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Date: July 20, 2012

Signature: /Stephanie Dominguez/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: U.S. Patent 5,974,120

Ex Parte Reexamination Request

Inventor: Ronald A. Katz

Filed: Jun. 7, 1995

Issued: Oct. 26, 1999

For: TELEPHONE INTERFACE CALL
PROCESSING SYSTEM WITH CALL
SELECTIVITY

REQUEST FOR REEXAMINATION
UNDER 35 U.S.C. §§ 302-307 AND
37 C.F.R. § 1.510

Mail Stop *Ex Parte* Reexamination
Attn: Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR *EX PARTE* REEXAMINATION OF U.S. PATENT 5,974,120

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LIST OF EXHIBITS

The exhibits to the present Request are arranged in four groups: prior art ("PA"), relevant patent prosecution file history, patents, and claim dependency relationships ("PAT"), claim charts ("CC"), and other ("OTH").

A. PRIOR ART (PA)

PA-SB08A/B	Information Disclosure Statement (USPTO Form SB/08A & B)
PA-A	<i>Automated Student Registration Using Touch-Tone Telephone/Voice Response, An Application Note</i> , Periphonics Corporation, 1986. ("Student Registration" or "SR")
PA-B	<i>Advanced Function VRU Applications</i> , Thomas E. Calabrese, 1989. ("Calabrese")
PA-C	<i>AT&T's Conversant™ I Voice System</i> , John P. Moosemiller, 1986. ("Moosemiller")
PA-D	U.S. Patent 4,797,911 to Szlam et al. ("Szlam")

B. RELEVANT PATENT MATERIALS (PAT)

PAT-A	U.S. Patent 5,974,120 ("the '120 Patent")
PAT-C	Terminal Disclaimer for the '120 Patent

C. CLAIM CHARTS (CC)

CC-A	Claim Chart Comparing the Combination of Periphonic's Student Registration and Calabrese to claim 61 of the '120 Patent
CC-B	Claim Chart Comparing the Combination of Periphonic's Student Registration, Moosemiller and Szlam to claim 61 of the '120 Patent

D. OTHER DOCUMENTS (OTH)

OTH-A	<u>Conclusions of Law Regarding Patent Claim Construction</u> ; <i>Ronald A. Katz, Technology Licensing, L.P., v .AT&T Corp.</i> , 63 F.Supp. 2d 583 (E.D. Pa 1999).
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- OTH-B Order RE: Claim Construction; *Verizon Cal. Inc., v. Ronald A. Katz Technology Licensing, L.P.*, 326 F.Supp. 2d 1060 (C.D. Cal 2003).
- OTH-C Plaintiff's Definitions for Claim Terms Identified by AT&T Corp. in its Initial Listing of Claims to be Construed, filed March 11, 1998 in *Ronald A. Katz, Technology Licensing, L.P., v. AT&T Corp.*, Civil Action No. 97-CV-4453 (E.D. Pa).
- OTH-D Plaintiff's Response to Second Listing of Defendant AT&T Corp. of Claim Terms to Be Construed, filed May 20, 1998 in *Ronald A. Katz, Technology Licensing, L.P., v. AT&T Corp.*, Civil Action No. 97-CV-4453 (E.D. Pa).
- OTH-E Plaintiff Ronald A. Katz Technology Licensing, L.P.'s Patent Local Rule 4-2 Disclosure of Preliminary Claim Constructions, filed April 24, 2006 in *Ronald A. Katz Technology Licensing, L.P. v. Citibank, N.A.*, Civil Action No. 5:05-CV-142-DF (E.D. Tex.).
- OTH-F Plaintiff's and Defendants' Joint Claim Construction and Pre-Hearing Statement Pursuant to Patent Rule 4-3, filed July 25, 2006 in *Ronald A. Katz Technology Licensing, L.P. v. Citibank, N.A.* Civil Action No. 5:05-CV-142-DF (E.D. Tex.).

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REQUEST FOR *EX PARTE* REEXAMINATION OF U.S. PATENT 5,974,120

Dear Sir:

Pursuant to 35 U.S.C. §§ 302-307, 37 C.F.R. § 1.510, and MPEP § 2295, GEICO Corporation, GEICO Casualty Company, GEICO General Insurance Company, GEICO Indemnity Company and Government Employees Insurance Company (collectively, "GEICO") (herein after "Requester") hereby respectfully request reexamination of claim 61 of U.S. Patent 5,974,120 ("the '120 patent") filed on June 7, 1995 and issued Oct. 26, 1999 to Ronald A. Katz.

Exhibit PAT-A. Reexamination is requested¹ in view of the substantial new questions of patentability ("SNQ") presented below:

- The combination of Periphonic's Student Registration ("SR") and Calabrese raises an SNQ with regard to claim 61 of the '120 patent under 35 U.S.C. § 103; and
- The combination of SR, Moosemiller and Szlam raises an SNQ with regard to claim 61 of the '120 patent under 35 U.S.C. § 103.

The BPAI has already affirmed rejections of related claims 56 and 67. See *Ex parte Ronald A. Katz Technology Licensing, L.P.*, Appeal No. 2010-006100 (May 3, 2011) (hereafter, "BPAI"). First, the BPAI affirmed the rejection of claim 56 (from which claim 61 depends) as obvious over SR and Calabrese. Second, the BPAI also affirmed rejection of claim 67 (which includes a limitation substantially similar to the additional limitation of claim 61) as obvious over SR and Calabrese. Thus, the BPAI found, effectively, that the limitations of claim 61 are disclosed by the combination of SR and Calabrese, and that it is appropriate to combine these references.

The Federal Circuit has made similar findings in a related litigation proceeding. The Federal Circuit affirmed the district court's determination that claims 57 and 63 of the '120 patent (each depend from claim 56) are obvious over SR and Moosemiller, and claim 67 of the '120 patent (which, again, includes a limitation substantially similar to the additional limitation of claim 61) is obvious over SR and Szlam. *In re Katz Interactive Call Processing Patent Litigation*, 2011 WL 607381, *33-34 (Fed. Cir. Feb. 18, 2011). Thus, the Federal Circuit not

¹ By simply filing this Request in compliance with the Patent Rules, Requester does not represent, agree, or concur that the '120 patent is enforceable. As alleged by the Patent Owner in the Underlying Litigation (cited below), and as required by 37 C.F.R. § 1.510(a), the '120 patent is still within its period of enforceability for reexamination purposes, to the extent that the '120 patent has not lapsed for failure to pay maintenance fees, has not been the subject of any Terminal Disclaimer, and has not yet been held unenforceable in a court of competent jurisdiction. By asserting the SNQs herein, Requester specifically asserts that claim 61 of the '120 patent is in fact not patentable and as such the U.S. Patent and Trademark Office (the "Office") should reexamine and find claim 61 unpatentable and cancel claim 61 of the '120 patent, rendering claim 61 the '120 patent null, void, and unenforceable.

only found that similar elements to those at issue in claim 61 were disclosed in SR, Moosemiller and Szlam, but also affirmed the combination of SR with each of Moosemiller and Szlam.

CLAIM 56 was found obvious by: BPAI in view of SR and Calabrese; FED CIR in view of SR and Moosemiller	CLAIM 61	CLAIM 67 was found obvious by: BPAI in view of SR and Calabrese; FED CIR in view of SR and Szlam
56. A process for interfacing, through a telephone-communication facility, (1) callers who are at a multitude of remote terminals for voice-digital communication with (2) a system for prompting the callers with caller cues, said process comprising the steps of:		67. A process for interfacing, through a telephone-communication facility, (1) callers who are at a multitude of remote terminals for voice-digital communication with (2) a system for prompting the callers with caller cues, said process comprising the steps of:
establishing telephone communications between the callers and the system, the system having a receiving unit for receiving digital signals including dialed-number identification signals provided automatically from the telephone-communication facility;		
utilizing the dialed-number identification signals to identify one from a plurality of numbers dialed by the callers;		
also receiving at the receiving unit identification signals relating to the callers;		receiving identification signals at a receiving unit of the system,
	61. A process according to claim 56, wherein <u>the identification signals relating to the callers are calling number identification signals automatically provided by the telephone-communication facility.</u>	<u>the identification signals indicating telephone numbers of the multitude of remote terminals, the identification signals being automatically provided by the telephone-communication facility;</u>
testing said identification signals relating to the callers to determine whether to qualify the callers for access to at least a portion of operations of the system;		testing, to determine whether to qualify the callers for voice-digital communication with the system, the identification signals that indicate the telephone numbers;
utilizing, for qualified callers, the identification signals relating to the callers, to avoid prompting certain callers with a certain previously provided cue or cues; and		utilizing, for qualified callers, the identification signals that indicate the telephone numbers to avoid prompting certain callers with a certain previously provided cue or cues; and
providing to the qualified callers at least one other caller cue.		providing to the qualified callers at least one other caller cue.

As set forth below, Requester respectfully submits that substantial new questions of patentability exist with respect to claim 61 of the '120 patent.

I. OVERVIEW OF THE '120 PATENT AND SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY

A. RELATED CO-PENDING LITIGATION REQUIRES TREATMENT WITH SPECIAL DISPATCH AND PRIORITY OVER ALL OTHER CASES

The '120 patent, specifically claim 61, is involved in the following currently pending litigation:

- *In Re: Katz Interactive Call Processing Patent Litigation*, Ca. No. 07-ml-01816-B-RGK (FFMx) (CACD February 21, 2008)

Claim 61 of the '120 patent is currently being asserted as enforceable against GEICO in the above-identified multi-district litigation. Accordingly, pursuant to 35 U.S.C. § 305, it is respectfully urged that this Request be granted and reexamination conducted not only with "**special dispatch**," but also with "**priority over all other cases**" in accordance with MPEP § 2261, due to the nature of the litigation.

B. RELATED CO-PENDING REEXAMINATIONS

The '120 patent is the subject of three merged, co-pending reexamination proceedings. A first request for ex parte reexamination of the '120 patent was filed on September 20, 2006 and assigned Reexamination Control No. 90/008,229 ("the '229 proceeding"). A second request for ex parte reexamination of the '120 patent was filed on November 7, 2007 and assigned Reexamination Control No. 90/010,044 ("the '044 proceeding"). A third request for ex parte reexamination of the '120 patent was filed on March 28, 2008 and assigned Reexamination Control No. 90/010,130 ("the '130 proceeding").

Claims 28 and 56 of the '120 patent were the subject of the '229 proceeding as filed. Claims 28, 34, 56, 62, 67 and 73 of the '120 patent were the subject of the '044 proceeding as filed. Claim 57 of the '120 patent was the subject of the '130 proceeding. The '229, '044 and '130 proceedings were merged as the '229 proceeding. Following final rejections of claims 28, 34, 56, 57, 62, 67 and 73 of the '120 patent in the merged '229 proceeding, patent owner filed an appeal to the Board of Patent Appeals and Interferences. On May 3, 2011 the BPAI affirmed rejections of all claims. Further appellate proceedings remain pending.

Claim 61 was not requested to be reexamined in the merged, co-pending '229 proceeding. However, the instant request is related to the '229 proceeding in that it utilizes one of the same combinations of art raised in the '229 proceeding. The instant request also utilizes other references applied in rejections affirmed in the '229 proceeding. In particular, the instant request asserts identical arguments used for the elements of claim 56, from which 61 depends. The instant request also asserts identical arguments used for the elements of claim 67 (which includes a limitation substantially similar to the additional limitation of claim 61). The instant request asserts that these combinations each raise an SNQ as to claim 61.

In order to satisfy the requirements of 37 C.F.R. § 1.510(b)(2) that each SNQ include a detailed description, the arguments from the previous reexamination requests that resulted in the Office ordering reexamination of claims 56 and 67 are reproduced herein without modification. The only additional arguments are those raised with respect to claim 61, which is the only claim for which reexamination is requested in this filing.

C. CLAIM 61 OF THE '120 PATENT

Claim 56 of the '120 patent recites:

56. A process for interfacing, through a telephone-communication facility, (1) callers who are at a multitude of remote terminals for voice-digital communication with (2) a system for prompting the callers with caller cues, said process comprising the steps of:

establishing telephone communications between the callers and the system. the system having a receiving unit for receiving digital signals including dialed-number identification signals provided automatically from the telephone-communication facility;

utilizing the dialed-number identification signals to identify one from a plurality of numbers dialed by the callers;

also receiving at the receiving unit identification signals relating to the callers;

testing² said identification signals relating to the callers to determine whether to qualify³ the callers for access to at least a portion of operations of the system;

utilizing, for qualified callers, the identification signals relating to the callers, to avoid prompting certain callers with a certain previously provided cue or cues; and

providing to the qualified callers at least one other caller cue.

Claim 61 of the '120 Patent recites:

61. A process according to claim 56, wherein the identification signals relating to the callers are calling number identification signals automatically provided by the telephone-communication facility.

D. OVERVIEW OF CLAIM 61 OF THE '120 PATENT

Claim 56 of the '120 patent is generally directed to a telephone call processing system for receiving calls to a game or contest, with means to limit repeat-call advantages. The system prompts callers with caller cues. In order to avoid prompting a repeat-caller with the same caller cues, which would give a caller repeat-call advantages, the system receives identification signals

² The patentee has asserted that "testing" means to consider with respect to specified criteria. *See* Exhibit OTH-C, p. 35.

³ The patentee has asserted that "to qualify" or "qualifying" means "determining whether a condition that must be met in order to exercise certain rights has been satisfied." *See* Exhibit OTH-C, pp. 36, 27.

relating to the callers. The system tests these identification signals to determine whether to qualify the callers for access to a portion of the operations of the system, and then utilizes the identification signals to avoid prompting certain callers with certain previously provided cues and providing those certain callers with at least one other caller cue.

Claim 61 of the '120 Patent additionally requires that the identification signals are “calling number identification signals automatically provided by the telephone-communication facility.” As described in the specification of the '120 patent, this limitation requires the identification signals to be "ANI" (Automatic Numerical Identification). *See* '120 patent at 2:7-11. “ANI” are signals indicating a caller's telephone number. Specifically, “ANI” provides digital identification signals representing the number associated with the calling terminals.

It is important to note that claim 67, like claim 61, also requires “identification signals being automatically provided by the telephone-communication facility.” In other words, claims 61 and 67 both require that the identification signals of claim 56 be “ANI.” And the BPAI and the Federal Circuit, collectively, found claim 67 obvious over Student Registration and Calabrese and Student Registration and Szlam.

E. SUMMARY OF THE PRIOR ART

The prior art submitted with the instant request discloses all of the limitations of claim 61 of the '120 Patent. *See* Exhibit PA-A through PA-D. All of the references submitted herein were previously submitted in the merged '229 proceeding. In the merged proceeding, however, claim 61 was not requested to be reexamined. Accordingly, claim 61 the '120 patent should be reexamined, rejected and canceled pursuant to this Request.

1. STUDENT REGISTRATION ("SR")

The article, *Automated Student Registration Using Touch-Tone Telephone/Voice Response, An Application Note*, 1986 ("Student Registration" or "SR"), is directed to automated student registration through a touch-tone telephone. Student Registration describes the system as follows:

Automated student registration through Touch-Tone telephone/voice response is the most exciting innovation since the computerization of the registration process. All pre-authorized students are given the ability to choose, add or drop courses from any Touch-Tone telephone – anywhere! Each transaction is automatically prompted and confirmed by computer controlled spoken messages. An interface between your existing computer system and the telephone network is provided by a Voice Response System and appropriate software. This technique is compatible with both on-line and batch systems, as shown in Figure 1-1.

Pg. 1-1.

2. CALABRESE

The article, *Advanced Function VRU Applications*, 1989 ("Calabrese"), is directed to implementations of Voice Response Units (VRUs). VRU applications include various insurance industry services involving automatic screen transfer, use of network services such as DNIS and ANI, voice recognition, and speech synthesis. The use of automatic voice processing versus a live operator to handle client calls can lead to improved customer service, operating cost reductions, competitive pressures, and customer preferences.

3. MOOSEMILLER

The article, *AT&T's Conversant™ I Voice System*, 1986 ("Moosemiller"), is directed to a voice response system for automated information services use. The system accesses databases via the public telephone network, where telephones become instant terminals eliminating the

need for computer peripheral and providing easy availability. Callers access the system through touch-tone signals, speaking isolated words and connected digit strings, or by using modems and data terminal equipment; the system then responds with high-quality, natural sounding speech using an advanced speech coding algorithm. Conversant applications include, *inter alia*, financial services, credit authorization, and college registration.

4. SZLAM

U.S. Patent 4,797,911 to Szlam et al., filed June 16, 1987, is directed to a customer account online servicing center. Szlam discloses a method and apparatus for relieving the operator of the duty of causing the number to be dialed and waiting for an answer, relieves the operator of the duty of obtaining preliminary customer account information, and provides for online, direct updating of the customer account information in the mainframe, thereby eliminating the need for consolidation of changes into the customer account file and thereby providing the operator with the most current information on the customer account.

Szlam also discloses an apparatus that automatically answers incoming calls, queries the customer as to the nature of his call, obtains preliminary information, such as the customer account code and/or the reason for the call from the caller, obtains the current customer account information from the mainframe, routes the incoming call to the next available operator, and provides, at the operator's terminal, the customer account information and the nature of the query.

Szlam also discloses an apparatus that automatically answers incoming calls, obtains the calling party's telephone number (ANI) from the telephone company central office equipment, retrieves, from the mainframe, the current customer account information corresponding to the

calling party's telephone number, routes the call to the next available operator, and provides, at the operator's terminal, the current customer account information retrieved from the mainframe.

F. OVERVIEW OF THE SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY

For the reasons set forth below, SNQs exist with respect to claim 61 of the '120 patent. In particular, the Federal Circuit already found claim 56 (from which claim 61 depends) obvious over Student Registration and Moosemiller. Similarly, the BPAI already found claim 56 (from which claim 61 depends) obvious over Student Registration and Calabrese. For the ANI feature, the Federal Circuit found claim 67 (which additionally requires "ANI" like claim 61) obvious over Student Registration and Szlam. Also for the ANI feature, the BPAI found claim 67 (reciting ANI) obvious over Student Registration and Calabrese. Therefore, the Office should order reexamination of claim 61 of the '120 patent and reject claim 61 as being unpatentable.

The following tables summarize the prior determinations by the Federal Circuit and BPAI with respect to the particular features recited in claim 61 of the '120 patent, which depends from claim 56.

1. CLAIM 56 – RECEIVING DNIS

Prior Art	Federal Circuit	BPAI
Moosemiller	"Moosemiller system can identify the number that the caller has dialed" (p. 33)	Examiner rejection as to Moosemiller rendered moot by alternative affirmance
Calabrese	Reference not subject to appeal	"DNIS services" (p. 13)

2. CLAIM 56 – USING DNIS TO IDENTIFY TELEPHONE NUMBERS

Prior Art	Federal Circuit	BPAI
Moosemiller	"Moosemiller system can identify the number that the	Examiner rejection as to Moosemiller rendered moot

	caller has dialed and use that information to classify incoming calls” (p. 33)	by alternative affirmance
Calabrese	Reference not subject to appeal	“DNIS services ... ‘to trigger application processing based on the number dialed’” (p. 13)

3. CLAIM 56 – RECEIVING ID SIGNALS RELATING TO CALLERS

Prior Art	Federal Circuit	BPAI
Moosemiller	“Moosemiller discloses ... allowing callers to log in to the system with touchtone signals.” (p. 33)	Examiner rejection as to Moosemiller rendered moot by alternative affirmance
Student Registration	“Students use their identification numbers to register for courses.” (p. 33) “Student Registration discloses multi-faceted identification techniques” (p. 34)	“if the student enters a correct student ID and personal access code” (p. 26)
Calabrese	Reference not subject to appeal	Fact #7 - “For the Traveler’s current VRU-based applications, ‘[o]ne of the most critical aspects ... is the initial entry by the caller of the proper Account Number (Employee ID, Account #, Policy #, etc.)” (p. 12)

4. CLAIM 56 – TESTING ID SIGNALS RELATING TO CALLERS

Prior Art	Federal Circuit	BPAI
Moosemiller	“Moosemiller discloses ... allowing callers to log in to the system with touchtone signals.” (p. 33)	Examiner rejection as to Moosemiller rendered moot by alternative affirmance
Student Registration	“Students use their identification numbers to register for courses.” (p. 33) “Student Registration	“if the student enters a correct student ID and personal access code” (p. 26)

	discloses multi-faceted identification techniques” (p. 34)	
Calabrese	Reference not subject to appeal	Fact #7 – “failure to get a valid account number touch-toned in.” (pp. 12-13).

5. CLAIM 56 – CUE SUPPRESSION

Prior Art	Federal Circuit	BPAI
Student Registration	“the system will use Dialog #23 if the student wishes to be placed on a course registration waiting list. If the student is already on the waiting list, the system will not play Dialog #23 but will instead play Dialog #27” (p. 33) “the Student Registration system uses student numbers to access the caller’s registration status and avoid giving repeat cues” (p. 34)	“Periphonics teaches that dialogue design for the voice response system is important for the speed and capacity of the system, including ‘all ‘go wrong’ possibilities in the registration processing.’ (FF 13.) As an example, Periphonics teaches that some possible responses include: ‘Your student ID number or your personal access code is not on our file’, ‘You are now registered for 12 credits’ or ‘You are not registered for any classes.’ (FF 14). In other words, if the student enters a correct student ID and a personal access code, the response ‘Your student ID number or your personal access code is not on our file’ can be avoided and the student receives a response related to class registration status.” (p. 26)

6. CLAIM 56 – PROVIDING ANOTHER CALLER CUE

Prior Art	Federal Circuit	BPAI
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Student Registration	Not subject to appeal on this issue	“when the student enters a correct student ID number and a correct personal access code, Periphonics provides another example of a response message ... [and] this response message is not ‘merely informational,’ because it solicits the student to register for classes.” (pp. 27-28).
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7. CLAIM 61 – ID SIGNALS AS ANI

Prior Art	Federal Circuit	BPAI
Szlam	“Claim 67 is therefore an obvious combination of Student Registration’s cue suppression with the ANI-based identification process of Szlam.” (p. 34)	Examiner rejection as to Szlam rendered moot by alternative affirmance
Calabrese	Reference not subject to appeal	Fact #7 – “by using ANI to automatically capture the phone number of the caller, the VRU can cross-reference the caller’s phone number with a host database to obtain the caller’s ID number and latest claim status, for example.” (p. 13)

8. CLAIM 61 – PRIOR ART COMBINATIONS

Prior Art	Federal Circuit	BPAI
Student Registration and Calabrese	Combination not subject to appeal	“A person of ordinary skill in the art would have recognized that incorporating the dialogue of Periphonics’ voice response system including ‘all ‘go wrong’

		possibilities’ with Calabrese’s voice response units would provide the advantage of enhancing the speed and capacity of the voice response units.” (p. 27).
Student Registration and Moosemiller	“The Court also invalidated several of the Dual Call Mode claims for the ‘120 patent in view of two prior art references known as ‘Student Registration’ and ‘Moosemiller.’ ... We affirm all of those rulings.” (p. 30).	Examiner rejection as to Student Registration and Moosemiller rendered moot by alternative affirmance
Student Registration and Szlam	“The problem with Katz’s argument is that claim 67 reads on any method to suppress cues by identifying callers based in part on ANI data. And Student Registration discloses multi-faceted identification techniques such as using a personal identification number or a birth date in addition to a registration number. Claim 67 is therefore an obvious combination of Student Registration’s cue suppression with the ANI-based identification process of Szlam.” (p. 34)	Examiner rejection as to Student Registration and Szlam rendered moot by alternative affirmance

A complete listing of the prior art submitted with this Request is provided in the attached Information Disclosure Statement (USPTO Form PTO-SB/08A/B), together with a full copy of each listed document, all of which are included as Exhibits PA-A through PA-D.

- PA-A *Automated Student Registration Using Touch-Tone Telephone/Voice Response, An Application Note*, Periphonics Corporation, 1986. ("Student Registration" or "SR")
- PA-B *Advanced Function VRU Applications*, Thomas E. Calabrese, 1989. ("Calabrese")
- PA-C *AT&T's Conversant™ I Voice System*, John P. Moosemiller, 1986. ("Moosemiller")
- PA-D U.S. Patent 4,797,911 to Szlam et al. ("Szlam")

Further, pursuant to the recently announced policy of the Office concerning revised reexamination procedures to provide for a scheduling-type order of expected substantive action dates in Requests ordered after the Office's 2005 fiscal year, Requester respectfully seeks such a scheduling order upon the grant of this Request.

G. CLAIM CONSTRUCTION

In accordance with 37 C.F.R § 1.555(b) and MPEP § 2111, each term of the claims is to be given its "broadest reasonable construction" consistent with the specification. MPEP § 2111; *In re Trans Texas Holding Corp.*, No. 2006-1599, -1600, p.14 (Fed. Cir. August 22, 2007)(citing *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). As the Federal Circuit noted in *Trans Texas*, the Patent Office has traditionally applied this standard during reexamination and does not interpret claims as a court would interpret claims. MPEP § 2111. The Patent Office is not bound by any prior district court claim construction. *Trans Texas*, No.2006-1599 at 14, 19. Rather:

the PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification.

In re Morris, 127 F.3d 1048, 1054-55, 44 U.S.P.Q.2d 1023, 1027-28 (Fed. Cir. 1997)

The rationale underlying the "broadest reasonable" standard is that it reduces the possibility that a claim, after issue or certificate of reexamination, will be interpreted more broadly than is justified. 37 C.F.R § 1.555(b), MPEP § 2111.

Because the standards of claim interpretation used in the courts in patent litigation are different than the claim interpretation standards used in the Office in claim examination proceedings (including reexamination), any claim interpretations submitted herein for the purpose of demonstrating an SNQ are neither binding upon litigants in any litigation related to the '120 patent nor do such claim interpretations necessarily correspond to the construction of claims under the legal standards that are mandated to be used by the courts in litigation. *See* MPEP § 2286 II (determination of an SNQ is made independently of a court's decision on validity because of different standards of proof and claim interpretation employed by the District Courts and the Office); *see also In re Zletz*, 893 F.2d 319, 322, 13 USPQ2d 1320,1322 (Fed. Cir. 1989); 35 U.S.C. § 305.

For purposes of this Request, the Requester has and will construe all claim language as least as broadly as in those claim constructions asserted by the Patent Owner in litigation proceeding involving the '120 Patent. *See* Plaintiffs' Definitions for Claim Terms Identified by AT&T Corp. in its Initial Listing of Claims to be Constructed, Exhibit OTH-C; Plaintiffs' Response to Second Listing of Defendant AT&T Corp. of Claim Terms to be Construed, Exhibit OTH-D; Plaintiff Ronald A. Katz Technology Licensing, L.P.'s Patent Local Rule 4-2 Disclosure of Preliminary Claim Constructions, Exhibit OTH-E; Plaintiff's and Defendants' Joint Claim Construction and Pre-Hearing Statement Pursuant to Patent Rule 4-3; Exhibit OTH-F. Such statements by the

patentee may be used by the Office to interpret the claim language at issue.⁴ When the claims are interpreted in the manner proffered by Patent Owner, or even under a narrower, more reasonable interpretation of the claims, the claims are unpatentable in view of the new prior art references presented herein.

By construing the claim language in the manner proffered by Patent Owner, and/or as otherwise set forth explicitly or implicitly herein, the Requester is neither admitting nor acquiescing as to the correctness and/or reasonableness of Patent Owner's implicit or explicit claim constructions.

II. STATEMENT UNDER 37 C.F.R. § 1.510(b) OF EACH SUBSTANTIAL NEW QUESTION OF PATENTABILITY

This Request is based on the cited prior art documents listed above and on the accompanying Information Disclosure Statement (USPTO Form PTO-SB/08A/B). Exhibit PA-SB/08A/B. All of these cited prior art publications constitute effective prior art as to the claims of the '120 patent under 35 U.S.C. § 103.

Claim 61 of the '120 patent is rendered obvious under § 103 by the various prior art references cited herein. The '044 proceeding summarizes the prosecution history and related proceedings history of the '120 patent. *See* '044 proceeding, 2/1/2008 Determination at 3-4. Specifically, the Examiner concluded, for claims 56, 62, 67 and 73, that "[t]he prosecution history also indicates [sic] the examiner of the '185 application subsequently allowed the claims without rejecting them over prior art references without providing reasons for allowance (the '185 application, Office action filed 16 November 1998, p. 5 and Notice of Allowance filed 21

⁴ *See* 37 C.F.R. § 1.104(c)(3): "In rejecting claims the Examiner may rely upon admissions by the applicant, or the Patent Owner in a reexamination proceeding, as to any matter affecting patentability[.]"

June 1999).” *See* ‘044 proceeding, 2/1/2008 Determination at 3. In addressing the ‘229 proceeding as part of the ‘044 proceeding, the Examiner recognized:

(b) Issued **claims 56, 62, 67, and 73** include the features, (i) using identification data signals “to avoid prompting certain callers with a certain previously provided cue or cues”, and (ii) providing at least one other caller cue.

Accordingly, a reference teaching a call processing system that includes at least one of the features in (a) or (b), above, may raise a substantial new question of patentability at to claims 28, 32, 56, 62, 67, and 73 of the ‘120 patent, notwithstanding the requirement for a reasonable examiner to find the reference important to the patentability of the claims.

See ‘044 proceeding, 2/1/2008 Determination at 4.

With respect to the applied prior art in the instant proceeding, the reference Moosemiller and Szlam are cited on the face of the ‘120 patent, however, neither Moosemiller or Szlam was cited in a rejection by the examiner, and further these references are presented in this request in combination with art not before the Office during the prosecution of the ‘120 patent. The remaining references, Student Registration and Calabrese, were not submitted to the Office during the prosecution of the ‘120 patent.

The Student Registration reference, applied in each proposed SNQ below, specifically discloses the pertinent features for claim 56 of the ‘120 patent found lacking in the prior art during prosecution: (i) using identification data signals “to avoid prompting certain callers with a certain previously provided cue or cues”, and (ii) providing at least one other caller cue.

Specifically, the Federal Circuit affirmed the district court’s determination that SR discloses these features. The Federal Circuit explained that:

In the Student Registration system, students use their identification numbers to register for courses, and the system provides different messages dependent on a student’s registration status. For example, the system will use Dialog #23 if the student wishes to be placed on a course registration waiting list. If the student is already on the waiting list, the system will not play Dialog #23 but will instead play Dialog #27, which tells the student that he or she is already registered or is on the waiting list for the course. Katz argues that the asserted claims of the ‘120 patent require a system that tracks the cues a user has received, and that Student

Registration discloses a system that tracks only the student's registration status. The asserted claims, however, simply requiring using identification signals to avoid repeating cues; they do not dictate how that must be accomplished. Because the Student Registration system uses student numbers to access the caller's registration status and avoid giving repeat cues, Student Registration clearly discloses the "cue suppression" limitation.

In re Katz, 2011 WL 607381, *33-34.

Further, in the related and merged '229 proceeding, the BPAI also concluded that Student Registration (referenced as "Periphonics") discloses these features. The BPAI explained that:

Periphonics teaches that dialogue design for the voice response system is important for the speed and capacity of the system, including "all 'go wrong' possibilities in the registration process." (FF 13.) As an example, Periphonics teaches that some possible responses include: "Your student ID number or your personal access code is not on our file", "You are now registered for 12 credits" or "You are not registered for any classes." (FF 14.) In other words, if the student enters a correct student ID and a personal access code, the response "Your student ID number or your personal access code is not on our file" can be avoided and the student receives a response related to class registration status. (See FF 14.) Thus Periphonics teaches "utilizing, for qualified callers, the identification signals relating to the callers, to avoid prompting certain callers with a certain previously provided cue or cues" and "providing to the qualified callers at least one other caller cue."

'229 proceeding, 5/3/2011 BPAI at 26.

In more pertinent detail, SR allows qualified callers who have placed themselves on a wait-list, to continue with the registration process by providing a different prompt and skipping a previously provided prompt relating to selecting the wait-list option. See SR, pp. A-1 to A-5, C-1 *Dropping a Class* and *Adding a Class*.

Specifically, after being qualified for access to the system, the caller is provided with Dialog #10. SR, p. A-1.

10: You are now registered for 12 credits.
(or)
You are not registered for any classes.
Please enter your request.

To add a class, the caller provides the following formatted input “A1234#” whereby “A” indicates Add A Class and “1234” specifies the class number, and “#” indicates end of the entry. If the indicated class is not accepting further students for registration, Dialog #23 informs the caller of a wait-list option. SR, p. A-2.

**23: Call number 1234 ENG 101 3 credits is closed.
The number of students on the waiting list is 2.
Enter a W to place your name on the waiting list.**

As shown in Dialog #23, the caller is informed that the class is closed and that the caller can be placed on a wait-list by inputting a “W” (first caller cue). The caller is again provided with Dialog #10 indicating registered credits and also prompted to enter a request. (another caller cue). If the caller again attempts to register for class 1234 by inputting “A1234#”, the system provides the caller with a different response, Dialog #27 (second caller cue). Dialog #27 provides (SR, p. A-2):

**27: You are already registered (waiting) for call number 1234
ENG 101 3 credits.**

The caller is again prompted by Dialog #10 to provide an input to the system (another caller cue). As above, the first caller cue, Dialog #23 is avoided in favor of Dialog #27. The caller, identified by his Student ID number, is not prompted to enter a W to be placed on the wait-list because the caller has already been placed on the wait-list for class 1234. For these reasons, SR teaches the “cue suppression” feature missing in the cited prior art during prosecution of the ‘120 patent.

Therefore all references cited herein have either not been previously before the Office or are being presented in a new light pursuant to MPEP § 2242(II).

A. OBVIOUSNESS OVER THE COMBINATION OF PERIPHONIC'S STUDENT REGISTRATION ("SR") AND CALABRESE

Because, as the Federal Circuit and BPAI have already collectively determined, SR teaches the cue suppression and additional prompt features, and Calabrese teaches DNIS and ANI, the combination of SR and Calabrese, when considered in light of the knowledge of those skilled in the art at the time of the alleged invention of the '120 patent, renders obvious, under 35 U.S.C. § 103, claim 61 of the '120 patent. A claim chart demonstrating the applicability of SR and Calabrese to claim 61 of the '120 patent is attached hereto at Exhibit CC-A, to comply with 37 C.F.R. § 1.510(b)(2). Additionally, the SNQ raised by the present Request is further demonstrated below. Accordingly claim 61 should be reexamined, rejected under 35 U.S.C. § 103, and canceled pursuant to this Request.

B. OBVIOUSNESS OVER THE COMBINATION OF PERIPHONIC'S STUDENT REGISTRATION ("SR") AND MOOSEMILLER AND SZLAM

Because SR teaches the cue suppression and additional prompt features, Moosemiller teaches DNIS, and Szlam teaches ANI, the combination of SR, Moosemiller and Szlam, when considered in light of the knowledge of those skilled in the art at the time of the alleged invention of the '120 patent, renders obvious, under 35 U.S.C. § 103, claim 61 of the '120 patent. A claim chart demonstrating the applicability of SR, Moosemiller and Szlam to claim 61 of the '120 patent is attached hereto at Exhibit CC-B, to comply with 37 C.F.R. § 1.510(b)(2). Additionally, an SNQ raised by the present Request is demonstrated below. Accordingly claim 61 should be reexamined, rejected under 35 U.S.C. § 103, and canceled pursuant to this Request.

III. APPLICATION OF PRIOR ART SUPPORTING SUBSTANTIAL NEW QUESTION OF PATENTABILITY FOR CLAIM 61 OF THE '120 PATENT

Claim 61 of the '120 Patent is set forth in detail on the attached claim charts (Exhibit CC-A through CC-B) that compare the limitations of claim 61 to the pertinent prior art references. As the claim charts demonstrate, claim 61 of the '120 patent is invalid under 35 U.S.C. § 103 in view of the submitted prior art references under a reasonable interpretation of the claims.

Please see attached Exhibits CC-A through Exhibit CC-B presenting claim charts for comparison of the disclosed prior art with the '120 patent

A. CLAIM 61 OF THE '120 PATENT IS UNPATENTABLE UNDER 35 U.S.C. § 103 AS IT IS RENDERED OBVIOUS OVER THE COMBINATION OF PERIPHONIC'S STUDENT REGISTRATION AND CALABRESE

Combination of Periphonic's Student Registration ("SR") and Calabrese

One of ordinary skill in the art would have reason to combine Calabrese and SR.⁵ Calabrese teaches advanced function Voice Response Unit (VRU) applications that recognize and use a caller's number to facilitate automated telephone menu navigation. Calabrese suggests that using applications that implement VRUs benefit from functions such as: (1) increased ease of use; (2) additional cost savings; (3) greater competitive advantage; (4) improved information and content; and (5) improved customer service. Calabrese, p.16. Furthermore, Calabrese teaches that the use of the caller's number as identifying indicia is advantageous in a variety of

⁵ The BPAI confirmed that one of ordinary skill in the art would have reasons to combine Calabrese and SR. '229 proceeding, 5/3/2011 BPAI Decision at 27-28 ("A person of ordinary skill in the art would have recognized that incorporating the dialogue of Periphonics' voice response system including 'all 'go wrong' possibilities' with Calabrese's voice response units would provide the advantage of enhancing the speed and capacity of the voice response units.")

ways including: (1) avoiding human error by reducing user interaction; (2) promoting short call times by reducing user interaction; and (3) adding layers of security/authentication. Calabrese, p.21.

Moreover, Calabrese describes particular advantages of the system. Specifically, Calabrese discloses:

One of the most critical aspects of our current VRU-based applications is the initial entry by the caller of the proper Account Number (Employee ID, Account #, Policy #, etc.). Our highest percentage of calls that must be transferred over to live operators is a result of failure to get a valid account number touch-toned in. We find this is often because the caller does not have it handy when the call is made or he/she makes a keying error on the touch-tone pad. These rejects are the worst in that the caller never really gets into the VRU application because a valid account number is an essential data element. [...]

With an ANI (Automatic Number Identification) capability, we can get by the first step of recognizing who is calling, making the chances for success in the VRU call significantly greater. Assuming our host database has the home and business phone number of the client, and it is up-to-date, we can automatically trigger the proper inquiry to the host. Using ANI we would automatically capture the phone number of the caller as its delivered from the network common Carrier. The VRU answers the phone and greets the caller, the proper host record would be pulled down the VRU based on the phone number match (ex: If we got the call on 203-277-6854 we can cross reference to know that this is Tom Calabrese and his ID number is 040-34-7490. We can then bring down the latest claim status record for this account.) In this manner we have eliminated the difficult part of entry to the VRU where the client must remember, and key in correctly, a long string of digits (Which in some cases may include alpha characters which is even a more serious problem, in that phones do not have alpha keys).

Calabrese, p. 21. These advantages would obviously apply to the use of ANI in SR.

SR teaches an automated telephone registration application that allows students to access and modify their course registration. SR also suggests its applicability to other enhanced interactive applications. For example, SR discloses:

The same system can easily be expanded for many other applications including: admission status; financial aid status; graduation requirements status; course grade information; ordering supplies; job interview scheduling; storm closing

announcement; and many other applications. The only limit is availability of the appropriate data base.

SR, p. 2-1. The combination of Calabrese and SR would have yielded the predictable result of the advanced functioning VRU utilizing the Student Registration application program.⁶

1. CLAIM 56⁷

The preamble of claim 56 (from which claim 61 depends) recites:

A process for interfacing, through a telephone-communication facility,

(1) callers who are at a multitude of remote terminals for voice-digital communication with

(2) a system for prompting the callers with caller cues, said process comprising the steps of:

Shown below in Figure 4, Calabrese discloses *a process for interfacing...callers who are at a multitude of remote terminals for voice-digital communication with a system for prompting the callers with caller cues*. Specifically, Calabrese discloses telephone communication facilities that implement Voice Response Units (VRUs) for automatic voice processing. Calabrese, p. 16. The VRUs accept calls for a wide variety of applications and set up logical paths through the menu structure. Calabrese, p. 23.

⁶ In *KSR*, the United States Supreme Court emphasized that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." The Court provided further instruction stating that "when a patent 'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement, the combination is obvious." *Id.* at 1740 (quoting *Sakraida* at 273.). See also *Ex parte Catan*, Appeal 2007-0820 (BPAI July 3, 2007); *Ex Parte Kubin*, 2007-0819 (BPAI May 31, 2007); *Ex Parte Smith*, Appeal 2007-1925 (BPAI June 25, 2007).

⁷ Although Requester is not requesting reexamination of claim 56, Requester is requesting reexamination of claim 61 which depends on claim 56. Therefore this request presents a detailed explanation of how the prior art applies to the elements of claim 56 even though only claim 61 is requested for reexamination. The arguments presented herein for the elements of claim 56 are similar to the arguments set forth in the merged '229 proceeding in which the Office found an SNQ existed as to claim 56, ultimately affirmed by the BPAI.

Likewise, SR discloses an automated student registration program that uses a touch-tone telephone/voice response system that gives students the ability to choose, add, or drop courses from any touch-tone telephone. SR, p. 1-1. Additionally, SR discloses that "[e]ach transaction is automatically prompted and configured by computer controlled spoken messages." SR, p. 1-1.

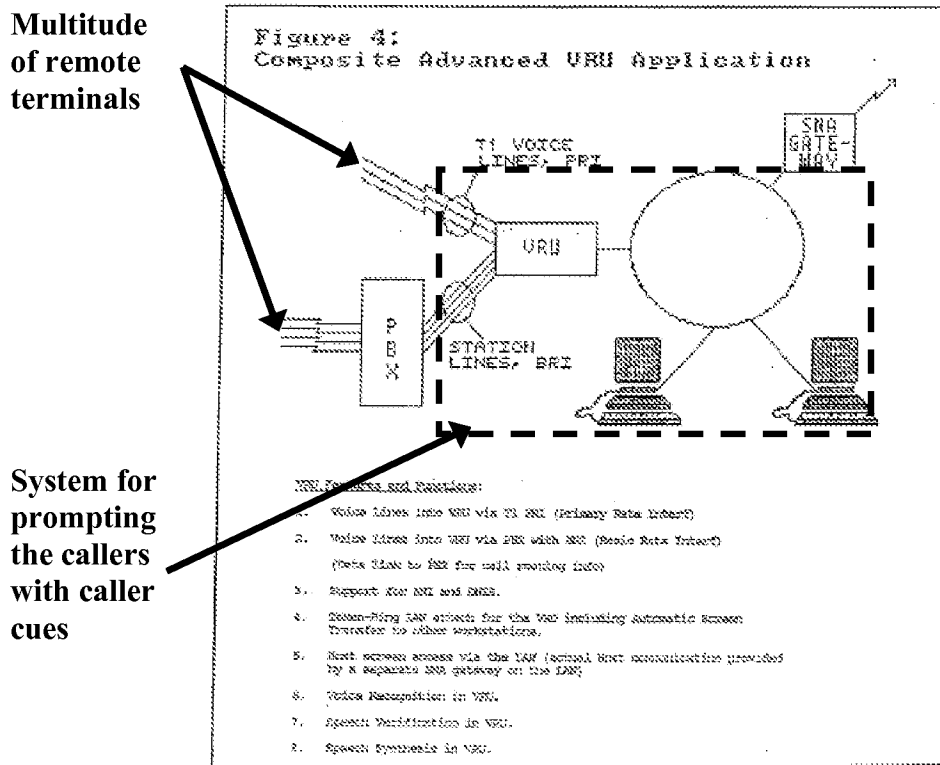


FIGURE 4 OF CALABRESE

The **first limitation** in the body of claim 56 recites:

establishing telephone communications between the callers and the system. the system having a receiving unit for receiving digital signals including dialed-number identification signals provided automatically from the telephone-communication facility;

SR does not explicitly disclose the use of dialed-number identification signals, however, Calabrese discloses a VRU that receives dialed-number identification signals provided from a telephone communication facility, e.g., DNIS (Dialed Number Identification Service). Calabrese, pp. 23, 24, Fig. 4.

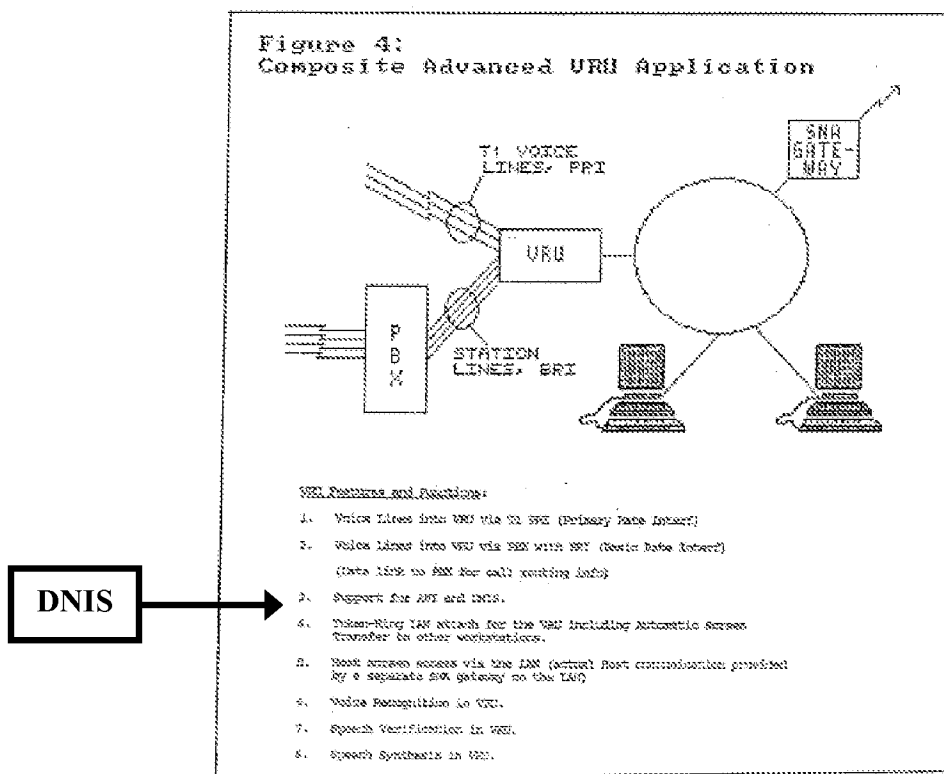


FIGURE 4 OF CALABRESE

The **second limitation** in the body of claim 56 recites:

utilizing the dialed-number identification signals to identify one from a plurality of numbers dialed by the callers;

The premise of DNIS is to use dialed-number identification signals to identify one from a plurality of numbers dialed by the callers. For example, Calabrese discloses that DNIS can be used to set up different logical paths through the menu structure depending on the number the customer dialed to gain access. Calabrese, p. 23.

The **third limitation** in the body of claim 56 recites:

also receiving at the receiving unit identification signals relating to the callers;

Both Calabrese and SR disclose receiving identification signals relating to callers.

Calabrese discloses that the VRUs accept ANI signals that identify the caller based on the caller's telephone number. Calabrese, pp. 23, 21. Calabrese further discloses that a caller may speak-in an account number. Calabrese, p. 18.

SR discloses that a student may enter their student ID numbers and personal access numbers by pressing corresponding buttons on the telephone. SR, pp. A-1, C-1.

The **fourth limitation** in the body of claim 56 recites:

testing said identification signals relating to the callers to determine whether to qualify the callers for access to at least a portion of operations of the system;

Both Calabrese and SR, alone, and in combination disclose testing and qualifying the callers based on the identification signals.

Calabrese discloses that a call made from a known phone number greets the caller by name because it recognizes the phone number from which the caller is calling. Calabrese, p. 23.

SR discloses that a student is allowed to access the system based on their student ID numbers and personal access numbers. SR, pp. A-1, C-1.

The combination of Calabrese and SR would yield the predictable result of the student registration program having the ability to recognize phone numbers and cross reference the number with the student's name and student identification number to then access the latest record for the account. Furthermore, one of ordinary skill in the art would recognize that a student registration program using ANI must still allow users to call from any location, and hence, if the student registration program does not qualify a caller based (at least in part) on the caller's telephone number, the program would also have the ability to qualify the caller using more laborious methods. Furthermore, Calabrese specifically recognizes that a caller may not want to

access the account associated with the telephone number and that the caller may then enter an account number. Calabrese, p. 18.

The **fifth limitation** in the body of claim 56 recites:

utilizing, for qualified callers, the identification signals relating to the callers, to avoid prompting certain callers with a certain previously provided cue or cues; and

The Federal Circuit affirmed the district court's determination that SR discloses this limitation. The Federal Circuit explained that:

In the Student Registration system, students use their identification numbers to register for courses, and the system provides different messages dependent on a student's registration status. For example, the system will use Dialog #23 if the student wishes to be placed on a course registration waiting list. If the student is already on the waiting list, the system will not play Dialog #23 but will instead play Dialog #27, which tells the student that he or she is already registered or is on the waiting list for the course. Katz argues that the asserted claims of the '120 patent require a system that tracks the cues a user has received, and that Student Registration discloses a system that tracks only the student's registration status. The asserted claims, however, simply requiring using identification signals to avoid repeating cues; they do not dictate how that must be accomplished. Because the Student Registration system uses student numbers to access the caller's registration status and avoid giving repeat cues, Student Registration clearly discloses the "cue suppression" limitation.

In re Katz, 2011 WL 607381 at *33-34.

SR allows qualified callers who have placed themselves on a wait-list, to continue with the registration process by providing a different prompt and skipping a previously provided prompt relating to selecting the wait-list option. *See* SR, pp. A-1 to A-5, C-1 *Dropping a Class* and *Adding a Class*.

Specifically, after being qualified for access to the system, the caller is provided with Dialog #10. SR, p. A-1.

10: You are now registered for 12 credits.
(or)
You are not registered for any classes.
Please enter your request.

To add a class, the caller provides the following formatted input "A1234#" whereby "A" indicates Add A Class and "1234" specifies the class number, and "#" indicates end of the entry. If the indicated class is not accepting further students for registration, Dialog #23 informs the caller of a wait-list option. SR, p. A-2.

23: Call number 1234 ENG 101 3 credits is closed.
The number of students on the waiting list is 2.
Enter a W to place your name on the waiting list.

As shown in Dialog #23, the caller is informed that the class is closed and that the caller can be placed on a wait-list by inputting a "W" (first caller cue). The caller is again provided with Dialog #10 indicating registered credits and also prompted to enter a request. (another caller cue). If the caller again attempts to register for class 1234 by inputting "A1234#", the system provides the caller with a different response, Dialog #27 (second caller cue). Dialog #27 provides:

27: You are already registered (waiting) for call number 1234
ENG 101 3 credits.

The caller is again prompted by Dialog #10 to provide an input to the system (another caller cue). As above, the first caller cue, Dialog #23 is avoided in favor of Dialog #27. The caller, identified by his Student ID number, is not prompted to enter a W to be placed on the wait-list because the caller has already been placed on the wait-list for class 1234. Exhibit CC-A identifies further examples of avoiding a previously provided cue as recited in this limitation.

The **final limitation** in the body of claim 56 recites:

providing to the qualified callers at least one other caller cue.

SR allows the registration process to continue for students who have been placed on a class wait-list by prompting them to enter a request code. *See* SR, pp. A-1 to A-5, C-1 *Dropping a Class* and *Adding a Class*.

Specifically, after being informed by Dialog #27 that the caller is on the wait-list for class 1234, the caller is provided with Dialog #10. SR, p. A-1.

10: You are now registered for 12 credits.
(or)
You are not registered for any classes.
Please enter your request.

Exhibit CC-A identifies further examples of avoiding a previously provided cue as recited in this limitation.

2. CLAIM 61

Claim 61 recites:

A process according to claim 56, wherein the identification signals relating to the callers are calling number identification signals automatically provided by the telephone-communication facility.

As shown above, the combination of SR and Calabrese renders claim 56 obvious.

Additionally, the combination of SR and Calabrese discloses the limitation of claim 61. Specifically, SR discloses that a student (a caller) may enter their student ID numbers and personal access numbers (identification signals relating to the callers) by pressing corresponding buttons on the telephone. SR, pp. A-1, C-1. Calabrese discloses an alternative arrangement whereby the calling number, provided via ANI, is delivered by the communication facility (calling number identification signals) and cross-referenced with existing telephone numbers to determine an account identifier match. Calabrese, p. 21 (“If we go the call on 203-277-6854 we

can cross reference to know that this is Tom Calabrese and his ID number is 040-34-7490.”) Calabrese explains how ANI avoids the problem of a caller making “a keying error in the touch-tone pad” when entering identification information into the system. Calabrese, p. 21. By using the ANI feature disclosed by Calabrese in the SR system, a student caller need not enter his student ID number into the system, thereby avoiding a “keying error.”

The combination discloses that ANI, as substituted for the student ID number, is used to determine if the caller is eligible to participate in class registration. Calabrese, p. 21; SR, p. A-1. Specifically, a person of skill in the art would understand from the combined disclosures of SR and Calabrese that after receiving the calling number provided via ANI, the system matches the calling number with a student ID. Based on the student ID, possible responses include, *inter alia*, “You are now registered for 12 credits” (eligible to participate) and “Your student ID number or your or personal access code is not on our file” (not eligible to participate). SR, p. A-1.

The Federal Circuit affirmed the district court’s determination that SR could implement “cue suppression on ANI data.” The Federal Circuit explained for claim 67 of the ‘120 patent that:

Katz contends that students’ mobility and their tendency to share telephone numbers would cause “unpredictable and disastrous results” in a cue suppression system based solely on ANI data. The problem with Katz’s argument is that claim 67 reads on any method to suppress cues by identifying callers based in part on ANI data. And Student Registration discloses multi-faceted identification techniques such as using a personal identification number or a birth date in addition to a registration number.

In re Katz, 2011 WL 607381 at *34.

B. CLAIM 61 OF THE '120 PATENT IS UNPATENTABLE UNDER 35 U.S.C. § 103 AS IT IS RENDERED OBVIOUS OVER THE COMBINATION OF PERIPHONIC'S STUDENT REGISTRATION, MOOSEMILLER AND SZLAM

Combination of Periphonics Student Registration ("SR"), Moosemiller and Szlam

One of ordinary skill in the art would have reason to combine SR, Moosemiller and Szlam.⁸ Moosemiller discloses a voice response and speech recognition product for the growing market of automated information services. The system accesses databases via the public telephone network, and enables telephones to become instant terminals. Moosemiller discloses that callers can access the system through touch-tone signals, speaking related words and connected digit strings, or by using modems and data terminal equipment. Moosemiller **explicitly** teaches that "CONVERSANT I applications include the following broad areas of informational dissemination:...*college registration*." Moosemiller, p.89, col. 1 (emphasis added). Furthermore, Moosemiller states:

When compared with traditional means for providing informational services, the CONVERSANT I System is very cost effective. It reduces attendant cost through automation and provides revenue through new services that were previously uneconomical.

Moosemiller, p.89, col. 3– p.90, col. 1.

One of ordinary skill in the art would have reason to combine and SR. Szlam teaches a method and apparatus for a telephone-based customer account service center. Szlam describes an apparatus that answers incoming calls, obtains the calling party's telephone number from the telephone company central office equipment, retrieves, from the mainframe, the current customer account information corresponding to the calling party's telephone number and routes the call.

⁸ The Federal Circuit affirmed the district court's ruling that one of ordinary skill in the art would have reason to combine Moosemiller and SR and to combine Szlam and Moosemiller. *In re Katz*, 2011 WL 607381 at *33-34. The '229 proceeding included rejections of claim 56 and 67 based on the combinations of Moosemiller and SR and Szlam and SR. The BPAI, however, did not reach the issues pertaining to these combinations because these rejections were deemed cumulative. 5/3/2011 BPAI Decision at 31.

Szlam at 2:59-68. Szlam suggests that the disclosed invention provides advantages because it relieves an operator of obtaining preliminary customer account information, and provides for online (i.e., over a telephone) direct updating of the customer account information in the mainframe, thereby eliminating the need for consolidation of changes into the customer account file. Szlam at 2:29-35.

SR teaches an automated telephone registration application that allows students to access and modify their course registration. The combination of Szlam and SR would have yielded the predictable result of the telephone-based student account service center that utilized the Student Registration application program. The combination would relieve the students of entering preliminary account information, and would provide for direct updating of account information, for example, adding and dropping courses (and all other functions disclosed by SR).⁹ *See In re Katz*, 2011 WL 607381 at *34 (“obvious combination of Student Registration’s cue suppression with ANI-based identification process of Szlam.”).

Moreover, Szlam describes particular advantages of the system, including the advantage of using ANI to obtain preliminary customer account information about a caller. Based upon the express suggestion of Szlam to substitute ANI for touch-tone identification to achieve increased efficiency, one of ordinary skill would be motivated to adapt the SR system to improve upon the registration application with the ANI feature. Specifically, Szlam discloses:

Furthermore, in some areas of the country, the local telephone office provides a service, sometimes called automatic number identification (ANI). In areas where ANI is available, the central office will provide, over the trunk, tone signals, ISDN data signals, or other signals which can be decoded to yield the number

⁹ In *KSR*, the United States Supreme Court emphasized that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” The Court provided further instruction stating that “when a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *Id.* at 1740 (quoting *Sakraida* at 273.). *See also Ex parte Catan*, Appeal 2007-0820 (BPAI July 3, 2007); *Ex Parte Kubin*, 2007-0819 (BPAI May 31, 2007); *Ex Parte Smith*, Appeal 2007-1925 (BPAI June 25, 2007).

from the calling party is calling. In this case, a decoder, such as ANI decoder 10a24 would provide the calling party's telephone number to trunk interface control unit 10a13. Trunk interface control unit 10a13 would then provide the calling party telephone number to system controller 11. System controller 11 requests mainframe 16 to provide the customer account information based upon the calling party telephone number. ...

if the calling party telephone number corresponds to the telephone number of an existing client in the database, then mainframe computer 16 will provide this information either to system controller 11 or to the next available operator terminal.

Szlam at 12:29-59.

SR teaches an automated telephone registration application that allows students to access and modify their course registration. SR also suggests its applicability to other enhanced interactive applications. For Example, SR discloses:

The same system can easily be expanded for many other applications including: admission status; financial aid status; graduation requirements status; course grade information; ordering supplies; job interview scheduling; storm closing announcement; and many other applications. The only limit is availability of the appropriate data base.

SR, p. 2-1. The combination of SR, Moosemiller and Szlam would have yielded the predictable result of a voice response and speech recognition system, with automatic account lookup, that utilized the Student Registration application program.¹⁰

¹⁰ In *KSR*, the United States Supreme Court emphasized that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." The Court provided further instruction stating that "when a patent 'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement, the combination is obvious." *Id.* at 1740 (quoting *Sakraida* at 273.). See also *Ex parte Catan*, Appeal 2007-0820 (BPAI July 3, 2007); *Ex Parte Kubin*, 2007-0819 (BPAI May 31, 2007); *Ex Parte Smith*, Appeal 2007-1925 (BPAI June 25, 2007).

1. CLAIM 56¹¹

The preamble of claim 56 (from which claim 61 depends) recites:

A process for interfacing, through a telephone-communication facility,

(1) callers who are at a multitude of remote terminals for voice-digital communication with

(2) a system for prompting the callers with caller cues, said process comprising the steps of:

Moosemiller discloses:

[T]he CONVERSANT I Voice System, a voice response and speech recognition product for the growing market of automated information services. The system accesses data bases via the public telephone network. Telephones, rotary or touch-tone, can become instant terminals eliminating the need for costly computer peripherals and providing easy availability.

Moosemiller, p. 88, col.1.

Likewise, SR discloses an automated student registration program that uses a touch-tone telephone/voice response system that gives students the ability to choose, add, or drop courses from any touch-tone telephone. SR, p. 1-1. Additionally, SR discloses that "[e]ach transaction is automatically prompted and configured by computer controlled spoken messages." SR, p. 1-1.

Szlam generally discloses a method and apparatus for direct and immediate updating of customer account information, handling inquiries, and initiating communications. Szlam, Abstract. More particularly, Szlam describes an apparatus which answers incoming calls and

¹¹ Although Requester is not requesting reexamination of claim 56, Requester is requesting reexamination of claim 57 which depends on claim 56. Therefore this request presents a detailed explanation of how the prior art applies to the elements of claim 56 even though only claim 57 is requested for reexamination. The arguments presented herein for claim 56 are identical to the arguments set forth in the '044 proceeding in which the Office found an SNQ existed to claim 56.

prompts callers, obtains the calling party's telephone number, retrieves customer account information, and routes the call. Szlam at 2:59-68.

The **first limitation** in the body of claim 56 recites:

establishing telephone communications between the callers and the system. the system having a receiving unit for receiving digital signals including dialed-number identification signals provided automatically from the telephone-communication facility;

Moosemiller discloses the use of the Dialed Number Identification Service (DNIS) for use with a Direct Inward Dialing (DID) trunk interface to receive dialed digits as part of the call setup protocol. Moosemiller, p. 88, col. 3. Moosemiller discloses that DNIS allows advanced classification of incoming calls for different applications which are greeted by appropriate transaction prompts. Moosemiller, p. 88, col. 3. Moosemiller discloses that DNIS features are useful for service bureaus or for multiple-user applications. Moosemiller, p. 88, col. 3.

The **second limitation** in the body of claim 56 recites:

utilizing the dialed-number identification signals to identify one from a plurality of numbers dialed by the callers;

Moosemiller discloses advanced classification of incoming calls for different applications utilizing DNIS. Moosemiller, p. 88, col. 3. Moosemiller discloses that DNIS features are useful for service bureaus or for multiple-user applications. Moosemiller, p. 88, col. 3.

The **third limitation** in the body of claim 56 recites:

also receiving at the receiving unit identification signals relating to the callers;

SR discloses that students may enter their student ID numbers and personal access numbers by pressing corresponding buttons on the telephone. SR, pp. A-1, C-1. Therefore, the combination of Moosemiller and SR teaches receiving identification signals at the receiving unit relating to the callers (student ID and/or personal access number) at a receiving unit.

Szlam discloses “receiving at the receiving unit identification signals relating to the callers.” Szlam discloses a trunk interface unit that contains an automatic number identification (ANI) decoder, which receives identification signals indicating telephone numbers. Szlam at 11:60-68. Moreover, Szlam discloses that “[i]n areas where ANI is available, the central office will provide, over the trunk, tone or other signals which can be decoded to yield the number from which the calling party is calling. In this case, a decoder, such as ANI decoder 10a24 would provide the calling party's telephone number to trunk interface control unit 10a13.” Szlam at 12:31-37.

The **fourth limitation** in the body of claim 56 recites:

testing said identification signals relating to the callers to determine whether to qualify the callers for access to at least a portion of operations of the system;

SR discloses that a student is allowed to access the system based on their student ID numbers and personal access numbers. SR, pp. A-1, C-1. That is, a student's ID and personal access number are tested to determine whether to qualify the student for access to the system.

SR does not specifically disclose identification signals that are calling number identification signals to qualify the callers, but instead asks the students to enter their student ID number and personal access code. However, Szlam discloses a system with the ability to automatically answer incoming calls, obtain the calling party's telephone number from the telephone company central office equipment and retrieve the current customer account information corresponding to the calling party's telephone number. Szlam at 2:59-68.

The combination of Szlam and SR would yield the predictable result of the student registration program having the ability to recognize phone numbers and cross reference the number with the student's name and student identification number to then access the student's

account. Furthermore, one of ordinary skill in the art would recognize that a student registration program using ANI must still allow users to call from any location, and hence, if the student registration program does not qualify a caller based (at least in part) on the caller's telephone number, the program would also have the ability to qualify the caller using more laborious methods. Szlam specifically recognizes that a caller may need to transmit additional information, such as a phone number or account number to access the system. Szlam at 12:14-28, 12:44-59.

The **fifth limitation** in the body of claim 56 recites:

utilizing, for qualified callers, the identification signals relating to the callers, to avoid prompting certain callers with a certain previously provided cue or cues; and

The Federal Circuit affirmed the district court's determination that SR discloses this limitation. The Federal Circuit explained that:

In the Student Registration system, students use their identification numbers to register for courses, and the system provides different messages dependent on a student's registration status. For example, the system will use Dialog #23 if the student wishes to be placed on a course registration waiting list. If the student is already on the waiting list, the system will not play Dialog #23 but will instead play Dialog #27, which tells the student that he or she is already registered or is on the waiting list for the course. Katz argues that the asserted claims of the '120 patent require a system that tracks the cues a user has received, and that Student Registration discloses a system that tracks only the student's registration status. The asserted claims, however, simply requiring using identification signals to avoid repeating cues; they do not dictate how that must be accomplished. Because the Student Registration system uses student numbers to access the caller's registration status and avoid giving repeat cues, Student Registration clearly discloses the "cue suppression" limitation.

In re Katz, 2011 WL 607381 at *33-34.

SR allows qualified callers who have placed themselves on a wait-list, to continue with the registration process by providing a different prompt and skipping a previously provided

prompt relating to selecting the wait-list option. See SR, pp. A-1 to A-5, C-1 *Dropping a Class* and *Adding a Class*; compare Szlam at 14:4-22 (disclosing caller interactions using prerecorded prompts and receiving responses to prompts).

Specifically, after being qualified for access to the system, the caller is provided with Dialog #10. SR, p. A-1.

10: You are now registered for 12 credits.
(or)
You are not registered for any classes.
Please enter your request.

To add a class, the caller provides the following formatted input “A1234#” whereby “A” indicates Add A Class and “1234” specifies the class number, and “#” indicates end of the entry. If the indicated class is not accepting further students for registration, Dialog #23 informs the caller of a wait-list option. SR, p. A-2.

23: Call number 1234 ENG 101 3 credits is closed.
The number of students on the waiting list is 2.
Enter a W to place your name on the waiting list.

As shown in Dialog #23, the caller is informed that the class is closed and that the caller can be placed on a wait-list by inputting a “W” (first caller cue). The caller is again provided with Dialog #10 indicating registered credits and also prompted to enter a request. (another caller cue). If the caller again attempts to register for class 1234 by inputting “A1234#”, the system provides the caller with a different response, Dialog #27 (second caller cue). Dialog #27 provides:

27: You are already registered (waiting) for call number 1234
ENG 101 3 credits.

The caller is again prompted by Dialog #10 to provide an input to the system (another caller cue). As above, the first caller cue, Dialog #23 is avoided in favor of Dialog #27. The caller,

identified by his Student ID number, is not prompted to enter a W to be placed on the wait-list because the caller has already been placed on the wait-list for class 1234. Exhibit CC-B identifies further examples of avoiding a previously provided cue as recited in this limitation.

The **final limitation** in the body of claim 56 recites:

providing to the qualified callers at least one other caller cue.

SR allows the registration process to continue for students who have been placed on a class wait-list by prompting them to enter a request code. *See* SR, pp. A-1 to A-5, C-1 *Dropping a Class* and *Adding a Class*.

Specifically, after being informed by Dialog #27 that the caller is on the wait-list for class 1234, the caller is provided with Dialog #10. SR, p. A-1.

10: You are now registered for 12 credits.
(or)
You are not registered for any classes.
Please enter your request.

Exhibit CC-B identifies further examples of avoiding a previously provided cue as recited in this limitation.

2. CLAIM 61

Claim 61 recites:

A process according to claim 56, wherein the identification signals relating to the callers are calling number identification signals automatically provided by the telephone-communication facility.

As shown above, the combination of SR and Moosemiller renders claim 56 obvious.

Additionally, the combination of SR, Moosemiller and Szlam discloses the limitation of claim 61. Specifically, SR discloses that a student (a caller) may enter their student ID numbers and personal access numbers (identification signals relating to the callers) by pressing

corresponding buttons on the telephone. SR, pp. A-1, C-1. Szlam discloses an alternative arrangement whereby the calling number, provided via ANI, is delivered by the communication facility (calling number identification signals) and cross-referenced with existing telephone numbers to determine an account identifier match. Szlam at 12:55-59 (“if the calling party telephone number corresponds to the telephone number of an existing client in the database, then mainframe computer 16 will provide this information ... to system controller 11”). Szlam explains how ANI increases efficiencies in that ANI avoids the “inefficient duties of ... ascertaining the customer’s account number, and keying in the customer’s account number.” Szlam at 13:31-33. By using the ANI feature disclosed by Szlam in the SR system, a student caller need not enter his student ID number into the system, thereby avoiding input errors and increasing the duration of the call.

The combination discloses that ANI, as substituted for the student ID number, is used to determine if the caller is eligible to participate in class registration. Szlam at 12:55-59; SR, p. A-1. Specifically, a person of skill in the art would understand from the combined disclosures of SR and Szlam that after receiving the calling number provided via ANI, the system matches the calling number with a student ID. Based on the student ID, possible responses include, *inter alia*, “You are now registered for 12 credits” (eligible to participate) and “Your student ID number or your or personal access code is not on our file” (not eligible to participate). SR, p. A-1.

The Federal Circuit affirmed the district court’s determination that SR could implement “cue suppression on ANI data.” The Federal Circuit explained, in the context of SR and Szlam (relied on for ANI) for claim 67 of the ‘120 patent that:

Katz next argues that it would not have ben obvious to combine Student Registration and Szlam to create the invention of claim 67 of the ‘120 patent,

which bases cue suppression on ANI data. Katz contends that students' mobility and their tendency to share telephone numbers would cause "unpredictable and disastrous results" in a cue suppression system based solely on ANI data. The problem with Katz's argument is that claim 67 reads on any method to suppress cues by identifying callers based in part on ANI data. And Student Registration discloses multi-faceted identification techniques such as using a personal identification number or a birth date in addition to a registration number. Claim 67 is therefore an obvious combination of Student Registration's cue suppression with the ANI-based identification process of Szlam. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) ("[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.").

In re Katz, 2011 WL 607381 at *34.

IV. CONCLUSION

The prior art documents presented above were either not previously considered by the Office or are being presented in a new light pursuant to MPEP § 2242(II). Claim 61 of the '120 patent is not patentable over the prior art documents cited herein. The prior art documents disclose the claim limitations of the '120 patent in a manner such that substantial new questions of patentability are raised for claim 61 by this Request.

Accordingly, the Office is requested to grant this Request and to initiate reexamination with special dispatch due to the co-pending litigation.

As an aid to the application of the presented prior art to claims of the '120 patent, corresponding claim charts are provided at Exhibit CC-A through CC-B attached hereto.

Enclosed is a credit card authorization to cover the Fee for reexamination. If this authorization is missing or defective please charge the Fee, any additional fees or refund any excess to the Novak Druce Deposit Account No. 14-1437.

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