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## DETAILED ACTION

### *Response to Remarks*

1. This communication is considered fully responsive to the Amendment filed on 4/25/11.
2. 101 rejection of claims 1-10 withdrawn since amended accordingly.
3. 101 rejection of claims 11-18 maintained. See details below.
4. 101 rejection of claims 19-20 maintained. See details below.

### *Response to Arguments*

5. Applicant's arguments filed 4/25/11 have been fully considered but they are not persuasive.

1] Applicant argues: (emphasis added)

Applicant respectfully submits that interpreting "computer storage medium" to include "transitory propagating signals per se" is not be reasonable in view of the express claim language and the Specification. (See also, MPEP 2106 which provides that functional descriptive material recorded on a computer readable storage medium becomes structurally and functionally interrelated to the medium and is thus directed to statutory subject matter since use of the technology permits the function of the descriptive material to be realized). Applicant respectfully submits that claims 11-18 are directed to statutory subject matter. Withdrawal of this rejection is respectfully requested.

The examiner respectfully disagrees.

The current standard reply that a computer storage medium may be read as a signal is actually shorthand for saying that a computer storage medium may be interpreted as a propagation medium that is a carrier wave that propagates signals. Thus, given that the instant application is silent on hardware, to overcome the 101 rejection, applicant should amend claim to read "computer storage medium wherein the medium does not include a propagating signal." **Furthermore, per applicant's specification, 'computer storage medium may be interpreted as signal per se (a**

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**propagation medium that is a carrier wave that propagates signals)** (see at least applicant IFW specification [0019-20] on a computer storage medium includes both volatile and nonvolatile...media...or any other medium which can be used to store the desired information... ([0019]) and communication media typically embodies computer-readable instructions, data structures, program modules or other data in a modulated data signal such as a carrier wave or other transport mechanism and includes any information delivery media and the term 'modulated data signal' means a signal...communication media includes...combinations of any of the above should be included within the scope of computer-readable media ([0020])). Thus, 101 rejection is maintained since claims are not amended accordingly.

2] Applicant argues:

III.

Rejection of Claims 19 and 20 Under 35 U.S.C. §101 As Being Directed to Non-Statutory Subject Matter

Claims 19 and 20 were rejected under 35 U.S.C. §101 as being directed to non- statutory subject matter. Claim 19 has been amended to recite "a processing unit coupled to a memory". Applicant respectfully submits that claim 19, as amended herein, is directed to statutory subject matter.

The examiner respectfully disagrees.

Examiner's comments regarding claim construction:

Regarding claim 19, for the purposes of examination, given the knowledge of one of ordinary skill at the time the invention was made as evidence by exemplary (and not limited to) disclosure of the pertinent art (*see attached PTO-892: Tanenbaum, McConnell and Vahid; PGPub 20090172183 A1; PGPub 2009/0300097 A1*), the claimed apparatus having a processing unit coupled to memory has been interpreted as meaning software (*see at least Tanenbaum (1984): pg. 11 on a central theme of this*

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book that will occur over and over again is: Hardware and Software are logically equivalent. **Any operation performed by software can also be built directly into the hardware and any instruction executed by the hardware can also be simulated in software**; pg. 12 on the point of this discussion is to show that the boundary between hardware and software is arbitrary and constantly changing. Today's software is tomorrow's hardware, and vice versa; see at least *McConnell (2001)*: pg. 5 on have we arrived at a point where even computer hardware is really software? and Wolfgang Strigel: No doubt, the distinction between software and hardware has blurred; pg. 6 ...Larry Graham: **I agree that the line between software and hardware is blurry. Patent law has a fairly rich tradition that equates the two - virtually every hardware device can be described in terms of a function it performs and vice versa....**; pg. 7 on Terry Bollinger: I think the distinction needs to focus on the idea of **"information machines" – what we have traditionally called software ....A structured algorithm masked into an addressable array that is an integral part of a processor chip most emphatically is an information machine**, because its complete set of properties can be represented as structured binary information only, without reference to the chip's physical properties; see at least *Vahid (2003)*: pg. 31 on the "soft" bits ...some have the traditional role of representing instructions to be executed on a programmable processor, but others now represent processors themselves; pg. 32 on, **in short, the processors, memories, and buses – what we previously considered a system's unchangeable hardware –can actually be quite soft**; pg. 33 on the meeting of software and software design has ignited the demand for methods

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and tools to help designers implement applications as collections of processors (software) – generally referred to as hardware/software codesign; see at least *PGPub 20090172183 A1*: [0025-26]) on neither the AMX MBean server nor any of the AMX MBeans live somewhere in ABAP, but rather are created each time a request has to be processed...This requires that **the server and the MBeans are instantiated on request**; [0027] ...these facets of ABAP...result in the creation of two different contexts and two different MBean servers; [0035]...If no MBean server exists, the MBean server are instantiated...Subsequently, **the MBeans...are instantiated ...Once the MBean server exists or is instantiated...**; see at least *PGPub 2009/0300097 A1*: [0005]) and [0022] '**...some user devices may have different operating systems and/or hardware platforms ....' and '...client device...may be implemented using any appropriate combination of hardware and/or software...**' ).

Thus, **claims 19-20**, in light of what was known in the prior art at the time of this invention, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In particular, **per applicant's specification** an apparatus having a processing unit coupled to memory may be software per se (see at least IFW spec [0048] on the term component is to be read to include all or a portion of a device, a collection of one or more software modules or portions thereof, some combination of one or more software modules or portions thereof and one or more devices or portions thereof and the like; [0078] on the apparatus may include recording agents, a store, communication mechanisms and other components (not shown) and the apparatus corresponds to any entity of fig. 2 or another entity and may be implemented on or as

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the same or similar device(s)) – and ‘hardware’ is nowhere explicitly disclosed in the specification. In particular, the apparatus is not clearly a machine with structural or hardware limitations having only ‘processing unit coupled to memory’ ‘request manager’ ‘local communication point identifier’ ‘local communication point updater’ that is software per se and, thus, is non-statutory.

6. Applicant's other arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 101***

7. 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.

8. Claims 11-18 are rejected under 35 USC 101 since the claims are directed to non-statutory subject matter. Claims 11-18 recite a computer storage medium having computer-executable instructions which appears to cover both transitory and non-transitory embodiments. The United States Patent and Trademark Office (USPTO) is required 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

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2111.01. When the broadest reasonable interpretation of a claim covers a signal *per se*, the claim **must** be rejected under 35 U.S.C. § 101 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 Examiner suggests that the Applicant revise the limitation to "computer readable medium wherein the medium does not include a propagating signal" to the claims in order to properly render the claims in statutory form in view of their broadest reasonable interpretation in light of the originally filed specification.

9. Examiner's comments regarding claim construction:

Regarding claim 19, for the purposes of examination, given the knowledge of one of ordinary skill at the time the invention was made as evidence by exemplary (and not limited to) disclosure of the pertinent art (*see attached PTO-892: Tanenbaum, McConnell and Vahid; PGPub 20090172183 A1; PGPub 2009/0300097 A1*), the claimed apparatus having a processing unit coupled to memory has been interpreted as meaning software (*see at least Tanenbaum (1984)*: pg. 11 on a central theme of this book that will occur over and over again is: Hardware and Software are logically equivalent. **Any operation performed by software can also be built directly into the hardware and any instruction executed by the hardware can also be simulated in software**; pg. 12 on the point of this discussion is to show that the boundary between hardware and software is arbitrary and constantly changing. Today's software is

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tomorrow's hardware, and vice versa; see at least *McConnell (2001)*: pg. 5 on have we arrived at a point where even computer hardware is really software? and Wolfgang Strigel: No doubt, the distinction between software and hardware has blurred; pg. 6 ...Larry Graham: **I agree that the line between software and hardware is blurry.**

**Patent law has a fairly rich tradition that equates the two - virtually every hardware device can be described in terms of a function it performs and vice versa....;** pg. 7 on Terry Bollinger: I think the distinction needs to focus on the idea of **“information machines” – what we have traditionally called software ....A structured algorithm masked into an addressable array that is an integral part of a processor chip most emphatically is an information machine**, because its complete set of properties can be represented as structured binary information only, without reference to the chip's physical properties; see at least *Vahid (2003)*: pg. 31 on the “soft” bits ...some have the traditional role of representing instructions to be executed on a programmable processor, but others now represent processors themselves; pg. 32 on, **in short, the processors, memories, and buses – what we previously considered a system’s unchangeable hardware –can actually be quite soft**; pg. 33 on the meeting of software and software design has ignited the demand for methods and tools to help designers implement applications as collections of processors (software) – generally referred to as hardware/software codesign; see at least *PGPub 20090172183 A1*: [0025-26]) on neither the AMX MBean server nor any of the AMX MBeans live somewhere in ABAP, but rather are created each time a request has to be processed...This requires that **the server and the MBeans are instantiated on**

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**request**; [0027] ...these facets of ABAP...result in the creation of two different contexts and two different MBean servers; [0035]...If no MBean server exists, the MBean server are instantiated...Subsequently, **the MBeans...are instantiated ...Once the MBean server exists or is instantiated...**; see at least *PGPub 2009/0300097 A1*: [0005]) and [0022] '**...some user devices may have different operating systems and/or hardware platforms ....' and '...client device...may be implemented using any appropriate combination of hardware and/or software...**' ).

10. **Claims 19-20**, in light of what was known in the prior art at the time of this invention, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In particular, **per applicant's specification** an apparatus having a processing unit coupled to memory **may be software per se or a signal** (see at least IFW specification [0019-20] on a computer storage medium includes both volatile and nonvolatile...media...or any other medium which can be used to store the desired information... ([0019]) and communication media typically embodies computer-readable instructions, data structures, program modules or other data in a modulated data signal such as a carrier wave or other transport mechanism and includes any information delivery media and the term 'modulated data signal' means a signal...communication media includes...combinations of any of the above should be included within the scope of computer-readable media ([0020])); IFW [0021] on the system memory includes computer storage media in the form of volatile and/or nonvolatile memory... ; IFW spec [0048] on the term component is to be read to include all or a portion of a device, a collection of one or more software modules or portions

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thereof, some combination of one or more software modules or portions thereof and one or more devices or portions thereof and the like; [0078] on the apparatus may include recording agents, a store, communication mechanisms and other components (not shown) and the apparatus corresponds to any entity of fig. 2 or another entity and may be implemented on or as the same or similar device(s)) – and ‘hardware’ is nowhere explicitly disclosed in the specification. In particular, the apparatus is not clearly a machine with structural or hardware limitations having only ‘processing unit coupled to memory’ ‘request manager’ ‘local communication point identifier’ ‘local communication point updater’ that is software or a signal per se and, thus, is non-statutory.

***Claim Rejections - 35 USC § 103***

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

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 1-6 and 10-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication No. 2004/0202295 A1 to *Shen et al.* (“*Shen*”) in view of U.S. Patent Publication No. 2004/0240439 A1 to *Castleberry et al.* (“*Castleberry*”).

As to **claim 1**, *Shen* discloses a method implemented at least in part by a computer, the method comprising:  
receiving data regarding establishing a communication session between at least two entities via a switched packet network for a communication that includes

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audio (see at least Shen: [0084-96] on interception media gateway controller (MGC) detects signaling information between two IP parties ([0084]) and the method for performing SIP signaling for media stream and receiving SIP invite message of first IP party ([0085-86]); [0027-28] on SIP can establish, modify and terminate multimedia sessions or calls);

using a processing unit to locate locating one or more parameters in the data that indicate one or more local candidate communication points of at least one of the at least two entities (see at least Shen: [0084-96] on interception media gateway controller (MGC) detects signaling information between two IP parties ([0084]) and adapting at least one connection parameter in the SDP of received SIP invite message and adapting at least one connection parameter in the SDP of the received SIP response message ([0085-91])).

*Shen* did not explicitly disclose removing the one or more parameters from the data to indicate that there are no direct paths between the two entities to cause the communication session to be established over a path that includes a recording agent that is capable of silently copying the communication between the at least two entities.

*Castleberry* discloses removing the one or more parameters from the data to indicate that there are no direct paths between the two entities to cause the communication session to be established over a path that includes a recording agent that is capable of silently copying the communication between the at least two entities (see at least Castleberry: [0003] on when the LEA sends a court

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order to a service provider, the service provider must provide the information such that neither the target party, non-security service provider employees nor other LEAs are aware that the target's calls intercepted (**capable of silently copying the communication between the at least two entities**); fig. 2, [0021-27] on Softswitch sends the Intercept Router an AddNAT message including the target address A to create an alias IP address A' chosen from a pool that the other routers know are to be routed through Intercept Router 22 ([0023-24]) and each endpoint is told to send bearer packets to the alias IP addresses A' and B' and, for example, the Invite message at 44 uses the target's alias A' and B' thereby sending the call content destined for the target through the Intercept Router (**removing the one or more parameters from the data to indicate that there are no direct paths between the two entities to cause the communication session to be established over a path**) ([0025]); fig. 1, [0020] on the Softswitch 20 uses alias IP addresses for the targeted bearer packets to redirect the targeted bearer packets through the Intercept Router 22 and once the bearer packets are forced to route through the Intercept Router 22 (**indicate that there are no direct paths between the two entities**) the call content can easily be reviewed, recorded, forwarded to an LEA agency, etc. (**see with [0003] - a path that includes a recording agent that is capable of silently copying the communication between the at least two entities**)).

*Shen* and *Castleberry* are analogous art because they are from the same field of endeavor with respect to lawful interception.

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At the time of invention, it would have been obvious to a person of ordinary skill in the art to incorporate the strategies by *Castleberry* into the method by *Shen*. The suggestion/motivation would have been to provide a redirecting bearer method of targeting bearer packets containing call content controlling the redirection through a specified Intercept Router using alias IP addresses for the targeted bearer packets for legal interception (see at least *Castleberry*: [0001]).

*Shen* and *Castleberry* further disclose providing the data with the parameters removed to a protocol entity that uses the data to follow a communication protocol to establish the communication session via the path (see at least *Castleberry*: [0023] on the Intercept Router 22 holds the NAT mapping of the target address A mapped to the alias address A' in its internal NAT tables for the duration of the call so that the Intercept Router knows to route bearer packets it receives having the IP address A' to the target at the IP address A), the protocol entity potentially including one or more of the at least two entities and/or any entity that interacts with one or more of the at least two entities (see at least *Castleberry*: [0023] on the other routers in the network know to route bearer packets having the address A' to the Intercept Router).

Same motivation applies as mentioned above to make the proposed modification.

As to **claim 2**, *Shen* and *Castleberry* disclose wherein receiving data regarding establishing a communication session between at least two entities

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comprises receiving the data from a call server that is involved in establishing the communication session, the call server responsible at least for relaying invite requests from a requesting one of the entities to a receiving one of the entities (see at least Castleberry: [0018] on Softswitch 20, also known as media gateway controller, call agent, or call server may be any network element that controls call completion and call features via control signaling), the call server configurable to provide the data to a recording agent before establishing the communication session (see at least Castleberry: fig. 2, [0021-27] on when the Softswitch receives the call control information (INVITE) from the target 12 placing the call, the Softswitch identifies the destination IP address of the call as belonging to target 12 and determines the call is to be intercepted and the Softswitch sends the Intercept Router an AddTarget message with the IP address and port number of target 12, herein after target's address A ([0021-22])).

For motivation, see rejection of claim 1.

As to **claim 3**, *Shen* and *Castleberry* disclose wherein receiving data regarding establishing a communication session between two entities comprises receiving the data at a recording agent logically disposed between a requesting entity of the at least two entities and a call server that is involved in establishing the communication session (see at least *Shen*: fig. 2, [0079-96] on Interception Proxy with RTP proxy and RTP recorder; [0010] on the RTP proxy can start record both media channels; see at least *Castleberry*: fig. 1, [0020] on the Softswitch 20 uses alias IP addresses for the targeted bearer packets to redirect

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the targeted bearer packets through the Intercept Router 22 and once the bearer packets are forced to route through the Intercept Router 22 the call content can easily be reviewed, recorded, forwarded to an LEA agency, etc.).

For motivation, see rejection of claim 1.

As to **claim 4**, *Shen* and *Castleberry* disclose wherein removing the one or more parameters from the data comprises deleting the one or more parameters from session description protocol data that includes the data (see at least *Shen*: abstract on due to the adaptation (removal/replacement) of the connection parameters in the SDP part of the SIP message sent to the IP parties, the interception is transparent to the IP parties).

For motivation, see rejection of claim 1.

As to **claim 5**, *Shen* and *Castleberry* disclose further comprising receiving a request to monitor packets to and from at least one of the at least two entities and updating a database with an identifier of the at least one of the at least two entities in response to the request (see at least *Castleberry*: fig. 2, [0021-27] on when the Softswitch receives the call control information (INVITE) from the target 12 placing the call, the Softswitch identifies the destination IP address of the call as belonging to target 12 and determines the call is to be intercepted and the Softswitch sends the Intercept Router an AddTarget message with the IP address and port number of target 12, herein after target's address A ([0021-22]) and Softswitch sends the Intercept Router an AddNAT message and Intercept

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Router holds the NAT mapping of the target address A mapped to alias address A' ([0023])).

For motivation, see rejection of claim 1.

As to **claim 6**, *Shen* and *Castleberry* disclose further comprising configuring a network device to create a copy of the communication in response to receiving the request, the network device logically disposed within the path (see at least *Castleberry*: fig. 1, [0020] on the Softswitch 20 uses alias IP addresses for the targeted bearer packets to redirect the targeted bearer packets through the Intercept Router 22 and once the bearer packets are forced to route through the Intercept Router 22 the call content can easily be reviewed, recorded (copy), forwarded to an LEA agency, etc.).

For motivation, see rejection of claim 1.

As to **claim 10**, *Shen* and *Castleberry* disclose wherein receiving data regarding establishing a communication session comprises receiving session description protocol parameters according to a session initiation protocol of a voice over Internet protocol (see at least *Shen*: abstract on due to the adaptation of the connection parameters in the SDP part of the SIP message sent to the IP parties, the interception is transparent to the IP parties).

For motivation, see rejection of claim 1.

As to **claims 11 and 12**, see similar rejection to claim 1 where the computer storage medium is taught by the method.

As to **claim 13**, see similar rejection to claim 2.

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As to **claim 14**, *Shen* and *Castleberry* disclose wherein changing the data comprises changing a flag, the flag indicating that the path that includes the recording agent be used for the communication session (see at least *Castleberry*: fig. 2, [0021-27] on Softswitch sends the Intercept Router an AddNAT message and the Intercept Router 22 holds the NAT mapping (flag) of the target address A mapped to the alias address A' in its internal NAT tables for the duration of the call so that the Intercept Router knows to route bearer packets it receives having the IP address A' to the target at the IP address A Intercept Router holds the NAT mapping of the target address A mapped to alias address A' and the other routers in the network know to route bearer packets having address A' (flagged) to the Intercept Router ([0023])).

For motivation, see rejection of claim 1.

As to **claim 15**, *Shen* and *Castleberry* disclose wherein changing the data comprises adding additional data to the data, the additional data indicating that the path that includes the recording agent is to be used for the communication session (see at least *Castleberry*: fig. 2, [0021-27] on when the Softswitch receives the call control information (INVITE) from the target 12 placing the call, the Softswitch identifies the destination IP address of the call as belonging to target 12 and determines the call is to be intercepted and the Softswitch sends the Intercept Router an AddTarget message with the IP address and port number of target 12, herein after target's address A ([0021-22]) and Softswitch sends the

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Intercept Router an AddNAT message and Intercept Router holds the NAT mapping of the target address A mapped to alias address A' ([0023])).

As to **claim 16**, *Shen* and *Castleberry* disclose wherein changing the data comprises deleting parameters from the data leaving remaining parameters in the data, the remaining parameters indicating that the path that includes the recording agent is to be used for the communication session (see at least *Castleberry*: fig. 2, [0021-27] on Softswitch sends the Intercept Router an AddNAT message including the target address A to create an alias IP address A' chosen from a pool that the other routers know are to be routed through Intercept Router 22 ([0023-24]) and each endpoint is told to send bearer packets to the alias IP addresses A' and B' and, for example, the Invite message at 44 uses the target's alias A' and B' thereby sending the call content destined for the target through the Intercept Router ([0025])).

For motivation, see rejection of claim 1.

As to **claim 17**, *Shen* and *Castleberry* disclose wherein receiving data that indicates one or more candidate communication points of at least one of the at least two entities comprises receiving Internet protocol data that identifies ports and Internet protocol addresses of network address translation devices associated with the at least two entities (see at least *Castleberry*: fig. 2, [0021-27] on when the Softswitch receives the call control information (INVITE) from the target 12 placing the call, the Softswitch identifies the destination IP address of the call as belonging to target 12 and determines the call is to be intercepted and

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the Softswitch sends the Intercept Router an AddTarget message with the IP address and port number of target 12, herein after target's address A ([0021-22]) and Softswitch sends the Intercept Router an AddNAT message and the Intercept Router 22 holds the NAT mapping of the target address A mapped to the alias address A' in its internal NAT tables for the duration of the call so that the Intercept Router knows to route bearer packets it receives having the IP address A' to the target at the IP address A Intercept Router holds the NAT mapping of the target address A mapped to alias address A' ([0023])).

For motivation, see rejection of claim 1.

13. **Claims 7-9 and 18-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication No. 2004/0202295 A1 to *Shen et al.* ("*Shen*") in view of U.S. Patent Publication No. 2004/0240439 A1 to *Castleberry et al.* ("*Castleberry*") and further in view of "Cisco Service Independent Intercept Architecture Version 3.0" (4/19/2007) to *Cisco*. ("*Cisco*").

As to **claim 7**, *Shen* and *Castleberry* disclose method of claim 1.

For motivation, see rejection of claim 1.

*Shen* and *Castleberry* did not explicitly disclose further comprising creating a copy of the communication by creating at least one additional stream in conjunction with creating a stream associated with the communication.

*Cisco* discloses further comprising creating a copy of the communication by creating at least one additional stream in conjunction with creating a stream

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associated with the communication (see at least *Cisco*: pg. 6-7, 'Interfaces Between Devices).

*Shen, Castleberry* and *Cisco* are analogous art because they are from the same field of endeavor with respect to lawful interception.

At the time of invention, it would have been obvious to a person of ordinary skill in the art to incorporate the strategies by *Cisco* into the method by *Shen* and *Castleberry*. The suggestion/motivation would have been to provide an architecture in response to need of service providers compliance with lawful interception (see at least *Cisco*: abstract).

As to **claim 8**, *Shen, Castleberry* and *Cisco* disclose further comprising forwarding the at least one additional stream to an entity identified prior to receiving the data (see at least *Cisco*: pg. 6 'Communication Content Intercept Access Point' on the CC IAP intercepts CC information, replicates it, and forwards the replicated information to the mediation device; pg. 5, 'LI Administration and Function' on the mediation device (MD) is maintained by the SP or ISP and is the center of the LI process).

For motivation, see rejection of claim 1.

As to **claim 9**, *Shen, Castleberry* and *Cisco* disclose further comprising storing data corresponding to the communication to a storage medium for later retrieval by a law enforcement agent (see at least *Cisco*: pg. 6 'Collection Function' on the collection function is a third-part device maintained by the LEA that receives, sorts, and stores intercept information from the MD).

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For motivation, see rejection of claim 1.

As to **claim 18**, *Shen, Castleberry and Cisco* disclose further comprising configuring the recording agent to create a copy of data transmitted in the communication session and to send the copy to an entity associated with a law enforcement agent (see at least *Cisco*: pg. 8, Table 1 Interface d2 on the CCIAP replicates CC and sends content to MD and CC IAP encapsulates packets with additional UDP and IP headers and CCCID header and the CCCID is included so MD can map intercepts to the appropriate warrants and usually MD will rewrite the CCCID before forwarding intercept information to collection functions; pg. 6 'Collection Function' on the collection function is a third-part device maintained by the LEA that receives, sorts, and stores intercept information from the MD and collection function may also include case management capabilities).

For motivation, see rejection of claim 1.

As to **claims 19 and 20**, see similar rejection to claims 1-10 where the apparatus is taught by the method.

### ***Conclusion***

14. Applicant's future amendments need to comply with the requirements of **MPEP § 714.02, MPEP § 2163.04** and **MPEP § 2163.06**.

"with respect to newly added or amended claims, applicant should show support in the original disclosure for the new or amended claims." See MPEP § 714.02 and § 2163.06 ("Applicant should \* \* \* specifically point out the support for any amendments made to the disclosure."); and **MPEP § 2163.04** ("If applicant amends the claims and points out where and/or how the originally filed disclosure supports the amendment(s), and the examiner finds that the disclosure does not reasonably convey that the inventor had possession of the subject matter of the amendment at the time of the filing of the application, the examiner has the initial

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burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.”). See *In re Smith*, 458 F.2d 1389, 1395, 173 USPQ 679, 683 (CCPA 1972) *In re Wertheim*, 541 F.2d at 262, 191 USPQ at 96. (emphasis added).

“The use of a confusing variety of terms for the same thing should not be permitted.

New claims and amendments to the claims already in the application should be scrutinized not only for new matter but also for new terminology. While an applicant is not limited to the nomenclature used in the application as filed, he or she should make appropriate amendment of the specification whenever this nomenclature is departed from by amendment of the claims so as to have clear support or antecedent basis in the specification for the new terms appearing in the claims. This is necessary in order to insure certainty in construing the claims in the light of the specification.” *Ex parte Kotler*, 1901 C.D. 62, 95 O.G. 2684 (Comm’r Pat. 1901). See 37 CFR 1.75, MPEP § 608.01(i) and § 1302.01.

Note that examiners should ensure that the terms and phrases used in claims presented late in prosecution of the application (including claims amended via an examiner’s amendment) find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description, see 37 CFR 1.75(d)(1). If the examiner determines that the claims presented late in prosecution do not comply with 37 CFR 1.75(d)(1), applicant will be required to make appropriate amendment to the description to provide clear support or antecedent basis for the terms appearing in the claims provided no new matter is introduced.”

“USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure.” *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). MPEP § 2106.”

15. The examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider each of the cited references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage disclosed by the examiner.

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16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUNE SISON whose telephone number is (571)270-5693. The examiner can normally be reached on Mon-Thur, 8:00a-4:30p est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia Dollinger can be reached on (571)272-4170. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. S./

Examiner, Art Unit 2443

/TONIA L.M. DOLLINGER/

Supervisory Patent Examiner, Art Unit 2443