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Daniel B. Ravicher, Executive Director
PUBLIC PATENT FOUNDATION
55 Fifth Ave., Suite 928
New York, NY 10003

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/009,275.
PATENT NO. 6137498
ART UNIT 3992

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified ex parte reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the ex parte reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).
The request for ex parte reexamination filed 12 September 2008 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments:  
a) □ PTO-892,  b) ☒ PTO/SB/08,  c) □ Other: _____

1. ☒ The request for ex parte reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).

For Requester's Reply (optional): TWO MONTHS from the date of service of any timely filed Patent Owner's Statement (37 CFR 1.535). NO EXTENSION OF THIS TIME PERIOD IS PERMITTED. If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. □ The request for ex parte reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.151(c)). EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.

In due course, a refund under 37 CFR 1.26 (c) will be made to requester:

a) □ by Treasury check or,

b) □ by credit to Deposit Account No. _____, or

c) □ by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).
DECISION

Response to Request for Ex Parte Reexamination

1. A substantial new question of patentability affecting claims 1-10, 14-25, and 29-60 of United States Patent Number 6,137,498 A (hereinafter ‘498 Patent) 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).

2. A prior art patent or printed publication raises a substantial new question of patentability where there is:

   (A) a substantial likelihood that a reasonable Examiner would consider the prior art patent or printed publication important in deciding whether or not the claim is patentable, MPEP §2242 (I) and,

   (B) the same question of patentability as to the claim has not been decided in a previous or pending proceeding or in a final holding of invalidity by a federal court. See MPEP §2242 (III).

3. The ‘498 Patent is currently assigned to: RUNAWAY TECHNOLOGY, INC., of CAMBRIDGE, MASSACHUSETTS. The ‘498 Patent was issued from the Application 08/957,833 (hereinafter ’833 Application), which was filed on 27th of October 1997.

4. In the request for reexamination, the Requester alleges that the ‘498 Patent claims 1-10, 14-25, and 29-60 are unpatentable over the following references:

   a) "Web Gothic," published by Adam Finkelstein, a computer created image mosaic, 1995 (hereinafter, "Web Gothic").

   b) "WIRED," published by WIRED magazine, a magazine cover, November 1995 (hereinafter, "WIRED magazine").

   c) "Geoconda Sapiens," a photomosaic of Mona Lisa, 1995 (hereinafter, "Geoconda Sapiens").

   d) "Portrait of Jerome Weisner," created by Robert S. Silvers (Patentee), a photomosaic, 1995 (hereinafter, "Portrait of Jerome Weisner").


Of the above references, except "WIRED magazine" which is cited on the face of the '498 Patent, the rest of the references are not of record in the file of '498 Patent, and are not cumulative to the art of record in the original file.

However, a review of the prosecution history of the '833 Application reveals that even though "WIRED magazine" was considered by the Examiner, but was not relied upon to reject any claims during the prosecution of the '498 Patent.
Scope of Reexamination

5. Since requester did not request reexamination of claims 11-13, 26-28, and 61-63 and did not assert the existence of a substantial new question of patentability (SNQ) for such claims (See 35 U.S.C. §311(b)(2); See also 37 CFR 1.915b and 1.923), such claim will not be reexamined. This matter was squarely addressed in Sony Computer Entertainment America Inc., et al. v. Jon W. Dudas, Civil Action No. 1:05CV1447 (E.D.Va. May 22, 2006), Slip Copy, 2006 WL 1472462. (Not Reported in F.Supp.2d.) The District Court upheld the Office’s discretion to not reexamine claims in an Inter Partes Reexamination proceeding other than those claims for which reexamination had specifically been requested. The Court stated:

"To be sure, a party may seek, and the PTO may grant, inter partes review of each and every claim of a patent. Moreover, while the PTO in its discretion may review claims for which inter partes review was not requested, nothing in the statute compels it to do so. To ensure that the PTO considers a claim for inter partes review, 35 U.S.C. §311(b)(2) requires that the party seeking reexamination demonstrate why the PTO should reexamine each and every claim for which it seeks review. Here, it is undisputed that Sony did not seek review of every claim under the '213 and '333 patents. Accordingly, Sony cannot now claim that the PTO wrongly failed to reexamine claims for which Sony never requested review, and its argument that AIPA compels a contrary result is unpersuasive."

The Sony decision's reasoning and statutory interpretation apply analogously to Ex Parte Reexamination, as the same relevant statutory language applies to both Inter Partes and Ex Parte Reexamination. 35 U.S.C. §302 provides that the Ex Parte Reexamination "request must set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested" (Emphasis added), and 35 U.S.C. §303 provides that "the Director will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request ..." (Emphasis added). These provisions are analogous to the language of 35 U.S.C. §311(b)(2) and 35 U.S.C. § 312 applied and construed in Sony, and would be construed in the same manner. As the Director can decline to reexamine non-requested claims in an Inter Partes Reexamination proceeding, the Director can likewise do so in Ex Parte Reexamination proceeding. See Notice of Clarification of Office Policy To Exercise Discretion in Reexamining Fewer Than All the Patent Claims (signed Oct. 5, 2006) 1311 OG 197 (Oct. 31, 2006). See also MPEP §2240, Rev. 5, Aug. 2006. Therefore, claims 11-13, 26-28, and 61-63 will not be reexamined in this Ex Parte Reexamination proceeding.
Substantial New Questions of Patentability Raised by the Requester

6. In the request for reexamination, the request sets forth that Requester considers that:
   a) Claims 1, 2, 5-9, 14, 15, 18-22, 51, and 55-59 of the '498 Patent are unpatentable over WIRED magazine taken with either Lu et al. or Hsu et al.
   b) Claims 1, 3, 5-9, 14, 16, 18-22, 51, 53, and 55-59 of the '498 Patent are unpatentable over WIRED magazine taken with Ioka.
   c) Claims 1, 5-9, 14, 18-22, 51, and 55-59 of the '498 Patent are unpatentable over WIRED magazine taken with any one of Barber, Gary, and Stricker & Dimai.
   d) Claims 10, 23, and 60 of the '498 Patent are unpatentable over WIRED magazine taken with Barber, and further, either Niblack et al. or Ogle et al.
   e) Claims 24 and 25 of the '498 Patent are unpatentable over WIRED magazine taken with Ioka, and further, Adobe Brochure.
   f) Claims 29-41 and 42-45 of the '498 Patent are unpatentable over any one of WIRED magazine, Giaconda Sapiens, and Portrait of Jerome Weisner.
   g) Claims 46-50 of the '498 Patent are unpatentable over WIRED magazine taken with White.
   h) Claims 1, 4, 14, 17, 51, and 54 of the '498 Patent are unpatentable over Giaconda Sapiens taken with Ioka.
   i) Claims 46-50 of the '498 Patent are unpatentable over Web Gothic taken with White.

Analysis of Substantial New Questions of Patentability

7. It is agreed that the consideration of WIRED magazine taken with various references proposed by Requester raises a substantial new question of patentability as to the respective claims 1, 14, 29, 46, and 51 of the '498 Patent.

   As pointed out on pages 14-15 of the request, WIRED Magazine (actually, the magazine cover and the description of said magazine cover) shows an image consisting of a number of images positioned with respect to each other so as to approximate an image of Mr. Nicholas Negroponte, wherein WIRED magazine teaches generally complex source images to the tile region (i.e., the source images used to create the mosaic of WIRED magazine were generally complex; See Exhibit 18, the cover page and its description). The teaching as to said generally
complex source images to the tile region was not present in the prosecution of the '833 Application which became the '498 Patent.

Furthermore, there is a substantial likelihood that a reasonable Examiner would consider this teaching important in deciding whether or not the claims are patentable. Accordingly, WIRED magazine in view of various references proposed by Requester raises substantial new questions of patentability as to the claim 1 and its dependent claims 2-10, the claim 14 and its dependent claims 15-25, the claim 29 and its dependent claims 30-45, the claim 46 and its dependent claims 47-50, and the claim 51 and its dependent claims 52-60, which questions have not been decided in a previously examination of the '498 Patent.

Conclusion

The Patent Owner is reminded that any proposed amendment to the specification and/or claims in this reexamination proceeding must comply with 37 CFR 1.530(d)-(j).

After filing of a request for ex parte reexamination by a Third Party requester, any document filed by either the Patent Owner or the Third Party requester must be served on the other party (or parties where two or more Third Party requester proceedings are merged) in the reexamination proceeding in the manner provided in 37 CFR 1.248. The document must reflect service or the document may be refused consideration by the Office. See 37 CFR 1.550(f).

The Patent Owner is reminded of the continuing responsibility under 37 CFR 1.565(a), to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving the instant Patent Under Reexamination or any related patent throughout the course of this reexamination proceeding. The Third Party requester is also reminded of the ability to similarly inform the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

All correspondence relating to this ex parte reexamination proceeding should be directed:
By EFS: Registered users may submit via the electronic filing system EFS-Web, at http://portal.uspto.gov/authenticate/authenticateuserlocaletpf.html
By Mail to: Mail Stop Ex Parte Reexam
Central Reexamination Unit
Commissioner for Patents
5
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to: (571) 273-9900
10
Central Reexamination Unit

By hand: Customer Service Window
Randolph Building
401 Dulany Street
15
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/
Primary Patent Examiner (Reexamination)
30
Central Reexamination Unit / Art Unit 3992

Conferees:

ESK