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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 90/015,338 | 06/23/2025 | 8015006 | DIA006 | 3889 |

174899 7590 09/19/2025

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| EXAMINER | |
|---|---|
| CAMPBELL, JOSHUA D | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3992 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 09/19/2025 | 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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# *EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/015,338* .

PATENT UNDER REEXAMINATION *8015006* .

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 Request For Ex Parte Reexamination* | Control No. 90/015,338 | Patent Under Reexamination 8015006 | |
|---|---|---|---|
| | Examiner JOSHUA D CAMPBELL | Art Unit 3992 | AIA (FITF) Status No |

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

The request for *ex parte* reexamination filed 23 June 2025 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.

| /JOSHUA D CAMPBELL/<br>Primary Examiner, Art Unit 3992 | | |
|---|---|---|

cc:Requester ( if third party requester )

**Decision on Request**

1. A substantial new question (SNQ) of patentability affecting claims 1-5 of United States Patent Number 8,015,006 (hereinafter "the '006 Patent") is raised by the request for *ex parte* reexamination filed June 23, 2025.

***Information Disclosure Statement***

2. Where the IDS citations are submitted but not described, the examiner is only responsible for cursorily reviewing the references. The initials of the examiner on the PTO-1449 indicate only that degree of review unless the reference is either applied against the claims, or discussed by the examiner as pertinent art of interest, in a subsequent office action.

See Guidelines for Reexamination of Cases in View of In re Portola Packaging, Inc., 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997), 64 FR at 15347, 1223 Off. Gaz. Pat. Office at 125 (response to comment 6).

Consideration by the examiner of the information submitted in an IDS means that the examiner will consider the documents in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. The initials of the examiner placed adjacent to the citations on the PTO-1449 or PTO/SB/08A and 08B or its equivalent mean that the information has been considered by the examiner to the extent noted above.

Regarding IDS submissions MPEP 2256 recites the following: "Where patents, publications, and other such items of information are submitted by a party (patent owner) in compliance with the requirements of the rules, the requisite 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."

**Affidavits, Declarations, or Other Written Evidence**

3. The Examiner notes that affidavits or declarations or other written evidence which explain the contents or pertinent dates of prior art patents or printed publications in more detail may be considered in reexamination (see: MPEP 2258(I)(E)), but any rejection must be based upon the prior art patents or printed publications as explained by the affidavits or declarations or other written evidence. The rejection in such circumstances cannot be based on the affidavits or declarations or other written evidence as such, but must be based on the prior art patents or printed publications.

4. The Examiner recognizes that a declaration of Bruce McNair (Exhibit 1003) has been referenced in support of Third-Party Requester. The declaration has been considered and made of record. In the instant case, the submitted McNair Declaration at least further explains the contents of the prior art patents and printed publications in more detail.

**Prior art cited in the Request**

5. The present request indicates that the Requester considers that a substantial new question of patentability is raised as to claims 1-5 of the '006 Patent by the following prior art references:

a. **Weber** – U.S. Patent No. 6,532,444

b. **Strubbe** – U.S. Patent No. 6,731,307

c. **Arnold** – U.S. Patent No. 7,016,849

d. **Gao** – U.S. Patent No. 6,925,154

e. **Beutnagel** – U.S. Patent No. 6,078,885

**Prosecution History**

6. The '006 Patent application was assigned serial number 12/130,397 (hereinafter "the '397 application"), filed May 30, 2008. During the original prosecution, the '397 application initially included claims 18-32 following a preliminary amendment filed July 7, 2008. The '006 patent application is a

continuation of U.S. Patent application No. 10/452,147 (U.S. Patent No. 7,398,209), filed June 3, 2003. The '397 application also relies on provisional application No. 60/384,388, filed June 3, 2002.

In a first action mailed January 26, 2011, the previous examiner rejected claims 18 and 32 under 35 U.S.C 101. The previous examiner also rejected claims 18, 19, and 25 in view of Halverson, claims 22 and 23 in view of Halverson and Gorin, claim 26 in view of Halverson and Schuetze. Claims 20, 21, 24, 27, and 32 were found to be allowable if rewritten to overcome the rejection under 35 U.S.C. 101 and to include all of the limitations of the base claims and any intervening claims.

In response, the patent owner filed an amendment on April 25, 2011, amending claims 20-24 and 29-32 and cancelling claims 18, 19, and 25. Patent owner also presented arguments in view of the amendments. Patent owner amended claims 20, 21, 24, 27, and 31 to include all of the limitations of the base claims and any intervening claims as directed by the previous examiner.

In response to the amendments, the application was passed to allowance in the Notice of Allowance mailed May 9, 2011. The examiner stated that claims 20, 21, and 24 (Patent claim 1, 4, and 5) were allowed for the following reasons:

> *Independent claim 20 is allowable because the prior art of record does not disclose or reasonably suggest a combination of parsing to determine a meaning and a context of speech associated with a request involving a grammar by a domain agent, satisfying a predetermined confidence level, updating user specific vocabularies or dictionaries, and determining an identity of a user based on voice characteristics. Sabourin (U.S. Patent No. 6,208,964) teaches updating user specific vocabularies or dictionaries, but not in combination with satisfying a predetermined confidence level and determining an identity of the user based on voice characteristics of the user. Although determining an identity of a user based on voice characteristics is known individually for a voice profile, the prior art of record does not disclose or reasonably suggest that feature in combination with updating a user specific vocabulary when a predetermined confidence level is not met.*

*Independent claim 21 is allowable because the prior art of record does not disclose or reasonably suggest a combination of parsing to determine a meaning and a context of speech associated with a request involving a grammar by a domain agent, satisfying a predetermined confidence level, updating user specific vocabularies or dictionaries, and updating vocabulary information to indicate that spelling was used when the vocabulary item had to be spelled. Holthouse et al. (U.S. Patent No. 6,606,598) teaches that it is known to use confidence scores and thresholds to determine whether recognition is correct, and updating vocabulary information to indicate that spelling was used when the vocabulary item had to be spelled. Still, Holthouse et al. doesn't clearly disclose requesting the user to spell when the recognized words fail to satisfy a confidence level. While Marx et al. (U.S. Patent No. 6,173,266) suggests a spelling fallback method when a dialogue module is unable or unsure of a response, the prior art of record does not disclose or reasonably suggest updating vocabulary information from spelling when a confidence level is not met.*

*Independent claim 24 is allowable because the prior art of record does not disclose or reasonably suggest a combination of parsing to determine a meaning and a context of speech associated with a request involving a grammar by a domain agent, determining one or more required values and one or more optional values associated with a request in the grammar used by the domain agent, inferring one more further criteria and one or more further parameters associated with the request, and transforming the extracted criteria, extracted parameters, inferred criteria, and inferred parameters into tokens having a format compatible with the grammar used by the domain agent. It is known individually to provide grammars with required and optional values, and to infer criteria from a current context, but the prior art of record does not disclose or reasonably suggest at least a format transformation in combination.*

Thus, as it currently stands based on the prosecution history of the '397 application, it appears that the claims of the '006 Patent were allowed at least in part based on the following limitations:

*associating the one or more recognized words or phrases and a pronunciation associated with the one or more recognized words or phrases with the determined identity and the request contained in the utterance in response to the one or more recognized words or phrases satisfying a predetermined confidence level;* (patent claim 1)

*updating the information in the one or more dictionary and phrase tables based on a phonetic alphabet spelling associated with the one or more words or phrases, wherein the user provides the phonetic alphabet spelling in one or more subsequent natural language speech utterances;* (patent claim 4)

*transforming the one or more extracted criteria, the one or more extracted parameters, the one or more inferred criteria, and the one or more inferred parameters into one or more tokens having a format compatible with the grammar used by the domain agent, wherein the one or more tokens include all the required values and one or more of the optional values associated with formulating the request in the grammar used by the domain agent; processing the formulated request with the domain agent associated with the determined context to generate a response to the utterance; and presenting the generated response to the utterance via the speech unit.* (patent claim 5)

***Priority and Patent Term***

7. As mentioned above, the '006 Patent matured from the '397 application, which was a continuation of U.S. Patent application No. 10/452,147 (U.S. Patent No. 7,398,209), filed June 3, 2003. The '397 application also relies on provisional application No. 60/384,388, filed June 3, 2002.

8. MPEP 2701(I) and (IV) state the following:

*A patent granted on a continuation, divisional, or continuation-in-part application that was filed on or after June 8, 1995, will have a term which ends twenty years from the filing date of earliest*

*application for which a benefit is claimed under 35 U.S.C. 120, 121, 365(c), or 386(c) regardless of whether the application for which a benefit is claimed under 35 U.S.C. 120, 121, or 365(c) was filed prior to June 8, 1995.*

*Domestic benefit under 35 U.S.C. 119(e) to one or more U.S. provisional applications is not considered in the calculation of the twenty-year term. See 35 U.S.C. 154(a)(3).*

Based on the citation above, the '006 patent is expired. The term of twenty years from the filing date (based on the continuation filing date of June 3, 2003) plus the term adjustment of 617 days (February 9, 2025) of the '006 patent has passed.

9. 37 C.F.R. 1.530(j) states, "No enlargement of claim scope. No amendment may enlarge the scope of the claims of the patent or introduce new matter. ***No amendment may be proposed for entry in an expired patent. Moreover, no amendment, other than the cancellation of claims, will be incorporated into the patent by a certificate issued after the expiration of the patent.***" (emphasis added). Thus, because the patent is expired no amendments of the claims will be allowed aside from the cancellation of claims.

Additionally, in making the determination of whether to order reexamination, the Office will determine the proper meaning of the patent claims by giving the claims their broadest reasonable interpretation consistent with the specification (see In re Yamamoto, 740 F.2d 1569 (Fed. Cir. 1984)), except in the case of an expired patent (in a reexamination involving claims of an expired patent, claim construction is pursuant to the principle set forth by the court in Phillips v. AWH Corp., 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (words of a claim "are generally given their ordinary and customary meaning" as understood by a person of ordinary skill in the art in question at the time of the invention, see Ex parte Papst-Motoren, 1 USPQ2d 1655 (Bd. Pat. App. & Inter. 1986)).

**Substantial New Question of Patentability**

10. The italicized sections of claims 1, 4, and 5 are utilized by the examiner to show how specific teachings of the proposed references create a substantial new question of patentability.

1. A method for processing natural language speech utterances with context-specific domain agents, comprising:

receiving, at a speech unit coupled to a processing device, a natural language speech utterance that contains a request;

recognizing, at a speech recognition engine coupled to the processing device, one or more words or phrases contained in the utterance using information in one or more dictionary and phrase tables, wherein recognizing the one or more words or phrases contained in the utterance includes:

dynamically updating the information in the one or more dictionary and phrase tables based on a dynamic set of prior probabilities or fuzzy possibilities;

determining an identity associated with a user that spoke the utterance based on voice characteristics associated with the utterance; and

***associating the one or more recognized words or phrases and a pronunciation associated with the one or more recognized words or phrases with the determined identity and the request contained in the utterance in response to the one or more recognized words or phrases satisfying a predetermined confidence level;***

parsing, at a parser coupled to the processing device, the one or more recognized words or phrases to determine a meaning associated with the utterance and a context associated with the request contained in the utterance, wherein the one or more recognized words or phrases are further associated with the determined context in response to the one or more recognized words or phrases satisfying the predetermined confidence level;

formulating, at the parser, the request contained in the utterance in accordance with a grammar used by a domain agent associated with the determined context;

processing the formulated request with the domain agent associated with the determined context to generate a response to the utterance; and

presenting the generated response to the utterance via the speech unit.

4. A method for processing natural language speech utterances with context-specific domain agents, comprising:

receiving, at a speech unit coupled to a processing device, a natural language speech utterance that contains a request;

recognizing, at a speech recognition engine coupled to the processing device, one or more words or phrases contained in the utterance using information in one or more dictionary and phrase tables, wherein recognizing the one or more words or phrases contained in the utterance includes:

requesting a user that spoke the utterance to spell the one or more words or phrases in response to the one or more recognized words or phrases failing to satisfy a predetermined confidence level; and

***updating the information in the one or more dictionary and phrase tables based on a phonetic alphabet spelling associated with the one or more words or phrases, wherein the user provides the phonetic alphabet spelling in one or more subsequent natural language speech utterances;***

parsing, at a parser coupled to the processing device, the phonetic alphabet spelling associated with the one or more words or phrases to determine a meaning associated with the utterance and a context associated with the request contained in the utterance;

formulating, at the parser, the request contained in the utterance in accordance with a grammar used by a domain agent associated with the determined context;

processing the formulated request with the domain agent associated with the determined context to generate a response to the utterance; and

presenting the generated response to the utterance via the speech unit.

5. A method for processing natural language speech utterances with context-specific domain agents, comprising:

receiving, at a speech unit coupled to a processing device, a natural language speech utterance that contains a request;

recognizing, at a speech recognition engine coupled to the processing device, one or more words or phrases contained in the utterance using information in one or more dictionary and phrase tables;

parsing, at a parser coupled to the processing device, information relating to the utterance to determine a meaning associated with the utterance and a context associated with the request contained in the utterance, wherein the parsed information includes the one or more recognized words or phrases;

formulating, at the parser, the request contained in the utterance in accordance with a grammar used by a domain agent associated with the determined context, wherein formulating the request in accordance with the grammar used by the domain agent includes:

determining one or more required values and one or more optional values associated with formulating the request in the grammar used by the domain agent;

extracting one or more criteria and one or more parameters from one or more keywords contained in the one or more recognized words or phrases, wherein the parser extracts the one or more criteria and the one or more parameters using procedures sensitive to the determined context;

inferring one or more further criteria and one or more further parameters associated with the request using a dynamic set of prior probabilities or fuzzy possibilities; and

***transforming the one or more extracted criteria, the one or more extracted parameters, the one or more inferred criteria, and the one or more inferred parameters into one or more tokens having a format compatible with the grammar used by the domain agent, wherein the one or more tokens include all the required values and one or more of the optional values associated with formulating the request in the grammar used by the domain agent;***

processing the formulated request with the domain agent associated with the determined context to generate a response to the utterance; and

presenting the generated response to the utterance via the speech unit.

**Weber in view of Strubbe and Arnold (SNQ 1)**

11. The Request shows that Weber in view of Strubbe and Arnold provide teachings relevant to the determination of patentability regarding the following limitations, for claims 1 and 5:

*associating the one or more recognized words or phrases and a pronunciation associated with the one or more recognized words or phrases with the determined identity and the request contained in the utterance in response to the one or more recognized words or phrases satisfying a predetermined confidence level;*

Weber discloses determining if any of the possible matching entries has a confidence value greater than or equal to some predetermined threshold, using said threshold to decide whether or not the phrase matched any of the entries in the database (column 3, lines 47-53 and column 10, lines 13-29 of Weber).

Arnold discloses a "speaker adaptation" can be performed using parameters such as pronunciation (accents or dialect) of the speaker when performing speech recognition functions (column 5, lines 18-32 of Arnold).

Strubbe discloses a conversation simulator that is adapted to the identified user (column 13, lines 25-35 of Strubbe), including a "mood/personality classifier" which includes

classifiers such as "the pitch of the user's voice" (column 22, line 44-column 23, line 14 of Strubbe).

*transforming the one or more extracted criteria, the one or more extracted parameters, the one or more inferred criteria, and the one or more inferred parameters into one or more tokens having a format compatible with the grammar used by the domain agent, wherein the one or more tokens include all the required values and one or more of the optional values associated with formulating the request in the grammar used by the domain agent;*

Weber discloses weighting individual words based on their relative importance or significance to the overall meaning of a phrase by a "word weighter", this allows for more powerful searching of the NLP database (column 9, lines 39-51 of Weber).

Strubbe discloses receiving data requests from an input parser and generating an agent to obtain information from a data resource (column 20, lines 45-52 of Strubbe).

Arnold discloses extracting and inferring certain criteria and parameters (column 5, line 33-column 6, line 12 and column 11, lines 33-38 of Arnold).

The Weber, Strubbe, and Arnold references were cited on information disclosure statement during the original prosecution of the '006 patent and were considered by the previous Examiner and thus are "old art", however, none of these three references nor their combination were discussed on the record during previous examination of the patent. Accordingly, Webber, Strubbe and Arnold are now being considered in a new light/different way from their previous consideration in view of the new material new argument presented in the request (see MPEP 2242(II)(A)).

It is agreed that the combination of Weber, Strubbe, and Arnold raises a substantial new question of patentability with respect to at least independent claims 1 and 5 of the '006 Patent. There is a substantial likelihood that an examiner would consider these new, non-cumulative technological teachings important in deciding whether or not these claims are patentable.

Accordingly, the combination of Weber, Strubbe, and Arnold raises a substantial new question of patentability with respect to at least claims 1-3 and 5 of the '006 Patent, a question which has not been decided in a previous examination of the '006 Patent nor was there a final holding of invalidity by the Federal Courts regarding the '006 Patent.

**Weber in view of Strubbe, Gao, and Beutnagel (SNQ 2)**

12. The Request shows that Weber in view of Strubbe, Gao, and Beutnagel provide teachings relevant to the determination of patentability regarding the following limitations, for claim 4:

*updating the information in the one or more dictionary and phrase tables based on a phonetic alphabet spelling associated with the one or more words or phrases, wherein the user provides the phonetic alphabet spelling in one or more subsequent natural language speech utterances;*

Weber discloses prompting a user for additional information if a matching entry is not a correct interpretation of an utterance and updating the database with said additional information. Weber discusses that this allows the system to adaptively learn the meaning of additional utterances (column 3, lines 54-65 of Weber).

Gao discloses prompting a user to spell out a name to distinguish the desired name when several names obtain relatively close scored during speech recognition (column 10, line 66-column 11, line 8 of Gao).

Beutnagel discloses allows a user to update speech recognition engine to revise "phonetic transcription" of words in dictionary or add transcriptions for words not present in the dictionary (column 2, lines 57-64 of Beutnagel).

The Weber, Strubbe, and Arnold references were cited on information disclosure statement during the original prosecution of the '006 patent and were considered by the previous Examiner and thus are "old art", however, none of these three references nor their combination with the Beutnagel reference were discussed on the record during previous examination of the patent. Accordingly, Webber, Strubbe

and Arnold are now being considered in a new light/different way from their previous consideration in view of the new material new argument presented in the request (see MPEP 2242(II)(A)). The Beutnagel reference was not previously discussed by the previous examiner nor applied to claim 4 in the prior examination of the patent.

It is agreed that the combination of Weber, Strubbe, Gao, and Beutnagel raises a substantial new question of patentability with respect to at least independent claim 4 of the '006 Patent. There is a substantial likelihood that an examiner would consider these new, non-cumulative technological teachings important in deciding whether or not these claims are patentable.

Accordingly, the combination of Weber, Strubbe, Gao, and Beutnagel raises a substantial new question of patentability with respect to at least claim 4 of the '006 Patent, a question which has not been decided in a previous examination of the '006 Patent nor was there a final holding of invalidity by the Federal Courts regarding the '006 Patent.

**Scope of Reexamination**

13. Claims 1-5 will be reexamined as requested.

**35 U.S.C. § 325(d)**

14. Section 325(d) of 35 U.S.C. states in part that "[i]n determining whether to institute or order proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office." Thus, pursuant to the statute, in order for the Director to exercise discretion as to whether to Order a reexamination proceeding under chapter 30, the request must first be determined to be based on the same or substantially the same prior art or arguments that were previously presented to the Office.

As of the filing of the instant Request, a review of the post grant history of the '006 Patent indicates that the patent was the subject of a single prior Office post grant challenge that has been

decided, and after the filing of the instant Request, a second, pending post grant challenge not yet decided.

On April 5, 2024, a Petition for *inter partes* review of the '006 Patent was filed with the Patent Trial and Appeal Board ("Board") and assigned number IPR2024-00748 ("the '748 IPR"). The Petition in the '748 IPR presented the following challenges on which a reasonable likelihood of prevailing ("RLP") were reviewed.

| RLP # | Claim(s) Challenged | 35 U.S.C. § | References |
|---|---|---|---|
| 1 | 1-3 | 103(a)[1] | Coffman[2], Kanevsky[3], Kneser[4], Zadrozny[5] |
| 2 | 4 | 103(a) | Coffman, Kanevsky, Kneser, Zadrozny, Maes '101[6], Franceschi[7] |
| 3 | 5 | 103(a) | Coffman, Kanevsky, Kneser, Zadrozny, Chai[8] |
| 4 | 6, 9 | 103(a) | Coffman, Kanevsky, Kneser, Zadrozny, Redfern[9] |

In the '748 IPR, the Board denied institution as explained in the Decision Denying Institution of the *Inter Partes* Review ("Dec. Denying Inst.") entered Oct. 11, 2024. In particular, the Board found that Coffman does not adequately describe the "domain agent associated with the determined context," as recited in the claims, and thus, "the record does not demonstrate a reasonable likelihood that Petitioner

[1] The Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), revised 35 U.S.C. § 103, effective March 16, 2013. The '006 patent's filing date is before March 16, 2013, so the pre-AIA version of § 103 applies.
[2] Coffman et al., International Patent Application Publication No. WO 00/20962, ("Coffman").
[3] Kanevsky et al., U.S. Patent No. 5,897,616, ("Kanevsky").
[4] Kneser et al., U.S. Patent No. 6,157,912, ("Kneser").
[5] Zadrozny et al., NL Understanding with a Grammar of Constructions, Coling 94: The 15th International Conference on Computational Linguistics, 1994 ("Zadrozny").
[6] Maes, U.S. Patent No. 6,073,101, ("Maes '101").
[7] Franceschi, U.S. Patent No. 6,321,196 B1, ("Franceschi").
[8] Chai et al., U.S. Patent No. 6,829,603 B1, ("Chai").
[9] Redfern, U.S. Patent No. 6,078,914, ("Redfern").

would prevail with respect to at least one challenged claim, so we deny institution of the petitioned *inter partes* review per 35 U.S.C. § 314(a)." Dec. Denying Inst. 20; *see also id.* at 16-17.

On August 15, 2025, another *inter partes* review petition was filed and assigned number IPR2025-01335 ("the '1335 IPR") but has not yet been decided by the Board. The Petition in the '1335 IPR presents the following challenges on which RLPs are to be reviewed.

| RLP # | Claim(s) Challenged | 35 U.S.C. § | References |
|---|---|---|---|
| 1 | 5 | 103(a) | Ross '723[10], Ittycheriah[11], and Ross '018[12] |
| 2 | 6 | 103(a) | Ross '723 and Aridor[13] |
| 3 | 5 | 103(a) | Hartono[14] and Baker[15] |
| 4 | 6 | 103(a) | Hartono and Aridor |

A comparison between the prior art presented in the instant *ex parte* reexamination request (90/015,338) and the prior '748 IPR petition and the pending '1335 IPR petition indicates that the Request is based on different prior art and arguments than was previously presented in the prior discretionarily denied '748 IPR petition and is presented in the pending '1335 IPR petition. As noted above, the current Request presents the following grounds as raising a substantial new question ("SNQ") of patentability for claims 1-4 and 5 of the '006 Patent.

| SNQ # | Claim(s) Challenged | 35 U.S.C. § | References |
|---|---|---|---|
| 1 | 1-3, 5 | 103(a) | Weber, Strubbe, and Arnold |
| 2 | 4 | 103(a) | Weber, Strubbe, Gao, and Beutnagel |

The following facts are relevant to the 325(d) analysis. The prior art in the Request does not overlap with the prior art presented in the '748 IPR petition. Since the '1335 IPR petition was filed after the filing of the current Request, the threshold that "the same or substantially the same prior art or arguments *previously were* presented to the Office" is not met. The prior art in the Request does not

[10] Ross et al., U.S. Patent No. 7,085,723, ("Ross '723").
[11] Ittycheriah et al., U.S. Patent No. 5,937,383, ("Ittycheriah").
[12] Ross et al., U.S. Patent No. 7,249,018, ("Ross '018").
[13] Aridor et al., U.S. Patent No. 6,636,848, ("Aridor").
[14] Hartono et al., International Patent Application Publication No. WO 00/11571, ("Hartono").
[15] Baker et al., U.S. Patent No. 5,680,511, ("Baker").

overlap with the prior art presented in the '1335 IPR petition. The instant Request presents new/additional arguments that were not presented in the '748 IPR petition. Specifically, with respect to the claimed "domain agent" that the Board found not taught by at least Coffman in the '748 IPR petition, the Request argues and the Examiner finds that the "domain agent" limitation is taught in at least Webber's "word weighter" (col. 9, ll. 39-51), and Strubbe's generating an agent to obtain information from a data resource (col. 20, ll. 45-52), as explained above.

For these reasons, the Request presents SNQs over prior art and arguments that have not yet been presented to the Office. As a result, the threshold for discretionary denial under 35 USC 325(d) of the *ex parte* reexamination request is not met, and *ex parte* Reexamination is Ordered based on the determination above that the Request raises a substantial new question of patentability of the '006 Patent.

***Conclusion***

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. 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. 8,015,006 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.

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

Electronically: Registered users may submit via Patent Center at https://patentcenter.uspto.gov/.

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
Knox Building
501 Dulany Street
Alexandria, VA 22314

For Patent Center 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 date of transmission, which is prior to the expiration of the set period of time in the Office action.

Any inquiry concerning this communication should be directed to Joshua Campbell at telephone number (571) 272-4133.

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