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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------------------|------------------|
| 90/015,301 | 09/22/2023 | 7058040 | EMP0902-RE | 4883 |
| 67050 | 7590 | 08/21/2024 | | |
| KASHA LAW LLC 14532 Dufief Mill Road North Potomac, MD 20878 | | | EXAMINER HENEGHAN, MATTHEW E | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3992 | |
| | | | MAIL DATE | DELIVERY MODE |
| | | | 08/21/2024 | PAPER |

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

The time period for reply, if any, is set in the attached communication.



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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***EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/015,301 .

PATENT UNDER REEXAMINATION 7058040 .

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)).

| | | | |
|---|---------------------------------------|--|-------------------------|
| Notice of Intent to Issue Ex Parte Reexamination Certificate | Control No. 90/015,301 | Patent Under Reexamination 7058040 | |
| | Examiner MATTHEW E HENEGHAN | Art Unit 3992 | AIA Status No |

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

1. ☒ Prosecution on the merits is (or remains) closed in this *ex parte* reexamination proceeding. This proceeding is subject to reopening at the initiative of the Office or upon petition. *Cf.* 37 CFR 1.313(a). A Certificate will be issued in view of
 - (a) ☒ Patent owner's communication(s) filed: 21 May 2024.
 - (b) ☐ Patent owner's failure to file an appropriate timely response to the Office action mailed: ____.
 - (c) ☐ Patent owner's failure to timely file an Appeal Brief (37 CFR 41.31).
 - (d) ☐ The decision on appeal by the ☐ Board of Patent Appeals and Interferences ☐ Court dated ____
 - (e) ☐ Other: ____.
2. The Reexamination Certificate will indicate the following:
 - (a) Change in the Specification: ☐ Yes ☒ No
 - (b) Change in the Drawing(s): ☐ Yes ☒ No
 - (c) Status of the Claim(s):
 - (1) Patent claim(s) confirmed: 1-6 and 16.
 - (2) Patent claim(s) amended (including dependent on amended claim(s)): ____
 - (3) Patent claim(s) canceled: ____.
 - (4) Newly presented claim(s) patentable: ____.
 - (5) Newly presented canceled claims: ____.
 - (6) Patent claim(s) ☐ previously ☐ currently disclaimed: ____
 - (7) Patent claim(s) not subject to reexamination: 7-15.
3. ☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on ____.
4. ☒ Note the attached statement of reasons for patentability and/or confirmation. Any comments considered necessary by patent owner regarding reasons for patentability and/or confirmation must be submitted promptly to avoid processing delays. Such submission(s) should be labeled: "Comments On Statement of Reasons for Patentability and/or Confirmation."
5. ☐ Note attached NOTICE OF REFERENCES CITED (PTO-892).
6. ☒ Note attached LIST OF REFERENCES CITED (PTO/SB/08 or PTO/SB/08 substitute).
7. ☐ The drawing correction request filed on ____ is: ☐ approved ☐ disapproved.
8. ☐ Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the certified copies have

☐ been received.
☐ not been received.
☐ been filed in Application No. ____.
☐ been filed in reexamination Control No. ____.
☐ been received by the International Bureau in PCT Application No. _____.

* Certified copies not received: ____.
9. ☐ Note attached Examiner's Amendment.
10. ☐ Note attached Interview Summary (PTO-474).
11. ☐ Other: ____.

All correspondence relating to this 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.

| | |
|--|---|
| | /MATTHEW E HENEGHAN/ Primary Examiner, Art Unit 3992 |
|--|---|

cc: Requester (if third party requester)

DETAILED ACTION

Notice of Pre-AIA or AIA Status

The present reexamination is being examined under the pre-AIA first to invent provisions.

Reexamination

The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 7,058,040 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

As stated in the Order Granting *Ex Parte* Reexamination mailed by the Office on 20 November 2023, a substantial new question of patentability affecting claims 1-6 and 16 of United States Patent Number 7,058,040 (hereinafter the '040 patent) has been raised by the request for *ex parte* reexamination. Claims 1-6 and 16 have been examined. Claims 7-15 are not subject to 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).

The term of the '040 patent has expired. Claim construction shall be pursuant to the principle set forth by the court in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (words of a claim "are generally given their ordinary and customary meaning" as understood by a person of ordinary skill in the art in question at the time of the invention, see *Ex parte Papst-Motoren*, 1 USPQ2d 1655 (Bd. Pat. App. & Inter. 1986)). No amendments, other than for the cancellation of claims, will be allowed. See MPEP 2258(G) and 37 CFR 1.530(j).

Response to Arguments

Applicant's arguments, see Request for Reconsideration, filed 21 May 2024, with respect to the rejections of claims 1-6 and 16 have been fully considered and are persuasive. The rejections of claims 1-6 and 16 have been withdrawn.

The process of "dynamically adjusting a number of time-slot channels assigned to one of the first and second media during the data transmission to remain within limits of a desired level of service" is described in the specification of the '040 patent at

column 5, lines 23-37, in which adjustments are made while data is actually being transmitted. The specification specifically contrasts this with embodiments using static adjusting (see Figure 1D), in which adjusting is only performed before or after the data transmission. Jokinen's teaching essentially corresponds to the static embodiment. It is therefore agreed that Jokinen does not disclose the claimed "dynamically adjusting." Joerssen's disclosure of such adjusting is not made in sufficient detail to determine if it is dynamic or static; as such, Joerssen is likewise found to not disclose this limitation. It is noted that the Third Party Requester also proposed the combination of Joerssen with Stanwood to establish this teaching, but Stanwood also does not discuss this in sufficient detail to establish whether such adjusting is dynamic or static in nature.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 31 May 2024 was filed after the mailing date of the first action on the merits on 21 March 2024. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner to the extent to which the pertinence of the references has been discussed by the Patent Owner.

Allowable Subject Matter

Claims 1-6 and 16 are confirmed.

STATEMENT OF REASONS FOR PATENTABILITY AND/OR CONFIRMATION

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

None of the art cited discloses "dynamically adjusting a number of time-slot channels assigned to one of the first and second media during the data transmission to remain within limits of a desired level of service," as recited in claim 1.

Claims 2-6 and 16 are confirmed based upon their dependence on claim 1.

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

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW E HENEGHAN whose telephone number is (571)272-3834. The examiner can normally be reached M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Fuelling can be reached on (571)270-1367. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of published or unpublished applications may be obtained from Patent Center. Unpublished application information in Patent Center is available to registered users. To file and manage patent submissions in Patent Center, visit: <https://patentcenter.uspto.gov>. Visit <https://www.uspto.gov/patents/apply/patent-center> for more information about Patent Center and <https://www.uspto.gov/patents/docx> for information about filing in DOCX format. For additional questions, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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