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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,299	10/08/2008	5886274	PA612REX	6427
22830	7590	12/31/2008	EXAMINER	
CARR & FERRELL LLP 2200 GENG ROAD PALO ALTO, CA 94303			ART UNIT	PAPER NUMBER

DATE MAILED: 12/31/2008

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



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Electronic Frontier Foundation
c/o Michael Kwun, Esq.
454 Shotwell Street
San Francisco, CA 94110- 1914

MAILED

DEC 31 2008

CENTRAL REEXAMINATION UNIT

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. 90/009,299.

PATENT NO. 5886274.

ART UNIT 3992.

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

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

Order Granting / Denying Request For Ex Parte Reexamination	Control No. 90/009,299	Patent Under Reexamination 5886274	
	Examiner ALBERT J. GAGLIARDI	Art Unit 3992	

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

The request for *ex parte* reexamination filed 08 October 2008 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

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

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

RESPONSE TIMES ARE SET AS FOLLOWS:

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

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

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

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

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

- a) by Treasury check or,
b) by credit to Deposit Account No. _____, or
c) by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

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cc:Requester (if third party requester)

DECISION GRANTING EX PARTE REEXAMINATION

Decision on Request

A substantial new question of patentability affecting claims 1-45 of United States Patent Number 5,886,274 to Jungleib (*Jungleib*) is raised by the this Third Party request for *ex parte* reexamination.

References Cited in the Request

Jungleib, Stanley, General MIDI (*General MIDI*)

France *et al.* – US 5,734,119 (*France*)

Paulson *et al.* – US 5,521,323 (*Paulson*)

Heimlich *et al.*, Sound Blaster: The Official Book (*Sound Blaster*)*

Levergood *et al.*, AudioFile: A Network-Transport System (*AudioFile*)*

* Cited as secondary reference only – no separate issue

Issues Raised by Request

Issue 1

The requester alleges (p. 2-4) that *General MIDI*, either alone or in combination, raises a substantial new question of patentability regarding at least claims 1-45.

Issue 2

The requester alleges (p. 4-5) that *France*, either alone or combination, raises a substantial new question of patentability regarding at least claims 1-45.

Issue 3

The requester alleges (p. 5-6) that *Paulson*, either alone or combination, raises a substantial new question of patentability regarding at least claims 1-45.

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The Jungleib Patent

The *Jungleib* patent is generally directed to methods and apparatus for the composition and playing of a musical work file sounds stored in a sound bank. Claim 1 is representative:

A composition system comprising:

a sound bank containing at least one instrument sound;

an input device for receiving music control signals;

a sequencer coupled to the input device for storing the music control signals; and

a work manager coupled to the sound bank and to the sequencer for generating a musical work file containing the music control signals and at least a portion of the sound bank.

Pertinent Prosecution History

Claims 1-45 are the current claims in the *Jungleib* patent which issued 23 March 1999 from application 08/891,580 filed on 11 July 1997.

Of the claims for which reexamination is requested, claims 1, 16, 26, 27, 28, 36, 44 and 45 are independent claims. The claims were not renumbered during prosecution.

In a first non-final rejection (6/22/1998), the examiner rejected claims 1-45 as obvious over Sato *et al.* (US 5,589,947) in view of that which was well known in the art. The examiner also rejected some of the claims as indefinite under 35 U.S.C. 112.

In response (9/25/1998), the applicant amended the claims to overcome the indefiniteness rejections and further traversed the examiner's art rejection.

In reference to claims 1-27, the applicant argued that the invention relates to "*generating* a music work file *from which a player system performs or produces sound*" (emphasis in the original), whereas the Sato reference, described as a karaoke system, "reproduces (or produces)

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music and video of music pieces, such that “the *Sato* karaoke system generates sound from a sound source, which is totally different from a sound-source (music work file) generator of the claimed invention.”

In reference to claim 28, also amended, applicant further argued that the input terminal of the player system was capable of receiving a musical work file containing downloadable-in-real-time topology information and music sequence data, with the sound bank including at least one downloadable-in-real-time instrument sound.

Applicant also indicated that independent claims 36, 44 and 45 recited corresponding limitations.

Following the response, a Notice of Allowance (10/27/1998) was issued with no additional comment regarding the reasons for allowability of the claims.

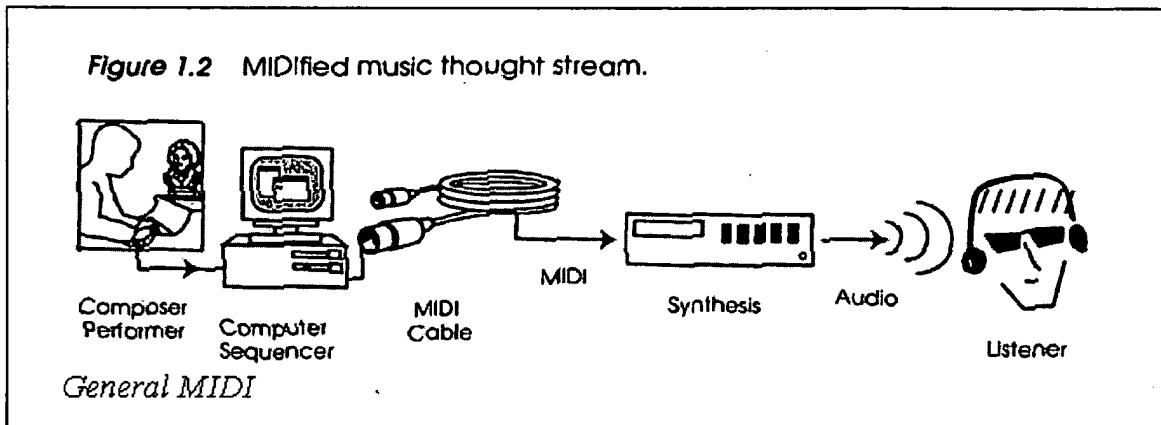
Substantial New Question

In view of the prosecution history, it is considered that the evaluation of a prior art reference (or combination of references) that teaches or suggests a composition system capable of creating or playing a “a sound-source (music work file)” and/or a player system for “receiving a musical work file containing downloadable-in-real-time topology information and music sequence data” would raises a substantial new question of patentability.

Detailed Analysis

Issue 1

The *General MIDI* reference is new prior art. *General MIDI* teaches, among other things, a composition system (Fig 1.2) capable of creating and playing a music work file (e.g., a standard MIDI file (SMF)) (see generally pp. 7-8) (see also Request Exhibit B (*General MIDI*



claim chart) at pp. 3-10)... *General MIDI* also teaches that the system may be connected to a network and may download file in real time (see generally pp. 188-189 and 165) (see also Request Exhibit B (*General MIDI* claim chart) at pp. 70-76).

Since these teachings are directly related to subject matter considered as the basis for allowability of the patent claims, a reasonable examiner would consider evaluation of the *General MIDI* reference as important in determining the patentability of the claims. As such, it is agreed that the *General MIDI* reference raises a substantial new question of patentability with respect to at least claims 1-45 of the *Jungleib* patent.

Issue 2

The *France* patent is new prior art. *France* teaches among other things, a composition system (Figs. 1, 8), capable of creating and playing a music work file (e.g., a CyberMIDI file (MDF)) (col. 6, line 53 to col. 7, line 9) (see also Request Exhibit E (*France* claim chart) at pp. 2-14). *France* also teaches that the system may be connected to a network and may download file in real time (see generally Fig. 1) (see also Request Exhibit E (*France* claim chart) at pp. 102-109).

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Since these teachings are directly related to subject matter considered as the basis for allowability of the patent claims, a reasonable examiner would consider evaluation of the *France* patent as important in determining the patentability of the claims. As such, it is agreed that the *France* reference raises a substantial new question of patentability with respect to at least claims 1-45 of the *Jungleib* patent.

Issue 3

The *Paulson* patent is new prior art. *Paulson* teaches among other things, a composition system (Fig. 5), capable of creating and playing a music work file (e.g., repertoire data file) (col. 2, lines 3-16) (see also Request Exhibit G (*Paulson* claim chart) at pp. 2-10). *Paulson* also teaches that the system can receive and play downloadable-in-real-time music (Fig. 2; col. 3, lines 53-59; col. 8, lines 8-17) (see also Request Exhibit G (*Paulson* claim chart) at pp. 82-93).

Since these teachings are directly related to subject matter considered as the basis for allowability of the patent claims, a reasonable examiner would consider evaluation of the *Paulson* patent as important in determining the patentability of the claims. As such, it is agreed that the *Paulson* reference raises a substantial new question of patentability with respect to at least claims 1-45 of the *Jungleib* patent.

Conclusion

Extensions of Time

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

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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).

Waiver of Right to File Patent Owner Statement

In a reexamination proceeding, Patent Owner may waive the right under 37 C.F.R. 1.530 to file a Patent Owner Statement. The document needs to contain a statement that Patent Owner waives the right under 37 C.F.R. 1.530 to file a Patent Owner Statement and proof of service in the manner provided by 37 C.F.R. 1.248, if the request for reexamination was made by a third party requester, see 37 C.F.R. 1.550(f). The Patent Owner may consider using the following statement in a document waiving the right to file a Patent Owner Statement:

Patent Owner waives the right under 37 C.F.R. 1.530 to file a Patent Owner Statement.

Amendment in Reexamination Proceedings

Patent owner is notified that any proposed amendment to the specification and/or claims in this reexamination proceeding must comply with 37 CFR 1.530(d)-(j), must be formally presented pursuant to 37 CFR § 1.52(a) and (b), and must contain any fees required by 37 CFR § 1.20(c). See MPEP § 2250(IV) for examples to assist in the preparation of proper proposed amendments in reexamination proceedings.

Submissions

If the patent owner fails to file a timely and appropriate response to any Office action or any written statement of an interview required under 37 CFR § 1.560(b), the *ex parte* reexamination proceeding will be terminated, and the Director will proceed to issue a certificate under 37 CFR § 1.570 in accordance with the last Office action.

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Service of Papers

After the filing of a request for reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party (or parties where two or more third party requester proceedings are merged) in the reexamination proceeding in the manner provided in 37 CFR 1.248. See 37 CFR 1.550(f).

Notification of Concurrent Proceedings

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. 5,521,323 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.

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All correspondence relating to this *ex parte* reexamination proceeding should be directed:

By Mail to: Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450


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

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

Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at <https://portal.uspto.gov/authenticate/authenticateuserlocalepf.html>. EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

Any inquiry concerning this communication should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

Signed:



Albert J Gagliardi
Examiner
Art Unit 3992

Conferees:


AD