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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO. Includes details for application 90/015,284 and examiner SAGER, MARK ALAN.

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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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

PAUL HASTINGS LLP
2050 M. STREET NW
WASHINGTON, DC 20036

***EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/015,284 .

PATENT UNDER REEXAMINATION 8677398 .

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)).

Notice of Intent to Issue Ex Parte Reexamination Certificate	Control No. 90/015,284	Patent Under Reexamination 8677398	
	Examiner MARK A SAGER	Art Unit 3992	AIA Status 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: 05/14/2024.
 - (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: 1-2.
 - (2) Patent claim(s) amended (including dependent on amended claim(s)): _____
 - (3) Patent claim(s) canceled: _____.
 - (4) Newly presented claim(s) patentable: _____.
 - (5) Newly presented canceled claims: _____.
 - (6) Patent claim(s) previously currently disclaimed: _____
 - (7) Patent claim(s) not subject to reexamination: 3-44.
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.

/MARK SAGER/
Primary Examiner, Art Unit 3992

cc: Requester (if third party requester)

Notice of Pre-AIA or AIA Status

1. The present application is being examined under the pre-AIA first to invent provisions.
2. This action replies to Patent Owner response filed May 14, 2024 to Official Action (OA) mailed March 14, 2024 of challenged claims 1 and 2 of U.S. Patent No. 8,677,398 (hereinafter also referred to as ‘398) for which it was determined in Order mailed Nov. 27, 2023 that a substantial new question of patentability affecting claims 1 and 2 of U.S. Patent No. 8,677,398 is raised by the request. Claims 3-44 were not reexamined herein. The ‘398 patent is not expired. For the record, Patent Owner correctly interpreted inadvertent inconsistencies in noted OA as stated in their footnotes 1-3.

Declaration of Christopher M. Schmandt (“Schmandt”)

3. The Declaration (signed 3/25/2022, as filed in IPR2017-00773), filed 8/31/2023, under 37 CFR 1.68, was reviewed and has been considered. Declarant summarizes his qualifications (paragraphs 1-7) and provides a Curriculum Vitae (Appendix A). Declarant provides expert testimony based on stated experience. Declarant provides a discussion of each of the references cited in the request (para. 37-189). A statement from this Declaration is relied on only where a portion of the statement(s) is cited. For reasons herein, Declarant’s opinions applying the Phillips standard for purposes of his opinions regarding claims 36 and 37 are applicable and at least encompass the analysis presented in the request where claims 1 and 2 are assessed under their broadest reasonable interpretation taking into the account the similarity in language of the claims, the specification, and prosecution file history.

Declaration of Sylvia D. Hall-Ellis, Ph.D. (“Hall-Ellis”)

4. The Declaration (signed 3/25/2022, as originally filed in IPR2017-00773), filed 8/31/2023, under 37 CFR 1.68, was reviewed and has been considered. Declarant states (paragraph 4) receiving compensation for her work on the Declaration where “My compensation is not in any way tied to the content of this Declaration, the substance of my opinions, or the outcome of this litigation. I have no other

interests in this proceeding or with any of the parties.” Declarant summarizes their qualifications (paragraphs 6-9) and provides a Curriculum Vitae (Appendix A). Declarant provides expert testimony based on stated experience. Declarant provides a discussion of the Zwicky (PA-6) and Hahn (PA-8) references cited in the request as being a true and accurate copy that is publicly available (para. 42-55). A statement from the Declaration is relied on only where a portion of the statement(s) is cited.

Declaration of Erik De La Iglesia

5. The Declaration (signed 5/14/2024), filed 5/24/2024, under 37 CFR 1.68, was reviewed and has been considered. Declarant summarizes their qualifications (paragraphs 3-11) and provides a Curriculum Vitae (Appendix A). Declarant states “I have been retained as an independent expert witness on behalf of Intent IQ, LLC to provide evidence as a technical expert regarding certain issues pertinent to Control No. 90/015,284 in the United States Patent and Trademark Office concerning the reexamination of U.S. Patent 8,677,398 (“the 398 Patent”). In this declaration, I provide opinions and evidence supporting Patent Owner’s Response to Office Action dated March 14, 2021[]” and “My work on this matter is being billed at my normal hourly consulting rate of \$750, with reimbursement for actual expenses. My compensation is not related to the outcome of any proceeding involving the ’398 Patent. I have no personal interest in the outcome of the case.” Declarant provides expert testimony based on stated experience. Declarant provides a discussion of each of the references cited in the request (para. 37-189). A statement from the Declaration is relied on only where a portion of the statement(s) is cited.

Claim Construction

6. The ’398 Patent has not yet expired. Under MPEP §2240, patent claims are to be given their broadest reasonable interpretation consistent with the specifications during Ex Parte Reexaminations. See *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). Claims should only be construed to the extent necessary to resolve a controversy. See *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868

F.3d 1013, 1017 (Fed. Cir. 2017) (only claim terms “that are in controversy” must be construed and “only to the extent necessary to resolve the controversy”).

In summary, since ‘398 patent has not yet expired, the claims must be given their “broadest reasonable interpretation consistent with the specification.” See MPEP § 2258; *In re Yamamoto*, 740 F.2d 1569, 222 USPQ 934 (Fed. Cir. 1984). Thus, in this case, the claim terms are given their broadest reasonable interpretation consistent with ‘398 Patent without reading limitations from ‘398 disclosure into the claims.

Response to Arguments

7. Patent Owner’s arguments, see pages 5-20 of remarks, filed 5/14/2024, with respect to obviousness over Baig (PA-3) in view of Hahn (PA-8), and alternatively further in view of either Satapati (PA-7) or Zwicky (PA-6) have been fully considered and are persuasive. The rejection of claims 1 and 2 has been withdrawn.

8. Patent Owner’s arguments, see pages 5-20 of remarks, filed 5/14/2024, with respect to obviousness over Baig (PA-3) in view of Hahn (PA-8) and Appleman (PA-9), and alternatively further in view of either Satapati (PA-7) or Zwicky (PA-6) have been fully considered and are persuasive. The rejection of claims 1 and 2 has been withdrawn.

9. Patent Owner’s arguments, see pages 5-20 of remarks, filed 5/14/2024, with respect to obviousness over Baal-Haness (PA-10) in view of Appelman (PA-9) have been fully considered and are persuasive. The rejection of claims 1 and 2 has been withdrawn.

Allowable Subject Matter

10. Claims 1 and 2 are confirmed.

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: lacking evidence to the contrary, with

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reconsideration of scope of claims and teachings of applied references, the applied references herein do not disclose recited "another computer system" taking action with respect to a "second device," as summarized by Patent Owner remarks for the limitation "**another programmed hardware computer system to take an action, based on first electronic profile data associated with the first device identifier, with respect to the second device, which is indicated at the time of the action by the second device identifier,**" as particularly recited in combination with other limitations, where their above noted remarks are persuasive.

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

11. 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/my_portal/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-

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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.

Other useful telephone numbers:

Reexamination Practice (571) 272-7703

Reexamination Facsimile Transmission No. (571) 273-9900

/Mark Sager/
Patent Reexamination Specialist, CRU
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Supervisory Patent Examiner, Art Unit 3992