	Control No.	Patent Under Reexamination
Order Granting / Denying Request For	90/008,779	6199048
Ex Parte Reexamination	Examiner	Art Unit
	Anjan K. Deb	3992
The MAILING DATE of this communication app	ears on the cover sheet	with the correspondence address
The request for <i>ex parte</i> reexamination filed <u>26</u> been made. An identification of the claims, the determination are attached.	<u>S July 2007</u> has been co references relied upon,	onsidered and a determination has and the rationale supporting the
Attachments: a) PTO-892, b) PT	ſO/SB/08, c)⊠ (	Other: <u>1449/PTO</u>
1. The request for <i>ex parte</i> reexamination is	GRANTED.	
RESPONSE TIMES ARE SET AS F	FOLLOWS:	
For Patent Owner's Statement (Optional): TW (37 CFR 1.530 (b)). EXTENSIONS OF TIME /		
For Requester's Reply (optional): TWO MON Patent Owner's Statement (37 CFR 1.535). <b>N</b> If Patent Owner does not file a timely stateme is permitted.	O EXTENSION OF TH	S TIME PERIOD IS PERMITTED.
2. The request for <i>ex parte</i> reexamination is	DENIED.	
This decision is not appealable (35 U.S.C. 303 Commissioner under 37 CFR 1.181 within ON CFR 1.515(c)). EXTENSION OF TIME TO FIL AVAILABLE ONLY BY PETITION TO SUSPE 37 CFR 1.183.	E MONTH from the ma E SUCH A PETITION	iling date of this communication (37 UNDER 37 CFR 1.181 ARE
In due course, a refund under 37 CFR 1.26 (	c ) will be made to requ	ester:
a) 🗌 by Treasury check or,		*
b) 🗌 by credit to Deposit Account No	, or	
c) 🗌 by credit to a credit card account, u	nless otherwise notified	(35 U.S.C. 303(c)).
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		Aujoulu Del-
		Anjan K Deb Primary Examiner
cc:Requester ( if third party requester )		Art Unit: 2858

U.S. Patent and Trademark Office PTOL-471 (Rev. 08-06)

Office Action in Ex Parte Reexamination

Part of Paper No. 20071010

## DECISION GRANTING EX PARTE REEXAMINATION

#### **Decision on Request**

A substantial new question of patentability affecting claims 1-95 of United States Patent Number 6,199,048, to Hudetz et al., is raised by the request for *ex parte* reexamination.

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

### Summary

The examiner considers a substantial new question of patentability has been raised by at least the following prior art references:

US Patent No. 5,640,193 (Wellner et al.)

US Patent No. 4,780,599 (Bauss)

### Background

Claims 1-95 are the current claims in the US Patent No. 6,199,048 which issued March 6, 2001 from application 09/232,908 filed January 15, 1999, which is a division of application 08/538,365 filed 10/03/1995, which claimed priority from Provisional Application 60/000,442, filed 6/20/1995.

In the first action on the merits in 09/232,908, original claims 1-4 were rejected as being obvious over Beller et al. US 5,978,773 in view of Diolin, Jr. US 5,519,878 and the remaining claims 5-11 were objected to as being dependent on the rejected claims but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In response, applicant cancelled claims 1-11 and filed new claims that were allowed and renumbered claims 1-95. The present request alleges all claims (1-95) of US Patent Number 6,199,048 are unpatentable.

### Substantial New Questions of Patentability

The request indicates (p. 3, 12) that Requester considers that claims 1-9, 16-22, 25-44, 51-57, 60-79, 86-87 and 90-95 to be unpatentable over Wellner et al. (US 5,640,193).

It is agreed that the consideration of Wellner et al. patent raises a substantial new question of patentability with respect to at least claims 1-9, 16-22, 25-44, 51-57, 60-79, 86-87 and 90-95 of the Hudetz et al. patent (US 6,199,048).

Wellner et al. teaches, reading data from a marked object by an input device (scanner), accessing a database (server) based on the read "mark", producing an object code corresponding to the read mark, and communicating the object code to remote computer (other servers) to select information about the object from multimedia service available from the server so as to provide the information to a user. This teaching was not present during the prosecution of the application, which became the Hudetz et al. patent. Further, there is

substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not the claims are patentable. Accordingly, Wellner et al., raises a substantial new question of patentability with respect to at least claims 1-9, 16-22, 25-44, 51-57, 60-79, 86-87 and 90-95, which question has not been decided in a previous examination of the Hudetz et al. patent.

The request indicates (p. 35) that Requester considers that claims 1-95 to be unpatentable over Wellner et al. (US 5,640,193) in combination with additional prior art references.

Wellner disclosed the use of pointer and URL but did not expressly disclose the use of Internet technologies and resolving a URL through DNS lookup and then accessing the resource pointed by the URL. Additionally, Berners-Lee et al., RFC 1738 teaches that user could enter a URL into a web browser and the web browser would automatically download the network resource associated with the URL using a combination of Internet technologies such as DNS. This process of resolving a URL through a DNS lookup and then accessing the resource pointed to by the URL was not present in the application, which became US Patent 6,199,048. Each of the Wellner et al. (US 5,640,193) and Berners-Lee et al., RFC 1738 references was not of record during the prosecution of US Patent 6,199,048 and there is a substantial likelihood that a reasonable Examiner would have considered the use of pointers and URL in a web browser using Internet technologies such as DNS in determining the patentability of the claims of the application which became US Patent 6,199,048. Accordingly, the Wellner et al. patent and the Berners-Lee et al., RFC 1738

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references raises a substantial new question of patentability with respect to claims 1-95 which question has not been decided in a previous examination of the Hudetz et al. patent.

The request indicates (p. 4, 75) that Requester considers that claims 1-4, 6-9, 15-17, 22-26, 34, 36-39, 41-44, 50-52, 57-61, 69, 71-74, 76-79, and 85-90 to be unpatentable over Bauss (US 4,780,599).

It is agreed that the consideration of Bauss patent raises a substantial new question of patentability with respect to at least claims 1-4, 6-9, 15-17, 22-26, 34, 36-39, 41-44, 50-52, 57-61, 69, 71-74, 76-79, and 85-90 of the Hudetz et al. patent (US 6,199,048).

Bauss teaches, reading device (scanning gun) for reading codings on saleable goods, a data processing unit comprises a coding unit which includes means for producing an address in response to the coding read by the reading device and communicating the address to a storage unit for supplying the information corresponding to the address signal to an output unit to provide the information to a user. Bauss specifically disclosed the use of pointers for locating and displaying object of interest to the user. This teaching was not present during the prosecution of the application, which became the Hudetz et al. patent. Further, there is substantial likelihood that a reasonable examiner would consider this teaching important in deciding whether or not the claims are patentable. Accordingly, Bauss raises a substantial new question of patentability with respect to at least claims 1-4, 6-9, 15-17, 22-26, 34, 36-39, 41-44, 50-52, 57-61, 69, 71-74, 76-79, and 85-90, which question has not been decided in a previous examination of the Hudetz et al. patent.

The request indicates (p. 5) that Requester considers that claims 1-3, 18-21, 27, 30-31, 34, 36-38, 53-56, 62, 65-66, 69, 71-73, 91, 95-95 are obvious over Bauss (US 4,780,599) in view of RFC 1738 [Appendix O], HTTP 1991 [Appendix P], RFC 1034 [Appendix Q] and RFC 1035 [Appendix R].

Bauss teaches, reading device for reading codings on saleable goods (abstract), a data processing unit that pairs codes with addresses to a storage unit (column 2 lines 57-66) and an output device that displays the information obtained from storage unit (column 3 lines 50-53).

Since this teaching is directly related to subject matter considered as the basis for allowability of the patent claims, a reasonable examiner would consider evaluation of the Bauss reference as important in determining the patentability of the claims. Additionally, Berners-Lee et al., RFC 1738 teaches that user could enter a URL into a web browser and the web browser would automatically download the network resource associated with the URL using a combination of Internet technologies such as DNS. This process of resolving a URL through a DNS lookup and then accessing the resource pointed to by the URL was not present in the application, which became US Patent 6,199,048.

Each of the Bauss (US 4,780,599) and Berners-Lee et al., RFC 1738 references was not of record during the prosecution of US Patent 6,199,048 and there is a substantial likelihood that a reasonable Examiner would have considered these references in determining the patentability of the claims of the application which became US Patent 6,199,048. Accordingly, the Bauss patent (US 4,780,599) and the Berners-Lee et al., RFC 1738 references raises a substantial new

question of patentability with respect to at least claims 28, 63, and 92 which question has not been decided in a previous examination of the Hudetz et al. patent.

The request indicates (p. 5) that Requester considers that claims 4, 6-9, 22-25, 39, 41-44, 57-60, 74, 76-79, and 88-89 are obvious over Bauss (US 4,780,599) in view of U.S. Patent No. 5,420,943 and U.S. Patent No. 3,961,164.

Bauss disclosed reading bar codes found on goods, which correspond to the claimed UPC code, EAN code or ISBN code.

U.S. Patent No. 5,420,943 further disclosed using standardized bar codes and U.S. Patent No. 3,961,164 disclosed using UPC code.

This process of using standardized bar codes comprising UPC code, EAN code or ISBN code was not present in the application, which became US Patent 6,199,048.

Each of the patents (US 4,780,599), (US 5,420,943) and US (3,961,164) was not of record during the prosecution of US Patent 6,199,048 and there is a substantial likelihood that a reasonable Examiner would have considered these references in determining the patentability of the claims of the application which became US Patent 6,199,048. Accordingly, the patents (US 4,780,599), (US 5,420,943), US (3,961,164) raises a substantial new question of patentability with respect to at least claims 4, 6-9, 22-25, 39, 41-44, 57-60, 74, 76-79, and 88-89 which question has not been decided in a previous examination of the Hudetz et al. patent.

The request indicates (p. 5) that Requester considers that claims 5, 40, and 75 are obvious over Bauss (US 4,780,599) in view of U.S. Patent No. 5,640,193 and U.S. Patent No. 5,373,550.

Bauss teaches optical reader for reading codes on objects and US patent No 5,640,193 teaches the use of scanners that read bar-code on objects, additionally US patent No. 5,373,550 discloses the use of character recognition to read image data to determine its destination.

Each of the patents (US 4,780,599), (US 5,640,193) and (US 5,373,550) was not of record during the prosecution of US Patent 6,199,048 and there is a substantial likelihood that a reasonable Examiner would have considered these references in determining the patentability of the claims 5, 40, and 75 of the application which became US Patent 6,199,048. Accordingly, the patents (US 4,780,599), (US 5,640,193) and (US 5,373,550) raises a substantial new question of patentability with respect to at least claims 5, 40, and 75 which question has not been decided in a previous examination of the Hudetz et al. patent.

The request indicates (p. 5) that Requester considers that claims 10-14, 45-49, and 80-84 are obvious over Bauss (US 4,780,599) in view of U.S. Patent No. 5,420,943, U.S. Patent No. 5,111,391, and U.S. Patent No. 4,796,292.

Bauss teaches optical reader for reading codes from an object, U.S. Patent No. 5,420,943 and U.S. Patent No. 5,111,391 teaches variety of input mechanisms for making connection to computer, additionally U.S. Patent No. 4,796,292 teaches the use of reading a magnetic card for making network connection.

Each of the patents (US 4,780,599), (US 5,420,943), (US 5,111,391) and (US 4,796,292) was not of record during the prosecution of US Patent 6,199,048 and there is a substantial likelihood that a reasonable Examiner would have considered the teachings of providing a variety of input mechanisms for making connection to computer in determining the

patentability of the claims 10-14, 45-49, and 80-84 of the application which became US Patent 6,199,048. Accordingly, the patents (US 4,780,599), (US 5,420,943), (US 5,111,391) and (US 4,796,292) raises substantial new question of patentability with respect to at least claims 10-14, 45-49, and 80-84 which question has not been decided in a previous examination of the Hudetz et al. patent.

The request indicates (p. 5) that Requester considers that claims 15, 50, and 85 are obvious over Bauss (US 4,780,599) in view of U.S. Patent 4,907,264 [Appendix D].

Bauss teaches accessing the database by handheld device, and U.S. Patent No. 4,907,264 teaches bar code reader for accessing a database.

Each of the patents (US 4,780,599) and (US 4,907,264) was not of record during the prosecution of US Patent 6,199,048 and there is a substantial likelihood that a reasonable Examiner would have considered these references in determining the patentability of the claims 15, 50, and 85 of the application which became US Patent 6,199,048. Accordingly, the patents (US 4,780,599) and (US 4,907,264) raises substantial new question of patentability with respect to at least claims 15, 50, and 85 which question has not been decided in a previous examination of the Hudetz et al. patent.

The request indicates (p. 5) that Requester considers that claims 16, 32, 51, 67 and 86 are obvious over Bauss (US 4,780,599) in view of U.S. Patent No. 5,420,943.

Bauss disclosed that data processing and storage unit may reside in different locations, additionally U.S. Patent No. 5,420,943 disclosed bar code is scanned and remote database is

connected. Therefore it would have been obvious for one of ordinary skill in the art to host the remote database through a service provider in order to utilize the database.

Each of the patents (US 4,780,599) and U.S. Patent No. 5,420,943 was not of record during the prosecution of US Patent 6,199,048 and there is a substantial likelihood that a reasonable Examiner would have considered these references in determining the patentability of the claims 16, 32, 51, 67 and 86 of the application, which became US Patent 6,199,048. Accordingly, the patents (US 4,780,599), (US 5,420,943) raises substantial new question of patentability with respect to at least claims 16, 32, 51, 67 and 86 which question has not been decided in a previous examination of the Hudetz et al. patent.

The request indicates (p. 5) that Requester considers that claims 17, 52, and 87 are obvious over Bauss (US 4,780,599) in view of U.S. Patent No. 5,398,336.

Bauss disclosed database existing across multiple computers, additionally U.S. Patent No. 5,398,336 disclosed factory management software comprising database located in more than one computer and accessed by scanning bar codes.

Each of the patents (US 4,780,599), (US 5,398,336) was not of record during the prosecution of US Patent 6,199,048 and there is a substantial likelihood that a reasonable Examiner would have considered these teachings of locating database in more than one computer and accessing the database by scanning bar code in determining the patentability of the claims 17, 52, and 87 of the application which became US Patent 6,199,048. Accordingly, the patents (US 4,780,599), (US 5,420,943) raises substantial new question of patentability with respect to at

least claims 17, 52, and 87 which question has not been decided in a previous examination of the Hudetz et al. patent.

The request indicates (p. 5) that Requester considers that claims 26, 61, and 90 are obvious over Bauss (US 4,780,599) in view of U.S. Patent No. 5,115,326 and European Patent No. 0 465 011.

Bauss disclosed an autonomous system for communicating information to user, additionally U.S. Patent No. 5,115,326 and European Patent No. 0 465 011 disclosed scanning bar codes on faxes to automatically forward fax to e-mail address corresponding to scanned bar code.

Each of the patents (US 4,780,599) and (US 5,115,326) and European Patent No. 0 465,011 was not of record during the prosecution of US Patent 6,199,048 and there is a substantial likelihood that a reasonable Examiner would have considered the teaching of automatically forwarding fax to e-mail address to remote computer by scanning a bar code in the fax in determining the patentability of the claims 26, 61, and 90 of the application which became US Patent 6,199,048. Accordingly, the patents (US 4,780,599), (US 5,115,326) and European Patent No. 0 465,011 raises a substantial new question of patentability with respect to at least claims 26, 61, and 90 which question has not been decided in a previous examination of the Hudetz et al. patent.

The request indicates (p. 5) that Requester considers that claims 28, 63, and 92 are obvious over the Bauss (US 4,780,599) in view of B. Ibrahim (Computer Networks and ISDN Systems).

Bauss disclosed control means to trigger information from storage unit, additionally B. Ibrahim disclosed HTML and hyperlinks are used to display information to user.

Each of the patent (US 4,780,599) and the reference B. Ibrahim (Computer Networks and ISDN Systems) was not of record during the prosecution of US Patent 6,199,048 and there is a substantial likelihood that a reasonable Examiner would have considered the teaching of HTML and hyperlinks that are used to display information to user in determining the patentability of the claims 28, 63, and 92 of the application which became US Patent 6,199,048. Accordingly, the patents patent (US 4,780,599) and the reference B. Ibrahim (Computer Networks and ISDN Systems) raises a substantial new question of patentability with respect to at least claims 28, 63, and 92 which question has not been decided in a previous examination of the Hudetz et al. patent.

The request indicates (p. 136) that Requester considers that Claims 29, 64, and 93 are obvious over Bauss (US 4,780,599) in view of U.S. Patent No. 5,115,326, European Patent No. 0 465 011, and U.S. Patent No. 5,398,336.

Bauss disclosed storage units for supplying information to user in response to the coding read by a reading device. Additionally, U.S. Patent No. 5,115,326 and European Patent No. 0 465 011 disclosed scanning a bar code on incoming fax and forwarding the fax to an e-mail

address on a LAN, WAN or other networks, and U.S. Patent No. 5,398,336 disclosed computers running management software have access to wide area network.

Each of the patents (US 4,780,599), (US 5,115,326), (US 5,398,336) and European Patent No. 0 465, 011 was not of record during the prosecution of US Patent 6,199,048 and there is a substantial likelihood that a reasonable Examiner would have considered the teaching of computers comprising wide area networks for enhancing storage capacity in determining the patentability of the claims 29, 64, and 93 of the application which became US Patent 6,199,048. Accordingly, the patents (US 4,780,599), (US 5,115,326), (US 5,398,336) and European Patent No. 0 465, 011 raises a substantial new question of patentability with respect to at least claims 29, 64, and 93 which question has not been decided in a previous examination of the Hudetz et al. patent.

The request indicates (p. 138) that Requester considers that claims 33 and 68 are obvious over Bauss (US 4,780,599) in view of U.S. Patent No. 5,606,668.

Bauss did not expressly disclose that the computer provides a gateway to the Internet. Additionally, U.S. Patent No. 5,606,668 disclosed network that provides access to the Internet through a gateway.

Each of the patents (US 4,780,599) and (US 5,606,668), was not of record during the prosecution of US Patent 6,199,048 and there is a substantial likelihood that a reasonable Examiner would have considered the teaching of computer network that provides access to the internet through a gateway for communication. Accordingly, the patents (US 4,780,599) and (US 5,606,668), raises a substantial new question of patentability with respect to at least

claims 33 and 68 which question has not been decided in a previous examination of the Hudetz et al. patent.

The request indicates (p. 138) that Requester considers that claims 35 and 70 are obvious over Bauss (US 4,780,599) in view of U.S. Patent No. 5,331,547, Internet-On-A-Disk #7 [Appendix L], and NL-KR Digest [Appendix M].

Bauss did not expressly disclose that the database is associated with search engine. Additionally, U.S. Patent No. 5,331,547, disclosed a search process initiated by scanning barcode and the prior art references Internet-On-A-Disk #7, and NL-KR Digest disclosed the use of internet based search engines.

Each of the patents (US 4,780,599), (US 5,331,547), and the prior art references Internet-On-A-Disk #7, and NL-KR Digest was not of record during the prosecution of US Patent 6,199,048 and there is a substantial likelihood that a reasonable Examiner would have considered the teaching of search process initiated by scanning bar-code and the use of internet based search engines for searching database distributed across a network of computers. Accordingly, the patents (US 4,780,599), (US 5,331,547), and the prior art references Internet-On-A-Disk #7, and NL-KR Digest raises a substantial new question of patentability with respect to at least claims 35 and 70 which question has not been decided in a previous examination of the Hudetz et al. patent.

All claims 1-95 will be examined.

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

Any inquiry concerning this communication should be directed to the Central

Reexamination Unit at telephone number (571) 272-7705.

Aujanlu D.b\_

Anjan K. Deb, P.E, Ph.D. Primary Patent Examiner Art Unit 2992 571-272-2228

Conferees:

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Approved for use through 07/31/2006. OMB 0651-0031

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\*EXAMINER: Initial If reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicent. 1 Applicant's unique citation designation number (optional). 2 See Kinds Codes of USPTO Patent Documents at <u>www.uspto.gov</u> or MPEP 901.04. 3 Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). 4 For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. 5 Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. 6 Applicant is to place a check mark here if English language Translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the Individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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STATEMENT BY APPLICANT			PPLICANT	First Named Inventor	F. Hudetz
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Sheet	2	of	2	Attorney Docket Number	0504-001

Examiner Initials*	Cite No.1	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T2
/A.D./	L	ANONYMOUS, Internet-On-A-Disk #7, December 3, 1994.	
	м	ANONYMOUS, NL-KR Digest, October 3, 1988.	
	N	B. IBRAHIM, Computer Networks and ISDN Systems, North Holland Publishing, November 1994,.	
	0	T. BERNERS-LEE, L. MASINTER, M. MCCAHILL, Uniform Resource Locators (URL), Network Working Group, Request for Comments 1738, December 1994.	
	Ρ	T. BERNERS-LEE, The Original HTTP as defined in 1991.	
	۵	P. MOCKAPETRIS, Domain Names- Concepts and Facilities, Network Working Group, Request for Comments 1034, November 1987.	
V	R	P. MOCKAPETRIS, Domain Names- Implementation and Specification, Network Working Group, Request for Comments 1034, November 1987.	
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	Examiner Signature	/Anjan Deb/	Date Considered	10/11/2007
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considered. Include copy of this form with next communication to applicant. 1 Applicant's unique citation designation number (optional). 2 Applicant is to place a check mark here if English language Translation is attached. This collection of information is required by 37 CFR 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: **Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450**.

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