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ROBERT S. BLASI, ESQ.  
GOODWIN PROCTOR LLP  
EXCHANGE PLACE  
53 STATE STREET  
BOSTON, MA 02109

EXAMINER

LEE, CHRISTOPHER E.

ART UNIT      PAPER

3992

DATE MAILED

JUL 03 2010

CENTRAL REEXAMINATION UNIT

**INTER PARTES REEXAMINATION  
COMMUNICATION**

BELOW/ATTACHED YOU WILL FIND A COMMUNICATION FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE OFFICIAL(S) IN CHARGE OF THE PRESENT REEXAMINATION PROCEEDING.

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

<b>INTER PARTES REEXAMINATION COMMUNICATION</b>	<b>Control No.</b>	<b>Patent Under Reexamination</b>	
	95/001,018	6,928,479	
	<b>Examiner</b>	<b>Art Unit</b>	
	Christopher E. Lee	3992	

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

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE  
 1 MONTH(S)  THIRTY DAYS FROM THE MAILING DATE OF THIS LETTER. EXTENSIONS  
OF TIME FOR PATENT OWNER ARE GOVERNED BY 37 CFR 1.956.

Each time the patent owner responds to this Office action, the third party requester of the *inter partes* reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

**All correspondence** relating to this *inter partes* 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.

**Right of Appeal Notice  
(37 CFR 1.953)**

Control No.	Patent Under Reexamination	
95/001,018	6,928,479	
Examiner	Art Unit	
Christopher E. Lee	3992	

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

Responsive to the communication(s) filed by:  
Patent Owner on 19 September 2009  
Third Party(ies) on 19 October 2009

Patent owner and/or third party requester(s) may file a notice of appeal with respect to any adverse decision with payment of the fee set forth in 37 CFR 41.20(b)(1) within **one-month or thirty-days (whichever is longer)**. See MPEP 2671. In addition, a party may file a notice of **cross** appeal and pay the 37 CFR 41.20(b)(1) fee **within fourteen days of service** of an opposing party's timely filed notice of appeal. See MPEP 2672.

**All correspondence** relating to this inter partes 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.

If no party timely files a notice of appeal, prosecution on the merits of this reexamination proceeding will be concluded, and the Director of the USPTO will proceed to issue and publish a certificate under 37 CFR 1.997 in accordance with this Office action.

The proposed amendment filed 19 September 2009  will be entered  will not be entered\*

\*Reasons for non-entry are given in the body of this notice.

- 1a.  Claims 1-11,20-33 and 42-46 are subject to reexamination.
- 1b.  Claims 12-19 and 34-41 are not subject to reexamination.
2.  Claims \_\_\_\_\_ have been cancelled.
3.  Claims 1-6,20-30 and 42-45 are confirmed. [Unamended patent claims].
4.  Claims 7-11,31-33 and 46 are patentable. [Amended or new claims].
5.  Claims \_\_\_\_\_ are rejected.
6.  Claims \_\_\_\_\_ are objected to.
7.  The drawings filed on \_\_\_\_\_  are acceptable.  are not acceptable.
8.  The drawing correction request filed on \_\_\_\_\_ is  approved.  disapproved.
9.  Acknowledgment is made of the claim for priority under 35 U.S.C. 119 (a)-(d) or (f). The certified copy has:  
 been received.  not been received.  been filed in Application/Control No. \_\_\_\_\_.
10.  Other \_\_\_\_\_

**Attachments**

1.  Notice of References Cited by Examiner, PTO-892
2.  Information Disclosure Citation, PTO/SB/08
3.  \_\_\_\_\_

**DETAILED ACTION**

1. This is an *Inter Partes* Reexamination of Meyer et al. [US 6,928,479 B1; hereinafter '479 Patent].

***Receipt Acknowledgement***

2. Receipts are acknowledged of Patent Owner's response filed on 19<sup>th</sup> of September 2009 (hereinafter "the Response") and Third Party requester's comments filed on 19<sup>th</sup> of October 2009 (hereinafter "the Comments") to the *Inter Partes* REX ACP Office Action mailed on 19<sup>th</sup> of August 2009 (hereinafter "the previous Office action"). Claims 7, 8, and 31 have been amended; claims 47-100 have been canceled; and no claim has been newly added since the previous Office action was mailed. Currently, the claims 1-11, 20-33, and 42-46 are subject to reexamination in this *inter partes* reexamination proceedings.

***Statutory Basis for Grounds of Rejections - 35 USC §102 and §103***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This patent under reexamination currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Patent Owner is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly

owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §102(e), (f) or (g) prior art under 35 U.S.C. §103(a).

***Summary of Inter Partes Reexamination Prosecution***

5. In the original Third Party request filed on 7<sup>th</sup> of December 2007, the following references, either by itself or in combination with one or more additional references, were alleged to render at least some of the claims unpatentable.

The references cited by the Third Party requester are

- Crichton et al. [US 6,104,716 A; hereinafter Crichton '716]
- Crichton et al. [GB 2323757; hereinafter Crichton '757]
- Remer et al. [US 6,742,039 B1; hereinafter Remer]
- BuddyHelp ["buddyhelp - How it works." URL:<http://web.archive.org/web/19991010222933/http://www.buddyhelp.com/how.tmpl>, Webpage [online].expertcity.com, October 10, 1999]
- NetMeeting [Official Microsoft NetMeeting 2.1, Summers, R., Microsoft Press, 1998]
- ILS [Microsoft Internet Locator Server Operations Guide Version 1.0. Microsoft Corporation, 1996]
- PhonePatch FAQ ["PhonePatch Frequently Asked Questions." URL:<http://web.archive.org/web/19981207050230/www.equival.com/phonepatch/faq.html>, Webpage [online]. Equivalence Pty Ltd., December 7, 1998]
- PhonePatch HIW ["PhonePatch - How it works." URL:<http://web.archive.org/web/19981206010333/www.equival.com/phonepatch/howitworks.html>, Webpage [online]. Equivalence Pty Ltd., December 6, 1998]
- NAT P2P ["NAT and Peer-to-peer Networking." URL:<http://web.archive.org/web/19990420024156/http://www.alumni.caltech.edu/~dank/peer-nat.html>, Webpage [online]. Dan Kegel, April 20, 1999]
- NAT P2P Games ["NAT support for peer-to-peer games: a proposal." In Linux IP NAT Forum, Kegel, Dan., URL:<http://web.archive.org/web/19981206184416/http://www.csn.tu-chemnitz.de/HyperNews/get/linux-ip-nat/97.html>, [online]: June 18, 1998, 15:38:56 GMT]
- LapLink [LapLink Professional User's Guide. Traveling Software, Inc., 1998], and
- RemotePassage [RemotePassage for Solaris Administration Guide. i-Planet, 1998].

In the *Inter Partes* REX Non-ACP Office Action mailed on 16<sup>th</sup> of June 2008, the original claim 7 was confirmed, and the other claims subject to the *inter partes* reexamination were rejected as follows:

- The original claims 1, 2, 5, 20-27, and 42-46 rejection based on Crichton '716, proposed by Third Party requester, were adopted and they were rejected, with or without modification, under 35 U.S.C. §102(e) as being anticipated by Crichton '716.  
The original claims 3, 4, 6, 7, 9-11, 28-30, 32, and 33 rejection based on Crichton '716, proposed by the Third Party requester, were not adopted.
- The original claims 1, 2, 5, 20-27, and 42-46 rejection based on Crichton '757, proposed by Third Party requester, were adopted and they were rejected, with or without modification, under 35 U.S.C. §102(b) as being anticipated by Crichton '757.  
The original claims 3, 4, 6, 7, 9-11, 28-30, 32, and 33 rejection based on Crichton '757, proposed by the Third Party requester, were not adopted.
- The original claims 24-33, 45, and 46 rejection based on Remer, proposed by Third Party requester, were adopted and they were rejected, with or without modification, under 35 U.S.C. §102(e) as being anticipated by Remer.  
The original claims 1-11, 20-23, and 42-44 rejection based on Remer, proposed by the Third Party requester, were not adopted.
- The original claims 1-5, 11, 2-30, and 42-46 rejection based on BuddyHelp, proposed by Third Party requester, were adopted and they were rejected, with or without modification, under 35 U.S.C. §102(a) as being anticipated by BuddyHelp.  
The original claims 6-10, and 31-33 rejection based on BuddyHelp, proposed by the Third Party requester, were not adopted.
- The original claims 1-3, 5, 6, 8-11, 20-28, and 42-46 rejection based on NetMeeting, proposed by Third Party requester, were adopted and they were rejected, with or without modification, under 35 U.S.C. §102(b) as being anticipated by NetMeeting.  
The original claims 4, 7, and 29-33 rejection based on NetMeeting, proposed by the Third Party requester, were not adopted.
- The original claims 1, 2, 5, 6, 8-10, 20-27, and 42-46 rejection based on ILS, proposed by Third Party requester, were adopted and they were rejected, with or without modification, under 35 U.S.C. §102(b) as being anticipated by ILS.

The original claims 3, 4, 7, 11, and 28-33 rejection based on ILS, proposed by the Third Party requester, were not adopted.

- The original claims 1, 2, 5, 20-27, and 42-46 rejection based on PhonePatch, proposed by Third Party requester, were adopted and they were rejected, with or without modification, under 35 U.S.C. §102(b) as being anticipated by PhonePatch.

The original claims 3, 4, 6-11, and 28-33 rejection based on PhonePatch, proposed by the Third Party requester, were not adopted.

- The original claims 1, 2, 5, 20, 21, and 23-27 rejection based on NAT P2P, proposed by Third Party requester, were adopted and they were rejected, with or without modification, under 35 U.S.C. §102(b) as being anticipated by NAT P2P.

The original claims 6, 7, 10, 22, 30, and 32 rejection based on NAT P2P, proposed by the Third Party requester, were not adopted.

- The original claims 1, 2, 5, 20, 21, and 23-27 rejection based on NAT P2P Games, proposed by Third Party requester, were adopted and they were rejected, with or without modification, under 35 U.S.C. §102(b) as being anticipated by NAT P2P Games.

The original claims 6, 7, 10, 22, 30, and 32 rejection based on NAT P2P Games, proposed by the Third Party requester, were not adopted.

- The original claims 1-5, 11, 20-30, and 42-46 rejection based on LapLink taken with RemotePassage, proposed by Third Party requester, were adopted and they were rejected, with or without modification, under 35 U.S.C. §103(a) as being unpatentable over LapLink in view of RemotePassage.

The original claims 6, 7, 9, 10, 22, 32, and 33 rejection based on LapLink taken with RemotePassage, proposed by the Third Party requester, were not adopted.

- None of the original claims 1-11, 20-33, and 42-46 rejection based on PhonePatch FAQ taken with PhonePatch HIW, proposed by the Third Party requester, was adopted.

In response to the *Inter Partes* REX Non-ACP Office Action, the Patent Owner filed the response on 3<sup>rd</sup> of September 2008 with the newly added claims 47-100. The Third Party requester filed the comments to the Patent Owner's response on 12<sup>th</sup> of December 2008 with proposing new claims 47-100 rejections.

The Examiner issued the *Inter Partes* REX ACP Office Action mailed on 19<sup>th</sup> of August 2009 with the claims 7 and 31-33 determined to be patentable while the claims 1-6, 8-11, 20-30, and 42-100 were rejected.

In response to the *Inter Partes* REX ACP Office Action, the Patent Owner filed the response on 19<sup>th</sup> of September 2009 with canceling the newly added claims 47-100. The Third Party requester filed the comments to the Patent Owner's response on 19<sup>th</sup> of October 2009.

### ***Oath/Declaration***

6. *Second Declaration of Gregory R. Ganger under 37 C.F.R. §1.132*

The declaration under 37 CFR §1.132 filed on 19<sup>th</sup> of September 2009 is sufficient to overcome the rejections of

- Claims 1, 2, 5, 20-27, and 42-46 based upon Crichton '716 under 35 U.S.C. §102(e),
- Claims 1, 2, 5, 20-27, and 42-46 based upon Crichton '757 under 35 U.S.C. §102(b),
- Claims 1-3, 5, 6, 8-11, 20-28, and 42-46 based upon NetMeeting under 35 U.S.C. §102(b),
- Claims 1, 2, 5, 6, 8-10, 20-27, and 42-46 based upon ILS under 35 U.S.C. §102(b),
- Claims 1, 2, 5, 20-27, and 42-46 based upon PhonePatch under 35 U.S.C. §102(b),
- Claims 1, 2, 5, 20, 21, and 23-27 based upon NAT P2P under 35 U.S.C. §102(b),
- Claims 1, 2, 5, 20, 21, and 23-27 based upon NAT P2P Games under 35 U.S.C. §102(b),
- Claims 1-5, 11, 20-23, and 42-46 based upon LapLink in view of RemotePassage under 35 U.S.C. §103(a),
- Claims 1-5, 11, 20-23, and 42-46 based upon LapLink in view of RemotePassage under 35 U.S.C. §103(a), and
- Claims 6 and 8-11 based upon PhonePatch in view of NetMeeting and ILS under 35 U.S.C. §103(a).

1) Regarding to Crichton references, the declarant particularly stresses that Crichton references do not teach the claimed limitation "by determining the then current location of the personal computer," which is required by the claims of the '479 Patent. The Examiner agrees because Crichton references are silent upon the Xserver (i.e., personal computer) is located by the Server end proxy (i.e., data communication facility). In fact, the then current location of the Xserver 211 (i.e., personal computer) is not determined by the Server end proxy 213 (i.e., data communication facility) in Fig. 4.

- 2) Regarding to ILS and NetMeeting references, the declarant particularly points out that ILS and NetMeeting references do not teach the claimed limitation "the location facility creates a communication channel between the remote computer and the personal computer," which is required by the claims of the '479 Patent. The Examiner agrees because the communication channel is created by the application software NetMeeting after the personal computer has been located by the internet locator server (i.e., ILS).
- 3) Regarding to PhonePatch in view of NetMeeting and ILS, the declarant again states that NetMeeting and ILS references do not teach the claimed limitation "the location facility creates a communication channel between the remote computer and the personal computer," which is required by the claims of the '479 Patent, and furthermore, the declarant asserts that PhonePatch does not address it. The Examiner agrees because the communication channel is created by the application software NetMeeting and PhonePatch after the personal computer has been located by the internet locator server (i.e., ILS).
- 4) Regarding to LapLink in view of RemotePassage, the declarant again states that LapLink reference do not teach the claimed limitation "the location facility creates a communication channel between the remote computer and the personal computer," which is required by the claims of the '479 Patent, and furthermore, the declarant asserts that RemotePassage does not address it. The Examiner agrees because the communication channel is created by the application software LapLink after the target personal computer has been located by the Windows Name Server (i.e., WINS).
- 5) Regarding to NAT P2P and NAT P2P Games References, the declarant particularly stresses that NAT P2P and NAT P2P Games references do not teach the claimed limitation "the location facility creates a communication channel between the remote computer and the personal computer," which is required by the claims of the '479 Patent. The Examiner agrees because the well-known server (i.e., address server) in NAT P2P and NAT P2P Games references does not create the communication channel, but resolving the each other computer's IP addresses in peer-to-peer communication much like with said ILS and WINS.

### ***Third Party requester's Grounds of Rejections***

#### **Ground #1: Crichton '716**

- Claims 1-7, 9-11, 20-30, 32, 33, and 42-46 of '479 Patent to be unpatentable over Crichton '716

Ground #2: Crichton '757

- Claims 1-7, 9-11, 20-30, 32, 33, and 42-46 of '479 Patent to be unpatentable over Crichton '757

Ground #3: Remer

- Claims 1-11, 20-33, and 42-46 of '479 Patent to be unpatentable over Remer

Ground #4: BuddyHelp

- Claims 1-11, 20-33, and 42-46 of '479 Patent to be unpatentable over BuddyHelp

Ground #5: NetMeeting

- Claims 1-11, 20-33, and 42-46 of '479 Patent to be unpatentable over NetMeeting

Ground #6: ILS

- Claims 1-11, 20-33, and 42-46 of '479 Patent to be unpatentable over ILS

Ground #7: PhonePatch

- Claims 1-11, 20-33, and 42-46 of '479 Patent to be unpatentable over PhonePatch (i.e., PhonePatch FAQ and PhonePatch HIW)

Ground #8: NAT P2P

- Claims 1, 2, 5-7, 10, 20-27, 30, and 32 of '479 Patent to be unpatentable over NAT P2P

Ground #9: NAT P2P Games

- Claims 1, 2, 5-7, 10, 20-27, 30, and 32 of '479 Patent to be unpatentable over NAT P2P Games

Ground #10: LapLink in view of RemotePassage

- Claims 1-7, 9-11, 20-30, 32, 33, and 42-46 of '479 Patent to be unpatentable over LapLink taken with RemotePassage

Ground #11: PhonePatch in view of NetMeeting and ILS

- Claims 1-11, 20-33, and 42-46 of '479 Patent to be unpatentable over PhonePatch (i.e., PhonePatch FAQ and PhonePatch HIW) taken with NetMeeting and ILS

***Analysis of Proposed Third Party Requester's Rejections***

**Re. Ground #1: Crichton '716**

7. Summary of Adoption of the proposed claim rejections:

- Adopted - None
- Not Adopted - Claims 1-7, 9-11, 20-30, 32, 33, and 42-46

8. The proposed rejections of claims 1-7, 9-11, 20-30, 32, 33, and 42-46 under 35 U.S.C. §102(e) as being anticipated by Crichton '716 are **not adopted** for the reasons as noted below.

*Referring to claims 1-7, 11, 20-30, and 42-46, the Crichton '716 lacks the teaching of at least the claimed subject limitation "by determining the then current location of the personal computer" in the respective independent claims 1, 7, 20, 21, 23, 24, and 26, as is shown in the above section of Oath/Declaration.*

*Thus, the rejections of the claims 1, 7, 20, 21, 23, 24, and 26 proposed by the Third Party requester in the request filed on 7<sup>th</sup> of December 2007 (hereinafter the Request) are **not adopted**.*

*Further, at least, since the claims 2-6, 11, and 42 are dependent claims of the claim 1, the claim 43 is a dependent claim of the claim 20, the claims 22 and 44 are dependent claims of the claim 21, the claims 25 and 45 are dependent claims of the claim 24, and the claims 27-30 and 46 are dependent claims of the claim 26, the claims 2-6, 11, 22, 25, 27-30, and 42-46 are not deemed to be anticipated by Crichton '716, and thus, the rejection of claims 2-6, 11, 22, 25, 27-30, and 42-46 proposed by the Third Party requester in the Request are **not adopted**.*

*Referring to claim 9, while it depends from the newly amended claim 8, the Third Party requester does not indicate that the claim 8 is anticipated under 35 U.S.C. §102(e) by Crichton '716. The Examiner raises a question how the claim 9 is anticipated under 35 U.S.C. §102(e) by Crichton '716 because the Third Party requester fails to show that the prior claim 8 is anticipated under 35 U.S.C. §102(e) by Crichton '716.*

*Therefore, since the claim 9 is a dependent claim of the claim 8, the claim 9 is not deemed to be anticipated by Crichton '716, and the rejection of claim 9 proposed by the Third Party requester in the Request is **not adopted**.*

*Referring to claim 10, while it depends from the claims 8 and 9, the prior claims 8 and 9 have not been anticipated by Crichton '716, *Supra*.*

*At least, since the claim 10 is a dependent claim of the claims 8 and 9, the claim 10 is not deemed to be anticipated by Crichton '716, and thus, the rejection of claim 10 proposed by the Third Party requester in the Request is **not adopted**.*

Referring to claim 32, while it depends from the newly amended claim 31, the Third Party requester does not indicate that the claim 31 is anticipated under 35 U.S.C. §102(e) by Crichton '716. The Examiner raises a question how the claim 32 is anticipated under 35 U.S.C. §102(e) by Crichton '716 because the Third Party requester fails to show that the prior claim 31 is anticipated under 35 U.S.C. §102(e) by Crichton '716.

Therefore, since the claim 32 is a dependent claim of the claim 31, the claim 32 is not deemed to be anticipated by Crichton '716, and the rejection of claim 32 proposed by the Third Party requester in the Request is **not adopted**.

Referring to claim 33, while it depends from the claims 31 and 32, the prior claims 31 and 32 have not been anticipated by Crichton '716, *Supra*.

At least, since the claim 33 is a dependent claim of the claims 31 and 32, the claim 33 is not deemed to be anticipated by Crichton '716, and thus, the rejection of claim 33 proposed by the Third Party requester in the Request is **not adopted**.

#### **Re. Ground #2: Crichton '757**

9. Summary of Adoption of the proposed claim rejections:

- Adopted - None
- Not Adopted - Claims 1-7, 9-11, 20-30, 32, 33, and 42-46

10. The proposed rejections of claims 1-7, 9-11, 20-30, 32, 33, and 42-46 under 35 U.S.C. §102(b) as being anticipated by Crichton '757 are **not adopted** for the reasons as noted below.

Referring to claims 1-7, 11, 20-30, and 42-46, the Crichton '757 lacks the teaching of at least the claimed subject limitation "by determining the then current location of the personal computer" in the respective independent claims 1, 7, 20, 21, 23, 24, and 26, as is shown in the above section of Oath/Declaration.

Thus, the rejections of the claims 1, 7, 20, 21, 23, 24, and 26 proposed by the Third Party requester in the Request are **not adopted**.

Further, at least, since the claims 2-6, 11, and 42 are dependent claims of the claim 1, the claim 43 is a dependent claim of the claim 20, the claims 22 and 44 are dependent claims of the claim 21, the claims 25 and 45 are dependent claims of the claim 24, and the claims 27-30 and 46 are dependent claims of the claim 26, the claims 2-6, 11, 22, 25, 27-30, and 42-46 are not deemed

to be anticipated by Crichton '757, and thus, the rejection of claims 2-6, 11, 22, 25, 27-30, and 42-46 proposed by the Third Party requester in the Request are **not adopted**.

Referring to claim 9, while it depends from the newly amended claim 8, the Third Party requester does not indicate that the claim 8 is anticipated under 35 U.S.C. §102(b) by Crichton '757. The Examiner raises a question how the claim 9 is anticipated under 35 U.S.C. §102(b) by Crichton '757 because the Third Party requester fails to show that the prior claim 8 is anticipated under 35 U.S.C. §102(b) by Crichton '757.

Therefore, since the claim 9 is a dependent claim of the claim 8, the claim 9 is not deemed to be anticipated by Crichton '757, and the rejection of claim 9 proposed by the Third Party requester in the Request is **not adopted**.

Referring to claim 10, while it depends from the claims 8 and 9, the prior claims 8 and 9 have not been anticipated by Crichton '757, *Supra*.

At least, since the claim 10 is a dependent claim of the claims 8 and 9, the claim 10 is not deemed to be anticipated by Crichton '757, and thus, the rejection of claim 10 proposed by the Third Party requester in the Request is **not adopted**.

Referring to claim 32, while it depends from the newly amended claim 31, the Third Party requester does not indicate that the claim 31 is anticipated under 35 U.S.C. §102(e) by Crichton '757. The Examiner raises a question how the claim 32 is anticipated under 35 U.S.C. §102(b) by Crichton '757 because the Third Party requester fails to show that the prior claim 31 is anticipated under 35 U.S.C. §102(b) by Crichton '757.

Therefore, since the claim 32 is a dependent claim of the claim 31, the claim 32 is not deemed to be anticipated by Crichton '757, and the rejection of claim 32 proposed by the Third Party requester in the Request is **not adopted**.

Referring to claim 33, while it depends from the claims 31 and 32, the prior claims 31 and 32 have not been anticipated by Crichton '757, *Supra*.

At least, since the claim 33 is a dependent claim of the claims 31 and 32, the claim 33 is not deemed to be anticipated by Crichton '757, and thus, the rejection of claim 33 proposed by the Third Party requester in the Request is **not adopted**.

**Re. Ground #3: Remer**

11. Summary of Adoption of the proposed claim rejections in the request:

- Adopted - None
- Not Adopted - Claims 1-11, 20-33, and 42-46

12. The proposed rejections of claims 1-11, 20-33, and 42-46 under 35 U.S.C. §102(e) as being anticipated by Remer are **not adopted** for the reasons as noted below.

*Referring to claims 1-6, 11, 20-30, and 42-46, the instant Office action maintains the reasons of the claims 1-6, 11, 20-30, and 42-46 as not being anticipated by Remer from the previous Office action, hereby incorporated by reference.*

*Thus, the rejections of the claims 1-6, 11, 20-30, and 42-46 proposed by the Third Party requester in the Request are **not adopted**.*

*Referring to claims 7, 8-10, and 31-33, Remer does in fact teach a system for providing access (i.e., system for connecting to a device on a protected network; See col. 1, lines 8-11) to a personal computer (i.e., Local computer 10a of Fig. 3) having a location on the Internet (i.e., Internet 250 of Fig. 3) defined by a dynamic IP address from a remote computer (i.e., said local computer having a dynamic IP address that changes from time-to-time because it has intermittent communications with the trusted arbiter; See Remer, Fig. 3 and col. 3, lines 30-35), the system comprising: a personal computer (i.e., local computer 10a of Fig. 3) linked to the Internet (i.e., said Internet; See Remer, col. 3, lines 4-10); a remote computer (i.e., remote computer 20c of Fig. 3) linked to the Internet (i.e., said Internet; See Remer, col. 3, lines 3-5).*

*However, Remer is silent upon the claimed limitation "determining a then current location of the personal computer" recited in the respective claims 7, 8, and 31, which is newly amended by the Patent Owner.*

*In conclusion, the Third Party requester fails to indicate any proper teaching from Remer anticipating the claimed subject matter "determining a then current location of the personal computer." Therefore, since the claimed subject matter "determining a then current location of the personal computer" is not taught by Remer at least, the claims 7, 8, and 31 are not deemed to be anticipated by Remer, and the rejection of claims 7, 8, and 31 proposed by the Third Party requester during the prosecution are **not adopted**.*

*Further, at least, since the claims 9 and 10 are dependent claims of the claim 8, and the claims 32 and 33 are dependent claims of the claim 31, the claims 9, 10, 32, and 33 are not*

*deemed to be anticipated by Remer, and thus, the rejection of claims 9, 10, 32, and 33 proposed by the Third Party requester during the prosecution are **not adopted**.*

**Re. Ground #4: BuddyHelp**

13. Summary of Adoption of the proposed claim rejections in the request:

- Adopted - None
- Not Adopted - Claims 1-11, 20-33, and 42-46

14. The proposed rejections of claims 1-11, 20-33, and 42-46 under 35 U.S.C. §102(a) as being anticipated by BuddyHelp are **not adopted** for the reasons as noted below.

*Referring to claims 1-6, 11, 20-30, and 42-46, the instant Office action maintains the reasons of the claims 1-6, 11, 20-30, and 42-46 as not being anticipated by BuddyHelp from the previous Office action, hereby incorporated by reference.*

*Thus, the rejections of the claims 1-6, 11, 20-30, and 42-46 proposed by the Third Party requester in the Request are **not adopted**.*

*Referring to claims 7, 8-10, and 31-33, BuddyHelp does in fact teach a system (i.e., Buddyhelp System) for providing access to a personal computer (i.e., Buddy computer running Windows 95/98/2000 or NT 4.0) having a location on the Internet (See CTX/COL 00070749, What do I need to run buddyhelp?) defined by a dynamic IP address from a remote computer (i.e., Helper computer; said Buddy computer can grant access to its files and control of said Buddy computer to said Helper computer. And further, it is inherent and well known in the art that most of computers connected to the Internet have a dynamic IP address at the time the invention was made.; See CTX/COL 00070744), the system (i.e., said Buddyhelp System) comprising: a personal computer (i.e., Buddy computer running Windows 95/98/2000 or NT 4.0) linked to the Internet (See CTX/COL 00070749, What do I need to run buddyhelp?), a remote computer (i.e., Helper computer) linked to the Internet (See CTX/COL 00070749, What do I need to run buddyhelp? and Who connects to whom ?).*

However, BuddyHelp is silent upon the claimed limitation "said one or more communication sessions being created by the location facility, in response to receipt of the request for communication with the personal computer from the remote computer" recited in the respective claims 7, 8, and 31, which is newly amended by the Patent Owner. Moreover, this issue was persuasively argued by the Patent Owner during the prosecution.

*In conclusion, the Third Party request fails to indicate any proper teaching from BuddyHelp anticipating the claimed subject matter "said one or more communication sessions being created by the location facility, in response to receipt of the request for communication with the personal computer from the remote computer." Therefore, since the claimed subject matter "said one or more communication sessions being created by the location facility, in response to receipt of the request for communication with the personal computer from the remote computer" is not taught by BuddyHelp at least, the claims 7, 8, and 31 are not deemed to be anticipated by BuddyHelp, and the rejection of claims 7, 8, and 31 proposed by the Third Party requester during the prosecution are **not adopted**.*

*Further, at least, since the claims 9 and 10 are dependent claims of the claim 8, and the claims 32 and 33 are dependent claims of the claim 31, the claims 9, 10, 32, and 33 are not deemed to be anticipated by BuddyHelp, and thus, the rejection of claims 9, 10, 32, and 33 proposed by the Third Party requester during the prosecution are **not adopted**.*

#### **Re. Ground #5 : NetMeeting**

15. Summary of Adoption of the proposed claim rejections in the request:

- Adopted - None
- Not Adopted - Claims 1-11, 20-33, and 42-46

16. The proposed rejections of claims 1-11, 20-33, and 42-46 under 35 U.S.C. §102(b) as being anticipated by NetMeeting are **not adopted** for the reasons as noted below.

*Referring to claims 1-11, 20-33, and 42-46, the NetMeeting lacks the teaching of at least the claimed subject limitation "the location facility creates a communication channel between the remote computer and the personal computer" in the respective independent claims 1, 7, 8, 20, 21, 23, 24, 26, and 31, as is shown in the above section of Oath/Declaration.*

*Thus, the rejections of the claims 1, 7, 8, 20, 21, 23, 24, 26, and 31 proposed by the Third Party requester in the Request are **not adopted**.*

*Further, at least, since the claims 2-6, 11, and 42 are dependent claims of the claim 1, the claims 9 and 10 are dependent claims of the claim 8, the claim 43 is a dependent claim of the claim 20, the claims 22 and 44 are dependent claims of the claim 21, the claims 25 and 45 are dependent claims of the claim 24, the claims 27-30 and 46 are dependent claims of the claim 26, and the claims 32 and 33 are dependent claims of the claim 31, the claims 2-6, 9-11, 22, 25, 27-30, 32, 33 and 42-46 are not deemed to be anticipated by NetMeeting, and thus, the rejection of*

claims 2-6, 9-11, 22, 25, 27-30, 32, 33 and 42-46 proposed by the Third Party requester in the Request are **not adopted**.

**Re. Ground #6: ILS**

17. Summary of Adoption of the proposed claim rejections in the request:

- Adopted - None
- Not Adopted - Claims 1-11, 20-33, and 42-46

18. The proposed rejections of claims 1-11, 20-33, and 42-46 under 35 U.S.C. §102(b) as being anticipated by ILS are **not adopted** for the reasons as noted below.

Referring to claims 1-11, 20-33, and 42-46, the ILS lacks the teaching of at least the claimed subject limitation "the location facility creates a communication channel between the remote computer and the personal computer" in the respective independent claims 1, 7, 8, 20, 21, 23, 24, 26, and 31, as is shown in the above section of Oath/Declaration.

Thus, the rejections of the claims 1, 7, 8, 20, 21, 23, 24, 26, and 31 proposed by the Third Party requester in the Request are **not adopted**.

Further, at least, since the claims 2-6, 11, and 42 are dependent claims of the claim 1, the claims 9 and 10 are dependent claims of the claim 8, the claim 43 is a dependent claim of the claim 20, the claims 22 and 44 are dependent claims of the claim 21, the claims 25 and 45 are dependent claims of the claim 24, the claims 27-30 and 46 are dependent claims of the claim 26, and the claims 32 and 33 are dependent claims of the claim 31, the claims 2-6, 9-11, 22, 25, 27-30, 32, 33 and 42-46 are not deemed to be anticipated by ILS, and thus, the rejection of claims 2-6, 9-11, 22, 25, 27-30, 32, 33 and 42-46 proposed by the Third Party requester in the Request are **not adopted**.

**Re. Ground #7 : PhonePatch**

19. Summary of Adoption of the proposed claim rejections in the request:

- Adopted - None
- Not Adopted - Claims 1-11, 20-33, and 42-46

20. The proposed rejections of claims 1-11, 20-33, and 42-46 under 35 U.S.C. §102(b) as being anticipated by PhonePatch are **not adopted** for the reasons as noted below.

Referring to claims 1-11, 20-33, and 42-46, the PhonePatch lacks the teaching of at least the claimed subject limitation "the location facility creates a communication channel between the

remote computer and the personal computer" in the respective independent claims 1, 7, 8, 20, 21, 23, 24, 26, and 31, as is shown in the above section of Oath/Declaration.

Thus, the rejections of the claims 1, 7, 8, 20, 21, 23, 24, 26, and 31 proposed by the Third Party requester in the Request are **not adopted**.

Further, at least, since the claims 2-6, 11, and 42 are dependent claims of the claim 1, the claims 9 and 10 are dependent claims of the claim 8, the claim 43 is a dependent claim of the claim 20, the claims 22 and 44 are dependent claims of the claim 21, the claims 25 and 45 are dependent claims of the claim 24, the claims 27-30 and 46 are dependent claims of the claim 26, and the claims 32 and 33 are dependent claims of the claim 31, the claims 2-6, 9-11, 22, 25, 27-30, 32, 33 and 42-46 are not deemed to be anticipated by PhonePatch, and thus, the rejection of claims 2-6, 9-11, 22, 25, 27-30, 32, 33 and 42-46 proposed by the Third Party requester in the Request are **not adopted**.

#### **Re. Ground #8: NAT P2P**

21. Summary of Adoption of the proposed claim rejections in the request:

- Adopted - None
- Not Adopted - Claims 1, 2, 5-7, 10, 20-27, 30, and 32

22. The proposed rejections of claims 1, 2, 5-7, and 20-27 under 35 U.S.C. §102(b) as being anticipated by NAT P2P are **not adopted** for the reasons as noted below.

Referring to claims 1, 2, 5-7, and 20-27, the NAT P2P lacks the teaching of at least the claimed subject limitation "the location facility creates a communication channel between the remote computer and the personal computer" in the respective independent claims 1, 7, 20, 21, 23, 24, and 26, as is shown in the above section of Oath/Declaration.

Thus, the rejections of the claims 1, 7, 20, 21, 23, 24, and 26 proposed by the Third Party requester in the Request are **not adopted**.

Further, at least, since the claims 2, 5, 6, and 11 are dependent claims of the claim 1, the claim 22 is a dependent claim of the claim 21, the claim 25 is a dependent claim of the claim 24, and the claim 27 is a dependent claim of the claim 26, the claims 2, 5, 6, 11, 22, 25, and 27 are not deemed to be anticipated by NAT P2P, and thus, the rejection of claims 2, 5, 6, 11, 22, 25, and 27 proposed by the Third Party requester in the Request are **not adopted**.

Referring to claim 10, while it depends from the newly amended claim 8 and its dependent claim 9, the Third Party requester does not indicate that the claims 8 and 9 are anticipated under 35 U.S.C. §102(b) by NAT P2P. The Examiner raises a question how the claim 10 is anticipated under 35 U.S.C. §102(b) by NAT P2P because the Third Party requester fails to show that the prior claims 8 and 9 are anticipated under 35 U.S.C. §102(b) by NAT P2P.

Therefore, since the claim 10 is a dependent claim of the claims 8 and 9, the claim 10 is not deemed to be anticipated by NAT P2P, and the rejection of claim 10 proposed by the Third Party requester in the Request is **not adopted**.

Referring to claim 30, the Third Party request does not indicate that the prior claims 28 and 29 are anticipated under 35 U.S.C. §102(b) by NAT P2P, at page 9 in the request.

Therefore, the Examiner doubts how the claim 30 is anticipated under 35 U.S.C. §102(b) by NAT P2P because the Third Party request fails to show that the prior claims 28 and 29 are anticipated under 35 U.S.C. §102(b) by NAT P2P.

In conclusion, since the claim 30 is a dependent claim of the claims 28 and 29, the claim 30 is not deemed to be anticipated by NAT P2P, and thus, the rejection of claim 30 proposed by the Third Party requester in the Request is **not adopted**.

Referring to claim 32, while it depends from the newly amended claim 31, the Third Party requester does not indicate that the claim 31 is anticipated under 35 U.S.C. §102(b) by NAT P2P. The Examiner raises a question how the claim 32 is anticipated under 35 U.S.C. §102(b) by NAT P2P because the Third Party requester fails to show that the prior claim 31 is anticipated under 35 U.S.C. §102(b) by NAT P2P.

Therefore, since the claim 32 is a dependent claim of the claim 31, the claim 32 is not deemed to be anticipated by NAT P2P, and the rejection of claim 32 proposed by the Third Party requester in the Request is **not adopted**.

#### **Re. Ground #9 : NAT P2P Games**

23. Summary of Adoption of the proposed claim rejections in the request:

- Adopted - None
- Not Adopted - Claims 1, 2, 5-7, 10, 20-27, 30, and 32

24. The proposed rejections of claims 1, 2, 5-7, and 20-27 under 35 U.S.C. §102(b) as being anticipated by NAT P2P are **not adopted** for the reasons as noted below.

*Referring to claims 1, 2, 5-7, and 20-27, the NAT P2P Games lacks the teaching of at least the claimed subject limitation "the location facility creates a communication channel between the remote computer and the personal computer" in the respective independent claims 1, 7, 20, 21, 23, 24, and 26, as is shown in the above section of Oath/Declaration.*

*Thus, the rejections of the claims 1, 7, 20, 21, 23, 24, and 26 proposed by the Third Party requester in the Request are **not adopted**.*

*Further, at least, since the claims 2, 5, 6, and 11 are dependent claims of the claim 1, the claim 22 is a dependent claim of the claim 21, the claim 25 is a dependent claim of the claim 24, and the claim 27 is a dependent claim of the claim 26, the claims 2, 5, 6, 11, 22, 25, and 27 are not deemed to be anticipated by NAT P2P Games, and thus, the rejection of claims 2, 5, 6, 11, 22, 25, and 27 proposed by the Third Party requester in the Request are **not adopted**.*

*Referring to claim 10, while it depends from the newly amended claim 8 and its dependent claim 9, the Third Party requester does not indicate that the claims 8 and 9 are anticipated under 35 U.S.C. §102(b) by NAT P2P Games. The Examiner raises a question how the claim 10 is anticipated under 35 U.S.C. §102(b) by NAT P2P Games because the Third Party requester fails to show that the prior claims 8 and 9 are anticipated under 35 U.S.C. §102(b) by NAT P2P Games.*

*Therefore, since the claim 10 is a dependent claim of the claims 8 and 9, the claim 10 is not deemed to be anticipated by NAT P2P Games, and the rejection of claim 10 proposed by the Third Party requester in the Request is **not adopted**.*

*Referring to claim 30, the Third Party request does not indicate that the prior claims 28 and 29 are anticipated under 35 U.S.C. §102(b) by NAT P2P Games, at page 9 in the request. Therefore, the Examiner doubts how the claim 30 is anticipated under 35 U.S.C. §102(b) by NAT P2P Games because the Third Party request fails to show that the prior claims 28 and 29 are anticipated under 35 U.S.C. §102(b) by NAT P2P GAMES.*

*In conclusion, since the claim 30 is a dependent claim of the claims 28 and 29, the claim 30 is not deemed to be anticipated by NAT P2P Games, and thus, the rejection of claim 30 proposed by the Third Party requester in the Request is **not adopted**.*

Referring to claim 32, while it depends from the newly amended claim 31, the Third Party requester does not indicate that the claim 31 is anticipated under 35 U.S.C. §102(b) by NAT P2P Games. The Examiner raises a question how the claim 32 is anticipated under 35 U.S.C. §102(b) by NAT P2P Games because the Third Party requester fails to show that the prior claim 31 is anticipated under 35 U.S.C. §102(b) by NAT P2P Games.

Therefore, since the claim 32 is a dependent claim of the claim 31, the claim 32 is not deemed to be anticipated by NAT P2P Games, and the rejection of claim 32 proposed by the Third Party requester in the Request is **not adopted**.

#### **Re. Ground #10: LapLink in view of RemotePassage**

25. Summary of Adoption of the proposed claim rejections in the request:

- Adopted - None
- Not Adopted - Claims 1-7, 9-11, 20-30, 32, 33, and 42-46

26. The proposed rejections of claims 1-7, 9-11, 20-30, 32, 33, and 42-46 under 35 U.S.C. §103(a) as being unpatentable over LapLink in view of RemotePassage are **not adopted** for the reasons as noted below.

Referring to claims 1-7, 11, 20-30, and 42-46, the combination of LapLink and RemotePassage lacks the teaching of at least the claimed subject limitation "the location facility creates a communication channel between the remote computer and the personal computer" in the respective independent claims 1, 7, 20, 21, 23, 24, and 26, as is shown in the above section of Oath/Declaration.

Thus, the rejections of the claims 1, 7, 20, 21, 23, 24, and 26 proposed by the Third Party requester in the Request are **not adopted**.

Further, at least, since the claims 2-6, 11, and 42 are dependent claims of the claim 1, the claim 43 is a dependent claim of the claim 20, the claims 22 and 44 are dependent claims of the claim 21, the claims 25 and 45 are dependent claims of the claim 24, and the claims 27-30 and 46 are dependent claims of the claim 26, the claims 2-6, 11, 22, 25, 27-30, and 42-46 are not deemed to be obvious over LapLink in view of RemotePassage, and thus, the rejection of claims 2-6, 11, 22, 25, 27-30, and 42-46 proposed by the Third Party requester in the Request are **not adopted**.

Referring to claim 9, while it depends from the newly amended claim 8, the Third Party requester does not indicate that LapLink in view of RemotePassage renders obviousness of the

claimed invention in the claim 8. The Examiner raises a question how LapLink in view of RemotePassage renders obviousness of the claimed invention in the claim 9 because the Third Party requester fails to show that LapLink in view of RemotePassage renders obviousness of the claimed invention in the claim 8.

*Therefore, since the claim 9 is a dependent claim of the claim 8, the claim 9 is not deemed to be obvious over LapLink in view of RemotePassage, and the rejection of claim 9 proposed by the Third Party requester in the Request is **not adopted**.*

*Referring to claim 10, while it depends from the claims 8 and 9, the prior claims 8 and 9 have not been rendered obviousness of the claimed invention over LapLink in view of RemotePassage, *Supra*.*

*At least, since the claim 10 is a dependent claim of the claims 8 and 9, the claim 10 is not deemed to be obvious over LapLink in view of RemotePassage, and thus, the rejection of claim 10 proposed by the Third Party requester in the Request is **not adopted**.*

*Referring to claim 32, while it depends from the newly amended claim 31, the Third Party requester does not indicate that LapLink in view of RemotePassage renders obviousness of the claimed invention in the claim 31. The Examiner raises a question how LapLink in view of RemotePassage renders obviousness of the claimed invention in the claim 32 because the Third Party requester fails to show that LapLink in view of RemotePassage renders obviousness of the claimed invention in the claim 31.*

*Therefore, since the claim 32 is a dependent claim of the claim 31, the claim 32 is not deemed to be obvious over LapLink in view of RemotePassage, and the rejection of claim 32 proposed by the Third Party requester in the Request is **not adopted**.*

*Referring to claim 33, while it depends from the claims 31 and 32, the prior claims 31 and 32 have not been rendered obviousness of the claimed invention over LapLink in view of RemotePassage, *Supra*.*

*At least, since the claim 33 is a dependent claim of the claims 31 and 32, the claim 33 is not deemed to be obvious over LapLink in view of RemotePassage, and thus, the rejection of claim 33 proposed by the Third Party requester in the Request is **not adopted**.*

**Re. Ground #11: PhonePatch in view of NetMeeting and ILS**

27. Summary of Adoption of the proposed claim rejections in the request:

- Adopted - None
- Not Adopted - Claims 1-11, 20-33, and 42-46

28. The proposed rejections of claims 1-11, 20-33, and 42-46 under 35 U.S.C. §103(a) as being unpatentable over PhonePatch in view of NetMeeting and ILS are **not adopted** for the reason as noted below.

*Referring to claims 1-11, 20-33, and 42-46, the combination of PhonePatch, NetMeeting, and ILS lacks the teaching of at least the claimed subject limitation "the location facility creates a communication channel between the remote computer and the personal computer" in the respective independent claims 1, 7, 8, 20, 21, 23, 24, 26, and 31, as is shown in the above section of Oath/Declaration.*

*Thus, the rejections of the claims 1, 7, 8, 20, 21, 23, 24, 26, and 31 proposed by the Third Party requester in the Request are **not adopted**.*

*Further, at least, since the claims 2-6, 11, and 42 are dependent claims of the claim 1, the claims 9 and 10 are dependent claims of the claim 8, the claim 43 is a dependent claim of the claim 20, the claims 22 and 44 are dependent claims of the claim 21, the claims 25 and 45 are dependent claims of the claim 24, the claims 32 and 33 are dependent claims of the claim 31, and the claims 27-30, and 46 are dependent claims of the claim 26, the claims 2-6, 9-11, 22, 25, 27-30, 32, 33, and 42-46 are not deemed to be obvious over PhonePatch in view of NetMeeting and ILS, and thus, the rejection of claims 2-6, 9-11, 22, 25, 27-30, 32, 33, and 42-46 proposed by the Third Party requester in the Request are **not adopted**.*

**Response to Arguments/Remarks**

**Issue 1:** *Whether Patent Owner's amendment are, in part, improper in form and should, in part, be rejected (See the Response at page 4 and the Comments at page 5).*

According to the rule 37 C.F.R. §1.530(i), all amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing the request for reexamination. Therefore, the Patent Owner's amendment, indicating that the amendments to claims 7, 8 and 31 are made, in part, to negate the prior amendment of those claims submitted with Patent Owner's Response filed on 3<sup>rd</sup> of September 2008, is proper in form because the instant amendments to claims 7, 8 and 31 are made relative to the claims of the '479 Patent, which were in effect as of the date of filing the request for *inter partes* reexamination. In other words, the Patent Owner is not required to bracket the phrase "IP address" (i.e., [IP address]) and underline the word "location" (i.e., location) because the word "location" in the claims is not a new claiming word relative to the claims of the '479 Patent.

In conclusion, the proposed amendments to claims 7, 8, and 31 are proper in form and are entered by the Office.

**Issue 2:** *Whether the Patent Owner's amendments to claims 7, 8 and 31 should be reexamined for the patentability of these claims (See the Comments at page 6).*

In fact, the proposed amendments to the claims 7, 8, and 31 are entered because the claims 7, 8, and 31 as amended do not present a new issue requiring further consideration or search (i.e., no more than nominal consideration is necessary).

Thus, the amended claims 7, 8, and 31 have been properly reexamined by the Examiner as shown in the above.

**Issue 3:** *Whether the claims 31-33 are invalid over the prior art (See the Comments at pages 7-11).*

Essentially, the Third Party requester argues that the claims 31-33 are not patentable because the limitation in the claims 31-33 requiring that the communication be created and sent by the data communication program to the locator server periodically is obvious at least in light of LapLink in view of RemotePassage in further view of the any one of the references of record teaching periodic communications, as set forth in the Request.

The Examiner believes that Remer, at least, discloses periodic communications between a connection entity and a trusted arbitrator, which is suggesting the argued element. However, the claim 31 has been **amended** as an independent claim including the limitations "by determining the then current location of the personal computer and creating a communication channel between the remote computer and the personal computer, the location facility being operable to create such communication channel whether the personal computer is linked to the Internet directly (with a publicly addressable) dynamic IP address or indirectly via an Internet gateway/proxy (with a publicly un-addressable dynamic LAN IP address)," which had been discussed in the prior Office action and are not taught by the prior art in the record, as is discussed in the above section of Oath/Declaration.

Therefore, the Third Party requester's arguments with respect to claim 31 and its dependent claims 32 and 33 have been considered but are moot.

**Issue 4:** *Whether the Patent Owner's proposed interpretation of a locator server creating a communication channel was not supported by the written description or other disclosure in the '479 Patent (See the Comments at pages 11-12).*

While an Applicant is not limited to the nomenclature used in the application as filed, the Applicant should make appropriate amendment of the specification whenever this nomenclature is departed from by amendment of the claims so as to have clear support or antecedent basis in the specification for the new terms appearing in the claims (See MPEP 608.01(o) [R-3] Basis for Claim Terminology in Description). The specification includes the text description disclosure, the drawings, and the claims.

In this case, even though the Patent Owner's proposed interpretation of a locator server creating a communication channel is not disclosed in the written description of the '479 Patent, the limitation "the location facility being operable to create such communication channel" was disclosed in the exemplary claim 1 as filed in the '479 Patent. Therefore, this Patent Owner's interpretation is not a new matter, but a originally disclosed description being fully supported by the disclosure of the specification, i.e., by the claim in particular.

Thus, the Third Party requester's assertion on this point is not persuasive.

**Issue 5:** *Whether Crichton '716 and '757 teach a location facility that determines the then current location of the personal computer (See the Response at pages 9-10 and the Comments at pages 20-21).*

Patent Owner argues that the middle proxy operates in pass through mode without knowing about any computers that may or may not be communicating with the end proxies. The Examiner agrees. Furthermore, the Examiner believes that the claimed subject matters "personal computer" and "remote computer" are not anticipated by the end proxies of Crichton '716 and '757 in light of the specification of the '479 Patent.

Thus, the Patent Owner's arguments on this point are persuasive and the claims rejection over either Crichton '716 or Crichton '757 in the previous Office action have been withdrawn in the instant Office action.

However, the Third Party requester asserts that the end proxies could be on the computers such as "the personal computer" and "the remote computer," and thus, the middle proxy (i.e., locator server) does locate the server end proxy (i.e., personal computer).

Let us assume, *arguendo*, the middle proxy (i.e., locator server) does locate the server end proxy (i.e., personal computer). Then, how Crichton '716 and '757 does teach the claimed subject matter "data communication facility," which is linked to the claimed subject matter "personal computer" in the exemplary claim 1. If the server end proxy is on the personal computer as a single subject matter in Crichton '716 and '757 lacks the teaching of the claimed subject matter "data communication facility". In other words, it is not proper that the single subject matter "server end proxy" of Crichton references teaches not only the claimed subject matter "personal computer", but also "data communication facility".

In addition, the middle proxy (i.e., locator server) does not perform any determination of the then current location of any computers, but provides a communication tunneling over the Internet (See Crichton '716 and '757, Abstract).

In particular, the third Party requester asserts that the server end proxy satisfies the claimed subject matter "personal computer" because Crichton references clearly states "... there is no reason why the proxies, for example, could not be run on a personal computer (PC) or main frame computer, ...". However, this is a clear misunderstanding of Crichton references by the Third Party requester because said personal computer (PC) does not mean the claimed subject matter "personal computer" (i.e., a general-purpose computer equipped with a microprocessor and designed to run especially commercial software as a word processor or Internet browser for an

individual user), but a general-purpose computer equipped with a microprocessor running **PC operating system** instead of **UNIX operating system** for an individual user. In other words, Crichton references does not disclose if the end proxies could be on the computers such as X-server (i.e., the personal computer) and X-client (i.e., the remote computer).

Therefore, the Third Party requester's assertion on this point is not persuasive.

**Issue 6:** *Whether Crichton '716 and '757 teach a data communication facility that creates and sends communications to the locator server computer that include the then current dynamic public IP address or dynamic LAN IP address of the personal computer (See the Response at page 10 and the Comments at page 21).*

The Crichton '716 and '757 discloses an end proxy (i.e., data communication facility) initiates a TCP/IP connection to the middle proxy (i.e., locator server), thereby said end proxy necessarily creates and sends a communication for initial connection using a TCP/IP connection. However, Crichton '716 and '757 are silent upon the then current dynamic public IP address or dynamic LAN IP address of the X-server (i.e., personal computer) being included in said communication.

Thus, the Patent Owner's arguments on this point are persuasive and the claims rejection over either Crichton '716 or Crichton '757 in the previous Office action have been withdrawn in the instant Office action.

The Third Party requester merely asserts that communications from the server end proxies do include the address of the server end proxy. However, the Third Party requester fails to point out the support of this assertion in Crichton '716 and '757.

Therefore, the Third Party requester's assertion on this point is not persuasive.

**Issue 7:** *Whether Crichton '716 and '757 disclose a data communication facility on a personal computer whose location on the Internet is defined by a dynamic IP address(See the Response at pages 10-11).*

According to the exemplary claim 21 rejection, the respective Crichton references teaches a data communication facility (i.e., Server end proxy) on the personal computer (i.e., Xserver and Server end proxy), wherein the data communication facility (i.e., said Server end proxy) being adapted to create and send a communication (i.e., proper sequencing of tunneling management events in Lightweight Secure Tunneling Protocol) that includes a then current dynamic public IP address (publicly addressable) or dynamic LAN IP address (publicly un-addressable) of the

personal computer (in fact, said Crichton references disclose an end proxy initiates, *inter alia*, a TCP/IP connection to the middle proxy, thereby necessarily sending the middle proxy its current TCP/IP address.; See the previous Office action).

However, the Patent Owner argues that the one-time, manual, human-initiated connection process between the end proxies and middle proxy in Crichton references is inconsistent with use of dynamic IP addresses for the end proxies because a change of the IP address would break the connection.

Even though Crichton references do not explicitly recite dynamic IP addresses and a mechanism for coping with changes to the IP addresses of either end proxies or personal computers, it does not necessarily mean that Crichton does not teach the claimed subject matter "dynamic IP addresses" and its related processes because: (a) Crichton is teaching a method and apparatus for Lightweight Secure Communication Tunneling over Internet, wherein X-server and X-client have the respective locations on the Internet defined by their respective IP addresses based on TCP/IP protocol. (b) While said IP addresses are not expressly taught as dynamic IP addresses, Crichton does not specify that said IP addresses could not be dynamic IP addresses, but static IP addresses. (c) It is clear that the Crichton's invention should have a communication between X-server and X-client via Internet based on TCP/IP protocol, and thus, the respective locations of said X-server and X-client on the Internet should be defined by their respective IP addresses as either dynamic IP addresses or static IP addresses. (d) Therefore, Crichton inherently anticipates the claimed subject matter "dynamic IP addresses" and its related processes as well as said static IP addresses.

Therefore, it is not proper to assert that Crichton explicitly teaches away from dynamic IP addresses, in describing a manual, human-initiated connection between each end proxy and the middle proxy and in providing no indication of possibly dealing with disruptions of that one-time human initiated connection, and the Patent Owner's argument on this point is not persuasive.

There is not particular comments from the Third Party requester regarding to this issue.

**Issue 8:** *Whether NetMeeting, ILS, PhonePatch, LapLink, RemotePassage, NAT P2P, and NAT P2P Games references, alone or in combination, teach or suggest a locator server computer that creates a communication channel (See the Response at pages 11-23 and the Comments at pages 12-20).*

The Patent Owner's arguments regarding to this issue are persuasive, and the Examiner have withdrawn the claims rejection over NetMeeting, ILS, PhonePatch, LapLink, RemotePassage, NAT P2P, and NAT P2P Games references, alone or in combination, in the previous Office action.

However, the Third Party requester maintains its assertion in the Request and its previous Comments how the NetMeeting software, PhonePatch software, LapLink software, RemotePassage software, NAT P2P software, NAT P2P Games software, and ILS software interact, as described by each of the NetMeeting, ILS, PhonePatch, LapLink, RemotePassage, NAT P2P, and NAT P2P Games references.

In the Request at pages 23-24, the Third Party requester admitted that the ILS Software functions as a locator server, which is essentially a directory server that stores the location information of every user currently registered with the ILS Software, much like an electronic phonebook. The server computer executing the ILS Software itself typically has a static IP address to facilitate its location by other computers, which are running said application software for making a direct connection between the computers (i.e., creating communication channel using said location information).

Therefore, the Third Party requester's assertion on this point is not persuasive.

**Issue 9:** *The Patent Owner's arguments and the Third Party requester's comments with respect to the claims 47-100 cancelled in the Response (See the Response at pages 23-24 and the Comments at pages 21-22).*

All issues raised in the Response and the Comments regarding to the claims 47-100 are moot because of having been cancelled by the Patent Owner.

**Issue 10:** *Whether the declaration from Patent Owner's paid expert constitutes uncorroborated opinion testimony (See the Comments at page 23).*

Even though the declaration might be naked argument with no citation to any portion of the '479 Patent or any third-party reference, the declarant could show any evidence (e.g., expert opinion, etc.) submitted to traverse the rejection or objection on a basis not otherwise provided for under 37 CFR §1.132 (emphasis added).

Therefore, the Third Party requester's assertion on this point is not persuasive.

**STATEMENT OF REASONS FOR PATENTABILITY AND/OR CONFIRMATION**

29. Claims 1-6, 20-30, and 42-45 are confirmed.

Claims 7, 8, 11, 31, and 46 are determined to be patentable as amended.

Claims 9 and 10 dependent on the amended claim 8 are determined to be patentable.

Claims 32 and 33 dependent on the amended claim 31 are determined to be patentable.

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

With respect to claims 1-11, 20-33, and 42-46, the claim limitations of the respective claims 1, 7, 8, 20, 21, 23, 24, 26, and 31 are deemed patentable over the prior art of record as the prior art fails to teach or suggest that the location facility determines the then current location of the personal computer and creates a communication channel between the remote computer and the personal computer.

The claims 2-6, 11, and 42 are dependent claims of the claim 1.

The claims 9 and 10 are dependent claims of the claim 8.

The claim 43 is a dependent claim of the claim 20.

The claims 22 and 44 are dependent claims of the claim 21.

The claims 25 and 45 are dependent claims of the claim 24.

The claims 27-30 and 46 are dependent claims of the claim 26.

The claims 32 and 33 are dependent claims of the claim 31.

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***

31. **This is a RIGHT OF APPEAL NOTICE (RAN);** see MPEP § 2673.02 and § 2674. The decision in this Office action as to the patentability or unpatentability of any original patent claim, any proposed amended claim and any new claim in this proceeding is a FINAL DECISION.

No amendment can be made in response to the Right of Appeal Notice in an *inter partes* reexamination. 37 CFR 1.953(c). Further, no affidavit or other evidence can be submitted in an

*inter partes* reexamination proceeding after the right of appeal notice, except as provided in 37 CFR 1.981 or as permitted by 37 CFR 41.77(b)(1). 37 CFR 1.116(f).

Each party has a **thirty-day or one-month time period, whichever is longer**, to file a notice of appeal. The patent owner may appeal to the Board of Patent Appeals and Interferences with respect to any decision adverse to the patentability of any original or proposed amended or new claim of the patent by filing a notice of appeal and paying the fee set forth in 37 CFR 41.20(b)(1). The third party requester may appeal to the Board of Patent Appeals and Interferences with respect to any decision favorable to the patentability of any original or proposed amended or new claim of the patent by filing a notice of appeal and paying the fee set forth in 37 CFR 41.20(b)(1).

In addition, a patent owner who has not filed a notice of appeal may file a notice of cross appeal within **fourteen days of service** of a third party requester's timely filed notice of appeal and pay the fee set forth in 37 CFR 41.20(b)(1). A third party requester who has not filed a notice of appeal may file a **notice of cross appeal within fourteen days of service** of a patent owner's timely filed notice of appeal and pay the fee set forth in 37 CFR 41.20(b)(1).

Any appeal in this proceeding must identify the claim(s) appealed, and must be signed by the patent owner (for a patent owner appeal) or the third party requester (for a third party requester appeal), or their duly authorized attorney or agent.

Any party that does not file a timely notice of appeal or a timely notice of cross appeal will lose the right to appeal from any decision adverse to that party, but will not lose the right to file a respondent brief and fee where it is appropriate for that party to do so. If no party files a timely appeal, the reexamination prosecution will be terminated, and the Director will proceed to issue and publish a certificate under 37 CFR 1.997 in accordance with this Office action.

**All** correspondence relating to this *inter partes* reexamination proceeding should be directed:

By EFS: Registered users may submit via the electronic filing system EFS-Web, at <http://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

By Mail to: Mail Stop *Inter Partes* 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

Art Unit: 3992

*Inter Partes* Right of Appeal Notice

Central Reexamination Unit

By hand: Customer Service Window  
Randolph Building  
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 date of transmission, which is prior to the expiration of the set period of time in the Office action.

Any inquiry concerning this communication or earlier communications from the Reexamination 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.

Signed:

/Christopher E. Lee/  
Christopher E. Lee / Art Unit 3992  
Primary Examiner (Reexamination)  
Central Reexamination Unit

Conferee:

  
JESSICA HARRISON  
SUPERVISORY PATENT EXAMINER



Receipt date: 12/23/2009

95001018, GAU: 3992

Approved for use through 07/31/2006. OMB 0651-0031  
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Substitute for form 1449/PTO		<b>Complete if Known</b>	
<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>		<b>Application Number</b>	95/001,018
Date Submitted: December 23, 2009		<b>Filing Date</b>	12/07/2007
(Use as many sheets as necessary)		<b>First Named Inventor</b>	6,928,479
		<b>Art Unit</b>	3992
		<b>Examiner Name</b>	Christopher E. Lee
		<b>Attorney Docket Number</b>	79123.00006
Sheet	1	of	1

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. <sup>1</sup>	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code <sup>2</sup> (if known)			
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FOREIGN PATENT DOCUMENTS							
Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document		Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Documents	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T <sup>6</sup>
		Country Code <sup>3</sup>	Number <sup>4</sup> Kind Code <sup>5</sup> (if known)				
/CEL/	C1	JP	2000-125062 A	04-28-2000	Canon Inc.		
/							

Examiner Signature	/Christopher E. Lee/	Date Considered	01/04/2010
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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 applicant. <sup>1</sup> Applicant's unique citation designation number optional. <sup>2</sup> See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>6</sup> 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 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 Office, 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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