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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 14/627,703 | 02/20/2015 | MARK UNAK | CU-100221 | 1909 |

124057 7590 12/30/2016

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| EXAMINER |
|---|
| KUJUNDZIC, DINO |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2179 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 12/30/2016 | ELECTRONIC |

**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.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| Office Action Summary | Application No. 14/627,703 | Applicant(s) UNAK ET AL. | |
|---|---|---|---|
| | Examiner DINO KUJUNDZIC | Art Unit 2179 | AIA (First Inventor to File) Status Yes |

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

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *2/20/2015*.

☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

4)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims***

5)☒ Claim(s) *1-21* is/are pending in the application.

5a) Of the above claim(s) _____ is/are withdrawn from consideration.

6)☐ Claim(s) _____ is/are allowed.

7)☒ Claim(s) *1-21* is/are rejected.

8)☐ Claim(s) _____ is/are objected to.

9)☐ Claim(s) _____ are subject to restriction and/or election requirement.

* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.

**Application Papers**

10)☐ The specification is objected to by the Examiner.

11)☒ The drawing(s) filed on *02/20/2015* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

**Certified copies:**

a)☐ All b)☐ Some** c)☐ None of the:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

** See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☒ Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b)

3) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

**DETAILED ACTION**

1. This action is responsive to the following communication: non-provisional application filed on February 20, 2015, and an Information Disclosure Statement filed on June 24, 2015.

2. Claims 1-21 are pending in the case; Claims 1, 8, and 15 are independent claims.

3. The present application, filed on or after March 16, 2013, is being examined under the first inventor to file provisions of the AIA.

4. It is noted that Claim 12 is dependent upon Claim 11 (which is dependent upon independent Claim 8; Claim 13 is dependent upon Claim 12) and although there is proper antecedent basis in Claims 11-13, it appears that Claim 12 should depend from Claim 10 instead of Claim 11; as currently presented, Claim 12 requires "a third response" but there is no mention of "second response" thus Claim 12 can be interpreted as being almost identical to Claim 10 (see also corresponding Claims 5 and 19, depending from Claims 3 and 17, respectively).

5. Claims 15-21 are directed to a "computing system including a processor and memory" and while the instant Specification states that "the present disclosure may take the form ... of an entirely software embodiment," it appears that the “system” is intended to be directed toward “an embodiment combining software and hardware aspects" thus "processor and memory" recited in these claims are interpreted as being implemented, at least in part, by hardware (see Specification, ¶ 0067). It is noted that if the applicant disagrees with this interpretation, that is, in case the applicant intends the system to

include the software-only embodiments, Claims 15-21 would be subject to 35 USC § 101 rejection as being directed to a non-statutory subject matter (software per se).

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claims 8-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter**.

Regarding Claims 8-14, independent Claim 8 recites "A computer program product residing on a computer readable medium…" but the instant Specification states that "any suitable computer useable or computer readable medium may be utilized thus the "computer readable medium" as recited herein does not appear to be limited to only statutory embodiments in the instant Specification (see Specification, ¶ 0068). It is thus not clear that the instant Specification would limit the "computer program product residing on a computer readable medium" only to statutory subject matter.

The United States Patent and Trademark Office (USPTO) is obliged to give claims their broadest reasonable interpretation consistent with the specification during proceedings before the USPTO. *See In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989) (during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow). The broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory

propagating signals *per se* in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. *See* MPEP 2111.01. Therefore, the claims are rejected as covering non-statutory subject matter. *See In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and *Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101*, Aug. 24, 2009; p. 2.

The applicant should note that amending independent Claim 8 to recite a "residing on a **non-transitory** computer readable medium …" would overcome this rejection (see David J. Kappos, Official Gazette Notice, "Subject Matter Eligibility of Computer Readable Media," January 26, 2010, stating that adding "non-statutory" in order to narrow the claim to cover only statutory embodiments to avoid rejection under 35 U.S.C. § 101 would not raise the issue of new matter).

***Claim Rejections - 35 USC § 103***

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

> A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102 of this title, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.

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