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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,049	02/02/2004	John N. Gross	JNG 2004-5	1525
23694	7590	09/20/2007	EXAMINER	
J. NICHOLAS GROSS, ATTORNEY 2030 ADDISON ST. SUITE 610 BERKELEY, CA 94704			RUHL, DENNIS WILLIAM	
		ART UNIT	PAPER NUMBER	
		3629		
		MAIL DATE		DELIVERY MODE
		09/20/2007		PAPER

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.

Office Action Summary	Application No.	Applicant(s)	
	10/771,049	GROSS, JOHN N.	
	Examiner	Art Unit	
	Dennis Ruhl	3629	

-- 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 09 August 2007.
- 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) 2-18,21-25 and 27-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 2-7,10-18,21-25,27-29 is/are allowed.
- 6) Claim(s) 8,9 and 30-34 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: _____

Applicant's response of 8/9/07 has been entered. The examiner address applicant's remarks regarding the prior art at the end of this office action.

With respect to the IDS of 8/9/07 and the submitted declaration filed under 37 CFR 1.132, it has been considered on the merits and is found to be non-persuasive and insufficient to show a public use of the *claimed invention* prior to the earliest date that the instant inventor/applicant is entitled to. The comments accompanying the IDS have been considered as well as applicant submitted Exhibits 1-4 that accompanied the IDS. The examiner finds the declaration to be insufficient to establish a showing of public use of the claimed invention. The 132 declaration alleges that as early as 12/16/2002 Netflix sent emails to customers informing them that their queue was empty. In support of this assertion Mr. Hunt included Exhibits 1,2 and 3 and stated they are evidence that supports his statements. Each exhibit is stated as showing a composition that was included in emails sent to actual customers. None of the exhibits have any dates. With no dates on the exhibits it cannot be accepted that they are in fact printed publications that were in the public prior to 12/16/2002. The lack of dates on the exhibits is a critical deficiency. The examiner also does not see any evidence that supports the assertion that any emails were sent to customers as alleged. The compositions that make up Exhibits 1-3 do not show an actual email that was in public use and there is no evidence to support the statement that thousands of emails were sent out that contained the compositions of Exhibits 1-3. The examiner notes that what Mr. Hunt has submitted is not an email and there is no evidence that shows the actual compositions of each exhibit were actually known in the public or used in the public domain. No evidence

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shows any emails were sent to anyone. The statements applicant is making are not supported by sufficient evidence to be persuasive. The examiner questions where copies of the emails are if they were sent out to actual customers as alleged. The evidence does not support the statement that emails were sent that contained the composition shown in Exhibits 1-3 because there are no emails of evidence to consider. Turning to the exhibits themselves, there are some issues that the examiner feels puts the credibility of the Exhibits in question. For Exhibit 3, the Spider-Man movie was not released on DVD until November of 2002. This movie was not available at the end of June. The language in the exhibit that says that Spider-Man is arriving on or around June 27, 2002 is contradicted by the fact that this movie was not released on DVD until November of 2002. The examiner personally verified this information on the Internet by looking up the DVD release date for this movie. This discrepancy is not addressed by Mr. Hunt and there appears to be no explanation for this incorrect date. Also, the spelling is wrong for this movie. Netflix actually sent out emails that called it "Spinder-Man" instead of "Spider-Man"? This is hard to believe and has no reasonable explanation as far as the examiner can tell. Also, none of the movies listed in the New Releases portion of the Exhibit were even released yet. This inaccuracy concerns the examiner as well as the other issues with this Exhibit. Exhibit 1 also says that Spider-Man is arriving on or around June 27, 2002, which is contradicted by the fact that this movie was not released on DVD until November of 2002. The statement #8 of the declaration is not supported by any evidence in exhibits 1,2, or 3. Statement #9 discusses computer logic and states that the logic is also prior art. No evidence of any

logic being in the public domain has been provided so this statement is not supported by any evidence of record. With respect to statement #10 Mr. Hunt stated that Netflix stopped using notification messages after 2003 and is not presently using such messages. The instant applicant has provided copies of 3 emails that are dated from the years 2005, 2006, and 2007. The emails show that a sender (info@netflix.com) sent an email to a customer to inform them that their queue was empty. This suggests and calls into question the credibility of statement #10. There is evidence in the record in the form of emails that calls into question the credibility of statement number 10. When considering a 132 declaration such as executed by Mr. Hunt, one must take into account any bias that the declarant may have. The examiner notes that although not a determining factor alone, it must be taken into account that the declarant is an employee of Netflix and that Netflix may benefit if the current application does not issue as a patent. There are obviously things happening between Netflix and the instant inventor that involve attorneys and legal matters that the examiner is not fully aware of. Taking this potential bias into account, taking the issues outlined by the examiner for the exhibits into account (dates, spelling error), and taking into account that there is evidence in the record that directly contradicts statement number 10, the examiner finds the 132 declaration to be insufficient to show that the claimed invention (in any pending claim) was in public use before the invention by applicant as Mr. Hunt alleges. The examiner dose not find that the evidence supports the allegation of prior public use by Netflix and does not find it persuasive that the submitted Exhibits 1-3 are in fact printed publications that were in the public domain.

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With respect to the 131 declaration submitted by the applicant, because the 132 declaration does not provide evidence of prior public use or prior printed publications, the issue of swearing behind the date of 12/16/2002 is moot. The dates of the prior art used in the current rejections of record are behind the date alleged in the 131 declaration so it is not relevant at this point in time. In the event that the 131 declaration becomes relevant to the examination, it will then be commented on with regards to the merits.

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 8,9, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 8,9, have been amended to recite that the recommendation system determines additional media items that are predicted to be more desirable than at least some of the other items in the rental queue. The examiner does not feel that this kind of recommendation system has enablement in the specification as originally filed. While the specification does provide support for what is claimed (i.e. this is not new matter), it