reach. It is a complicated job to control access between what could be thousands of users, and it is made more complicated by the fact that the same user might access the system from different locations and might need different levels of access as a function of the location. The possible combinations of access increase geometrically because of these "nomadic" users." (US5889953, col. 1, 11.55-64).

"There is a vast array of communication device alternatives such as Ethernet, Wireless LAN, and dialup modem among which the users switches when in the office, moving around the office, or on the road (such as at a hotel, airport, or home). The device transparency in the nomadic router provides seamless switching among these devices (easily, transparently, intelligently, and without session loss). The location transparency support in the nomadic router prevents users from having to reconfigure (e.g., IP and gateway address) their network device (laptop) each time they move to a new network or subnetwork." (US6130892, col. 2, 11.52-62).

The '074 Patent

The patent owner notes that the passage cited by the examiner discusses two concepts independently, i.e. the concept of a mobile unit and that of a nomadic vehicle. The patent owner notes that in this instance the mobile unit has a limitation on connectivity and is therefore not nomadic. The patent owner states that the non-nomadic mobile unit however may be mounted in a nomadic vehicle.

In review of the how the claimed "nomadic" should be defined, the examiner maintains the previous position that the term "nomadic" requires an entity to be capable of roaming as opposed to being fixed.

In reviewing the claim language, the examiner acknowledges that the claim is directed to the *transfer of information* as a single nomadic transmission/reception point. The term nomadic is describing how transfer of information as opposed to the mobile unit itself. The examiner took the position that since the PBS of Eng is within a mobile vehicle and since the mobile vehicle is capable of being nomadic, then the claims is rendered obvious. In review of the examiner's reliance on the teachings set forth in the '074 patent:

> When the mobile hub station has reached its location, its antenna is calibrated. In one embodiment, the calibration process is a line of sight process. In an alternate embodiment, the calibration process is not necessary where the mobile hub station includes an omni-directional antenna and is able to transfer information from a non-stationary position. In one embodiment, the mobile hub station only transfers data from a stationary position. However, even though the transfer of data only occurs from a stationary position, the mobile hub station is in fact a nomadic vehicle that may be driven any where and can still gain access to the wireless WAN of the present invention. Thus, the mobile vehicle receives high bandwidth at a mobile location, avoiding reliance on existing cable sites.
>
> (col. 4, lines 61-col. 5, line 7

The above description shows that the mobile hub station only transfer data from a stationary position. The description then shows that the mobile hub station is in fact a nomadic **vehicle** that may be driver any where and still can access to the wireless WAN.

Upon further review, the examiner agrees that this description is consistent with the patent owner's proffered definition and arguments. It is noted that in the description, the vehicle

is nomadic and hence can travel, but the above description does not state that the hub can transmit as a nomadic transmission point and therefore does not shown that simply having a nomadic vehicle then the claimed limitation is met.

Based on this argument, although, the combination of Eng, Jonas and Wilson teaches of a portable and mobile unit and that the unit can travel in a nomadic vehicle, the citations relied upon by the examiner do not show that the unit "is configured to transfer broadband information as a single nomadic transmission/reception point" as claimed. The examiner finds the evidence submitted by the patent owner to show that the term "nomadic" within the context of the claims and the patent specification must be considered different that the claimed "mobile". As explained previously, nomadic requires remaining or moving from site to site and the claims specifically require the mobile unit to transfer broadband information **as a single nomadic transmission/reception point**. That is the transmission point is nomadic and hence must move and therefore the transfer of information is occurring while being nomadic.

With respect to *Eng* the patent owner argues that the PBSs of Eng are not nomadic. The examiner agrees and maintains that the correct argument is not whether the PBSs of Eng are nomadic but whether the combination of Eng, Jonas and Wilson discloses a nomadic transmission in the context of the claim language.

> The patent owner states that in order to achieve high speed wireless point-to point connectivity between PBSs, Eng teaches the use of a free space optical link between PBSs. See id. at col. 4, lines 34-42 and Fig. 5. The laser transmitter/receivers necessary to achieve these speeds, if at all possible, require that a relatively tightly beamed line-of-sight transmission medium between the transmitter and the receiver be maintained at all time in order to maintain reception, as can be seen even with a cursory review of Fig. 5.

> Even though Eng hints at wireless connectivity using radio in addition to optics, there is no discussion as to how this can be achieved without a line-of-sight connection.~ Point-to-point, line of sight wireless transmission systems require antennas serving the transmitter and the receiver that are both aligned toward each other so that line-of-sight is always maintained. If the line-of-sight alignment is broken, reception and thus connectivity is lost. Moreover, the Examiner ignores that line-of-site requires that there be no obstructions. This requires some sort of antenna supporting structure, such as a radio tower, to elevate antennas above all obstacles. Eng does not provide any guidance in this regard to even hint that there is a movable antenna structure. Eng's PBSs therefore must be fixed once deployed for them to operate as intended by Eng. McNally Dec. II at ¶8.

The examiner maintains that the combination of Eng, Jonas and Wilson supports the PBSs of Eng being placed into a mobile vehicle. It is further maintained that the mobile vehicle of Wilson is a nomadic vehicle that can roam from site to site. However, neither, Eng, Jonas nor Wilson discloses of the PBSs being configured to transfer information as a single nomadic transmission/reception point. As explained by the patent owner, the PBSs of Eng require a line-of-sight to be maintained. In addition, the teachings of Wilson do not show that it is capable of moving and receiving satellite transmission. Therefore, the examiner maintains that the prior art does not show that the PBSs when combined with Jonas and Wilson is configured as a nomadic transmission/reception point.

Any comments considered necessary by PATENT OWNER regarding the above statement must be submitted promptly to avoid processing delays. Such submission by the patent owner should be labeled: "Comments on Statement of Reasons for Patentability and/or Confirmation" and will be placed in the reexamination file.

Conclusion

14. 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. 6,445,777 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.

15. 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).

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

By EFS: registered users may submit via the electronic filing system EFS-Web, at https://efs.uspto.gov/efile/myportal/efs-registered.

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

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

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

For EFS-Web transmissions, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the data of transmission, which is prior to the expiration of the set period of time in the Office action.

Any inquiry by the patent owner concerning this communication or earlier communications from the 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.

/Ovidio Escalante/
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Conferee: /r.g.f./

/Daniel J Ryman/
Supervisory Patent Examiner, Art Unit 3992