Request for Judicial Notice Exhibit G

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/889,995	07/13/2004	Matthew A. Katzer	7431.0071	6779

7590 12/21/2006

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EXAMINER	
NGUYEN, CUONG H	
ART UNIT	PAPER NUMBER
3661	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/21/2006	PAPER

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

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/889,995	KATZER, MATTHEW A.	
	Examiner	Art Unit	
	CUONG H. NGUYEN	3661	

-- 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 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, 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 *05 October 2006*.

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

3)☐ 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

4)☒ Claim(s) *1,3-9,16,18 and 21-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-9,16,18 and 21-32* is/are rejected.

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

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

Application Papers

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

10)☐ The drawing(s) filed on _____ 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).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

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).

a)☐ All b)☐ Some * c)☐ None of:

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) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is the answer to the communications received on 10/05/2006.

2. Claims 1, 3-9, 16-18, and 21-32 are pending in this application.

Information Disclosure Statement

3. Two set of IDSs, received on 5/25/2006, and 6/26/2006 are acknowledged (several documents of these IDS are not initialed yet because IDS requirement is "Include name of the author, title of the article, title of the item, date, page(s), volume-issue number(s), publisher, city and/or country where published" – if an author is not printed, write "UNKNOWN AUTHOR", if a published year is not printed, please writes a year that it may be published).

Response to Amendment

4. The current examiner respectfully submits that the pending claims essentially comprising of receiving/acknowledging commands/signals that passively received by an object via a digital command station (i.e., a model railroad) this is a very obvious issue that is claimed by the applicant. – a digitally controlled model railroad as claimed is merely an object that receiving commands. Therefore, claiming a method of operating a digitally controlled model railroad by sending command signals and receiving back responses are obvious from DigiToys Systems as admitted by applicant.

As to the claimed physical location (i.e., in a digitally-controlled model railroad environment) being merely a field of use limitation (note that it is unclear for "digital control" in the claims here (is there any distinguished in the pending claims about sending an analog command, or a digital command?), again the Examiner's position about this claimed subject matter is obvious. The examiner respectfully submits that the

claimed "model railroad" does not differ structurally from the control taught by DigiToy Systems. He finds that they differ solely based on an intended use (if there is any).

Statements of intended use do not serve to distinguish structure over the prior art. See In re Pearson, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974); In re Yanush, 477 F.2d 958, 959, 177 USPQ 705, 706 (CCPA 1973); In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967).

Claim Rejections - 35 USC § 103

5. Claims 1, 3-9, 16-18, and 21-32 are rejected under 35 U.S.C. 103(a) as being obvious over Applicant Admitted Prior Art (AAPA) in view of well-known signal interactions between a sender and a receiver via an interface.

AAPA (i.e., DigiToys Systems) teaches a method for controlling a model railroad set from a remote location via executing a software.

Since it's well known to sending command signals and receiving back responses, it would have been obvious to modify the process of AAPA by clearly disclosing claimed limitations because these steps have been "normal" for "shaking hands" between a sender and a receiver through a middle-man (a digital command station, a railroad, and a controlling interface).

In the specification, the applicant recognizes that this claimed subject matter already been taught: "[0004] DigiToys Systems of Lawrenceville, Ga. has developed a software program for controlling a model railroad set from a remote location. The software includes an interface which allows the operator to select desired changes to devices of the railroad set that include a digital decoder, such as increasing the speed of a train or switching a switch. The software issues a command locally or through a network,

such as the internet, to a digital command station at the railroad set which executes the command. The protocol used by the software is based on Cobra from Open Management Group where the software issues a command to a communication interface and awaits confirmation that the command was executed by the digital command station. When the software receives confirmation that the command executed, the software program sends the next command through the communication interface to the digital command station. In other words, the technique used by the software to control the model railroad is analogous to an inexpensive printer where commands are sequentially issued to the printer after the previous command has been executed. Unfortunately, it has been observed that the response of the model railroad to the operator appears slow, especially over a distributed network such as the internet. One technique to decrease the response time is to use high-speed network connections but unfortunately such connections are expensive."

The reasons from the applicant that DigiToy Systems' model is slow (how slow?) (i.e., "the response of the model railroad to the operator appears slow", or another technique is expensive (how expensive?) are not included in the pending claims to show a comparison between the pending model and the prior art's model.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to utilize DigiToy Systems (as admitted by the applicant) to operate a digitally controlled model railroad because this prior art already created fundamental steps as claimed of exchanging electronic communications (directly or indirectly) between related components for controlling model railroads (see also attached PTO-892).

Conclusion

6. Pending claims are not patentable. The examiner invites a request for an interview to understand further what the applicant wants to claim.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose telephone number is 571-272-6759 (or email. Cuong.nguyen@uspto.gov). The examiner can normally be reached on 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THOMAS G. BLACK can be reached on 571-272-6956. The Rightfax number for the organization where this application is assigned is 571-273-6759.

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).

Please provide support, with page and line numbers, for any amended or new claim in an effort to help advance prosecution; otherwise any new claim language that is introduced in an amended or new claim may be considered as new matter, especially if the Application is a Jumbo Application.

CUONG H. NGUYEN
Primary Examiner
Art Unit 3661