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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,275	09/12/2008	6137498		8821

7590 11/20/2008
WEINGARTEN, SCHURGIN, GAGNEBIN & HAYS LLP
Ten Post Office Square
Boston, MA 02109

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 11/20/2008

Please find below and/or attached an Office communication concerning this application or proceeding.



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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)).

Order Granting / Denying Request For Ex Parte Reexamination	Control No. 90/009,275	Patent Under Reexamination 6137498	
	Examiner Christopher E. Lee	Art Unit 3992	

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

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 1.515(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)).

/Christopher E. Lee/ Primary Examiner, Art Unit 3992		
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cc:Requester (if third party requester)

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
5 *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
10 *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
15 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
20 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
25 (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").
- 30 d) "Portrait of Jerome Weisner," created by Robert S. Silvers (Patentee), a photomosaic, 1995 (hereinafter, "Portrait of Jerome Weisner").

- e) Barber et al. [US 5,579,471 A] "Image Query System and Method," November 1996 (hereinafter, "Barber").
- f) Robert S. Gary, "Content-based Image Retrieval: Color and Edges," Dartmouth Computer Technical Report PCS-TR95-252 (1995) (hereinafter, "Gary").
- 5 g) M. Stricker and A. Dimai, "Color Indexing with Weak Spatial Constraints," Storage and Retrieval for Still Image and Video Databases IV, Proceedings of SPIE Volume: 2670, pages 29-40 (February 1996) (hereinafter, "Stricker & Dimai").
- h) Hongjun Lu, Beng-Chin Ooi, and Kian-Lee Tan, "Efficient Image Retrieval By Color Contents," Applications of Databases, First International Conference on Applications of Databases, pages 95-108 (1994) (hereinafter, "Lu et al.").
- 10 i) Wynne Hsu, Chua T.S., and Pung H.K., "An Integrated Color-Spatial Approach to Content-based Image Retrieval," Proceedings of the Third ACM International Conference on Multimedia, pages 305-313 (1995) (hereinafter, "Hsu et al.").
- j) Mikihiro Ioka, "A method of Defining the Similarity of Images on the Basis of Color Information," IBM Research Report RT-0030, Tokyo Research Laboratory (1989) (hereinafter, "Ioka").
- 15 k) Ron White, "How Computers Work," published by Zeff-Davis, pages 50, 51, 63, 67, 75, and 79 (1993) (hereinafter, "White").
- l) Brochure, "Adobe Photoshop 3.0," published by Adobe Systems Incorporated (1995) (hereinafter, "Adobe Brochure").
- 20 m) Virginia E. Ogle and Michael Stone Braker, "Chabot: Retrieval from a Relational Database of Images," IEEE Computer, pages 40-48 (September 1995) (hereinafter, "Ogle et al.").
- n) Wayne Niblack and Myron Flickner, "Fine Me the Pictures That Look Like This: IBM's Image Query Project," Advanced Imaging, pages 32-35 (1993) (hereinafter, "Niblack et al.").
- 25

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.

- 30 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:

10 "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."

20 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, Gioconda 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 Gioconda 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://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

Art Unit: 3992

Ex Parte REX Order Decision

5 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

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

15 By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

20 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.

25 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/

30 Primary Patent Examiner (Reexamination)
Central Reexamination Unit / Art Unit 3992

Conferees:

ESK

JS