store, where the consumer would not have "possession and control" over the device, as required by the Hair invention. (Tygar Rebuttal at 75-76.)

Defendants correctly point out that in Interactive Gift Express, Inc. v. Compuserve, Inc., 256 F.3d 1323, 1334 (Fed. Cir. 2001), the Court construed "point of sale kiosk" to include a location in a consumer's home, contrary to Dr. Tygar's conclusion that it was limited to a business location. However, the Court in Interactive Gift Express affirmed the lower court's construction of the term "material object" in the Freeny Patent to be (a) separate and distinct from the IMM, (b) removed from the IMM after purchase, and (c) intended for use away from the point-of-sale location. Id. at 1336. The Federal Circuit Court stated, "These three conditions. . . are fundamental to the meaning of a material object as clearly and consistently specified in the patent description." Id. at 1337. The Court explicitly noted that the "material object" on which the information is recorded "does not encompass the hard disk component of a home personal computer" and the material object "must be offered for sale, and be purchasable, at [the] point of sale location[ ]." Id. at 1338. Since one using the Hair invention purchases only the signals, not the material object on which they are stored, and since the Sightsound Patents specifically reference the consumer's system as incorporating a hard disk, the Freeny Patent, as construed by the Federal Circuit Court in Interactive Gift Express, arguably teaches away from the Hair invention in at least two ways. (See, e.g., Claims 13 and 14 of the '440 Patent as discussed in the Magistrate's Report at 65.)

g. The Hellman Patent:

This patent was issued in April 1987 and describes a "software distribution system." (Hayes Decl. Exh. 24, U.S. Patent No. 4,658,093, "the Hellman Patent.") The patent description concentrates on a mechanical means of preventing unauthorized copying. That is, the digital signal downloaded to the customer is never encrypted, per se; instead, the consumer must purchase a specially manufactured base unit which has a built-in decoder key. (Hellman Patent, col. 4, lines 37-63.) In order to playback the software, music or movie the consumer has purchased and downloaded, he initiates another contact to the seller who sends a signal to "unlock" the playback mechanism. In this sense, the Hellman Patent envisions a system more like "pay per view" television in that the copyright holder controls playback, not the consumer. (Defs.' Brief at 12.) As Dr. Tygar points out, the need for a special base unit (as compared to a personal computer) and the lack of control by the consumer both teach away from the Hair invention. (Tygar Rebuttal at 79.)

In sum, Dr. Tygar offers precise reasons why the prior art referenced by Defendants both fails to disclose the elements of the Sightsound Patents and fails to render the Asserted Claims obvious. Some prior art – for instance, the IRD Reports and the Hellman Patent – actually teach away from the Sightsound Patents and would thus discourage one skilled in the art in 1988 from attempting to develop a system or methodology comparable to the Hair invention.

There is another question to be considered, however, and that is whether one skilled in the art would be motivated to combine the teachings of Akashi, PAN, Compusonics and/or other prior art to arrive at the Hair invention. The Federal

Circuit has stated:

> Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be clear and particular.

Winner Int'l, 202 F.3d at 1348-49 (citations omitted).

As noted above, the purpose of the "motivation to combine" requirement is to prevent the use of hindsight based on the invention to defeat its patentability. "In other words, the [party opposing the patent] must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

Dr. Tygar has offered his views as to why none of the prior art references, read in combination with other prior art, would render the Asserted Claims obvious. Moreover, he has put forth several arguments to support the conclusion that some prior art references actually teach away from certain Sightsound elements such as copy protection or a single unit to control all aspects of the consumer's use of the invention. (See, e.g., Tygar Rebuttal at 54-55 (Bowen Article); 64, 66, 67 (IRD Reports); 75-76 (Freeny Patent); 76-78 (Akashi Patent); 78 (PAN); 78 (Compusonics); and 79 (Hellman).) These reasons are sufficiently cogent and well-reasoned that a factfinder could conclude the Sightsound Patents were not obvious.

Furthermore, I find that summary judgment must be denied because there are underlying unresolved questions of fact with regard to evidence of secondary considerations of non-obviousness. Secondary considerations can "provide objective evidence of how the patented device is viewed in the marketplace, by those directly interested in the product." Demaco Corp. v. F. Von Langsdorff Licensing Ltd., 851 F.2d 1387, 1391 (Fed. Cir. 1988). Secondary considerations include (1) long-felt but unsolved need; (2) commercial success of the invention; (3) failed efforts of others; (4) copying by others; (5) praise for the invention; (7) unexpected results; (8) disbelief of experts; (9) general skepticism of those in the art; (10) commercial acquiescence; and (11) simultaneous development. See Nat'l Steel Car, Ltd. v. Canadian Pac. Ry. Co., 254 F. Supp.2d 527, 570 (E.D. Pa. 2003), and cases cited therein. "Evidence of secondary considerations may often be the most probative and cogent evidence in the record. It may often establish that an invention appearing to have been obvious in light of the prior art was not. It is to be considered as part of all the evidence, not just when the decisionmaker remains in doubt after reviewing the art." Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1538-39 (Fed. Cir. 1983). However, "there must be a nexus between the claimed invention and the secondary considerations before the evidence is relevant to the question of obviousness." Nat'l Steel Car, Id., citing SIBIA Neurosciences, 225 F.3d at 1358-59.

Plaintiff has presented evidence showing that not later than 1987, Compusonics had abandoned its efforts to commercialize the music downloading

industry[27] and, in fact, Dr. Tygar opined that none of the systems incorporating prior art survived as a consumer oriented mass market distribution system for digital music distribution. (Tygar Rebuttal at 80.) As he also noted, the IRD Reports reflected a general skepticism in 1986 for the viability of a teledelivery system for digital audio signals. At the same time, numerous articles dating from the 1990s show an ongoing interest in such services, establishing the fact that there was a long-felt need for the invention. (Plf.'s Exh. C, Rebuttal Report of Frederic R. Miller, "Miller Rebuttal," at 5.) We also know from the history of this case that while the '440 Patent application was still pending, Sightsound accused N2K of illegally copying technology covered by its earlier Patents.

On the other hand, Defendants essentially omit any discussion of secondary considerations from their Brief in Support of the Motion for Summary Judgment. In their Reply Brief, their argument on this point is limited to a conclusory statement: "Sightsound has not presented relevant evidence of secondary considerations because it failed to establish a nexus between the merits of the claimed invention and the evidence offered." (Defs.' Reply Brief at 6, citing Cable Electric Prods., Inc., v. Genmark, Inc., 770 F.2d 1015, 1027 (Fed. Cir. 1985);[28] Sjolund v Musland, 847 F.2d 1573 (Fed. Cir. 1988); Windsurfing Int'l Inc., *supra*.) I have reviewed

---

[27] A former principal in Compusonics, David Schwartz, testified at his deposition that sometime in 1986 or 1987, his company "gave up on trying to commercialize" telerecording (which he defined as buying, selling and databasing music libraries for sale on demand.) (Plf.'s Exh. M, Deposition of David Schwartz, at 97.) He explained that record companies in the United States, Europe and Japan "were not receptive to the concept in any way, shape, or form." (Id. at 142.)

[28] Overruled on other grounds by Midwest Indus., Inc. v. Karavan Trailers, Inc., 175 F.3d 1356, 1358 (Fed. Cir. 1999).

the cited cases, despite not having a clear idea of how Defendants' single-sentence argument relates to them, and find that all three concentrate on commercial success, only one of many secondary considerations which may be offered by a patentee. See Cable Electric, id. at 1027, holding that for commercial success to have "true relevance" to the question of nonobviousness, that success must be shown to be due to the nature of the patented subject matter, rather than to economic and commercial factors unrelated to the technical quality of the patented subject matter; Siolund, id. at 1582, concluding that evidence of commercial success was irrelevant because the aspect of the invention to which its success was attributed was not part of the claimed invention. Windsurfing Int'l, which also discusses commercial success, focuses on the weight a district court may properly give to secondary considerations, concluding that the weight should correlate to the objective evidence provided to support them. 782 F.2d at 1000.

Here, I have noted Plaintiff's arguments that at the time the Sightsound Patents were issued, there were numerous examples of secondary considerations: copying, skepticism on the part of those skilled in the art as to the viability of such a system, long-felt but unsatisfied needs, and unsuccessful attempts by others to solve the problem underlying the claimed invention. Given nothing substantive from Defendants in their Reply Brief to refute these claims, I accept them as presented by Plaintiff for purposes of deciding this summary judgment motion.

5. Conclusion:

Conflicts in the evidence on factual issues are not to be resolved on summary

Form PTO-1595 (Rev. 08/05)
OMB No. 0651-0027 (exp. 6/30/2008)

Docket Number: GE219099

U.S. DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

RECORDATION FORM COVER SHEET

PATENTS ONLY

To the Director of the U.S. Patent and Trademark Office: Please record the attached documents or the new address(es) below.

1. Name of conveying party(ies)/Execution Date(s):

SightSound Technologies, Inc. (Delaware Corp)

Execution Date(s) 10 November 2005

Additional name(s) of conveying party(ies) attached? ☐ Yes ☑ No

2. Name and address of receiving party(ies)

Name: DMT Licensing, LLC (Delaware LLC)

Internal Address:

Street Address: One Independence Way

City: Princeton

State: New Jersey

Country: US Zip: 08540

Additional name(s) & address(es) attached? ☐ Yes ☑ No

3. Nature of conveyance:

☑ Assignment ☐ Merger

☐ Security Agreement ☐ Change of Name

☐ Government Interest Assignment

☐ Executive Order 9424, Confirmatory License

☐ Other

4. Application or patent number(s):

☐ This document is being filed together with a new application.

A. Patent Application No.(s)

09/286,892
10/820,995
10/632,166

B. Patent No.(s)

5,191,573 6,721,491
5,675,734 6,615,349
5,966,440 6,014,491

Additional numbers attached? ☐ Yes ☑ No

5. Name and address to whom correspondence concerning document should be mailed:

Name: Matthew P. McWilliams

Internal Address: Drinker Biddle & Reath LLP

Street Address: One Logan Square
18th and Cherry Streets

City: Philadelphia

State: Pennsylvania Zip: 19103-6996

Phone Number: 215.988.3381

Fax Number: 215.988.2757

Email Address: matthew.mcwilliams@dbr.com

6. Total number of applications and patents involved: 9

7. Total fee (37 CFR 1.21(h) & 3.41) $ 360.00

☐ Authorized to be charged by credit card

☐ Authorized to be charged to deposit account

☑ Enclosed

☐ None required (government interest not affecting title)

8. Payment Information

a. Credit Card Last 4 Numbers
Expiration Date

b. Deposit Account Number

Authorized User Name

9. Signature:

Signature — December 26, 2005 Date

Matthew P. McWilliams, Reg. No. 46,922
Name of Person Signing

Total number of pages including cover sheet, attachments, and documents: 6

Documents to be recorded (including cover sheet) should be faxed to (703) 306-5995, or mailed to:
Mail Stop Assignment Recordation Services, Director of the USPTO, P.O.Box 1450, Alexandria, V.A. 22313-1450

PATENT ASSIGNMENT AGREEMENT

THIS PATENT ASSIGNMENT AGREEMENT (this "Agreement"), is made as of this 10th day of November, 2005 by and between SightSound Technologies, Inc., a Delaware corporation ("Assignor"), and DMT Licensing, LLC, a Delaware limited liability company ("Assignee"). Assignor and Assignee are sometimes referred to herein as a "Party" or collectively as the "Parties."

WITNESSETH:

WHEREAS, Assignor is the owner of the entire right, title and interest in and to all of the patents and patent applications (including any and all inventions and improvements disclosed and described therein) set forth on Exhibit A hereto (the "Patents"); and

WHEREAS, Assignee desires to obtain all of Assignor's right, title and interest in, to and under the Patents.

NOW THEREFORE, in consideration of the premises and mutual covenants contained in this Agreement and in the Asset Purchase Agreement between Assignor and Assignee, the receipt and sufficiency of which are hereby acknowledged, the Parties agree as follows:

1. Assignor hereby conveys, assigns, sells, transfers and delivers to Assignee, its successors and assigns, all of its right, title and interest throughout the world in, to and under the Patents, including the underlying inventions described therein and any and all United States or foreign reissues, divisions, renewals, extensions, provisionals, continuations and continuations-in-part thereof and substitutes therefor, all letters patent of the United States which have been or may be granted thereof and all foreign counterparts thereof, including any reissues or extensions of letters patent granted thereon and any and all rights corresponding to any of the foregoing throughout the world, all priority rights under the International Convention for the Protection of Industrial Property for every member country (and any other international convention or treaty), any and all accounts, contract rights, warranties, litigation claims and rights, including the right to sue for and collect upon all claims for profits and damages as a result of future or past infringement, and other general intangibles of Assignor related to any of the foregoing, in each case whether now existing or hereafter acquired or created, whether owned, leased or licensed beneficially or of record and whether owned, leased or licensed individually, jointly or otherwise, together with the products and proceeds thereof (including license royalties and the proceeds of infringement suits from the date of this Agreement forward), all payments and other distributions with respect thereto from the date of this Agreement forward, and the right to fully and entirely stand in the place of Assignor in all matters related thereto.

2. Assignor hereby conveys, assigns, transfers and delivers to Assignee, its successors and assigns, all of its right, title and interest throughout the world in and to any and all lab notes, prototypes, draft patent applications, correspondence with the United States Patent and Trademark Office or any foreign patent office, nondisclosure agreements, invention agreements and noncompete agreements, to the extent such materials relate to the Patents.

3. Assignor hereby requests the Commissioner for Patents (the "Commissioner") to record this assignment of the Patents to Assignee. Assignor hereby further requests the

Commissioner to issue any and all letters patent of the United States resulting from applications among the Patents or derived therefrom to Assignee as assignee of the entire interest. Assignor hereby covenants that the Commissioner has full right to convey the entire interest herein assigned, and that Assignor has not executed, and will not execute, any agreements inconsistent herewith.

4. Assignor further agrees that it shall on the date hereof and from time to time thereafter, at the request of Assignee, perform or cause to be performed such acts and execute, acknowledge and deliver at the request of Assignee, such documents as may reasonably be required to evidence or effectuate the sale, conveyance, assignment, transfer and delivery to Assignee of the Patents or for the performance by Assignor of any of its obligations hereunder.

5. This Agreement will be binding upon and will inure to the benefit of the parties hereto and their successors and assigns, and no person other than Assignor, Assignee or their respective successors and assigns shall have any rights under this Agreement or the provisions contained herein.

6. An executed copy of this Agreement may be filed with the proper governmental or regulatory authority or public body by Assignee at any time.

7. This Agreement shall be governed by and construed in accordance with the laws of the State of New York without regard for the conflicts of laws principles thereof, except that if it is necessary in any other jurisdiction to have the law of such other jurisdiction govern this Agreement in order for this Agreement to be effective in any respect, then the laws of such other jurisdiction shall govern this Agreement but only to such extent.

[SIGNATURE PAGE FOLLOWS]

IN WITNESS WHEREOF, the Parties have caused this Agreement to be duly executed, as of the date first above written.

ASSIGNEE

By: _____
Name: Peter Moller
Title: Vice President
Date: November 10, 2005

ASSIGNOR

By: _____
Name: Scott C. Sander
Title: President and Chief Executive Officer
Date: November 10, 2005

Commonwealth of Pennsylvania
County of Allegheny ss.:

On the 10th day of November, 2005, before me personally came Scott C. Sander, to me known (or satisfactorily proven), who being by me duly sworn, did depose and say that he is the Prindent and CEO of Assignor, the corporation described in, and which executed the foregoing instrument, and that he was fully authorized to execute this Patent Assignment Agreement on behalf of said corporation.

_____
Notary Public

COMMONWEALTH OF PENNSYLVANIA
Notarial Seal
Kendra J. Jenkins, Notary Public
City Of Pittsburgh, Allegheny County
My Commission Expires Jan. 12, 2008
Member, Pennsylvania Association Of Notaries

EXHIBIT A

PATENTS AND PATENT APPLICATIONS

A/V eCommerce Patents:

	Country	Number	Issued
01]	United States	5,191,573	Issued
02]	United States	5,675,734	Issued
03]	United States	5,966,440	Issued
04]	United States	09/286,892	Application In Process

A/V Compression Patents:

01]	United States	6,014,491	Issued
02]	Singapore	67158	Issued
03]	New Zealand	337344	Issued
04]	Australia	752057	Issued
05]	China	1252917	Issued
06]	United States	6,721,491	Issued
07]	Hong Kong	1025208	Issued
08]	Australia	6341198	Application In Process
09]	Brazil	9811455	Application In Process
10]	Canada	2279853	Application In Process
11]	China	1121124C	Application In Process
12]	European Patent Office	0965128	Application In Process
13]	Japan	2002508850T	Application In Process
14]	United States	2005038535	Application In Process
15]	World Intellectual Property Organization	9843405	Application In Process

Applied Encryption Patents:

01]	New Zealand	502871	Issued
02]	United States	6,615,349	Issued
03]	Taiwan	574641	Issued
04]	Singapore	93860	Issued
05]	Australia	776005	Issued
06]	Austria	EP2000300727	Pending
07]	Belgium	EP2000300727	Pending
08]	Cypress	EP2000300727	Pending
09]	Denmark	EP2000300727	Pending
10]	Finland	EP2000300727	Pending
11]	France	EP2000300727	Pending
12]	Germany	EP2000300727	Pending
13]	Greece	EP2000300727	Pending
14]	Ireland	EP2000300727	Pending
15]	Italy	EP2000300727	Pending
16]	Lichtenstein	EP2000300727	Pending
17]	Luxembourg	EP2000300727	Pending
18]	Monaco	EP2000300727	Pending

19]	Netherlands	EP2000300727	Pending
20]	Portugal	EP2000300727	Pending
21]	Sweden	EP2000300727	Pending
22]	Spain	EP2000300727	Pending
23]	Switzerland	EP2000300727	Pending
24]	United Kingdom	EP2000300727	Pending
25]	China	CN1269549	Pending
26]	Hong Kong	HK1028466	Pending
27]	Australia	1481000	Application In Process
28]	Brazil	0000702	Application In Process
29]	Canada	2299056	Application In Process
30]	Japan	2000259478	Application In Process
31]	United States	2004025037	Application In Process

***Peer-to-Peer Patents*:**

01]	European Patent Office	1332428	Application In Process
02]	Japan	JP2004513453T	Application In Process
03]	World Intellectual Property Organization	239253	Application In Process

All Intellectual Property to be free of any liens or encumbrances.

FORM PTO-1595
(Rev. 6-93)
OMB No. 0651-0011 (exp. 4/94)

RECORDATIC
PAT

10-20-1995

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

Tab settings ▼ ▼ ▼ ▼ ▼ ▼

To the Honorable Commissioner of Patents and Trade

100079959

ocuments or copy thereof.

1. Name of conveying party(ies):

Arthur R. Hair

mrd 10-2-95

Additional name(s) of conveying party(ies) attached? ☐ Yes ☒ No

2. Name and address of receiving party(ies)

Name: Parsec Sight/Sound, Inc.

Internal Address: _____

Street Address: 1518 Allison Drive

City: Upper St. Clair State: PA ZIP: 15241

Additional name(s) & address(es) attached? ☐ Yes ☒ No

3. Nature of conveyance:

☒ Assignment ☐ Merger

☐ Security Agreement ☐ Change of Name

☐ Other _____

Execution Date: September 20, 1995

4. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application is: _____

A. Patent Application No.(s)

B. Patent No.(s)
5,191,573

Additional numbers attached? ☐ Yes ☒ No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: Ansel M. Schwartz

Internal Address: _____

Street Address: 425 N. Craig Street, Suite 301

City: Pittsburgh State: PA ZIP: 15213

6. Total number of applications and patents involved: 1

7. Total fee (37 CFR 3.41).....$ 40.00

☒ Enclosed

☐ Authorized to be charged to deposit account

8. Deposit account number:

_____

(Attach duplicate copy of this page if paying by deposit account)

DO NOT USE THIS SPACE

050 MH 10/16/95 5191573
1-56 40.00 CK

9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Ansel M. Schwartz
Name of Person Signing

Ansel Schwartz
Signature

9/21/95
Date

Total number of pages including cover sheet, attachments, and document: 4

Mail documents to be recorded with required cover sheet information to:
Commissioner of Patents & Trademarks, Box Assignments
Washington, D.C. 20231

PATENT
REEL: 7656 FRAME: 0701

Attorney's Docket No. HAIR **PATENT**

For: ☒ U.S. and/or ☐ Foreign Rights
For: ☐ U.S. Application or
☐ U.S. Provisional Application
For: ☒ U.S. Patent
For: ☐ PCT Application
By: ☒ Inventor(s) or ☐ Present Owner

ASSIGNMENT OF INVENTION

In consideration of the payment by ASSIGNEE to ASSIGNOR of the sum of One Dollar ($1.00), the receipt of which is hereby acknowledged, and for other good and valuable consideration,

ASSIGNOR:

(inventor(s) or person(s) or entity(ies) who own the *invention*)

Arthur R. Hair
(type or print name(s) of ASSIGNOR(S))

1518 Allison Drive
Address

Upper St. Clair, PA 15241

Nationality

(if assignment is by person or entity to whom invention was previously assigned and this was recorded in PTO, add the following)

Recorded on _____ **Reel** _____
Frame _____

hereby sells, assigns and transfers to

ASSIGNEE:

Parsec Sight/Sound, Inc.
(type or print name(s) of ASSIGNEE(S))

1518 Allison Drive
Address

Upper St. Clair, PA 15241

Nationality

and the successors, assigns and legal representatives of the ASSIGNEE

(complete one of the following)

☒ the entire right, title and interest

☐ an undivided _____ percent (_____%) interest

for the United States and its territorial possessions

(check the following box, if foreign rights are also to be assigned)

☐ and in all foreign countries, including all rights to claim priority,

in and to any and all improvements which are disclosed in the invention entitled:

METHOD FOR TRANSMITTING A DESIRED DIGITAL VIDEO OR AUDIO SIGNAL

Name of inventor(s) Arthur R. Hair

(check and complete (a), (b), (c), (d), (e), (f) or (g))

and which is found in

(a) ☐ U.S. patent application executed on even date herewith

(b) ☐ U.S. patent application executed on _____

(c) ☐ U.S. provisional application naming the above inventor(s) for the above-entitled invention.

☐ Express mail label no.: _____

Mailed: _____

☐ To comply with 37 CFR 3.21 for recordal of this assignment, I, an ASSIGNOR signing below, hereby authorize and request my attorney to insert below the filing date and application number when they become known.

(d) ☐ U.S. application no. /_____

filed on _____

(e) ☐ International appliciation no. PCT/ _____ /_____

(f) ☒ U.S. patent no. 5,191,573 issued March 2, 1993

☐ A change of address to which correspondence is to be sent regarding patent maintenance fees is being sent separately.

(also check (g), if foreign application(s) is also being assigned)

(g) ☐ and any legal equivalent thereof in a foreign country, including the right to claim priority.

and, in and to, all Letters Patent to be obtained for said invention by the above application or any continuation, division, renewal, or substitute thereof, and as to letters patent any reissue or re-examination thereof

ASSIGNOR hereby covenants that no assignment, sale, agreement or encumbrance has been or will be made or entered into which would conflict with this assignment;

ASSIGNOR further covenants that ASSIGNEE will, upon its request, be provided promptly with all pertinent facts and documents relating to said invention and said Letters Patent and legal equivalents as may be known and accessible to ASSIGNOR and will testify as to the same in any interference, litigation or proceeding related thereto and will promptly execute and deliver to ASSIGNEE or its legal representatives any and all papers, instruments or affidavits required to apply for, obtain, maintain, issue and enforce said application, said invention and said Letters Patent and said equivalents thereof which may be necessary or desirable to carry out the purposes thereof.

IN WITNESS WHEREOF, I/We have hereunto set hand and seal this

20th day of Sept. 1995 (Date of signing).

WARNING: *The date of signing must be the same as the date of execution of the application, if item (a) was checked above.*

Date: 9/20/1995 _____
Signature of ASSIGNOR(S)

Date: _____

Date: _____

Date: _____

(if ASSIGNOR is a legal entity, complete the following information)

_____
(type or print the name of the above person authorized to sign on behalf of ASSIGNOR)

_____
Title

NOTE: No witnessing, notarization or legalization is necessary. If the assignment is notarized or legalized, then it will only be prima facie evidence of execution. 35 USC 261. Use next page if notarization is desired.

☐ Notarization or Legalization Page Added.

FORM PTO-1595
(Rev. 6-93)
OMB No. 0651-0011 (exp. 4/94)

Tab settings ⇨ ⇨ ⇨

RECORD 05-16-2000 U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

101357242

To the Honorable Commissioner of Patents ar riginal documents or copy thereof.

1. Name of conveying party(ies): MLD 53.00
Parsec Sight/Sound, Inc.

Additional name(s) of conveying party(ies) attached? ☐ Yes ☒ No

2. Name and address of receiving party(ies)

Name: SightSound.com Incorporated

Internal Address:

Street Address: 733 Washington Road,
Suite 400

City: Mt. Lebanon State: PA ZIP: 15228

Additional name(s) & address(es) attached? ☐ Yes ☒ No

3. Nature of conveyance:

☐ Assignment ☐ Merger
☐ Security Agreement ☒ Change of Name
☐ Other

Execution Date:

4. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application is:

A. Patent Application No.(s)
08/023,398 09/469,802
09/286,892 09/256,432

B. Patent No.(s)
5,191,573 5,966,440
5,675,734 6,014,491

Additional numbers attached? ☐ Yes ☒ No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: Ansel M. Schwartz

Internal Address:

Street Address: One Sterling Plaza,
201 N. Craig Street, Suite 304

City: Pittsburgh State: PA ZIP: 15213

6. Total number of applications and patents involved: 8

7. Total fee (37 CFR 3.41).....$ 320.00

☒ Enclosed

☐ Authorized to be charged to deposit account

8. Deposit account number:

(Attach duplicate copy of this page if paying by deposit account)

05/16/2000 DNGUYEN 00000058 08023398
01 FC:581 320.00 OP

DO NOT USE THIS SPACE

9. Statement and signature.
To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Ansel M. Schwartz
Name of Person Signing

Signature

4/28/00
Date

Total number of pages including cover sheet, attachments, and document: 18

Mail documents to be recorded with required cover sheet information to:
Commissioner of Patents & Trademarks, Box Assignments
Washington, D.C. 20231

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CHANGE OF NAME IN RECORDED ASSIGNMENTS

1. Particulars of assignments

A list of assignments recorded against patent applications and/or patents is set forth on the attached page.

2. Old name of assignee

The old name for the assignee as shown for the assignments on the attached page is:

Parsec Sight/Sound, Inc.

(type or print old name of Assignee)

3. New name of assignee

The new name of the assignee is

SightSound.com Incorporated

(type or print new name of Assignee)

4. Proof of name change

Proof of assignee's change of name is established by the attached

☒ certificate of the Secretary of State of Pennsylvania, showing the name change. *(type name of state)*

☐ certificate of name change from: _____. *(type or print name of authority)*

(check, if applicable)

☐ Because the certificate or the certified copy of the name change is not in the English language, it is accompanied by a verified translation signed by the translator.

5. Change of address for patent maintenance fees

(complete, if applicable)

☐ A change of address to which correspondence is to be sent regarding patent maintenance fees for each patent listed is being sent separately.

COMMONWEALTH OF PENNSYLVANIA

DEPARTMENT OF STATE

APRIL 26, 2000

TO ALL WHOM THESE PRESENTS SHALL COME, GREETING:

SIGHTSOUND.COM INCORPORATED

I, Kim Pizzingrilli, Secretary of the Commonwealth of Pennsylvania do hereby certify that the foregoing and annexed is a true and correct photocopy of Articles of Incorporation and all Amendments

which appear of record in this department

IN TESTIMONY WHEREOF, I have hereunto set my hand and caused the Seal of the Secretary's Office to be affixed, the day and year above written.

Kim Pizzingrilli

Secretary of the Commonwealth

JS0W

198:198166

Microfilm Number _____ _____

Entity Number 2449623

File with the Department of State on AUG 01 1995

Secretary of the Commonwealth

ARTICLES OF INCORPORATION-FOR PROFIT
DSCB:15-1306/2102/2303/2702/2903/7102A (Rev 90)

Indicate type of domestic corporation (check one):

X Business-stock (15 Pa.C.S. § 1306) ____ Management (15 Pa.C.S. § 2702)

____ Business-nonstock (15 Pa.C.S. § 2102) ____ Professional (15 Pa.C.S. § 2903)

____ Business-statutory close (15 Pa.C.S. § 2303) ____ Cooperative (15 Pa.C.S. § 7102A)

In compliance with the requirements of the applicable provisions of 15 Pa.C.S. (relating to corporations and unincorporated associations) the undersigned, desiring to incorporate a corporation for profit hereby state(s) that:

1. The name of the corporation is: Parsec Sight/Sound, Inc.

2. The (a) address of this corporation's initial registered office in this Commonwealth or (b) name of its commercial registered office provider and the county of venue is:

(a)	1518 Allison Drive Number and Street	Upper St. Clair City	PA State	15241 Zipcode	Allegheny County
(b)	c/o: N/A Name of Commercial Registered Office Provider				County

For a corporation represented by a commercial registered office provider, the county in (b) shall be deemed the county in which the corporation is located for venue and official publication purposes.

3. The corporation is incorporated under the provisions of the Business Corporation Law of 1988.

4. The aggregate number of shares authorized is: 100,000 (other provisions, if any, attach 8 1/2 x 11 sheet)

5. The name and address, including street and number, if any, of each incorporator is:

Name	Address
Joan E. Marshall	1300 Oliver Building Pittsburgh, PA 15222

AUG-1 95

PA Dept. of State

198:198166

6. The specified effective date, if any, is:

N/A _____ _____
month day year hour, if any

7. Any additional provisions of the articles, if any, attach an 8 1/2 x 11 sheet.

8. **Statutory close corporation only:** Neither the corporation nor any shareholder shall make an offering of any of its shares of any class that would constitute a "Public Offering" within the meaning of the Securities Act of 1933 (15 U.S.C. § 77A et seq.).

9. **Cooperative corporations only:** (Complete and strike out inapplicable term) The common bond of membership among its members/shareholders is: N/A

IN TESTIMONY WHEREOCF, the incorporator has signed these Articles of Incorporation this 1st day of August, 1995.

Joan E. Marshall
Joan E. Marshall

162160A.

Microfilm Number _____ Filed with the Department of State on APR 03 1996

Entity Number 2649623 _____ Secretary of the Commonwealth

ARTICLES OF AMENDMENT-DOMESTIC BUSINESS CORPORATION
DSCB:15-1915 (Rev 90)

In compliance with the requirements of 15 Pa.C.S. § 1915 (relating to articles of amendment), the undersigned business corporation, desiring to amend its Articles, hereby states that:

1. The name of the corporation is: PARSEC SIGHT/SOUND, INC.

2. The address of this corporation's current (a) registered office in this Commonwealth or (b) name of its commercial registered office provider and the county of venue is (the Department is hereby authorized to correct the following address to conform to the records of the Department):

(a)	1518 Allison Drive	Upper St. Clair	PA	15241	Allegheny
	Number and Street	City	State	Zip	County

(b) c/o: N/A
Name of Commercial Registered Office Provider County

For a corporation represented by a commercial registered office provider, the county in (b) shall be deemed the county in which the corporation is located for venue and official publication purposes.

3. The statute by or under which it was incorporated is: Business Corporation Law of 1988, Act of December 21, 1988, P.L. 1444, as amended

4. The date of its incorporation is: August 1, 1995

5. (Check, and if appropriate complete, one of the following):

X The amendment shall be effective upon filing these Articles of Amendment in the Department of State.

____ The amendment shall be effective on: _____
Date
at _____
Hour

6. (Check one of the following):

X The amendment was adopted by the shareholders pursuant to 15 Pa.C.S. §1914(a) and (b).

APR-3 96

PA Dept. of State

162160A

____ The amendment was adopted by the board of directors pursuant to 15 Pa.C.S. §1914 (c).

7. (Check, and if appropriate complete, one of the following):

__X__ The amendment adopted by the corporation, set forth in full, is as follows:

Paragraph 4 of the Articles of Incorporation shall be amended to read as follows:

4. The aggregate number of shares authorized is 1,000,000, each share having a par value of .1¢ per share.

A new Paragraph 10 shall be added to the Articles of Incorporation which shall read as follows:

10. The shareholders of the Corporation shall not be entitled to cumulate their votes for the election of directors or for any other purpose.

____ The amendment adopted by the corporation is set forth in full in Exhibit A, attached hereto and made a part hereof.

8. (Check if the amendment restates the Articles):

____ The restated Articles of Incorporation supersede the original Articles and all amendments thereto.

IN TESTIMONY WHEREOF, the undersigned corporation has caused these Articles of Amendment to be signed by a duly authorized officer thereof this 2ND day of APRIL, 1996.

Arthur R. Hair

PCDOCS#: 73331 9764-1192

Filed with the Department of State

Microfilm Number _____ on AUG 25 1997

Entity Number 2649623

Secretary of the Commonwealth

ARTICLES OF AMENDMENT-DOMESTIC BUSINESS CORPORATION
DSCB:15-1915 (Rev 90)

In compliance with the requirements of 15 Pa.C.S. § 1915 (relating to articles of amendment), the undersigned business corporation, desiring to amend its Articles, hereby states that:

1. The name of the corporation is: PARSEC SIGHT/SOUND, INC.

2. The address of this corporation's current (a) registered office in this Commonwealth or (b) name of its commercial registered office provider and the county of venue is (the Department is hereby authorized to correct the following address to conform to the records of the Department):

(a)	1518 Allison Drive	Upper St. Clair	PA	15241	Allegheny
	Number and Street	City	State	Zip	County

(b) c/o: N/A
Name of Commercial Registered Office Provider County

For a corporation represented by a commercial registered office provider, the county in (b) shall be deemed the county in which the corporation is located for venue and official publication purposes.

3. The statute by or under which it was incorporated is: Pennsylvania Business Corporation Law of 1988, Act of December 21, 1988, P.L. 1444, as amended

4. The date of its incorporation is: August 1, 1995

5. (Check, and if appropriate complete, one of the following):

X The amendment shall be effective upon filing these Articles of Amendment in the Department of State.

___ The amendment shall be effective on: _____
Date
at _____
Hour

AUG 25 97
PA Dept. of State

6. **(Check one of the following):**

_X_ The amendment was adopted by the shareholders pursuant to 15 Pa.C.S. §1914(a) and (b).

___ The amendment was adopted by the board of directors pursuant to 15 Pa.C.S. §1914 (c).

7. **(Check, and if appropriate complete, one of the following):**

_X_ The amendment adopted by the corporation, set forth in full, is as follows:

Paragraph 4 of the Articles of Incorporation shall be amended to read as follows:

4. The aggregate number of shares authorized is 100,000,000, each share having a par value of .001¢

___ The amendment adopted by the corporation is set forth in full in Exhibit A, attached hereto and made a part hereof.

8. **(Check if the amendment restates the Articles):**

___ The restated Articles of Incorporation supersede the original Articles and all amendments thereto.

IN TESTIMONY WHEREOF, the undersigned corporation has caused these Articles of Amendment to be signed by a duly authorized officer thereof this 15th day of August 1997.

PARSEC SIGHT/SOUND, INC.

BY: Arthur R. Hair

Arthur R. Hair

TITLE: Authorized Officer

PCDOCS#: 96304

9808-947

Microfilm Number_____

Filed with the Department of State
on FEB 05 1998

Entity Number 264623

Secretary of the Commonwealth

STATEMENT OF CHANGE OF REGISTERED OFFICE
DSCB:15-1507/4144/5507/6144/8506 (Rev 90)

Indicate type of entity (check one):

X **Domestic Business Corporation** (15 Pa.C.S. § 1507)

___ **Foreign Business Corporation** (15 Pa.C.S. § 4144)

___ **Domestic Nonprofit Corporation** (15 Pa.C.S. § 5507)

___ **Foreign Nonprofit Corporation** (15 Pa.C.S. § 6144)

___ **Domestic Limited Partnership** (15 Pa.C.S. § 8506)

In compliance with the requirements of the applicable provisions of 15 Pa.C.S. (relating to corporations and unincorporated associations) the undersigned corporation or limited partnership, desiring to effect a change of registered office, hereby states that:

1. The **name** of the corporation or limited partnership is: Parsec Sight/Sound, Inc.

2. The (a) **address** of this corporation's or limited partnership's current registered office in this Commonwealth or (b) **name** of its commercial registered office provider and the county of venue is: (the Department is hereby authorized to correct the following address to conform to the records of the Department):

(a) 1518 Allison Drive (Number and Street) Upper St. Clair (City) PA (State) 15241 (Zip) Allegheny (County)

(b) c/o: N/A (Name of Commercial Registered Office Provider) (County)

For a corporation or a limited partnership represented by a commercial registered office provider, the county in (b) shall be deemed the county in which the corporation or limited partnership is located for venue and official publication purposes.

3. **(Complete part (a) or (b))**:

PA DEPT. OF STATE

FEB 05 1998

PCDOCS#: 96304

(a) The **address** to which the registered office of the corporation or limited partnership in this Commonwealth is to be changed is:

733 Washington Road	Mt. Lebanon	PA	15228	Allegheny
Number and Street	City	State	Zip	County

(b) The registered office of the corporation or limited partnership shall be provided by:

c/o: N/A
Name of Commercial Registered Office Provider — County

For a corporation or a limited partnership represented by a commercial registered office provider, the county in (b) shall be deemed the county in which the corporation or limited partnership is located for venue and official publication purposes.

4. **(Strike out if a limited partnership):** Such change was authorized by the Board of Directors of the corporation.

IN TESTIMONY WHEREOF, the undersigned corporation or limited partnership has caused this statement to be signed by a duly authorized officer this 19th day of January, 1998.

Parsec Sight/Sound, Inc.

BY: Arthur R. Hair
Arthur R. Hair, Chairman

PCDOCS# 139018

Filed with the Department of State

Microfilm Number _____ on _____

Entity Number 2644423 _____

ACTING Secretary of the Commonwealth

ARTICLES OF MERGER-DOMESTIC BUSINESS CORPORATION
DSCB:15-1926 (Rev 90)

In compliance with the requirements of 15 Pa.C.S. §1926 (relating to articles of merger or consolidation), the undersigned business corporations, desiring to effect a merger, hereby state that:

1. The name of the corporation surviving the merger is: Parsec Sight/Sound, Inc.

2. (Check and complete one of the following):

X The surviving corporation is a domestic business corporation and the (a) address of its current registered office in this Commonwealth or (b) name of its commercial registered office provider and the county of venue is (the Department is hereby authorized to correct the following address to conform to the records of the Department):

(a) 733 Washington Road Mt. Lebanon PA 15228 Allegheny
Number and Street City State ZipCode County

(b) c/o: N/A
Name of Commercial Registered Office Provider County

For a corporation represented by a commercial registered office provider, the county in (b) shall be deemed the county in which the corporation is located for venue and official publication purposes.

N/A The surviving corporation is a qualified foreign business corporation incorporated under the laws of, and the (a) address of its current registered office in this Commonwealth or (b) name of its commercial registered office provider and the county of venue is (the Department is hereby authorized to correct the following address to conform to the records of the Department):

(a) N/A
Number and Street City State Zip County

PTDOCS#: 139856

4. Upon said merger becoming effective, each share of common capital stock of Digital shall be converted into one share of common capital stock of the Surviving Corporation. A Certificate for the appropriate number of shares of the common capital stock of the Surviving Corporation shall be delivered by the Surviving Corporation to each shareholder of Digital on or after the Effective Date, upon such shareholder's delivery to the Surviving Corporation of the certificates representing all of such shareholder's shares of common capital stock of Digital. The shares of common capital stock of the Surviving Corporation presently outstanding shall remain outstanding.

5. Each share of common capital stock of Digital outstanding prior to the Effective Date shall after the Effective Date represent only the right to receive one validly issued, fully paid and non-assessable share of common capital stock of the Surviving Corporation. As of the Effective Date, the equity interest of each shareholder of Digital as a shareholder of Digital shall be extinguished.

6. This Agreement and Plan of Merger shall be submitted to the shareholders of each of the Corporations for approval by unanimous written consent and agreement pursuant to and in accordance with §1924(a) of the Business Corporation Law of 1988.

7. At any time prior to the Effective Date, this Agreement and Plan of Merger may be terminated by the board of directors of either of the Corporations.

IN WITNESS WHEREOF, the parties hereto, with the intent to be legally bound hereby, have entered into this Agreement and Plan of Merger and have duly authorized their respective officers to execute the same in their respective corporate names, the day and year first above written.

PARSEC SIGHT/SOUND, INC.

By: _____
Scott C. Sander, President

DIGITAL SIGHT/SOUND, INC.

By: _____
Scott C. Sander, President

PCDOCS#: 138856

Exhibit "A"

AGREEMENT AND PLAN OF MERGER

THIS AGREEMENT AND PLAN OF MERGER (this "Agreement and Plan of Merger") made this 22nd day of September, 1998, by and between **PARSEC SIGHT/SOUND, INC.** ("Parsec"), a Pennsylvania corporation with its registered office located at 733 Washington Road, Suite 212, Mt. Lebanon, Pennsylvania 15228, and **DIGITAL SIGHT/SOUND, INC.** ("Digital"), a Pennsylvania corporation with its registered office located at 733 Washington Road, Suite 212, Mt. Lebanon, Pennsylvania 15228. Parsec and Digital are also herein referred to collectively as the "Corporations".

WHEREAS, Parsec and Digital are corporations duly organized and validly existing under the laws of the Commonwealth of Pennsylvania, having both been incorporated on August 1, 1995, under and in accordance with the provisions of the Pennsylvania Business Corporation Law of 1988, Act of December 21, 1988, P.L. 1144, as amended (the "Business Corporation Law of 1988"); and

WHEREAS, the Corporations desire to merge Digital into Parsec under and in accordance with the provisions of the Business Corporation Law of 1988.

NOW, THEREFORE, in consideration of the premises and of the terms and conditions hereinafter set forth, the parties hereto, with the intent to be legally bound hereby, mutually agree to merge the Corporations upon the following terms and conditions:

1. Upon compliance with the applicable provisions of the Business Corporation Law of 1988, on the Effective Date (as defined herein), Digital shall be merged with and into Parsec and thereupon the separate existence of Digital shall cease. Parsec, as it shall exist after the Effective Date, is hereinafter referred to as the "Surviving Corporation".

2. Articles of Merger shall be filed with the Department of State of the Commonwealth of Pennsylvania, and the merger shall be effective as of the date of filing of said Articles of Merger (the "Effective Date").

3. The Articles of Incorporation and By-laws of Parsec, as amended through the Effective Date, shall continue to be the Articles of Incorporation and By-laws of the Surviving Corporation and shall not be amended or otherwise affected by the merger provided for herein except as follows:

a. Article 1 of the Articles of Incorporation and Section 1.1 of the By-laws shall both read as follows: The name of the Corporation is SIGHTSOUND.COM INCORPORATED.

b. Article 2 of the Articles of Incorporation shall read as follows: The address of this corporation's registered office in this Commonwealth and the county of venue is 733 Washington Road, Suite 400, Mt. Lebanon, Pennsylvania 15228, Allegheny.

PCDOCS#: 139018

Digital Sight/Sound, Inc. — Adopted by the directors and shareholders pursuant to 15 Pa.C.S. § 1924(a)

6. (Strike out this paragraph if no foreign corporation is a party to the merger). ~~The plan was authorized, adopted or approved, as the case may be, by the foreign business corporation (or each of the foreign business corporations) party to the plan in accordance with the laws of the jurisdiction in which it is incorporated.~~

7. (Check, and if appropriate complete, one of the following):

X The plan of merger is set forth in full in Exhibit A attached hereto and made a part hereof.

___ Pursuant to 15 Pa.C.S. §1901 (relating to omission of certain provisions from filed plans) the provisions of the plan of merger that amend or constitute the operative Articles of Incorporation of the surviving corporation as in effect subsequent to the effective date of the plan are set forth in full in Exhibit A, attached hereto and made a part hereof. The full text of the plan of merger is on file at the principal place of business of the surviving corporation, the address of which is:

N/A
Number and Street City State Zip County

IN TESTIMONY WHEREOF, each undersigned corporation has caused these Articles of Merger to be signed by a duly authorized officer thereof this 31st day of March, 1999.

PARSEC SIGHT/SOUND, INC.

BY: _____
Scott C. Sander, President

DIGITAL SIGHT/SOUND, INC.

BY: _____
Scott C. Sander, President

PCDOCS• 139918

(b) c/o: _____
Name of Commercial Registered Office Provider County

For a corporation represented by a commercial registered office provider, the county in (b) shall be deemed the county in which the corporation is located for venue and official publication purposes.

N/A The surviving corporation is a nonqualified foreign business corporation incorporated under the laws of and the address of its principal office under the laws of such domiciliary jurisdiction is:

N/A _____
Number and Street City State Zip County

3. The name and the address of the registered office in this Commonwealth or name of its commercial registered office provider and the county of venue of each other domestic business corporation and qualified foreign business corporation which is a party to the plan of merger are as follows:

Name of Corporation	Address of Registered Office or Name of Commercial Registered Office Provider	County
Digital Sight/Sound, Inc.	733 Washington Road Mt. Lebanon, PA 15228	Allegheny

4. (Check, and if appropriate complete, one of the following):

_X The plan of merger shall be effective upon filing these Articles of Merger in the Department of State.

___ The plan of merger shall be effective on :

_____ at _____
Date Hour

5. The manner in which the plan of merger was adopted by each domestic corporation is as follows:

Name of Corporation	Manner of adoption
Parsec Sight/Sound, Inc.	Adopted by the directors and shareholders pursuant to 15 Pa.C.S. § 1924(a)

01-30-2002

Form PTO-1595 R
(Rev. 03/01)
OMB NO. 0651-0027 (exp. 5/31/2002)
Tab settings ⇒ ⇒ ⇒ 0 0

101964848

U.S. DEPARTMENT OF COMMERCE
U.S. Patent and Trademark Office

0 0

To the Honorable Commissioner of Patents and Trademarks: Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):

SightSound Technologies, Inc.

10-24-01

Additional name(s) of conveying party(ies) attached? ☐ Yes ☑ No

3. Nature of conveyance:

☐ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name
☑ Other Notice of Grant of Security Interest

Execution Date: October 1, 2001

2. Name and address of receiving party(ies)

Name: Kenyon & Kenyon

Internal Address:

Street Address: One Broadway

City: New York State: N.Y.. Zip: 10004

Additional name(s) & address(es) attached? ☑ Yes ☐ No

4. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application is:

A. Patent Application No.(s) 09/286,892
09/469,802 09/256,432 09/706,048
09/710,380

B. Patent No.(s) 5,191,573 5,675,734
5,966,440 6,014,491

Additional numbers attached? ☐ Yes ☑ No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: Deborah Hartnett, Esq.
Internal Address: Paul, Weiss, Rifkind, Wharton & Garrison

Street Address: 1285 Avenue of the Americas

City: New York State: NY Zip: 10019

6. Total number of applications and patents involved: 9

7. Total fee (37 CFR 3.41) $ 360.00

☑ Enclosed
☐ Authorized to be charged to deposit account

8. Deposit account number:

(Attach duplicate copy of this page if paying by deposit account)

DO NOT USE THIS SPACE

9. Statement and signature

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Minter Krotzer
Name of Person Signing

Signature

10/24/01
Date

Total number of pages including cover sheet, attachments, and documents: 6

Mail documents to be recorded with required cover sheet information to:
Commissioner of Patents & Trademarks, Box Assignments
Washington, D.C. 20231

Doc#: NY6: 61198.1

Additional Receiving Parties

1. Ansel M. Schwartz
One Sterling Plaza
201 N. Craig Street, Suite 304
Pittsburgh, PA 15213

2. Waterview Partners, LLP
152 West 57th Street, 46th Floor
New York, NY 10019

3. D&DF Waterview Partners, L.P.
152 West 57th Street, 46th Floor
New York, NY 10019

Notice of Grant of Security Interest in Patents

NOTICE OF GRANT OF SECURITY INTEREST IN PATENTS (the "Notice"), dated as of October 1, 2001, made by SIGHTSOUND TECHNOLOGIES, INC., a Delaware corporation ("Pledgor"), in favor of KENYON & KENYON ("KK"), Ansel M. Schwartz ("Schwartz"), Waterview Partners, LLP ("WPL") and D&DF Waterview Partners, L.P. ("DWPL"), (each, a "Secured Parties" and collectively, the "Secured Parties").

WHEREAS, Pledgor is the owner of certain patents and patent applications as set forth in Schedule 1 attached hereto (collectively, the "Patents"); and

WHEREAS, pursuant to the Security Agreement, dated as of the date hereof, between Pledgor and Secured Parties (the "Security Agreement"), Pledgor granted to Secured Parties a security interest in, and lien on, certain intellectual property of Pledgor, including (a) all letters patent of the United States or any other country and all reissues and extensions thereof, including, without limitation, the Patents, and the inventions and improvements described and claimed therein, if any, and patentable inventions, (b) the reissues, divisions, continuations, renewals, extensions, reexaminations and continuations-in-part of any of the foregoing, (c) all applications for any of the foregoing in the United States or any other country and (d) all agreements, whether written or oral, providing for the grant by or to Pledgor of any right to manufacture, use or sell any invention covered by a Patent, including, without limitation, any thereof referred to in Schedule 1 ("Patent Licenses"), in each case, now owned or hereafter acquired or in which Pledgor now has or at any time in the future may acquire any right, title or interest (collectively, the "Patent Collateral").

WHEREAS, pursuant to the Security Agreement, Pledgor agreed to execute and deliver to Secured Parties this Notice for purposes of filing the same with the United States Patent and Trademark Office (the "PTO") to confirm, evidence and perfect the security interest in the Patent Collateral granted pursuant to the Security Agreement;

NOW, THEREFORE, for good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, and subject to the terms and conditions of the Security Agreement (as the same may be from time to time amended, restated or supplemented), the terms of which are incorporated by reference herein, Pledgor hereby grants to Secured Parties a security interest in, and lien, on the Patent Collateral.

Pledgor hereby acknowledges the sufficiency and completeness of this Notice to create the security interest in the Patent Collateral and to grant the same to Secured Parties, and Pledgor hereby requests the PTO to file and record the same together with the annexed Schedule 1.

Pledgor and Secured Parties hereby acknowledge and agree that the security interest in the Patent Collateral may only be terminated, and Secured Parties

rights as secured parties may only be exercised, in accordance with the terms of the Security Agreement.

IN WITNESS WHEREOF, the undersigned has caused this Notice to be duly executed and delivered as of the date first above written.

SIGHTSOUND TECHNOLOGIES, INC.

By: _____
Name: SCOTT C. SANDER
Title: PRESIDENT & CEO

Doc#: NY6: 44648.1

STATE OF Pennsylvania
: ss.:
COUNTY OF Allegheny)

On the 15 day of October, 2001, before me the undersigned, personally appeared Scott C. Sander, personally known to me or proved to me on the basis of satisfactory evidence to be the individual whose name is subscribed to the within instrument and acknowledged to me that he executed the same in his capacity, and that by his signature on the instrument, the individual, or the person upon behalf of which the individual acted, executed the instrument.

Eleanor A Carpenter
Notary Public

Notarial Seal
Eleanor A. Carpenter, Notary Public
Mt. Lebanon Twp., Allegheny County
My Commission Expires May 2, 2005
Member, Pennsylvania Association of Notaries

Doc#: NY6: 44648.1

Schedule 1

Patents

A. Issued Patents

Description	Patent No.
Title: Method for Transmitting a Desired Digital Video or Audio Signal	5,191,573
Title: System for Transmitting Desired Digital Video or Audio Signals	5,675,734
Title: System and Method for Transmitting Desired Digital Video or Audio Signals	5,966,440
Title: Method and System for Manipulation of Audio or Video Signals	6,014,491

B. Patent Applications

Patent No.	Application No.
	09/286,892
	09/469,802
	09/256,432
	09/706,048
	09/710,380

Patent Licenses

There was a license with Henry R. Moore, an individual doing business as Moore Multimedia Publishing, dated March 25, 1999. Under the terms of the license, it has expired. However, Mr. Moore and SightSound have expressed an interest in renewing the license.

Doc Code:

70053 U.S.PTO

PTO/SB/82 (04-05)
Approved for use through 11/30/2005. OMB 0651-0035
Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control

12/27/05

REVOCATION OF POWER OF ATTORNEY WITH NEW POWER OF ATTORNEY AND CHANGE OF CORRESPONDENCE ADDRESS

Application Number	5,191,573 90/007402
Filing Date	03/02/1993
First Named Inventor	Arthur R. Hair
Art Unit	2132
Examiner Name	Benjamin E. Lanier
Attorney Docket Number	47274-219099-1

I hereby revoke all previous powers of attorney given in the above-identified application:

☐ A Power of Attorney is submitted herewith.

OR

☑ I hereby appoint the practitioners associated with the Customer Number: 23973

☑ Please change the correspondence address for the above-identified application to:

☑ The address associated with Customer Number: 23973

OR

☑ Firm *or* Individual Name	Robert A. Koons, Jr.				
Address	Drinker Biddle & Reath LLP One Logan Square 18th & Cherry Streets				
City	Philadelphia	State	PA	ZIP	19103-6996
Country	United States of America				
Telephone	(215) 988-3392	Email	robert.koons@dbr.com		

I am the:

☐ Applicant/Inventor.

☑ Assignee of record of the entire interest. See 37 CFR 3.71
Statement under 37CFR 3.73(b) is enclosed. (Form PTO/SB/96)

SIGNATURE of Applicant or Assignee of Record

Signature			
Name	Kenneth Glick, Assistant Secretary DMT Licensing, LLC		
Date	12/22/2005	Telephone	609-734-9562

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 37 CFR 1.36. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending on the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Doc Code:

PTO/SB/96 (09-04)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
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STATEMENT UNDER 37 CFR 3.73(b)

Applicant/Patent Owner: **DMT Licensing, LLC**

Application No./Patent No.: **5,191,573** Filed/Issue Date: **03/02/1993**

Entitled: **Method for Transmitting a Desired Digital Video or Audio Signal**

DMT Licensing, LLC , a **Delaware Limited Liability Company**

(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

states that it is:

1. [☑] the assignee of the entire right, title, and interest; or

2. [ ] an assignee of less than the entire right, title and interest.
The extent (by percentage) of its ownership interest is _____ %

in the patent application/patent identified above by virtue of either:

A. [☑] An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel _____ , Frame _____ , or for which a copy thereof is attached.

OR

B. [ ] A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as shown below:

1. From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at
Reel _____ , Frame _____ , or for which a copy thereof is attached.

2. From: _____ To: _____
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3. From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at
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[ ] Additional documents in the chain of title are listed on a supplemental sheet.

[☑] Copies of assignments or other documents in the chain of title are attached.
[NOTE: A separate copy (*i.e.*, a true copy of the original assignment document (s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, if the assignment is to be recorded in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

Signature	12/22/2005 Date
Kenneth Glick Printed or Typed Name	609-734-9562 Telephone number
Assistant Secretary, DMT Licensing, LLC Title	

This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETE D FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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P.O. Box 1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,402	01/31/2005	5191573	NAPS001	2998

7590 01/19/2006

EXAMINER	

Ansel M. Schwartz
425 N. Craig Street Suite 301
Pittsburgh, PA 15213

ART UNIT	PAPER NUMBER

DATE MAILED: 01/19/2006

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Albert S. Penilla
MARTINE PENILLA & GENCARELLA, LLP
710 Lakeway Drive, Suite 200
Sunnyvale, CA 94085

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/007,402*.

PATENT NO. *5191573*.

ART UNIT *2132*.

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)).

PTOL-465 (Rev.07-04)

Notice Of Defective Paper In Ex Parte Reexamination	Control Number	Patent Under Reexamination	
	90/007,402	5191573	
	Examiner	Art Unit	
	Benjamin E. Lanier	2132	

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

1. ☐ Since no proof of service was included with the paper filed on _____ , it fails to comply with 37 CFR 1.248 and 1.540. Proof of service is required within ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this letter, whichever is longer. Failure to provide proof of service may result in a refusal to consider the paper. If the failure to comply with this requirement results in a patent owner failure 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 prosecution of the reexamination proceeding will be terminated under 37 CFR 1.550(d).

2. ☐ The paper filed on _____ is unsigned. A duplicate paper or ratification, properly signed, is required within ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this letter, whichever is longer. Failure to comply with this requirement will result in the paper not being considered. If the failure to comply results in a patent owner failure 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 prosecution of the reexamination proceeding will be terminated under 37 CFR 1.550(d).

3. ☐ The paper filed on _____ is signed by _____ , who is not of record. A duplicate paper or ratification signed by a person of record, a person made of record by way of a new power of attorney, is required within ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this letter, whichever is longer. Failure to comply with this requirement will result in the paper not being considered. If the failure to comply results in a patent owner failure to file a timely and appropriate response to any Office action or any written statement of an interview required under § 1.560(b), the prosecution of the reexamination proceeding will be terminated under 37 CFR 1.550(d).

4. ☒ The Amendment filed on *27 December 2005* does not comply with 37 CFR 1.530(d)-(j). Patent owner is given ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this letter, whichever is longer to correct this informality; otherwise, the prosecution of the the reexamination proceeding will be terminated under (37 CFR 1.550(d)).

5. ☐ The amendment filed by patent owner on _____, does not comply with 37 CFR ☐1.20(c)(3) and/or ☐1.20(c)(4), as to excess claim fees. Patent owner is given a time period of ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this letter, whichever is longer, to correct this fee deficiency, or the prosecution of the reexamination proceeding will be terminated under 37 CFR 1.550(d), to effect the "abandonment" set forth in 37 CFR 1.20(c)(5).

6. ☐ Other :

Gilberto Barron Jr

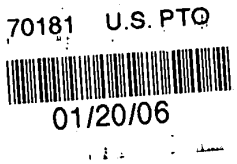
GILBERTO BARRON JR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

NOTE: EXTENSION OF TIME ARE GOVERNED BY 37 CFR 1.550(c). If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.

cc: Requester (if third party requester)

CERTIFICATE UNDER 37 C.F.R. 1.10

In Re: Arthur R. Hair



Docket No.: 219099/573
Patent No.: 5,191,573
Re-Examination Control No.: 90/007,402
Re-Examination Filing Date: January 31, 2005
Examiner: Benjamin E. Lanier

EXPRESS MAIL: EV 299886460 US

DATE OF DEPOSIT: January 20, 2006

I hereby certify that the following correspondence

Letter notifying Office of real party interest, and
Return receipt postcard

are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Mail Stop Ex Parte Re-Examination, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.

Jane D. Roberts
(Typed or printed name of person mailing paper)

Jane D. Roberts
(Signature of person mailing paper or fee)

Drinker Biddle & Reath LLP
One Logan Square
18th and Cherry Streets
Philadelphia, PA 19103-6996

Customer No. 23973

PHIP\449843\1

EV299886460US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)
	)
ARTHUR R. HAIR	)
	)
Reexamination Control No.: 90/007,402	)
	)
Reexamination Filed: January 31, 2005	) METHOD FOR
	) TRANSMITTING A DESIRED
Patent Number: 5,191,573	) DIGITAL VIDEO OR AUDIO
	) SIGNAL
Examiner: Benjamin E. Lanier	)

Mail Stop Ex parte Reexamination
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In compliance with the duty of candor and good faith to the Office, Applicant wishes to notify the Office of the recent assignment of the subject Patent No. 5,191,573, in Reexamination Control Number 90/007,402 to DMT Licensing, LLC, whose owner, and therefore the real party in interest is the General Electric Company. Further, Applicant wishes to notify the Office that DMT Licensing, LLC and the real party in interest, the General Electric Company, have also received by assignment the ownership of U.S. Patent Nos. 5,675,734 and 5,966,440, which are currently the subject of Reexamination Control Nos. 90/007,403; and 90/007,407 respectively, and Patent Application Control No. 09/286,892.

Respectfully submitted

DRINKER, BIDDLE & REATH LLP

Robert A. Koons, Jr.
Reg. No. 32,474
Attorney for Patentee

DRINKER, BIDDLE & REATH LLP
One Logan Square
18th and Cherry Streets
Philadelphia, PA 19103

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing document was served via First Class United States Mail, postage prepaid, this 20th day of January, 2006, on the following:

Mr. Albert S. Penilla
Martine, Penilla, & Gencarella, LLP
710 Lakeway Drive, Suite 200
Sunnyvale, CA 94085
Attorney for Third Party Reexamination Requester

By: _____
Robert A. Koons, Jr.
Attorney for Patentee

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United States Patent and Trademark Office
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APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
90/007,402	01/31/2005	5191573	NAPS001

CONFIRMATION NO. 2998

OC000000017902165

23973
DRINKER BIDDLE & REATH
ATTN: INTELLECTUAL PROPERTY GROUP
ONE LOGAN SQUARE
18TH AND CHERRY STREETS
PHILADELPHIA, PA 19103-6996

Date Mailed: 01/24/2006

NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 12/27/2005.

The Power of Attorney in this application is accepted. Correspondence in this application will be mailed to the above address as provided by 37 CFR 1.33.

Michelle R. Eason

MICHELLE R EASON
3921 (571) 272-4231

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APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
90/007,402	01/31/2005	5191573	NAPS001

CONFIRMATION NO. 2998

OC000000017902147

Ansel M. Schwartz
425 N. Craig Street Suite 301
Pittsburgh, PA 15213

Date Mailed: 01/24/2006

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 12/27/2005.

- The Power of Attorney to you in this application has been revoked by the assignee who has intervened as provided by 37 CFR 3.71. Future correspondence will be mailed to the new address of record(37 CFR 1.33).

Michelle R. Eason

MICHELLE R EASON
3921 (571) 272-4231

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,402	01/31/2005	5191573	NAPS001	2998

23973 7590 01/27/2006

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18TH AND CHERRY STREETS
PHILADELPHIA, PA 19103-6996

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 01/27/2006

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Albert S. Penilla
MARTINE PENILLA & GENCARELLA, LLP
710 Lakeway Drive, Suite 200
Sunnyvale, CA 94085

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/007,402*.

PATENT NO. *5191573*.

ART UNIT *2132*.

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)).

Notice Of Defective Paper In Ex Parte Reexamination	Control Number	Patent Under Reexamination	
	90/007,402	5191573	
	Examiner	Art Unit	
	Benjamin E. Lanier	2132	

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1. ☐ Since no proof of service was included with the paper filed on _____ , it fails to comply with 37 CFR 1.248 and 1.540. Proof of service is required within ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this letter, whichever is longer. Failure to provide proof of service may result in a refusal to consider the paper. If the failure to comply with this requirement results in a patent owner failure 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 prosecution of the reexamination proceeding will be terminated under 37 CFR 1.550(d).

2. ☐ The paper filed on _____ is unsigned. A duplicate paper or ratification, properly signed, is required within ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this letter, whichever is longer. Failure to comply with this requirement will result in the paper not being considered. If the failure to comply results in a patent owner failure 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 prosecution of the reexamination proceeding will be terminated under 37 CFR 1.550(d).

3. ☐ The paper filed on _____ is signed by _____ , who is not of record. A duplicate paper or ratification signed by a person of record, a person made of record by way of a new power of attorney, is required within ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this letter, whichever is longer. Failure to comply with this requirement will result in the paper not being considered. If the failure to comply results in a patent owner failure to file a timely and appropriate response to any Office action or any written statement of an interview required under § 1.560(b), the prosecution of the reexamination proceeding will be terminated under 37 CFR 1.550(d).

4. ☒ The Amendment filed on *27 December 2005* does not comply with 37 CFR 1.530(d)-(j). Patent owner is given ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this letter, whichever is longer to correct this informality; otherwise, the prosecution of the the reexamination proceeding will be terminated under (37 CFR 1.550(d)).

5. ☐ The amendment filed by patent owner on _____, does not comply with 37 CFR ☐1.20(c)(3) and/or ☐1.20(c)(4), as to excess claim fees. Patent owner is given a time period of ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this letter, whichever is longer, to correct this fee deficiency, or the prosecution of the reexamination proceeding will be terminated under 37 CFR 1.550(d), to effect the "abandonment" set forth in 37 CFR 1.20(c)(5).

6. ☐ Other :

GILBERTO BARRON JR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

NOTE: EXTENSION OF TIME ARE GOVERNED BY 37 CFR 1.550(c). If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.

cc: Requester (if third party requester)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	70181 U.S. PTO
ARTHUR R. HAIR	)	
	)	02/06/06
Reexamination Control No. 90/007,402	)	
	)	
Reexamination Filed: January 31, 2005	)	METHOD FOR TRANSMITTING
	)	A DESIRED DIGITAL VIDEO OR
Patent Number: 5,191,573	)	AUDIO SIGNAL
	)	
Examiner: Benjamin E. Lanier		

Mail Stop *Ex Parte* Reexamination
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO NOTICE OF DEFECTIVE PAPER
IN EX PARTE REEXAMINATION

Sir:

In response to the Notice of Defective Paper in *Ex Parte* Reexamination mailed January 27, 2006, Applicant respectfully submits herewith a corrected Response under 37 C.F.R. § 1.530 in *Ex Parte* Reexamination.

1. Pursuant to 37 C.F.R. § 1.530(d)(2), Applicant has listed the entire text of all claims proposed to be changed or added by the instant amendment. Applicant respectfully points out that the instant amendment only proposes to add claims 7 to 43. No changes to existing claims 1 to 6 are proposed in the instant amendment.

2. Pursuant to 37 C.F.R. § 1.530(e), Applicant has provided on a separate sheet from the amendments a listing of the status of each claim in the reexamination as of the date of the instant amendment, as either pending or canceled.

3. Pursuant to 37 C.F.R. § 1.530(f)(2), Applicant has underlined the new text of the claims being added by amendment.

4. Pursuant to 37 C.F.R. § 1.530(g), Applicant has preserved the numbering of the claims in the instant amendment.

5. The terms used in the newly added claims correspond to terms appearing in the specification of U.S. Patent Serial Number 5,191,573 as issued. Applicant therefore believes that no amendment of the disclosure pursuant to 37 C.F.R. § 1.530(h) is necessary.

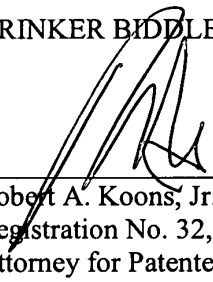
6. Pursuant to 37 C.F.R. § 1.530(i), all amendments have been made relative to the patent specification, including claims and drawings in effect as of the date of filing the request for reexamination.

7. Pursuant to 37 C.F.R. § 1.530(j), the scope of the claims has not been enlarged by the instant amendments, as noted at page 13 of the response.

Applicant respectfully submits that the amended response filed herewith complies with all of the requirements of 37 C.F.R. § 1.530(d)-(j). If the Office believes that any portion of the response does not comply with the requirements of 37 C.F.R. § 1.530(d)-(j), the Office is hereby requested to contact the Applicant's undersigned attorney directly.

Respectfully submitted,

DRINKER BIDDLE & REATH LLP



Robert A. Koons, Jr.
Registration No. 32,474
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DRINKER BIDDLE & REATH LLP
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18th & Cherry Streets
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Telephone: (215) 988-3392
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Customer No. 023973

February 6, 2006

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing document was served via First Class United States Mail, postage prepaid, this 6th day of February, 2006, on the following:

Mr. Albert S. Penilla
Martine, Penilla, & Gencarella, LLP
710 Lakeway Drive, Suite 200
Sunnyvale, CA 94085
Attorney for Third Party Reexamination Requester

By: _____
Robert A. Koons, Jr.
Attorney for Patentee

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	
ARTHUR R. HAIR	)	
	)	
Reexamination Control No. 90/007,402	)	
	)	
Reexamination Filed: January 31, 2005	)	METHOD FOR TRANSMITTING
	)	A DESIRED DIGITAL VIDEO OR
Patent Number: 5,191,573	)	AUDIO SIGNAL
	)	
Examiner: Benjamin E. Lanier		

Mail Stop *Ex Parte* Reexamination
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE

In response to the Office Action for the above-identified reexamination dated October 26, 2005, please enter the following amendments and remarks.

Amendments to the Claims begin on page **2** of this paper.

Remarks begin on page **13** of this paper.

Claim Amendments

Please add new Claims 7 to 43 as follows:

7. (New) A method for transmitting a desired digital audio signal stored on a first memory of a first party to a second memory of a second party comprising the steps of:

transferring money electronically via a telecommunications line to the first party at a location remote from the second memory and controlling use of the first memory from the second party financially distinct from the first party, said second party controlling use and in possession of the second memory;

connecting electronically via a telecommunications line the first memory with the second memory such that the desired digital audio signal can pass therebetween;

transmitting the desired digital audio signal from the first memory with a transmitter in control and possession of the first party to a receiver having the second memory at a location determined by the second party, said receiver in possession and control of the second party;

storing the digital audio signal in the second memory; and

listing/scrolling digital audio signals from the second memory.

8. (New) A method as described in Claim 7 wherein the transferring step comprises the steps of telephoning the first party controlling use of the first memory by the second party; providing a credit card number of the second party controlling the second memory to the first party controlling the first memory so the second party is charged money.

9. (New) A method as described in Claim 7 further comprising the step of displaying a name of a digital audio signal from the second memory.

10. (New) A method as described in Claim 7 further comprising the step of displaying a duration of the digital audio signal from the second memory.

11. (New) A method as described in Claim 7 further comprising the step of displaying a name of an artist of the digital audio signal from the second memory.

12. (New) A method as described in Claim 7 further comprising the step of displaying a name of an album associated with the digital audio signal from the second memory.

13. (New) A method as described in Claim 7 further comprising the step of randomly selecting digital audio signals from the second memory by a second party integrated circuit of a second party control unit.

14. (New) A method for transmitting a desired digital video signal stored on a first memory of a first party to a second memory of a second party comprising the steps of:

transferring money electronically via a telecommunications line to the first party location remote from the second memory and controlling use of the first memory, from a second party financially distinct from the first party, said second party in control and in possession of the second memory;

connecting electronically via a telecommunications line the first memory with the second memory such that the desired digital video signal can pass therebetween;

transmitting the desired digital video signal from the first memory with a transmitter in control and possession of the first party to a receiver having the second memory at a location determined by the second party, said receiver in possession and control of the second party;

storing the digital signal in the second memory; and

listing/scrolling digital video signals from the second memory.

15. (New) A method as described in Claim 14 wherein the transferring step comprises the steps of telephoning the first party controlling use of the first memory by the second party controlling the second memory; providing a credit card number of the second party controlling the second memory to the first party controlling the first memory so the second party controlling the second memory is charged money.

16. (New) A method as described in Claim 14 further comprising the step of displaying a name of a digital video signal from the second memory.

17. (New) A method as described in Claim 14 further comprising the step of listing/scrolling queued digital video signals stored in the second memory.

18. (New) A method as described in Claim 14 further comprising the step of displaying a duration of the digital video signal from the second memory.

19. (New) A method as described in Claim 14 further comprising the step of displaying a name of an artist of the digital video signal from the second memory.

20. (New) A method as described in Claim 14 further comprising the step of displaying a name of an album associated with the digital video signal from the second memory.

21. (New) A method as described in Claim 14 further comprising the step of randomly selecting digital video signals from the second memory by a second party integrated circuit of a second party control unit.

22. (New) A method for transmitting a desired digital audio signal stored on a first memory of a first party to a second memory of a second party comprising the steps of:

transferring money electronically via a telecommunications line to the first party at a location remote from the second memory and controlling use of the first memory from the second party financially distinct from the first party, said second party controlling use and in possession of the second memory;

connecting electronically via a telecommunications line the first memory with the second memory such that the desired digital audio signal can pass therebetween;

transmitting the desired digital audio signal from the first memory with a transmitter in control and possession of the first party to a receiver having the second memory at a location determined by the second party, said receiver in possession and control of the second party;

storing the digital audio signal in the second memory; and

randomly selecting digital audio signals from the second memory by a second party integrated circuit of a second party control unit.

23. (New) A method as described in Claim 22 wherein the transferring step further comprises the step of providing a credit card number of the second party controlling the second memory to the first party controlling the first memory so the second party is charged money.

24. (New) A method as described in Claim 22 further comprising the step of listing/scrolling queued digital audio signals stored in the second memory.

25. (New) A method as described in Claim 22 further comprising the step of displaying a name of a digital audio signal from the second memory.

26. (New) A method for transmitting a desired digital audio signal stored on a first memory of a first party to a second memory of a second party comprising the steps of:

transferring money electronically via a telecommunications line to the first party at a location remote from the second memory and controlling use of the first memory from the second party financially distinct from the first party, said second party controlling use and in possession of the second memory;

connecting electronically via a telecommunications line the first memory with the second memory such that the desired digital audio signal can pass therebetween;

transmitting the desired digital audio signal from the first memory with a transmitter in control and possession of the first party to a receiver having the second memory at a location determined by the second party, said receiver in possession and control of the second party;

storing the digital audio signal in the second memory; and

displaying a name of an artist of the digital audio signal from the second memory.

27. (New) A method as described in Claim 26 wherein the transferring step further comprises the step of providing a credit card number of the second party controlling the second memory to the first party controlling the first memory so the second party is charged money.

28. (New) A method as described in Claim 26 further comprising the step of listing/scrolling queued digital audio signals stored in the second memory.

29. (New) A method for transmitting a desired digital audio signal stored on a first memory of a first party to a second memory of a second party comprising the steps of:

transferring money electronically via a telecommunications line to the first party at a location remote from the second memory and controlling use of the first memory from the second party financially distinct from the first party, said second party controlling use and in possession of the second memory;

connecting electronically via a telecommunications line the first memory with the second memory such that the desired digital audio signal can pass therebetween;

transmitting the desired digital audio signal from the first memory with a transmitter in control and possession of the first party to a receiver having the second memory at a location determined by the second party, said receiver in possession and control of the second party;

storing the digital audio signal in the second memory; and

displaying a duration of the digital audio signal from the second memory.

30. (New) A method as described in Claim 29 wherein the transferring step further comprises the step of providing a credit card number of the second party controlling the second memory to the first party controlling the first memory so the second party is charged money.

31. (New) A method as described in Claim 29 including the step of listing/scrolling queued digital audio signals stored in the second memory.

32. (New) A method as described in Claim 29 including the step of displaying a name of a digital audio signal from the second memory.

33. (New) A method for transmitting a desired digital video signal stored on a first memory of a first party to a second memory of a second party comprising the steps of:

transferring money electronically via a telecommunications line to the first party at a location remote from the second memory and controlling use of the first memory from the

second party financially distinct from the first party, said second party controlling use and in possession of the second memory;

connecting electronically via a telecommunications line the first memory with the second memory such that the desired digital video signal can pass therebetween;

transmitting the desired digital video signal from the first memory with a transmitter in control and possession of the first party to a receiver having the second memory at a location determined by the second party, said receiver in possession and control of the second party;

storing the digital video signal in the second memory; and

randomly selecting digital video signals from the second memory by a second party integrated circuit of a second party control unit.

34. (New) A method as described in Claim 33 wherein the transferring step further comprises the step of providing a credit card number of the second party controlling the second memory to the first party controlling the first memory so the second party is charged money.

35. (New) A method as described in Claim 33 further comprising the step of listing/scrolling queued digital video signals stored in the second memory.

36. (New) A method as described in Claim 33 including the step of displaying a name of a digital video signal from the second memory.

37. (New) A method for transmitting a desired digital video signal stored on a first memory of a first party to a second memory of a second party comprising the steps of:

transferring money electronically via a telecommunications line to the first party at a location remote from the second memory and controlling use of the first memory from the second party financially distinct from the first party, said second party controlling use and in possession of the second memory;

connecting electronically via a telecommunications line the first memory with the second memory such that the desired digital video signal can pass therebetween;

transmitting the desired digital video signal from the first memory with a transmitter in control and possession of the first party to a receiver having the second memory at a location determined by the second party, said receiver in possession and control of the second party;

storing the digital video signal in the second memory; and

displaying a name of an artist of the digital video signal from the second memory.

38. (New) A method as described in Claim 37 wherein the transferring step further comprises the step of providing a credit card number of the second party controlling the second memory to the first party controlling the first memory so the second party is charged money.

39. (New) A method as described in Claim 37 including the step of listing/scrolling queued digital video signals stored in the second memory.

40. (New) A method for transmitting a desired digital video signal stored on a first memory of a first party to a second memory of a second party comprising the steps of:

transferring money electronically via a telecommunications line to the first party at a location remote from the second memory and controlling use of the first memory from the second party financially distinct from the first party, said second party controlling use and in possession of the second memory;

connecting electronically via a telecommunications line the first memory with the second memory such that the desired digital video signal can pass therebetween;

transmitting the desired digital video signal from the first memory with a transmitter in control and possession of the first party to a receiver having the second memory at a location determined by the second party, said receiver in possession and control of the second party;

storing the digital video signal in the second memory; and

displaying a duration of the digital video signal from the second memory.

41. (New) A method as described in Claim 40 wherein the transferring step further comprises the step of providing a credit card number of the second party controlling the second memory to the first party controlling the first memory so the second party is charged money.

42. (New) A method as described in Claim 40 further comprising the step of listing/scrolling queued digital video signals stored in the second memory.

43. (New) A method as described in Claim 40 further comprising the step of displaying a name of a digital video signal from the second memory.

REMARKS

Status of the Claims

Claims 1-43 are currently pending[1].

Amendments to the Claims

There have been no amendments to the previously pending claims, Claims 1 through 6, with this response. Claims 7-43 have been added. The newly added claims are fully supported by the specification. Support for new Claims 7-43 can be found in column 5, lines 5-25 of U.S. Patent 5,191,573 Patent as issued.

In addition, all newly added claims contain at least the same limitations as set forth in pending Claims 1 and 4. As a result, all of the newly added claims are presumed to be allowable for at least the same reasons as set forth below with respect to pending independent Claims 1 and 4. Further, Applicant respectfully submits that because the newly presented claims place additional limitations on existing claim elements, the scope of the claims has not been enlarged.

Rejections Under 35 U.S.C. § 103(a)

The Examiner has cited the combination of Akashi and Freeny in an effort to make out a *prima facie* case of obviousness of Claims 1-6 under 35 U.S.C. § 103(a). Applicant respectfully submits that the combination of Akashi and Freeny is inadequate to make out a *prima facie* case of obviousness of Claims 1-6.

[1] In considering these claims, Applicant wishes to direct the Examiner's attention to the reference identified as Number 849 in the Information Disclosure Statement filed July 21,2005, which may not have been considered by the Examiner in the pending Office Action. Applicant does not believe this reference constitutes prior art that anticipates or renders obvious any of the original or newly added claims. Nonetheless, in view of the large number of references disclosed, Applicant wants to ensure that the

Comments On Examiner's Response To Arguments

In the Office Action dated October 26, 2005, the Examiner states in his *Response to Arguments* that the "District Court decision was an analysis of Freeny as a Section 102 reference and not as a secondary reference." Applicant respectfully disagrees with this characterization of the District Court's opinion. Applicant maintains that a thorough review of the Opinion and Order of Court dated October 23, 2003 (the "Opinion") in the Sightsound v. N2K et al. litigation demonstrates that the District Court analyzed Freeny as a Section 103 reference. Applicant respectfully directs the Examiner to section 2 of the Opinion and Order beginning on page 45, titled "*Defendants' Examples of Prior Art giving Rise to Obviousness*" (emphasis added), attached hereto as Exhibit A. The District Court Judge goes on to analyze the Section 103 references cited by the defendants, including specifically "The Freeny Patent" at page 52 of the Opinion. Accordingly, Applicant respectfully disagrees with the Examiner's position that Freeny was not analyzed as a secondary reference in an obviousness context. Moreover, Applicant submits that, not only did the District Court consider Freeny as a secondary reference, but the Court also reasoned that Freeny *teaches away* from Applicant's claimed invention. See Opinion, page 52-53.

Applicant also respectfully points out that the District Court specifically considered the Examiner's primary reference, Akashi, in regard to obviousness in its Opinion. See Opinion, page 50. Although not binding on the Examiner in this proceeding, Applicant respectfully submits that a reasoned analysis by a competent Court should be regarded by the Examiner as strongly persuasive against the suggested combination of Freeny with Akashi and other references in the present Section 103(a) rejections.

Examiner has considered this reference.

A Prima Facie Case Of Obviousness Under 35 U.S.C. § 103(a) Over The Cited References Has Not Been Established In The Instant Office Action

MPEP 2144 explicitly requires the presentation of a rationale found "expressly or impliedly in the prior art or drawn from a convincing line of reasoning based on established scientific principles or legal precedent" in order to combine references under Section 103. Further, MPEP 2142 states that, "[t]o reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made." These dual requirements ensure that an examiner does not fall into the trap of using hindsight based on his own knowledge of the Applicant's disclosure to reconstruct the claimed invention from the prior art.

To avoid such hindsight reconstruction, the CAFC requires "a rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re Beasley* 117 Fed.Appx. 739, 742 (Fed. Cir. 2004). "This is consonant with the obligation of the Board [of Patent Appeals and Interferences] to develop an evidentiary basis for its factual findings to allow for judicial review under the substantial evidence standard that is both deferential and meaningful." *Id.* at 742-43. Neither an examiner nor the Board is entitled rely only on their own knowledge as skilled artisans. *Id.* at 743.

Applicant respectfully submits that, even assuming each and every element of Claims 1-6 has been located in the combination of Akashi and Freeny, there nonetheless has been no showing that one having ordinary skill in the art at the time of Applicant's invention, over 17 years ago, would have found the requisite motivation and reasonable expectation of success in

combining these references.[2] Because a rigorous showing of teaching or motivation to combine the cited references has not been provided as required by the CAFC, a *prima facie* case of obviousness has not been established.

Applicant will demonstrate that the cited combination of references does not establish a *prima facie* case of obviousness.

Akashi discloses an automated sales system for music on record albums. Akashi teaches a recording reproducing apparatus with a built-in computer communication means which is connected by a telephone line to a host computer storing data representing music on record albums or similar information such as the composers, list of music stores, musicians and the like. The data representing music on record albums is sent from the aforesaid host computer to the recording reproducing apparatus when the host computer is accessed by the aforesaid recording reproducing apparatus. See Akashi para. 4. The recording reproducing apparatus may be either a digital audio tape recorder or a compact disk deck that employs a write-once, read-many times recordable optical disk that allows data to be read immediately after the data is written. See Akashi para. 6.

As recognized by the Examiner, Akashi discloses no means or method whatsoever of effecting payment. As also recognized by the Examiner, Akashi does not teach or suggest a hard disk used by the purchaser to store the data.

Further, as set forth in the Declaration of Kenneth Pohlmann, attached as Exhibit B, Akashi does not teach any playback capability. Akashi is a simple inexpensive digital audio tape recorder or compact disk device that has the ability to communicate with a host computer to

[2] The '573 Patent has a priority date of June 13, 1988. Thus, Applicant's invention was made at least as early as that date.

download music from the host computer onto an audio tape or an optical disk. It is submitted that once the music is stored on the tape or the optical disk, the tape or optical disk is then removed and carried away by the purchaser to be listened to on a completely distinct playback device separate and remote from the tape recorder or compact disk device. See Pohlmann Dec. para. 14.

The Examiner cites Freeny for the provision of video data and the element of making a payment by electronic means. Applicant submits that Freeny is non-analogous to, and plainly teaches away from, Akashi. Freeny discloses a material object offered for sale and purchasable at a point-of-sale location. As disclosed in Freeny, the information used to manufacture a material object is stored locally at the point of sale, such as a kiosk. Only the authorization to make a copy is obtained from a remote location by a communication link at the time of the sale. Freeny, col. 5, ln. 32 to col. 6, ln. 11. This is directly contrary to Akashi which teaches acquiring a recording from a remote location at the time of the sale. It is well established that, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are insufficient to render the claims *prima facie* obvious." *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Thus, on this basis alone, the teachings of Freeny cannot be combined with Akashi because Freeny teaches a system that operates in a fundamentally different way than Akashi.

Moreover, Applicant submits that the rationale provided for combining selected elements of Freeny with Akashi is inadequate to make out a *prima facie* case of obviousness. As held by the CAFC in *Beasley*, "***conclusory*** statements of generalized advantages and convenient ***assumptions*** about skilled artisans...are ***inadequate*** to support a finding of motivation, which is a factual question that cannot be resolved on subjective belief and unknown authority." *Id.* at

744. (emphasis added) In the first instance, Applicant respectfully submits that the motivation asserted by the Examiner in Freeny to modify Akashi for the sale of video information is precisely the type of conclusory and generalized statements of advantage that the CAFC has determined are inadequate to show obviousness. The portion of Freeny cited by the Examiner is notably from the Background section of the patent, which states, unsurprisingly, that manufacturing facilities and distribution systems are expensive. From this general statement in Freeny, the Examiner concludes it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Akashi to provide video in addition to audio information to take advantage of cost savings from eliminating manufacturing facilities and distribution systems. Applicant submits this is not the necessary motivation to combine that must be found in the prior art or knowledge of one of ordinary skill in the art, as required by *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). Applicant respectfully submits that, instead, this is the type of hindsight reconstruction, based on the Applicant's disclosure, that the CAFC has repeatedly held to be improper. See *Teleflex, Inc. v. KSR International Co.*, 119 Fed.Appx. 282, 285-86 (Fed. Cir. 2005) ("Combining prior art references without evidence of...a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.")

What has not been shown is some teaching in either Akashi or Freeny, or the knowledge generally available to one of ordinary skill in the art at the time of Applicant's invention, which would lead a person without knowledge of the claimed invention, to modify Akashi to provide video rather than audio information from a remote system via communication lines. Further, the

Examiner has provided no showing of the required reasonable expectation of success in thus modifying Akashi.

With respect to the teaching in Freeny of an electronic payment, the cited section of Freeny refers to a process whereby an authorization to manufacture a material object is received from a remote location. The information from which the material object is manufactured is stored locally at the point of sale. There is no suggestion in Freeny or Akashi that transmission of audio or video information from a remote location can be triggered by providing credit card account information at the point of sale. Again, no prior art or knowledge generally available to one of skill in the art has been pointed to that would lead a person of skill in the art at the time of Applicant's invention to that conclusion. Applicant therefore respectfully requests that Akashi and Freeny be withdrawn as references in the present case.

For the reasons set for the above regarding the improper combination of Akashi and Freeny, Applicant submits that a *prima facie* case of obviousness has not been established with respect to any of Claims 1-6. Rather, it appears that the references were surveyed to find individual elements that the Examiner believes correspond to the elements recited in the claims, without regard to demonstrating some rational line of reasoning as to why it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to combine the references' divergent teachings. Indeed, the Examiner has apparently overlooked teachings of the references that demonstrate their incompatibility with each other and thus militate *against* their combination.

Applicant respectfully submits this is precisely the type of hindsight reconstruction that the CAFC has proscribed. See *In re Fritch*; *Teleflex*, *supra*. To avoid hindsight reconstruction, Examiners are required to apply a rigorous "showing of the teaching or motivation to combine

prior art references." *In re Beasley*. Applicant does not believe the Examiner has met the foregoing burden in the current case. Applicant therefore respectfully requests reconsideration and withdrawal of the rejections of Claims 1-6 under 35 U.S.C. § 103(a).

Secondary Considerations Of Non-Obviousness

In the Office Action response filed on July 21, 2005, Applicant provided evidence of secondary considerations of non-obviousness, including evidence of commercial success of distribution systems employing the claimed invention. The Examiner has indicated that he did not find the secondary evidence provided by Applicant persuasive. In support of his conclusion, the Examiner stated that "Applicant has not provided proof that the claimed features were responsible for the commercial success of the mentioned distribution systems (i.e., ITunes)." See Office Action, para. 3. The Examiner cites to *Ex parte Remark*, 15 USPQ2d 1498, 1502 for the proposition that merely showing that there was commercial success of an article which embodied the invention is not sufficient to provide a secondary consideration of non-obviousness.[3]

In view of Applicant's arguments refuting the Examiner's rejection of Claims 1-6 under 35 U.S.C. § 103(a), presented above, Applicant respectfully submits that a showing of secondary considerations is not strictly necessary to establish the non-obviousness of Applicant's invention. However, further in view of the fact that such secondary considerations in fact do exist, Applicant feels compelled to at least set forth below a summary of such indicia.

[3] Additionally, the Examiner cites to certain comments the Examiner believes were made by the Inventor during an Examiner's Interview concerning the unavailability of content for sale via his invention. Applicant believes the Examiner misunderstood the comments made by the Inventor during the Interview and respectfully disagrees with the Examiner's recollection of those comments. Nonetheless, in view of the additional ample evidence of secondary indicia submitted with the current response, including the Declaration of Arthur R. Hair attached hereto as Exhibit C, Applicant believes it unnecessary to pursue this issue here.

The CAFC has explicitly set forth the factors, such as commercial success, long felt but unresolved needs, skepticism by experts, and copying by competitors that can be used to establish non-obviousness. *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F. 3d 1120, 1129 (Fed. Cir. 2000).

The CAFC has held that a nexus must be established between the merits of a claimed invention and the evidence of non-obviousness offered if that evidence is to be given substantial weight enroute to a conclusion of non-obviousness. *Remark* at 1502. The CAFC has also held, however, that copying of a patented feature or features of an invention, while other unpatented features are not copied, gives rise to an inference that there is a nexus between the patented feature and the commercial success. *Hughes Tool Company v. Dresser Industries, Inc.* 816 F.2d 1549, 1556 (Fed. Cir. 1987). Moreover, it is well established that copying of a patented invention, rather than one within the public domain, is by itself indicative of non-obviousness. See *Windsurfing International Inc., v. AMF, Inc.*, 782 F.2d 995, 1000 (Fed. Cir. 1986).

The Present Invention Has Been Copied By Others With Commercial Success

The invention recited in Claims 1-6 generally comprises transferring "for pay" digital video or digital audio signals between a first memory controlled by a seller and a second memory at a remote location controlled by a buyer over a telecommunication line. As set forth in the Declaration of Arthur R. Hair attached hereto as Exhibit C, the invention has in the past achieved significant commercial success.

Moreover, the invention continues to achieve commercial success in that it has been copied by a major participant in the field. The features of the invention generally included in Claims 1-6 have been copied by at least one commercially successful system available today: Napster Light. The Napster Light system ("Napster") for purchasing digital music files online at

www.napster.com is a commercially successful system that embodies the features of the claimed invention. Applicant's assertion that Napster is commercially successful and has copied the claimed invention is supported by the Declaration of Justin Douglas Tygar, Ph.D., is attached to this response as Exhibit D. Dr. Tygar is a professor at the University of California, Berkley with a joint appointment in the Department of Electrical Engineering and Computer Science and the School of Information Management and Systems. See Tygar Dec., para. 1. Dr. Tygar is an expert in the field of computer science with significant experience in the field of electronic commerce. See Tygar Dec., paras. 2-4.

Dr. Tygar has determined that Napster has achieved a level of commercial success. See Tygar Dec., para. 6. Further, Dr. Tygar compared Napster to the invention recited in Claims 1-6 and determined Napster copied the invention. Specifically, Dr. Tygar found that Napster operates a music download system incorporating servers having hard disks and memory, through which it sells digital music files to a buyer for download over the internet. See Tygar Dec., para. 10. The buyer using Napster has a computer at a home, office, or other location remote from Napster. See Tygar Dec., para. 11. The buyer forms a connection between his or her computer and Napster via the Internet, selects digital music file(s) he or she wishes to purchase, provides a credit card number, and receives the music file via a download process where the file is transferred from Napster's server to the buyer's computer and stored on the hard drive. The buyer can then play the file using his or her computer system. See Tygar Dec., paras. 12-16. In view of this comparison, Dr. Tygar properly concludes that Napster has copied the features taught by the present invention. See Tygar Dec., para. 19.

Additionally, Applicant respectfully points out that Napster *does not* copy the closest prior art cited by the Examiner, i.e., Freeny and Akashi. Freeny teaches a point-of-sale device

(e.g., a kiosk) that dispenses a material object (e.g., tape) containing the music purchased. See Freeny, col. 1, line 64 to col. 2, line 12. These features of Freeny are plainly not found in Napster Light. See Tygar Dec., para. 16. Akashi teaches writing data to a digital audio tape recorder or a compact disk deck that employs a write-once, read-many times recordable optical disk which allows data to be read immediately after the data is written. The user downloads data to a RAM and then the data is written directly from the RAM to a recordable optical disk. See Akashi para. 6. This process of Akashi is not how Napster Light operates. See Tygar Dec. para. 18.

Therefore, it is apparent that Napster chose to copy the system taught by the '573 patent. See Tygar Dec. para. 19. It is also apparent that Napster choose *not* to copy the prior art systems of Freeny and Akashi. See Tygar Dec. para. 20 and 21. Applicant submits this selective copying by Napster of the invention recited in Claims 1-6, while Napster ignored the systems of Freeny and Akashi, provides a sound basis upon which the required nexus between commercial success and Applicant's claimed invention can be found. See *Hughes Tool,* 816 F.2d at 1556. Additionally, Napster's selective copying of Applicant's invention, coupled with Napster's disregard of the Freeny and Akashi systems, is itself substantive evidence of a recognized secondary indication of non-obviousness. See *Windsurfing International Inc.*, 782 F.2d 995.

Applicant therefore respectfully submits that the foregoing remarks and the attached Declaration of Dr. Tygar have established the requisite nexus between the commercial success of Napster and Applicant's claimed invention. Applicant also respectfully submits that these remarks and the attached Declaration of Dr. Tygar similarly have established copying by Napster as a secondary indicia of non-obviousness.

Newly Added Claims Are Not Taught by the Prior Art

It is well established that, in order to establish a *prima facie* case of obviousness of a claimed invention, all limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974), MPEP §2143.03. The elements added via newly presented Claims 7-43 are not taught or suggested in the cited prior art, i.e., Akashi and Freeny, or in any other art cited in the related co-pending reexaminations for U.S. Patent No. 5,675,734 and U.S. Patent No. 5,966,440. The newly added claims comprise various combinations of the following limitations, as applied to both digital audio signals and digital video signals:

a) listing/scrolling the digital signals from the second memory (Claims 7-21, 24, 28, 31, 35, 39);

b) displaying a name of a digital signal from the second memory (Claims 9, 16, 25, 32, 36)

c) displaying a duration of the digital signal from the second memory (Claims 10, 18, 29-34);

d) displaying a name of an artist of the digital signal from the second memory (Claims 11, 19, 26-28, 37-39);

e) displaying a name of an album associated with the digital signal from the second memory (Claims 12 and 20); and

f) randomly selecting digital signals from the second memory by a second party integrated circuit of a second party control unit (Claims 13, 22-25, 33-36).

All of the limitations set forth above involve features surrounding playback from the second memory. None of these limitations are taught in Akashi or Freeny.

More specifically, limitation (a) set forth above is listing/scrolling the digital signals from the second memory. Akashi teaches a recording reproducing apparatus that either may be a digital audio tape recorder or a compact disk deck which employs a write-once, read-many times recordable optical disk. Akashi does not teach any listing/scrolling feature of a second memory. Freeny teaches using information stored locally at the point of sale (e.g., kiosk) to manufacture a material object. There is no teaching of listing/scrolling digital signals from the second memory in Freeny.

Limitations (b), (c), (d) and (e) set forth above all provide for displaying information from the second memory regarding the digital audio or digital video signal. Specifically, a name, duration, name of an artist, and name of an album are displayed. Neither Akashi nor Freeny teaches or suggests any display features concerning information in the second memory.

Limitation (f) set forth above is randomly selecting digital signals from the second memory by a second party integrated circuit of a second party control unit. Neither Akashi or Freeny teaches or suggests a second party integrated circuit of a second party control unit that allows for random selection of the digital signal. No random selection of signals by any means is taught or suggested in either reference.

As a result, in addition to being allowable for the reasons previously set forth concerning Claims 1 through 6, Applicant respectfully submits that the newly added claims are allowable for the further reason that the limitations found in the newly added claims are not taught or suggested by the prior art.

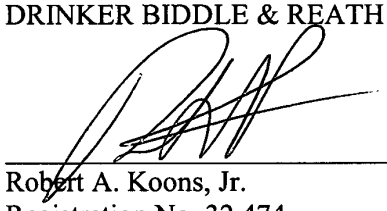
CONCLUSION

Applicant believes the foregoing remarks have overcome or rendered moot all grounds for rejection of original Claims 1-6 and any potential grounds for rejection of newly added Claims 7-43. Applicant therefore believes that all such claims are patentable over the art cited by the Examiner. There being no other rejections or objections of record, Applicant believes that the application is in condition for allowance.

Applicant understands, however, that the Examiner may have additional questions or concerns prior to allowing Applicant's claims. Applicant therefore respectfully requests that the Examiner contact Applicant's undersigned attorney directly to schedule an Interview before the Examiner takes any further action in this case.

Respectfully submitted,

DRINKER BIDDLE & REATH LLP



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CERTIFICATE UNDER 37 C.F.R. 1.10

In Re: Patent Application of Arthur R. Hair	)	
	)	
Docket No.: NAPS001	)	
Reexamination Control No. 90/007,402	)	**METHOD FOR**
Reexamination Filed: January 31, 2005	)	**TRANSMITTING A DESIRED**
Patent Number: 5,191,573	)	**DIGITAL VIDEO OR**
Examiner: Benjamin E. Lanier	)	**AUDIO SIGNAL**

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Date of Deposit: February 6, 2006

I hereby certify that the following correspondence

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First Named Inventor	Arthur R. Hair
Art Unit	
Examiner Name	Benjamin E. Lanier
Attorney Docket Number	NAPS001

ENCLOSURES *(Check all that apply)*

- [ ] Fee Transmittal Form
  - [ ] Fee Attached
- [x] Amendment / Reply
  - [ ] After Final
  - [ ] Affidavits/declaration(s)
- [ ] Extension of Time Request
- [ ] Express Abandonment Request
- [ ] Information Disclosure Statement
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  - [ ] Reply to Missing Parts under 37 CFR 1.52 or 1.53
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- [ ] Petition to Convert to a Provisional Application
- [ ] Power of Attorney, Revocation Change of Correspondence Address
- [ ] Terminal Disclaimer
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- [ ] CD, Number of CD(s) _____
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Drinker Biddle & Reath LLP		
Signature			
Printed name	Robert A. Koons, Jr.		
Date	February 6, 2006	Reg. No.	32,474

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,402	01/31/2005	5191573	NAPS001	2998

23973 7590 03/20/2006

DRINKER BIDDLE & REATH
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EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 03/20/2006

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

PTO-90C (Rev. 10/03)

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/007,402*.

PATENT NO. *5191573*.

ART UNIT *2132*.

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)).

PTOL-465 (Rev.07-04)

Office Action in Ex Parte Reexamination	Control No. 90/007,402	Patent Under Reexamination 5191573	
	Examiner Benjamin E. Lanier	Art Unit 2132	

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

a☒ Responsive to the communication(s) filed on *06 February 2006*. b☒ This action is made FINAL.
c☐ A statement under 37 CFR 1.530 has not been received from the patent owner.

A shortened statutory period for response to this action is set to expire *2* month(s) from the mailing date of this letter. Failure to respond within the period for response will result in termination of the proceeding and issuance of an *ex parte* reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).** If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892.
2. ☐ Information Disclosure Statement, PTO-1449.
3. ☐ Interview Summary, PTO-474.
4. ☐ _____.

Part II SUMMARY OF ACTION

1a. ☒ Claims *1-43* are subject to reexamination.
1b. ☐ Claims _____ are not subject to reexamination.
2. ☐ Claims _____ have been canceled in the present reexamination proceeding.
3. ☐ Claims _____ are patentable and/or confirmed.
4. ☒ Claims *1-43* are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ The drawings, filed on _____ are acceptable.
7. ☐ The proposed drawing correction, filed on _____ has been (7a)☐ approved (7b)☐ disapproved.
8. ☐ Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
   a)☐ All b)☐ Some* c)☐ None of the certified copies have
   1☐ been received.
   2☐ not been received.
   3☐ been filed in Application No. _____.
   4☐ been filed in reexamination Control No. _____.
   5☐ been received by the International Bureau in PCT application No. _____.
   * See the attached detailed Office action for a list of the certified copies not received.
9. ☐ Since the proceeding appears to be in condition for issuance of an *ex parte* reexamination certificate 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.
10. ☐ Other: _____

cc: Requester (if third party requester)

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed 06 February 2006 adds claims 7-43. Applicant's amendment has been fully considered and is entered.

Response to Arguments

2. Applicant's arguments filed 06 February 2006 have been fully considered but they are not persuasive. In response to Applicant's arguments with respect to the Freeny reference, the District Court considered the Freeny reference, in the analysis on pages 52-53, with respect to anticipation and obviousness in view of only the teachings within the Freeny reference. Nowhere does the court decision discuss a combination of Akashi and Freeny, as applied in this reexamination proceeding, as being non-obvious.

3. The Examiner disagrees with Applicant's assessment of Akashi as a simple inexpensive digital audio tape recorder because Akashi clearly shows that the user device that communicates with the host computer is a personal computer (paragraph 4). The recording device that Applicant is referring to is a device/module of the personal computer; much the same as a hard drive or a CD-ROM drive is a device/module of a personal computer.

4. In response to applicant's argument that Freeny is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Akashi and Freeny both deal with

music purchasing over telecommunication lines that enable users access to requested music (See Akashi page 1 and Freeny Col. 5, line 1 – Col. 6, line 23 & Col. 13, lines 27-31).

5. Applicant argues that the proposed modification of Akashi, in view of Freeny, would change the principle operation of the Akashi is not persuasive because the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The proposed modification to the automated purchasing component of Akashi, which isn't even described in the Akashi reference, would not change the principle operation of the Akashi reference. Akashi discloses that the digital music data is purchased automatically but does not expressly detail how the purchase is transacted. Freeny discloses a method of electronically distributing and selling audio and video data by way of having the requesting user transmit a consumer credit card number along with their request for the audio and video data (Col. 13, lines 25-29). This step allows the owner of the data to approve the sale and charge the sale to the consumer credit card number (Col. 13, lines 30-31). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the requesting user's of Akashi transmit a consumer credit card number along with their request for the digital data so that the source unit could approve and charge the sale of the digital data to the consumer credit card because this method of electronic sale allows the owner of the information to receive directly the compensation for sale of recording and such compensation is received before the reproduction is authorized as taught in Freeny (Col. 13, lines 36-39). The subsequent

transmission of data in Akashi has not been modified, and therefore, suggesting that the modification of the purchasing component of Akashi would change the principle operation of Akashi is simply not true.

6. Applicant's argument that the motivation for the proposed modification of the purchasing component of Akashi with the electronic sales procedure of Freeny is not persuasive because the motivation is not a conclusory statement but instead is teaching directly from the Freeny reference. See motivation below:

> It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the requesting user's of Akashi transmit a consumer credit card number along with their request for the digital data so that the source unit could approve and charge the sale of the digital data to the consumer credit card because this method of electronic sale allows the owner of the information to receive directly the compensation for sale of recording and such compensation is received before the reproduction is authorized as taught in Freeny (Col. 13, lines 36-39).

This teaching in Freeny would lead one of ordinary skill in the art at the time the invention was made to perform an electronic sale using credit card information so that the seller could receive direct compensation.

7. In response to Applicant's argument that no showing of a reasonable expectation of success has been made, the incorporation of the electronic payment steps of Freeny into the automated purchasing system of Akashi allow for a seller to receive direct compensation for the data that the automated purchasing system of Akashi allows to be sold.

8. Applicant's argument that the combination of Akashi and Freeny do not suggest that transmission of audio or video information from a remote location can be triggered by providing credit card account information is not persuasive because taking into account the above-mentioned modification of Akashi using the electronic payment steps of Freeny, the user's request for the data from the host computer of Akashi would be accompanied with the user's credit card information. At the remote cite, access to the data would be allowed once the credit card information is authorized (See Freeny Col. 13, lines 27-39). In Akashi the access provided to the user is done through telecommunication lines (i.e. data being transmitted from the host computer to the user's personal computer over telecommunication lines)(See Akashi Page 1 through line 1 of Page 2 & Page 4 paragraph 1).

9. All of the Applicant's arguments with the respect to the 103 rejections represent attacks on the references individually where the rejections are based on combinations of references and they represent allegations that various features of the secondary references cannot be bodily incorporated into the structure of the primary reference. These arguments cannot be relied upon to show nonobviousness. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

10. Therefore, the cited prior art references were considered as a whole when making the claim rejections and would have suggested to those of ordinary skill in the art the above-mentioned combinations.

11. Applicant's arguments with respect to commercial success are not persuasive because commercial success may have been attributable to extensive advertising and position as a market leader before the introduction of the patented product, Pentec, Inc. v. Graphic Controls Corp.,

776 F.2d 309, 227 USPQ 766 (Fed. Cir. 1985). The Napster name gained worldwide notoriety in the late 1990's because of their software which allowed users to illegally download music. At its height, Napster had 70 million unique users who were estimated to have traded over 3 billion files a month (See Wired News "Napster is Alive, Alive", Page 3). This would have given Napster's legitimate online music store a starting base of 70 million users who were familiar with Napster products prior to their online music store's launch. Therefore, Applicant has failed to show that the commercial success of the Napster Light software is due to the alleged use of Applicant's claimed invention instead of being a direct result of Napster's prominent name with respect to music downloading.

12. Success of invention could be due to recent changes in related technology or consumer demand, In re Fielder, 471 F.2d 690, 176 USPQ 300 (CCPA 1973). The existence and profitability of the systems mentioned by Applicant are due to the advances in recent technology and not Applicant's claimed invention. If the latter was responsible for the success, then it stands to reason that the existence of a profitable system would have occurred earlier since Applicant's first application directed to the claimed subject matter was filed in June of 1988. At the time of Napster Light's ("Napster") launch, personal computer storage capacities were significantly larger than they were at the time of the prior art systems. Hard drives routinely come in capacities of 20 gigabytes or higher, whereas in 1988 the capacity was around 40 megabytes. Not to mention the fact that when Napster was launched, audio file compression was advanced to the point where a file could be compressed to a third of the size with little observable quality loss. Add to that the proliferation of broadband Internet that simply did not exist at the time of prior art systems and what you have is the ability to store a significantly larger amount of music

because of file size and storage capacity, and the ability to acquire this music much faster. Therefore, Applicant cannot attribute the commercial success of Napster's system to the alleged use of their claimed invention when there is no reason to suggest that any of the prior art distribution system would not have been just as successful given these same advances in technology.

13. Applicant's arguments with respect to the newly added claims and the Akashi and Freeny references have been persuasive, however, upon search and consideration of the newly added claims, grounds of rejection are made in view of the previously cited Akashi and Freeny references and in further view of Stokes and Kimura. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**.

Claim Rejections - 35 USC § 103

14. 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 negatived by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akashi, "Automated Music Purchasing System", in view of Freeny, U.S. Patent No. 4,528,643. Referring to claims 1, 3, 4, 6, Akashi discloses a system for automatically selling recorded music via telecommunication lines (Page 1 through line 1 of Page 2). This system utilizes the telecommunications lines to transmit the recorded music data from a host computer that stores the recorded music data to a personal computer (Page 2 Section 4), which meets the limitation of connecting electronically via telecommunications line the first memory with the second memory such that the desired digital audio signal can pass therebetween, transmitting the desired digital audio signal from the first memory with a transmitter in control and possession of the first party to a receiver having the second memory at a location determined by the second party, said receiver in possession and control of the second party, storing the digital signal in the second memory. Akashi discloses that the digital music data is purchased automatically but does not expressly detail how the purchase is transacted. Freeny discloses a method of electronically distributing and selling audio and video data by way of having the requesting user transmit a consumer credit card number along with their request for the audio and video data (Col. 13, lines 25-29). This step allows the owner of the data to approve the sale and charge the sale to the consumer credit card number (Col. 13, lines 30-31), which meets the limitation of transferring money electronically via a telecommunications lines to the first party at a location remote from the second memory and controlling use of the first memory from the second party financially distinct from the first party, said second party controlling use and in possession of the second memory, the transferring step includes the steps of telephoning the first party controlling use of the first memory by the second party, providing a credit card number of the second party

controlling the second memory to the first party controlling the first memory so the second party is charged money. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the requesting user's of Akashi transmit a consumer credit card number along with their request for the digital data so that the source unit could approve and charge the sale of the digital data to the consumer credit card because this method of electronic sale allows the owner of the information to receive directly the compensation for sale of recording and such compensation is received before the reproduction is authorized as taught in Freeny (Col. 13, lines 36-39).

Referring to claims 2, 5, Akashi discloses that personal computer contains a CPU (Figure 1). The personal computer sends an access signal to the host computer, and the host computer returns a response signal that contains menu data displayed at the personal computer (Page 3 Paragraph 6). Using the monitor screen, the user chooses desired data using a control unit and sending the selection data to the host computer in the same way the initial transmission was sent (Page 4 Paragraph 1), which meets the limitation of the steps of searching the first memory for the desired digital audio signal and selecting the desired digital audio signal from the first memory.

17. Claims 7-12, 14-20, 26-32, 37-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akashi, "Automated Music Purchasing System", in view of Freeny, U.S. Patent No. 4,528,643, and further in view of Stokes, U.S. Patent No. 4,870,515. Referring to claims 7, 8, Akashi discloses a system for automatically selling recorded music via telecommunication lines (Page 1 through line 1 of Page 2 & Page 3, lines 3-5). This system utilizes the telecommunications lines to transmit the recorded music data from a host computer

that stores the recorded music data to a personal computer (Page 2 Section 4), which meets the limitation of connecting electronically via telecommunications line the first memory with the second memory such that the desired digital audio signal can pass therebetween, transmitting the desired digital audio signal from the first memory with a transmitter in control and possession of the first party to a receiver having the second memory at a location determined by the second party, said receiver in possession and control of the second party, storing the digital audio signal in the second memory. Akashi discloses that the digital music data is purchased automatically but does not expressly detail how the purchase is transacted. Freeny discloses a method of electronically distributing and selling audio and video data by way of having the requesting user transmit a consumer credit card number along with their request for the audio and video data (Col. 13, lines 25-29). This step allows the owner of the data to approve the sale and charge the sale to the consumer credit card number (Col. 13, lines 30-31), which meets the limitation of transferring money electronically via a telecommunications lines to the first party at a location remote from the second memory and controlling use of the first memory from the second party financially distinct from the first party, said second party controlling use and in possession of the second memory, the transferring step includes the steps of telephoning the first party controlling use of the first me... ...e second party, providing a credit card number of the second party controlling the second memory to the first party controlling the first memory so the second party is charged money. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the requesting user's of Akashi transmit a consumer credit card number along with their request for the digital data so that the source unit could approve and charge the sale of the digital data to the consumer credit card because this method of electronic

sale allows the owner of the information to receive directly the compensation for sale of recording and such compensation is received before the reproduction is authorized as taught in Freeny (Col. 13, lines 36-39). Akashi discloses that the music data is immediately readable after it has been downloaded to the user computer and stored on the storage medium (Page 2, "Operation" section through Page 3, line 1), but does not disclose how the stored music data is read. Stokes discloses a music memory data recording, storage and playback system wherein a computer data terminal (Figure 2, element 42), which has input devices and a monitor (Figure 2), is used along with storage devices and speakers to access storage audio data (Col. 5, lines 11-48). The audio data is stored such that it can be displayed to the user (Col. 2, lines 30-38) on the user's computer data terminal (Col. 5, lines 44-48), which meets the limitation of listing/scrolling digital audio signals from the second memory. For the purposes of examination "listing/scrolling" will be treated as its grammatical equivalent, which is "listing or scrolling". The cited portions of Stokes are meant to read on listing, however, Stokes also includes several teaches of scrolling capabilities to enable selection of audio data (Col. 6, lines 17-18 & Col. 8, lines 57-62). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide access/playback system of Stokes in the user personal computer of Akashi in order for the user of the personal computer of Akashi to be choose which musical selections are to be played, and in what order as taught in Stokes (Col. 1, lines 56-59).

Referring to claims 14, 15, 37-43, Akashi discloses a system for automatically selling recorded music via telecommunication lines (Page 1 through line 1 of Page 2 & Page 3, lines 3-5). This system utilizes the telecommunications lines to transmit the recorded music data from a host computer that stores the recorded music data to a personal computer (Page 2 Section 4),

which meets the limitation of connecting electronically via telecommunications line the first memory with the second memory such that the desired digital audio signal can pass therebetween, transmitting the desired digital audio signal from the first memory with a transmitter in control and possession of the first party to a receiver having the second memory at a location determined by the second party, said receiver in possession and control of the second party, storing the digital audio signal in the second memory. Akashi does not disclose that the digital data is video data. Freeny discloses a method of electronically distributing and selling audio and video data by way of having the requesting user transmit a consumer credit card number along with their request for the audio and video data (Col. 13, lines 25-29). It would have been obvious to one of ordinary skill in the art at the time the invention was made to distribute video data using the system of Akashi because distributors of video data would benefit from the cost reduction that would occur when eliminating manufacturing facilities for reproducing the information in material objects and a distribution network for distributing the material objects to the various points of sale locations for sale to the consumer as taught in Freeny (Col. 1, lines 10-26). Akashi discloses that the digital music data is purchased automatically but does not expressly detail how the purchase is transacted. Freeny discloses a method of electronically distributing and selling audio and video data by way of having the requesting user transmit a consumer credit card number along with their request for the audio and video data (Col. 13, lines 25-29). This step allows the owner of the data to approve the sale and charge the sale to the consumer credit card number (Col. 13, lines 30-31), which meets the limitation of transferring money electronically via a telecommunications lines to the first party at a location remote from the second memory and controlling use of the first memory from the

second party financially distinct from the first party, said second party controlling use and in possession of the second memory, the transferring step includes the steps of telephoning the first party controlling use of the first memory by the second party, providing a credit card number of the second party controlling the second memory to the first party controlling the first memory so the second party is charged money. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the requesting user's of Akashi transmit a consumer credit card number along with their request for the digital data so that the source unit could approve and charge the sale of the digital data to the consumer credit card because this method of electronic sale allows the owner of the information to receive directly the compensation for sale of recording and such compensation is received before the reproduction is authorized as taught in Freeny (Col. 13, lines 36-39). Akashi discloses that the music data is immediately readable after it has been downloaded to the user computer and stored on the storage medium (Page 2, "Operation" section through Page 3, line 1), but does not disclose how the stored music data is read. Stokes discloses a music memory data recording, storage and playback system wherein a computer data terminal (Figure 2, element 42), which has input devices and a monitor (Figure 2), is used along with storage devices and speakers to access storage audio data (Col. 5, lines 11-48). The audio data is stored such that it can be displayed to the user (Col. 2, lines 30-38) on the user's computer data terminal (Col. 5, lines 44-48), which meets the limitation of listing/scrolling digital audio signals from the second memory. For the purposes of examination "listing/scrolling" will be treated as its grammatical equivalent, which is "listing or scrolling". The cited portions of Stokes are meant to read on listing, however, Stokes also includes several teaches of scrolling capabilities to enable selection of audio data (Col. 6, lines 17-18 & Col. 8,

lines 57-62). Stokes discloses that when the audio data is stored in the system, it is stored with information that includes the artists name, title, album, playing time, track (song), and location of the audio data (Col. 1, lines 8-14 & Col. 2, lines 27-20). This information is displayed when the list of audio data is presented to the user for selection (Col. 2, lines 30-38 & Col. 4, line 65 – Col. 5, line 10, 44-48), which meets the limitation of displaying a duration, and a name of an artist of the digital signal from the second memory. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide access/playback system of Stokes in the user personal computer of Akashi in order for the user of the personal computer of Akashi to be choose which musical selections are to be played, and in what order as taught in Stokes (Col. 1, lines 56-59).

Referring to claims 26-32, Akashi discloses a system for automatically selling recorded music via telecommunication lines (Page 1 through line 1 of Page 2 & Page 3, lines 3-5). This system utilizes the telecommunications lines to transmit the recorded music data from a host computer that stores the recorded music data to a personal computer (Page 2 Section 4), which meets the limitation of connecting electronically via telecommunications line the first memory with the second memory such that the desired digital audio signal can pass therebetween, transmitting the desired digital audio signal from the first memory with a transmitter in control and possession of the first party to a receiver having the second memory at a location determined by the second party, said receiver in possession and control of the second party, storing the digital audio signal in the second memory. Akashi discloses that the digital music data is purchased automatically but does not expressly detail how the purchase is transacted. Freeny discloses a method of electronically distributing and selling audio and video data by way of

having the requesting user transmit a consumer credit card number along with their request for the audio and video data (Col. 13, lines 25-29). This step allows the owner of the data to approve the sale and charge the sale to the consumer credit card number (Col. 13, lines 30-31), which meets the limitation of transferring money electronically via a telecommunications lines to the first party at a location remote from the second memory and controlling use of the first memory from the second party financially distinct from the first party, said second party controlling use and in possession of the second memory, the transferring step includes the steps of telephoning the first party controlling use of the first memory by the second party, providing a credit card number of the second party controlling the second memory to the first party controlling the first memory so the second party is charged money. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the requesting user's of Akashi transmit a consumer credit card number along with their request for the digital data so that the source unit could approve and charge the sale of the digital data to the consumer credit card because this method of electronic sale allows the owner of the information to receive directly the compensation for sale of recording and such compensation is received before the reproduction is authorized as taught in Freeny (Col. 13, lines 36-39). Akashi discloses that the music data is immediately readable after it has been downloaded to the user computer and stored on the storage medium (Page 2, "Operation" section through Page 3, line 1), but does not disclose how the stored music data is read. Stokes discloses a music memory data recording, storage and playback system wherein a computer data terminal (Figure 2, element 42), which has input devices and a monitor (Figure 2), is used along with storage devices and speakers to access storage audio data (Col. 5, lines 11-48). The audio data is stored such that it can be displayed to

the user (Col. 2, lines 30-38) on the user's computer data terminal (Col. 5, lines 44-48), which meets the limitation of listing/scrolling digital audio signals from the second memory. For the purposes of examination "listing/scrolling" will be treated as its grammatical equivalent, which is "listing or scrolling". The cited portions of Stokes are meant to read on listing, however, Stokes also includes several teaches of scrolling capabilities to enable selection of audio data (Col. 6, lines 17-18 & Col. 8, lines 57-62). Stokes discloses that when the audio data is stored in the system, it is stored with information that includes the artists name, title, album, playing time, track (song), and location of the audio data (Col. 1, lines 8-14 & Col. 2, lines 27-20). This information is displayed when the list of audio data is presented to the user for selection (Col. 2, lines 30-38 & Col. 4, line 65 – Col. 5, line 10, 44-48), which meets the limitation of displaying a name of an artist, a duration, and a name of the digital audio signal from the second memory. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide access/playback system of Stokes in the user personal computer of Akashi in order for the user of the personal computer of Akashi to be choose which musical selections are to be played, and in what order as taught in Stokes (Col. 1, lines 56-59).

Referring to claims 9-12, 16-20, Stokes discloses that when the audio data is stored in the system, it is stored with information that includes the artists name, title, album, playing time, track (song), and location of the audio data (Col. 1, lines 8-14 & Col. 2, lines 27-20). This information is displayed when the list of audio data is presented to the user for selection (Col. 2, lines 30-38 & Col. 4, line 65 – Col. 5, line 10, 44-48), which meets the limitation of displaying a name, duration, name of an artist, and name of an album associated with the digital audio signal from the second memory. It would have been obvious to one of ordinary skill in the art at the

time the invention was made to provide access/playback system of Stokes in the user personal computer of Akashi in order for the user of the personal computer of Akashi to be choose which musical selections are to be played, and in what order as taught in Stokes (Col. 1, lines 56-59).

18. Claims 13, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akashi, "Automated Music Purchasing System", in view of Freeny, U.S. Patent No. 4,528,643, and further in view of Stokes, U.S. Patent No. 4,870,515 as applied to claims 7, 14 above, and further in view of Kimura, U.S. Patent No. 4,855,979. Referring to claim 13, 21, Akashi discloses that the music data is immediately readable after it has been downloaded to the user computer and stored on the storage medium (Page 2, "Operation" section through Page 3, line 1), but does not disclose how the stored music data is read. Stokes discloses a music memory data recording, storage and playback system wherein a computer data terminal (Figure 2, element 42), which has input devices and a monitor (Figure 2), is used along with storage devices and speakers to access storage audio data (Col. 5, lines 11-48). The audio data is stored such that it can be displayed to the user (Col. 2, lines 30-38) on the user's computer data terminal (Col. 5, lines 44-48). Stokes does not disclose that audio data can be played back randomly. Kimura discloses a playback method for digital audio wherein the playback device sorts the audio files and plays them back randomly (Col. 1, lines 31-58). It would have been obvious to one of ordinary skill in the art at the time the invention was made to sort the retrieved digital audio and play the files back randomly in order to avoid repeating the same file with respect to the number of files in the collection as taught in Kimura (Col. 2, lines 53-58).

19. Claims 22, 23, 33, 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akashi, "Automated Music Purchasing System", in view of Freeny, U.S. Patent No. 4,528,643,

in view of Kimura, U.S. Patent No. 4,855,979. Referring to claims 22, 23, Akashi discloses a system for automatically selling recorded music via telecommunication lines (Page 1 through line 1 of Page 2 & Page 3, lines 3-5). This system utilizes the telecommunications lines to transmit the recorded music data from a host computer that stores the recorded music data to a personal computer (Page 2 Section 4), which meets the limitation of connecting electronically via telecommunications line the first memory with the second memory such that the desired digital audio signal can pass therebetween, transmitting the desired digital audio signal from the first memory with a transmitter in control and possession of the first party to a receiver having the second memory at a location determined by the second party, said receiver in possession and control of the second party, storing the digital audio signal in the second memory. Akashi discloses that the digital music data is purchased automatically but does not expressly detail how the purchase is transacted. Freeny discloses a method of electronically distributing and selling audio and video data by way of having the requesting user transmit a consumer credit card number along with their request for the audio and video data (Col. 13, lines 25-29). This step allows the owner of the data to approve the sale and charge the sale to the consumer credit card number (Col. 13, lines 30-31), which meets the limitation of transferring money electronically via a telecommunications lines to the first party at a location remote from the second memory and controlling use of the first memory from the second party financially distinct from the first party, said second party controlling use and in possession of the second memory, the transferring step includes the steps of telephoning the first party controlling use of the first memory by the second party, providing a credit card number of the second party controlling the second memory to the first party controlling the first memory so the second party is charged money. It would

have been obvious to one of ordinary skill in the art at the time the invention was made to have the requesting user's of Akashi transmit a consumer credit card number along with their request for the digital data so that the source unit could approve and charge the sale of the digital data to the consumer credit card because this method of electronic sale allows the owner of the information to receive directly the compensation for sale of recording and such compensation is received before the reproduction is authorized as taught in Freeny (Col. 13, lines 36-39).

Referring to claims 33, 34, Akashi discloses a system for automatically selling recorded music via telecommunication lines (Page 1 through line 1 of Page 2 & Page 3, lines 3-5). This system utilizes the telecommunications lines to transmit the recorded music data from a host computer that stores the recorded music data to a personal computer (Page 2 Section 4), which meets the limitation of connecting electronically via telecommunications line the first memory with the second memory such that the desired digital audio signal can pass therebetween, transmitting the desired digital audio signal from the first memory with a transmitter in control and possession of the first party to a receiver having the second memory at a location determined by the second party, said receiver in possession and control of the second party, storing the digital audio signal in the second memory. Akashi does not disclose that the digital data is video data. Freeny discloses a method of electronically distributing and selling audio and video data by way of having the requesting user transmit a consumer credit card number along with their request for the audio and video data (Col. 13, lines 25-29). It would have been obvious to one of ordinary skill in the art at the time the invention was made to distribute video data using the system of Akashi because distributors of video data would benefit from the cost reduction that would occur when eliminating manufacturing facilities for reproducing the information in

material objects and a distribution network for distributing the material objects to the various points of sale locations for sale to the consumer as taught in Freeny (Col. 1, lines 10-26). Akashi discloses that the digital music data is purchased automatically but does not expressly detail how the purchase is transacted. Freeny discloses a method of electronically distributing and selling audio and video data by way of having the requesting user transmit a consumer credit card number along with their request for the audio and video data (Col. 13, lines 25-29). This step allows the owner of the data to approve the sale and charge the sale to the consumer credit card number (Col. 13, lines 30-31), which meets the limitation of transferring money electronically via a telecommunications lines to the first party at a location remote from the second memory and controlling use of the first memory from the second party financially distinct from the first party, said second party controlling use and in possession of the second memory, the transferring step includes the steps of telephoning the first party controlling use of the first memory by the second party, providing a credit card number of the second party controlling the second memory to the first party controlling the first memory so the second party is charged money. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the requesting user's of Akashi transmit a consumer credit card number along with their request for the digital data so that the source unit could approve and charge the sale of the digital data to the consumer credit card because this method of electronic sale allows the owner of the information to receive directly the compensation for sale of recording and such compensation is received before the reproduction is authorized as taught in Freeny (Col. 13, lines 36-39).

20. Claims 24, 25, 35, 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akashi, "Automated Music Purchasing System", in view of Freeny, U.S. Patent No. 4,528,643,

in view of Kimura, U.S. Patent No. 4,855,979 as applied to claims 22, 33 above, and further in view of Stokes, U.S. Patent No. 4,870,515. Referring to claims 24, 25, 35, 36, Akashi discloses that the music data is immediately readable after it has been downloaded to the user computer and stored on the storage medium (Page 2, "Operation" section through Page 3, line 1), but does not disclose how the stored music data is read. Stokes discloses a music memory data recording, storage and playback system wherein a computer data terminal (Figure 2, element 42), which has input devices and a monitor (Figure 2), is used along with storage devices and speakers to access storage audio data (Col. 5, lines 11-48). The audio data is stored such that it can be displayed to the user (Col. 2, lines 30-38) on the user's computer data terminal (Col. 5, lines 44-48), which meets the limitation of listing/scrolling digital audio signals from the second memory. For the purposes of examination "listing/scrolling" will be treated as its grammatical equivalent, which is "listing or scrolling". The cited portions of Stokes are meant to read on listing, however, Stokes also includes several teaches of scrolling capabilities to enable selection of audio data (Col. 6, lines 17-18 & Col. 8, lines 57-62). Stokes discloses that when the audio data is stored in the system, it is stored with information that includes the artists name, title, album, playing time, track (song), and location of the audio data (Col. 1, lines 8-14 & Col. 2, lines 27-20). This information is displayed when the list of audio data is presented to the user for selection (Col. 2, lines 30-38 & Col. 4, line 65 – Col. 5, line 10, 44-48), which meets the limitation of displaying a name of a digital signal from the second memory. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide access/playback system of Stokes in the user personal computer of Akashi in order for the user of the personal computer of Akashi to

be choose which musical selections are to be played, and in what order as taught in Stokes (Col. 1, lines 56-59).

Conclusion

21. Patent owner's amendment filed 06 February 2006 necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

A shortened statutory period for response to this action is set to expire **two months** from the mailing date of this action.

Extensions of time under 37 CFR 1.136(a) do not apply in reexamination proceedings. The provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Further, in 35 U.S.C. 305 and in 37 CFR 1.550(a), it is required that reexamination proceedings "will be conducted with special dispatch within the Office."

Extensions of time in reexamination proceedings are provided for in 37 CFR 1.550(c). A request for extension of time must be filed on or before the day on which a response to this action is due, and it must be accompanied by the petition fee set forth in 37 CFR 1.17(g). The mere filing of a request will not effect any extension of time. An extension of time will be granted only for sufficient cause, and for a reasonable time specified.

The filing of a timely first response to this final rejection will be construed as including a request to extend the shortened statutory period for an additional month, which will be granted even if previous extensions have been granted. In no event, however, will the statutory period for response expire later than SIX MONTHS from the mailing date of the final action. See MPEP § 2265.

22. 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. 5,191,573 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.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E. Lanier whose telephone number is 571-272-3805. The examiner can normally be reached on M-Th 7:30am-5:00pm, F 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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).

Benjamin E. Lanier

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Patentability Conferee
Kim VU
Gilberto Barron

PINCHUS M. LAUFER, PH.D., J.D.
SPECIAL PROGRAM EXAMINER
TECHNOLOGY CENTER 2100

- Procedure matters only

Notice of References Cited	Application/Control No. 90/007,402	Applicant(s)/Patent Under Reexamination 5191573	
	Examiner Benjamin E. Lanier	Art Unit 2132	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-4,870,515	09-1989	Stokes, Richard A.	360/72.2
*	B	US-4,855,979	08-1989	Kimura et al.	369/98
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

Litigation Search Report CRU 3999

Reexam Control No. 90/007,402

TO: Mark Reinhart **Location: CRU** **Art Unit : 3992** **Date: 04/15/06** **Case Serial Number: 90/007,402**	**From: James R. Matthews** **Location: CRU 3999** **RND 1C79** **Phone: (571) 272-4233** **JamesR.Matthews@uspto.gov**

Search Notes

U.S. Patent No- 5,191,573

1) I performed a KeyCite Search in Westlaw, which retrieves all history on the patent including any litigation.

2) I performed a search on the patent in Lexis CourtLink for any open dockets or closed cases.

3) I performed a search in Lexis in the Federal Courts and Administrative Materials databases for any cases found.

4) I performed a search in Lexis in the IP Journal and Periodicals database for any articles on the patent.

5) I performed a search in Lexis in the news databases for any articles about the patent or any articles about litigation on this patent.

Litigation was found

Westlaw

Date of Printing: APR 13,2006

KEYCITE

HUS PAT 5191573 METHOD FOR TRANSMITTING A DESIRED DIGITAL VIDEO OR AUDIO SIGNAL, (Mar 02, 1993)

History
Direct History

=> 1 **METHOD FOR TRANSMITTING A DESIRED DIGITAL VIDEO OR AUDIO SIGNAL,** US PAT 5191573, 1993 WL 1138260 (U.S. PTO Utility Mar 02, 1993) (NO. 586391)

Construed by

H 2 SightSound.Com Inc. v. N2K, Inc., 185 F.Supp.2d 445 (W.D.Pa. Feb 08, 2002) (NO. CIV.A.98-CV-118)

H 3 SYSTEM FOR TRANSMITTING DESIRED DIGITAL VIDEO OR AUDIO SIGNALS, US PAT 5675734, 1997 WL 1488819 (U.S. PTO Utility Oct 07, 1997) (NO. 607648)

Construed by

H 4 SightSound.Com Inc. v. N2K, Inc., 185 F.Supp.2d 445 (W.D.Pa. Feb 08, 2002) (NO. CIV.A.98-CV-118)

H 5 SYSTEM AND METHOD FOR TRANSMITTING DESIRED DIGITAL VIDEO OR DIGITAL AUDIO SIGNALS, US PAT 5966440, 1999 WL 1731614 (U.S. PTO Utility Oct 12, 1999) (NO. 471964)

Construed by

H 6 SightSound.Com Inc. v. N2K, Inc., 185 F.Supp.2d 445 (W.D.Pa. Feb 08, 2002) (NO. CIV.A.98-CV-118)

Related References (U.S.A.)

H 7 Sightsound.com Inc. v. N2K, Inc., 391 F.Supp.2d 321 (W.D.Pa. Oct 24, 2003) (NO. CIV.A. 98-CV-118)

Court Documents
Trial Court Documents (U.S.A.)

W.D.Pa. Expert Testimony

8 SIGHTSOUND.COM INCORPORATED, a Pennsylvania corporation, Plaintiff, v. N2K, INC., a Delaware corporation, Cdnow, Inc., a Pennsylvania corporation, and Cdnow Online, Inc., a Pennsylania corporation, Defendants., 1998 WL 34373758 (Expert Report and Affidavit) (W.D.Pa. 1998) **Opening Expert Report of James A. Moorer** (NO. 98-0118)

9 SIGHTSOUND. COM INCORPORATED, A Pennsylvania corporation, Plaintiff, v. N2K, INC., a Delaware corporation CDNOW, Inc., A Pennsaylvania corporation, and CDNOW Online, Inc., a Pennsylvania corporation, Defendants., 2001 WL 34891529 (Expert Deposition) (W.D.Pa. Apr. 19, 2001) **Proceedings** (NO. 98-118)

10 SIGHTSOUND COM INCORPORATED, a Pennsylvania corporation, Plaintiff, v. N2K, INC., a Delaware Corporation, CDNOW, INC., a CDNOW Online, Inc., a Pennsylvania corporation, Defendants., 2002 WL 32994569 (Expert Report and Affidavit) (W.D.Pa. Dec. 24, 2002) **Expert Report of Michael Ian Shamos, Ph.D., J.D.** (NO. 98-118)

11 SIGHTSOUND.COM INCORPORATED, Plaintiff, v. N2K, INC., CDNow, Inc., and CDNow Online, Inc., Defendants., 2003 WL 24288805 (Expert Report and Affidavit) (W.D.Pa. Jan. 21, 2003) **Expert Report of Justin Douglas Tygar, Ph.D.** (NO. 98-0118)

12 SIGHTSOUND.COM INCORPORATED, a Pennsylvania corporation, Plaintiff, v. N2K, INC., a Delaware corporation, Cdnow, Inc., a Pennsylvania corporation, and Cdnow Online, Inc., a Pennsylvania corporation, Defendants., 2003 WL 24288806 (Expert Report and Affidavit) (W.D.Pa. Feb. 19, 2003) **Rebuttal Expert Report of James A. Moorer to Opening Report of Professor Tygar** (NO. 98-0118)

13 SIGHTSOUND.COM INCORPORATED a Pennsylvania corporation, Plaintiff, v. N2K, INC., a Delaware Corporation, Cdnow, Inc., a Pennsylvania corporation, and Cdnow Onlline, Inc., a Pennsylvania corporation, Defendants., 2003 WL 24288804 (Expert Report and Affidavit) (W.D.Pa. Feb. 20, 2003) **Rebuttal Report of Michael Ian Shamos, PH.D., J.D.** (NO. 98-118)

14 SIGHTSOUND.COM. INCORPORATED, Plaintiff, v. N2K, INC., CDnow, Inc., and CDnow Online, Inc., Defendants., 2003 WL 24289706 (Expert Report and Affidavit) (W.D.Pa. Feb. 20, 2003) **Rebuttal Expert Report of Justin Douglas Tygar, Ph.D.** (NO. 98-0118)

15 SIGHTSOUND.COM, INC., a Pennsylvania corporation, Plaintiff, v. N2K, INC., a Delaware corporation, Cdnow, Inc., a Pennsylvania corporation, and Cdnow Online, Inc., a Pennsylvania corporation, Defendants., 2003 WL 24288807 (Expert Report and Affidavit) (W.D.Pa. Apr. 23, 2003) **Declaration by James A. Moorer in Support of Defendants' Motion for Summary Judgment** (NO. 98-0118)

16 SIGHTSOUND.COM, INC., a Pennsylvania corporation, Plaintiff and, Counterdefendants, v. N2K, INC., a Delaware corporation, CDNOW, Inc., a Pennsylvania corporation, and Cdnow Online, INC., a Pennsylvania corporation, Defendants and Counterclaimants., 2004 WL 3735168 (Expert Report and Affidavit) (W.D.Pa. Jan. 27, 2004) **Declaration of Michael Ian Shamos in Support of Defendants' Motion for Summary Judgment** (NO. 98-0118)

Assignments

17 Assignee(s): KENYON & KENYON ONE BROADWAY NEW YORK NEW YORK 10004 Assignee(s): SCHWARTZ, ANSEL M. ONE STERLING PLAZA 201 N. CRAIG STREET, SUITE 304 PITTSBURGH PENNSYLVANIA 15213, DATE RECORDED: Oct 24, 2001

18 ASSIGNEE(S): SIGHTSOUND.COM INCORPORATED 733 WASHINGTON ROAD, SUITE 400 MT. LEBANON PENNSYLVANIA 15228, DATE RECORDED: May 03, 2000

19 , DATE RECORDED: Oct 02, 1995

Patent Status Files

.. Request for Re-Examination, (OG date: Mar 29, 2005)

.. Patent Suit(See LitAlert Entries),

.. Certificate of Correction, (OG date: Dec 21, 1993)

Litigation Alert

23 LitAlert P1998-06-59, (1999) Action Taken: A complaint was filed.

Prior Art

P 24 US PAT 4567359 AUTOMATIC INFORMATION, GOODS AND SERVICES DISPENSING SYSTEM, (U.S. PTO Utility 1986)

C 25 US PAT 3990710 COIN-OPERATED RECORDING MACHINE, (U.S. PTO Utility 1976)

C 26 US PAT 4654799 SOFTWARE VENDING SYSTEM, Assignee: Brother Kogyo Kabushiki Kaisha, (U.S. PTO Utility 1987)

C 27 US PAT 3718906 VENDING SYSTEM FOR REMOTELY ACCESSIBLE STORED INFORMATION, Assignee: Lightner R, (U.S. PTO Utility 1973)

C 28 US PAT 4647989 VIDEO CASSETTE SELECTION MACHINE, (U.S. PTO Utility 1987)

Docket

US District Court Civil Docket

U.S. District - Pennsylvania Western
(Pittsburgh)

2:04cv1549

Sightsound Tech v. Roxio, Inc, et al

This case was retrieved from the court on Monday, April 03, 2006

Date Filed:	**10/08/2004**	Class Code:	
Assigned To:	**Chief Judge Donetta W Ambrose**	Closed:	**no**
Referred To:		Statute:	**35:271**
Nature of suit:	**Patent (830)**	Jury Demand:	**Both**
Cause:	**Patent Infringement**	Demand Amount:	**$0**
Lead Docket:	**None**	NOS Description:	**Patent**
Other Docket:	**Related, 2:98-cv-118**		
Jurisdiction:	**Federal Question**		

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Documents

Retrieve Document(s)

	Availability	Date	No.	Proceeding Text (Filter)
☐	Runner	10/08/2004	1	COMPLAINT with summons issued; jury demand Filing Fee $ 150.00 Receipt # 05C 10/08/2004)
☐	Runner	10/08/2004	2	DISCLOSURE statement by SIGHTSOUND TECH (tt) (Entered: 10/08/2004)
☐	Runner	10/08/2004	--	COPY of Complaint and Docket Entries mailed to the Commissioner of Patents and (Entered: 10/08/2004)
☐	Runner	11/08/2004	3	RETURN OF SERVICE executed as to ROXIO, INC. 11/5/04 Answer due on 11/26/0 (tt) (Entered: 11/09/2004)
☐	Runner	11/08/2004	4	RETURN OF SERVICE executed as to NAPSTER, L.L.C. 11/5/04 Answer due on 11/: L.L.C. (tt) (Entered: 11/09/2004)
☐	Runner	11/24/2004	5	ANSWER to Complaint; jury demand and COUNTERCLAIM by ROXIO, INC., NAPSTI William M. Wycoff, Kevin P. Allen, Charles K. Verhoeven, Michael E. Williams) agai TECH (tt) Modified on 03/11/2005 (Entered: 11/24/2004)
☐	Runner	11/24/2004	6	DISCLOSURE statement by ROXIO, INC., NAPSTER, L.L.C. (tt) (Entered: 11/24/20
☐	Runner	11/24/2004	7	NOTICE Opting Out of Arbitration by ROXIO, INC., NAPSTER, L.L.C. (tt) (Entered:
☐	Runner	12/15/2004	8	ANSWER by SIGHTSOUND TECH to [5-2] counterclaims by NAPSTER, L.L.C., ROXI 12/16/2004)
☐	Runner	12/17/2004	9	Case Management Conference set for 9:15 1/11/05 (tt) (Entered: 12/17/2004)
☐	Runner	01/10/2005	10	INITIAL Case Scheduling Conference Statement by ROXIO, INC., NAPSTER, L.L.C. 01/10/2005)
☐	Runner	01/10/2005	11	MOTION by SIGHTSOUND TECH for Preliminary Injunction , with Proposed Order. (01/11/2005)
☐	Runner	01/10/2005	12	EXHIBITS by SIGHTSOUND TECH to [11-1] motion for Preliminary Injunction (tt) (01/11/2005)
☐	Runner	01/10/2005	13	BRIEF by SIGHTSOUND TECH in support of [11-1] motion for Preliminary Injunctio TECH (tt) (Entered: 01/11/2005)
☐	Runner	01/10/2005	14	DECLARATION of Justin Douglas Tygar, Ph.D. concerning the Operation of Roxio/N motion for Preliminary Injunction by SIGHTSOUND TECH (tt) (Entered: 01/11/200
☐	Runner	01/11/2005	15	MOTION by ROXIO, INC., NAPSTER, L.L.C. to Substitute Attorney , with Proposed 01/11/2005)
☐	Runner	01/11/2005	16	MOTION by ROXIO, INC., NAPSTER, L.L.C. for Charles K. Verhoeven to Appear Pro $ 40.00 Receipt # 05001581 , with Proposed Order. (tt) (Entered: 01/11/2005)
☐	Runner	01/11/2005	17	MOTION by ROXIO, INC., NAPSTER, L.L.C. for Tigran Guledjian to Appear Pro Hac 40.00 Receipt # 05001581 , with Proposed Order. (tt) (Entered: 01/11/2005)
☐	Runner	01/11/2005	18	MOTION by ROXIO, INC., NAPSTER, L.L.C. for Michael E. Williams to Appear Pro H 40.00 Receipt # 05001581 , with Proposed Order. (tt) (Entered: 01/11/2005)
☐	Runner	01/11/2005	19	Status Conference held 1/11/05 before Chief Judge Donetta W. Ambrose [Reporte (Entered: 01/11/2005)
☐	Runner	01/11/2005	--	Deadline updated; Response to Motion set to 2/11/05 for [11-1] motion for Prelim Reply to Response to Motion set to 2/21/05 for [11-1] motion for Preliminary Injur Hearing set for 1:30 3/3/05 for [11-1] motion for Preliminary Injunction (tt) (Ente
☐	Runner	01/11/2005	20	RESPONSE by SIGHTSOUND TECH to defts' [10-1] Initial Case Scheduling Confere (Entered: 01/11/2005)
				ORDER upon motion granting [15-1] motion to Substitute Attorney ; terminated at Wycoff for ROXIO, INC., attorney Kevin P. Allen for ROXIO, INC., attorney William

	Runner	01/11/2005	--	NAPSTER, L.L.C., attorney Kevin P. Allen for NAPSTER, L.L.C. and added Laurence Kathryn M. Kenyon for defts. (signed by Chief Judge Donetta W. Ambrose on 1/11 of record. (tt) (Entered: 01/12/2005)
	Runner	01/11/2005	--	ORDER upon motion granting [16-1] motion for Charles K. Verhoeven to Appear Pr of defts. (signed by Chief Judge Donetta W. Ambrose on 1/11/05) CM all parties ((Entered: 01/12/2005)
	Runner	01/11/2005	--	ORDER upon motion granting [17-1] motion for Tigran Guledjian to Appear Pro Ha defts. (signed by Chief Judge Donetta W. Ambrose on 1/11/05) CM all parties of 01/12/2005)
	Runner	01/11/2005	--	ORDER upon motion granting [18-1] motion for Michael E. Williams to Appear Pro defts. (signed by Chief Judge Donetta W. Ambrose on 1/11/05) CM all parties of 01/12/2005)
	Runner	01/18/2005	21	Status Conference via phone held 1/18/05 before Chief Judge Donetta W. Ambrose Deft wants leave to amend counterclaims related to press release. Pltf doesn't obje leave to amend. Leave granted orally by the Court; Amended counterclaim due 1/ Motion to Stay Case pending outcome of application to Patent & Trademark Office, 10 days. (tt) (Entered: 01/19/2005)
	Runner	01/21/2005	22	MOTION by ROXIO, INC., NAPSTER, L.L.C. to Stay Pending Reexamination of Pater Proposed Order. (jsp) (Entered: 01/24/2005)
	Runner	01/21/2005	23	BRIEF by ROXIO, INC., NAPSTER, L.L.C. in support of [22-1] motion to Stay Pendi Patents in Suit by NAPSTER, L.L.C., ROXIO, INC. (jsp) (Entered: 01/24/2005)
	Runner	01/25/2005	24	FIRST AMENDED ANSWER to Complaint by ROXIO, INC., NAPSTER, L.L.C. amends NAPSTER, L.L.C., ROXIO, INC. and COUNTERCLAIMS against SIGHTSOUND TECH (01/26/2005)
	Runner	01/27/2005	25	MOTION by SIGHTSOUND TECH to Extend Time w/in which to respond to defts' mo receipt of defts' request for re-examination of patents and prior art which defts int Patent and Trademark Office , with Proposed Order. (tt) (Entered: 01/28/2005)
	Runner	01/28/2005	26	RESPONSE by ROXIO, INC., NAPSTER, L.L.C. to pltf's [25-1] motion to Extend Tim respond to defts' motion to stay (tt) (Entered: 01/28/2005)
	Runner	01/28/2005	27	ACCEPTANCE OF SERVICE of First Amended Answer and Counterclaim as to Scott 1/26/05 (tt) (Entered: 01/28/2005)
	Runner	01/28/2005	28	BRIEF by SIGHTSOUND TECH in support of [25-1] motion to Extend Time w/in whi defts' motion to stay (tt) (Entered: 01/31/2005)
	Runner	02/02/2005	29	Status Conference via phone held 1/31/05 before Chief Judge Donetta W. Ambrose Pltf's response to motion to stay due 2/11/05 ; Defts' reply due 2/16/05 ; Prelimin will be scheduled via order on motion to stay ; Defts do not have to file answer to by March. (tt) (Entered: 02/02/2005)
	Runner	02/02/2005	--	ORDER upon motion granting [25-1] motion to Extend Time w/in which to respond stay pending receipt of defts' request for re-examination of patents and prior art w submit to the Patent and Trademark Office. Defts shall serve on counsel for pltf by sent no later than 2/1/05 any request for re-examination of the patents in suit whi with the PTO, including all prior art on which defts plan to rely in such request for Response to Motion set to 2/11/05 for defts' [22-1] motion to Stay Pending Reexa Suit ; Defts' Reply Brief due 2/16/05 ; Defts are not required to file an answer to p preliminary injunction until further order of court. (signed by Chief Judge Donetta 1/31/05) CM all parties of record. (tt) (Entered: 02/02/2005)
	Runner	02/03/2005	30	MOTION by SIGHTSOUND TECH for Brian S. Mudge to Appear Pro Hac Vice ; Filing # 05001943 , with Proposed Order. (tt) (Entered: 02/04/2005)
	Runner	02/03/2005	31	MOTION by SIGHTSOUND TECH for William K. Wells to Appear Pro Hac Vice ; Filing # 05001943 , with Proposed Order. (tt) (Entered: 02/04/2005)
	Runner	02/03/2005	32	MOTION by SIGHTSOUND TECH for Duncan L. Williams to Appear Pro Hac Vice ; Fi Receipt # 05001943 , with Proposed Order. (tt) (Entered: 02/04/2005)
	Runner	02/03/2005	33	MOTION by SIGHTSOUND TECH for Clyde E. Findley to Appear Pro Hac Vice ; Filing 05001943 Receipt # 05001943 , with Proposed Order. (tt) (Entered: 02/04/2005)
	Runner	02/04/2005	34	NOTICE of Lodging of Pending Requests for Reexamination by ROXIO, INC., NAPST (Entered: 02/04/2005)
	Runner	02/04/2005	35	EXHIBITS (VOLUME I) by ROXIO, INC., NAPSTER, L.L.C. to [34-1] notice of lodging for reexamination. (tt) (Entered: 02/04/2005)
	Runner	02/04/2005	36	EXHIBITS (VOLUME II) by ROXIO, INC., NAPSTER, L.L.C. to [34-1] notice of lodgir requests for reexamination. (tt) (Entered: 02/04/2005)
	Runner	02/04/2005	37	EXHIBITS (VOLUME III) by ROXIO, INC., NAPSTER, L.L.C. to [34-1] notice of lodgi requests for reexamination. (tt) (Entered: 02/04/2005)
	Runner	02/07/2005	--	ORDER upon motion granting [30-1] motion for Brian S. Mudge to Appear Pro Hac (signed by Chief Judge Donetta W. Ambrose on 2/4/05) CM all parties of record. 02/07/2005)
	Runner	02/07/2005	--	ORDER upon motion granting [31-1] motion for William K. Wells to Appear Pro Hac pltf. (signed by Chief Judge Donetta W. Ambrose on 2/4/05) CM all parties of rec

				02/07/2005)
☐	Runner	02/07/2005	--	ORDER upon motion granting [32-1] motion for Duncan L. Williams to Appear Pro pltf. (signed by Chief Judge Donetta W. Ambrose on 2/4/05) CM all parties of rec 02/07/2005)
☐	Runner	02/07/2005	--	ORDER upon motion granting [33-1] motion for Clyde E. Findley to Appear Pro Hac pltf. (signed by Chief Judge Donetta W. Ambrose on 2/4/05) CM all parties of rec 02/07/2005)
☐	Runner	02/11/2005	38	REPLY by SIGHTSOUND TECH to [24-2] First Amended Counterclaims by NAPSTER (tt) (Entered: 02/14/2005)
☐	Runner	02/11/2005	39	BRIEF by SIGHTSOUND TECH in opposition to Napster's [22-1] motion to Stay Pen of Patents in Suit (tt) (Entered: 02/14/2005)
☐	Runner	02/11/2005	40	MOTION by SIGHTSOUND TECH, SCOTT SANDER to Dismiss defts' Amended Coun (Entered: 02/14/2005)
☐	Runner	02/11/2005	41	BRIEF by SIGHTSOUND TECH, SCOTT SANDER in support of their [40-1] motion to Amended Counterclaims 4-9 (tt) (Entered: 02/14/2005)
☐	Runner	02/16/2005	42	REPLY by ROXIO, INC., NAPSTER, L.L.C. in support of their Motion to Stay pending the Patents-In-Suit (tt) (Entered: 02/17/2005)
☐	Runner	02/16/2005	43	DECLARATION of William E. Growney (tt) Modified on 02/18/2005 (Entered: 02/17
☐	Runner	02/16/2005	44	MOTION by ROXIO, INC., NAPSTER, L.L.C. to Seal [43-1] Declaration , with Propos (Entered: 02/17/2005)
☐	Runner	02/17/2005	45	OPPOSITION by SIGHTSOUND TECH to defts' [44-1] motion to Seal [43-1] Declara 02/18/2005)
☐	Runner	02/17/2005	46	NOTICE OF FILING: Supplemental Declaration of Christopher Reese by SIGHTSOUI UNDER SEAL) (tt) Modified on 02/28/2005 (Entered: 02/18/2005)
☐	Runner	02/17/2005	47	REQUEST by SIGHTSOUND TECH for Oral Argument on Motion to Stay . (tt) (Enter
☐	Runner	02/18/2005	--	ORDER upon motion denying [44-1] motion to Seal [43-1] Declaration. The declar vague, unsuccessful attempts & no dollar values are set forth. I see no risk of conf being disclosed. (signed by Chief Judge Donetta W. Ambrose on 2/18/05) CM all (Entered: 02/18/2005)
☐	Runner	02/18/2005	--	ORDER upon motion denying [47-1] motion for Oral Argument on Motion to Stay. clearly represented their respective positions in the briefs and declarations filed. (Donetta W. Ambrose on 2/18/05) CM all parties of record. (tt) (Entered: 02/18/2(
☐	Runner	02/23/2005	48	MOTION by ROXIO, INC., NAPSTER, L.L.C. to Seal Supplemental Declaration of Ch Proposed Order. (tt) (Entered: 02/23/2005)
☐	Runner	02/23/2005	49	OPPOSITION by SIGHTSOUND TECH to defts' [48-1] motion to Seal Supplemental Christopher Reese (tt) (Entered: 02/24/2005)
☐	Runner	02/28/2005	--	ORDER upon motion granting [48-1] motion to Seal Supplemental Declaration of C The Supplemental Declaration of Christopher Reese filed 2/17/05 shall be placed u Chief Judge Donetta W. Ambrose on 2/28/05) CM all parties of record. (tt) (Enter
☐	Runner	02/28/2005	50	MEMORANDUM OPINION & ORDER granting defts' [22-1] motion to Stay. The defts Court immediately upon receiving any notification from the PTO regarding the outc for Reexamination. The preliminary injunction hearing scheduled for 3/3/05 is can motion for Preliminary Injunction is denied without prejudice to reassert once the s by Chief Judge Donetta W. Ambrose on 2/28/05) CM all parties of record. (tt) (En
☐	Runner	03/03/2005	51	NOTICE OF APPEAL by SIGHTSOUND TECH from [50-1] memorandum opinion date FEE $ 255 RECEIPT # 2394 TPO issued. (lck) (Entered: 03/07/2005)
☐	Runner	03/03/2005	--	Certified copy of Notice of Appeal [51-1] appeal by SIGHTSOUND TECH , certified certified copy of order dated 2/28/05 mailed to USCA; copy of Notice of Appeal an ROXIO, INC., NAPSTER, L.L.C. and judge. Copy of information sheet to appellant. 03/07/2005)
☐	Runner	03/11/2005	52	Transcript Purchase order re: [51-1] appeal by SIGHTSOUND TECH indicating that ordered. (tt) (Entered: 03/11/2005)
☐	Runner	03/21/2005	--	Text not available. (Entered: 03/21/2005)
☐	Runner	04/04/2005	53	NOTICE of PTO's Order granting ex parte Reexamination by ROXIO, INC., NAPSTEI (Entered: 04/04/2005)
☐	Online	07/21/2005	54	MOTION for Relief from Stay with Respect to Defamation Counterclaims by SIGHTS TECHNOLOGIES, INC., SCOTT SANDER. (Attachments: # 1 Proposed Order)(jsp) (07/21/2005)
☐	Online	07/21/2005	55	BRIEF in Support re 54 MOTION for Relief from Stay with Respect to Defamation C SIGHTSOUND TECHNOLOGIES, INC., SCOTT SANDER. (Attachments: # 1 Part 2 of 07/21/2005)
☐	Online	07/22/2005	56	NOTICE: re 54 MOTION for Relief from Stay with Respect to Defamation Counterc on or before 8/4/05. (jlh) (Entered: 07/22/2005)
☐	Online	08/04/2005	57	NOTICE by ROXIO, INC., NAPSTER, L.L.C. of PTO's Issuance of Office Actions in Ex

				(Attachments: # 1 # 2 # 3)(Helmsen, Joseph) (Entered: 08/04/2005)
☐	Online	08/04/2005	58	MOTION for attorney Michael T. Zeller to Appear Pro Hac Vice by ROXIO, INC., NAI (Attachments: # 1 Proposed Order)(Kenyon, Kathryn) (Entered: 08/04/2005)
☐	Online	08/04/2005	59	NOTICE by ROXIO, INC., NAPSTER, L.L.C. re 57 Notice (Other) Letter Notice of Pri Kathryn) (Entered: 08/04/2005)
☐	Online	08/04/2005	60	BRIEF in Opposition re 54 MOTION for Relief from Stay with Respect to Defamatior by ROXIO, INC., NAPSTER, L.L.C.. (Attachments: # 1 Exhibit A# 2 Exhibit B# 3 Ex 5 Exhibit E# 6 Exhibit F# 7 Exhibit G# 8 Exhibit H)(Kenyon, Kathryn) (Entered: 08
☐	Runner	08/04/2005	--	Pro Hac Vice Fees received in the amount of $ 40 receipt # 4877 re 58 Motion to A (ept) (Entered: 08/05/2005)
☐	Online	08/08/2005	61	ORDER granting 58 Motion to Appear Pro Hac Vice . Signed by Judge Donetta W. A (jlh) (Entered: 08/08/2005)
☐	Online	09/01/2005	62	ORDER denying 54 Motion for Relief from Stay . Signed by Judge Donetta W. Ambi (jlh) (Entered: 09/01/2005)
☐	Online	09/06/2005	63	NOTICE by SIGHTSOUND TECHNOLOGIES, INC., SCOTT SANDER NOTICE OF FILIN RECORD (Kerr, Benjamin) (Entered: 09/06/2005)
☐	Online	09/07/2005	64	Minute Entry for proceedings held before Judge Donetta W. Ambrose : Status Conf 9/7/2005. Parties to keep Court informed of PTO Action. (jlh) (Entered: 09/07/20
☐	Online	11/02/2005	65	NOTICE by ROXIO, INC., NAPSTER, L.L.C. of PTO's Issuance of Second Office Actic Reexamination (Attachments: # 1 Exhibit A# 2 Exhibit B# 3 Exhibit C)(Kenyon, Ka 11/02/2005)
☐	Online	11/14/2005	66	MANDATE of USCA for the Federal Circuit as to [51] Notice of Appeal filed by SIGH TECHNOLOGIES, INC., that the appeal is dismissed, with each party to bear its ow (Entered: 11/15/2005)
☐	Online	03/02/2006	67	MOTION by Clyde E. Findley to Withdraw as Attorney by SIGHTSOUND TECHNOLO (Entered: 03/02/2006)

Retrieve Document(s)

586391 (07) 5191573 March 2, 1993

UNITED STATES PATENT AND TRADEMARK OFFICE GRANTED PATENT

5191573

March 2, 1993

Method for transmitting a desired digital video or audio signal

REEXAM-LITIGATE: January 31, 2005 - Reexamination requested by Napster, Inc.; c/o Albert S. Penilla, Martine, Penilla & Gencarella, LLP, Reexamination No. 90/007,402 (O.G. March 29, 2005) Ex. Gp: 2655

NOTICE OF LITIGATION

Sightsound Technologies, Inc., a Delaware corporation v. Roxio, Inc., a Delaware corporation, et al, Filed October 8, 2004, D.C. W.D. Pennsylvania (Pittsburgh), Doc. No. 04-CV-1549

INVENTOR: Hair, Arthur R. - 301 Oaklawn Dr., Pittsburgh, Pennsylvania, United States (US), 15241

CERT-CORRECTION: December 21, 1993 - a Certificate of Correction was issued for this Patent

APPL-NO: 586391 (07)

FILED-DATE: September 18, 1990

GRANTED-DATE: March 2, 1993

ASSIGNEE-AFTER-ISSUE: October 2, 1995 - ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS)., PARSEC SIGHT/SOUND, INC. 1518 ALLISON DRIVE UPPER ST. CLAIR PENNSYLVANIA 15241, Reel and Frame Number: 07656/0701
May 3, 2000 - CHANGE OF NAME (SEE DOCUMENT FOR DETAILS)., SIGHTSOUND.COM INCORPORATED 733 WASHINGTON ROAD, SUITE 400 MT. LEBANON PENNSYLVANIA 15228, Reel and Frame Number: 10776/0703
October 24, 2001 - NOTICE OF GRANT OF SECURITY INTEREST, D&DF WATERVIEW PARTNERS, L.P. ONE STERLING PLAZA 152 WEST 57TH STREET, 46TH FLOOR NEW YORK NEW YORK 10019; KENYON & KENYON ONE BROADWAY NEW YORK NEW YORK 10004; SCHWARTZ, ANSEL M. ONE STERLING PLAZA 201 N. CRAIG STREET, SUITE 304 PITTSBURGH PENNSYLVANIA 15213; WATERVIEW PARTNERS, LLP ONE STERLING PLAZA 152 WEST 57TH STREET, 46TH FLOOR NEW YORK NEW YORK 10019, Reel and Frame Number: 12506/0415

LEGAL-REP: Schwartz, Ansel M.

PUB-TYPE: March 2, 1993 - Utility Patent having no previously published pre-grant publication (A)

PUB-COUNTRY: United States (US)

REL-DATA:
Continuation of Ser. No. 07/206497, June 13, 1988, ABANDONED

US-MAIN-CL: 369#84

US-ADDL-CL: 235#380, 235#381, 369#15, 369#85

CL: 369, 235, 369

SEARCH-FLD: 369#33, 369#34, 369#13, 369#15, 369#84, 369#85, 235#380, 235#381, 235#375, 364#479, 364#410

IPC-MAIN-CL: 5G 11B005#86

IPC-ADDL-CL: G 11B007#0, G 11B011#0

PRIM-EXMR: Nguyen, Hoa

REF-CITED:
03718906, February, 1973, Lightner, United States (US), 235381
03990710, November, 1976, Hughes, United States (US), 369034
04567359, January, 1986, Lockwood, United States (US), 235381
04647989, March, 1987, Geddes, United States (US), 235381
04654799, March, 1987, Ogaki et al., United States (US), 364479

CORE TERMS: user, song, music, memory, electronically, stored, digital, hardware, hard disk, electronic ...

ENGLISH-ABST:

The present invention is a method for transmitting a desired digital video or audio signal stored on a first memory of a first party to a second memory of a second party. The method comprises the steps of transferring money via a telecommunications line to the first party from the second party. Additionally, the method comprises the step of then connecting electronically via a telecommunications line the first memory with the second memory such that the desired signal can pass therebetween. Next, there is the step of transmitting the desired digital signal from the first memory with a transmitter in control and in possession of the first party to a receiver having the second memory at a location determined by the second party. The receiver is in possession and in control of the second party. There is also the step of then storing the digital signal in the second memory.

NO-OF-CLAIMS: 6

EXMPL-CLAIM: 1

NO-OF-FIGURES: 2

NO-DRWNG-PP: 2

SUMMARY:

FIELD OF THE INVENTION

The present invention is related to a method for the electronic sales and distribution of digital audio or video signals, and more particularly, to a method which a user may purchase and receive digital audio or video signal from any location which the user has access to a telecommunications line.

BACKGROUND OF THE INVENTION

The three basic mediums (hardware units) of music: records, tapes, and compact discs, greatly restricts the transferability of music and results in a variety of inefficiencies.

CAPACITY: The individual hardware units as cited above are limited as to the amount of music that can be stored on each.

MATERIALS: The materials used to manufacture the hardware units are subject to damage and deterioration during normal operations, handling, and exposure to the elements.

SIZE: The physical size of the hardware units imposes constraints on the quantity of hardware units which can be housed for playback in confined areas such as in automobiles, boats, planes, etc.

RETRIEVAL: Hardware units limit the ability to play, in a sequence selected by the user, songs from different albums. For example, if the user wants to play one song from ten different albums, the user would spend an inordinate amount of time handling, sorting, and cueing the ten different hardware units.

SALES AND DISTRIBUTION: Prior to final purchase, hardware units need to be physically transfered from the manufacturing facility to the wholesale warehouse to &:he retail warehouse to the retail outlet, resulting in lengthly, lag time between music creation and music marketing, as well as incurring unnessary and inefficient transfer and handling costs. Additionally, tooling costs required for mass production of the hardware units and the material cost of the hardware units themselves, further drives up the cost of music to the end user.

QUALITY: Until the recent invention of Digital Audio Music, as used on Compact Discs, distortion free transfer from the hardware units to the stereo system was virtually impossible. Digital Audio Music is simply music converted into a very basic computer language known as binary. A series of commands known as zeros or ones encode the music for future playback. Use of laser retrieval of the binary commands results in distortion free transfer of the music from the compact disc to the stereo system. Quality Digital Audio Music is defined as the binary structure of the Digital Audio Music. Conventional analog tape recording of Digital Audio Music is not to be considered quality inasmuch as the binary structure itself is not recorded. While Digital Audio Music on compact discs is a technological breakthrough in audio quality, the method by which the music is sold, distributed, stored, manipulated, retrieved, played and protected from copyright infringements remains as inefficient as with records and tapes.

COPYRIGHT PROTECTION: Since the invention of tape recording devices, strict control and enforcement of copyright laws have proved difficult and impossible with home recorders. Additionally, the recent invention of Digital Audio Tape Recorders now jeopardizes the electronic copyright protection of quality Digital Audio Music on Compact Discs or Digital Audio Tapes. If music exists on hardware units, it can be copied.

Accordingly, it is an objective of this invention is to provide a new and improved methodology/system to electronically sell and distribute Digital Audio Music.

A further objective of this invention to provide a new and improved methodology/system to electronically store and retrieve Digital Audio Music.

Another objective of this invention is to provide a new and improved methodology/system to electronically manipulate, i.e., sort, cue, and select, Digital Audio Music for playback.

Still another objective of this invention is to offer a new and improved methodology/system which can prevent unauthorized electronic copying of quality Digital Audio Music.

SUMMARY OF THE INVENTION

Briefly, this invention accomplishes the above cited objectives by providing a new and improved methodology/system of electronic sales, distribution, storage, manipulation, retrieval, playback, and copyright protection of Digital Audio Music. The high speed transfer of Digital Audio Music as prescribed by this invention is stored onto one piece of hardware, a hard disk, thus eliminating the need to unnecessarily handle records, tapes, or compact discs on a regular basis. This invention recalls stored music for playback as selected/programmed by the user. This invention can easily and electronically sort stored music based on many different criteria such as, but not limited to, music category, artist, album, user's favorite songs, etc. An additional feature of this invention is the random playback of songs, also based on the user's selection. For example, the user could have this invention randomly play all jazz songs stored on the user's hard disk, or randomly play all songs by a certain artist, or randomly play all of the user's favorite songs which the user previously electronically "tagged" as favorites. Further, being more specific, the user can electronically select a series of individual songs from different albums for sequential playback.

This invention can be configured to either accept direct input of Digital Audio Music from the digital output of a Compact Disc, such transfer would be performed by the private user, or this invention can be configured to accept Digital Audio Music from a source authorized by the copyright holder to sell and distribute the copyrighted materials, thus guaranteeing the protection of such copyrighted materials. Either method of electronically transfering Digital Audic Music by means of this invention is intended to comply with all copyright laws and restrictions and any such transfer is subject to the appropriate authorization by the copyright holder. Inasmuch as Digital Audio Music is software an this invention electronically transfers and stores such music, electronic sales and distribution of the music can take place via telephone lines onto a hard disk. This new methodology/system of music sales and distribution will greatly reduce the cost of goods sold and will reduce the lag time between music creation and music marketing from weeks down to hours.

The present invention is a method for transmitting a desired digital video or audio signal stored on a first memory of a first party to a second memory of a second party. The method comprises the steps of transferring money via a telecommunications line to the first party from the second party. Additionally, the method comprises the step of then connecting electronically via a telecommunications line the first memory with the second memory such that the desired digital signal can pass therebetween. Next, there is the step of transmitting the desired digital signal from the first memory with a transmitter in control and in possession of the first party to a receiver having the second memory at a location determined by the second party. The receiver is in possession and in control of the second party. There is also the step of then storing the digital signal in the second memory.

Further objectives and advantages of this invention will become apparent as the following description proceeds and the particular features of novelty which characterize this invention will be pointed out in the claims annexed to and forming a part of this declaration.

DRWDESC:

BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF DRAWINGS

For a better understanding of this invention, reference should be made to the following detailed description, taken in conjunction with the accompanying drawings, in which:

FIG. 1 is a pictorial flow chart which may be used in carrying out the teachings of this invention for the purposes of electronic sales, distribution, storage, manipulation, retrieval, playback, and copyright protection of Digital Audio Music; and

FIG. 2 is a pictorial flow chart which may be used in carrying out the teachings of this invention for the purposes of electronic storage, manipulation, retrieval, and playback of Digital Audio Music.

DETDESC:

DESCRIPTION OF THE PREFERRED EMBODIMENT

Referring now to the FIG. 1, this invention is comprised of the following:

10 Hard Disk of the copyright holder

20 Control Unit of the copyright holder

20a Control Panel

20b Control Integrated Circuit

20c Sales Random Access Memory Chip

30 Telephone Lines/Input Transfer

50 Control Unit of the user

50a Control Panel

50b Control Integrated circuit

50c Incoming Random Access Memory Chip

50d Play Back Random Access Memory Chip

60 Hard Disk of the user

70 Video Display Unit

80 Stereo Speakers

The Hard Disk 10 of the agent authorized to electronically sell and distribute the copyrighted Digital Audio Music is the originating source of music in the configuration as outlined in FIG. 1. The Control Unit 20 of the authorized agent is the means by which the electronic transfer of the Digital Audio Music from the agent's Hard Disk 10 via the Telephone Lines 30 to the user's Control Unit 50 is possible. The user's Control Unit would be comprised of a Control Panel 50a, a Control Integrated Circuit 50b, an Incoming Random Access Memory Chip 50c, and a Play Back Random Access Memory Chip 50d. Similarly, the authorized agent's Control Unit 20 would have a control panel and control integrated circuit similar to that of the user's Control Unit 50. The authorized agent's Control Unit 20, however, would only require the Sales Random Access Memory Chip 20c. The other components in FIG. 1 include a Hard Disk 60, a Video (display Unit 70, and a set of Stereo Speakers 80.

Referring now to FIG. 2, with the exception of a substitution of a Compact Disc Player 40 (as the initial source of Digital Audio Music) for the agent's Hard Disk 10, the agent's Control Unit 20, and the Telephone Lines 30 in FIG. 1, FIG. 2 is the same as FIG. 1.

In FIG. 1 and FIG. 2, the following components are already commercially available: the agent's Hard Disk 10, the Telephone Lines 30, the Compact Disc Player 40, the user's Hard Disk 60, the Video Display Unit 70, and the Stereo Speakers 80. The Control Units 20 and 50, however, would be designed specifically to meet the teachings of this invention. The design of the control units would incorporate the following functional features:

1) the Control Panels 20a and 50a would be designed to permit the agent and user to program the respective Control Integrated Circuits 20b and 50b,

2) the Control Integrated Circuits 20b and 50b would be designed to control and execute the respective commands of the agent and user and regulate the electronic transfer of Digital Audio Music throughout the system, additionally, the sales Control Integrated Circuit 20b could electronically code the Digital Audio Music in a configuration which would prevent unauthorized reproductions of the copyrighted material,

3) the Sales Random Access Memory Chip 20c would be designed to temporarily store user purchased Digital Audio Music for subsequent electronic transfer via telephone lines to the user's Control Unit 50,

4) the Incoming Random Access Memory Chip 50c would be designed to temporarily store Digital Audio Music for subsequent electronic storage to the user's Hard Disk 60,

5) the Play Back Random Access Memory Chip 50d would be designed to temporarily store Digital Audio Music for sequential playback.

The foregoing description of the Control Units 20 and 50 is intended as an example only and thereby is not restrictive with respect to the exact number of components and/or its actual design.

Once the Digital Audio Music has been electronically stored onto the user's Hard Disk 60, having the potential to store literally thousands of songs, the user is free to perform the many functions of this invention. To play a stored song, the user types in the appropriate commands on the Control Panel 50a, and those commands are relayed to the Control Integrated Circuit 50b which retrieves the selected song from the Hard Disk 60. When a song is retrieved from the Hard Disk 60 only a replica of the permanently stored song is retrieved. The permanently stored song remains intact on the Hard Disk 60, thus allowing repeated playback. The Control Integrated Circuit 50b stores the replica onto the Play Back Random Access Memory Chip 50d at a high transfer rate. The Control Integrated Circuit 50b then sends the electronic output to the Stereo Speakers 80 at a controlled rate using the Play Back Random Access Memory Chip 50d as a temporary staging point for the Digital Audio Music.

Unique to this invention is that the Control Unit 50 also serves as the user's personal disk jocky. The user may request specific songs to be electronically cued for playback, or may request the Control Unit 50 to randomly select songs based on the user's criteria. All of these commands are electronically stored in random access memory enabling the control unit to remember prior commands while simultaneously performing other tasks requested by the user and, at the same &time, continuing to play songs previously cued.

Offering a convenient visual display of the user's library of songs is but one more new and improved aspect of this invention. As the Control Unit 50 is executing the user's commands to electronically sort, select, randomly play, etc., the Video Display Screen 70 is continually providing feedback to the user. The Video Display Screen 70 can list/scroll all songs stored on the Hard Disk 60, list/scroll all cued songs, display the current command function selected by the user, etc. Further expanding upon the improvements

this invention has to offer, the Video Display Screen 70 can display the lyrics of the song being played, as well as the name of the song, album, artist, recording company, date of recording, duration of song, etc. This is possible if the lyrics and other incidental information are electronically stored to the Hard Disk 60 with the Digital Audio Music.

The present invention is a method for transmitting a desired digital video or audio signal stored on a first memory of a first party to a second memory of a second party. The method comprises the steps of transferring money via a telecommunications line to the first party from the second party. Additionally, the method comprises the step of then connecting electronically via a telecommunications line the first memory with the second memory such that the desired digital signal can pass therebetween. Next, there is the step of transmitting the desired digital signal from the first memory with a transmitter in control and in possession of the first party to a receiver having the second memory at a location determined by the second party. The receiver is in possession and in control of the second party. There is also the step of then storing the digital signal in the second memory.

In summary, there has been disclosed a new and improved methodology/system by which Digital Audio Music can be electronically sold, distributed, transferred, and stored. Further, there has been disclosed a new and improved methodology/system by which Digital Audio Music can be electronically manipulated, i.e., sorted, cued, and selected for playback. Further still, there has beer disclosed a new and improved methodology/system by which the electronic manipulation of Digital Audio Music can be visually displayed for the convenience of the user. Additionally, there has been disclosed a new and improved methodology/system by which electronic copyright protection of quality Digital Audio Music is possible through use of this invention.

Since numerous changes may be made in the above described process and apparatus and different embodiments of the invention may be made without departing from the spirit thereof, it is intended that all matter contained in the foregoing description or shown in the accompanying drawings shall be interpreted as illustrative, and not in a limiting sense. Further, it is intended that this invention is not to be limited to Digital Audio Music and can include Digital Video, Digital Commercials, and other applications of digital information.

ENGLISH-CLAIMS:
Return to Top of Patent

I claim:

1. A method for transmitting a desired digital audio signal stored on a first memory of a first party to a second memory of a second party comprising the steps of:

transferring money electronically via a telecommunication lien to the first party at a location remote from the second memory and controlling use of the first memory from the second party financially distinct from the first party, said second party controlling use and in possession of the second memory;

connecting electronically via a telecommunications line the first memory with the second memory such that the desired digital audio signal can pass therebetween;

transmitting the desired digital audio signal from the first memory with a transmitter in control and possession of the first party to a receiver having the second memory at a location determined by the second party, said receiver in possession and control of the second party; and

storing the digital signal in the second memory.

2. A method as described in claim 1 including after the transferring step, the steps of

searching the first memory for the desired digital audio signal; and selecting the desired digital audio signal from the first memory.

3. A method as described in claim 2 wherein the transferring step includes the steps of telephoning the first party controlling use of the first memory by the second party; providing a credit card number of the second party controlling the second memory to the first party controlling the first memory so the second party is charged money.

4. A method for transmitting a desired digital video signal stored on a first memory of a first party to a second memory of a second party comprising the steps of:

transferring money electronically via a telecommunications line to the first party at a location remote from the second memory and controlling use of the first memory, from a second party financially distinct from the first party, said second party in control and in possession of the second memory;

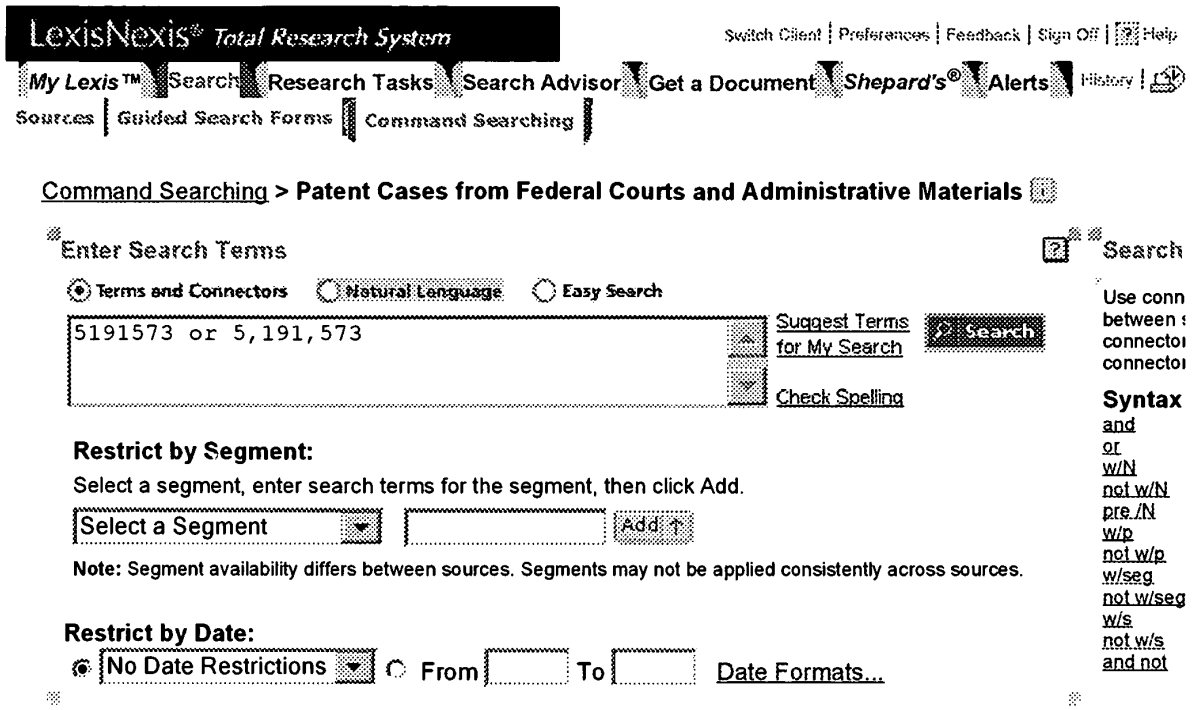
connecting electronically via a telecommunications line the first memory with the second memory such that the desired digital video signal can pass therebetween;

transmitting the desired digital video signal from the first memory with a transmitter in control and possession of the first party to a receiver having the second memory at a location determined by the second party, said receiver in possession and control of the second party; and

storing the digital signal in the second memory.

5. A method as described in claim 4 including after the transferring money step, the step of searching the first memory for the desired digital signal and selecting the desired digital signal from the first memory.

6. A method as described in claim 5 wherein the transferring step includes the steps of telephoning the first party controlling use of the first memory by the second party controlling the second memory; providing a credit card number of the second party controlling the second memory to the first party controlling the first memory so the second party controlling the second memory is charged money.



Source: Command Searching > **Patent Cases from Federal Courts and Administrative Materials**
Terms: **5191573 or 5,191,573** (Edit Search | Suggest Terms for My Search)

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1. Sightsound.com, Inc. v. N2K, Inc., Civil Action No. 98-0118 , UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF PENNSYLVANIA , 391 F. Supp. 2d 321; 2003 U.S. Dist. LEXIS 25503, October 23, 2003, Decided

   OVERVIEW: Defendant was denied summary judgment on claims of patent invalidity; earlier patent described only "possibility" of use of unit in way that anticipated use of patent-in-suit, not the required "necessity," and fact question existed as to obviousness.

   CORE TERMS: patent, digital, signal, invention, music, summary judgment, license, audio, sightsound, consumer ...

   ... United States Patent No. **5,191,573** ("the '573 Patent") to Mr. ...

2. Sightsound.com Inc. v. N2k, Inc., Civil Action No. 98-118 , UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF PENNSYLVANIA , 185 F. Supp. 2d 445; 2002 U.S. Dist. LEXIS 6828, February 8, 2002, Decided

   OVERVIEW: In an action involving patents which were directed to commercially-acceptable systems and methods for selling music and video in digital form over telecommunications lines, the judge made several recommendations regarding claim construction.

   CORE TERMS: digital, patent, memory, signal, telecommunication, audio, electronically, specification, desired, telephone ...

   ... S. Patent Nos. **5,191,573** ("the '573 Patent"), 5,675,734 ("the ' ...

Source: Command Searching > **Patent Cases from Federal Courts and Administrative Materials**
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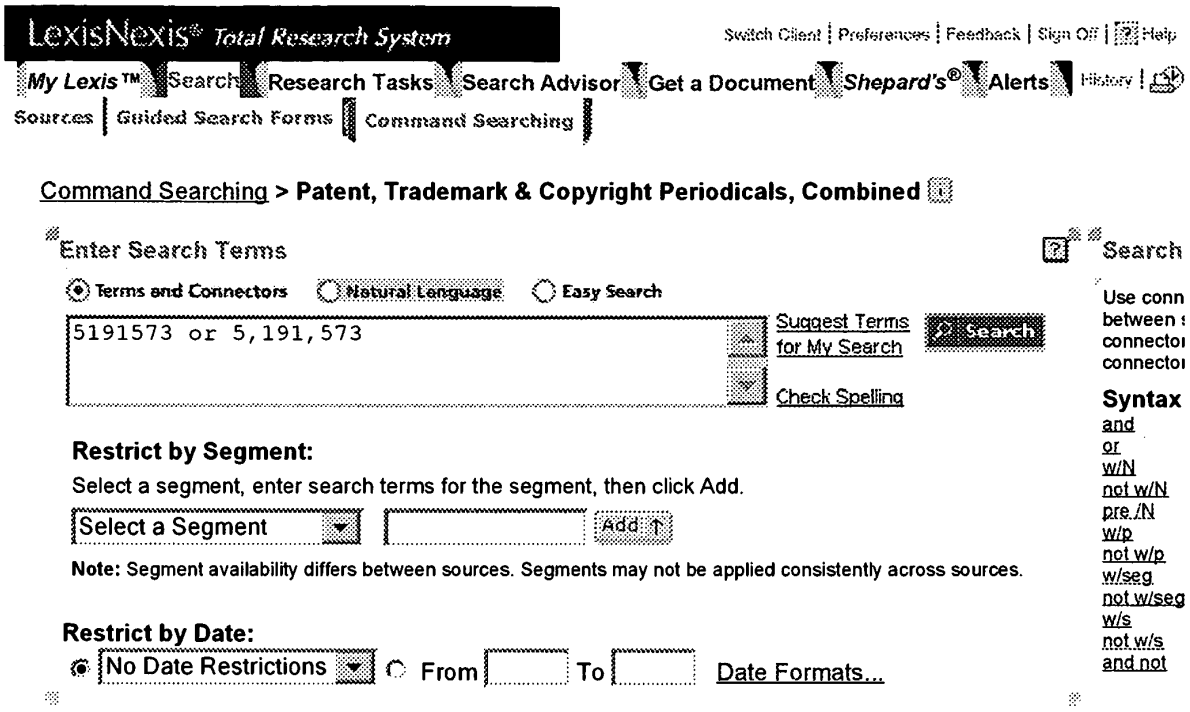

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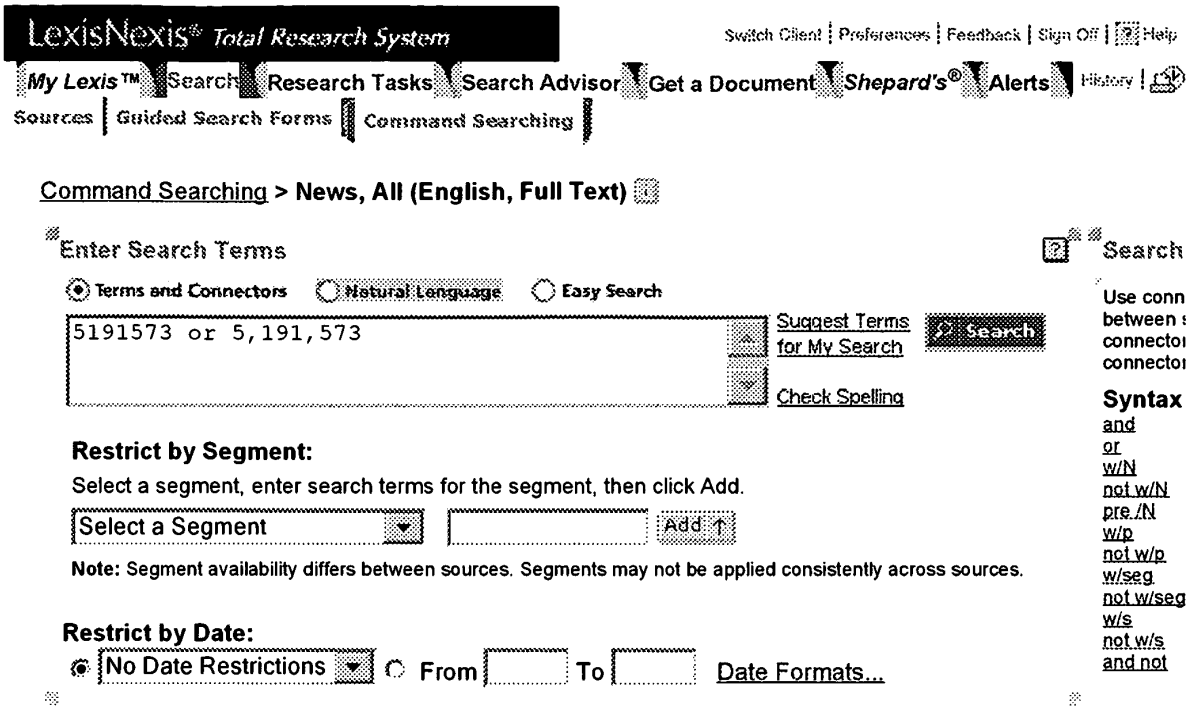

Source: Command Searching > **News, All (English, Full Text)**
Terms: **5191573 or 5,191,573** (Edit Search | Suggest Terms for My Search)

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1. Intellectual Property Today, April, 2004, INTERNETINFO.COLUMN; Pg. 49, 718 words, Will the Price of Music Downloads Include Patent License Fees?, BY W. SCOTT PETTY; Scott Petty, a Patent Attorney with King & Spalding, focuses on intellectual property issues for computer software, telecommunications and e-commerce companies. Scott can be contacted by telephone at 404.572.2888 or via e-mail at spetty@kslaw.com.
... U.S. Patent Nos. **5,191,573** and 5,675,734, which date back to ...

2. Rutgers Computer & Technology Law Journal, March 22, 2002, No. 1, Vol. 28; Pg. 61; ISSN: 0735-8938, 24588 words, The multiple unconstitutionality of business method patents: common sense, congressional consideration, and constitutional history., Pollack, Malla
... U.S. Patent No. **5,191,573** (issued Mar. 2 ...

3. Canadian Press Newswire, September 4, 2001, S 4'01, 5191573, 81 words, Trio of alleged drug-smugglers from Montreal elect trial by judge alone

4. Canadian Press Newswire, September 4, 2001, S 4'01, 5191573, 81 words, Trio of alleged drug-smugglers from Montreal elect trial by judge alone (Record in progress)

5. The Toronto Sun, May 19, 2000, Friday,, Final EDITION, NEWS,, Pg. 32, 174 words, KILLER INSULTS VICTIM'S KIN, ALAN CAIRNS, TORONTO SUN, BARRIE

6. The National Law Journal, November 22, 1999, Monday, PATENT LAW; Pg. B9, 2106 words, Business methods, Bradley C. Wright; Mr. Wright is a shareholder and registered patent attorney at Washington, D.C.'s Banner & Witcoff Ltd. He can be reached at wright@bannerwitcoff.com.
... method (Patent No. **5,191,573,** titled "Method for ...

7. Mondaq Business Briefing - Hale and Dorr LLP, US, November 3, 1999, 02275027, 2096 words, US: Business Methods Patents - The Effects Of State Street On Electronic Commerce And The Internet, Alter, Scott M
... 7. Patent number **5,191,573** and 5,675,734 ...

8. The National Law Journal, October 25, 1999, Monday, INTELLECTUAL PROPERTY; Focus on Patent; Pg. C8, 2014 words, 'State Street' sets stage for new patents, battles, BY SCOTT M. ALTER, SPECIAL TO THE NATIONAL LAW JOURNAL; Mr. Alter is a partner in the Washington, D.C., office of Boston's Hale and Dorr L.L.P.
... n6 Patent nos. **5,191,573** and 5,675,734. Sightsound.com has been ...

9. The Computer Lawyer, October, 1999, PATENT; Vol. 16, No. 10; Pg. 3, 11742 words, What the General Intellectual Property Practitioner Should Know about Patenting Business Methods, by David L. Hayes; David L. Hayes is a partner and is Chairman of the Intellectual Property Practice Group at Fenwick & West in Palo Alto. CA. Copyright © 1999 Fenwick & West LLP.
... terms of the matched coupons. **5,191,573** Title: "Method for ...
... US Pat. No. **5,191,573** described above. Enforcement: ...
... Sightsound.com asserted this and the **5,191,573** patent above against ...

10. Salon.com, March 9, 1999 Tuesday, Feature, 2469 words, How can they patent that?, By Peter Wayner
... eyes. Or consider patents **5191573** and 5675734, created by ...
... N2K, is evaluating what patents **5191573** and 5675734 mean to his company's ...

Source: Command Searching > **News, All (English, Full Text)**
Terms: **5191573 or 5,191,573** (Edit Search | Suggest Terms for My Search)
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PTOL-413A (09-04)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Applicant Initiated Interview Request Form

Application No.: 90,007,402; 90/007,403; 90/007,407 First Named Applicant: Arthur Hair
Examiner: Benjamin Lanier Art Unit: _____ Status of Application: Reexamination

Tentative Participants:
(1) Kenneth Glick (2) ~~James DiGiorgio~~ Michael R. Casey
(3) Robert Koons (4) Examiner Lanier

Proposed Date of Interview: April 19, 2006 **Proposed Time:** 2:00PM **(AM/PM)**

Type of Interview Requested:
(1) [ ] Telephonic (2) [X] Personal (3) [ ] Video Conference

Exhibit To Be Shown or Demonstrated: [ ] YES [X] NO
If yes, provide brief description: _____

Issues To Be Discussed

Issues (Rej., Obj., etc)	Claims/ Fig. #s	Prior Art	Discussed	Agreed	Not Agreed
(1) Allowed	69-71 77-79 65-68	N/A	[ ]	[ ]	[ ]
(2) Obj.	73-76	N/A	[ ]	[ ]	[ ]
(3) Rej.	All	All	[ ]	[ ]	[ ]
(4) Proposed	New Claims		[ ]	[ ]	[ ]

[ ] Continuation Sheet Attached

Brief Description of Arguments to be Presented:
See attached

An interview was conducted on the above-identified application on 4/19/06.
NOTE: This form should be completed by applicant and submitted to the examiner in advance of the interview (see MPEP § 713.01).
This application will not be delayed from issue because of applicant's failure to submit a written record of this interview. Therefore, applicant is advised to file a statement of the substance of this interview (37 CFR 1.133(b)) as soon as possible.

Applicant/Applicant's Representative Signature — Examiner/SPE Signature

Robert A. Koons, Jr.
Typed/Printed Name of Applicant or Representative

32,474
Registration Number, if applicable

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,407	01/31/2005	5966440	NAPSP003	4782

23973 7590 04/21/2006

DRINKER BIDDLE & REATH
ATTN: INTELLECTUAL PROPERTY GROUP
ONE LOGAN SQUARE
18TH AND CHERRY STREETS
PHILADELPHIA, PA 19103-6996

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 04/21/2006

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

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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Albert S. Penilla
MARTINE PENILLA & GENCARELLA, LLP
710 Lakeway Drive, Suite 200
Sunnyvale, CA 94085

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/007,407*.

PATENT NO. *5966440*.

ART UNIT *2132*.

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)).

/

PTOL-465 (Rev.07-04)

Ex Parte Reexamination Interview Summary	Control No.	Patent Under Reexamination	
	90/007,407	5966440	
	Examiner	Art Unit	
	Benjamin E. Lanier	2132	

All participants (USPTO personnel, patent owner, patent owner's representative):

(1) *Benjamin E. Lanier*

(2) *Kenneth Glick*

(3) *Robert Koons*

(4) *Michael R. Casey*

Date of Interview: *19 April 2006*

Type: a)☐ Telephonic b)☐ Video Conference
c)☒ Personal (copy given to: 1)☐ patent owner 2)☐ patent owner's representative)

Exhibit shown or demonstration conducted: d)☐ Yes e)☒ No.
If Yes, brief description: _____

Agreement with respect to the claims f)☐ was reached. g)☐ was not reached. h)☒ N/A.
Any other agreement(s) are set forth below under "Description of the general nature of what was agreed to..."

Claim(s) discussed: *1,64,65 and 69*.

Identification of prior art discussed: *Mr. Koons discussed the claim limitations that were previously indicated as allowable and asked Examiner to explain the rationale behind the indication of allowability. Examiner provided rationale for the indication and Mr. Koons discusses possible amending the claims to include the allowable subject matter.*

Description of the general nature of what was agreed to if an agreement was reached, or any other comments:
_____

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims patentable, if available, must be attached. Also, where no copy of the amendments that would render the claims patentable is available, a summary thereof must be attached.)

A FORMAL WRITTEN RESPONSE TO THE LAST OFFICE ACTION MUST INCLUDE PATENT OWNER'S STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. (See MPEP § 2281). IF A RESPONSE TO THE LAST OFFICE ACTION HAS ALREADY BEEN FILED, THEN PATENT OWNER IS GIVEN **ONE MONTH** FROM THIS INTERVIEW DATE TO PROVIDE THE MANDATORY STATEMENT OF THE SUBSTANCE OF THE INTERVIEW (37 CFR 1.560(b)). THE REQUIREMENT FOR PATENT OWNER'S STATEMENT CAN NOT BE WAIVED. **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

cc: Requester (if third party requester)

Examiner's signature, if required

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DRINKER BIDDLE & REATH
Attn: INTELLECTUAL PROPERTY GROUP
One Logan Square
18th and Cherry Streets
Philadelphia, PA 19103-6996

(For Patent Owner)

MAILED

MAY 15 2006

REEXAM UNIT

Albert S. Panilla
MARTINE PENILLA & GENCARELLA, LLP
710 Lakeway Drive, Suite 200
Sunnyvale, CA 94085

(For Requester)

DECISION, *SUA SPONTE*,
TO VACATE
REEXAMINATION OFFICE
ACTION

In re Arthur R. Hair
Ex Parte Reexamination Proceeding
Control No. 90/007,402
Filed: January 31, 2005
For: US Patent No. 5,191,573

The above captioned reexamination is before the Central Reexamination Unit for Consideration, *sua sponte*, whether to vacate the Office action made Final dated March 20, 2006.

REVIEW OF FACTS

1. U. S. Patent No. 5,191,573 issued on March 2, 1993.

2. A request was filed by a third party requester for reexamination of US Patent No. 5,191,573 on January 31, 2005.

3. The Order granting reexamination is dated March 18, 2005.

4. Non-final Office actions were mailed on June 21, 2005 and October 26, 2005 respectively.

6. A final Office action was mailed on March 20, 2006.

DISCUSSION REGARDING VACATING THE FINAL ACTION

MPEP 2271 is directed to final Office actions in *ex parte* reexamination proceedings and states as follows:

> Before a final action is in order, a clear issue should be developed between the examiner and the patent owner. To bring the prosecution to a speedy conclusion and at the same time deal justly with the patent owner and the public, the examiner will twice provide the patent owner with such information and references as may be useful in defining the position of the Office as to unpatentability before the action is made final. Initially, the decision ordering reexamination of the patent will contain an identification of the new questions of patentability that the examiner considers to be raised by the prior art considered. In addition, the first Office action will reflect the consideration of any arguments and/or amendments contained in the request, the owner's statement filed pursuant to 37 CFR 1.530, and any reply thereto by the requester, and should fully apply all relevant grounds of rejection to the claims.
>
> ...
>
> In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed and any grounds or rejection relied on should be reiterated. The grounds of rejection must (in the final rejection) be clearly developed to such an extent that the patent owner may readily judge the advisability of an appeal. However, where a single previous Office action contains a complete statement of a ground of rejection, the final rejection may refer to such a statement and also should include a rebuttal of anyarguments raised in the patent owner's response.

DECISION TO VACATE THE FINAL OFFICE ACTION

All pending reexamination proceedings which remained assigned to the USPTO Technology Centers were transferred from the USPTO Technology Centers into the Central Reexamination Unit (CRU) by May 2006.

As a result of the reassignment of the present proceeding to the CRU, and the facts specific to this proceeding, the Office is vacating the final Office action mailed on March 20, 2006 to permit a CRU panel review and further analysis of the issues. The newly assigned CRU examiner in charge will, in conjunction with a panel review, issue a new Office action .

The patent owner is relieved of the requirement to respond to the final Office action mailed on March 20, 2006, in view of that Office action being vacated.

CONCLUSION

1. By way of instant decision, the Office action mailed in reexamination proceeding 90/007,402 mailed March 20, 2006 is hereby *sua sponte* **vacated.**

2. Jurisdiction over the present proceeding is now forwarded to the newly assigned CRU examiner who is directed to issue a new Office action in due course.

3. No response is required on the part of the Patent Owner, either to the decision or the final Office action mailed on March 20, 2006, which has now been vacated.

4. Correspondence may be submitted as follows:

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

5. Telephone inquiries with regard to this decision should be directed to Mark Reinhart, Special Program Examiner in the Central Reexamination Unit, Art Unit 3992, at (571) 272-1611

/MReinhart/ SPRE-CRU-3992 for
Lissi M. Marquis,
Director,
Central Reexamination Unit

5/9/06

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	
ARTHUR R. HAIR	)	
	)	
Reexamination Control No. 90/007,402	)	
	)	
Reexamination Filed: January 31, 2005	)	METHOD FOR TRANSMITTING
	)	A DESIRED DIGITAL VIDEO OR
Patent Number: 5,191,573	)	AUDIO SIGNAL
	)	
Examiner: Roland G. Foster	)	

Mail Stop *Ex Parte* Reexamination
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

STATEMENT UNDER 37 C.F.R. §1.560(b)

At the Interview with Examiner Lanier on April 19, 2006, in Reexamination Control Nos. 90/007,402, 90/007,403 and 90/007,407, Applicant's counsel presented the following reasons as warranting favorable action in the pending Reexamination applications:

1. The rejections of the pending claims in all three Reexaminations under Section 103 are improper and should be withdrawn because the multiple references cited against those claims are not properly combinable, for all the reasons set forth in Applicant's response to the second office actions filed on December 27, 2005. For the same reasons, the objections to claims in Reexamination Control No. 90/007,407 also are improper.

2. In Reexamination Control No. 90/007,407, if Applicant were to add claims having limitations directed to specific types of tagging, those claims should be allowable to the extent such types of tagging are not shown or suggested by the prior art; and

3. Further in Reexamination Control No. 90/007,407, if Applicant were to add claims having a limitation directed to executing a command on audio or video signals stored in the second memory of Applicant's invention, those claims should be allowable to the extent the execution of such a command is not shown or suggested by the prior art.

Respectfully submitted,

DRINKER BIDDLE & REATH LLP

Robert A. Koons, Jr.
Registration No. 32,474

DRINKER BIDDLE & REATH LLP
One Logan Square
18th & Cherry Streets
Philadelphia, PA 19103-6996
Telephone: (215) 988-3392
Facsimile: (215) 988-2757

PHIP\517210\1

CERTIFICATE OF MAILING BY "EXPRESS MAIL" (37 CFR 1.10) Applicant(s): **Arthur R. Hair**			Docket No. **NAPS001**	
Application No. **90/007,402**	Filing Date **January 31, 2005**	Examiner **Roland G. Foster**	Customer No. **023973**	Group Art Unit

Invention: **METHOD FOR TRANSMITTING A DESIRED DIGITAL VIDEO OR AUDIO SIGNAL**

I hereby certify that the following correspondence:

Statement Under 37 C.F.R. Section 1.560(b); Post Card

(Identify type of correspondence)

is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

May 16, 2006
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Lisa Richardson
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Drinker Biddle & Reath LLP
One Logan Square
18th & Cherry Streets
Philadelphia, PA 19103

P06A/REV03

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing document was served via First Class United States Mail, postage prepaid, this 16th day of May, 2006, on the following:

Mr. Albert S. Penilla
Martine, Penilla, & Gencarella, LLP
710 Lakeway Drive, Suite 200
Sunnyvale, CA 94085
Attorney for Third Party Reexamination Requester

By: _____
Robert A. Koons, Jr.
Attorney for Patentee

05-25-06

Reexam
F
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	
ARTHUR R. HAIR	)	
	)	
Reexamination Control No. 90/007,402	)	
	)	
Reexamination Filed: January 31, 2005	)	METHOD FOR TRANSMITTING
	)	A DESIRED DIGITAL VIDEO OR
Patent Number: 5,191,573	)	DIGITAL AUDIO SIGNALS
	)	
Examiner: Roland G. Foster	)	

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PETITION UNDER 37 C.F.R. §1.137(b)

On July 13, 2005, then counsel of record for Patentee, Ansel M. Schwartz, conducted an in person Interview with the then examiner of record, Examiner Benjamin Lanier, in Reexamination Control Nos. 90/007,402, 90/007,403 and 90/007,407. Following the Interview, Mr. Schwartz did not file a formal Summary of Interview pursuant to 37 C.F.R. § 1.560(b). Current counsel of record for Patentee now submits the Summary of Interview along with the required fee under 37 C.F.R. § 1.137(b), and hereby respectfully petitions, as provided by 37 C.F.R. § 1.550(e)(2), to have the Office accept the Summary of Interview as having been unintentionally delayed after the period provided under 37 C.F.R. § 1.560(b).

In support of the instant Petition, current counsel of record for Patentee, after having made reasonable inquiry, hereby states that the entire delay in filing the Summary of Interview was unintentional.

PHIP\517780\1

Respectfully submitted,

DRINKER, BIDDLE & REATH LLP

Robert A. Koons, Jr.
Registration No. 32,474

DRINKER BIDDLE & REATH LLP
One Logan Square
18th & Cherry Streets
Philadelphia, PA 19103-6996
Telephone: (215) 988-3392
Facsimile: (215) 988-2757

PHIP\517780\1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	
ARTHUR R. HAIR	)	
	)	
Reexamination Control No. 90/007,402	)	
	)	
Reexamination Filed: January 31, 2005	)	METHOD FOR TRANSMITTING
	)	A DESIRED DIGITAL VIDEO OR
Patent Number: 5,191,573	)	DIGITAL AUDIO SIGNALS
	)	
Examiner: Roland G. Foster	)	

Mail Stop *Ex Parte* Reexamination
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

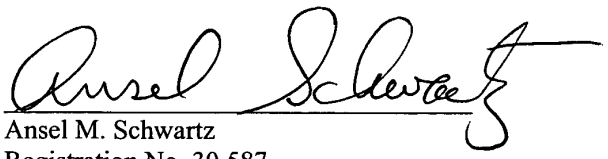
STATEMENT UNDER 37 C.F.R. §1.560(b)

On July 13, 2005, then counsel of record for Patentee, Ansel M. Schwartz, conducted an in person Interview with the then examiner of record, Examiner Benjamin Lanier, in Reexamination Control Nos. 90/007,402, 90/007,403 and 90/007,407. Following the Interview, Mr. Schwartz did not file a formal Summary of Interview pursuant to 37 C.F.R. § 1.560(b), which summary is now submitted herewith. Mr. Schwartz, as former counsel of record for Patentee, hereby declares that the entire delay in filing the current Summary of Interview was unintentional, and submits the following statement concerning the reasons presented to Examiner Lanier as warranting favorable action in the pending Reexaminations.

1. Patentee stated that favorable action to Claim 11 of Reexam 90/007407, as well as all the active claims in Reexam 90/007407, Reexam 90/007403 and 90/007402 was warranted.

This is because neither of the references Freeny or Gallagher anticipated any of the claims, and in view of the secondary evidence of patentability presented, the claims were allowable.

Respectfully submitted,



Ansel M. Schwartz
Registration No. 30,587

PHIP\517811\1

TRANSMITTAL LETTER (General - Patent Pending)	Docket No. NAPSP001

In Re Application Of:
Arthur R. Hair
Patent No. 5,191,573

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
90/007,402	01/31/2005	Roland G. Foster	23973		2998

Title: **Method for Transmitting a Desired Digital Video or Digital Audio Signals**

COMMISSIONER FOR PATENTS:

Transmitted herewith is:

Petition Under 37 C.F.R. 1.137(b)
Statement Under 37 C.F.R. 1.560(b)
Check for $1,500.00 (Petition Fee)
Post Card

in the above identified application.

- ☐ No additional fee is required.
- ☒ A check in the amount of **$1,500.00** is attached.
- ☒ The Director is hereby authorized to charge and credit Deposit Account No. **50-0573** as described below.
  - ☐ Charge the amount of
  - ☒ Credit any overpayment.
  - ☒ Charge any additional fee required.
- ☐ Payment by credit card. Form PTO-2038 is attached.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Dated: 5/24/06

Signature

Robert A. Koons, Jr., Reg. No. 32,474
DRINKER BIDDLE & REATH LLP
One Logan Square
18th & Cherry Streets
Philadelphia, PA 19103-6996
Telephone (215) 988-3392
Facimile: (215) 988-2757

cc:

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on

_____.
(Date)

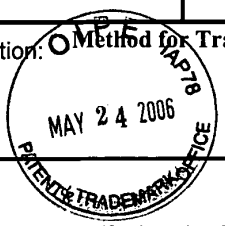
Signature of Person Mailing Correspondence

Typed or Printed Name of Person Mailing Correspondence

P16A/REV03

CERTIFICATE OF MAILING BY "EXPRESS MAIL" (37 CFR 1.10) Applicant(s): **Arthur R. Hair**			Docket No. **NAPSP001**	
Application No. **90/007,402**	Filing Date **01/31/2005**	Examiner **Roland G. Foster**	Customer No. **23973**	Group Art Unit

Invention: **Method for Transmitting a Desired Digital Video or Digital Audio Signals**



I hereby certify that the following correspondence:

Petition Under 37 C.F.R. 1.137(b), Statement Under 37 C.F.R. 1.560(b), Transmittal Letter, Check for $1,500.00, Post Card.

(Identify type of correspondence)

is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

May 24, 2006
(Date)

Lorraine T. Lewis
(Typed or Printed Name of Person Mailing Correspondence)

Lorraine T. Lewis
(Signature of Person Mailing Correspondence)

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P06A/REV03

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing Petition Under 37 C.F.R. § 1.137(b) with the attached Statement Under 37 C.F.R. § 1.560(b) was served, via First Class United States Mail, postage prepaid, this 24th day of May, 2006, on the following:

Mr. Albert S. Penilla
Martine, Penilla, & Gencarella, LLP
710 Lakeway Drive, Suite 200
Sunnyvale, CA 94085
Attorney for Third Party Reexamination Requester

By: _____
Robert A. Koons, Jr.
Attorney for Patentee

PHIP\517812\1

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

6/19/06

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

ALBERT S. PENILA

MARTINE PENILLA & GENCARELLA LLP

710 LAKEWAY DRIVE, SUITE 200

SUNNYVALE, CA 94085

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007402

PATENT NO. 5,191,573

ART UNI 3993

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)).

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,402	01/31/2005	5191573	NAPS001	2998

23973 7590 06/19/2006

DRINKER BIDDLE & REATH
ATTN: INTELLECTUAL PROPERTY GROUP
ONE LOGAN SQUARE
18TH AND CHERRY STREETS
PHILADELPHIA, PA 19103-6996

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 06/19/2006

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

DRINKER, BIDDLE & REATH, LLP (For Patent Owner)
Attn: Intellectual Property Group
One Logan Square
18th and Cherry Streets
Philadelphia Pa 19103-6996

Albert S. Penilla (For Third Party Requester)
Martine, Penilla & Gencarcella, LLP
710 Lakeway Drive, Suite 200
Sunnyvale, CA 94085

In re Reexamination Proceeding	:
Arthur R. Hair	:
Control No. 90/007,402	: DECISION GRANTING PETITION
Filed: January 31, 2005	:
U.S. Patent No. 5,191,573	:
Attorney Docket No. NAPSP001	:

This is a decision on the petition under 37 CFR 1.137(b) filed by the patent owner on May 24, 2006, for entry of late papers based upon unintentional delay.

The petition is before the Office of Patent Legal Administration (OPLA) for decision.

37 CFR 1.137(b) states:

> *"Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by: (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in § 1.17(m); (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section."

§ 1.560 Interviews in ex parte reexamination proceedings.

> (a) Interviews in ex parte reexamination proceedings pending before the Office between examiners and the owners of such patents or their attorneys or agents of record must be conducted in the Office at such times, within Office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Director. Interviews for the discussion of the patentability of claims in patents involved in ex parte reexamination proceedings will not be conducted prior to the first official

> action. Interviews should be arranged in advance. Requests that reexamination requesters participate in interviews with examiners will not be granted.
>
> (b) In every instance of an interview with an examiner in an ex parte reexamination proceeding, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the patent owner. An interview does not remove the necessity for response to Office actions as specified in § 1.111. Patent owner's response to an outstanding Office action after the interview does not remove the necessity for filing the written statement. The written statement must be filed as a separate part of a response to an Office action outstanding at the time of the interview, or as a separate paper within one month from the date of the interview, whichever is later.

The present petition under 37 CFR 1.137(b) includes the requisite response (written statement)(item 1), a $1500.00 petition fee under 37 CFR 1.17(m) (item 2) and the requisite statement (item 3).

The petition for entry of the late papers is granted.

Jurisdiction over the reexamination proceeding is being returned to Technology Center Art Unit 3992 for further examination and consideration of the written statement filed May 24, 2006, along with the present petition, in due course.

Any further communications as to the merits of the reexamination proceeding should be directed to the primary examiner, Roland Foster, in Technology Center Art Unit 3992, who can be reached at 571-272-7538.

Telephone inquiries related to this decision should be directed to Fred A. Silverberg at 571-272-7719.

Fred A. Silverberg
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy

Conferee: Kenneth M. Schor

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,402	01/31/2005	5191573	NAPS001	2998

23973 7590 09/29/2006

DRINKER BIDDLE & REATH
ATTN: INTELLECTUAL PROPERTY GROUP
ONE LOGAN SQUARE
18TH AND CHERRY STREETS
PHILADELPHIA, PA 19103-6996

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 09/29/2006

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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9/29/06

THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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MARTINE PENILLA & GENCARELLA LLP

710 LAKEWAY DRIVE, SUITE 200

SUNNYVALE, CA 94085

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007402

PATENT NO. 5,191,573

ART UNI 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)).

Office Action in Ex Parte Reexamination	Control No. 90/007,402	Patent Under Reexamination 5191573	
	Examiner Roland G. Foster	Art Unit 3992	

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

a☒ Responsive to the communication(s) filed on *06 February 2006* . b☐ This action is made FINAL.
c☐ A statement under 37 CFR 1.530 has not been received from the patent owner.

A shortened statutory period for response to this action is set to expire 2 month(s) from the mailing date of this letter. Failure to respond within the period for response will result in termination of the proceeding and issuance of an *ex parte* reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).** If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892.
2. ☐ Information Disclosure Statement, PTO-1449.
3. ☐ Interview Summary, PTO-474.
4. ☐ _____.

Part II SUMMARY OF ACTION

1a. ☒ Claims *1-43* are subject to reexamination.
1b. ☐ Claims _____ are not subject to reexamination.
2. ☐ Claims _____ have been canceled in the present reexamination proceeding.
3. ☐ Claims _____ are patentable and/or confirmed.
4. ☒ Claims *1-43* are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ The drawings, filed on _____ are acceptable.
7. ☐ The proposed drawing correction, filed on _____ has been (7a)☐ approved (7b)☐ disapproved.
8. ☐ Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
   a)☐ All b)☐ Some* c)☐ None of the certified copies have
   1☐ been received.
   2☐ not been received.
   3☐ been filed in Application No. _____ .
   4☐ been filed in reexamination Control No. _____.
   5☐ been received by the International Bureau in PCT application No. _____.
   * See the attached detailed Office action for a list of the certified copies not received.
9. ☐ Since the proceeding appears to be in condition for issuance of an *ex parte* reexamination certificate 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.
10. ☐ Other: _____

cc: Requester (if third party requester)

DETAILED ACTION

Response to Arguments

The Patent Owner submitted various responses to the Final Rejection, mailed on March 20, 2006, rejecting all claims of the instant U.S. Patent No. 5,191,573 patent under reexamination (the "'573 Patent").

Patent Owner arguments were considered, but deemed moot in view new issues concerning the earliest effective filing date of the '573 Patent, which as discussed below is September 18, 1990 (at the earliest) with respect to the original claims, and concerning 35 U.S.C. 112 issues with respect to the new claims. Thus, new grounds of rejection are set forth below.

Benefit of Earlier Filing Date Regarding Original Claims

As an initial matter, the instant '573 Patent and the earlier filed application are related as follows. The '573 Patent under reexamination issued from U.S. Application No. 07/586,391 (hereinafter the "Child Application"), which was filed on September 18, 1990. The parent (earlier filed) application to the Child Application is U.S. Application No. 07/206,497, filed on June 13, 1988 (hereinafter the "Parent Application"). All of the above applications are alleged to be related as "continuation" applications (i.e., no new matter was introduced, thus the applications allegedly share a common specification, see MPEP § 201.06(c).III). [1] However, the specification of the Child Application (issuing as the '573 Patent under reexamination) and the specification of the original Parent application are not common, as discussed below.

[1] Note that all the applications above were filed under the old "file wrapper continuation" procedures under 37 CFR 1.62, see MPEP § 201.06(a).

The prosecution history of the Child Application (issuing as the '573 Patent under reexamination) does not show that the examiner had reason to consider the propriety of the benefit (continuation) claim set forth in the patent. In addition, the prosecution history of the Child patent does not contain any substantive, written discussion between the applicant and the examiner regarding such a claim.

Intervening Patents and Printed Publications Are Available as Prior Art In a Reexamination Proceeding According to 35 U.S.C. 120

A rejection may be made in an *ex-parte* reexamination proceeding based on an intervening patent when the patent claims under reexamination, under 35 U.S.C. 120, are entitled only to the filing date of the patent under reexamination. Specifically:

> Rejections may be made in reexamination proceedings based on intervening patents or printed publications where the patent claims under reexamination are entitled only to the filing date of the patent and are not supported by an earlier foreign or United States patent application whose filing date is claimed. For example, under 35 U.S.C. 120, the effective date of these claims would be the filing date of the application which resulted in the patent. Intervening patents or printed publications are available as prior art under *In re Ruscetta*, 255 F.2d 687, 118 USPQ 101 (CCPA 1958), and *In re van Langenhoven*, 458 F.2d 132, 173 USPQ 426 (CCPA 1972). See also MPEP § 201.11

MPEP § 2258.I.C, Scope of Reexamination (emphasis added).

As discussed above, 35 U.S.C. 120 applies to *ex-parte* reexamination procedure. To be entitled to benefit of an earlier filing date under 35 U.S.C. 120, the previously filed specification of the Parent Application must support the invention claimed in the Child Application. See 35 U.S.C. 120.

The Original Claims of the Child Patent Under Reexamination Lack Benefit to the Filing Date of the Original Parent Application Under 35 U.S.C. 120 Because the Original Parent Application Fails to Support Several Features Claimed in the Child Patent Under Reexamination

A review of the prosecution history reveals that a significant amount of new text (directed to various features) added in a series of amendments is not found in the original Parent Application. Consider the following Table I:

Table I. New Matter Chart

	Parent Appln. 07/206,497, filed 6/13/88 (Abandoned)		Child Appln. 07/586,391, filed 9/18/90 (5,191,573)	
Feature	Date First Appearing in **Claims** of Parent Appln.	Date First Appearing in **Spec.** of Parent Appln.	Date First Appearing in **Claims** of Child Appln.	Date First Appearing in **Spec.** of Child Appln.
Hard Disk/Control Unit of Seller/User Electronic sales and distribution of the music	Filing Date of the **Original** Application – 6/13/88	Filing Date of the **Original** Application – 6/13/88		Filing Date of the Child Application – 9/18/90
Broad Statement at end of spec. regarding Video Applicability, Note *		Filing Date of the **Original** Application – 6/13/88		Filing Date of the Child Application – 9/18/90
Transferring Money from Second Party to a First Party (Charging a Fee)	12/22/88 (2/28/90)		Filing Date of the Child Application – 9/18/90	12/11/91
Providing a Credit Card Number	12/22/88		Filing Date of the Child Application – 9/18/90	
Controlling Use of First/Second Memory	12/22/88		Filing Date of the Child Application – 9/18/90	12/11/91
Transmitting to a Location Determined by Second Party	2/28/90		Filing Date of the Child Application – 9/18/90	12/11/91
Specific Video Download Procedures	2/28/90		Filing Date of the Child Application – 9/18/90	12/11/91 Note **
First Party in Possession of Transmitter	8/24/90, but not entered		Filing Date of the Child Application – 9/18/90	12/11/91
Second Party in Possession of Receiver and Second Memory	8/24/90, but not entered		Filing Date of the Child Application – 9/18/90	12/11/91

Key: Clear row means original matter present in the original Parent Application. Shaded row means new matter introduced by amendment into both the Parent and Child Applications subsequent to the date of the original Parent Application.

Note * - The original specification also describes using a "convenient visual display of the user's library of songs" (page 5), however this section appears to relate to displaying category/lyrical information to the user regarding downloaded audio content, and not directed to the actual download, processing, and display of video content.

Note ** - Even more detailed video download procedures are added to the specification of subsequent child applications, see the 90/007,403 and 90/007,407 reexaminations.

Applicant failed to provide adequate support for all the new text added by amendment (as identified in Table I above) to the Parent and Child applications. Applicant should specifically point out the support for any amendments made to the original disclosure. MPEP § 714.02, 2163.II.A.2(b), and 2163.06. Consider the following:

I. Parent Application No. 07/206,497 (filed June 13, 1988)

a. Amendment of Dec. 22, 1988

New Matter in Claims

New Independent Claim 11 – "transferring money to a party controlling use of the first memory"

New Dependent Claim 13 - "providing a credit card number of the party controlling use of the first memory by the party controlling the second memory"

New Matter in Spec.

No new matter added to specification.

Support for New Matter

Applicant made a statement in the amendment that "support for these new claims is found in the figures." This statement however is very broad. Applicant does not specifically point out where in the figures the added features are found and the examiner cannot find support for such features.

b. Amendment of Feb. 28, 1990

New Matter in Claims

New Dependent Claim 14 - "transmitting the digital signal from the first memory to the second memory at a location determined by the second party..."

New Independent Claim 15 –

* "transmitting a desired digital, a video or audio music signal...."

[detailed recitation of a method for transmitting follows]

* "charging a fee to the first party controlling use of the second memory"

New Dependent Claim 18 – "charging a fee to a party controlling the use and the location of the second memory."

New Matter in Spec.

Abstract briefly mentions storing video signals onto a hard disk.

Support for New Matter

Applicant made a statement in the amendment that "antecedent support for these claims is found in Figure 1." This statement is very broad. Applicant does not specifically point out where in the figures the added features are found and the examiner cannot find support for such features.

c. Proposed After-final Amendment of August 24, 1990 (Not Entered)

New Matter in Claims

Independent Claim 11 –

*"second party controlling use and in possession of the second memory"

* "with a transmitter in control and possession of the first party to a receiver having a second memory at a location determined by the second party, said receiver in possession and control of the second party"

Independent Claim 15 –

* "charging a fee by a first party controlling use of the first memory
* new limitations similar to claim 11 above

New Matter in Spec.

Title amended to state "Method for Transmitting a Desired Video or Audio Signal"

Support for New Matter

No support was provided.

II. Child Application No. 07/586,391 (filed September 18, 1990) (FWC) (Issued as 5,191,573)

a. Preliminary Amendment of September 18, 1990

New Matter in Claims

Independent Claims 11 and 15 – Same limitations as set forth in the proposed, after-final amendments of 8/24/1990 (not entered) as discussed above in parent application.

New Matter in Specification

No amendment to the specification.

Support for New Matter

No support was provided.

b. Amendment of December 11, 1991

New Matter in Claims

New Dependent Claim 22 – providing a credit card number of the party controlling the second memory to the party controlling the first memory so the party controlling the second memory is charged money

New Matter in Specification

Introduces large amount of new text into the specification directed to earlier claim amendments, such as the Sept. 18, 1990 Amendment, and directed to adding specific video download details.

Support for New Matter

No support was provided.

c. ***Amendment of June 25, 1992***

New Matter in Claims

Dependent Claim 13 – further detailed limitation regarding providing a credit card number.

New Independent Claim 23 – contains various limitations set forth in the above amendments.

New Matter in Specification

New abstract related to limitations set forth in the above amendment.

Support for New Matter

Applicant made a statement in the amendment that "antecedent support for the amendments to the claims [including new claim 23] is found in the figures and page 6, line 1."

This statement is very broad. Applicant does not specifically point out where in the figures the added features are found and the examiner cannot find support for such features.

d. Amendment of October 5, 1992

New Matter in Claims

No issues of new matter

New Matter in Spec.

No issues of new matter

Support for New Matter

N/A

Thus, as discussed above, the Applicant failed to point out support in the original Parent Application for all of the new text added by the series of amendments. Applicant should specifically point out the support for any amendments made to the original disclosure. MPEP § 714.02, 2163.II.A.2(b), and 2163.06.

Furthermore, the new text added by the amendments identified above is in the nature of additional, narrowing limitations and elements undisclosed by the generic statements in the original disclosure of the Parent Application. When an explicit limitation in a claim "is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires that limitation." Hyatt v. Boone, 146 F.3d 1348, 1353, 47 USPQ2d 1128, 1131 (Fed. Cir. 1998) (emphasis added) (Certiorari Denied). "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference.... Inherency, however, may not be established by probabilities or possibilities." In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51

(Fed. Cir. 1999) (citations omitted, emphasis added). As for speculation about undisclosed uses of the originally disclosed elements, it is not sufficient that the written description, when "combined with the knowledge in the art, would lead one to speculate as to modifications that the inventor might have envisioned, but failed to disclose." Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1571, 41 USPQ2d 1961, 1965-66 (Fed. Cir. 1997). See also MPEP § 2163.II.A.2(b) and § 2163.05.II.

In the instant case, it is clear that the explicit limitations added by amendment but missing from the original written description are not required by or necessarily present in the original written description. The recited details as to how money is transferred from a second party to the first party, a fee is charged, or how a credit card number is provided are not disclosed or required by the original, generic statement "electronic sales and distribution of the music...." For example, during the originally disclosed electronic sale, money could instead be transferred from a third party buyer (e.g., advertiser, local network provider, local retail store, friend, etc.) and/or transferred to a third party seller (e.g., remote wholesale music provider, local network provider, local retail store, etc.). Furthermore, a fee would not necessarily be charged upfront during a sale (e.g., a free preview or trial period). Finally, digital content would not necessarily be purchased using a credit card (e.g., person downloading the content could receive the bill in the mail).

Similarly, the ability to control and possess a transmitter, receiver, and memory and to determine the location to which data is transmitted is not disclosed or required by the original, generic statements such as "control unit of the user." For example, the originally disclosed

control unit of the seller or user could instead mean that seller and/or buyer instead rent or lease the equipment as is commonplace in the computer network industry rather than possess the equipment. Neither is the seller or user required to exercise control over their equipment, for example, the downloading services could be provided by a third party offering a turn-key solution.

The specific video download features added to the original specification and claims by the above amendments are not disclosed nor required by the one sentence, generic statement at the end of the original specification that "this invention is not to be limited to Digital Audio Music and can include Digital Video...."[2] Undisclosed digital video features (assuming enablement) could be implemented into the broadly termed "invention" in an almost unlimited number of specific, possible (but not required) ways, such as at various levels of integration with the originally disclosed audio system and at various levels of detail. By introducing new text directed to specific video download features in the subsequent amendments, the applicant simply chose one possible (but not required) way to integrate video features into the originally disclosed audio system.[3] Indeed, the applicant continued to add specific, video download and transmission procedures not found in the original specification (i.e., chose other possible ways to integrate video features) during the prosecution of subsequent, allegedly "continuation" applications, see the 90/007,403 and 90/007,407 reexaminations.[4] Thus, the original, one sentence generic

[2] The original specification also describes using a "convenient visual display of the user's library of songs" (page 5), however this section appears to relate to displaying category/lyrical information to the user regarding downloaded audio content, and not directed to the actual download, processing, and display of video content.
[3] See the amendments of February 28, 1990, December 11, 1991, and June 25, 1992.
[4] Although adding text that replaces all appearances of "audio" with "video" would be one possible (but not required) way to integrate undisclosed video features into the originally disclosed audio system, this is not what the applicant has done here, probably because such a rote replacement would create a dysfunctional system. For example, those originally disclosed audio features directed to listening to the audio during cannot be simply replaced with the word video. For example, applicant waited

statement does not require all the many instances of undisclosed, specific details later added by the applicant.

Furthermore, transmission and storage of digital video content significantly differs in technology from the transmission and storage of digital audio content, thus the originally disclosed audio transmission features fail to imply or require any video transmission features. For example, the decoding of digital video data is much more processor intensive than the decoding of digital audio data due to the increased information content and bandwidth of a typical video signal. In the mid 1980(s), at the time of the filing date of the original Parent specification, only compact audio disks players were routinely available.[5] Personal user devices with the processing power capable of playing back much larger and more complex digital video files, such as DVD players, were not routinely available until the late 1990(s), and even these devices initially only read video data from read-only DVD disks capable of storing large digital video files, not from video data downloaded (recorded) from a remote server via a communications network.[6] Thus, undisclosed devices capable of decoding and playing back digital video files would not have been required nor necessarily present based on the original disclosure of an integrated circuit 50 of the user, which was also originally disclosed to process and store audio information. For the same reasons, it is also not clear how the originally

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until the child application to add new text directed toward displaying downloaded video, see page 10 of the amendment, filed January 3, 1994, in child application 08/023,398.

[5] See "The History of Recordings", Recording Industry of Association, retrieved from http://www.riaa.com/issues/audio/hisotry.asp on September 19, 2006. See also the "History of CD Technology", citing as a source "The compact Disc Handbook, 2nd Edition," by Ken C. Pohlmann, retrieved from http://www.oneoffcd.com/info/hisotrycd.cfm on September 19, 2006.

[6] See the "History of MPEG", University of California, Berkeley, School of Information Management and Systems, retrieved from http://www2.sims.berkeley.edu/courses/is224/s99/GroupG/report1.html on September 19, 2006. See also the "History of CD Technology", citing as a source "The compact Disc Handbook, 2nd Edition," by Ken C. Pohlmann, retrieved from http://www.oneoffcd.com/info/hisotrycd.cfm on September 19, 2006.

disclosed, incoming RAM 50c and playback RAM 50d could have supported storage of downloaded video and playback.

Further regarding the original equipment of the user (consumer), in 1988 a large capacity drive for a user (e.g., 3.5 inch form factor) was around 30 megabytes[7], yet the digital bandwidth required to transmit a video signal at even VHS quality was 1.5 megabits per second (approximately 30 megabytes in 3 minutes) and this even using a Moving Picture Coding Experts Group Standard "1" ("MPEG-1") video compression technology not even available in 1988.[8] Thus, undisclosed devices capable of downloading and storing digital video files would not have been required or necessarily present based on the original disclosure of hard disk 60, which was also originally disclosed to process and store audio information.

Regarding video equipment used at the library (server) end, even large mainframe computers (e.g., IBM mainframe computers) typically only provided hard drives with capacity well below 10 gigabytes.[9] Thus, undisclosed devices capable of supporting even a small-sized video library, with its steep storage requirements as discussed above, would not have been required or necessarily present based on the original disclosure of the library (server) hard disk 10 of the copyright holder, which was originally disclosed as storing audio information.

Regarding the transfer of these large video files over a network, the proliferation of broadband communication network capable of delivering these large files to consumers, such as

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[7] See "IBM HDD Evolution" chart, by Ed Grochowski at Almaden, retrieved from http://www.soragereview.com/guideImages/z_ibm_sorageevolution.gif" on September 19, 2006.
[8] See the "History of MPEG", University of California, Berkeley, School of Information Management and Systems, retrieved from http://www2.sims.berkeley.edu/courses/is224/s99/GroupG/report1.html on September 19, 2006.

the Internet, simply did not exist or were not well known in 1988. Furthermore, it is not clear how the digital video would have been coded and decoded during transmission, as digital video coding standards for purposes of transmission and file downloading were not settled in 1988. As an example of the above points, the MPEG-1 standard, which was designed to code/decode digital video information and to transmit the video via a telephone (telecommunications) network in NTSC (broadcast) quality for archiving, was only established in 1992.[10] Thus, undisclosed devices capable of coding, transmitting, and decoding video digital data would not have been required or necessarily present based on the original disclosure of telephone line 30 (transmission line) and control IC(s) 20b and 50b (coding/decoding devices), which were originally disclosed as processing audio information.

In view of the above, all of the new text introduced by amendment into the Child Application (as identified in Table I above) is considered new matter to the original Parent Application for the purposes of this reexamination. Thus, the previously filed specification of the Parent Application fails to support the invention claimed in the Child Application and thus is not entitled to priority under 35 U.S.C. 120, See 35 U.S.C. 120. Thus, the effective filing date (priority) of the instant '573 Patent under reexamination is latest date at which time the priority chain was broken, namely September 18,1990 (at the earliest), which is also the filing date of the Child Application (which issued as the '573 Patent under reexamination).

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[9] IBM HDD Evolution chart, *supra*.
[10] History of MPEG, *supra*.

Claim Rejections - 35 USC § 112

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.

Claims 7-43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

35 U.S.C. 112 issues can be addressed in a reexamination proceeding with respect to new claims or amendatory subject matter. MPEP § 2258.

"Most typically, the [112] issue will arise in the context of determining whether new or amended claims are supported by the description of the invention in the application as filed... whether a claimed invention is entitled to the benefit of an earlier priority date or effective filing date under 35 U.S.C. 119, 120, or 365(c)." MPEP § 2163.I. Here, the '573 Patent under reexamination claims benefit under 35 U.S.C. 120 to the earlier filing date of the Parent Application.

The new claim(s) contain subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the

time the original Parent Application was filed, had possession of the claimed invention. Indeed, the new claims contain extensive new text that is not found in the written description of the original Parent Application (see Table I in the priority section above).

> To comply with the written description requirement of 35 U.S.C. 112, para. 1, or to be entitled to an earlier priority date or filing date under 35 U.S.C. 119, 120, or 365(c), each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure. When an explicit limitation in a claim "is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires that limitation." Hyatt v. Boone, 146 F.3d 1348, 1353, 47 USPQ2d 1128, 1131 (Fed. Cir. 1998). See also *In re* Wright, 866 F.2d 422, 425, 9 USPQ2d 1649, 1651 (Fed. Cir. 1989).

MPEP § 2163.II.A.2.(b), emphasis added.

Here, the Patent Owner, on page 13 in the amendment of February 06, 2005, points to col. 5, ll. 5-25 of the '573 Patent. However, this section fails to provide support for the extensive set of limitations introduced by thirty-six new claims, such as those limitations directed to a first party controlling use of the first memory, a second party controlling use and in possession of the second memory, transmitting the desired signal to a second memory at a location determined by the second party, a transmitter in control and possession of the first party, and a receiver in possession and control of the second party. Neither are these limitations implicit or inherent to the originally filed disclosure in the Parent Application, as extensively discussed in the "Benefit of Earlier Filing Date Regarding the Original Claims" section above.

Claims 14-21 and 33-43 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.

35 U.S.C. 112 issues can be addressed in a reexamination proceeding with respect to new claims or amendatory subject matter. MPEP § 2258.

The new claim(s) contain subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time both original Parent Application was filed, that the specification would have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. In re Wright, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). See also MPEP § 2164.01 and 2164.05(a).

Undue Experimentation Factors

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." These factors include, but are not limited to whether the scope and breadth of the claims are reasonably related to the scope of enablement within the original specification, the level of ordinary skill in the art, and the quantity of undue experimentation. See MPEP 2164.01(a).

Here, the subject claims recite extensive new text directed to specific and detailed video download and processing procedures that is not found in original specification of the Parent

Application. The original specification does contain a general statement at the end of the specification stating "[f]urther, it is intended that this invention is not to be limited to Digital Audio Music and can include Digital Video....", however this broad, generic statement fails to enable specifically claimed video download and processing procedures.[11]

The detailed and extensive claim limitations directed to video download and processing stand in contrast to the brief, generic one sentence disclosure in the original specification, as discussed above. Thus, the scope and breadth of the claims are not reasonably correlated to the scope of enablement in the original specification. The scope of enablement must at least bear a "reasonable correlation" to the scope of the claims. See, e.g., In re Fisher, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). See also MPEP § 2164.08.

The original specification would not have been enabling to one of ordinary skill in the art and furthermore an undue quantity of experimentation would have been required to make or use the scope of the claimed invention (video download and processing features) based on the original specification. The specification must be enabling as of the filing date of the specification. MPEP § 2164.05(a). Here, the filing date of the Parent Application was June 13, 1988. In the mid 1980(s) however, only compact audio disks players were just becoming popular.[12] Personal user devices with the processing power capable of playing back much larger and more complex digital video files, such as DVD players, were not routinely available until the

[11] The original specification also describes using a "convenient visual display of the user's library of songs" (page 5), however this section appears to relate to displaying category/lyrical information to the user regarding downloaded audio content, and not directed to the actual download of video content.

[12] See "The History of Recordings", Recording Industry of Association, retrieved from http://www.riaa.com/issues/audio/hisotry.asp on September 19, 2006. See also the "History of CD Technology", citing as a

late 1990(s), and even these devices initially only read video data from read-only DVD disks capable of storing large digital video files, not from video data downloaded (recorded) from a remote server via a communications network. [13] Thus, it is not clear how the originally disclosed, integrated circuit 50 of the user would have had the processing power to decode and playback downloaded, digital video signals. For the same reasons, it is also not clear how the originally disclosed, incoming RAM 50c and playback RAM 50d could have supported storage of downloaded video and playback.

Further regarding the equipment of the user (consumer), in 1988 a large capacity drive for a user (e.g., 3.5 inch form factor) was around 30 megabytes[14], yet the digital bandwidth required to transmit a video signal at even VHS quality was 1.5 megabits per second (approximately 30 megabytes in 3 minutes) and this even using a Moving Picture Coding Experts Group Standard "1" ("MPEG-1") video compression technology not even available in 1988.[15] Thus, it is not clear how a how downloaded video files of any appreciable or viable size would have been downloaded and stored on originally disclosed hard disk 60 of the user in the original specification.

Regarding the equipment used at the library (server), even large mainframe computers (e.g., IBM mainframe computers) typically only provided hard drives with capacity well below

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source "The compact Disc Handbook, 2nd Edition," by Ken C. Pohlmann, retrieved from http://www.oneoffcd.com/info/hisotrycd.cfm on September 19, 2006.

[13] See the "History of MPEG", University of California, Berkeley, School of Information Management and Systems, retrieved from http://www2.sims.berkeley.edu/courses/is224/s99/GroupG/report1.html on September 19, 2006. See also the "History of CD Technology", citing as a source "The compact Disc Handbook, 2nd Edition," by Ken C. Pohlmann, retrieved from http://www.oneoffcd.com/info/hisotrycd.cfm on September 19, 2006.

[14] See "IBM HDD Evolution" chart, by Ed Grochowski at Almaden, retrieved from http://www.soragereview.com/guideImages/z_ibm_sorageevolution.gif" on September 19, 2006.

10 gigabytes.[16] Thus, it is not clear how even a small-sized video library, with its steep bandwidth (storage) requirements (as discussed above), would have been stored in the hard disk 10 of the copyright holder in the original specification, without requiring details directed toward a complex mainframe operating environment.

Regarding the transfer of these large video files over a network, the proliferation of broadband communication network capable of delivering these large files to consumers, such as the Internet, simply did not exist or were not well known in 1988. Furthermore, it is not clear how the digital video would have been coded and decoded during transmission, as digital video coding standards for purposes of transmission and file downloading were not settled in 1988. As an example of the above points, the MPEG-1 standard, which was designed to code/decode digital video information and to transmit the video via a telephone (telecommunications) network in NTSC (broadcast) quality for archiving, was only established in 1992.[17]

Thus, based on the evidence regarding each of the above factors, the specification, at the time the Parent application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation.

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[15] See the "History of MPEG", University of California, Berkeley, School of Information Management and Systems, retrieved from http://www2.sims.berkeley.edu/courses/is224/s99/GroupG/report1.html on September 19, 2006.
[16] IBM HDD Evolution chart, *supra*.

Claim Rejections Based on Bush

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Bush.

Regarding **claim 1**,

A method for transmitting a desired digital audio signal stored on a first memory of a first party to a second memory of a second party comprising the steps of:

Bush teaches transmitting a desired digital, audio or video signal (col. 2, ll. 18-29 and col. 3, ll. 26 - 35). The digital audio or video signals are stored on compact disc machines 41-46 (first memory) of a pay per view entertainment system provider associated with source 10 (first party) (Figs. 1, 4 and col. 2, ll. 19-47). The digital signals are transmitted via a network to the consumer's receiver 14 (Fig. 1) (also illustrated as receiver 100 in Fig. 5, see also col. 3, ll. 14-17). The signals are stored on cassette recording unit and an associated cassette tape (second memory) (Fig. 5 and col. 4, ll. 1-11). Note that the second memory is also a compact disc recorder (col. 10, claim 14) and thus the second memory is also a CD.

transferring money electronically via a telecommunication line to the first

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[17] History of MPEG, *supra*.

party at a location remote from the second memory and controlling use of the first memory from the second party financially distinct from the first party, said second party controlling use and in possession of the second memory;

Bush teaches that money is electronically transferred via a telephone line (telecommunications line) and clearing house 200 to the source 10 (first party) by way of a credit card transaction (Fig. 3 and col. 2, ll. 58-63, col. 4, ll. 44-47, col. 5, ll. 1-3, col. 6, ll. 25-28, and ll. 45-48). The first party's location (source 10) is remote via a network from the consumer (Fig. 1). The second party (consumer) commands the download of audio/video from the memories of the first party (source 10) (Fig. 7, col. 1, ll. 59-64, and col. 6, ll. 11-48). Thus, the first memory is controlled from the second party. Clearly, the second party (consumer) is financially distinct from the first party (source 10). The second party (consumer) also controls the use and also possesses the second memory, such as by the ability to determine what contents are stored in the second memory (col. 6, ll. 11-48)

connecting electronically via a telecommunications line the first memory with the second memory such that the desired digital audio signal can pass therebetween;

The limitation broadly recites "a telecommunications line," which lacks antecedent basis to the previous recitation of a telecommunications line. The examiner interprets a "telecommunications line" to mean a electronic medium of communicating between computers, which requires end-to-end connectivity, which is an interpretation consistent with an interpretation advanced by the Patent Owner and adopted by the district court. Sightsound.com Inc. v. NSK, Inc. Cdnow, Inc., and Cdnow Online, Inc., Civil Action No. 98-118, pp. 50 and 57

(District Court for the Western District of Pennsylvania, Feb. 2002). Here, Bush teaches of a cable system (electronic medium) that provides end-to-end communications between computer at the central cable system associated with source 10 and the consumer's computer (Figs. 1, 2 and 5). The audio and video files are downloaded via the telecommunications line and thus connect the first and second memories, as discussed above.

transmitting the desired digital audio signal from the first memory with a transmitter in control and possession of the first party to a receiver having the second memory at a location determined by the second party, said receiver in possession and control of the second party; and

The desired digital audio or video signal is transmitted from the first memory as discussed above using a transmitter (Fig. 4, CADA transceiver 40) in control (col. 2, ll. 18-21) and possession of the first party, such as when the first party (source 10) determines what contents are stored in the first memory (col. 2, ll. 30-42). The second party (consumer) determines the location to which the audio/video data is transmitted as broadly recited by the claims, such as the consumer operates the invention by turning on the television and interacts with the pay per view channel at a location (e.g., consumer's home) determined by the consumer. The receiver 14 includes a cassette tape (or CD) (as discussed above) that is in possession and control of the second party (col. 1, ll. 59-64).

storing the digital signal in the second memory.

The received audio/video digital signal is stored in the second memory (cassette tape or CD) associated with the second party (consumer) as discussed above. See also col. 5, ll. 24-52.

Claim 4 differs substantively from claim 1 in that claim 4 recites that digital "video" signal is transmitted (downloaded) as opposed to the audio signal in claim 1. However, the claim 1 rejection clearly explained how Bush teaches that both audio and video digital signals are downloaded. Therefore, see the claim 1 rejection for additional details.

Regarding **claims 2 and 5**, after the money transfer step, the recording system searches for a recording signal from the remote library (e.g., forward and reverse roll commands) and then for a subsequent video/audio file from the remote library for the purposes of recording, where the video/audio file is stored in the first memory, as discussed above (col. 5, ll. 35-44 and col. 6, ll. 23-48.

Regarding **claims 3 and 6**, Bush teaches (similarly to Yurt) of a system for downloading audio and video files from a central library to a user, where the user pays for the audio files and stores the audio files (abstract and Figs. 1 and 6). Bush also teaches that the user provides a credit card number to the second party (library) (col. 4, ll. 44-47, col. 5, ll. 1-3, col. 6, ll. 25-28, and ll. 45-48).

Claim Rejections - 35 USC § 103

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 negatived by the manner in which the invention was made.

Claims 7-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bush in view of U.S. Patent No. 4,870,515 ("Stokes"), of record.

Claim 7 differs substantively from claim 1 in that claim 7 recites the additional limitation "listing/scrolling digital audio signals from the second memory." For the purposes of examination "listing/scrolling" will be interpreted as "listing or scrolling."

Although Bush teaches of limited scrolling capability via a keypad interface and date/PIN display (Fig. 6), Bush does not clearly teach listing or scrolling from the second memory associated with the second party (consumer).

Stokes however (similarly to Bush) teaches of a tape or CD playback device (abstract and Figs. 3 and 3a) that provides extensive listing or scrolling capability regarding the available selections (including the name of the digital audio signal, such as title of the track, duration of the digital audio signal, and name of the artist, and name of the album) (abstract, col. 2, ll. 3-38, ll. 57-61, and col. 3, ll. 4-35). Note also that Stokes (similarly to Bush) teaches of supporting a compact disc (col. 3, ll. 49-56).

The suggestion/motivation for adding the teachings of Stokes would have been to increase the user friendliness and operational efficiency of the playback device by adding the ability to "display to the user a wide variety of data about musical selections recorded on the magnetic tape or other medium," "display[] identifying information concerning the musical

selections, for example, artist, title, track, playing time, album name," "enable the user to choose which tracks or musical selections are to be played," and store the track data in a library memory, "so that a user can quickly locate a given selection of music" (Stokes, col. 1, l. 43 – col. 2, l. 2 and col. 3, ll. 4-13).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the listing or scrolling teachings (including the name of the digital audio signal, such as title of the track, duration of the digital audio signal, and name of the artist, and name of the album) as taught by the tape or CD playback device of Stokes to the tape or CD playback device of Bush.

Claim 14 does not substantively differ from claims 4 and 7 above.

Claim 22 differs substantively from claims 1 and 7 in that claim 22 recites the additional limitation "randomly selecting digital audio signals from the second memory by a second party integrated circuit of a second party control unit." Stokes teaches that the second memory in the receiver also includes an interchangeable, random access memory ("RAM) 48 (Fig. 13, col. 5, ll. 20-34 and col. 9, l. 58 – col. 1, 2). More generally, the user can retrieve data using random access commands, such as play, fast forward, rewind, stop, pause, and play slow commands (col. 5, ll. 64-66). The circuits used to randomly select the digital audio or video are integrated circuits, such as 8-bit CPU 10. Thus, Bush teaches the literal language of the claims ("randomly selecting digital audio signals from the second memory by a second party"), namely that the second party (user) randomly accesses the second memory for media content, such as when

randomly entering media playback commands (e.g., forward, rewind, stop, pause, etc.) by a integrated circuit of the second party.

Claim 26 differs substantively from claims 1 and 7 in that claim 26 recites the additional limitation "displaying a name of an artist of the digital audio signal from the second memory." This limitation was addressed in the details of the claim 7 rejection above.

Claim 29 differs substantively from claims 1 and 7 in that claim 29 recites the additional limitation "displaying a duration of the digital audio signal from the second memory." This limitation was addressed in the details of the claim 7 rejection above.

Claim 33 does not substantively differ from claims 7 and 22 above.

Claim 37 does not substantively differ from claims 7 and 26 above.

Claim 40 does not substantively differ from claims 7 and 29 above.

Regarding **claims 8, 15, 23, 27, 30, 34, 38, and 41**, see the claim 3 rejection above for additional details.

Regarding **claims 9, 25, and 32**, see the claim 26 rejection and col. 12, ll. 61-65 regarding the "name of a digital audio signal."

Regarding **claim 10**, see the claim 29 rejection for additional details regarding "duration of digital audio signal"

Regarding **claim 11**, see the claim 26 rejection regarding the "name of an artist of the digital audio signal."

Regarding **claim 12**, see the claim 26 rejection and col. 12, ll. 61-65 regarding the "name of an album with the digital audio signal."

Regarding **claim 13**, see the claim 22 rejection for additional details regarding "randomly selecting digital audio signals."

Regarding **claims 16, 36, and 43**, see the claims 9 and 26 rejections for additional details regarding "name of a digital video."

Regarding **claims 17, 35, 39, and 42**, see the claim 14 rejection for additional details regarding "listing/scrolling queued digital video signals."

Regarding **claim 18**, see the claim 40 rejection for additional details regarding "duration of the digital video signal."

Regarding **claim 19**, see the claim 37 rejection for additional details regarding "name of artist of the digital video signal."

Regarding **claim 20**, see the claim 12 regarding the "name of an album", where this name also refers to a video signal, as discussed in the claim 4 rejection above.

Regarding **claim 21**, see the claim 33 rejection for additional details regarding "randomly selecting digital video signals."

Regarding **claims 24, 28 and 31**, see the claim 7 rejection for additional details regarding "listing/scrolling."

Regarding **claim 35**, see the claim 17 rejection for additional details.

Claims 22, 24, 25 and 33, 35, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bush in view of Stokes as applied above, and further in view of U.S. Patent No. 4,787,073 ("Masaki"), newly cited.

Claims 22 and 33 differ substantively from claim 7 in that claim 22 recites the additional limitation "randomly selecting digital audio signals from the second memory by a second party integrated circuit of a second party control unit."

Bush teaches that the second memory in the receiver also includes an interchangeable, random access memory ("RAM) 48 (Fig. 13, col. 5, ll. 20-34 and col. 9, l. 58 – col. 1, 2). More generally, the user can retrieve data using random access commands, such as play, fast forward,

rewind, stop, pause, and play slow commands (col. 5, ll. 64-66). The circuits used to randomly select the digital audio or video are integrated circuits, such as 8-bit CPU 10. Thus, Bush could be said to impliedly teach the literal language of the claims ("randomly selecting digital audio signals from the second memory by a second party"), namely that the second party (user) randomly accesses the second memory for media content, such as when randomly entering media playback commands (e.g., forward, rewind, stop, pause, etc.) by a integrated circuit of the second party.

Bush however fails to explicitly teach randomly selecting the digital audio by the second party (user).

Masaki (similarly to Bush) teaches of a digital playback system (col. 1, ll. 5-12) that randomly plays back audio files from a storage system (col. 3, ll. 40-67).

The suggestion/motivation for combining the random playback teachings of Masaki with Bush would have been to increase user-friendliness and the effectiveness and enjoyment of the stored content by avoiding the situation where "order of playing back the musical pieces [is]...known beforehand, which spoils the enjoyment" (Masaki, col. 1, ll. 25-27).

Therefore, to one of ordinary skill in the art at the time the invention was made, it would have been obvious to add the random playback from digital storage as taught by Masaki to the playback device using digital storage as taught by Bush.

Regarding **claims 23 and 34,** see the claim 8 rejection above for further details.

Regarding **claim 24**, see the claim 7 rejection above for additional details.

Regarding **claim 25**, see the claim 9 rejection above for additional details.

Regarding **claim 35**, see the claim 17 rejection above for additional details.

Regarding **claim 36**, see the claim 16 rejection above for additional details.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bush as applied above, and further in view of Masaki. See the claim 22 rejection above for additional details.

Claim Rejections Based on Cohen

Claim Rejections - 35 USC § 102

Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 4,949,187 ("Cohen"), of record.

The filing date of the Cohen patent is December 16, 1988. The earliest priority date of the '573 Patent under reexamination however is September 18, 1990, as discussed extensively above in the Priority section. Thus, Cohen is available as 102(e) type prior art.

With respect to **claim 1**, Cohen clearly teaches a method for transmitting a desired digital movie signal (abstract) comprising video and audio components (col. 1, ll. 7-12 and ll. 46-50) of a first party (central source of audio and video data, Fig. 4) to a second memory (disk storage system 114) of a second party (home viewer) (abstract). Money is electronically transferred via a telephone (telecommunication) line, where the first (central source) and second party (home viewer) are clearly financially distinct (abstract and Fig. 4, telephone line 60). The desired digital movie (video and audio) is in the first memory (principal on line movie storage 12-26, Fig. 4) is connected to and transferred via the telephone (telecommunications) line 60 to the second memory (disk storage system 114), where it is stored (col. 4, ll. 1-68).

Claim 4 differs substantively from claim 1 in that claim 4 recites that digital "video" signal is transmitted (downloaded) as opposed to the audio signal in claim 1. However, the claim 1 rejection clearly explained how Cohen teaches that both audio and video digital signals are downloaded. Therefore, see the claim 1 rejection for additional details.

Regarding **claims 2 and 5**, see col. 4, ll. 19-29 and ll. 47-63, where after the money transfer (accounting) step, the system searches for the desired selection by the home viewer and commences downloading.

Claim Rejections - 35 USC § 103

Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen as applied to claims 1, 2, 4, and 5 above, and further in view of Bush.

Cohen teaches of telephoning the first party controlling use of the first memory and transferring money (as discussed above in the claim 1 rejection). Cohen however fails to teach providing a credit card number of the second party.

Bush teaches (similarly to Cohen) of a system for downloading audio and video files from a central library to a user, where the user pays for the audio files and stores the audio files (abstract and Figs. 1 and 6). See also the Bush, claim 1 rejection above. Bush also teaches that the user provides a credit card number to the second party (library) (col. 4, ll. 44-47, col. 5, ll. 1-3, col. 6, ll. 25-28, and ll. 45-48).

The suggestion/motivation for providing a credit card number to the second party would be to reduce the expenses involved in operating a download service, because financial service organizations, such as credit card organizations, "enable the source 10 to [be] paid be a service fee for the subscriber's use of the system." Bush, col. 2, ll. 58-63. Obviously, providing a credit card number would have been required to use the services of a credit card organization.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add the step of the user providing a credit number to the second party as taught by the audio/video download system of Bush to the audio/video download of Cohen, which teaches that the user pays for the download.

Claim Rejections Based on Akashi

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application No. 62-284496 ("Akashi") using the English translation of record, in view of U.S. Patent No. 4,528,643 ("Freeny").

Regarding **claims 1, 3, 4, 6**, Akashi discloses a system for automatically selling recorded music via telecommunication lines (Page 1 through line 1 of Page 2). This system utilizes the telecommunications lines to transmit the recorded music data from a host computer that stores the recorded music data to a personal computer (Page 2 Section 4), which meets the limitation of connecting electronically via telecommunications line the first memory with the second memory such that the desired digital audio signal can pass therebetween, transmitting the desired digital audio signal from the first memory with a transmitter in control and possession of the first party to a receiver having the second memory at a location determined by the second party, said receiver in possession and control of the second party, storing the digital signal in the second memory.

Akashi discloses that the digital music data is purchased automatically but does not expressly detail how the purchase is transacted.

Freeny discloses a method of electronically distributing and selling audio and video data by way of having the requesting user transmit a consumer credit card number along with their request for the audio and video data (Col. 13, lines 25-29). This step allows the owner of the data

to approve the sale and charge the sale to the consumer credit card number (Col. 13, lines 30-31), which meets the limitation of transferring money electronically via a telecommunications lines to the first party at a location remote from the second memory and controlling use of the first memory from the second party financially distinct from the first party, said second party controlling use and in possession of the second memory, the transferring step includes the steps of telephoning the first party controlling use of the first memory by the second party, providing a credit card number of the second party controlling the second memory to the first party controlling the first memory so the second party is charged money.

The suggestion/motivation for combining Akashi with Freeny would have been because this method of electronic sale allows the owner of the information to receive directly the compensation for sale of recording and such compensation is received before the reproduction is authorized as taught in Freeny (Col. 13, lines 36-39).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the requesting user's of Akashi transmit a consumer credit card number along with their request for the digital data so that the source unit could approve and charge the sale of the digital data to the consumer credit card

Regarding **claims 2 and 5**, Akashi discloses that personal computer contains a CPU (Figure 1). The personal computer sends an access signal to the host computer, and the host computer returns a response signal that contains menu data displayed at the personal computer (Page 3 Paragraph 6). Using the monitor screen, the user chooses desired data using a control

unit and sending the selection data to the host computer in the same way the initial transmission was sent (Page 4 Paragraph 1), which meets the limitation of the steps of searching the first memory for the desired digital audio signal and selecting the desired digital audio signal from the first memory.

Conclusion

Extensions of time under 37 CFR 1.136(a) do not apply in reexamination proceedings. The provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Further, in 35 U.S.C. 305 and in 37 CFR 1.550(a), it is required that reexamination proceedings "will be conducted with special dispatch within the Office."

Extensions of time in reexamination proceedings are provided for in 37 CFR 1.550(c). A request for extension of time must be filed on or before the day on which a response to this action is due, and it must be accompanied by the petition fee set forth in 37 CFR 1.17(g). The mere filing of a request will not effect any extension of time. An extension of time will be granted only for sufficient cause, and for a reasonable time specified.

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 U.S. Patent No. 5,191,573 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282, and 2286.

A complete response should be made in response to this Office Action since the next Office Action is expected to be a Final Action. Thus, in order to ensure full consideration of any amendments, affidavits or declarations, or other documents as evidence of patentability, such documents must be submitted in response to this Office Action. Submissions after the next

Office Action, which is intended to be a Final Action, will be governed by the requirements of 37 C.F.R. 1.116(b), which will be strictly enforced. Any amendment after a Final Action must include "a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented" in order to be considered. See MPEP § 2260.

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

By **U.S. Postal Service Mail** to:

Mail Stop "Ex Parte Reexam"
ATTN: Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

By **FAX** to:

(571) 273-9900
Central Reexamination Unit

By **hand** to:

Customer Service Window
Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Reexamination Legal Advisor or Examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

Signed:

Roland G. Foster
Central Reexamination Unit, Primary Examiner
Electrical Art Unit 3992
(571) 272-7538

Conferee:

SCOTT L. WEAVER
CRU EXAMINER-AU 3992

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

Search Notes	Application/Control No.	Applicant(s)/Patent under Reexamination	
	90/007,402	5191573	
	Examiner	Art Unit	
	Roland G. Foster	3992	

SEARCHED			
Class	Subclass	Date	Examiner

INTERFERENCE SEARCHED			
Class	Subclass	Date	Examiner

SEARCH NOTES (INCLUDING SEARCH STRATEGY)	DATE	EXMR
EAST - SEE SEARCH HISTORY PRINTOUT	8/15/06	R.G.F.
- 707/10.4.1 709/217, 219		
STIC - SEE SEARCH HISTORY PRINTOUT		

Index of Claims

Application/Control No.	Applicant(s)/Patent under Reexamination
90/007,402	5191573
Examiner	**Art Unit**
Roland G. Foster	3992

√	Rejected	–	(Through numeral) Cancelled	N	Non-Elected	A	Appeal
=	Allowed	÷	Restricted	I	Interference	O	Objected

Claim		Date
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STIC R.G.F.

File 9:Business & Industry(R) Jul/1994-2006/Aug 10
(c) 2006 The Gale Group
File 15:ABI/Inform(R) 1971-2006/Aug 11
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(c) 2006 Dialog
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(c) 2006 The Gale group
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(c) 2006 The Gale Group
File 80:TGG Aerospace/Def.Mkts(R) 1982-2006/Aug 10
(c) 2006 The Gale Group
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        (c) 2006 Dialog
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File 813:PR Newswire 1987-1999/Apr 30
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S27        77   S25 NOT S26
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File 348:EUROPEAN PATENTS 1978-2006/ 200632
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File 349:PCT FULLTEXT 1979-2006/UB=20060803,UT=20060727
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              RD?? OR BBS
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S30         3   S29 NOT (S13 OR S14 OR S20 OR S26)
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[redacted]

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File 344:Chinese Patents Abs Jan 1985-2006/Jan
         (c) 2006 European Patent Office
File 347:JAPIO Dec 1976-2005/Dec(Updated 060404)
         (c) 2006 JPO & JAPIO
File 350:Derwent WPIX 1963-2006/UD=200651
         (c) 2006 The Thomson Corporation

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             K?? OR DELPHI??
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S21       156   S20 NOT AD=19970811:20000811/PR
S22        39   S21 NOT AD=20000811:20030811/PR
S23        39   S22 NOT AD=20000811:20030811/PR
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S25         4   S10 AND (S5 OR S6)
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S31        85   S30 NOT AD=20000811:20030811/PR
S32        27   S31 NOT AD=20030811:20060811/PR
S33        25   S32 NOT (S24 OR S25)
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File 344:Chinese Patents Abs Jan 1985-2006/Jan
         (c) 2006 European Patent Office
File 347:JAPIO Dec 1976-2005/Dec(Updated 060404)
         (c) 2006 JPO & JAPIO
File 350:Derwent WPIX 1963-2006/UD=200651
         (c) 2006 The Thomson Corporation

Set     Items   Description
S1    2263545   AUDIO? ? OR VIDEO?? OR MUSIC?? OR SONG?? OR MOVIE?? OR FIL-
             M? ?
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S3       9494   (INTERNET??? OR ONLINE OR ON()LINE OR WEBSITE?? OR WWW OR -
             WEB()SITE??)(7N)S1
S4      16744   (NETWORK? ? OR WAN? ? OR LAN? ? OR NET()WORK?? OR INTRANET-
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S5      11278   (BUY??? OR PUCHAS??? OR RENT??? OR PAY???? OR SELL??? OR S-
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S6      14071   (CREDIT???? OR CHARG????)(5N)S1
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S8    2286571   LIBRARY?? OR SERVER?? OR MEMORY?? OR STORAGE?? OR DATA()(B-
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S10         9   AU=(HAIR A? OR HAIR, A?)
S11         1   (S2 OR S3 OR S4) AND (S5 OR S6) AND (S7 OR S8) AND S9
S12       837   (S2 OR S3 OR S4) AND (S5 OR S6) AND (S7 OR S8)
S13       819   S12 NOT AD=19911211:19940811/PR
S14       747   S13 NOT AD=19940811:19970811/PR
S15       515   S14 NOT AD=19970811:20000811/PR
S16       124   S15 NOT AD=20000811:20030811/PR
S17        10   S16 NOT AD=20030811:20060811/PR
S18         1   S10 AND (S2 OR S3 OR S4)
S19         1   S18 NOT (S11 OR S17)
```

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File 483:Newspaper Abs Daily 1986-2006/Aug 09
         (c) 2006 ProQuest Info&Learning
File 248:PIRA 1975-2006/Jul W4
         (c) 2006 Pira International

Set     Items   Description
S1    3886257   AUDIO? ? OR VIDEO?? OR MUSIC?? OR SONG?? OR MOVIE?? OR FIL-
              M? ?
S2       3697   (DOWNLOAD??? OR DOWN()LOAD???)(7N)S1
S3      25646   (INTERNET??? OR ONLINE OR ON()LINE OR WEBSITE?? OR WWW OR -
              WEB()SITE??)(7N)S1
S4      48990   (NETWORK? ? OR WAN? ? OR LAN? ? OR NET()WORK?? OR INTRANET-
              ??)(7N)S1
S5      32572   (BUY??? OR PUCHAS??? OR RENT??? OR PAY???? OR SELL??? OR S-
              ALE??? OR BOUGHT?? OR SOLD?? OR SHOPP????)(7N)S1
S6      34810   (CREDIT???? OR CHARG????)(5N)S1
S7     255889   (STOR??? OR SAV???? OR RECORD???? OR TAP???)(5N)S1
S8    2985962   LIBRARY?? OR SERVER?? OR MEMORY?? OR STORAGE?? OR DATA()(B-
              ASE?? OR BANK??) OR DATABASE?? OR DATABANK?? OR BULLETIN()BOA-
              RD?? OR BBS
S9     222805   AOL? ? OR COMPUSERV? ? OR COMPU()SERV? ? OR GENIE? ? OR PR-
              ODIGY? ? OR AMERICAN()ONLINE? ? OR EARTHLINK? ? OR EARTH()LIN-
              K?? OR DELPHI??
S10        40   AU=(HAIR A? OR HAIR, A?)
S11        67   (S2 OR S3 OR S4) AND (S5 OR S6) AND (S7 OR S8) AND S9
S12        67   RD  (unique items)
S13         1   S12 NOT PY>1991
S14      1506   (S2 OR S3 OR S4) AND (S5 OR S6) AND (S7 OR S8)
S15      1449   RD  (unique items)
```

S16	37	S15 NOT PY>1991
S17	36	S16 NOT S13
S18	2643	(S2 OR S3) AND S5
S19	2575	RD (unique items)
S20	7	S19 NOT PY>1991
S21	3	S20 NOT (S17 OR S13)
S22	0	S10 AND (S5 OR S6)

EAST R.C.F.

EAST Search History

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
L1	0	(704/104.1).CCLS.	US-PGPUB; USPAT	OR	OFF	2006/08/15 13:01
L2	5335	(707/104.1).CCLS.	US-PGPUB; USPAT	OR	OFF	2006/08/15 13:01
L3	107	2 and @ad<="19920101"	US-PGPUB; USPAT	OR	ON	2006/08/15 13:02
L4	991	2 and @ad<="19980101"	US-PGPUB; USPAT	OR	ON	2006/08/15 13:50
L5	378	4 and (voice or audio or movies or music)	US-PGPUB; USPAT	OR	ON	2006/08/15 13:51
L6	7290	(709/217,219).CCLS.	US-PGPUB; USPAT	OR	OFF	2006/08/15 13:50
L7	1038	6 and @ad<="19980101"	US-PGPUB; USPAT	OR	ON	2006/08/15 13:50
L8	530	7 and (voice or audio or movies or music)	US-PGPUB; USPAT	OR	ON	2006/08/15 13:51
L9	254	8 and (download$ or (down adj load))	US-PGPUB; USPAT	OR	ON	2006/08/15 13:51
S1	1	("5191573").PN.	US-PGPUB; USPAT	OR	OFF	2006/04/24 08:02
S2	1	("4528643").PN.	US-PGPUB; USPAT	OR	OFF	2006/04/20 11:59
S3	2	(("5675734") or ("5996440")).PN.	US-PGPUB; USPAT	OR	OFF	2006/04/20 12:00
S4	2	(("5675734") or ("5966440")).PN.	US-PGPUB; USPAT	OR	OFF	2006/04/20 12:00
S5	1	("4499568").PN.	US-PGPUB; USPAT	OR	OFF	2006/04/20 14:50
S19	54273	"379"/$.ccls.	US-PGPUB; USPAT	OR	ON	2006/04/24 08:17
S20	12829	S19 and (audio or (voice adj message))	US-PGPUB; USPAT	OR	ON	2006/04/24 08:17
S21	2884	S20 and (subscribe or subscription or buy or (credit adj card))	US-PGPUB; USPAT	OR	ON	2006/04/24 09:30
S22	267	S21 and @pn < "5300000"	US-PGPUB; USPAT	OR	ON	2006/04/24 08:44
S23	3895	"pay-per-view" or (pay adj3 view) and "379"/$.ccls.	US-PGPUB; USPAT	OR	ON	2006/04/24 09:08
S24	164	S23 and @pn < "5300000"	US-PGPUB; USPAT	OR	ON	2006/04/24 09:08
S25	4008	"pay-per-view" or (pay adj3 view) and isdn	US-PGPUB; USPAT	OR	ON	2006/04/24 09:08

EAST Search History

S26	705	("pay-per-view" or (pay adj3 view)) and isdn	US-PGPUB; USPAT	OR	ON	2006/04/24 09:09
S27	707	("pay-per-view" or (pay adj3 view)) and (isdn or idsn)	US-PGPUB; USPAT	OR	ON	2006/04/24 09:11
S28	6	S27 and @pn < "5300000"	US-PGPUB; USPAT	OR	ON	2006/04/24 09:09
S29	2964	music and (isdn or idsn)	US-PGPUB; USPAT	OR	ON	2006/04/24 09:11
S30	34	S29 and @pn < "5300000"	US-PGPUB; USPAT	OR	ON	2006/04/24 09:11
S31	23	("3766324" | "4332980" | "4381522" | "4506387" | "4654866" | "4755872" | "4761684" | "4763191" | "4792849" | "4797913" | "4807023" | "4829372" | "4849811" | "4852154" | "4890320" | "4897867" | "4949187" | "4995078" | "5010399" | "5014125" | "5130792" | "5132992" | "5133079").PN.	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 09:21
S32	572	(videotex or videotext or (video adj tex) or (video adj text)) and isdn	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 09:22
S33	23	S32 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 09:24
S34	652	((bulletin or Bulletin) adj board) and modem and music and (buy or order or credit)	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 09:26
S35	1	S34 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 09:25
S36	1973	((bulletin or Bulletin) adj board) and modem and video and (buy or order or credit)	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 09:27
S39	12	S36 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 09:28
S40	2126	((bulletin or Bulletin) adj board) and modem and video	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 09:27
S41	14	S40 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 09:29
S42	16087	isdn and video	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 09:30

EAST Search History

S43	329	S42 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 09:30
S44	42	S43 and (subscribe or subscription or buy or (credit adj card))	US-PGPUB; USPAT	OR	ON	2006/04/24 09:30
S45	18	(US-3718906-$ or US-4071697-$ or US-4500751-$ or US-4567359-$ or US-4649533-$ or US-4694490-$ or US-4789863-$ or US-4792849-$ or US-4837797-$ or US-4852154-$ or US-4665516-$ or US-4710955-$ or US-4829569-$ or US-4890319-$ or US-4893248-$ or US-5130792-$ or US-4849811-$ or US-4924492-$).did.	USPAT	OR	ON	2006/04/24 10:59
S46	1	("4789868").PN.	US-PGPUB; USPAT	OR	OFF	2006/04/24 11:00
S47	18	(US-4694490-$ or US-4649533-$ or US-4567359-$ or US-4500751-$ or US-4893248-$ or US-4890319-$ or US-4789863-$ or US-4852154-$ or US-4837797-$ or US-4792849-$ or US-4071697-$ or US-3718906-$ or US-4710955-$ or US-4665516-$ or US-4829569-$ or US-4849811-$ or US-4924492-$ or US-5130792-$).did.	USPAT	OR	ON	2006/04/24 12:39
S48	15	("3718906" | "4163254" | "4272791" | "4300040" | "4359631" | "4433207" | "4471379" | "4506387" | "4513315" | "4538176" | "4567512" | "4590516" | "4685131" | "4700386" | "Re31639").PN.	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 12:50
S49	45	("4789863").URPN.	USPAT	OR	ON	2006/04/24 13:43
S50	3	(("5191573") or ("5966440") or ("5675734")).PN.	US-PGPUB; USPAT	OR	OFF	2006/04/24 13:44
S51	14	("3718906" | "3990710" | "4124773" | "4506387" | "4521806" | "4528643" | "4538176" | "4567359" | "4647989" | "4654799" | "4789863" | "4789868" | "5191193" | "5191573").PN.	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 13:44
S52	44	("4124773").URPN.	USPAT	OR	ON	2006/04/24 13:50
S53	1070	(455/412.1).CCLS.	US-PGPUB; USPAT	OR	OFF	2006/04/24 13:50
S54	0	("7and@pn<5200000").PN.	US-PGPUB; USPAT	OR	OFF	2006/04/24 13:51
S55	11	S53 and (@pn < "5200000")	US-PGPUB; USPAT	OR	ON	2006/04/24 13:53
S56	593	(379/88.13).CCLS.	US-PGPUB; USPAT	OR	OFF	2006/04/24 14:03

EAST Search History

S57	27	S56 and (@pn < "5200000")	US-PGPUB; USPAT	OR	ON	2006/04/24 14:04
S58	740	(379/88.17).CCLS.	US-PGPUB; USPAT	OR	OFF	2006/04/24 14:03
S59	6	S58 and (@pn < "5200000")	US-PGPUB; USPAT	OR	ON	2006/04/24 14:04
S60	10567	(video and (charge or buy or credit)) and (@pn < "5200000")	US-PGPUB; USPAT	OR	ON	2006/04/24 14:05
S61	430	(video and (credit adj card)) and (@pn < "5200000")	US-PGPUB; USPAT	OR	ON	2006/04/24 15:36
S62	181	S61 and network	US-PGPUB; USPAT	OR	ON	2006/04/24 14:06
S63	243	(video and audio and (download$ or (down adj load$))) and (@pn < "5200000")	US-PGPUB; USPAT	OR	ON	2006/04/24 14:13
S64	157	S63 and network	US-PGPUB; USPAT	OR	ON	2006/04/24 14:13
S65	209	S63 and (network or communication)	US-PGPUB; USPAT	OR	ON	2006/04/24 14:14
S66	38	("3599178" | "3746780" | "4009344" | "4009346" | "4028733" | "4062043" | "4071697" | "4122299" | "4381522" | "4400717" | "4450477" | "4506387" | "4518989" | "4521806" | "4533936" | "4538176" | "4567512" | "4590516" | "4679079" | "4688246" | "4734765" | "4755872" | "4763191" | "4785349" | "4807023" | "4833710" | "4847677" | "4868653" | "4890320" | "4907081" | "4914508" | "4920432" | "4937821" | "4947244" | "4949169" | "4949187" | "4963995" | "5032927").PN.	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 15:30
S67	4	(("4963995") or ("5995705") or ("5057932") or ("5164839")).PN.	US-PGPUB; USPAT	OR	OFF	2006/04/24 15:32
S68	9	("4179709" | "4400717" | "4516156" | "4698664" | "4709418" | "4724491" | "4768110" | "4774574" | "4851931"). PN.	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 15:35
S69	29448	audio and video and (hard adj (drive or disk)) and network	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 15:36
S70	104	S69 and (@pn < "5200000")	US-PGPUB; USPAT	OR	ON	2006/04/24 16:28
S71	4959	music same download$	US-PGPUB; USPAT	OR	ON	2006/04/24 16:28
S72	7	S71 and (@pn < "5200000")	US-PGPUB; USPAT	OR	ON	2006/04/24 16:32

EAST Search History

S73	1	("4949187").PN.	US-PGPUB; USPAT	OR	OFF	2006/04/24 16:30
S74	7	("3718906" | "3990710" | "4232295" | "4597058" | "4597098" | "4769833" | "4789961").PN.	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 16:30
S75	261	("4949187").URPN.	USPAT	OR	ON	2006/04/24 16:32
S76	1372	music and isdn	USPAT	OR	ON	2006/04/24 16:32
S77	27	S76 and (@pn < "5200000")	US-PGPUB; USPAT	OR	ON	2006/04/24 16:45
S78	394	audio and music and (download$ or (down adj load$))	EPO; JPO; DERWENT; IBM_TDB	OR	ON	2006/04/24 16:40
S79	24	audio and music and isdn	EPO; JPO; DERWENT; IBM_TDB	OR	ON	2006/04/24 16:41
S80	341	audio and video and isdn	EPO; JPO; DERWENT; IBM_TDB	OR	ON	2006/04/24 16:42
S81	690	audio and video and (charge or buy or (credit adj card))	EPO; JPO; DERWENT; IBM_TDB	OR	ON	2006/04/24 16:43
S82	192	audio and video and (charge or buy or (credit adj card)) and (communications or network)	EPO; JPO; DERWENT; IBM_TDB	OR	ON	2006/04/24 16:44
S83	56788	(digital adj3 (audio or video)) and (network or communication)	US-PGPUB; USPAT	OR	ON	2006/04/24 16:45
S84	2209	S83 and (@pn < "5200000")	US-PGPUB; USPAT	OR	ON	2006/04/24 16:45
S85	12261	(digital adj3 (audio or video)) and (network or communication) and (buy or charge or (credit adj card))	US-PGPUB; USPAT	OR	ON	2006/04/24 17:06
S86	448	S85 and (@pn < "5200000")	US-PGPUB; USPAT	OR	ON	2006/04/24 17:06
S87	5130	(digital adj3 (audio or video)) and (network or communication) and (buy or (credit adj card))	US-PGPUB; USPAT	OR	ON	2006/04/24 17:06
S88	9207	(digital adj3 (audio or video)) and (network or communication) and (buy or purchase or (credit adj card))	US-PGPUB; USPAT	OR	ON	2006/04/24 17:06
S89	105	S88 and (@pn < "5200000")	US-PGPUB; USPAT	OR	ON	2006/04/24 17:40
S90	41	(real adj audio) and (bulletin adj board)	US-PGPUB; USPAT	OR	ON	2006/04/24 17:40
S91	41	(real adj audio) and (bullet$1n adj board)	US-PGPUB; USPAT	OR	ON	2006/04/24 17:40

EAST Search History

S92	41	(real adj audio) and (bull$1tin adj board)	US-PGPUB; USPAT	OR	ON	2006/04/24 17:41
S94	104	(bull$1tin adj board) and (download$ near3 audio)	US-PGPUB; USPAT	OR	ON	2006/04/24 17:42
S95	13	(bull$1tin adj board) and kermit	US-PGPUB; USPAT	OR	ON	2006/04/24 17:44
S96	3548	(bull$1tin adj board) and (audio or video)	US-PGPUB; USPAT	OR	ON	2006/04/24 17:43
S97	204	(computer adj bull$1tin adj board)	US-PGPUB; USPAT	OR	ON	2006/04/24 17:44
S98	116	(computer adj bull$1tin adj board) and (audio and video)	US-PGPUB; USPAT	OR	ON	2006/04/25 13:12
S99	101	zmodem	US-PGPUB; USPAT	OR	ON	2006/04/25 13:12
S100	33	zmodem and audio	US-PGPUB; USPAT	OR	ON	2006/04/25 13:13
S101	41	zmodem and video	US-PGPUB; USPAT	OR	ON	2006/04/25 13:14
S102	46	ymodem	US-PGPUB; USPAT	OR	ON	2006/04/25 13:14
S103	33	S102 and (audio or video)	US-PGPUB; USPAT	OR	ON	2006/04/25 13:15
S104	159	xmodem	US-PGPUB; USPAT	OR	ON	2006/04/25 13:15
S105	82	S104 and (audio or video)	US-PGPUB; USPAT	OR	ON	2006/04/25 13:17
S106	4094	download$ adj5 (audio or video)	US-PGPUB; USPAT	OR	ON	2006/04/25 13:17
S107	39	S106 and @pn < "5300000"	US-PGPUB; USPAT	OR	ON	2006/04/25 13:17
S108	32	("3263158" | "4529870" | "4658093" | "4924378" | "4932054" | "4937863" | "4953209" | "4961142" | "4977594" | "5010571" | "5014234" | "5023907" | "5047928" | "5050213" | "5058164" | "5103476" | "5113519" | "5146499" | "5159182" | "5191193" | "5204897" | "5235642" | "5247575" | "5260999" | "5263157" | "5291596" | "5339091" | "5432849" | "5438508" | "5504814" | "5530235").PN.	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/25 14:11
S109	1	("4636876").PN.	US-PGPUB; USPAT	OR	OFF	2006/04/25 14:44
S110	5	(("5428606") or ("5132992") or ("5130792") or ("4999806") or ("re35184")).PN.	US-PGPUB; USPAT	OR	OFF	2006/04/25 14:49

EAST Search History

S111	7	(("3244809") or ("3696297") or ("3718906") or ("3824597") or ("3947882") or ("3990710") or ("4028733")).PN.	US-PGPUB; USPAT	OR	OFF	2006/04/25 14:51
S112	11	(("4124773") or ("4300040") or ("4335809") or ("4370649") or ("4422093") or ("4499568") or ("4506387") or ("4520404") or ("4521806") or ("4521857") or ("4586430")).PN.	US-PGPUB; USPAT	OR	OFF	2006/04/25 15:04
S113	12	(("4533948") or ("4536856") or ("4538176") or ("4567359") or ("4567512") or ("4605973") or ("4647989") or ("4648037") or ("4658093") or ("4667802") or ("4672613") or ("4674055")).PN.	US-PGPUB; USPAT	OR	OFF	2006/04/25 15:05
S114	12	(("4688105") or ("4703465") or ("4725977") or ("4739510") or ("4754483") or ("4755872") or ("4759060") or ("4761684") or ("4763317") or ("4766581") or ("4787050") or ("4789863")).PN.	US-PGPUB; USPAT	OR	OFF	2006/04/25 15:27
S115	12	(("4792849") or ("4797918") or ("4829372") or ("4894789") or ("4918588") or ("4949187") or ("5003384") or ("5019900") or ("5041921") or ("5089885") or ("5099422") or ("5191410")).PN.	US-PGPUB; USPAT	OR	OFF	2006/04/25 16:20
S116	7	compusonic	US-PGPUB; USPAT	OR	ON	2006/04/25 16:22
S117	5322	bbs and (audio or video)	US-PGPUB; USPAT	OR	ON	2006/04/25 16:33
S118	739	S117 and @pn < "5300000"	US-PGPUB; USPAT	OR	ON	2006/04/25 16:33
S119	1661	bbs and (audio and video)	US-PGPUB; USPAT	OR	ON	2006/04/25 16:33
S120	95	S119 and @pn < "5300000"	US-PGPUB; USPAT	OR	ON	2006/04/25 17:05
S121	2	(("4870515") or ("4528643")).PN.	US-PGPUB; USPAT	OR	OFF	2006/04/25 17:05

EAST Search History

S122	40	(US-4694490-$ or US-4649533-$ or US-4567359-$ or US-4500751-$ or US-4893248-$ or US-4890319-$ or US-4789863-$ or US-4852154-$ or US-4837797-$ or US-4792849-$ or US-4071697-$ or US-3718906-$ or US-4710955-$ or US-4665516-$ or US-4829569-$ or US-4849811-$ or US-4924492-$ or US-5130792-$ or US-4538176-$ or US-4300040-$ or US-4521806-$ or US-4124773-$ or US-4829372-$ or US-4916737-$ or US-4623920-$ or US-4866770-$).did. or (US-4956768-$ or US-4949187-$ or US-4920432-$ or US-4894789-$ or US-4839745-$ or US-5113518-$ or US-4872151-$ or US-4724521-$ or US-5083271-$ or US-4658093-$ or US-4499568-$ or US-4422093-$ or US-5003384-$ or US-4935870-$).did.	USPAT	OR	ON	2006/04/26 08:38
S123	56	("3347988" | "3444324" | "3444550" | "3448216" | "3471648" | "3590381" | "3969680").PN. OR ("4124773").URPN.	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 09:02
S124	14870	music and (hard adj (drive or disk))	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 09:28
S125	165	S124 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 09:29
S126	36749	audio and video and (hard adj (drive or disk))	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:09
S127	373	S126 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 09:29
S128	7619	audio same video same (hard adj (drive or disk))	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 09:54
S129	82	S128 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 09:55
S130	1863	((audio or video) near5 (stored or store or storing)) near5 (hard adj (drive or disk))	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:09
S131	11	S130 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:10
S132	34	(disk adj streamer)	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 09:58

EAST Search History

S133	109	(audio and video and (hard adj (drive or disk))).ab.	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:10
S134	440	((hard adj (drive or disk)) and (audio or video)).ab.	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:11
S135	8	S134 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:21
S136	6078	((hard adj (drive or disk)) and (audio or video)).ab.	EPO; JPO; DERWENT	OR	ON	2006/04/26 10:12
S137	1784	((hard adj (drive or disk)) and (audio and video)).ab.	EPO; JPO; DERWENT	OR	ON	2006/04/26 10:20
S138	327	((hard adj (drive or disk)) near5 (audio and video)).ab.	EPO; JPO; DERWENT	OR	ON	2006/04/26 10:12
S139	2956	media near5 (hard adj (drive or disk))	EPO; JPO; DERWENT	OR	ON	2006/04/26 10:21
S140	2442	media near5 (hard adj (drive or disk)). ab.	EPO; JPO; DERWENT	OR	ON	2006/04/26 10:21
S141	19496	media near5 (hard adj (drive or disk))	USPAT	OR	ON	2006/04/26 10:21
S142	434	S141 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:53
S143	163	S142 and (video or audio)	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:50
S144	70	adlib	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:51
S145	90	jukebox and (sound adj card)	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:53
S146	1431	library and (sound adj card)	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:53
S147	0	S146 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:53
S148	0	".wav" and (sound adj card)	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:53
S149	534	"wav" and (sound adj card)	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:53

EAST Search History

S150	0	S149 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:57
S151	1269	(digital adj audio) same (hard adj (drive or disk))	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:56
S152	27	S151 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 11:16
S153	934	(compact adj disc adj player) and (hard adj (drive or disk))	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 11:18
S154	41	S153 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 11:21
S155	517	(compact adj disc adj player) and menu	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 11:21
S156	30	S155 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 14:10
S157	2921	(compact adj disc) and (artist or composer)	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 11:21
S158	192	(compact adj disc) and (search near5 (artist or composer))	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 11:21
S159	1	S158 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 11:39
S160	8	("3999050" | "4279022" | "4628193" | "4634845" | "4912640" | "4961158" | "5047614" | "Re32655").PN.	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 11:39
S161	12167	mpeg and (hard adj (disk or drive))	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 11:39
S162	1	S159 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 12:25
S163	22	"4870515"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 12:25

EAST Search History

S164	52	(US-4694490-$ or US-4649533-$ or US-4567359-$ or US-4500751-$ or US-4893248-$ or US-4890319-$ or US-4789863-$ or US-4852154-$ or US-4837797-$ or US-4792849-$ or US-4071697-$ or US-3718906-$ or US-4710955-$ or US-4665516-$ or US-4829569-$ or US-4849811-$ or US-4924492-$ or US-5130792-$ or US-4538176-$ or US-4300040-$ or US-4521806-$ or US-4124773-$ or US-4829372-$ or US-4916737-$ or US-4623920-$ or US-4866770-$).did. or (US-4956768-$ or US-4949187-$ or US-4920432-$ or US-4894789-$ or US-4839745-$ or US-5113518-$ or US-4872151-$ or US-4724521-$ or US-5083271-$ or US-4658093-$ or US-4499568-$ or US-4422093-$ or US-5003384-$ or US-4935870-$ or US-4864301-$ or US-4905003-$ or US-5065345-$ or US-5041921-$ or US-5040110-$ or US-5034980-$ or US-5012334-$ or US-4974178-$ or US-4851931-$ or US-4763207-$ or US-4527262-$ or US-4873589-$).did.	USPAT	OR	ON	2006/04/26 14:09
S166	8	S164 and record.ab.	USPAT	OR	ON	2006/04/26 12:48
S167	2799	video adj clips	USPAT	OR	ON	2006/04/26 14:09
S168	19	S167 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 14:14
S169	7	((download or downloading) adj3 video) and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 14:13
S170	343	videotext	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 14:13
S171	118	S170 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 14:14
S172	1	("5191573").PN.	US-PGPUB; USPAT	OR	OFF	2006/08/11 11:44

EAST Search History

S173	53	(US-4916737-$ or US-4789863-$ or US-4665516-$ or US-4694490-$ or US-5003384-$ or US-4890319-$ or US-4071697-$ or US-4567359-$ or US-4893248-$ or US-4724521-$ or US-4837797-$ or US-4710955-$ or US-4500751-$ or US-3718906-$ or US-4866770-$ or US-4792849-$ or US-4829569-$ or US-4852154-$ or US-4849811-$ or US-4829372-$ or US-4924492-$ or US-4920432-$ or US-4949187-$ or US-5130792-$ or US-4300040-$ or US-4521806-$).did. or (US-4124773-$ or US-4538176-$ or US-5083271-$ or US-4864301-$ or US-4905003-$ or US-4935870-$ or US-4623920-$ or US-4450477-$ or US-5012334-$ or US-4956768-$ or US-4839745-$ or US-4851931-$ or US-4894789-$ or US-4499568-$ or US-4872151-$ or US-5113518-$ or US-4422093-$ or US-4658093-$ or US-5041921-$ or US-5065345-$ or US-5034980-$ or US-4763207-$ or US-4527262-$ or US-5040110-$ or US-4974178-$ or US-4873589-$ or US-4649533-$).did.	USPAT	OR	ON	2006/08/11 12:35
S174	35	S173 and (buy or pay or credit or purchase)	USPAT	OR	ON	2006/08/11 12:36
S175	22	S173 and (credit)	USPAT	OR	ON	2006/08/11 16:32
S176	1	("4789863").PN.	US-PGPUB; USPAT	OR	OFF	2006/08/11 16:34
S177	1	("4870515").PN.	US-PGPUB; USPAT	OR	OFF	2006/08/11 16:55
S178	1	("4789863").PN.	US-PGPUB; USPAT	OR	OFF	2006/08/14 11:39
S179	1	("4870515").PN.	US-PGPUB; USPAT	OR	OFF	2006/08/14 11:39
S180	1	("4870515").PN.	US-PGPUB; USPAT	OR	OFF	2006/08/15 11:37
S181	1	burks$.in. and boska$.in.	US-PGPUB; USPAT	OR	ON	2006/08/15 12:15
S182	1	("5191573").PN.	US-PGPUB; USPAT	OR	OFF	2006/08/15 12:25
S183	142	itunes	US-PGPUB; USPAT	OR	ON	2006/08/15 12:25

EAST Search History

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
S1	5	(("5130792") or ("4949187") or ("4920432") or ("4829372") or ("4789863")).PN.	US-PGPUB; USPAT	OR	OFF	2006/08/01 14:09
S2	200	("5130792").URPN.	USPAT	OR	ON	2006/08/01 15:25
S3	1	("4949187").PN.	US-PGPUB; USPAT	OR	OFF	2006/08/01 15:25
S4	278	("4949187").URPN.	USPAT	OR	ON	2006/08/01 15:27
S6	194	S4 not S2	USPAT	OR	ON	2006/08/01 15:27
S7	8	("4506387" | "4709418" | "4949187" | "5144661" | "5172413" | "5216515" | "5218454" | "5229850").PN.	US-PGPUB; USPAT; USOCR	OR	ON	2006/08/01 17:09
S8	200	("5130792").URPN.	USPAT	OR	ON	2006/08/01 17:40
S9	1	("4920432").PN.	US-PGPUB; USPAT	OR	OFF	2006/08/01 17:40
S10	123	("4920432").URPN.	USPAT	OR	ON	2006/08/03 11:58
S11	1	("4829372").PN.	US-PGPUB; USPAT	OR	OFF	2006/08/03 11:59
S12	112	("4829372").URPN.	USPAT	OR	ON	2006/08/03 12:41
S13	1	("4789863").PN.	US-PGPUB; USPAT	OR	OFF	2006/08/03 13:14
S14	45	("4789863").URPN.	USPAT	OR	ON	2006/08/03 12:44
S15	1	("5721827").PN.	US-PGPUB; USPAT	OR	OFF	2006/08/03 12:44
S16	25	("5966440").URPN.	USPAT	OR	ON	2006/08/03 12:58
S17	1	("5133079").PN.	US-PGPUB; USPAT	OR	OFF	2006/08/03 13:14
S18	204	("5133079").URPN.	USPAT	OR	ON	2006/08/03 13:35
S19	1	("5172413").PN.	US-PGPUB; USPAT	OR	OFF	2006/08/03 13:35
S20	190	("5172413").URPN.	USPAT	OR	ON	2006/08/03 13:40
S21	3	(("5191573") or ("5966440") or ("5675734")).PN.	US-PGPUB; USPAT	OR	OFF	2006/08/03 13:41
S22	76	("5191573").URPN.	USPAT	OR	ON	2006/08/03 13:41
S23	74	("5675734").URPN.	USPAT	OR	ON	2006/08/03 13:43

EAST Search History

S24	31	(US-7017178-$ or US-6463207-$ or US-5717814-$ or US-5544228-$ or US-5528281-$ or US-5253275-$ or US-5132992-$ or US-5133079-$ or US-5172413-$ or US-5696869-$ or US-5550863-$ or US-5790174-$ or US-5594490-$ or US-5247347-$ or US-5220420-$ or US-5181107-$ or US-5119188-$ or US-5014125-$ or US-6609105-$ or US-6496802-$ or US-6072982-$ or US-5966440-$ or US-5745678-$ or US-5636276-$ or US-5555441-$ or US-5390172-$).did. or (US-5497502-$ or US-5410343-$ or US-5394182-$ or US-5371532-$ or US-6002720-$).did.	USPAT	OR	ON	2006/08/03 13:47
S25	93	("20010033659" | "3990710" | "4054911" | "4300040" | "4355338" | "4449198" | "4468751" | "4481412" | "4506387" | "4521806" | "4703456" | "4725977" | "4789863" | "4792849" | "4811325" | "4851931" | "4924303" | "4937807" | "5021893" | "5041921" | "5051822" | "5084768" | "5099422" | "5168481" | "5208665" | "5233477" | "5237157" | "5260778" | "5267351" | "5319707" | "5319774" | "5355302" | "5365381" | "5400401" | "5418654" | "5440637" | "5481296" | "5502601" | "5532920" | "5541638" | "5557541" | "5563665" | "5572442" | "5585866" | "5592511" | "5600573" | "5627867" | "5629733" | "5629867" | "5629980" | "5633839" | "5638443" | "5646992" | "5661787" | "5675734" | "5689648" | "5703795" | "5715403" | "5721827" | "5726909" | "5734961" | "5758257" | "5794217" | "5806068" | "5809246" | "5815471" | "5845262" | "5877755" | "5894119" | "5900830" | "5913204" | "5915090" | "5918213" | "5931901" | "5949411" | "5949476" | "5956491" | "5959944" | "5959945" | "5960411" | "5963916" | "5974004" | "5987525" | "6005597" | "6006251" | "6011758" | "6014184" | "6044403" | "6061680" | "6088455" | "6088710" | "6092105" | "6092197").PN.	US-PGPUB; USPAT; USOCR	OR	ON	2006/08/03 14:44
S26	45	("4789863").URPN.	USPAT	OR	ON	2006/08/03 14:46
S27	100	("4710921" | "4789863" | "4790010" | "4991207" | "5191611" | "5208665"). PN. OR ("5636276").URPN.	US-PGPUB; USPAT; USOCR	OR	ON	2006/08/03 16:28

EAST Search History

S28	19	("4956768" | "5113496" | "5191410" | "5195092" | "5418713" | "5423003" | "5550577" | "5555441" | "5560038" | "5583763" | "5590282" | "5619247" | "5636276" | "5729281" | "5756280" | "5781889" | "5790423" | "5867155" | "5870553").PN.	US-PGPUB; USPAT; USOCR	OR	ON	2006/08/03 16:44

EAST Search History

S29	264	("20010002852" | "20010003846" | "20010005906" | "20010010045" | "20010010095" | "20010013037" | "20010013120" | "20010014882" | "20010016836" | "20010017920" | "20010018742" | "20010018858" | "20010023416" | "20010023417" | "20010023428" | "20010024425" | "20010024566" | "20010025259" | "20010025269" | "20010025316" | "20010027561" | "20010027563" | "20010029491" | "20010029538" | "20010029583" | "20010030660" | "20010031066" | "20010032131" | "20010032132" | "20010032133" | "20010032187" | "20010032312" | "20010034635" | "20010034714" | "20010034883" | "20020057799" | "20020062261" | "20020066025" | "20020073038" | "3373517" | "3376465" | "3848193" | "3941926" | "3983317" | "3993955" | "4094010" | "4155042" | "4332022" | "4368485" | "4476488" | "4536791" | "4559480" | "4575750" | "4595950" | "4654482" | "4716410" | "4734779" | "4734858" | "4761641" | "4789863" | "4797913" | "4809325" | "4812843" | "4829569" | "4847825" | "4862268" | "4908713" | "4949187" | "5046090" | "5051822" | "5073925" | "5107107" | "5121430" | "5123046" | "5133079" | "5182669" | "5191573" | "5214793" | "5233423" | "5235587" | "5251193" | "5257017" | "5260778" | "5274762" | "5283731" | "5297204" | "5311423" | "5319735" | "5355302" | "5365282" | "5373330" | "5414756" | "5418713" | "5420647" | "5420923" | "5428606" | "5438355" | "5465291" | "5469020" | "5469206" | "5473584" | "5486819" | "5495283" | "5497186" | "5497479" | "5508815" | "5512935" | "5513260" | "5530751" | "5532920" | "5543856" | "5557541"). PN. OR ("5559549" | "5565909" | "5568272" | "5592511" | "5592551" | "5592626" | "5600839" | "5610653" | "5612741" | "5619247" | "5621840" | "5621863" | "5627895" | "5628050" | "5630067" | "5638113" | "5640453" | "5644859" | "5646603" | "5646997" | "5654747" | "5659366" | "5659613" | "5661516" | "5664018" | "5675734" | "5684918" | "5686954" | "5689799" | "5692214" | "5701161" | "5701383" | "5701397" | "5710869" | "5717814" | "5717832" | "5721827" | "5721951" | "5724062" | "5724091" | "5724525" | "5729214" | "5734413" | "5740326" |	US-PGPUB; USPAT; USOCR	OR	ON	2006/08/04 12:42

EAST Search History

S30	46	(US-7017178-$ or US-6463207-$ or US-5717814-$ or US-5544228-$ or US-5528281-$ or US-5253275-$ or US-5132992-$ or US-5133079-$ or US-5172413-$ or US-5696869-$ or US-5550863-$ or US-5790174-$ or US-5594490-$ or US-5247347-$ or US-5220420-$ or US-5181107-$ or US-5119188-$ or US-5014125-$ or US-6609105-$ or US-6496802-$ or US-6072982-$ or US-5966440-$ or US-5745678-$ or US-5636276-$ or US-5555441-$ or US-5390172-$).did. or (US-5497502-$ or US-5410343-$ or US-5394182-$ or US-5371532-$ or US-6002720-$ or US-5041921-$ or US-5267351-$ or US-5418654-$ or US-5638443-$ or US-5734961-$ or US-4789863-$ or US-6182128-$ or US-4956768-$ or US-5191410-$ or US-5195092-$ or US-5418713-$ or US-5550577-$ or US-5619247-$ or US-5781889-$ or US-5790423-$).did.	USPAT	OR	ON	2006/08/07 15:23
S31	1	("5191573").PN.	US-PGPUB; USPAT	OR	OFF	2006/08/08 11:53
S32	1	("5436960").PN.	US-PGPUB; USPAT	OR	OFF	2006/08/08 11:53

EAST Search History

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
S1	5	(("5130792") or ("4949187") or ("4920432") or ("4829372") or ("4789863")).PN.	US-PGPUB; USPAT	OR	OFF	2006/08/01 14:09
S2	200	("5130792").URPN.	USPAT	OR	ON	2006/08/01 15:25
S3	1	("4949187").PN.	US-PGPUB; USPAT	OR	OFF	2006/08/01 15:25
S4	278	("4949187").URPN.	USPAT	OR	ON	2006/08/01 15:27
S6	194	S4 not S2	USPAT	OR	ON	2006/08/01 15:27
S7	8	("4506387" | "4709418" | "4949187" | "5144661" | "5172413" | "5216515" | "5218454" | "5229850").PN.	US-PGPUB; USPAT; USOCR	OR	ON	2006/08/01 17:09
S8	200	("5130792").URPN.	USPAT	OR	ON	2006/08/01 17:40
S9	1	("4920432").PN.	US-PGPUB; USPAT	OR	OFF	2006/08/01 17:40
S10	123	("4920432").URPN.	USPAT	OR	ON	2006/08/03 11:58
S11	1	("4829372").PN.	US-PGPUB; USPAT	OR	OFF	2006/08/03 11:59
S12	112	("4829372").URPN.	USPAT	OR	ON	2006/08/03 12:41
S13	1	("4789863").PN.	US-PGPUB; USPAT	OR	OFF	2006/08/03 13:14
S14	45	("4789863").URPN.	USPAT	OR	ON	2006/08/03 12:44
S15	1	("5721827").PN.	US-PGPUB; USPAT	OR	OFF	2006/08/03 12:44
S16	25	("5966440").URPN.	USPAT	OR	ON	2006/08/03 12:58
S17	1	("5133079").PN.	US-PGPUB; USPAT	OR	OFF	2006/08/03 13:14
S18	204	("5133079").URPN.	USPAT	OR	ON	2006/08/03 13:35
S19	1	("5172413").PN.	US-PGPUB; USPAT	OR	OFF	2006/08/03 13:35
S20	190	("5172413").URPN.	USPAT	OR	ON	2006/08/03 13:40
S21	3	(("5191573") or ("5966440") or ("5675734")).PN.	US-PGPUB; USPAT	OR	OFF	2006/08/03 13:41
S22	76	("5191573").URPN.	USPAT	OR	ON	2006/08/03 13:41
S23	74	("5675734").URPN.	USPAT	OR	ON	2006/08/03 13:43

EAST Search History

S24	31	(US-7017178-$ or US-6463207-$ or US-5717814-$ or US-5544228-$ or US-5528281-$ or US-5253275-$ or US-5132992-$ or US-5133079-$ or US-5172413-$ or US-5696869-$ or US-5550863-$ or US-5790174-$ or US-5594490-$ or US-5247347-$ or US-5220420-$ or US-5181107-$ or US-5119188-$ or US-5014125-$ or US-6609105-$ or US-6496802-$ or US-6072982-$ or US-5966440-$ or US-5745678-$ or US-5636276-$ or US-5555441-$ or US-5390172-$). did. or (US-5497502-$ or US-5410343-$ or US-5394182-$ or US-5371532-$ or US-6002720-$). did.	USPAT	OR	ON	2006/08/03 13:47

EAST Search History

S25	93	("20010033659" | "3990710" | "4054911" | "4300040" | "4355338" | "4449198" | "4468751" | "4481412" | "4506387" | "4521806" | "4703456" | "4725977" | "4789863" | "4792849" | "4811325" | "4851931" | "4924303" | "4937807" | "5021893" | "5041921" | "5051822" | "5084768" | "5099422" | "5168481" | "5208665" | "5233477" | "5237157" | "5260778" | "5267351" | "5319707" | "5319774" | "5355302" | "5365381" | "5400401" | "5418654" | "5440637" | "5481296" | "5502601" | "5532920" | "5541638" | "5557541" | "5563665" | "5572442" | "5585866" | "5592511" | "5600573" | "5627867" | "5629733" | "5629867" | "5629980" | "5633839" | "5638443" | "5646992" | "5661787" | "5675734" | "5689648" | "5703795" | "5715403" | "5721827" | "5726909" | "5734961" | "5758257" | "5794217" | "5806068" | "5809246" | "5815471" | "5845262" | "5877755" | "5894119" | "5900830" | "5913204" | "5915090" | "5918213" | "5931901" | "5949411" | "5949476" | "5956491" | "5959944" | "5959945" | "5960411" | "5963916" | "5974004" | "5987525" | "6005597" | "6006251" | "6011758" | "6014184" | "6044403" | "6061680" | "6088455" | "6088710" | "6092105" | "6092197").PN.	US-PGPUB; USPAT; USOCR	OR	ON	2006/08/03 14:44
S26	45	("4789863").URPN.	USPAT	OR	ON	2006/08/03 14:46
S27	100	("4710921" | "4789863" | "4790010" | "4991207" | "5191611" | "5208665").PN. OR ("5636276"). URPN.	US-PGPUB; USPAT; USOCR	OR	ON	2006/08/03 16:28
S28	19	("4956768" | "5113496" | "5191410" | "5195092" | "5418713" | "5423003" | "5550577" | "5555441" | "5560038" | "5583763" | "5590282" | "5619247" | "5636276" | "5729281" | "5756280" | "5781889" | "5790423" | "5867155" | "5870553").PN.	US-PGPUB; USPAT; USOCR	OR	ON	2006/08/03 16:44

EAST Search History

S29	264	("20010002852" | "20010003846" | "20010005906" | "20010010045" | "20010010095" | "20010013037" | "20010013120" | "20010014882" | "20010016836" | "20010017920" | "20010018742" | "20010018858" | "20010023416" | "20010023417" | "20010023428" | "20010024425" | "20010024566" | "20010025259" | "20010025269" | "20010025316" | "20010027561" | "20010027563" | "20010029491" | "20010029538" | "20010029583" | "20010030660" | "20010031066" | "20010032131" | "20010032132" | "20010032133" | "20010032187" | "20010032312" | "20010034635" | "20010034714" | "20010034883" | "20020057799" | "20020062261" | "20020066025" | "20020073038" | "3373517" | "3376465" | "3848193" | "3941926" | "3983317" | "3993955" | "4094010" | "4155042" | "4332022" | "4368485" | "4476488" | "4536791" | "4559480" | "4575750" | "4595950" | "4654482" | "4716410" | "4734779" | "4734858" | "4761641" | "4789863" | "4797913" | "4809325" | "4812843" | "4829569" | "4847825" | "4862268" | "4908713" | "4949187" | "5046090" | "5051822" | "5073925" | "5107107" | "5121430" | "5123046" | "5133079" | "5182669" | "5191573" | "5214793" | "5233423" | "5235587" | "5251193" | "5257017" | "5260778" | "5274762" | "5283731" | "5297204" | "5311423" | "5319735" | "5355302" | "5365282" | "5373330" | "5414756" | "5418713" | "5420647" | "5420923" | "5428606" | "5438355" | "5465291" | "5469020" | "5469206" | "5473584" | "5486819" | "5495283" | "5497186" | "5497479" | "5508815" | "5512935" | "5513260" | "5530751" | "5532920" | "5543856" | "5557541").PN. OR ("5559549" | "5565909" | "5568272" | "5592511" | "5592551" | "5592626" | "5600839" | "5610653" | "5612741" | "5619247" | "5621840" | "5621863" | "5627895" | "5628050" | "5630067" | "5638113" | "5640453" | "5644859" | "5646603" | "5646997" | "5654747" | "5659366" | "5659613" | "5661516" | "5664018"	US-PGPUB; USPAT; USOCR	OR	ON	2006/08/04 12:42

EAST Search History

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
S1	1	("5191573").PN.	US-PGPUB; USPAT	OR	OFF	2006/04/24 08:02
S2	1	("4528643").PN.	US-PGPUB; USPAT	OR	OFF	2006/04/20 11:59
S3	2	(("5675734") or ("5996440")).PN.	US-PGPUB; USPAT	OR	OFF	2006/04/20 12:00
S4	2	(("5675734") or ("5966440")).PN.	US-PGPUB; USPAT	OR	OFF	2006/04/20 12:00
S5	1	("4499568").PN.	US-PGPUB; USPAT	OR	OFF	2006/04/20 14:50
S19	54273	"379"/$.ccls.	US-PGPUB; USPAT	OR	ON	2006/04/24 08:17
S20	12829	S19 and (audio or (voice adj message))	US-PGPUB; USPAT	OR	ON	2006/04/24 08:17
S21	2884	S20 and (subscribe or subscription or buy or (credit adj card))	US-PGPUB; USPAT	OR	ON	2006/04/24 09:30
S22	267	S21 and @pn < "5300000"	US-PGPUB; USPAT	OR	ON	2006/04/24 08:44
S23	3895	"pay-per-view" or (pay adj3 view) and "379"/$.ccls.	US-PGPUB; USPAT	OR	ON	2006/04/24 09:08
S24	164	S23 and @pn < "5300000"	US-PGPUB; USPAT	OR	ON	2006/04/24 09:08
S25	4008	"pay-per-view" or (pay adj3 view) and isdn	US-PGPUB; USPAT	OR	ON	2006/04/24 09:08
S26	705	("pay-per-view" or (pay adj3 view)) and isdn	US-PGPUB; USPAT	OR	ON	2006/04/24 09:09
S27	707	("pay-per-view" or (pay adj3 view)) and (isdn or idsn)	US-PGPUB; USPAT	OR	ON	2006/04/24 09:11
S28	6	S27 and @pn < "5300000"	US-PGPUB; USPAT	OR	ON	2006/04/24 09:09
S29	2964	music and (isdn or idsn)	US-PGPUB; USPAT	OR	ON	2006/04/24 09:11
S30	34	S29 and @pn < "5300000"	US-PGPUB; USPAT	OR	ON	2006/04/24 09:11
S31	23	("3766324" | "4332980" | "4381522" | "4506387" | "4654866" | "4755872" | "4761684" | "4763191" | "4792849" | "4797913" | "4807023" | "4829372" | "4849811" | "4852154" | "4890320" | "4897867" | "4949187" | "4995078" | "5010399" | "5014125" | "5130792" | "5132992" | "5133079").PN.	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 09:21

EAST Search History

S32	572	(videotex or videotext or (video adj tex) or (video adj text)) and isdn	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 09:22
S33	23	S32 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 09:24
S34	652	((bulletin or Bulletin) adj board) and modem and music and (buy or order or credit)	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 09:26
S35	1	S34 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 09:25
S36	1973	((bulletin or Bulletin) adj board) and modem and video and (buy or order or credit)	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 09:27
S39	12	S36 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 09:28
S40	2126	((bulletin or Bulletin) adj board) and modem and video	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 09:27
S41	14	S40 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 09:29
S42	16087	isdn and video	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 09:30
S43	329	S42 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 09:30
S44	42	S43 and (subscribe or subscription or buy or (credit adj card))	US-PGPUB; USPAT	OR	ON	2006/04/24 09:30
S45	18	(US-3718906-$ or US-4071697-$ or US-4500751-$ or US-4567359-$ or US-4649533-$ or US-4694490-$ or US-4789863-$ or US-4792849-$ or US-4837797-$ or US-4852154-$ or US-4665516-$ or US-4710955-$ or US-4829569-$ or US-4890319-$ or US-4893248-$ or US-5130792-$ or US-4849811-$ or US-4924492-$).did.	USPAT	OR	ON	2006/04/24 10:59
S46	1	("4789868").PN.	US-PGPUB; USPAT	OR	OFF	2006/04/24 11:00

EAST Search History

S47	18	(US-4694490-$ or US-4649533-$ or US-4567359-$ or US-4500751-$ or US-4893248-$ or US-4890319-$ or US-4789863-$ or US-4852154-$ or US-4837797-$ or US-4792849-$ or US-4071697-$ or US-3718906-$ or US-4710955-$ or US-4665516-$ or US-4829569-$ or US-4849811-$ or US-4924492-$ or US-5130792-$).did.	USPAT	OR	ON	2006/04/24 12:39
S48	15	("3718906" | "4163254" | "4272791" | "4300040" | "4359631" | "4433207" | "4471379" | "4506387" | "4513315" | "4538176" | "4567512" | "4590516" | "4685131" | "4700386" | "Re31639"). PN.	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 12:50
S49	45	("4789863").URPN.	USPAT	OR	ON	2006/04/24 13:43
S50	3	(("5191573") or ("5966440") or ("5675734")).PN.	US-PGPUB; USPAT	OR	OFF	2006/04/24 13:44
S51	14	("3718906" | "3990710" | "4124773" | "4506387" | "4521806" | "4528643" | "4538176" | "4567359" | "4647989" | "4654799" | "4789863" | "4789868" | "5191193" | "5191573").PN.	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 13:44
S52	44	("4124773").URPN.	USPAT	OR	ON	2006/04/24 13:50
S53	1070	(455/412.1).CCLS.	US-PGPUB; USPAT	OR	OFF	2006/04/24 13:50
S54	0	("7and@pn<5200000").PN.	US-PGPUB; USPAT	OR	OFF	2006/04/24 13:51
S55	11	S53 and (@pn < "5200000")	US-PGPUB; USPAT	OR	ON	2006/04/24 13:53
S56	593	(379/88.13).CCLS.	US-PGPUB; USPAT	OR	OFF	2006/04/24 14:03
S57	27	S56 and (@pn < "5200000")	US-PGPUB; USPAT	OR	ON	2006/04/24 14:04
S58	740	(379/88.17).CCLS.	US-PGPUB; USPAT	OR	OFF	2006/04/24 14:03
S59	6	S58 and (@pn < "5200000")	US-PGPUB; USPAT	OR	ON	2006/04/24 14:04
S60	10567	(video and (charge or buy or credit)) and (@pn < "5200000")	US-PGPUB; USPAT	OR	ON	2006/04/24 14:05
S61	430	(video and (credit adj card)) and (@pn < "5200000")	US-PGPUB; USPAT	OR	ON	2006/04/24 15:36
S62	181	S61 and network	US-PGPUB; USPAT	OR	ON	2006/04/24 14:06
S63	243	(video and audio and (download$ or (down adj load$))) and (@pn < "5200000")	US-PGPUB; USPAT	OR	ON	2006/04/24 14:13

EAST Search History

S64	157	S63 and network	US-PGPUB; USPAT	OR	ON	2006/04/24 14:13
S65	209	S63 and (network or communication)	US-PGPUB; USPAT	OR	ON	2006/04/24 14:14
S66	38	("3599178" | "3746780" | "4009344" | "4009346" | "4028733" | "4062043" | "4071697" | "4122299" | "4381522" | "4400717" | "4450477" | "4506387" | "4518989" | "4521806" | "4533936" | "4538176" | "4567512" | "4590516" | "4679079" | "4688246" | "4734765" | "4755872" | "4763191" | "4785349" | "4807023" | "4833710" | "4847677" | "4868653" | "4890320" | "4907081" | "4914508" | "4920432" | "4937821" | "4947244" | "4949169" | "4949187" | "4963995" | "5032927").PN.	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 15:30
S67	4	(("4963995") or ("5995705") or ("5057932") or ("5164839")).PN.	US-PGPUB; USPAT	OR	OFF	2006/04/24 15:32
S68	9	("4179709" | "4400717" | "4516156" | "4698664" | "4709418" | "4724491" | "4768110" | "4774574" | "4851931"). PN.	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 15:35
S69	29448	audio and video and (hard adj (drive or disk)) and network	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 15:36
S70	104	S69 and (@pn < "5200000")	US-PGPUB; USPAT	OR	ON	2006/04/24 16:28
S71	4959	music same download$	US-PGPUB; USPAT	OR	ON	2006/04/24 16:28
S72	7	S71 and (@pn < "5200000")	US-PGPUB; USPAT	OR	ON	2006/04/24 16:32
S73	1	("4949187").PN.	US-PGPUB; USPAT	OR	OFF	2006/04/24 16:30
S74	7	("3718906" | "3990710" | "4232295" | "4597058" | "4597098" | "4769833" | "4789961").PN.	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/24 16:30
S75	261	("4949187").URPN.	USPAT	OR	ON	2006/04/24 16:32
S76	1372	music and isdn	USPAT	OR	ON	2006/04/24 16:32
S77	27	S76 and (@pn < "5200000")	US-PGPUB; USPAT	OR	ON	2006/04/24 16:45
S78	394	audio and music and (download$ or (down adj load$))	EPO; JPO; DERWENT; IBM_TDB	OR	ON	2006/04/24 16:40
S79	24	audio and music and isdn	EPO; JPO; DERWENT; IBM_TDB	OR	ON	2006/04/24 16:41

EAST Search History

S80	341	audio and video and isdn	EPO; JPO; DERWENT; IBM_TDB	OR	ON	2006/04/24 16:42
S81	690	audio and video and (charge or buy or (credit adj card))	EPO; JPO; DERWENT; IBM_TDB	OR	ON	2006/04/24 16:43
S82	192	audio and video and (charge or buy or (credit adj card)) and (communications or network)	EPO; JPO; DERWENT; IBM_TDB	OR	ON	2006/04/24 16:44
S83	56788	(digital adj3 (audio or video)) and (network or communication)	US-PGPUB; USPAT	OR	ON	2006/04/24 16:45
S84	2209	S83 and (@pn < "5200000")	US-PGPUB; USPAT	OR	ON	2006/04/24 16:45
S85	12261	(digital adj3 (audio or video)) and (network or communication) and (buy or charge or (credit adj card))	US-PGPUB; USPAT	OR	ON	2006/04/24 17:06
S86	448	S85 and (@pn < "5200000")	US-PGPUB; USPAT	OR	ON	2006/04/24 17:06
S87	5130	(digital adj3 (audio or video)) and (network or communication) and (buy or (credit adj card))	US-PGPUB; USPAT	OR	ON	2006/04/24 17:06
S88	9207	(digital adj3 (audio or video)) and (network or communication) and (buy or purchase or (credit adj card))	US-PGPUB; USPAT	OR	ON	2006/04/24 17:06
S89	105	S88 and (@pn < "5200000")	US-PGPUB; USPAT	OR	ON	2006/04/24 17:40
S90	41	(real adj audio) and (bulletin adj board)	US-PGPUB; USPAT	OR	ON	2006/04/24 17:40
S91	41	(real adj audio) and (bullet$1n adj board)	US-PGPUB; USPAT	OR	ON	2006/04/24 17:40
S92	41	(real adj audio) and (bull$1tin adj board)	US-PGPUB; USPAT	OR	ON	2006/04/24 17:41
S94	104	(bull$1tin adj board) and (download$ near3 audio)	US-PGPUB; USPAT	OR	ON	2006/04/24 17:42
S95	13	(bull$1tin adj board) and kermit	US-PGPUB; USPAT	OR	ON	2006/04/24 17:44
S96	3548	(bull$1tin adj board) and (audio or video)	US-PGPUB; USPAT	OR	ON	2006/04/24 17:43
S97	204	(computer adj bull$1tin adj board)	US-PGPUB; USPAT	OR	ON	2006/04/24 17:44
S98	116	(computer adj bull$1tin adj board) and (audio and video)	US-PGPUB; USPAT	OR	ON	2006/04/25 13:12
S99	101	zmodem	US-PGPUB; USPAT	OR	ON	2006/04/25 13:12

EAST Search History

S100	33	zmodem and audio	US-PGPUB; USPAT	OR	ON	2006/04/25 13:13
S101	41	zmodem and video	US-PGPUB; USPAT	OR	ON	2006/04/25 13:14
S102	46	ymodem	US-PGPUB; USPAT	OR	ON	2006/04/25 13:14
S103	33	S102 and (audio or video)	US-PGPUB; USPAT	OR	ON	2006/04/25 13:15
S104	159	xmodem	US-PGPUB; USPAT	OR	ON	2006/04/25 13:15
S105	82	S104 and (audio or video)	US-PGPUB; USPAT	OR	ON	2006/04/25 13:17
S106	4094	download$ adj5 (audio or video)	US-PGPUB; USPAT	OR	ON	2006/04/25 13:17
S107	39	S106 and @pn < "5300000"	US-PGPUB; USPAT	OR	ON	2006/04/25 13:17
S108	32	("3263158" | "4529870" | "4658093" | "4924378" | "4932054" | "4937863" | "4953209" | "4961142" | "4977594" | "5010571" | "5014234" | "5023907" | "5047928" | "5050213" | "5058164" | "5103476" | "5113519" | "5146499" | "5159182" | "5191193" | "5204897" | "5235642" | "5247575" | "5260999" | "5263157" | "5291596" | "5339091" | "5432849" | "5438508" | "5504814" | "5530235").PN.	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/25 14:11
S109	1	("4636876").PN.	US-PGPUB; USPAT	OR	OFF	2006/04/25 14:44
S110	5	(("5428606") or ("5132992") or ("5130792") or ("4999806") or ("re35184")).PN.	US-PGPUB; USPAT	OR	OFF	2006/04/25 14:49
S111	7	(("3244809") or ("3696297") or ("3718906") or ("3824597") or ("3947882") or ("3990710") or ("4028733")).PN.	US-PGPUB; USPAT	OR	OFF	2006/04/25 14:51
S112	11	(("4124773") or ("4300040") or ("4335809") or ("4370649") or ("4422093") or ("4499568") or ("4506387") or ("4520404") or ("4521806") or ("4521857") or ("4586430")).PN.	US-PGPUB; USPAT	OR	OFF	2006/04/25 15:04
S113	12	(("4533948") or ("4536856") or ("4538176") or ("4567359") or ("4567512") or ("4605973") or ("4647989") or ("4648037") or ("4658093") or ("4667802") or ("4672613") or ("4674055")).PN.	US-PGPUB; USPAT	OR	OFF	2006/04/25 15:05

EAST Search History

S114	12	(("4688105") or ("4703465") or ("4725977") or ("4739510") or ("4754483") or ("4755872") or ("4759060") or ("4761684") or ("4763317") or ("4766581") or ("4787050") or ("4789863")).PN.	US-PGPUB; USPAT	OR	OFF	2006/04/25 15:27
S115	12	(("4792849") or ("4797918") or ("4829372") or ("4894789") or ("4918588") or ("4949187") or ("5003384") or ("5019900") or ("5041921") or ("5089885") or ("5099422") or ("5191410")).PN.	US-PGPUB; USPAT	OR	OFF	2006/04/25 16:20
S116	7	compusonic	US-PGPUB; USPAT	OR	ON	2006/04/25 16:22
S117	5322	bbs and (audio or video)	US-PGPUB; USPAT	OR	ON	2006/04/25 16:33
S118	739	S117 and @pn < "5300000"	US-PGPUB; USPAT	OR	ON	2006/04/25 16:33
S119	1661	bbs and (audio and video)	US-PGPUB; USPAT	OR	ON	2006/04/25 16:33
S120	95	S119 and @pn < "5300000"	US-PGPUB; USPAT	OR	ON	2006/04/25 17:05
S121	2	(("4870515") or ("4528643")).PN.	US-PGPUB; USPAT	OR	OFF	2006/04/25 17:05
S122	40	(US-4694490-$ or US-4649533-$ or US-4567359-$ or US-4500751-$ or US-4893248-$ or US-4890319-$ or US-4789863-$ or US-4852154-$ or US-4837797-$ or US-4792849-$ or US-4071697-$ or US-3718906-$ or US-4710955-$ or US-4665516-$ or US-4829569-$ or US-4849811-$ or US-4924492-$ or US-5130792-$ or US-4538176-$ or US-4300040-$ or US-4521806-$ or US-4124773-$ or US-4829372-$ or US-4916737-$ or US-4623920-$ or US-4866770-$).did. or (US-4956768-$ or US-4949187-$ or US-4920432-$ or US-4894789-$ or US-4839745-$ or US-5113518-$ or US-4872151-$ or US-4724521-$ or US-5083271-$ or US-4658093-$ or US-4499568-$ or US-4422093-$ or US-5003384-$ or US-4935870-$).did.	USPAT	OR	ON	2006/04/26 08:38
S123	56	("3347988" | "3444324" | "3444550" | "3448216" | "3471648" | "3590381" | "3969680").PN. OR ("4124773").URPN.	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 09:02
S124	14870	music and (hard adj (drive or disk))	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 09:28

EAST Search History

S125	165	S124 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 09:29
S126	36749	audio and video and (hard adj (drive or disk))	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:09
S127	373	S126 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 09:29
S128	7619	audio same video same (hard adj (drive or disk))	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 09:54
S129	82	S128 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 09:55
S130	1863	((audio or video) near5 (stored or store or storing)) near5 (hard adj (drive or disk))	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:09
S131	11	S130 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:10
S132	34	(disk adj streamer)	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 09:58
S133	109	(audio and video and (hard adj (drive or disk))).ab.	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:10
S134	440	((hard adj (drive or disk)) and (audio or video)).ab.	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:11
S135	8	S134 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:21
S136	6078	((hard adj (drive or disk)) and (audio or video)).ab.	EPO; JPO; DERWENT	OR	ON	2006/04/26 10:12
S137	1784	((hard adj (drive or disk)) and (audio and video)).ab.	EPO; JPO; DERWENT	OR	ON	2006/04/26 10:20
S138	327	((hard adj (drive or disk)) near5 (audio and video)).ab.	EPO; JPO; DERWENT	OR	ON	2006/04/26 10:12
S139	2956	media near5 (hard adj (drive or disk))	EPO; JPO; DERWENT	OR	ON	2006/04/26 10:21
S140	2442	media near5 (hard adj (drive or disk)).ab.	EPO; JPO; DERWENT	OR	ON	2006/04/26 10:21
S141	19496	media near5 (hard adj (drive or disk))	USPAT	OR	ON	2006/04/26 10:21

EAST Search History

S142	434	S141 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:53
S143	163	S142 and (video or audio)	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:50
S144	70	adlib	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:51
S145	90	jukebox and (sound adj card)	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:53
S146	1431	library and (sound adj card)	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:53
S147	0	S146 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:53
S148	0	".wav" and (sound adj card)	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:53
S149	534	"wav" and (sound adj card)	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:53
S150	0	S149 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:57
S151	1269	(digital adj audio) same (hard adj (drive or disk))	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 10:56
S152	27	S151 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 11:16
S153	934	(compact adj disc adj player) and (hard adj (drive or disk))	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 11:18
S154	41	S153 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 11:21
S155	517	(compact adj disc adj player) and menu	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 11:21
S156	30	S155 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 14:10

EAST Search History

S157	2921	(compact adj disc) and (artist or composer)	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 11:21
S158	192	(compact adj disc) and (search near5 (artist or composer))	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 11:21
S159	1	S158 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 11:39
S160	8	("3999050" | "4279022" | "4628193" | "4634845" | "4912640" | "4961158" | "5047614" | "Re32655").PN.	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 11:39
S161	12167	mpeg and (hard adj (disk or drive))	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 11:39
S162	1	S159 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 12:25
S163	22	"4870515"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 12:25
S164	52	(US-4694490-$ or US-4649533-$ or US-4567359-$ or US-4500751-$ or US-4893248-$ or US-4890319-$ or US-4789863-$ or US-4852154-$ or US-4837797-$ or US-4792849-$ or US-4071697-$ or US-3718906-$ or US-4710955-$ or US-4665516-$ or US-4829569-$ or US-4849811-$ or US-4924492-$ or US-5130792-$ or US-4538176-$ or US-4300040-$ or US-4521806-$ or US-4124773-$ or US-4829372-$ or US-4916737-$ or US-4623920-$ or US-4866770-$).did. or (US-4956768-$ or US-4949187-$ or US-4920432-$ or US-4894789-$ or US-4839745-$ or US-5113518-$ or US-4872151-$ or US-4724521-$ or US-5083271-$ or US-4658093-$ or US-4499568-$ or US-4422093-$ or US-5003384-$ or US-4935870-$ or US-4864301-$ or US-4905003-$ or US-5065345-$ or US-5041921-$ or US-5040110-$ or US-5034980-$ or US-5012334-$ or US-4974178-$ or US-4851931-$ or US-4763207-$ or US-4527262-$ or US-4873589-$).did.	USPAT	OR	ON	2006/04/26 14:09
S166	8	S164 and record.ab.	USPAT	OR	ON	2006/04/26 12:48

EAST Search History

S167	2799	video adj clips	USPAT	OR	ON	2006/04/26 14:09
S168	19	S167 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 14:14
S169	7	((download or downloading) adj3 video) and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 14:13
S170	343	videotext	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 14:13
S171	118	S170 and @pn < "5300000"	US-PGPUB; USPAT; USOCR	OR	ON	2006/04/26 14:14

Reexamination	Application/Control No.	Applicant(s)/Patent Under Reexamination
	90/007,402	5191573
	Certificate Date	Certificate Number

Requester Correspondence Address: ☐ **Patent Owner** ☒ **Third Party**

Albert S. Penilla
MARTINE PENILLA & GENCARELLA, LLP
710 Lakeway Drive, Suite 200
Sunnyvale, CA 94085

LITIGATION REVIEW ☒	r.g.f. (examiner initials)	9/5/06 (date)
Case Name		Director Initials
See the litigation searches conducted on 4/15/06 and 3/8/05.		MRuhe for Issi Mojica Marquis

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TYPE OF PROCEEDING	NUMBER
1.	
2.	
3.	
4.	

Notice of References Cited	Application/Control No. 90/007,402	Applicant(s)/Patent Under Reexamination 5191573	
	Examiner Roland G. Foster	Art Unit 3992	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-4,787,073	11-1988	Masaki, Naoki	369/178.01
*	B	US-5,535,137	07-1996	Rossmere et al.	358/537
*	C	US-5,241,428	08-1993	Goldwasser et al.	386/109
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	"The History of Recordings", Recording Industry of Association, retrieved from http://www.riaa.com/issues/audio/hisotry.asp on September 19, 2006.
	V	"History of CD Technology", citing as a source "The compact Disc Handbook, 2nd Edition," by Ken C. Pohlmann, retrieved from http://www.oneoffcd.com/info/hisotrycd.cfm on September 19, 2006.
	W	"History of MPEG", University of California, Berkeley, School of Information Management and Systems, retrieved from http://www2.sims.berkeley.edu/courses/is224/s99/GroupG/report1.html on September 19, 2006.
	X	"IBM HDD Evolution" chart, by Ed Grochowski at Almaden, retrieved from http://www.soragereview.com/guideImages/z_ibm_sorageevolution.gif" on September 19, 2006.

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

DRINKER BIDDLE & REATH LLP
One Logan Square
18th and Cherry Streets
Philadelphia, PA 19103
215-988-2700

FACSIMILE INFORMATION SHEET

FROM: Matthew P. McWilliams (215) 988-3381

TO: Examiner Roland Foster

FAX NO: (571) 273-9900

DATE: November 15, 2006

DOCUMENT NAME: Request for Interview

NUMBER OF PAGES (INCLUDING COVER): 3

OUR FILE: 219099

IF YOU DO NOT RECEIVE THIS FAX DOCUMENT IN ITS ENTIRETY, PLEASE CALL THE OPERATOR AT (215-988-2987)
DB&R FACSIMILE MACHINE
215-988-2757 or 2762

MESSAGE:

Dear Examiner Foster

Please find attached a formal Request for Interview for November 16, 2006. If you have any questions whatsoever, please feel free to contact Bob Koons, (215) 988-3392 or myself (215) 988-3381.

Regards, Matthew McWilliams

ORIGINAL WILL: ☐ FOLLOW ☒ NOT FOLLOW

PHIP\295524\4

PTOL-413A (09-04)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Applicant Initiated Interview Request Form

Application No.: ~~90/007,402~~ 90/007,403 90/007,407 First Named Applicant: Arthur Hair
Examiner: Roland Foster Art Unit: _____ Status of Application: Reexamination

Tentative Participants:
(1) Robert A. Koons (2) Michael R. Casey
(3) _____ (4) _____

Proposed Date of Interview: 11/16/06 **Proposed Time:** 1:00 (AM/PM)

Type of Interview Requested:
(1) [ ] Telephonic (2) [X] Personal (3) [ ] Video Conference

Exhibit To Be Shown or Demonstrated: [X] YES [ ] NO
If yes, provide brief description: See attached

Issues To Be Discussed

Issues (Rej., Obj., etc)	Claims/ Fig. #s	Prior Art	Discussed	Agreed	Not Agreed
(1) Rej.	All	All	[ ]	[ ]	[ ]
(2)			[ ]	[ ]	[ ]
(3)			[ ]	[ ]	[ ]
(4)			[ ]	[ ]	[ ]

[ ] Continuation Sheet Attached

Brief Description of Arguments to be Presented:
All claims are entitled to June 13, 1988 filing date. References that are appropriate prior art do not disclose novel features of invention.

An interview was conducted on the above-identified application on _____.
NOTE: This form should be completed by applicant and submitted to the examiner in advance of the interview (see MPEP § 713.01).
This application will not be delayed from issue because of applicant's failure to submit a written record of this interview. Therefore, applicant is advised to file a statement of the substance of this interview (37 CFR 1.133(b)) as soon as possible.

Applicant/Applicant's Representative Signature — Examiner/SPE Signature

Robert A. Koons
Typed/Printed Name of Applicant or Representative

32,474
Registration Number, if applicable

Attachment to Request for Interview

Summary of Exhibits to be Presented

- Claim charts demonstrating that the issue of alleged new matter was considered by and passed on by Examiner in original examination of patents in reexamination.
- Claim charts showing that each and every limitation of claims currently in reexamination has support in the specification filed on June 13, 1988.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/007,402	01/31/2005	5191573	NAPS001	2998

23973 7590 11/16/2006

DRINKER BIDDLE & REATH
ATTN: INTELLECTUAL PROPERTY GROUP
ONE LOGAN SQUARE
18TH AND CHERRY STREETS
PHILADELPHIA, PA 19103-6996

EXAMINER	
ART UNIT	PAPER NUMBER

DATE MAILED: 11/16/2006

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS

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710 LAKEWAY DRIVE, SUITE 200

SUNNYVALE, CA 94085

EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO 90/007402

PATENT NO. 5,191,573

ART UNI 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)).

Ex Parte Reexamination Interview Summary	Control No. 90/007,402 ~~90/007,403~~ ~~90/007,404~~	Patent Under Reexamination 5191573 ~~5615134~~ ~~5966446~~
	Examiner: Roland G. Foster	Art Unit: 3992 R.C.F. 11/16/06

All participants (USPTO personnel, patent owner, patent owner's representative):

(1) *Roland G. Foster*

(2) TODD DICKINSON

(3) ROBERT A. KOONS

(4) MICHAEL R. CASEY, PH.D.
ANDREW KASHIKOW
CLAYTON LABALLE
SCOTT WEAVER

Date of Interview: 11/16/06

Type: a)☐ Telephonic b)☐ Video Conference
c)☑ Personal (copy given to: 1)☐ patent owner 2)☑ patent owner's representative)

Exhibit shown or demonstration conducted: d)☐ Yes e)☑ No.
If Yes, brief description: _____

Agreement with respect to the claims f)☐ was reached. g)☐ was not reached. h)☑ N/A.
Any other agreement(s) are set forth below under "Description of the general nature of what was agreed to..."

Claim(s) discussed: N/A

Identification of prior art discussed: N/A

Description of the general nature of what was agreed to if an agreement was reached, or any other comments:
PATENT OWNER'S REPRESENTATIVES DISCUSSED PRIORITY AND 112 ISSUES AND STRATEGIES TO OVERCOME THEM. IN ADDITION, POSSIBLE AMENDMENTS WERE DISCUSSED.
(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims patentable, if available, must be attached. Also, where no copy of the amendments that would render the claims patentable is available, a summary thereof must be attached.) SEE THE ATTACHED CHARTS FOR ADDITIONAL DETAILS.

A FORMAL WRITTEN RESPONSE TO THE LAST OFFICE ACTION MUST INCLUDE PATENT OWNER'S STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. (See MPEP § 2281). IF A RESPONSE TO THE LAST OFFICE ACTION HAS ALREADY BEEN FILED, THEN PATENT OWNER IS GIVEN **ONE MONTH** FROM THIS INTERVIEW DATE TO PROVIDE THE MANDATORY STATEMENT OF THE SUBSTANCE OF THE INTERVIEW (37 CFR 1.560(b)). THE REQUIREMENT FOR PATENT OWNER'S STATEMENT CAN NOT BE WAIVED. **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

cc: Requester (if third party requester)

Examiner's signature, if required

	Parent Application 07/206,497 filed June 13, 1988		Child Application 07/586,391 filed September 18, 1990		Office Action in Application 07/586,391 and response		Issuance of '573 Patent
Feature	Date First Appearing in Claims of Parent Application	Date First Appearing in Specification of Parent Application	Date First Appearing in Claims of Child Application	Date First Appearing in Specification of Child Application	Consideration by Examiner Nguyen	Response by Applicant	Subsequent Action by Examiner Nguyen
Transferring Money from Second Party to a First Party (Charging a Fee)	December 22, 1988 February 28, 1990			September 18, 1990	Considered in Office Action February 24, 1992	Objection specifically responded to in June 25, 1992 response	Claims allowed in September 21, 1992 Office Action
Providing a Credit Card Number	December 22, 1988			September 18, 1990	Considered in Office Action February 24, 1992	Objection specifically responded to in June 25, 1992 response	Claims allowed in September 21, 1992 Office Action
Controlling Use of First/Second Memory	December 22, 1988			September 18, 1990	Considered in Office Action February 24, 1992	Objections responded to in June 25, 1992 response	Claims allowed in September 21, 1992 Office Action
Transmitting to a Location Determined by Second Party	February 28, 1990			September 18, 1990	Considered in Office Action February 24, 1992	Objection responded to June 25, 1992	Claims allowed in September 21, 1992 Office Action
Specific Video Download Procedures	February 28, 1990			September 18, 1990	No new matter issues were ever raised	No response was ever necessary since no issue was ever raised	Claims allowed in September 21, 1992 Office Action
First Party in Possession of Transmitter	August 24, 1990 (not entered)			September 18, 1990	Considered in Office Action February 24, 1992	Objections responded to in June 25, 1992 response	Claims allowed in September 21, 1992 Office Action

ATTACHMENT TO 90/007,402

36 PAGES

Second Party in Possession of Receiver and Second Memory	August 24, 1990 (not entered)			September 18, 1990	Considered in Office Action February 24, 1992	Objection specifically responded to in June 25, 1992 response	Claims allowed in September 21, 1992 Office Action

Claim Features of '440 Patent

Feature	Claims Reciting Feature	Written Description of Feature in Original Specification	Comments
A method/system for transferring desired digital video or digital audio signals	1-63	p. 1, lns. 13-15 p. 2, lns. 8-10, 20-26 (video) p. 5, lns. 36-43	*ipsis verbis*
forming a connection through telecommunications lines between a first memory of a first party and a second memory of a second party control unit of a second party	1-22, 25-28, 36-46, 58-63	p. 3, lns. 35-40	*ipsis verbis*
first memory having desired digital video or digital audio signals	1-21, 25-28, 42-57, 62, 63	p. 3, lns. 35-37	*ipsis verbis*
selling electronically by the first party to the second party through telecommunications lines	1-22, 25-28, 40, 42-45	p. 2, lns. 47-52 p. 3, lns. 35-40	*ipsis verbis*
transferring the desired digital video or digital audio signals from the first memory of the first party to the second memory of the second party control unit of the second party through telecommunications lines	1-21, 25-28, 36-40, 42-46, 62-63	p. 2, ln. 47-52 p. 3, lns. 35-40 Fig. 1	*ipsis verbis*

the second party control unit with the second memory is in possession and control of the second party	1-41, 46-52, 62	p. 3, lns. 26-33, 40-43	The as filed original specification includes *ipsis verbis* support for a second party control unit, where the user is the second party. A skilled artisan would readily recognize that the second memory is in possession and control of the second party, since the specification as originally filed states throughout that the user can store, sort and play thousands of songs from the user unit. A skilled artisan would clearly understand that this means the second party controls and possesses the second party control unit. This was previously pointed out in the declaration of Arthur Hair submitted May 5, 1992.
playing through speakers of the second party control unit the digital video or digital audio signals in the second memory	1-10, 11, 22, 36-46, 63	p. 2, lns. 26-32	*ipsis verbis*
speakers of the second party control unit connected with the second memory of the second party control unit	1-10, 28, 35, 62	p. 3, lns. 25-32 p. 4, lns. 47-50 Fig. 1	*ipsis verbis*

first control unit in possession and control of first party	24, 31-35	p. 2, lns. 38-43 p. 3, lns. 35-49	The as filed original specification includes *ipsis verbis* support for a first party control unit, where the authorized agent is the first party. A skilled artisan would readily recognize that the first party control unit is in possession and control of the first party because as an "agent authorized to electronically sell and distribute" digital audio or digital video, the first party would necessarily have to possess and control the source of the digital audio and digital video. This was previously pointed out in the declaration of Arthur Hair submitted May 5, 1992.
second party location remote from the first party location, determined by the second party	2-63	p. 2, lns. 47-50 p. 3, lns. 20-40 Fig. 1 p. 4, lns. 21-23	The original as filed specification states throughout that digital audio or digital video signals are sold and transferred via telephone lines. A skilled artisan would readily understand this to comprehend transfers between two remote locations. Since the second party possesses the second memory the second party can determine its location. This was previously pointed out in the declaration of Arthur Hair submitted May 5, 1992.

charging a fee via telecommunications lines by the first party to the second party	2-10, 19-21, 36-40, 43-45, 47-63	p. 1, lns. 13-15 p. 2, lns. 8-10, 20-23, 47-50 p. 3, lns. 20-33 Fig. 1	The specification discloses electronic sales via telephone lines. Because the agent is authorized to sell and to transfer via telephone lines, there is implicitly support for selling and thereby charging a fee. This was previously pointed out in the declaration of Arthur Hair submitted December 30, 1993.
second party has an account, charging the account of the second party **Possibly Amend to: "Charging the second party"**	3-10, 20-21, 38-40, 44-45, 56-57, 60-61	p. 1, lns. 13-15 p. 2, lns. 8-10, 20-23, 47-50 p. 3, lns. 20-33 Fig. 1	The specification discloses electronic sales via telephone lines. A skilled artisan would readily recognize that charging a fee via telecommunications lines would include the second party having an account that can be charged. This was previously pointed out in the declaration of Arthur Hair submitted December 30, 1993.
telephoning the first party controlling use of the first memory by the second party **Possibly Amend to: "establishing telephone communications between the first memory and the second memory"**	4-10, 39-40, 45, 57, 61	p. 2, lns. 47-50 p. 3, lns. 20-40 Fig. 1 p. 4, lns. 21-23	The original as filed specification states throughout that digital audio or digital video signals are sold and transferred via telephone lines. A skilled artisan would readily recognize this as comprehending the telephoning of the first party by the second party to initiate a transaction. This was addressed previously in the declaration of Arthur Hair submitted May 5, 1992.

providing a credit card number of the second party controlling the second memory to the first party controlling the first memory so the second party is charged money	4-10, 21, 39-40, 45, 61	p. 1, lns. 13-15 p. 2, lns. 8-10, 20-23, 38-52 p. 3, lns. 12-15, 35-37	The original as filed specification states throughout that the invention provides for electronic sales of digital audio or digital video signals. A skilled artisan would readily recognize credit card sales as being comprehended within electronic sales. This was addressed previously in the affidavit of Arthur Hair dated May 5, 1992.
storing the desired digital video or digital audio signals in the second memory	5-10, 22, 36-41	p. 2, lns. 23-27	*ipsis verbis*
electronically coding the desired digital video or digital audio signals into a configuration which would prevent unauthorized reproduction of the desired digital audio signals	6-8	p. 2, lns. 17-19 p. 4, lns. 15-20	*ipsis verbis*
first memory includes first party hard disk	7-8, 13, 14, 27-28, 34-35, 49-54	p. 4, lns. 5-6 p. 3, ln. 19 Fig. 1	*ipsis verbis*
second party can view desired digital video signals	58-61	p. 5, lns. 36-43 p. 3, lns. 26-33	The as filed original specification has *ipsis verbis* support for a video display. Since the specification explicitly says that the invention is applicable to video, a skilled artisan would recognize that a user could view the desired video signals on the video display.

second party can listen to the desired digital audio signals	63	p. 4, lns. 27-28, 36-50	*ipsis verbis*
first memory includes a sales random access memory chip	7-8, 13-18, 25-28, 49-54	p. 3, lns. 19-24 Fig. 1	*ipsis verbis*
second party control unit includes second memory	48-54	p. 3, lns. 26-30 Fig. 1	The as filed original specification has *ipsis verbis* support for a second party control unit. A skilled artisan would readily understand that the second party hard disk corresponds to a second memory.
second party control unit has a second party control panel	8, 12-21, 25-28, 32-35, 47-57	p. 3, lns. 26-27 Fig. 1	*ipsis verbis*
second party control panel connected to the second party integrated circuit	8, 16-18, 25-28, 32-35, 52-54	p. 3, lns. 26-28 Fig. 1	*ipsis verbis*
second memory of the second party control unit includes an incoming random access memory chip	9-10, 17-18, 25-28, 32-35, 53-54	p. 3, ln. 26-29 Fig. 1	*ipsis verbis*
second memory of the second party control unit includes a second party hard disk for storing the desired digital video or digital audio signals	9-10, 12-21, 25-28, 34-35, 50-54	p. 3, lns. 26-31 Fig. 1	*ipsis verbis*

second memory of the second party control unit includes a playback random access memory chip for temporarily storing the desired digital video or digital audio signals for sequential playback	9-10, 25-28 32-35, 50-54	p. 3, lns. 26-30 p. 4, lns. 39-50 Fig. 1	*ipsis verbis*
a first party control unit having a first memory	12-21, 25-28	p. 3, lns. 20-24 Fig. 1	*ipsis verbis*
second party control unit having means or a mechanism for playing the desired digital video or digital audio signals connected to the second memory and the second party control panel	12-35	p. 3, lns. 26-33 Fig. 1	The as filed original specification has *ipsis verbis* support for speakers and video display which are means for playing.
first party control integrated circuit connected to the first party hard disk, the first party sales random access memory, and the second party control integrated circuit through the telecommunications lines	15-18, 25-28, 32-35, 51-54	p. 3, lns. 20-33 Fig. 1	*ipsis verbis*

second party control integrated circuit connected to the second party hard disk, the playback random access memory, and the first party control integrated circuit through the telecommunications lines	16-18, 25-28, 52-54	p. 3, lns. 20-33 Fig. 1	*ipsis verbis*
first party control integrated circuit and second party control integrated circuit regulate the transfer of the desired digital video or digital audio signals	13-18, 25-28	p. 4, lns. 15-20	*ipsis verbis*
first party control panel connected to the first party control integrated circuit	15-18, 25-28, 51-54	p. 3, lns. 20-24 Fig. 1	*ipsis verbis*
incoming random access memory chip connected to the second party hard drive and the second party control integrated circuit, and the first party control unit through the telecommunications lines	17-18, 25-28, 53-54	p. 3, lns. 20-33 Fig. 1	*ipsis verbis*
second party control unit includes a video display unit and/or speakers	18, 25-28, 35, 47-61	p. 3, lns. 26-33 Fig. 1	*ipsis verbis*

second party control unit having a receiver, second memory connected to the receiver	22, 41, 47-56, 58-60	p. 2, lns. 47-49 p. 3, lns. 35-38 p. 4, lns. 24-26	A skilled artisan would readily recognize in order to receive digital audio or digital video signals over telecommunications lines as disclosed throughout the specification, part of the second party control unit would act as a receiver. This was addressed previously in the affidavit of Arthur Hair dated May 5, 1992.
second party financially distinct from the first party	22, 41	p. 2, lns. 8-16, 20-27, 38-52 p. 35-49	Throughout the specification discloses electronic sales of digital video or digital audio signals. A skilled artisan would readily recognize that the first and second parties would be financially distinct since this is required in order to have a sale. This issue was previously addressed in the affidavit of Arthur Hair filed on May 5, 1992.
first memory with a transmitter in control and possession of the first party	22-24, 29-35, 41, 58-61, 63	p. 1, lns. 10-12 p. 2, lns. 8-10, 20-26, 47-52 p. 3, lns. 20-25 p. 4, lns. 21-23	The as filed original specification has *ipsis verbis* support for electronic distribution via telecommunications lines. A skilled artisan would readily recognize that this requires transmission of those signals, where the telecommunications lines act as the transmitter.

receiver is in possession and control of the second party	22-24, 29-35, 41, 58-61, 63	p. 2, lns. 47-49 p. 3, lns. 35-38 p. 4, lns. 24-26	A skilled artisan would readily recognize in order to receive digital audio or digital video signals over telecommunications lines as disclosed throughout the specification, part of the second party control unit would act as a receiver. This was addressed previously in the affidavit of Arthur Hair dated May 5, 1992. A skilled artisan would readily recognize that the receiver is in possession and control of the second party, since the specification as originally filed states throughout that the user can store, sort and play thousands of songs from the user unit. A skilled artisan would clearly understand that this means the second party controls and possesses the second party control unit. This was previously pointed out in the declaration of Arthur Hair submitted December 30, 1993.
means or mechanism for transferring money electronically via telecommunications lines from the second party to the first party controlling use of the first memory	23-24, 30-35	p. 1, lns. 10-12 p. 2, lns. 8-10, 20-26, 47-52 p. 3, lns. 20-25 p. 4, lns. 21-23	The as filed original specification has *ipsis verbis* support for electronic sales via telecommunications lines. A skilled artisan would readily recognize that electronic sales via telecommunications lines would include the transfer of money via telecommunications lines. This was addressed previously in the affidavit of Arthur Hair dated May 5, 1992.

second party choosing desired digital video or digital audio from first memory with second party control panel	47-63	p. 2, lns. 8-16, 20-27, 38-52 p. 35-49	Throughout the specification discloses electronic sales of digital video or digital audio signals. A skilled artisan would readily recognize that this includes the selection of individual desired signals by the purchaser.
means or mechanism for connecting electronically via telecommunications lines the first memory with the second memory	23-24, 29-35	p. 4, lns. 15-20 Fig. 1	A skilled artisan would readily recognize from the specification that the first memory would include a means for connecting to the second memory via the disclosed telephone lines.
means or a mechanism for transmitting the desired digital video or digital audio signals from the first memory to a receiver having the second memory	23-24, 29-35	p. 1, lns. 10-12 p. 2, lns. 8-10, 20-26, 47-52 p. 3, lns. 20-25 p. 4, lns. 21-23	The as filed original specification has *ipsis verbis* support for electronic distribution via telecommunications lines. A skilled artisan would readily recognize that this requires transmission of those signals, where the telecommunications lines act as the transmitter. A skilled artisan would also readily recognize in order to receive digital audio or digital video signals over telecommunications lines, part of the second party control unit would act as a receiver. This was addressed previously in the affidavit of Arthur Hair dated May 5, 1992.

means or a mechanism for storing the digital video or digital audio signals in the second memory	23-24, 29-35	p. 3, lns. 26-31 p. 4, lns. 15-20 Fig. 1	The second party control unit includes a second party control integrated circuit which regulates the transfer of the digital audio and digital video signals. A skilled artisan would readily recognize that the second party integrated circuit regulates storage of the digital audio or digital video signals.
playing means or mechanism connected to the second memory	23-24, 29-35	p. 3, lns. 26-33 p. 4, lns. 39-50 Fig. 1	*ipsis verbis*
second memory connected to receiver and video display	48-54, 58-61	p. 3, lns. 26-33 p. 4, lns. 39-50 Fig. 1	The as filed original specification has *ipsis verbis* support for a video display connected to the second memory. A skilled artisan would also readily recognize in order to receive digital audio or digital video signals over telecommunications lines, part of the second party control unit would act as a receiver. This was addressed previously in the affidavit of Arthur Hair dated May 5, 1992.
telecommunications lines include telephone lines	26-28, 33-35	p. 3, ln. 25 Fig. 1	*ipsis verbis*
incurring a fee by second party to first party for use of telecommunication lines, the desired digital video or audio signal in first memory	46		**(CANCEL)**

Claim Features f '573 Patent

Feature	Claims Reciting Feature	Written Description f Feature in Original Specification	Comments
A method for transmitting a desired digital audio signal	1	p. 1, lns. 7-9 p. 2, lns. 8-10, 20-26	*ipsis verbis*
stored on a first memory of a first party to a second memory of a second party	1, 4	p. 3, lns. 35-40 p. 4, lns. 12-26	The specification states *ipsis verbis* that the hard disk in the control unit of the authorized agent is the source of the digital signal. Further, the specification states that the digital signal is transferred to the hard disk in the control unit of the user. A skilled artisan would understand this as transferring signals stored on a first memory to a second memory.
transferring money via a telecommunications line to a first party location remote from the second memory	1, 4	p. 1, lns. 13-15 p. 2, lns. 8-10, 20-23, 47-50 p. 3, lns. 20-33 Fig. 1	The specification discloses electronic sales via telephone lines. Because the agent is authorized to sell and to transfer via telephone lines, there is implicitly support for selling and thereby transferring money. This was previously pointed out in the declaration of Arthur Hair submitted May 5, 1992. A skilled artisan would readily understand this to comprehend transfers between two remote locations.

second party financially distinct from the first party	1, 4	p. 1, lns. 13-15 p. 2, lns. 8-10, 20-23, 47-50 p. 3, lns. 20-33	A skilled artisan would readily recognize that a sale requires the parties to be financially distinct. This was previously pointed out in the declaration of Arthur Hair submitted May 5, 1992.
second party controlling use and in possession of the second memory	1, 3	p. 3, lns. 26-33, 40-43	The as filed original specification includes *ipsis verbis* support for a second party control unit, where the user is the second party. A skilled artisan would readily recognize that the second memory is in possession and control of the second party, since the specification as originally filed states throughout that the user can store, sort and play thousands of songs from the user unit. A skilled artisan would clearly understand that this means the second party controls and possesses the second party control unit. This was previously pointed out in the declaration of Arthur Hair submitted May 5, 1992.
connecting electronically via a telecommunications line the first memory with the second memory	1, 4	p. 3, lns. 35-40	*ipsis verbis*

transmitting the desired digital audio signal from the first memory with a transmitter in control and possession of the first party	1	p. 2, ln. 47-52 p. 3, lns. 35-40 Fig. 1	The as filed original specification has *ipsis verbis* support transmitting a desired digital audio signal and that the hard disk in the control unit of the authorized agent is the source. A skilled artisan would recognize that in order to regulate distribution of the signals the authorized agent would have to possess and control the transmitter. This was previously pointed out in the declaration of Arthur Hair submitted May 5, 1992.
to a receiver having the second memory at a location determined by the second party; said receiver in possession and control of the second party	1, 4	p. 2, lns. 47-50 p. 3, lns. 20-40 Fig. 1 p. 4, lns. 21-23	A skilled artisan would readily recognize in order to receive digital signals over telecommunications lines as disclosed throughout the specification, part of the second party control unit would act as a receiver. This was addressed previously in the affidavit of Arthur Hair dated May 5, 1992. A skilled artisan would also readily understand this to comprehend transfers between two remote locations. Since the second party possesses the second memory the second party can determine its location. This was addressed previously in the declaration of Arthur Hair submitted May 5, 1992.

storing the digital audio signal in the second memory	1	p. 2, lns. 23-27	*ipsis verbis*
searching the first memory for the desired digital audio signal	2	p. 3, lns. 35-40 p. 4, lns. 12-28	The as filed original specification has *ipsis verbis* support for electronic sales and electronic transfer of digital signals from a control unit of an authorized agent to a control unit of a user. A skilled artisan would readily recognize that this would include searching the hard disk of the first party to locate desired digital signals for purchase.
selecting the desired digital audio signal from the first memory	2	p. 3, lns. 35-40 p. 4, lns. 12-28	The as filed original specification has *ipsis verbis* support for electronic sales and electronic transfer of digital signals from a control unit of an authorized agent to a control unit of a user. A skilled artisan would readily recognize that this would include selecting desired digital signals from the hard disk of the first party for purchase.

telephoning the first party controlling use of the first memory by the second party	3, 6	p. 2, lns. 47-50 p. 3, lns. 20-40 Fig. 1 p. 4, lns. 21-23	The original as filed specification states throughout that digital audio or digital video signals are sold and transferred via telephone lines. A skilled artisan would readily recognize this as comprehending the telephoning of the first party by the second party to initiate a transaction. This was addressed previously in the declaration of Arthur Hair submitted May 5, 1992.
providing a credit card number of the second party to the first party so that the second party is charged money	3, 6	p. 1, lns. 13-15 p. 2, lns. 8-10, 20-23, 38-52 p. 3, lns. 12-15, 35-37	The original as filed specification states throughout that the invention provides for electronic sales of digital audio or digital video signals. A skilled artisan would readily recognize credit card sales as being comprehended within electronic sales. This was addressed previously in the affidavit of Arthur Hair dated May 5, 1992.

first party controlling the first memory	3, 6	p. 2, lns. 38-43 p. 3, lns. 35-49	The as filed original specification includes *ipsis verbis* support for a first party control unit, where the authorized agent is the first party. A skilled artisan would readily recognize that the first party control unit is in possession and control of the first party because as an "agent authorized to electronically sell and distribute" digital audio or digital video, the first party would necessarily have to possess and control the source of the digital audio and digital video. This was previously pointed out in the declaration of Arthur Hair submitted May 5, 1992.
A method for transmitting a desired digital video signal	4	p. 5, lns. 36-43	*ipsis verbis*

transmitting the desired digital video signal from the first memory with a transmitter in control and possession of the first party	4	p. 5, lns. 36-43 p. 2, ln. 47-52 p. 3, lns. 35-40 Fig. 1	The as filed original specification has *ipsis verbis* support transmitting a desired digital audio signal and that the hard disk in the control unit of the authorized agent is the source. A skilled artisan would recognize that in order to regulate distribution of the signals the authorized agent would have to possess and control the transmitter. This was previously pointed out in the declaration of Arthur Hair submitted May 5, 1992. A skilled artisan would recognize based on the disclosure at the end of the specification that this procedure could also be used for digital video.
storing the digital video signal in the second memory	4	p. 5, lns. 36-43 p. 2, lns. 23-27	The as filed original specification has *ipsis verbis* support for storing digital signals on the hard disk of the user control unit. A skilled artisan would recognize based on the disclosure at the end of the specification that this procedure could also be used for digital video.

searching the first memory for the desired digital video signal	5	p. 3, lns. 35-40 p. 4, lns. 12-28 p. 5, lns. 36-43	The as filed original specification has *ipsis verbis* support for electronic sales and electronic transfer of digital signals from a control unit of an authorized agent to a control unit of a user. A skilled artisan would readily recognize that this would include searching the hard disk of the first party to locate desired digital signals for purchase. A skilled artisan would recognize based on the disclosure at the end of the specification that this procedure could also be used for digital video.
selecting the desired digital video signal from the first memory	5	p. 3, lns. 35-40 p. 4, lns. 12-28 p. 5, lns. 36-43	The as filed original specification has *ipsis verbis* support for electronic sales and electronic transfer of digital signals from a control unit of an authorized agent to a control unit of a user. A skilled artisan would readily recognize that this would include selecting desired digital signals from the hard disk of the first party for purchase. A skilled artisan would recognize based on the disclosure at the end of the specification that this procedure could also be used for digital video.

Claim Features of '734 Patent

Feature	Claims Reciting Feature	Written Description of Feature in Original Specification	Comments
A method/system for transferring desired digital video or digital audio signals	1-34	p. 1, lns. 7-9 p. 2, lns. 8-10, 20-26 (video) p. 5, lns. 36-43	*ipsis verbis*
forming a connection through telecommunications lines between a first memory of a first party and a second memory of a second party	1	p. 3, lns. 35-40	*ipsis verbis*
first party location and second party location remote from the first party location, the second party location determined by the second party	1, 4, 11, 16, 19, 26	p. 2, lns. 47-50 p. 3, lns. 20-40 Fig. 1 p. 4, lns. 21-23	The original as filed specification states throughout that digital audio or digital video signals are sold and transferred via telephone lines. A skilled artisan would readily understand this to comprehend transfers between two remote locations. Since the digital audio or digital video signals are transferred to the user's (second party's) control unit, a skilled artisan would readily understand that the second party can determine the second location.
the first party memory having a first party hard disk having a plurality of digital video or digital audio signals, including coded digital video or digital audio signals	1, 4, 16	p. 3, lns. 35-37	*ipsis verbis*

the first memory having a sales random access memory chip	1	p. 3, lns. 19-24 Fig. 1	*ipsis verbis*
telephoning the first party controlling the first memory by the second party **Possibly Amend to: "establishing telephone communications between the first memory and the second memory"**	1	p. 2, lns. 47-50 p. 3, lns. 20-40 Fig. 1 p. 4, lns. 21-23	The original as filed specification states throughout that digital audio or digital video signals are sold and transferred via telephone lines. A skilled artisan would readily recognize this as comprehending the telephoning of the first party by the second party to initiate a transaction. This was addressed previously in the declaration of Arthur Hair submitted May 5, 1992.
providing a credit card number of the second party to the first party so that the second party is charged money	1	p. 1, lns. 13-15 p. 2, lns. 8-10, 20-23, 38-52 p. 3, lns. 12-15, 35-37	The original as filed specification states throughout that the invention provides for electronic sales of digital audio or digital video signals. A skilled artisan would readily recognize credit card sales as being comprehended within electronic sales. This was addressed previously in the affidavit of Arthur Hair dated May 5, 1992.
electronically coding the digital video or digital audio signals to form coded digital audio signals into a configuration that would prevent unauthorized reproduction	1	p. 2, lns. 17-19 p. 4, lns. 15-20	*ipsis verbis*

storing a replica of the coded desired digital video or digital audio signals from the hard disk to the sales random access memory chip	1	p. 4, lns. 15-23	*ipsis verbis*
transferring the stored replica of the coded desired digital video or digital audio signal from the sales random access memory chip of the first party to the second memory of the second party through telecommunications lines while the second memory is in possession and control of the second party	1, 4	p. 4, lns. 15-23 p. 4, ln. 35 to p. 5, ln. 21	The original as filed specification includes *ipsis verbis* support for storing a replica of the coded desired digital audio or digital video signal to the first party sales random access memory, then transferring it to the memory of the second party. A skilled artisan would readily recognize that the second memory is in possession and control of the second party, since the specification as originally filed states throughout that the user can store, sort and play thousands of songs from the user unit. A skilled artisan would clearly understand that this means the second party controls and possesses the second memory. This was previously addressed in the declaration of Arthur Hair filed May 5, 1992.
storing the transferred digital video or digital audio signals in the second memory	1	p. 2, lns. 23-27	*ipsis verbis*

a second party integrated circuit which controls and executes commands of the second party connected to a second party control panel	2	p. 3, lns. 26-28 p. 4, lns. 15-20 Fig. 1	*ipsis verbis*
commanding the second party integrated circuit with the second party control panel to initiate the purchase of the desired digital video or digital audio signals from the first party hard disk	2	p. 4, lns. 12-20	**(CANCEL)**
the second memory includes a second party hard disk and an incoming random access memory chip	3, 5, 8, 13, 16, 21, 30	p. 3, lns. 26-31 Fig. 1	*ipsis verbis*
the second memory includes a playback random access memory chip	3, 5, 16, 21, 30	p. 3, lns. 26-30 p. 4, lns. 39-50 Fig. 1	*ipsis verbis*
playing the desired digital video or digital audio signal from the second party hard disk	3	p. 2, lns. 26-32	*ipsis verbis*

a first party control unit (in possession and control of the first party)	4, 11, 16, 19, 26, 28	p. 2, lns. 38-43 p. 3, lns. 35-49	The as filed original specification includes *ipsis verbis* support for a first party control unit, where the authorized agent is the first party. A skilled artisan would readily recognize that the first party control unit is in possession and control of the first party because as an "agent authorized to electronically sell and distribute" digital audio or digital video, the first party would necessarily have to possess and control the source of the digital audio and digital video.

a second party control unit (in possession and control of the second party)	4, 11, 16, 19, 26, 28	p. 2, lns. 38-43 p. 3, lns. 35-49	The as filed original specification includes *ipsis verbis* support for a second party control unit, where the user is the second party. A skilled artisan would readily recognize that the second memory is in possession and control of the second party, since the specification as originally filed states throughout that the user can store, sort and play thousands of songs from the user unit. A skilled artisan would clearly understand that this means the second party controls and possesses the second party control unit. This was previously addressed in the declaration of Arthur Hair filed May 5, 1992.

the first party control unit has a first party hard disk, a sales random access memory chip, and means or mechanism for electronically selling desired digital video or digital audio signals	4, 11, 19, 26, 28	p. 2, lns. 8-10 p. 3, lns. 20-40 Fig. 1	The as filed original specification has *ipsis verbis* support for a first party control unit with a hard disk, and sales random access memory chip. A skilled artisan would readily recognize that the first party control unit would include a means or mechanism for executing an electronic sale because the electronic sale is described in the original specification as separate from electronic transfer and electronic distribution.
the second party control unit has a second memory connected to the second party control panel	4, 19, 21, 26, 28	p. 3, lns. 26-31 Fig. 1	The as filed original specification has *ipsis verbis* support for a control panel connected to the second party control unit. A skilled artisan would readily understand that the second party hard disk corresponds to a second memory.
the second party control unit has means for playing desired digital video or digital audio signals connected to and controlled by the second party control panel	4, 28	p. 3, lns. 26-33 Fig. 1	*ipsis verbis*
selling digital video or digital audio signals through telecommunications lines	4	p. 2, lns. 8-10, lns. 47-50	*ipsis verbis*

the first party control unit includes a first party control integrated circuit connected to the first party hard disk, the sales random access memory and the second party control panel through telecommunications lines	4, 6, 11, 16, 19, 22, 26, 28, 31,	p. 3, lns. 20-33 Fig. 1	*ipsis verbis*
the first party control unit includes a first party control panel connected to and through which the first party control integrated circuit is programmed	6, 11, 16, 22, 31	p. 3, lns. 20-24 p. 4, lns. 12-14 Fig. 1	*ipsis verbis*
the second party control unit includes a second party control integrated circuit connected to the second party hard disk, the playback random access memory and the first party control integrated circuit	7, 11, 16, 23, 32	p. 3, lns. 20-33 p. 4, lns 15-20 Fig. 1	*ipsis verbis*
the second party control integrated circuit and the first party control integrated circuit regulate the transfer of desired digital video or digital audio signals	7, 22, 23, 31, 32	p. 4, lns. 15-20	*ipsis verbis*
the second party control unit includes a second party control panel connected to and through which the second party control integrated circuit is programmed	7, 16, 19, 23, 26, 28, 32	p. 3, lns. 26-28 p. 4, lns. 12-14 Fig. 1	*ipsis verbis*

the playing means of the second party control unit includes a video display	9, 14, 18, 19, 25, 34	p. 3, lns. 26-33 p. 5, lns. 9-21 Fig. 1	*ipsis verbis*
the telecommunications lines include telephone lines	10, 11, 12, 15, 17, 20, 27, 29	p. 3, ln. 25 Fig. 1	*ipsis verbis*
means or mechanism for transferring money electronically via telecommunications lines from the second party to the first party	11, 16, 19	p. 1, lns. 10-12 p. 2, lns. 8-10, 20-26, 47-52 p. 3, lns. 20-25 p. 4, lns. 21-23	The as filed original specification has *ipsis verbis* support for electronic sales via telecommunications lines. A skilled artisan would readily recognize that electronic sales via telecommunications lines would include the transfer of money via telecommunications lines. This was addressed previously in the affidavit of Arthur Hair dated May 5, 1992.
means or mechanism for the first party to charge a fee to the second party and granting access to desired digital video or digital audio signals	16, 19, 26	p. 1, lns. 13-15 p. 2, lns. 8-10, 20-23, 47-50 p. 3, lns. 20-33 Fig. 1	The specification discloses electronic sales via telephone lines. Because the agent is authorized to sell and to transfer via telephone lines, there is implicitly support for selling and thereby charging a fee. This was previously pointed out in the declaration of Arthur Hair submitted December 30, 1993.

means or mechanism for connecting electronically via telecommunications lines the first memory with the second memory	11, 16,	p. 4, lns. 15-20 Fig. 1	A skilled artisan would readily recognize from the specification that the first memory would include a means for connecting to the second memory via the disclosed telephone lines.
the second party control unit includes an incoming random access memory	11, 16, 24, 33	p. 3, lns. 26-29 Fig. 1	*ipsis verbis*
means or mechanism for transmitting desired digital video or digital audio signals	11, 16, 26, 28	p. 1, lns. 10-12 p. 2, lns. 8-10, 20-26, 47-52 p. 3, lns. 20-25 p. 4, lns. 21-23	The as filed original specification has *ipsis verbis* support for electronic distribution via telecommunications lines. A skilled artisan would readily recognize that this requires transmission of those signals, where the telecommunications lines act as the transmitter. A skilled artisan would also readily recognize in order to receive digital audio or digital video signals over telecommunications lines, part of the second party control unit would act as a receiver. This was addressed previously in the affidavit of Arthur Hair dated May 5, 1992.

a transmitter connected to the first memory and the telecommunications lines, the first party in possession and control of the transmitter	11, 16	p. 1, lns. 10-12 p. 2, lns. 8-10, 20-26, 47-52 p. 3, lns. 20-25 p. 4, lns. 21-23	The as filed original specification has *ipsis verbis* support for electronic distribution via telecommunications lines. A skilled artisan would readily recognize that this requires transmission of those signals, where the telecommunications lines act as the transmitter.

a receiver connected to the second memory and the telecommunications lines, the second party in possession and control of the receiver	11, 16, 19, 26	p. 2, lns. 47-49 p. 3, lns. 35-38 p. 4, lns. 24-26	A skilled artisan would readily recognize in order to receive digital audio or digital video signals over telecommunications lines as disclosed throughout the specification, part of the second party control unit would act as a receiver. This was addressed previously in the affidavit of Arthur Hair dated May 5, 1992. A skilled artisan would readily recognize that the receiver is in possession and control of the second party, since the specification as originally filed states throughout that the user can store, sort and play thousands of songs from the user unit. A skilled artisan would clearly understand that this means the second party controls and possesses the second party control unit. This was previously pointed out in the declaration of Arthur Hair submitted December 30, 1993.

the transmitter remote from the receiver, the receiver at a location determined by the second party in electrical communication with the connecting means or mechanism	11	p. 2, lns. 47-50 p. 3, lns. 20-40 Fig. 1 p. 4, lns. 21-23	The original as filed specification states throughout that digital audio or digital video signals are sold and transferred via telephone lines. A skilled artisan would readily understand this to comprehend transfers between two remote locations. A skilled artisan would further recognize that in order for transmission of the digital audio or video signals to occur the transmitter and receiver have to be in electrical communication with the connecting means.
means or mechanism for storing desired digital video or digital audio signals with the receiver	11, 16	p. 3, lns. 26-31 p. 4, lns. 15-20 Fig. 1	The second party control unit includes a second party control integrated circuit which regulates the transfer of the digital audio and digital video signals. A skilled artisan would readily recognize that the second party integrated circuit regulates storage of the digital audio or digital video signals.

speakers in possession and control of the second party	14, 18, 26	p. 3, ln. 33, 47-49	The as filed original specification has *ipsis verbis* support for speakers. A skilled artisan would readily recognize that the speakers would be in possession and control of the second party since the specification throughout states that the second party may repeatedly listen to stored songs through the speakers.
the second party choosing desired digital audio signals from the first party's hard disk	26	p. 2, lns. 8-16, 20-27, 38-52 p. 35-49	Throughout the specification discloses electronic sales of digital video or digital audio signals. A skilled artisan would readily recognize that this includes the selection of individual desired signals by the purchaser.

Application Number	Applicati n/C ntr l N .	Applicant(s)/Patent under Re xamination	
	90/007,402	5191573	
	Examiner	Art Unit	
	Roland G. Foster	3992	

TRANSMITTAL FORM

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ENCLOSURES (*check all that apply*)

- ⊞ Fee Transmittal Form
  - ⊞ Fee Attached
- [X] Amendment/Reply
  - ⊞ Restriction Requirement
  - [x] Response/Amendment to non-final Office Action
  - ⊞ After Final
- ⊞ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ⊞ Express Abandonment Request
- ⊞ Information Disclosure Statement
- ⊞ Certified Copy of Priority Document(s)
- ⊞ Response to Missing Parts/ Incomplete Application
  - ⊞ Response to Missing Parts under 37 CFR 1.52 or 1.53
- ⊞ Assignment Papers *(for an Application)*
- ⊞ Drawing(s) – Figs.
- ⊞ Licensing-related Papers
- ⊞ Petition
- ⊞ Petition to Convert to a Provisional Application
- ⊞ Power of Attorney, Revocation Change of Correspondence Address
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  - [x] Certificate of Service

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	**Drinker Biddle & Reath LLP**
Signature	
Printed Name	**Robert A. Koons, Jr., Reg. No. 32474**
Date	29 November 2006

CERTIFICATE OF MAILING UNDER 37 CFR 1.10

I hereby certify that this paper, along with any documents referred to as being enclosed therewith, is being deposited with the United States Postal Service in an Express Mail envelope addressed to Mail Stop Ex Parte ReExam, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

Typed or printed name	Jane D. Roberts	Express Mail No.: **EV 502958270 US**
Signature	Jane D. Roberts	Date: 29 November 2006

CERTIFICATE UNDER 37 C.F.R. 1.10

In Re: Arthur R. Hair

Docket No.: 219099/573
Patent No.: 5,191,573
Re-Examination Control No.: 90/007,402
Re-Examination Filing Date: January 31, 2005
Examiner: Roland Foster
3992

EXPRESS MAIL: EV 502958270 US

DATE OF DEPOSIT: November 29, 2006

I hereby certify that the following correspondence

Transmittal Letter and Fee Sheet
Response/Amendment
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Jane D. Roberts
(Typed or printed name of person mailing paper)

Jane D Roberts
(Signature of person mailing paper or fee)

Drinker Biddle & Reath LLP
One Logan Square
18th and Cherry Streets
Philadelphia, PA 19103-6996

Customer No. 23973

PHIP\449843\1

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing Response in Reexamination No. 90/007,402 was served via First Class United States Mail, postage prepaid, this 29th day of November, 2006, on the following:

Mr. Albert S. Penilla
Martine, Penilla, & Gencarella, LLP
710 Lakeway Drive, Suite 200
Sunnyvale, CA 94085
Attorney for Third Party Reexamination Requester

By: _____
Robert A. Koons, Jr.
Attorney for Patentee

FEE TRANSMITTAL for FY 2006

Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT ($.00)

Complete if known	
Patent Number	5,191,573
Issue Date	2 March 1993
First Named Inventor	Arthur R. Hair
Examiner Name	Roland Foster
Control Number	90/007402
Attorney Docket No.	219099/573

METHOD OF PAYMENT *(check all that apply)*

☐ Check ☐ Credit Card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:
Deposit Account Number **50-0573**
Deposit Account Name **Drinker Biddle & Reath LLP**

The Director is authorized to: *(check all that apply)*

☐ Charge fee(s) indicated below ☒ Credit any overpayments

☒ Charge any additional fee required under 37 CFR 1.16 and 1.17

☐ Charge fee(s) indicated below, **except for the filing fee** to the above-identified deposit account.

FEE CALCULATION

Total Claims Remaining After Amendment: 12
Highest # Total Claims Previously Paid For: 43
Total Claims Unpaid For: 0

Independent Claims After Amendment: 4
Highest # Independent Claims Prev. Paid For: 10
Total Independent Claims Unpaid For: 0

Number of Multiple Dependent Claims: 0

Additional Fee Owed: 0

Large Fee Code	Entity Fee ($)	Small Fee Code	Entity Fee Code	Fee Description
1202	50	2202	25	Claims in excess of 20
1201	200	2201	100	Independent claims in excess of 3
1203	360	2203	180	Multiple dependent claim, if not paid
1204	200	2204	100	**Reissue independent claims over original patent
1205	50	2205	25	**Reissue claims in excess of 20 and over original patent

**or number previously paid, if greater; For Reissue, see above

FEE CALCULATION (continued)

ADDITIONAL FEES

Fee Code	Large Entity Fee ($)	Fee Code	Small Entity Fee ($)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge – late filing fee or oath	
1052	50	2052	25	Surcharge – late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for *ex parte* reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	120	2251	60	Extension for reply within first month	
1252	450	2252	225	Extension for reply within second month	
1253	1,020	2253	510	Extension for reply within third month	
1254	1,590	2254	795	Extension for reply within fourth month	
1255	2,160	2255	1,080	Extension for reply within fifth month	
1401	500	2401	250	Notice of Appeal	
1402	500	2402	250	Filing a brief in support of an appeal	
1403	1,000	2403	500	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	500	2452	250	Petition to revive – unavoidable	
1453	1,500	2453	750	Petition to revive – unintentional	
1501	1,400	2501	700	Utility issue fee (or reissue)	
1503	1,100	2503	550	Plant issue fee	
1462	400	1462	400	Petition to the Commissioner – Group I	
1463	200	1463	200	Petition to the Commissioner – Group II	
1464	130	1464	130	Petition to the Commissioner – Group III	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
1810	790	2810	395	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	790	2801	395	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	
Other fee (specify)					

SUBMITTED BY CUSTOMER NO. 23973 Complete (if applicable)

Name (Print/Type)	Robert A. Koons, Jr.	Registration No. (Attorney/Agent)	32474	Telephone	(215) 988.3392
Signature				Date	29 November 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	
ARTHUR R. HAIR	)	
	)	
Reexamination Control No. 90/007,402	)	
	)	
Reexamination Filed: January 31, 2005	)	METHOD FOR TRANSMITTING
	)	A DESIRED DIGITAL VIDEO OR
Patent Number: 5,191,573	)	AUDIO SIGNAL
	)	
Examiner: Roland Foster		

Mail Stop *Ex Parte* Reexamination
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE

In response to the Office Action for the above-identified reexamination dated September 29, 2006, please enter the following amendments and remarks.

Amendments to the Claims begin on page **2** of this paper.

Remarks begin on page **6** of this paper.

PHIP\530059\4

In the Claims

1.(Amended) A method for transmitting a desired digital audio signal stored on a first memory of a first party to a second memory of a second party comprising the steps of:

transferring money electronically via a telecommunications line to the first party at a location remote from the second memory and controlling use of the first memory from the second party financially distinct from the first party, said second party controlling use and in possession of the second memory;

connecting electronically via a telecommunications line the first memory with the second memory such that the desired digital audio signal can pass therebetween;

transmitting the desired digital audio signal from the first memory with a transmitter in control and possession of the first party to a receiver having the second memory at a location determined by the second party, said receiver in possession and control of the second party;

and storing the digital signal in a non-volatile storage portion of the second memory, wherein the non-volatile storage portion is not a tape or a CD.

4.(Amended) A method for transmitting a desired digital video signal stored on a first memory of a first party to a second memory of a second party comprising the steps of:

transferring money electronically via a telecommunications line to the first party at a location remote from the second memory and controlling use of the first memory from the second party financially distinct from the first party, said second party controlling use and in possession of the second memory;

connecting electronically via a telecommunications line the first memory with the second memory such that the desired digital video signal can pass therebetween;

transmitting the desired digital video signal from the first memory with a transmitter in control and possession of the first party to a receiver having the second memory at a location determined by the second party, said receiver in possession and control of the second party;

and storing the digital signal in a non-volatile storage portion of the second memory,

wherein the non-volatile storage portion is not a tape or a CD.

7 - 43. (Canceled)

44. (New) A method for transmitting a desired digital audio signal stored on a first memory of a first party to a second memory of a second party comprising the steps of:

transferring money electronically via a telecommunications line to the first party at a location remote from the second memory and controlling use of the first memory from the second party financially distinct from the first party, said second party controlling use and in possession of the second memory;

the second memory including a second party hard disk;

connecting electronically via a telecommunications line the first memory with the second memory such that the desired digital audio signal can pass therebetween;

transmitting the desired digital audio signal from the first memory with a transmitter in control and possession of the first party to a receiver having the second memory at a location determined by the second party, said receiver in possession and control of the second party;

and storing the digital signal in the second party hard disk.

45.(New) A method as described in claim 44 including after the transferring step, the steps of searching the first memory for the desired digital audio signal; and selecting the desired digital audio signal from the first memory.

46. (New) A method as described in claim 45 wherein the transferring step includes the steps of telephoning the first party controlling use of the first memory by the second party; providing a credit card number of the second party controlling the second memory to the first party controlling the first memory so the second party is charged money.

47. (New) A method for transmitting a desired digital video signal stored on a first memory of a first party to a second memory of a second party comprising the steps of:

transferring money electronically via a telecommunications line to the first party at a location remote from the second memory and controlling use of the first memory from the second party financially distinct from the first party, said second party controlling use and in possession of the second memory;

the second memory including a second party hard disk;

connecting electronically via a telecommunications line the first memory with the second memory such that the desired digital video signal can pass therebetween;

transmitting the desired digital video signal from the first memory with a transmitter in control and possession of the first party to a receiver having the second memory at a location determined by the second party, said receiver in possession and control of the second party;

and storing the digital signal in the second party hard disk.

48.(New) A method as described in claim 47 including after the transferring step, the steps of searching the first memory for the desired digital signal; and selecting the desired digital signal from the first memory.

49. (New) A method as described in claim 47 wherein the transferring step includes the steps of telephoning the first party controlling use of the first memory by the second party; providing a credit card number of the second party controlling the second memory to the first party controlling the first memory so the second party is charged money.

REMARKS

Claims 1 through 6, which originally issued in the patent under reexamination, and new Claims 44 through 49, are currently pending in the reexamination. Patentee has amended Claims 1 and 4. Patentee has canceled Claims 7 through 43 without prejudice. Patentee has added new Claims 44 through 49.

I. SUMMARY

Patentee first wishes to thank the Examiner and the Office for taking time to conduct the Interview held on November 16, 2006 to discuss the instant reexamination and the two copending reexaminations.

In the most recent Office Action, the Office has raised new rejections based on prior art and alleged failure of the patents in reexamination to comply with the written description and enablement requirements of 35 U.S.C. § 112, first paragraph. Related to the alleged failure of the claims to be supported properly or enabled by the originally filed specification, the Office has further alleged that the claims in the instant reexamination are not entitled to the priority date corresponding to the filing date of the original specification.

To establish either *prima facie* anticipation or obviousness of the claims, the Office has cited patent references that do not qualify as prior art based on the June 13, 1988 priority date, to which the Patentee believes the claims in reexamination are entitled. As a predicate for citing this post 1988 art, the Office has asserted that the claims of U.S. Patent No. 5,191,573 (the "'573 Patent") are not entitled to the June 13, 1988 filing date due to an alleged failure of the originally filed specification to provide an adequate written description and/or properly enable the claimed invention. For the reasons set forth below, Patentee respectfully submits that it is improper for the Office to reconsider the priority date awarded to the claims as issued in the original

examination. In addition, notwithstanding the impropriety of considering the issue, Patentee respectfully submits for the reasons set forth below that the claims as issued in the '573 Patent both are described adequately and enabled by the original specification as filed. As a result, the claims as issued are entitled to the June 13, 1988 priority date and the post 1988 references cited by the Office, i.e., U.S. Patent No. 4,949,187 to *Cohen* (*Cohen*); U.S. Patent No. 5,132,992 to *Yurt* (*Yurt*); and U.S. Patent No. 5,241,428 to *Goldwasser et al* (*Goldwasser*), cannot be considered for the purposes of 35 U.S.C. §§ 102 and 103.

The Office also has cited several references that antedate the June 13, 1988 priority date. However, all of these references relate to reproducing copies of audio or video signals on tapes and/or CDs. As set forth below, the claimed invention obviates the need for tapes and CDs as a storage medium for audio and video signals. As a result, none of the applicable prior art of record, either alone or in combination, shows suggests, or teaches each and every limitation of the claimed invention.

Further, the rejections of Claims 7 through 43 under 35 U.S.C. § 112, first paragraph have been mooted by the cancellation of those claims. As recognized by the Office, it is inappropriate to apply rejections under 35 U.S.C. § 112 to unamended claims, as is the case with originally issued Claims 1 through 6. Specifically, under 37 C.F.R. § 1.552, it is only appropriate to consider 35 U.S.C. § 112 "with respect to subject matter added or deleted in the reexamination proceeding."

Patentee has introduced amendments to originally issued Claims 1, and 4 that are fully supported by the specification filed on June 13, 1988, as set forth below. Patentee respectfully submits that, because the claims as issued in the '573 Patent are entitled to the June 13, 1988 priority date, and because the amendatory subject matter added by the instant amendments is

supported fully by the originally filed specification, the claims as amended also are entitled to the June 13, 1988 priority date, and further are allowable over the applicable prior art of record for the reasons set forth below.

II. CLAIM AMENDMENTS

Patentee has amended Claims 1 and 4 to recite that the digital audio or digital video signals are stored in a non-volatile storage portion of the second memory, wherein the non-volatile storage is not a tape or CD. Support for this feature is found in the originally filed specification for example at page 4, lines 35 to 49, *et seq.*, which recites specifically a hard disk for storing digital audio or digital video signals. A hard disk is a form of non-volatile storage. *See e.g.* http://en.wikipedia.org/wiki/Non-volatile_storage ("Non-volatile memory, or non-volatile storage, is computer memory that can retain the stored information even when not powered.") Examples of non-volatile storage include computer hard disks. *See Id.* This definition is consistent with the usage of the term "non-volatile storage" at the time the original specification was filed. *See e.g.* U.S. Patent No. 4,458,109 at column 10, lines 60 to 62 ("The message MSG is stored on a non-volatile mass storage subsystem 43, for instance a hard disk."); U.S. Patent 4,872,064 at column 8, lines 15 to 17 ("More generally, Remote Storage 3 can be any non-volatile storage device including hard disk.") Thus it is clear that at the time of filing, June 13, 1988, a skilled artisan would have understood that a hard disk is a non-volatile storage and therefore supports the limitation. Therefore, no new matter has been added by the amendments.

Patentee has canceled Claims 7 through 43 without prejudice. Claims 7 through 43 were added during reexamination in response to rejections presented by the previous examiner, Examiner Lanier. Since the previous rejections have been vacated, *sua sponte,* by the Office,

Patentee respectfully submits that the reasons for the addition of Claims 7 through 43 have been mooted. Therefore, in order to expedite the instant reexamination, Patentee has canceled those claims.

Patentee has added new Independent Claims 44 and 47 which mirror Claims 1 and 4 except that Claims 44 and 47 recite specifically that the second memory includes a second party hard disk and that the digital audio or digital video signals are stored on the second party "hard disk", whereas Claims 1 and 4 recite that the digital audio or digital video signals are stored in a non-volatile storage portion of the second memory that is not a tape or CD. The "hard disk" is explicitly supported throughout the originally filed specification as, for example at page 4, lines 35 to 49, *et seq*. Patentee has also added new dependent Claims 45 and 46, which mirror original Claims 2 and 3, and new dependent Claims 48 and 49, which mirror original Claims 5 and 6. No new matter has been added.

III. THE CLAIMS OF THE '573 PATENT ARE ENTITLED TO THE JUNE 13, 1988 PRIORITY DATE AWARDED DURING THE INITIAL EXAMINATION

The Office asserts that the claims of the '573 Patent are not entitled to the June 13, 1988 priority date awarded during the original examination of the patent. As a basis for depriving the claims of the original priority date, the Office has asserted that the claims are not supported by an adequate written description and/or not enabled by the originally filed specification. The Office has used this assertion as a predicate to assign a later priority date to the claims and thereby introduce new references, i.e., *Yurt*, *Cohen* and *Goldwasser*, that do not qualify as prior art based on the proper June 13, 1988 priority date.

Patentee wishes to point out that the '573 Patent issued from an application that was a continuation of the parent application originally filed on June 13, 1988. The application was accorded the priority date of June 13, 1988 by the original Examiner ("Examiner Nguyen")

based on a thorough examination, including amendments to the claims and specification during prosecution of the application. For the reasons set forth below, Patentee respectfully submits that the Office lacks authority in reexamination to revisit the issue of priority decided in an initial examination, especially where the facts, as in the present case, clearly show that the issue was dealt with in detail by the original examiner. Moreover, Patentee further respectfully submits that the claims, in fact, are adequately supported and enabled by the originally filed specification. As a result, the claims are entitled to the June 13, 1988 priority date, and *Yurt*, *Cohen* and *Goldwasser* are not available as prior art.

A. As a Matter of Law, the Office Lacks Jurisdiction in Reexaminations to Reassign Priority Dates for Originally Issued Claims in the Absence of a Previous Continuation-in-Part Application

Patentee respectfully submits that the Office lacks jurisdiction in reexamination proceedings, as a matter of law, to reassign priority dates to originally issued claims, where there is no continuation-in-part ("CIP") application in the chain of prior applications.

1. Jurisdiction to Reassign Priority Dates Is Limited to Claim Limitations Added or Deleted in Reexamination and to Claims Relying on a Continuation-in-Part Application

Patentee respectfully submits that it is impermissible, in the context of a reexamination, to apply 35 U.S.C. § 120 to reassign priority dates for originally issued claims. It is well established that the primary determination under Section 120 is whether priority is claimed to an earlier application that "fulfills the requirements of Section 112, first paragraph." *Callicrate v. Wadsworth Mfg.*, 427 F.3d 1361, 1373 (Fed. Cir. 2005) (citation omitted). It equally is well established, however, that the scope of a reexamination proceeding is limited to whether claims are patentable under 35 U.S.C. §§ 102 and 103 "on the basis of patents and printed publications." 37 C.F.R. § 1.552. The reexamination rules explicitly preclude consideration of issues arising

under 35 U.S.C. § 112, except "with respect to subject matter added or deleted in the reexamination proceeding." *Id.*; *see In also re Etter*, 756 F.2d 852, 856 (Fed. Cir. 1985) (en banc) ("only new or amended claims are also examined under 35 U.S.C. §§ 112 and 132"). Moreover, the inquiry under Section 120 as to whether the language of a particular claim, as filed or amended during an original prosecution, was supported or unsupported by sufficient disclosure is, by definition, not a *new* question. Rather, it is an issue that necessarily arises at the time of original filing or amendment, and one that necessarily is before the original examiner. It cannot, therefore, raise a "substantial new question of patentability in reexamination," 35 U.S.C. § 303, because it is never a "new question" at all. Accordingly, Patentee respectfully submits that Section 120 cannot be used as a back door through which a reexamination proceeding may reach Section 112 issues for originally issued unamended claims.

The Office apparently relies on MPEP §§ 2258(I)(C) and 2217 for an implicit grant of authority to cite intervening art based upon a newly determined effective filing date for claims. Patentee respectfully submits, however, that a close reading of these MPEP Sections requires they properly be limited to situations where there was a continuation-in-part ("CIP") application in the chain of applications leading to the patent under reexamination. In fact, both of the cases cited for support of MPEP §§ 2217 and 2258(I)(C), *In re Ruscetta*, 255 F.2d 687 (CCPA 1958) and *In re van Langenhoven*, 458 F.2d 132 (CCPA 1972), are cases involving CIPs. These cases thus should be read as limited to CIP applications, and their holdings are inapplicable to situations involving pure continuation or divisional applications. Moreover, since both cases predate the enactment by Congress of the reexamination statute, 35 U.S.C. §§ 301 et seq., the cases cannot be read to justify, in the special context of reexamination, something that would plainly be impermissible by an examiner in the context of an original examination.

2. The Jurisdiction of a Reexamination Examiner Cannot Exceed the Authority of an Original Examiner to Reassign Priority Dates

During an original examination, if disclosure has been added to a specification and an examiner believes claims in an application are unsupported by the specification as originally filed, the proper procedure is to object under 35 U.S.C. § 132 to any alleged new matter appearing in the specification, and reject the claims as unsupported under Section 112. *See* MPEP § 706.03(o). Thereafter, if the applicant does not overcome the objection and rejection, the applicant has the option of refiling the application as a CIP including a new oath or declaration in support of the new matter, with the rejected claims being relegated to the actual filing date of the CIP for prior art purposes. However, in the absence of a CIP an original examiner cannot simply elect to assign a later effective priority date to claims the examiner believes are unsupported by an original specification, and then proceed to cite intervening art based upon the newly determined date. Such a procedure would amount to creation of a "*de facto* CIP" by the original examiner, an undertaking plainly unsupported by statute, regulation, case law, or MPEP provision, or any other authority or precedent.

During reexamination, it is well established that the scope of the proceeding is limited, and is considerably narrower than the scope of the original examination. *See* 37 C.F.R. 1.552. Accordingly, it is undisputed that a reexamination examiner can have no greater authority than an original examiner. As a result, because an original examiner cannot create a "*de facto* CIP," reassign priority dates, and reject claims over intervening prior art, it is clear that a reexamination examiner cannot do that either.

In the present case, no CIP was ever required by the original examiner or filed by the Applicant, and the original examiner therefore could not -- and did not -- reassign priority dates to the original claims. Patentee therefore respectfully submits that the present Examiner likewise

lacks authority -- and therefore jurisdiction -- to reassign priority dates to the pending unamended claims in reexamination that originally issued in the '573 Patent.

B. The Issue of Compliance with 35 U.S.C. § 112 was Considered and Passed on During the Original Examination Resulting in the '573 Patent and the Office Therefore Lacks Jurisdiction to Revisit the Same Issue in this Proceeding

Patentee respectfully submits that the Office further lacks jurisdiction under the facts in this proceeding to challenge the priority date of the unamended originally issued claims in reexamination, because the issue of those claims' entitlement to the filing date of the original application previously was considered and decided during the original examination of the '573 Patent.

1. The Issue of Compliance With 35 U.S.C. § 112 Was Considered and Passed On By the Original Examiner

The Office has asserted in the present Office Action that additional unsupported disclosure was added to the specification of the '573 Patent during its original prosecution. The Office has asserted further that the original examiner, Examiner Nguyen, did not consider or have reason to consider the issue of whether the additions to the specification constituted new matter. In support of these assertions, Examiner Foster has provided a helpful chart in the Office Action, showing when and under what circumstances additions to the specification and resulting claim amendments were made in the '573 Patent and its predecessor applications.

In order to demonstrate that Examiner Nguyen did in fact consider the various additions to the specification and concluded those additions did not constitute new matter and the subject claims therefore were supported under Section 112, Patentee has reproduced Examiner Foster's chart in amended form. The chart has been amended by adding three columns, subtitled

respectively "Consideration by Examiner Nguyen," "Response by Applicant," and "Subsequent Action by Examiner Nguyen." That chart is set forth immediately below:

	Parent Application 07/206,497 filed June 13, 1988		Child Application 07/586,391 filed September 18, 1990		Office Action in Application 07/586,391 and response		Issuance of '573 Patent
Feature	Date First Appearing in Claims of Parent Application	Date First Appearing in Specification of Parent Application	Date First Appearing in Claims of Child Application	Date First Appearing in Specification of Child Application	Consideration by Examiner Nguyen	Response by Applicant	Subsequent Action by Examiner Nguyen
Transferring Money from Second Party to a First Party (Charging a Fee)	December 22, 1988 February 28, 1990			September 18, 1990	Considered in Office Action February 24, 1992	Objection/rejections specifically responded to in June 25, 1992 response	Claims allowed in September 21, 1992 Office Action
Providing a Credit Card Number	December 22, 1988			September 18, 1990	Considered in Office Action February 24, 1992	Objection/rejections specifically responded to in June 25, 1992 response	Claims allowed in September 21, 1992 Office Action
Controlling Use of First/Second Memory	December 22, 1988			September 18, 1990	Considered in Office Action February 24, 1992	Objection/rejections responded to in June 25, 1992 response	Claims allowed in September 21, 1992 Office Action
Transmitting to a Location Determined by Second Party	February 28, 1990			September 18, 1990	Considered in Office Action February 24, 1992	Objection/rejections responded to June 25, 1992	Claims allowed in September 21, 1992 Office Action
Specific Video Download Procedures	February 28, 1990			September 18, 1990	No new matter issues were ever raised	No response was ever necessary since no issue was ever raised	Claims allowed in September 21, 1992 Office Action
First Party in Possession of Transmitter	August 24, 1990 (not entered)			September 18, 1990	Considered in Office Action February 24, 1992	Objection/rejections responded to in June 25, 1992 response	Claims allowed in September 21, 1992 Office Action

Second Party in Possession of Receiver and Second Memory	August 24, 1990 (not entered)			September 18, 1990	Considered in Office Action February 24, 1992	Objection/rejections specifically responded to in June 25, 1992 response	Claims allowed in September 21, 1992 Office Action

The foregoing chart shows that, following submission of the subject additions to the specification and corresponding amendments to the claims, Examiner Nguyen considered those additions and amendments in the Office Action of February 24, 1992. That consideration included an objection to the specification as containing new matter under Section 132, and corresponding rejections of the relevant claims under Section 112. The Applicant responded to, and overcame, that objection and those rejections in the Response of June 25, 1992. In that Response, the Applicant included arguments and a Declaration under 37 CFR 1.132 establishing that the additions to the specification had ample antecedent support in the originally filed specification because the subject matter of the additions was implicitly disclosed and understood by those skilled in the art. After considering this Response by the Applicant, Examiner Nguyen withdrew the objection to the specification and the Section 112 rejections of the claims, and thereby determined the claims were allowable.

Patentee respectfully submits that the amended chart set forth above demonstrates indisputably that Examiner Nguyen did consider, or at least had every reason and opportunity to consider, the very same new matter and Section 112 rejections the Office has made in the present Office Action. Moreover, even though no objection or rejections were made by Examiner Nguyen concerning the additional "video feature" disclosure and claim elements, it is clear from the Examiner Nguyen's overall thorough analysis of the other Section 132 and Section 112 issues that she similarly had every reason and opportunity to object to the "video feature" disclosure and reject those claims as well. She did not, however, do that. As a result, it is clear

Examiner Nguyen at least implicitly considered and passed on the "video feature" specification additions and claims as well, thereby allowing all of the pending claims to issue in the September 21, 1992 Office Action.

2. The Office Lacks Jurisdiction to Review Again the Same Section 112 Issues Determined by the Original Examiner

As established above, the question of Section 112 support, and hence the appropriate priority date for the claims in the issued '573 Patent, were considered and passed on by Examiner Nguyen in the original examination. The Patentee therefore respectfully submits that, as a matter of established law, the Office lacks jurisdiction under the facts in this proceeding to challenge again the Section 112 support and the 1988 priority date of the same claims in reexamination.

In *Patlex v. Quiqq*, 680 F.Supp. 33, (D.D.C. 1988), the United States District Court for the District of Columbia addressed a situation substantially identical to the circumstances of the present reexamination. In that case, the District Court reversed, on summary judgment, a decision by the BPAI upholding the final rejection of three claims in a reexamination proceeding. The claims in question had issued in a patent that resulted from a string of continuation and divisional applications relating back to an original priority application. The reexamination examiner took the position that the three claims were not entitled to the original priority date, and instead reassigned a later effective priority date, based on the reexamination examiner's determination that the specification had not enabled the three claims under Section 112 as of the original filing date.

The District Court determined, however, that the issue of whether the three claims were enabled under Section 112 previously had been considered and decided by the original examiner,

and the Court therefore explicitly held that the reexamination examiner lacked jurisdiction to consider that issue again:

> Entitlement to the ... [original priority] filing date was decided in the ... [original] examination. Plaintiffs contended then they were entitled to the [original priority] filing date, and the first Examiner considered then whether the [original] disclosure was enabling. Consequently, in order to reexamine ... [the patent] on the basis of whether the claims were anticipated by ... [later prior art], the reexamination examiner had to "reexamine" the question of whether the specification of the ... [original application] contained an enabling disclosure of the subject matter claimed in the ... [patent]. As noted above, however, the reexamination statute does not contemplate a "reexamination" of the sufficiency of a disclosure. Rather it is limited to reexamination of patentability based on prior art patents and publications. Hence, the Court concludes that the Examiner and the Board lack jurisdiction in this case to "reexamine" the sufficiency of the specification of the ... [original application]." Id. at 36. (Emphasis added)

The holding of the *Patlex* case, therefore, is clear. Where, as in the present case, an original examiner already has considered and determined the sufficiency of a specification's disclosure under Section 112 and the resulting entitlement of claims to an original priority date, there is no "substantial new" question of patentability for reexamination, as required by 35 U.S.C. §§ 301, *et seq*. As a result, the Office lacks jurisdiction to "reexamine" that same issue for those same claims in a subsequent reexamination proceeding.

Patentee therefore respectfully requests that, for this reason as well, the Office withdraw the current Section 112 rejections and reassignment of later priority dates for the originally issued unamended claims.

C. In Any Event, the Claims as Issued in the '573 Patent Plainly Were Supported by the Originally Filed Specification

As previously described, the Office has asserted in the present Office Action, *inter-alia*, that the claims as originally issued in the '573 Patent rely for written description support on certain alleged new matter added to the specification during the original prosecution of the '573 Patent. The Office also has asserted that the claims directed to the video embodiment of the

invention are not supported by disclosure that was enabling as of the original June 13, 1988 filing date claimed by Patentee. As set forth above in Sections III(A) and (B) above, Patentee's position is that the Office lacks jurisdiction to review issues of adequate written description and enablement, especially where the particular issue was dealt with explicitly in the original prosecution of the patent in reexamination. Nonetheless, Patentee further respectfully traverses these rejections because, in any event, it is clear the originally filed specification in fact does provide both adequate written description for all of the issued claims and an enabling disclosure for those claims directed to the "video feature" of the invention.

1. The Claims as Issued in the '573 Patent are Supported by Adequate Written Description in the Originally Filed Specification

In the current Office Action, Examiner Foster provided a helpful chart showing alleged new matter added to the specification of the '573 Patent during prosecution. Patentee reproduced an amended version of the examiner's chart above in Section III(B)(1), thereby demonstrating that the alleged new matter was considered by Examiner Nguyen and was determined, in fact, not to be new matter. However, for the sake of thoroughness and to reinforce that Examiner Nguyen correctly determined the issues, Patentee provides below an analysis demonstrating that each element in Claims 1 through 6 as issued in the '573 Patent in fact was supported, either explicitly or implicitly, by the original specification filed on June 13, 1988.

i) The Proper Standard for Determining if the Claims are Adequately Supported by the Specification as Filed

As a preliminary matter, Patentee wishes to point out that the standard for written support in the absence of *ipsis verbis* recitation of a claim limitation is not strictly the inherency or required interpretation standard urged by the Office. Rather, the proper standard generally is

whether the written description reasonably conveys to the skilled artisan that the inventor was in possession of the claimed subject matter.

The issue of whether the written description requirement has been met is a question of fact, to be determined on a case-by-case basis. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1562 (Fed. Cir. 1991). The legal standard for determining whether the facts of a particular case meet the written description requirement is not in dispute, however. In *Vas-Cath,* the CAFC held that "[t]he test for sufficiency of support in a patent application is whether the disclosure of the application relied on '***reasonably conveys*** to the skilled artisan that the inventor had possession at that time of the later claimed subject matter.'" *Vas-Cath* 935 F.2d at 1563 (emphasis added). As further held by the CAFC in *Union Oil Co. of Cal. v. Atlantic Richfield Co.*, 208 F.3d 989 (Fed. Cir. 2000), "[t]he written description does not require the applicant 'to describe exactly the subject matter claimed, [instead] the description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.'" *Union Oil*, 208 F.3d at 997.

Because the written description requirement is fact-based, various decision makers have at times appeared to drift from the "reasonably conveys" standard mandated by the CAFC. The CAFC, however, has never wavered from this standard. For example, in *Hyatt v. Boone*, 146 F.3d 1348 (Fed. Cir. 1998) the court reviewed a BPAI decision holding that one party to an interference (Hyatt) lacked the necessary written description in his originally filed application to support a later claim drawn to a count of the interference. The phraseology used by the BPAI in setting forth the standard for compliance with the written description requirement was that "the written description must be sufficient, when the entire specification is read that the 'necessary and only reasonable construction' that would be given it by a person of ordinary skill in the art is one that clearly supports each positive limitation in the count." *Hyatt*, 146 F.3d at 1353. The

appellant argued that the "necessary and only reasonable construction" standard applied by the BPAI was different from and more rigorous than the "reasonably conveys standard" set forth in *Vas-Cath*.

The CAFC determined, however, that the different phraseology used by the BPAI in fact did not a set different standard for meeting the written description requirement. Rather, the standard remains that "the written description must include all of the limitations...or the applicant must show that any absent text is ***necessarily comprehended*** in the description provided and would have been so understood at the time the patent application was filed." *Hyatt*, at 1354-55 (emphasis added). Moreover, the CAFC has on subsequent occasions repeatedly reinforced that the standard of *Vas-Cath* remains in effect. *See, e.g. Pandrol USA, LP v. Airboss Ry. Products, Inc.*, 424 F.3d 1161 (Fed. Cir. 2005)("[t]he applicant must...convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention."). In contrast, the general standard does not require that the "only reasonable interpretation" of the general features in the specification be the more specific features in the claims. *Vas-Cath* at 1566 ("[t]he [district] court further erred in applying a legal standard that essentially required the drawings of the '081 design application to *necessarily exclude* all diameters other than those within the claimed range.")(emphasis in original).

In addition to *Hyatt,* the Office has cited *In re Robertson*, 169 F.3d 734 (Fed. Cir. 1999) and *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565 (Fed. Cir. 1997) as establishing a strict inherency standard for finding written support for a claim element not having *ipsis verbis* support in the specification. In the first instance, Patentee respectfully submits that the citation of *In Re Robertson* is inapposite. In *Robertson,* the CAFC reiterated the well known standard for determining anticipation or obviousness of a claim by prior art where the prior art does not

include literal disclosure of one or more elements of the claim. As such, *Robertson* was a case directed solely to Section 102/103 issues, and does not even mention Section 112. Moreover, nowhere in *Hyatt* or *Lockwood* does either court even allude to an inherency standard for showing support for claim limitations not described *ipsis verbis* in the specification. Rather, the CAFC simply held in *Lockwood* that "exact terms need not be used *in haec verba*..., the specification must contain an equivalent description of the claimed subject matter." *Lockwood*, 107 F.3d at 1572 (citations omitted).

Patentee therefore respectfully submits that the requirement of an inherency standard under Section 112 is unsupported by *Hyatt, Robertson,* or *Lockwood.* Rather the proper standard to be applied by the Examiner in determining compliance with the written description requirement remains "whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language." *In re Kaslow*, 707 F.2d 1366 (Fed. Cir. 1983).

ii) All Features of Claims 1 Through 6 in the '573 Patent Find Written Support in the Originally filed Specification

Applying the proper standard for compliance with the written description requirement under Section 112, Patentee respectfully submits that all of the limitations in Claims 1 through 6 of the '573 Patent were supported by the originally filed specification. To illustrate this point, Patentee has prepared a detailed chart showing each feature of the invention, the claims in which those features are recited, and where support in the originally filed specification is found for each feature. That chart is set forth immediately below:

Feature	Claims Reciting Feature	Written Description of Feature in Original Specification	Comments

A method for transmitting a desired digital audio signal	1	p. 1, lns. 7-9 p. 2, lns. 8-10, 20-26	*ipsis verbis* support
stored on a first memory of a first party to a second memory of a second party	1, 4	p. 3, lns. 35-40 p. 4, lns. 12-26	The specification states *ipsis verbis* that the hard disk in the control unit of the authorized agent is the source of the digital signal. Further, the specification states that the digital signal is transferred to the hard disk in the control unit of the user. A skilled artisan would understand this as transferring signals stored on a first memory to a second memory.
transferring money via a telecommunications line to a first party location remote from the second memory	1, 4	p. 1, lns. 13-15 p. 2, lns. 8-10, 20-23, 47-50 p. 3, lns. 20-33 Fig. 1	The specification discloses electronic sales via telephone lines. Because the agent is authorized to sell and to transfer via telephone lines, there is implicitly support for selling and thereby transferring money. This was previously pointed out in the declaration of Arthur Hair submitted May 5, 1992. A skilled artisan would readily understand this to comprehend transfers between two remote locations.
second party financially distinct from the first party	1, 4	p. 1, lns. 13-15 p. 2, lns. 8-10, 20-23, 47-50 p. 3, lns. 20-33	A skilled artisan would readily recognize that a sale requires the parties to be financially distinct. This was previously pointed out in the declaration of Arthur Hair submitted May 5, 1992.
second party controlling use and in possession of the second memory	1, 3	p. 3, lns. 26-33, 40-43	The as filed original specification includes *ipsis verbis* support for a second party control unit, where the user is the second party. A skilled artisan would readily recognize that the second memory is in possession and control of the second party, since the specification as originally filed states throughout that the user can store, sort and

			play thousands of songs from the user unit. A skilled artisan would clearly understand that this means the second party controls and possesses the second party control unit. This was previously pointed out in the declaration of Arthur Hair submitted May 5, 1992.
connecting electronically via a telecommunications line the first memory with the second memory	1, 4	p. 3, lns. 35-40	*ipsis verbis* support
transmitting the desired digital audio signal from the first memory with a transmitter in control and possession of the first party	1	p. 2, ln. 47-52 p. 3, lns. 35-40 Fig. 1	The as filed original specification has *ipsis verbis* support transmitting a desired digital audio signal and that the hard disk in the control unit of the authorized agent is the source. A skilled artisan would recognize that in order to regulate distribution of the signals the authorized agent would have to possess and control the transmitter. This was previously pointed out in the declaration of Arthur Hair submitted May 5, 1992.
to a receiver having the second memory at a location determined by the second party; said receiver in possession and control of the second party	1, 4	p. 2, lns. 47-50 p. 3, lns. 20-40 Fig. 1 p. 4, lns. 21-23	A skilled artisan would readily recognize in order to receive digital signals over telecommunications lines as disclosed throughout the specification, part of the second party control unit would act as a receiver. This was addressed previously in the affidavit of Arthur Hair dated May 5, 1992. A skilled artisan would also readily understand this to comprehend transfers between two remote locations. Since the second party possesses the second memory the second party can determine its location. This was addressed previously in the declaration

			of Arthur Hair submitted May 5, 1992.
storing the digital audio signal in the second memory	1	p. 2, lns. 23-27	*ipsis verbis* support
searching the first memory for the desired digital audio signal	2	p. 3, lns. 35-40 p. 4, lns. 12-28	The as filed original specification has *ipsis verbis* support for electronic sales and electronic transfer of digital signals from a control unit of an authorized agent to a control unit of a user. A skilled artisan would readily recognize that this would include searching the hard disk of the first party to locate desired digital signals for purchase.
selecting the desired digital audio signal from the first memory	2	p. 3, lns. 35-40 p. 4, lns. 12-28	The as filed original specification has *ipsis verbis* support for electronic sales and electronic transfer of digital signals from a control unit of an authorized agent to a control unit of a user. A skilled artisan would readily recognize that this would include selecting desired digital signals from the hard disk of the first party for purchase.
telephoning the first party controlling use of the first memory by the second party	3, 6	p. 2, lns. 47-50 p. 3, lns. 20-40 Fig. 1 p. 4, lns. 21-23	The original as filed specification states throughout that digital audio or digital video signals are sold and transferred via telephone lines. A skilled artisan would readily recognize this as comprehending the telephoning of the first party by the second party to initiate a transaction. This was addressed previously in the declaration of Arthur Hair submitted May 5, 1992.
providing a credit card number of the second party to the first party so that the second party is charged money	3, 6	p. 1, lns. 13-15 p. 2, lns. 8-10, 20-23, 38-52 p. 3, lns. 12-15, 35-37	The original as filed specification states throughout that the invention provides for electronic sales of digital audio or digital video

			signals. A skilled artisan would readily recognize credit card sales as being comprehended within electronic sales. This was addressed previously in the affidavit of Arthur Hair dated May 5, 1992.
first party controlling the first memory	3, 6	p. 2, lns. 38-43 p. 3, lns. 35-49	The as filed original specification includes *ipsis verbis* support for a first party control unit, where the authorized agent is the first party. A skilled artisan would readily recognize that the first party control unit is in possession and control of the first party because as an "agent authorized to electronically sell and distribute" digital audio or digital video, the first party would necessarily have to possess and control the source of the digital audio and digital video. This was previously pointed out in the declaration of Arthur Hair submitted May 5, 1992.
A method for transmitting a desired digital video signal	4	p. 5, lns. 36-43	*ipsis verbis* support
transmitting the desired digital video signal from the first memory with a transmitter in control and possession of the first party	4	p. 5, lns. 36-43 p. 2, ln. 47-52 p. 3, lns. 35-40 Fig. 1	The as filed original specification has *ipsis verbis* support transmitting a desired digital audio signal and that the hard disk in the control unit of the authorized agent is the source. A skilled artisan would recognize that in order to regulate distribution of the signals the authorized agent would have to possess and control the transmitter. This was previously pointed out in the declaration of Arthur Hair submitted May 5, 1992. A skilled artisan would recognize based on the disclosure at the end of the specification that this

			procedure could also be used for digital video.
storing the digital video signal in the second memory	4	p. 5, lns. 36-43 p. 2, lns. 23-27	The as filed original specification has *ipsis verbis* support for storing digital signals on the hard disk of the user control unit. A skilled artisan would recognize based on the disclosure at the end of the specification that this procedure could also be used for digital video.
searching the first memory for the desired digital video signal	5	p. 3, lns. 35-40 p. 4, lns. 12-28 p. 5, lns. 36-43	The as filed original specification has *ipsis verbis* support for electronic sales and electronic transfer of digital signals from a control unit of an authorized agent to a control unit of a user. A skilled artisan would readily recognize that this would include searching the hard disk of the first party to locate desired digital signals for purchase. A skilled artisan would recognize based on the disclosure at the end of the specification that this procedure could also be used for digital video.
selecting the desired digital video signal from the first memory	5	p. 3, lns. 35-40 p. 4, lns. 12-28 p. 5, lns. 36-43	The as filed original specification has *ipsis verbis* support for electronic sales and electronic transfer of digital signals from a control unit of an authorized agent to a control unit of a user. A skilled artisan would readily recognize that this would include selecting desired digital signals from the hard disk of the first party for purchase. A skilled artisan would recognize based on the disclosure at the end of the specification that this procedure could also be used for digital video.

For all the reasons set forth in the chart immediately above, Patentee respectfully submits that the written description standard was satisfied for originally issued Claims 1 through 6 of the '573 Patent.

2. The "Video Feature" of the Invention in Claims 4 Through 6 of the '573 Patent was Enabled by the Originally Filed Specification

The Office asserts the "video feature" of the invention in Claims 4 through 6 was not enabled by the disclosure in the originally filed specification. Patentee respectfully traverses this for the reasons set forth below.

The Office acknowledges the "original specification does contain a general statement at the end of the specification stating '[f]urther, it is intended that this invention not be limited to Digital Audio Music and can include Digital Video....'" The Office, however, generally asserts "this broad, generic statement fails to enable specifically claimed video download and processing procedures." Office Action, page 12. Since the Office has not specifically identified which portions of the claims allegedly are not enabled, Patentee will discuss below the issue of enablement with respect to particular comments made in the Office Action.

Initially, Patentee respectfully submits that it appears the Office is attempting to apply a "mass production" standard to the claims when, in actuality, the enablement standard of Section 112 has no such requirement. As the CAFC held in *Christianson v. Colt Indus. Operating Corp.*, 822 F.2d 1544 (Fed. Cir. 1987) "the law has never required that a patentee ... must disclose in its patent the dimensions, tolerances, drawings, and other parameters of mass production not necessary to enable one skilled in the art to practice (as distinguished from mass-produce) the invention." Nonetheless, it appears this kind of "mass production" information is exactly the kind of information the Office now seeks. For example, the Office Action states "[p]ersonal user

devices with the processing power capable of playing back much larger and more complicated digital video files, such as DVD players, were not routinely available until the late 1990(s)." Office Action, pages 19-20. (emphasis added.) Whether such devices "routinely" were available is not part of the test for enablement, nor is it one of the eight factors for reasonable experimentation that were laid out by the CAFC in *In re Wands*, 858 F.2d 731 (Fed. Cir. 1988). Rather, the only relevant test is whether, without undue experimentation, one of ordinary skill in the art could have made and used the claimed invention.

As further evidence that the Office seeks to apply a "mass production" standard, it is noted that the Office Action states "the digital bandwidth required to transmit a video signal at even VHS quality was around 1.5 megabits per second (approximately 30 megabytes in 3 minutes)." Office Action, page 14. (emphasis added.) However, while VHS quality may be appropriate for "mass production," a limitation requiring VHS quality video is not included in any of the claims, and thus it is impermissible for the Office to use that level of quality as a benchmark for enablement. In fact, the recent success of very small screen video players shows that "mass production" can be achieved with even less than VHS quality.

Moreover, even if VHS quality were a requirement for enablement of the claims, there is no articulated basis to believe the original specification would not have enabled one of ordinary skill in the art to meet that quality for a short period of time. This fact is accentuated by the statement in the Office Action that "it is not clear ... how downloaded files of any appreciable or viable size would have been downloaded and stored on originally disclosed hard disk 60 of the user in the original specification." Office Action, page 20. (emphasis added.) The use of "appreciable" and "viable" makes it clear that short videos are enabled, and nothing more is required. Moreover, the Office appears to acknowledge that even a 30 megabyte hard drive

could store a three-minute movie if encoded at 1.5 megabits/second. *Id.* That alone is sufficient to meet the enablement requirement.

Moreover, Patentee respectfully submits that the Office impermissibly limits the scope of what it referenced when the Office Action cites the size of available hard drives. While a 30 megabyte hard drive would have been available in a 3.5 inch form factor, the same chart relied on by the Office illustrates that hard drives larger than 1.89 gigabytes were available at the same time. See Exhibit "A" to this Response, which is a copy of the chart cited in footnote 14 of the Office Action.

The Office has applied the same "mass production" requirement to the library server. The Office initially seems to acknowledge that mainframes did exist which could have operated as repositories for copyrighted materials using hard disk drives. However, the Office then seems to discount the relevance of the existing mainframes by stating "it is not clear how even a small-sized video library ... would have been stored in the hard disk of the copyright holder ... without requiring details directed to a complex mainframe operating environment." Patentee respectfully submits this unsupported statement on "complexity" is insufficient to prove that mainframe operating environments capable of storing digital video files were not already known at the time the original specification was filed, or that undue experimentation would have been required to store digital video files in such an environment. The statement also leaves unanswered how the Office is defining "small" -- according to the enablement standard under Section 112 or the improper "mass production" standard?

The Office Action further states "[r]egarding the transfer of these large video files over a network, the proliferation of broadband communication network[s] capable of delivering these large files to consumers, such as the Internet, simply did not exist or were not well known in

1988." Office Action, pages 14-15. (emphasis added.) Such a statement raises at least two issues. First, "not well known" to whom? Those of ordinary skill in the art of computer systems knew of telephony-based wide area networks at the time the original specification was filed. See http://www.rfc-editor.org/rfc-index.html for a list of computer communications standards including those available at the time of filing. Second, utilization of a "broadband" network is not required. In fact, the originally filed specification discloses that the audio and video files can be transferred over telephone lines. While this may not be an extremely fast method of transfer, it nonetheless clearly is enabling under Section 112.

The Office further questions "how the digital video would have been coded and decoded during transmission, as digital video coding standards for purposes of transmission and file download were not settled in 1988. [T]he MPEG-1 standard which was designed to code/decode digital video information and to transmit the video via a telephone (telecommunications) network in NTSC (broadcast) quality for archiving, was only established in 1992." Office Action, page 21. (emphasis added.) Again, Patentee respectfully notes that standardization of video coding and the use of "NTSC quality" relate to "mass production" rather than enablement under Section 112. Thus, the Office has not alleged -- and cannot allege -- that one of ordinary skill in the art could not have coded video at some other resolution or using some other encoding technique at the time the original specification was filed.

Accordingly, Patentee respectfully submits that Claims 4 through 6 directed to the "video feature" embodiment of the invention were enabled by the originally filed specification under the proper standard for Section 112 enablement.

D. Because the Originally Issued Claims of the '573 Patent are Entitled to the June 13, 1988 Priority Date Awarded During the Original Examination, the References *Yurt*, *Cohen* and *Goldwasser* are not Appropriate Prior Art

Based on the foregoing, Patentee respectfully submits that originally issued Claims 1 through 6 of the '573 Patent are entitled to the June 13, 1988 priority date. In the first instance, it is improper for the Office to reconsider the issue of priority in the present reexamination for the reasons set forth in Sections III(A) and (B) above. Further, even if it were proper to reconsider the issue of priority, Patentee respectfully submits the facts of record clearly show the claims were described adequately and enabled by the originally filed specification for the reasons set forth in Section III(C) above. Patentee therefore respectfully submits that the references *Yurt*, *Cohen* and *Goldwasser* are not appropriate prior art because all of these references post-date the applicable June 13, 1988 priority date of the claims. Patentee therefore respectfully requests that all rejections based on these references be withdrawn.

IV. THE AMENDED AND NEW CLAIMS ARE NEITHER ANTICIPATED BY, NOR OBVIOUS OVER, THE APPROPRIATE PRIOR ART OF RECORD

Claims 1 through 6 have been rejected as either anticipated by or obvious over several references that antedate the proper June 13, 1988 priority date of the claims, and one reference that post-dates the proper June 13, 1988 priority date. Specifically:

Claims 1 through 6 are rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,789,863 to Bush (*Bush*);

Claims 1, 2, 4 and 5 are rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 4,949,187 to Cohen (*Cohen*);

Claims 3 and 6 are rejected under 35 U.S.C. § 103 as obvious over *Cohen* in view of *Bush*;

Claims 1 through 6 are rejected under 35 U.S.C. § 103 as obvious over Japanese Published Application No. 62-284496 to Akashi (*Akashi*) in view of U.S. Patent No. 4,528,643 to Freeny (*Freeny*).

Patentee has amended Claims 1 and 4 to specify that the digital audio or digital video signals are stored in a non-volatile storage portion of the second memory, wherein the non-volatile storage portion is not a tape or CD. Patentee also has added new Claims 44 and 47 to specify that the second memory includes a hard disk and that the digital audio or digital video signals are stored in the second party hard disk. As a result, Patentee respectfully submits that none of the appropriate prior art of record, either alone or in combination, shows, suggests or teaches each and every limitation of independent Claims 1, 4, 44, and 47. By extension, none of the appropriate prior art, either alone or in combination, shows, suggests or teaches each and every limitation of dependent Claims 2, 3, 5, 6, 45, 46, 48 or 49.

A. The Rejections Based on *Cohen* are Improper and Should be Withdrawn

As demonstrated above in Section III, Claims 1 through 6 of the '573 Patent as issued were entitled to the June 13, 1988 priority filing date of the original application. Further, as shown above in Section II, the added recitations of "wherein the second memory comprises a non-volatile storage that is not a tape or CD" and "wherein the second memory comprises a hard disk" are both supported in the original specification filed June 13, 1988. As a result, amended Claims 1 and 4, new Claims 44 and 47, and all of their respective dependent claims are entitled to the June 13, 1988 priority date. *Cohen* therefore is not appropriate prior art against these claims for the purposes of 35 U.S.C. §§ 102 and 103. Patentee therefore respectfully submits that the rejections based on *Cohen* alone, and *Cohen* in combination with *Bush*, cannot be sustained and should be withdrawn.

B. None of *Bush*, *Akashi*, *Freeny* or Their Combination Shows, Suggests or Teaches Each and Every Limitation of Claims 1 Through 6, 44 or 45

As described above, amended Claims 1 and 4 recite the limitation, storing the digital audio or digital video signal in a non-volatile storage portion of the second memory, wherein the

non-volatile storage is not a tape or CD. Patentee respectfully submits that none of *Bush*, *Akashi* or *Freeny,* either alone or in combination, shows, suggests or teaches this feature. In fact, it is apparent that all of these references teach away from this feature. Further, new Claims 44 and 47 state that the second memory includes a second party hard disk and that the digital audio or digital video signals are stored in the second party hard disk. It similarly is clear that none of *Bush*, *Akashi* or *Freeny,* either alone or in combination, shows, suggests or teaches this feature, and that all of the references teach away from it.

In particular, *Bush* discloses a system whereby a user can receive selected pre-recorded entertainment over cable lines. *Bush*, col. 1, lns. 46-48. The pre-recorded entertainment includes audio and video selections that are stored at a control source in CD format. *Bush*, col. 2, lns. 30-34. According to the disclosure of *Bush*, the audio or video selection received by the user must be recorded on a cassette tape. *Bush*, col. 4, lns. 7-58. *Bush* also discloses that a CD may be used to record the audio or video entertainment. *Bush*, col. 5, lns. 24-29.

Akashi discloses a system whereby a user can select and download audio signals and record them to a tape or CD. *Akashi*, translation page 2, (6) Embodiment. Specifically, *Akashi* states, "[t]he record reproducing apparatus 1 may either be a digital audio tape recorder or a compact disk deck that employs a write-once, read-many recordable optical disk that allows data to be read immediately after the data is written." Id.

Freeny discloses a kiosk system wherein audio and/or video signals are stored on a storage medium at a point of sale location. See *Freeny*, Abstract. The main teaching of Freeny is the reproduction of information, for example audio or video, in the form of a tangible object, such as a cassette tape or video disk. Freeny, col. 4, lns. 36-55.

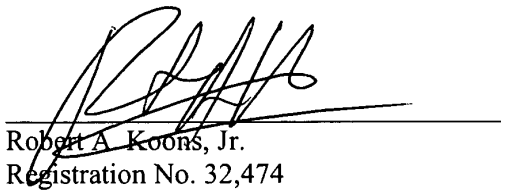
It is clear all of the foregoing references expressly require that audio or video signals be transferred from a first memory to a second memory that is a CD or tape. Thus, all of the references recognized the same problem in the prior art -- the inherent disadvantages in centrally producing CD's, tapes, and other fixed media at a remote manufacturing location and then distributing those objects for sale to ultimate consumers via traditional "brick and mortar" wholesale and retail distribution channels. However, all of these references failed to recognize, and therefore stopped short of, the ultimate and superior solution to the prior art problems provided by the invention of the '573 Patent -- the elimination of the need to produce CD's, tapes, or other fixed media objects at the second party's location. Thus, where the cited references still required the production of CD's and tapes at the second party's location, with all of the attendant localized problems of production, physical storage, and risk of damage, the invention of the '573 Patent solved these problems by providing storage in a non-volatile storage permitting repetitive playback of audio and video without requiring the second party to make, handle, physically store, or otherwise deal with CD's or tapes.

As a result, Patentee respectfully submits that none of the above references, either alone or in combination, shows, suggests, or teaches transferring audio or video signals from a first memory to a second memory wherein the signals are stored in a non-volatile storage portion of the second memory that is not a tape or CD and/or which is a hard disk. To the contrary, all of the references expressly teach away from this invention by requiring that the digital audio or digital video signals be transferred to a CD or tape in the second memory, while failing to recognize or deal with the problems and disadvantages associated with CD's and tapes. It therefore follows that none of these references, either alone or in combination, teaches storing digital audio or video signals in a portion of a memory that is a non-volatile storage and is not a

CD or tape, or which is a hard disk. Patentee therefore respectfully submits that none of the above references, or their combination, shows, suggests or teaches each and every limitation of Claims 1, 4, 44 or 47. As a result, none of Claims 1, 4, 44 and 47, or their dependent claims, can be anticipated by or obvious over *Bush*, *Akashi*, *Freeny,* or their combination.

Respectfully submitted,

DRINKER BIDDLE & REATH LLP



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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing Statement Under 37 C.F.R. §1.560(b) in Reexamination No. 90/007,402 was served via First Class United States Mail, postage prepaid, this 1ST day of December, 2006, on the following:

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By: _____
Robert A. Koons, Jr.
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CERTIFICATE OF MAILING BY "EXPRESS MAIL" (37 CFR 1.10) Applicant(s): **Arthur R. Hair**			Docket No. **219099 (NAPS001)**	
Application No. **90/007,402**	Filing Date **01/31/2005**	Examiner **Roland G. Foster**	Customer No. **23973**	Group Art Unit

Invention: **Method for Transmitting a Desired Digital Video or Digital Audio Signals** 3992 70181 U.S. PTO

I hereby certify that the following correspondence:

Statement Under 37 C.F.R. 1.560(b) w/chart attachments, Post Card.

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P06A/REV03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	
ARTHUR R. HAIR	)	
	)	
Reexamination Control No. 90/007,402	)	
	)	
Reexamination Filed: January 31, 2005	)	METHOD FOR TRANSMITTING
	)	A DESIRED DIGITAL VIDEO OR
Patent Number: 5,191,573	)	AUDIO SIGNAL
	)	
Examiner: Roland G. Foster	)	

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Sir:

STATEMENT UNDER 37 C.F.R. §1.560(b)

At the Interview with Examiners Foster, Weaver, Laballe, and Supervisory Examiner Kashnikow on November 16, 2006 in Reexamination Control Nos. 90/007,402; 90/007,403; and 90/007,407, Patentee's counsel presented the following reasons as warranting favorable action in the pending Reexamination applications:

1. The rejections of the pending claims in all three Reexaminations under Section 112 are improper and should be withdrawn because, as a matter of law, the Office is without jurisdiction to consider whether originally issued claims meet the requirements of Section 112, first paragraph.

2. The rejections of the pending claims in all three Reexaminations under Section 112 also should be withdrawn because where, as here, the original examiner considered whether

the originally issued claims in the patents in Reexamination met the requirements of Section 112, first paragraph, the Office is without jurisdiction in these three Reexaminations to consider again those same issues for those same claims under Section 112, first paragraph. Patentee's counsel presented a chart showing the manner in which the original examiner considered and passed on the issue of the originally issued claims meeting the requirements of Section 112, first paragraph. That chart is attached hereto.

3. Although the Office is without jurisdiction to consider the issue of whether the originally issued claims in all three Reexaminations meet the requirements of Section 112, first paragraph, it is clear that, in fact, those claims do meet the requirements of Section 112, first paragraph, because they find written support and are enabled by the original specification as it was filed on June 13, 1988. Patentee's counsel presented charts for all three patents in Reexamination, showing where support for all of the limitations in the originally issued claims find support in the original specification as filed on June 13, 1988. Those charts also are attached hereto.

4. Since all of the claims in the three Reexaminations properly are supported under Section 112 by the original specification as filed on June 13, 1988, those claims are entitled to June 13, 1988 as their priority date.

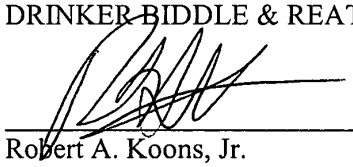
5. Since all of the claims in the three Reexaminations are entitled to a June 13, 1988 priority date, certain of the references cited by the Office in the pending Office Actions, i.e., United States Patent No. 5,241,421 to *Goldwasser*; United States Patent No. 5,132,992 to *Yurt*, and United States Patent No. 4,999,187 to *Cohen*, are inapplicable and not available

as prior art to the pending claims, because all three references postdate the June 13, 1988 priority date of those claims.

6. All of the other references cited by the Office in the pending Office Actions which antedate the June 13, 1988 priority date of the claims require that audio or digital signals be downloaded from a first memory to a second memory that requires a CD or tape. Patentees have amended the pending claims to make it clear those claims do not require the second memory be a CD or a tape and, as a result, those claims are not obvious over any of the pre-June 13, 1988 references, either alone or in combination.

Respectfully submitted,

DRINKER BIDDLE & REATH LLP



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December 1, 2006

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	Parent Application 07/206,497 filed June 13, 1988		Child Application 07/586,391 filed September 18, 1990		Office Action in Application 07/586,391 and response		Issuance of '573 Patent
Feature	Date First Appearing in Claims of Parent Application	Date First Appearing in Specification of Parent Application	Date First Appearing in Claims of Child Application	Date First Appearing in Specification of Child Application	Consideration by Examiner Nguyen	Response by Applicant	Subsequent Action by Examiner Nguyen
Transferring Money from Second Party to a First Party (Charging a Fee)	December 22, 1988 February 28, 1990			September 18, 1990	Considered in Office Action February 24, 1992	Objection specifically responded to in June 25, 1992 response	Claims allowed in September 21, 1992 Office Action
Providing a Credit Card Number	December 22, 1988			September 18, 1990	Considered in Office Action February 24, 1992	Objection specifically responded to in June 25, 1992 response	Claims allowed in September 21, 1992 Office Action
Controlling Use of First/Second Memory	December 22, 1988			September 18, 1990	Considered in Office Action February 24, 1992	Objections responded to in June 25, 1992 response	Claims allowed in September 21, 1992 Office Action
Transmitting to a Location Determined by Second Party	February 28, 1990			September 18, 1990	Considered in Office Action February 24, 1992	Objection responded to June 25, 1992	Claims allowed in September 21, 1992 Office Action
Specific Video Download Procedures	February 28, 1990			September 18, 1990	No new matter issues were ever raised	No response was ever necessary since no issue was ever raised	Claims allowed in September 21, 1992 Office Action
First Party in Possession of Transmitter	August 24, 1990 (not entered)			September 18, 1990	Considered in Office Action February 24, 1992	Objections responded to in June 25, 1992 response	Claims allowed in September 21, 1992 Office Action

Second Party in Possession of Receiver and Second Memory	August 24, 1990 (not entered)			September 18, 1990	Considered in Office Action February 24, 1992	Objection specifically responded to in June 25, 1992 response	Claims allowed in September 21, 1992 Office Action

Claim Features of '573 Patent

Feature	Claims Reciting Feature	Written Description of Feature in Original Specification	Comments
A method for transmitting a desired digital audio signal	1	p. 1, lns. 7-9 p. 2, lns. 8-10, 20-26	*ipsis verbis*
stored on a first memory of a first party to a second memory of a second party	1, 4	p. 3, lns. 35-40 p. 4, lns. 12-26	The specification states *ipsis verbis* that the hard disk in the control unit of the authorized agent is the source of the digital signal. Further, the specification states that the digital signal is transferred to the hard disk in the control unit of the user. A skilled artisan would understand this as transferring signals stored on a first memory to a second memory.
transferring money via a telecommunications line to a first party location remote from the second memory	1, 4	p. 1, lns. 13-15 p. 2, lns. 8-10, 20-23, 47-50 p. 3, lns. 20-33 Fig. 1	The specification discloses electronic sales via telephone lines. Because the agent is authorized to sell and to transfer via telephone lines, there is implicitly support for selling and thereby transferring money. This was previously pointed out in the declaration of Arthur Hair submitted May 5, 1992. A skilled artisan would readily understand this to comprehend transfers between two remote locations.

second party financially distinct from the first party	1, 4	p. 1, lns. 13-15 p. 2, lns. 8-10, 20-23, 47-50 p. 3, lns. 20-33	A skilled artisan would readily recognize that a sale requires the parties to be financially distinct. This was previously pointed out in the declaration of Arthur Hair submitted May 5, 1992.
second party controlling use and in possession of the second memory	1, 3	p. 3, lns. 26-33, 40-43	The as filed original specification includes *ipsis verbis* support for a second party control unit, where the user is the second party. A skilled artisan would readily recognize that the second memory is in possession and control of the second party, since the specification as originally filed states throughout that the user can store, sort and play thousands of songs from the user unit. A skilled artisan would clearly understand that this means the second party controls and possesses the second party control unit. This was previously pointed out in the declaration of Arthur Hair submitted May 5, 1992.
connecting electronically via a telecommunications line the first memory with the second memory	1, 4	p. 3, lns. 35-40	*ipsis verbis*

transmitting the desired digital audio signal from the first memory with a transmitter in control and possession of the first party	1	p. 2, ln. 47-52 p. 3, lns. 35-40 Fig. 1	The as filed original specification has *ipsis verbis* support transmitting a desired digital audio signal and that the hard disk in the control unit of the authorized agent is the source. A skilled artisan would recognize that in order to regulate distribution of the signals the authorized agent would have to possess and control the transmitter. This was previously pointed out in the declaration of Arthur Hair submitted May 5, 1992.
to a receiver having the second memory at a location determined by the second party; said receiver in possession and control of the second party	1, 4	p. 2, lns. 47-50 p. 3, lns. 20-40 Fig. 1 p. 4, lns. 21-23	A skilled artisan would readily recognize in order to receive digital signals over telecommunications lines as disclosed throughout the specification, part of the second party control unit would act as a receiver. This was addressed previously in the affidavit of Arthur Hair dated May 5, 1992. A skilled artisan would also readily understand this to comprehend transfers between two remote locations. Since the second party possesses the second memory the second party can determine its location. This was addressed previously in the declaration of Arthur Hair submitted May 5, 1992.

storing the digital audio signal in the second memory	1	p. 2, lns. 23-27	*ipsis verbis*
searching the first memory for the desired digital audio signal	2	p. 3, lns. 35-40 p. 4, lns. 12-28	The as filed original specification has *ipsis verbis* support for electronic sales and electronic transfer of digital signals from a control unit of an authorized agent to a control unit of a user. A skilled artisan would readily recognize that this would include searching the hard disk of the first party to locate desired digital signals for purchase.
selecting the desired digital audio signal from the first memory	2	p. 3, lns. 35-40 p. 4, lns. 12-28	The as filed original specification has *ipsis verbis* support for electronic sales and electronic transfer of digital signals from a control unit of an authorized agent to a control unit of a user. A skilled artisan would readily recognize that this would include selecting desired digital signals from the hard disk of the first party for purchase.

telephoning the first party controlling use of the first memory by the second party	3, 6	p. 2, lns. 47-50 p. 3, lns. 20-40 Fig. 1 p. 4, lns. 21-23	The original as filed specification states throughout that digital audio or digital video signals are sold and transferred via telephone lines. A skilled artisan would readily recognize this as comprehending the telephoning of the first party by the second party to initiate a transaction. This was addressed previously in the declaration of Arthur Hair submitted May 5, 1992.
providing a credit card number of the second party to the first party so that the second party is charged money	3, 6	p. 1, lns. 13-15 p. 2, lns. 8-10, 20-23, 38-52 p. 3, lns. 12-15, 35-37	The original as filed specification states throughout that the invention provides for electronic sales of digital audio or digital video signals. A skilled artisan would readily recognize credit card sales as being comprehended within electronic sales. This was addressed previously in the affidavit of Arthur Hair dated May 5, 1992.

first party controlling the first memory	3, 6	p. 2, lns. 38-43 p. 3, lns. 35-49	The as filed original specification includes *ipsis verbis* support for a first party control unit, where the authorized agent is the first party. A skilled artisan would readily recognize that the first party control unit is in possession and control of the first party because as an "agent authorized to electronically sell and distribute" digital audio or digital video, the first party would necessarily have to possess and control the source of the digital audio and digital video. This was previously pointed out in the declaration of Arthur Hair submitted May 5, 1992.
A method for transmitting a desired digital video signal	4	p. 5, lns. 36-43	*ipsis verbis*

transmitting the desired digital video signal from the first memory with a transmitter in control and possession of the first party	4	p. 5, lns. 36-43 p. 2, ln. 47-52 p. 3, lns. 35-40 Fig. 1	The as filed original specification has *ipsis verbis* support transmitting a desired digital audio signal and that the hard disk in the control unit of the authorized agent is the source. A skilled artisan would recognize that in order to regulate distribution of the signals the authorized agent would have to possess and control the transmitter. This was previously pointed out in the declaration of Arthur Hair submitted May 5, 1992. A skilled artisan would recognize based on the disclosure at the end of the specification that this procedure could also be used for digital video.
storing the digital video signal in the second memory	4	p. 5, lns. 36-43 p. 2, lns. 23-27	The as filed original specification has *ipsis verbis* support for storing digital signals on the hard disk of the user control unit. A skilled artisan would recognize based on the disclosure at the end of the specification that this procedure could also be used for digital video.

searching the first memory for the desired digital video signal	5	p. 3, lns. 35-40 p. 4, lns. 12-28 p. 5, lns. 36-43	The as filed original specification has *ipsis verbis* support for electronic sales and electronic transfer of digital signals from a control unit of an authorized agent to a control unit of a user. A skilled artisan would readily recognize that this would include searching the hard disk of the first party to locate desired digital signals for purchase. A skilled artisan would recognize based on the disclosure at the end of the specification that this procedure could also be used for digital video.
selecting the desired digital video signal from the first memory	5	p. 3, lns. 35-40 p. 4, lns. 12-28 p. 5, lns. 36-43	The as filed original specification has *ipsis verbis* support for electronic sales and electronic transfer of digital signals from a control unit of an authorized agent to a control unit of a user. A skilled artisan would readily recognize that this would include selecting desired digital signals from the hard disk of the first party for purchase. A skilled artisan would recognize based on the disclosure at the end of the specification that this procedure could also be used for digital video.

Claim Features of '734 Patent

Feature	Claims Reciting Feature	Written Description of Feature in Original Specification	Comments
A method/system for transferring desired digital video or digital audio signals	1-34	p. 1, lns. 7-9 p. 2, lns. 8-10, 20-26 (video) p. 5, lns. 36-43	*ipsis verbis*
forming a connection through telecommunications lines between a first memory of a first party and a second memory of a second party	1	p. 3, lns. 35-40	*ipsis verbis*
first party location and second party location remote from the first party location, the second party location determined by the second party	1, 4, 11, 16, 19, 26	p. 2, lns. 47-50 p. 3, lns. 20-40 Fig. 1 p. 4, lns. 21-23	The original as filed specification states throughout that digital audio or digital video signals are sold and transferred via telephone lines. A skilled artisan would readily understand this to comprehend transfers between two remote locations. Since the digital audio or digital video signals are transferred to the user's (second party's) control unit, a skilled artisan would readily understand that the second party can determine the second location.
the first party memory having a first party hard disk having a plurality of digital video or digital audio signals, including coded digital video or digital audio signals	1, 4, 16	p. 3, lns. 35-37	*ipsis verbis*

the first memory having a sales random access memory chip	1	p. 3, lns. 19-24 Fig. 1	*ipsis verbis*
telephoning the first party controlling the first memory by the second party **Possibly Amend to: "establishing telephone communications between the first memory and the second memory"**	1	p. 2, lns. 47-50 p. 3, lns. 20-40 Fig. 1 p. 4, lns. 21-23	The original as filed specification states throughout that digital audio or digital video signals are sold and transferred via telephone lines. A skilled artisan would readily recognize this as comprehending the telephoning of the first party by the second party to initiate a transaction. This was addressed previously in the declaration of Arthur Hair submitted May 5, 1992.
providing a credit card number of the second party to the first party so that the second party is charged money	1	p. 1, lns. 13-15 p. 2, lns. 8-10, 20-23, 38-52 p. 3, lns. 12-15, 35-37	The original as filed specification states throughout that the invention provides for electronic sales of digital audio or digital video signals. A skilled artisan would readily recognize credit card sales as being comprehended within electronic sales. This was addressed previously in the affidavit of Arthur Hair dated May 5, 1992.
electronically coding the digital video or digital audio signals to form coded digital audio signals into a configuration that would prevent unauthorized reproduction	1	p. 2, lns. 17-19 p. 4, lns. 15-20	*ipsis verbis*

storing a replica of the coded desired digital video or digital audio signals from the hard disk to the sales random access memory chip	1	p. 4, lns. 15-23	*ipsis verbis*
transferring the stored replica of the coded desired digital video or digital audio signal from the sales random access memory chip of the first party to the second memory of the second party through telecommunications lines while the second memory is in possession and control of the second party	1, 4	p. 4, lns. 15-23 p. 4, ln. 35 to p. 5, ln. 21	The original as filed specification includes *ipsis verbis* support for storing a replica of the coded desired digital audio or digital video signal to the first party sales random access memory, then transferring it to the memory of the second party. A skilled artisan would readily recognize that the second memory is in possession and control of the second party, since the specification as originally filed states throughout that the user can store, sort and play thousands of songs from the user unit. A skilled artisan would clearly understand that this means the second party controls and possesses the second memory. This was previously addressed in the declaration of Arthur Hair filed May 5, 1992.
storing the transferred digital video or digital audio signals in the second memory	1	p. 2, lns. 23-27	*ipsis verbis*

a second party integrated circuit which controls and executes commands of the second party connected to a second party control panel	2	p. 3, lns. 26-28 p. 4, lns. 15-20 Fig. 1	*ipsis verbis*
commanding the second party integrated circuit with the second party control panel to initiate the purchase of the desired digital video or digital audio signals from the first party hard disk	2	p. 4, lns. 12-20	**(CANCEL)**
the second memory includes a second party hard disk and an incoming random access memory chip	3, 5, 8, 13, 16, 21, 30	p. 3, lns. 26-31 Fig. 1	*ipsis verbis*
the second memory includes a playback random access memory chip	3, 5, 16, 21, 30	p. 3, lns. 26-30 p. 4, lns. 39-50 Fig. 1	*ipsis verbis*
playing the desired digital video or digital audio signal from the second party hard disk	3	p. 2, lns. 26-32	*ipsis verbis*

a first party control unit (in possession and control of the first party)	4, 11, 16, 19, 26, 28	p. 2, lns. 38-43 p. 3, lns. 35-49	The as filed original specification includes *ipsis verbis* support for a first party control unit, where the authorized agent is the first party. A skilled artisan would readily recognize that the first party control unit is in possession and control of the first party because as an "agent authorized to electronically sell and distribute" digital audio or digital video, the first party would necessarily have to possess and control the source of the digital audio and digital video.

a second party control unit (in possession and control of the second party)	4, 11, 16, 19, 26, 28	p. 2, lns. 38-43 p. 3, lns. 35-49	The as filed original specification includes *ipsis verbis* support for a second party control unit, where the user is the second party. A skilled artisan would readily recognize that the second memory is in possession and control of the second party, since the specification as originally filed states throughout that the user can store, sort and play thousands of songs from the user unit. A skilled artisan would clearly understand that this means the second party controls and possesses the second party control unit. This was previously addressed in the declaration of Arthur Hair filed May 5, 1992.

the first party control unit has a first party hard disk, a sales random access memory chip, and means or mechanism for electronically selling desired digital video or digital audio signals	4, 11, 19, 26, 28	p. 2, lns. 8-10 p. 3, lns. 20-40 Fig. 1	The as filed original specification has *ipsis verbis* support for a first party control unit with a hard disk, and sales random access memory chip. A skilled artisan would readily recognize that the first party control unit would include a means or mechanism for executing an electronic sale because the electronic sale is described in the original specification as separate from electronic transfer and electronic distribution.
the second party control unit has a second memory connected to the second party control panel	4, 19, 21, 26, 28	p. 3, lns. 26-31 Fig. 1	The as filed original specification has *ipsis verbis* support for a control panel connected to the second party control unit. A skilled artisan would readily understand that the second party hard disk corresponds to a second memory.
the second party control unit has means for playing desired digital video or digital audio signals connected to and controlled by the second party control panel	4, 28	p. 3, lns. 26-33 Fig. 1	*ipsis verbis*
selling digital video or digital audio signals through telecommunications lines	4	p. 2, lns. 8-10, lns. 47-50	*ipsis verbis*

the first party control unit includes a first party control integrated circuit connected to the first party hard disk, the sales random access memory and the second party control panel through telecommunications lines	4, 6, 11, 16, 19, 22, 26, 28, 31,	p. 3, lns. 20-33 Fig. 1	*ipsis verbis*
the first party control unit includes a first party control panel connected to and through which the first party control integrated circuit is programmed	6, 11, 16, 22, 31	p. 3, lns. 20-24 p. 4, lns. 12-14 Fig. 1	*ipsis verbis*
the second party control unit includes a second party control integrated circuit connected to the second party hard disk, the playback random access memory and the first party control integrated circuit	7, 11, 16, 23, 32	p. 3, lns. 20-33 p. 4, lns 15-20 Fig. 1	*ipsis verbis*
the second party control integrated circuit and the first party control integrated circuit regulate the transfer of desired digital video or digital audio signals	7, 22, 23, 31, 32	p. 4, lns. 15-20	*ipsis verbis*
the second party control unit includes a second party control panel connected to and through which the second party control integrated circuit is programmed	7, 16, 19, 23, 26, 28, 32	p. 3, lns. 26-28 p. 4, lns. 12-14 Fig. 1	*ipsis verbis*

the playing means of the second party control unit includes a video display	9, 14, 18, 19, 25, 34	p. 3, lns. 26-33 p. 5, lns. 9-21 Fig. 1	*ipsis verbis*
the telecommunications lines include telephone lines	10, 11, 12, 15, 17, 20, 27, 29	p. 3, ln. 25 Fig. 1	*ipsis verbis*
means or mechanism for transferring money electronically via telecommunications lines from the second party to the first party	11, 16, 19	p. 1, lns. 10-12 p. 2, lns. 8-10, 20-26, 47-52 p. 3, lns. 20-25 p. 4, lns. 21-23	The as filed original specification has *ipsis verbis* support for electronic sales via telecommunications lines. A skilled artisan would readily recognize that electronic sales via telecommunications lines would include the transfer of money via telecommunications lines. This was addressed previously in the affidavit of Arthur Hair dated May 5, 1992.
means or mechanism for the first party to charge a fee to the second party and granting access to desired digital video or digital audio signals	16, 19, 26	p. 1, lns. 13-15 p. 2, lns. 8-10, 20-23, 47-50 p. 3, lns. 20-33 Fig. 1	The specification discloses electronic sales via telephone lines. Because the agent is authorized to sell and to transfer via telephone lines, there is implicitly support for selling and thereby charging a fee. This was previously pointed out in the declaration of Arthur Hair submitted December 30, 1993.

means or mechanism for connecting electronically via telecommunications lines the first memory with the second memory	11, 16,	p. 4, lns. 15-20 Fig. 1	A skilled artisan would readily recognize from the specification that the first memory would include a means for connecting to the second memory via the disclosed telephone lines.
the second party control unit includes an incoming random access memory	11, 16, 24, 33	p. 3, lns. 26-29 Fig. 1	*ipsis verbis*
means or mechanism for transmitting desired digital video or digital audio signals	11, 16, 26, 28	p. 1, lns. 10-12 p. 2, lns. 8-10, 20-26, 47-52 p. 3, lns. 20-25 p. 4, lns. 21-23	The as filed original specification has *ipsis verbis* support for electronic distribution via telecommunications lines. A skilled artisan would readily recognize that this requires transmission of those signals, where the telecommunications lines act as the transmitter. A skilled artisan would also readily recognize in order to receive digital audio or digital video signals over telecommunications lines, part of the second party control unit would act as a receiver. This was addressed previously in the affidavit of Arthur Hair dated May 5, 1992.

a transmitter connected to the first memory and the telecommunications lines, the first party in possession and control of the transmitter	11, 16	p. 1, lns. 10-12 p. 2, lns. 8-10, 20-26, 47-52 p. 3, lns. 20-25 p. 4, lns. 21-23	The as filed original specification has *ipsis verbis* support for electronic distribution via telecommunications lines. A skilled artisan would readily recognize that this requires transmission of those signals, where the telecommunications lines act as the transmitter.

a receiver connected to the second memory and the telecommunications lines, the second party in possession and control of the receiver	11, 16, 19, 26	p. 2, lns. 47-49 p. 3, lns. 35-38 p. 4, lns. 24-26	A skilled artisan would readily recognize in order to receive digital audio or digital video signals over telecommunications lines as disclosed throughout the specification, part of the second party control unit would act as a receiver. This was addressed previously in the affidavit of Arthur Hair dated May 5, 1992. A skilled artisan would readily recognize that the receiver is in possession and control of the second party, since the specification as originally filed states throughout that the user can store, sort and play thousands of songs from the user unit. A skilled artisan would clearly understand that this means the second party controls and possesses the second party control unit. This was previously pointed out in the declaration of Arthur Hair submitted December 30, 1993.

the transmitter remote from the receiver, the receiver at a location determined by the second party in electrical communication with the connecting means or mechanism	11	p. 2, lns. 47-50 p. 3, lns. 20-40 Fig. 1 p. 4, lns. 21-23	The original as filed specification states throughout that digital audio or digital video signals are sold and transferred via telephone lines. A skilled artisan would readily understand this to comprehend transfers between two remote locations. A skilled artisan would further recognize that in order for transmission of the digital audio or video signals to occur the transmitter and receiver have to be in electrical communication with the connecting means.
means or mechanism for storing desired digital video or digital audio signals with the receiver	11, 16	p. 3, lns. 26-31 p. 4, lns. 15-20 Fig. 1	The second party control unit includes a second party control integrated circuit which regulates the transfer of the digital audio and digital video signals. A skilled artisan would readily recognize that the second party integrated circuit regulates storage of the digital audio or digital video signals.

speakers in possession and control of the second party	14, 18, 26	p. 3, ln. 33, 47-49	The as filed original specification has *ipsis verbis* support for speakers. A skilled artisan would readily recognize that the speakers would be in possession and control of the second party since the specification throughout states that the second party may repeatedly listen to stored songs through the speakers.
the second party choosing desired digital audio signals from the first party's hard disk	26	p. 2, lns. 8-16, 20-27, 38-52 p. 35-49	Throughout the specification discloses electronic sales of digital video or digital audio signals. A skilled artisan would readily recognize that this includes the selection of individual desired signals by the purchaser.

Claim Features of '440 Patent

Feature	Claims Reciting Feature	Written Description of Feature in Original Specification	Comments
A method/system for transferring desired digital video or digital audio signals	1-63	p. 1, lns. 13-15 p. 2, lns. 8-10, 20-26 (video) p. 5, lns. 36-43	*ipsis verbis*
forming a connection through telecommunications lines between a first memory of a first party and a second memory of a second party control unit of a second party	1-22, 25-28, 36-46, 58-63	p. 3, lns. 35-40	*ipsis verbis*
first memory having desired digital video or digital audio signals	1-21, 25-28, 42-57, 62, 63	p. 3, lns. 35-37	*ipsis verbis*
selling electronically by the first party to the second party through telecommunications lines	1-22, 25-28, 40, 42-45	p. 2, lns. 47-52 p. 3, lns. 35-40	*ipsis verbis*
transferring the desired digital video or digital audio signals from the first memory of the first party to the second memory of the second party control unit of the second party through telecommunications lines	1-21, 25-28, 36-40, 42-46, 62-63	p. 2, ln. 47-52 p. 3, lns. 35-40 Fig. 1	*ipsis verbis*

the second party control unit with the second memory is in possession and control of the second party	1-41, 46-52, 62	p. 3, lns. 26-33, 40-43	The as filed original specification includes *ipsis verbis* support for a second party control unit, where the user is the second party. A skilled artisan would readily recognize that the second memory is in possession and control of the second party, since the specification as originally filed states throughout that the user can store, sort and play thousands of songs from the user unit. A skilled artisan would clearly understand that this means the second party controls and possesses the second party control unit. This was previously pointed out in the declaration of Arthur Hair submitted May 5, 1992.
playing through speakers of the second party control unit the digital video or digital audio signals in the second memory	1-10, 11, 22, 36-46, 63	p. 2, lns. 26-32	*ipsis verbis*
speakers of the second party control unit connected with the second memory of the second party control unit	1-10, 28, 35, 62	p. 3, lns. 25-32 p. 4, lns. 47-50 Fig. 1	*ipsis verbis*

first control unit in possession and control of first party	24, 31-35	p. 2, lns. 38-43 p. 3, lns. 35-49	The as filed original specification includes *ipsis verbis* support for a first party control unit, where the authorized agent is the first party. A skilled artisan would readily recognize that the first party control unit is in possession and control of the first party because as an "agent authorized to electronically sell and distribute" digital audio or digital video, the first party would necessarily have to possess and control the source of the digital audio and digital video. This was previously pointed out in the declaration of Arthur Hair submitted May 5, 1992.
second party location remote from the first party location, determined by the second party	2-63	p. 2, lns. 47-50 p. 3, lns. 20-40 Fig. 1 p. 4, lns. 21-23	The original as filed specification states throughout that digital audio or digital video signals are sold and transferred via telephone lines. A skilled artisan would readily understand this to comprehend transfers between two remote locations. Since the second party possesses the second memory the second party can determine its location. This was previously pointed out in the declaration of Arthur Hair submitted May 5, 1992.

charging a fee via telecommunications lines by the first party to the second party	2-10, 19-21, 36-40, 43-45, 47-63	p. 1, lns. 13-15 p. 2, lns. 8-10, 20-23, 47-50 p. 3, lns. 20-33 Fig. 1	The specification discloses electronic sales via telephone lines. Because the agent is authorized to sell and to transfer via telephone lines, there is implicitly support for selling and thereby charging a fee. This was previously pointed out in the declaration of Arthur Hair submitted December 30, 1993.
second party has an account, charging the account of the second party **Possibly Amend to: "Charging the second party"**	3-10, 20-21, 38-40, 44-45, 56-57, 60-61	p. 1, lns. 13-15 p. 2, lns. 8-10, 20-23, 47-50 p. 3, lns. 20-33 Fig. 1	The specification discloses electronic sales via telephone lines. A skilled artisan would readily recognize that charging a fee via telecommunications lines would include the second party having an account that can be charged. This was previously pointed out in the declaration of Arthur Hair submitted December 30, 1993.
telephoning the first party controlling use of the first memory by the second party **Possibly Amend to: "establishing telephone communications between the first memory and the second memory"**	4-10, 39-40, 45, 57, 61	p. 2, lns. 47-50 p. 3, lns. 20-40 Fig. 1 p. 4, lns. 21-23	The original as filed specification states throughout that digital audio or digital video signals are sold and transferred via telephone lines. A skilled artisan would readily recognize this as comprehending the telephoning of the first party by the second party to initiate a transaction. This was addressed previously in the declaration of Arthur Hair submitted May 5, 1992.

providing a credit card number of the second party controlling the second memory to the first party controlling the first memory so the second party is charged money	4-10, 21, 39-40, 45, 61	p. 1, lns. 13-15 p. 2, lns. 8-10, 20-23, 38-52 p. 3, lns. 12-15, 35-37	The original as filed specification states throughout that the invention provides for electronic sales of digital audio or digital video signals. A skilled artisan would readily recognize credit card sales as being comprehended within electronic sales. This was addressed previously in the affidavit of Arthur Hair dated May 5, 1992.
storing the desired digital video or digital audio signals in the second memory	5-10, 22, 36-41	p. 2, lns. 23-27	*ipsis verbis*
electronically coding the desired digital video or digital audio signals into a configuration which would prevent unauthorized reproduction of the desired digital audio signals	6-8	p. 2, lns. 17-19 p. 4, lns. 15-20	*ipsis verbis*
first memory includes first party hard disk	7-8, 13, 14, 27-28, 34-35, 49-54	p. 4, lns. 5-6 p. 3, ln. 19 Fig. 1	*ipsis verbis*
second party can view desired digital video signals	58-61	p. 5, lns. 36-43 p. 3, lns. 26-33	The as filed original specification has *ipsis verbis* support for a video display. Since the specification explicitly says that the invention is applicable to video, a skilled artisan would recognize that a user could view the desired video signals on the video display.

second party can listen to the desired digital audio signals	63	p. 4, lns. 27-28, 36-50	*ipsis verbis*
first memory includes a sales random access memory chip	7-8, 13-18, 25-28, 49-54	p. 3, lns. 19-24 Fig. 1	*ipsis verbis*
second party control unit includes second memory	48-54	p. 3, lns. 26-30 Fig. 1	The as filed original specification has *ipsis verbis* support for a second party control unit. A skilled artisan would readily understand that the second party hard disk corresponds to a second memory.
second party control unit has a second party control panel	8, 12-21, 25-28, 32-35, 47-57	p. 3, lns. 26-27 Fig. 1	*ipsis verbis*
second party control panel connected to the second party integrated circuit	8, 16-18, 25-28, 32-35, 52-54	p. 3, lns. 26-28 Fig. 1	*ipsis verbis*
second memory of the second party control unit includes an incoming random access memory chip	9-10, 17-18, 25-28, 32-35, 53-54	p. 3, ln. 26-29 Fig. 1	*ipsis verbis*
second memory of the second party control unit includes a second party hard disk for storing the desired digital video or digital audio signals	9-10, 12-21, 25-28, 34-35, 50-54	p. 3, lns. 26-31 Fig. 1	*ipsis verbis*

second memory of the second party control unit includes a playback random access memory chip for temporarily storing the desired digital video or digital audio signals for sequential playback	9-10, 25-28 32-35, 50-54	p. 3, lns. 26-30 p. 4, lns. 39-50 Fig. 1	*ipsis verbis*
a first party control unit having a first memory	12-21, 25-28	p. 3, lns. 20-24 Fig. 1	*ipsis verbis*
second party control unit having means or a mechanism for playing the desired digital video or digital audio signals connected to the second memory and the second party control panel	12-35	p. 3, lns. 26-33 Fig. 1	The as filed original specification has *ipsis verbis* support for speakers and video display which are means for playing.
first party control integrated circuit connected to the first party hard disk, the first party sales random access memory, and the second party control integrated circuit through the telecommunications lines	15-18, 25-28, 32-35, 51-54	p. 3, lns. 20-33 Fig. 1	*ipsis verbis*

second party control integrated circuit connected to the second party hard disk, the playback random access memory, and the first party control integrated circuit through the telecommunications lines	16-18, 25-28, 52-54	p. 3, lns. 20-33 Fig. 1	*ipsis verbis*
first party control integrated circuit and second party control integrated circuit regulate the transfer of the desired digital video or digital audio signals	13-18, 25-28	p. 4, lns. 15-20	*ipsis verbis*
first party control panel connected to the first party control integrated circuit	15-18, 25-28, 51-54	p. 3, lns. 20-24 Fig. 1	*ipsis verbis*
incoming random access memory chip connected to the second party hard drive and the second party control integrated circuit, and the first party control unit through the telecommunications lines	17-18, 25-28, 53-54	p. 3, lns. 20-33 Fig. 1	*ipsis verbis*
second party control unit includes a video display unit and/or speakers	18, 25-28, 35, 47-61	p. 3, lns. 26-33 Fig. 1	*ipsis verbis*

second party control unit having a receiver, second memory connected to the receiver	22, 41, 47-56, 58-60	p. 2, lns. 47-49 p. 3, lns. 35-38 p. 4, lns. 24-26	A skilled artisan would readily recognize in order to receive digital audio or digital video signals over telecommunications lines as disclosed throughout the specification, part of the second party control unit would act as a receiver. This was addressed previously in the affidavit of Arthur Hair dated May 5, 1992.
second party financially distinct from the first party	22, 41	p. 2, lns. 8-16, 20-27, 38-52 p. 35-49	Throughout the specification discloses electronic sales of digital video or digital audio signals. A skilled artisan would readily recognize that the first and second parties would be financially distinct since this is required in order to have a sale. This issue was previously addressed in the affidavit of Arthur Hair filed on May 5, 1992.
first memory with a transmitter in control and possession of the first party	22-24, 29-35, 41, 58-61, 63	p. 1, lns. 10-12 p. 2, lns. 8-10, 20-26, 47-52 p. 3, lns. 20-25 p. 4, lns. 21-23	The as filed original specification has *ipsis verbis* support for electronic distribution via telecommunications lines. A skilled artisan would readily recognize that this requires transmission of those signals, where the telecommunications lines act as the transmitter.

receiver is in possession and control of the second party	22-24, 29-35, 41, 58-61, 63	p. 2, lns. 47-49 p. 3, lns. 35-38 p. 4, lns. 24-26	A skilled artisan would readily recognize in order to receive digital audio or digital video signals over telecommunications lines as disclosed throughout the specification, part of the second party control unit would act as a receiver. This was addressed previously in the affidavit of Arthur Hair dated May 5, 1992. A skilled artisan would readily recognize that the receiver is in possession and control of the second party, since the specification as originally filed states throughout that the user can store, sort and play thousands of songs from the user unit. A skilled artisan would clearly understand that this means the second party controls and possesses the second party control unit. This was previously pointed out in the declaration of Arthur Hair submitted December 30, 1993.
means or mechanism for transferring money electronically via telecommunications lines from the second party to the first party controlling use of the first memory	23-24, 30-35	p. 1, lns. 10-12 p. 2, lns. 8-10, 20-26, 47-52 p. 3, lns. 20-25 p. 4, lns. 21-23	The as filed original specification has *ipsis verbis* support for electronic sales via telecommunications lines. A skilled artisan would readily recognize that electronic sales via telecommunications lines would include the transfer of money via telecommunications lines. This was addressed previously in the affidavit of Arthur Hair dated May 5, 1992.

second party choosing desired digital video or digital audio from first memory with second party control panel	47-63	p. 2, lns. 8-16, 20-27, 38-52 p. 35-49	Throughout the specification discloses electronic sales of digital video or digital audio signals. A skilled artisan would readily recognize that this includes the selection of individual desired signals by the purchaser.
means or mechanism for connecting electronically via telecommunications lines the first memory with the second memory	23-24, 29-35	p. 4, lns. 15-20 Fig. 1	A skilled artisan would readily recognize from the specification that the first memory would include a means for connecting to the second memory via the disclosed telephone lines.
means or a mechanism for transmitting the desired digital video or digital audio signals from the first memory to a receiver having the second memory	23-24, 29-35	p. 1, lns. 10-12 p. 2, lns. 8-10, 20-26, 47-52 p. 3, lns. 20-25 p. 4, lns. 21-23	The as filed original specification has *ipsis verbis* support for electronic distribution via telecommunications lines. A skilled artisan would readily recognize that this requires transmission of those signals, where the telecommunications lines act as the transmitter. A skilled artisan would also readily recognize in order to receive digital audio or digital video signals over telecommunications lines, part of the second party control unit would act as a receiver. This was addressed previously in the affidavit of Arthur Hair dated May 5, 1992.

means or a mechanism for storing the digital video or digital audio signals in the second memory	23-24, 29-35	p. 3, lns. 26-31 p. 4, lns. 15-20 Fig. 1	The second party control unit includes a second party control integrated circuit which regulates the transfer of the digital audio and digital video signals. A skilled artisan would readily recognize that the second party integrated circuit regulates storage of the digital audio or digital video signals.
playing means or mechanism connected to the second memory	23-24, 29-35	p. 3, lns. 26-33 p. 4, lns. 39-50 Fig. 1	*ipsis verbis*
second memory connected to receiver and video display	48-54, 58-61	p. 3, lns. 26-33 p. 4, lns. 39-50 Fig. 1	The as filed original specification has *ipsis verbis* support for a video display connected to the second memory. A skilled artisan would also readily recognize in order to receive digital audio or digital video signals over telecommunications lines, part of the second party control unit would act as a receiver. This was addressed previously in the affidavit of Arthur Hair dated May 5, 1992.
telecommunications lines include telephone lines	26-28, 33-35	p. 3, ln. 25 Fig. 1	*ipsis verbis*
incurring a fee by second party to first party for use of telecommunication lines, the desired digital video or audio signal in first memory	46		**(CANCEL)**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
ART UNIT	PAPER NUMBER

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

PTO-90C (Rev. 10/03)

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EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM

REEXAMINATION CONTROL NO. *90/007,402*.

PATENT NO. *5191573*.

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)).

PTOL-465 (Rev.07-04)

Office Action in Ex Parte Reexamination	Control No. 90/007,402	Patent Under Reexamination 5191573	
	Examiner Roland G. Foster	Art Unit 3992	

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

a☒ Responsive to the communication(s) filed on *29 November 2006*. b☒ This action is made FINAL.
c☐ A statement under 37 CFR 1.530 has not been received from the patent owner.

A shortened statutory period for response to this action is set to expire 2 month(s) from the mailing date of this letter. Failure to respond within the period for response will result in termination of the proceeding and issuance of an *ex parte* reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).** If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Information Disclosure Statement, PTO/SB/08.
3. ☐ Interview Summary, PTO-474.
4. ☒ *07/206,497 (as originally filed)*.

Part II SUMMARY OF ACTION

1a. ☒ Claims *1-6 and 44-49* are subject to reexamination.
1b. ☐ Claims _____ are not subject to reexamination.
2. ☒ Claims *7-43* have been canceled in the present reexamination proceeding.
3. ☐ Claims _____ are patentable and/or confirmed.
4. ☒ Claims *1-6 and 44-49* are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ The drawings, filed on _____ are acceptable.
7. ☐ The proposed drawing correction, filed on _____ has been (7a)☐ approved (7b)☐ disapproved.
8. ☐ Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
   a)☐ All b)☐ Some* c)☐ None of the certified copies have
   1☐ been received.
   2☐ not been received.
   3☐ been filed in Application No. _____.
   4☐ been filed in reexamination Control No. _____.
   5☐ been received by the International Bureau in PCT application No. _____.
   * See the attached detailed Office action for a list of the certified copies not received.
9. ☐ Since the proceeding appears to be in condition for issuance of an *ex parte* reexamination certificate 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.
10. ☐ Other: _____

cc: Requester (if third party requester)

DETAILED ACTION

Summary

U.S. Patent No. 5,191,573 (the "'573" patent) is presently under reexamination in this proceeding. The '573 patent is generally directed to downloading audio and video content via a telecommunications line (e.g., see claims 1 and 4), where a district court has held that the term "telecommunications line" includes the Internet.[1] The amendment, filed on November 29, 2006 (the "Amendment"), has been duly considered but is not deemed persuasive to overcome the prior rejections of all claims in the '573 patent under reexamination. In addition, the Patent Owner has not shown that the effective filing date of the instant '573 patent under reexamination is earlier than September 18,1990. Therefore, the prior rejections are repeated below, except for any new grounds of rejections necessitated by the amendment to the claims. Accordingly, this Office action is made final. See MPEP § 706.07(a) and § 2271.III.

Benefit of Earlier Filing Date Regarding Original Claims

Definitions

As an initial matter, the instant '573 patent and the earlier filed application are related as follows. The '573 patent under reexamination issued from U.S. Application No. 07/586,391 (hereinafter the "Child" application), which was filed on September 18, 1990. The parent (earlier filed) application to the Child application is U.S. Application No. 07/206,497, as originally filed on June 13, 1988 (hereinafter the "Parent" application).

[1] Sightsound.com Inc. v. NSK, Inc. Cdnow, Inc., and Cdnow Online, Inc., Civil Action No. 98-118, pp. 50 and 57 (District Court for the Western District of Pennsylvania, Feb. 2002).

Basic Statement of the Issues Regarding Priority

The Child application is alleged to be related to the Parent application as a "continuation" application (i.e., the Child application did not, on filing, contain disclosure of any subject matter not present in the Parent application, and the claims of the Child application, on filing, were fully supported by the disclosure of the Child application, see MPEP § 201.06(c).III).[2] However, the specification of the Child application (at the time the Child application issued as the '573 patent under reexamination) and the specification of the Parent application, as originally filed (see attachment "A"), differ considerably, as discussed below, raising issues of priority under 35 U.S.C. 120.

Furthermore, the prosecution history of the Child application (issuing as the '573 patent under reexamination) does not show that the examiner had any reason to consider the propriety of the benefit (continuation) claim set forth in the Child application to the originally filed, Parent application, as, for example a reference dated later than the filing date of the Parent application that would antedate the actual filing date of the Child application. In addition, the prosecution history of the Child patent does not contain any substantive, written discussion between the Patent Owner and the examiner regarding such a claim to the benefit of filing date in the Parent applications, as originally filed.

[2] Note that all the applications above were filed under the old "file wrapper continuation" procedures under 37 CFR 1.62, see MPEP § 201.06(a).

For the reasons to be discussed below, the effective filing date of the '573 patent under reexamination, which issued from the Child application, is September 18,1990 (at the earliest), which is the actual filing date of the Child application.

Intervening Patents and Printed Publications Are Available as Prior Art In a Reexamination Proceeding According to 35 U.S.C. 120

A rejection may be made in an *ex-parte* reexamination proceeding based on an intervening patent when the patent claims under reexamination, under 35 U.S.C. 120, are entitled only to the filing date of the patent under reexamination. Specifically:

> Rejections may be made in reexamination proceedings based on intervening patents or printed publications where the patent claims under reexamination are entitled only to the filing date of the patent and are not supported by an earlier foreign or United States patent application whose filing date is claimed. For example, under 35 U.S.C. 120, the effective date of these claims would be the filing date of the application which resulted in the patent. Intervening patents or printed publications are available as prior art under *In re Ruscetta*, 255 F.2d 687, 118 USPQ 101 (CCPA 1958), and *In re van Langenhoven*, 458 F.2d 132, 173 USPQ 426 (CCPA 1972). See also MPEP § 201.11

MPEP § 2258.I.C, Scope of Reexamination (emphasis added).

As discussed above, 35 U.S.C. 120 applies to *ex-parte* reexamination procedure. To be entitled to benefit of an earlier filing date under 35 U.S.C. 120, the previously filed specification of the Parent application must support the invention claimed in the Child application. See 35 U.S.C. 120.

The Original Claims of the Child Patent Under Reexamination Are Not Entitled to Benefit of the Filing Date of the Parent Application, as Originally Filed, Under 35 U.S.C. 120 Because the Parent Application, as Originally Filed, Fails to Support Several Features Claimed in the Child Patent Under Reexamination

A review of the prosecution history reveals that a significant amount of new text (directed to various features) added in a series of amendments is not found in the Parent application as originally filed (attachment "A"). Consider the following Table I:

Table I. New Matter Chart

	Parent Appln. 07/206,497, filed 6/13/88 (Abandoned)		Child Appln. 07/586,391, filed 9/18/90 (5,191,573)	
Feature	Date First Appearing in **Claims** of Parent Appln.	Date First Appearing in **Spec.** of Parent Appln.	Date First Appearing in **Claims** of Child Appln.	Date First Appearing in **Spec.** of Child Appln.
Hard Disk/Control Unit of Seller/User Electronic sales and distribution of the music	Filing Date of the **Original** Application – 6/13/88	Filing Date of the **Original** Application – 6/13/88		Filing Date of the Child Application – 9/18/90
Broad Statement at end of spec. regarding Video Applicability, Note *		Filing Date of the **Original** Application – 6/13/88		Filing Date of the Child Application – 9/18/90
Transferring Money from Second Party to a First Party (Charging a Fee)	12/22/88 (2/28/90)		Filing Date of the Child Application – 9/18/90	12/11/91
Providing a Credit Card Number	12/22/88		Filing Date of the Child Application – 9/18/90	
Controlling Use of First/Second Memory	12/22/88		Filing Date of the Child Application – 9/18/90	12/11/91
Transmitting to a Location Determined by Second Party	2/28/90		Filing Date of the Child Application – 9/18/90	12/11/91
Specific Video Download Procedures	2/28/90		Filing Date of the Child Application – 9/18/90	12/11/91 Note **
First Party in Possession of Transmitter	8/24/90, but not entered		Filing Date of the Child Application – 9/18/90	12/11/91
Second Party in Possession of Receiver and Second Memory	8/24/90, but not entered		Filing Date of the Child Application – 9/18/90	12/11/91

Key: Clear row means original matter present in the original Parent application. Shaded row means new matter introduced by amendment into both the Parent and Child applications subsequent to the date of the original Parent application.

Note * - The original specification also describes using a "convenient visual display of the user's library of songs" (page 5), however this section appears to relate to displaying category/lyrical information to the user regarding downloaded audio content, and not directed to the actual download, processing, and display of video content.

Note ** - Even more detailed video download procedures are added to the specification of subsequent Child applications, see the 90/007,403 and 90/007,407 reexaminations.

Patent owner failed to provide adequate support for all the new text added by the series of amendments (as identified in Table I above) to the Parent and Child applications. Patent owner should specifically point out the support for any amendments made to the original disclosure. MPEP § 714.02, 2163.II.A.2(b), and 2163.06. Consider the following:

Table II. Amendment History Chart

I. Parent Application No. 07/206,497 (filed June 13, 1988)

a. Amendment of Dec. 22, 1988

New Matter in Claims

New Independent Claim 11 – "transferring money to a party controlling use of the first memory"

New Dependent Claim 13 - "providing a credit card number of the party controlling use of the first memory by the party controlling the second memory"

New Matter in Spec.

No new matter added to specification.

Support for New Matter

Applicant made a statement in the amendment that "support for these new claims is found in the figures." This statement however is very broad. Applicant does not specifically point out where in

the figures the added features are found and the examiner cannot find support for such features.

b. Amendment of Feb. 28, 1990

New Matter in Claims

New Dependent Claim 14 - "transmitting the digital signal from the first memory to the second memory at a location determined by the second party..."

New Independent Claim 15 –

* "transmitting a desired digital, a video or audio music signal...."

[detailed recitation of a method for transmitting follows]

* "charging a fee to the first party controlling use of the second memory"

New Dependent Claim 18 – "charging a fee to a party controlling the use and the location of the second memory."

New Matter in Spec.

Abstract briefly mentions storing video signals onto a hard disk.

Support for New Matter

Applicant made a statement in the amendment that "antecedent support for these claims is found in Figure 1." This statement is very broad. Applicant does not specifically point out where in the figures the added features are found and the examiner cannot find support for such features.

c. Proposed After-final Amendment of August 24, 1990 (Not Entered)

New Matter in Claims

Independent Claim 11 –

*"second party controlling use and in possession of the second memory"

* "with a transmitter in control and possession of the first party to a receiver having a second memory at a location determined by the second party, said receiver in possession and control of the second party"

Independent Claim 15 –

* "charging a fee by a first party controlling use of the first memory
* new limitations similar to claim 11 above

New Matter in Spec.

Title amended to state "Method for Transmitting a Desired Video or Audio Signal"

Support for New Matter

No support was provided.

II. Child Application No. 07/586,391 (filed September 18, 1990) (FWC) (Issued as 5,191,573)

A substantial amount of new matter to the Child application, with respect to the Parent application as originally filed. For example, see the preliminary amendment of September 18, 1990, the amendment of December 11, 1991, the amendment of June 25, 1992, and the amendment of October 5, 1992.

Thus, as discussed above, the Patent Owner failed to point out support in the original Parent application, as originally filed (attachment "A"), for all of the new text added by the series of amendments. Patent Owner should specifically point out the support for any amendments made to the original disclosure. MPEP § 714.02, 2163.II.A.2(b), and 2163.06.

Limitations Later Added by Amendment, but Missing from the Original Written Description, Must Be Required By or Necessarily Present in the Original Written Description, Otherwise Those Limitations Are New Matter To the Original Written Description

Furthermore, the new text added by the amendments identified above is in the nature of additional, narrowing limitations and elements undisclosed by the generic statements in the original disclosure of the Parent application. When an explicit limitation in a claim "is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires that limitation." Hyatt v. Boone, 146 F.3d 1348, 1353, 47 USPQ2d 1128, 1131 (Fed. Cir. 1998) (emphasis added) (Certiorari Denied). "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference.... Inherency, however, may not be established by probabilities or possibilities." In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted, emphasis added). As for speculation about undisclosed uses of the originally disclosed elements, it is not sufficient that the written description, when "combined with the knowledge in the art, would lead one to speculate as to modifications that the inventor might have envisioned, but failed to disclose." Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1571, 41 USPQ2d 1961, 1965-66 (Fed. Cir. 1997). See also MPEP § 2163.II.A.2(b) and § 2163.05.II.

New Matter Issues Other Than Video Download Features

In the instant case, it is clear that the explicit limitations added by amendment but missing from the original written description are not required by or necessarily present in the

original written description. The recited details as to how money is transferred from a second party to the first party, a fee is charged, or how a credit card number is provided are not disclosed or required by the original, generic statement "electronic sales and distribution of the music...." For example, during the originally disclosed electronic sale, money could instead be transferred from a third party buyer (e.g., advertiser, local network provider, local retail store, friend, etc.) and/or transferred to a third party seller (e.g., remote wholesale music provider, local network provider, local retail store, etc.). Furthermore, a money fee would not necessarily be charged upfront during a sale (e.g., a free preview or trial period, or a sale based on barter or credits). Thus, an electronic sale could be booked without the transfer of money. Finally, digital content would not necessarily be purchased using a credit card. For example, the person downloading the content could receive the bill in the mail.

Similarly, the ability to control and possess a transmitter, receiver, and memory and to determine the location to which data is transmitted is not disclosed or required by the original, generic statements such as "control unit of the user." For example, the originally disclosed control unit of the seller or user could instead mean that seller and/or buyer instead rent or lease the equipment as is commonplace in the computer network industry rather than possess the equipment. Neither is the seller or user required to exercise control over their equipment, for example, the downloading services could be provided by a third party offering a turn-key solution.

The Patent Owner submitted a Declaration on June 25, 1992 attempting to show many of the above features were nonetheless required. This Declaration however, and related attorney arguments, were in response to a new matter objection made to one in a series of amendments, specifically the amendment of December 11, 1991 (see the non-final rejection in the Child application, mailed on February 24, 1992), where by the way, both the examiner and Patent Owner only touched upon a subset of the new matter issues described in Table I above. A series of amendments to the specification and claims were filed previously and subsequently to this single amendment in the Parent and Child applications, where each amendment gradually added new matter. See Table II, *supra*. Therefore, it is not clear whether the examiner addressed this issue in regard to the specification as originally filed in the Child application from which the '573 patent issued, much less in regard to the specification as originally filed in the Parent application, which is at issue here.

Nonetheless, the Declaration is unpersuasive. Although factual evidence is preferable to opinion testimony in a 37 C.F.R. 1.132 Declaration, opinion testimony is entitled to consideration and some weight so long as the opinion is not on the ultimate legal conclusion at issue. While an opinion as to a legal conclusion is not entitled to any weight, the underlying basis for the opinion may be persuasive. MPEP § 71601(c).III. Here, the 1.132 Declaration relies upon the opinion of the inventor, often couched in conclusory language, to reach conclusions about what would have been required by the specification, as it existed at the time of the December 11, 1991 amendment. That is, the Declaration goes to the ultimate legal conclusion at issue, whether the specification at the time of the December 11, 1991 amendment

discloses those limitations newly introduced into the December 1991 amendment. Thus, the Declaration is not entitled to any weight, and furthermore the basis for the opinion is unpersuasive. For example, consider the following conclusory statement from page 2:

> One skilled in the art would know that an electronic sale inherently assumes a transferring of money by providing a credit or debit card number (since that is the only way for electronic sales to occur) coupled with a transferring of a service or product.

As discussed above, a money fee would not necessarily be charged upfront during a sale (e.g., a free preview or trial period, or a sale based on barter or credits). Thus, an electronic sale could be booked without the transfer of money. The purchaser instead could be easily identified by other types of information (e.g., account number, PIN, email address, mailing address, etc.). Furthermore, digital content would not necessarily be purchased using a credit card. The simplest example is that a person downloading the content could receive the bill in the mail.

New Matter Related to Video Download Features

Regarding the specific video download features added to the original specification and claims by the above amendments are not disclosed nor required by the one sentence, generic statement at the end of the original specification that "this invention is not to be limited to Digital Audio Music and can include Digital Video...."[3] Undisclosed digital video features (assuming enablement) could be implemented into the broadly termed "invention" in an almost unlimited number of specific, possible (but not required) ways, such as at various levels of integration with

[3] The original specification also describes using a "convenient visual display of the user's library of songs" (page 5), however this section appears to relate to displaying category/lyrical information to the user regarding downloaded audio content, and not directed to the actual download, processing, and display of video content.

the originally disclosed audio system and at various levels of detail. By introducing new text directed to specific video download features in the subsequent amendments, the Patent Owner simply chose one possible (but not required) way to integrate video features into the originally disclosed audio system.[4] Indeed, the Patent Owner continued to add specific, video download and transmission procedures not found in the original specification (i.e., chose other possible ways to integrate video features) during the prosecution of subsequent, allegedly "continuation" applications, see the 90/007,403 and 90/007,407 reexaminations.[5] Thus, the original, one sentence generic statement does not require all the many instances of undisclosed, specific details later added by the Patent Owner.

Furthermore, transmission and storage of digital video content significantly differs in technology from the transmission and storage of digital audio content, thus the originally disclosed audio transmission features fail to imply or require any video transmission features. For example, the decoding of digital video data is much more processor intensive than the decoding of digital audio data due to the increased information content and bandwidth of a typical video signal. In the mid 1980(s), at the time of the filing date of the original Parent specification, only compact audio disks players were routinely available.[6] Personal user devices with the processing power capable of playing back much larger and more complex digital video

[4] See the amendments of February 28, 1990, December 11, 1991, and June 25, 1992.
[5] Although adding text that replaces all appearances of "audio" with "video" would be one possible (but not required) way to integrate undisclosed video features into the originally disclosed audio system, this is not what the applicant has done here, probably because such a rote replacement would create a dysfunctional system. For example, those originally disclosed audio features directed to listening to the audio during cannot be simply replaced with the word video. For example, applicant waited until the child application to add new text directed toward displaying downloaded video, see page 10 of the amendment, filed January 3, 1994, in child application 08/023,398.
[6] See "The History of Recordings", Recording Industry of Association, retrieved from http://www.riaa.com/issues/audio/hisotry.asp on September 19, 2006. See also the "History of CD Technology", citing as a

files, such as DVD players, were not routinely available until the late 1990(s), and even these devices initially only read video data from read-only DVD disks capable of storing large digital video files, not from video data downloaded (recorded) from a remote server via a communications network.[7] Thus, undisclosed devices capable of decoding and playing back digital video files would not have been required nor necessarily present based on the original disclosure of an integrated circuit 50 of the user, which was also originally disclosed to process and store audio information. For the same reasons, it is also not clear how the originally disclosed, incoming RAM 50c and playback RAM 50d could have supported storage of downloaded video and playback.

Further regarding the original equipment of the user (consumer), in 1988 a large capacity drive for a user (e.g., 3.5 inch form factor) was around 30 megabytes[8], yet the digital bandwidth required to transmit a video signal at even VHS quality was 1.5 megabits per second (approximately 30 megabytes in 3 minutes) and this even using a Moving Picture Coding Experts Group Standard "1" ("MPEG-1") video compression technology not even available in 1988.[9] Thus, undisclosed devices capable of downloading and storing digital video files would not have been required or necessarily present based on the original disclosure of hard disk 60, which was also originally disclosed to process and store audio information.

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source "The compact Disc Handbook, 2nd Edition," by Ken C. Pohlmann, retrieved from http://www.oneoffcd.com/info/hisotrycd.cfm on September 19, 2006.

[7] See the "History of MPEG", University of California, Berkeley, School of Information Management and Systems, retrieved from http://www2.sims.berkeley.edu/courses/is224/s99/GroupG/report1.html on September 19, 2006. See also the "History of CD Technology", citing as a source "The compact Disc Handbook, 2nd Edition," by Ken C. Pohlmann, retrieved from http://www.oneoffcd.com/info/hisotrycd.cfm on September 19, 2006.

[8] See "IBM HDD Evolution" chart, by Ed Grochowski at Almaden, retrieved from http://www.soragereview.com/guideImages/z_ibm_sorageevolution.gif" on September 19, 2006.

Regarding video equipment used at the library (server) end, even large mainframe computers (e.g., IBM mainframe computers) typically only provided hard drives with capacity well below 10 gigabytes.[10] Thus, undisclosed devices capable of supporting even a small-sized video library, with its steep storage requirements as discussed above, would not have been required or necessarily present based on the original disclosure of the library (server) hard disk 10 of the copyright holder, which was originally disclosed as storing audio information.

Regarding the transfer of these large video files over a network, the proliferation of broadband communication network capable of delivering these large files to consumers, such as the Internet, simply did not exist or were not well known in 1988. Furthermore, it is not clear how the digital video would have been coded and decoded during transmission, as digital video coding standards for purposes of transmission and file downloading were not settled in 1988. As an example of the above points, the MPEG-1 standard, which was designed to code/decode digital video information and to transmit the video via a telephone (telecommunications) network in NTSC (broadcast) quality for archiving, was only established in 1992.[11] Thus, undisclosed devices capable of coding, transmitting, and decoding video digital data would not have been required or necessarily present based on the original disclosure of telephone line 30 (transmission line) and control IC(s) 20b and 50b (coding/decoding devices), which were originally disclosed as processing audio information.

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[9] See the "History of MPEG", University of California, Berkeley, School of Information Management and Systems, retrieved from http://www2.sims.berkeley.edu/courses/is224/s99/GroupG/report1.html on September 19, 2006.
[10] IBM HDD Evolution chart, *supra*.
[11] History of MPEG, *supra*.

Conclusion Regarding Priority

In view of the above, all of the new text introduced by amendment into the Child application (as identified in Table I above) is considered new matter to the original Parent application, as originally filed (Attachment "A"), for the purposes of this reexamination. Thus, the previously filed, original specification of the Parent application fails to support the invention claimed in the Child application and thus is not entitled to priority under 35 U.S.C. 120. Thus, the effective filing date (priority) of the instant '573 patent under reexamination is latest date at which time the priority chain was broken, namely September 18,1990 (at the earliest), which is also the filing date of the Child application (which issued as the '573 patent under reexamination).

Claim Rejections - 35 USC § 112

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.

Claims 1-6 and 44-49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

New Claims Contain Extensive New Text that is Not Found in the Written Description of the Parent Application As Originally Filed

35 U.S.C. 112 issues can be addressed in a reexamination proceeding with respect to new claims or amendatory subject matter. MPEP § 2258.

"Most typically, the [112] issue will arise in the context of determining whether new or amended claims are supported by the description of the invention in the application as filed... whether a claimed invention is entitled to the benefit of an earlier priority date or effective filing date under 35 U.S.C. 119, 120, or 365(c)." MPEP § 2163.I. Here, the '573 patent under reexamination claims benefit under 35 U.S.C. 120 to the earlier filing date of the Parent application.

The new claim(s) contain subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the original Parent application was filed, had possession of the claimed invention. Indeed, the new claims contain extensive new text that is not found in the written description of the originally filed Parent application (see Table I in the "Benefit of Earlier Filing Date" section above) (see attachment "A" regarding the originally filed, Parent application).

> To comply with the written description requirement of 35 U.S.C. 112, para. 1, or to be entitled to an earlier priority date or filing date under 35 U.S.C. 119, 120, or 365(c), each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure. When an explicit limitation in a claim "is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires that limitation." Hyatt v. Boone, 146 F.3d 1348, 1353, 47 USPQ2d 1128, 1131 (Fed. Cir. 1998). See also *In re* Wright, 866 F.2d 422, 425, 9 USPQ2d 1649, 1651 (Fed. Cir. 1989).

MPEP § 2163.II.A.2.(b), emphasis added.

Here, the Patent Owner, on page 9 of the Amendment, states that the new claims mirror the original claims in the '573 patent, where alleged support for the original claims in the '573 patent are provided on pages 21-26 of the Amendment. Certain of the claim limitations addressed in this chart, however, are not necessarily disclosed (required by) the written description of the originally filed, Parent application, and thus are not present in the said written description. Thus these limitations are considered new matter, as extensively discussed by the examiner in the "Benefit of Earlier Filing Date Regarding the Original Claims" section above.

New and Amended Claims Contain a Negative Limitation that is Not Found in the Written Description of the Original Parent Application

The Amendment also introduced a negative limitation into independent claims 1 and 4. For example, claim 1 now recites "a non-volatile storage portion of the second memory, wherein the non-volatile storage portion is not a tape or a CD" (emphasis added).

Any negative limitation must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims, however the mere absence of a positive recitation is not a basis for exclusion. Any claim containing a negative limitation, which does not have a basis in the original disclosure should be rejected under 35 U.S.C. 112. See MPEP § 2173.05(i).

Although the Parent application, as originally filed (attachment "A"), discloses a specific hard disk embodiment, which is therefore not in the form of a tape or a CD, the originally filed disclosure does not provide written description support for the recited, negative limitation. On page 8 of the Amendment, the Patent Owner points to page 4, lines 35 to 49 of the originally filed, Parent specification (attachment "A") has teaching a "hard disk for storing digital audio or digital video signals." The originally filed specification in the Parent application, including the section cited to by the Patent Owner above, only discloses one embodiment, where a hard disk 60 stores electronic audio music.[12] Thus, the originally filed, Parent specification discloses only a specific hard disk embodiment, which is not in the form of a tape or a CD. It should also be noted that "[c]laims are not necessarily limited to preferred embodiments, but if there are no other embodiments, and no other dislcsoure, then they may be so limited." Lizardtech, Inc. v. Earth Resource Mapping, Inc., 433 F.3d 1373, 1375 (Fed. Cir. 2006) (rehearing denied, *en banc*).

The negative limitation introduces new concepts beyond this specific embodiment. The new concepts include non-volatile storage devices that are not tapes or CDs, but that are also not hard disks. See page 3 of Ex Parte Wong, 2004 WL 4981845 (Bd.Pat.App. & Interf. 2004). The "express exclusion of certain elements implies the permissible inclusion of all other elements not so expressly excluded. This clearly illustrates that such negative limitations do, in fact, introduce new concepts. Ex parte Grasselli, 231 USPQ 393, 394 (Bd. App. 1983), aff 'd

mem., 738 F.2d 453 (Fed. Cir. 1984). "The artificial subgenus thus created in the claims is not described in the parent case and would be new matter if introduced into the parent case. It is thus equally 'new mater'...." Ex Parte Johnson, 558 F.2d 1008, 1014 (CCPA 1977). Here, the originally filed disclosure does not necessarily disclose (require) or even suggest an undisclosed, artificial subgenus of non-volatile storage devices that are not tapes or CDs. Thus, such a claimed subgenus represents new matter.

Claims 4-6 and 47-49 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.

35 U.S.C. 112 issues can be addressed in a reexamination proceeding with respect to new claims or amendatory subject matter. MPEP § 2258.

The new claim(s) contain subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time both original Parent application was filed, that the specification would have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. In re Wright, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). See also MPEP § 2164.01 and 2164.05(a).

[12] The originally filed specification in the Parent application, including the section cited to by the Patent Owner

Undue Experimentation Factors

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." These factors include, but are not limited to whether the scope and breadth of the claims are reasonably related to the scope of enablement within the original specification, the level of ordinary skill in the art, and the quantity of undue experimentation. See MPEP 2164.01(a).

Here, the subject claims recite extensive new text directed to specific and detailed video download and processing procedures that is not found in original specification of the Parent Application. The original specification does contain a general statement at the end of the specification stating "[f]urther, it is intended that this invention is not to be limited to Digital Audio Music and can include Digital Video...." (attachment "A"), however this broad, generic statement fails to enable specifically claimed video download and processing procedures.[13]

The detailed and extensive claim limitations directed to video download and processing stand in contrast to the brief, generic one sentence disclosure in the original specification, as discussed above. Thus, the scope and breadth of the claims are not reasonably correlated to the scope of enablement in the original specification. The scope of enablement must at least bear a

above, also fails to teach that the hard disk stored video data despite assertions by the Patent Owner.

[13] The original specification also describes using a "convenient visual display of the user's library of songs" (page 5), however this section appears to relate to displaying category/lyrical information to the user regarding downloaded audio content, and not directed to the actual download of video content.

"reasonable correlation" to the scope of the claims. See, e.g., In re Fisher, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). See also MPEP § 2164.08.

The original specification would not have been enabling to one of ordinary skill in the art and furthermore an undue quantity of experimentation would have been required to make or use the scope of the claimed invention (video download and processing features) based on the original specification. The specification must be enabling as of the filing date of the specification. MPEP § 2164.05(a). Here, the filing date of the Parent Application was June 13, 1988. In the mid 1980(s) however, only compact audio disks players were just becoming popular.[14] Personal user devices with the processing power capable of playing back much larger and more complex digital video files, such as DVD players, were not routinely available until the late 1990(s), and even these devices initially only read video data from read-only DVD disks capable of storing large digital video files, not from video data downloaded (recorded) from a remote server via a communications network.[15] Thus, it is not clear how the originally disclosed, integrated circuit 50 of the user would have had the processing power to decode and playback downloaded, digital video signals. For the same reasons, it is also not clear how the originally disclosed, incoming RAM 50c and playback RAM 50d could have supported storage of downloaded video and playback.

[14] See "The History of Recordings", Recording Industry of Association, retrieved from http://www.riaa.com/issues/audio/hisotry.asp on September 19, 2006. See also the "History of CD Technology", citing as a source "The compact Disc Handbook, 2nd Edition," by Ken C. Pohlmann, retrieved from http://www.oneoffcd.com/info/hisotrycd.cfm on September 19, 2006.

[15] See the "History of MPEG", University of California, Berkeley, School of Information Management and Systems, retrieved from http://www2.sims.berkeley.edu/courses/is224/s99/GroupG/report1.html on September 19, 2006. See also the "History of

Further regarding the equipment of the user (consumer), in 1988 a large capacity drive for a user (e.g., 3.5 inch form factor) was around 30 megabytes[16], yet the digital bandwidth required to transmit a video signal at even VHS quality was 1.5 megabits per second (approximately 30 megabytes in 3 minutes) and this even using a Moving Picture Coding Experts Group Standard "1" ("MPEG-1") video compression technology not even available in 1988.[17] Thus, it is not clear how a how downloaded video files of any appreciable or viable size would have been downloaded and stored on originally disclosed hard disk 60 of the user in the original specification.

Regarding the equipment used at the library (server), even large mainframe computers (e.g., IBM mainframe computers) typically only provided hard drives with capacity well below 10 gigabytes.[18] Thus, it is not clear how even a small-sized video library, with its steep bandwidth (storage) requirements (as discussed above), would have been stored in the hard disk 10 of the copyright holder in the original specification, without requiring details directed toward a complex mainframe operating environment.

Regarding the transfer of these large video files over a network, the proliferation of broadband communication network capable of delivering these large files to consumers, such as the Internet, simply did not exist or were not well known in 1988. Furthermore, it is not clear

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CD Technology", citing as a source "The compact Disc Handbook, 2nd Edition," by Ken C. Pohlmann, retrieved from http://www.oneoffcd.com/info/hisotrycd.cfm on September 19, 2006.

[16] See "IBM HDD Evolution" chart, by Ed Grochowski at Almaden, retrieved from http://www.soragereview.com/guideImages/z_ibm_sorageevolution.gif" on September 19, 2006.

[17] See the "History of MPEG", University of California, Berkeley, School of Information Management and Systems, retrieved from http://www2.sims.berkeley.edu/courses/is224/s99/GroupG/report1.html on September 19, 2006.

[18] IBM HDD Evolution chart, *supra*.

how the digital video would have been coded and decoded during transmission, as digital video coding standards for purposes of transmission and file downloading were not settled in 1988. As an example of the above points, the MPEG-1 standard, which was designed to code/decode digital video information and to transmit the video via a telephone (telecommunications) network in NTSC (broadcast) quality for archiving, was only established in 1992.[19]

Thus, based on the evidence regarding each of the above factors, the specification, at the time the Parent application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation.

Claim Rejections Based on Bush

Claim Rejections - 35 USC § 103

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 negatived by the manner in which the invention was made.

Claims 1-6 and 44-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 4,789,863 ("Bush"), of record, in view of U.S. Patent No. 4,949,187 ("Cohen"), of record.

[19] History of MPEG, *supra*.

The filing date of the Cohen patent is December 16, 1988. The earliest priority date of the '573 patent under reexamination however is September 18, 1990, as discussed extensively above in the "Benefit of Earlier Filing Date" section. Thus, Cohen is available as 102(e) type prior art.

Regarding **claim 1**,

A method for transmitting a desired digital audio signal stored on a first memory of a first party to a second memory of a second party comprising the steps of:

Bush teaches transmitting a desired digital, audio or video signal (col. 2, ll. 18-29 and col. 3, ll. 26 - 35). The digital audio or video signals are stored on compact disc machines 41-46 (first memory) of a pay per view entertainment system provider associated with source 10 (first party) (Figs. 1, 4 and col. 2, ll. 19-47). The digital signals are transmitted via a network to the consumer's receiver 14 (Fig. 1) (also illustrated as receiver 100 in Fig. 5, see also col. 3, ll. 14-17). The signals are stored on cassette recording unit and an associated cassette tape (second memory) (Fig. 5 and col. 4, ll. 1-11). Note that the second memory is also a compact disc recorder (col. 10, claim 14) and thus the second memory is also a CD.

transferring money electronically via a telecommunication line to the first party at a location remote from the second memory and controlling use of the first memory from the second party financially distinct from the first party, said second party controlling use and in possession of the second memory;

Bush teaches that money is electronically transferred via a telephone line (telecommunications line) and clearing house 200 to the source 10 (first party) by way of a credit

card transaction (Fig. 3 and col. 2, ll. 58-63, col. 4, ll. 44-47, col. 5, ll. 1-3, col. 6, ll. 25-28, and ll. 45-48). The first party's location (source 10) is remote via a network from the consumer (Fig. 1). The second party (consumer) commands the download of audio/video from the memories of the first party (source 10) (Fig. 7, col. 1, ll. 59-64, and col. 6, ll. 11-48). Thus, the first memory is controlled from the second party. Clearly, the second party (consumer) is financially distinct from the first party (source 10). The second party (consumer) also controls the use and also possesses the second memory, such as by the ability to determine what contents are stored in the second memory (col. 6, ll. 11-48)

connecting electronically via a telecommunications line the first memory with the second memory such that the desired digital audio signal can pass therebetween;

The limitation broadly recites "a telecommunications line," which lacks antecedent basis to the previous recitation of a telecommunications line. The examiner interprets a "telecommunications line" to mean a electronic medium of communicating between computers, which requires end-to-end connectivity, which is an interpretation that includes the Internet and that is consistent with an interpretation advanced by the Patent Owner and adopted by the district court. Sightsound.com Inc. v. NSK, Inc. Cdnow, Inc., and Cdnow Online, Inc., Civil Action No. 98-118, pp. 50 and 57 (District Court for the Western District of Pennsylvania, Feb. 2002). Here, Bush teaches of a cable system (electronic medium) that provides end-to-end communications between computer at the central cable system associated with source 10 and the

consumer's computer (Figs. 1, 2 and 5). The audio and video files are downloaded via the telecommunications line and thus connect the first and second memories, as discussed above.

transmitting the desired digital audio signal from the first memory with a transmitter in control and possession of the first party to a receiver having the second memory at a location determined by the second party, said receiver in possession and control of the second party; and

The desired digital audio or video signal is transmitted from the first memory as discussed above using a transmitter (Fig. 4, CADA transceiver 40) in control (col. 2, ll. 18-21) and possession of the first party, such as when the first party (source 10) determines what contents are stored in the first memory (col. 2, ll. 30-42). The second party (consumer) determines the location to which the audio/video data is transmitted as broadly recited by the claims, such as the consumer operates the invention by turning on the television and interacts with the pay per view channel at a location (e.g., consumer's home) determined by the consumer. The receiver 14 includes a cassette tape (or CD) (as discussed above) that is in possession and control of the second party (col. 1, ll. 59-64).

storing the digital signal in a non-volatile storage portion of the second memory, wherein the non-volatile storage portion is not a tape or a CD.

The received audio/video digital signal is stored in the second memory (cassette tape or CD) associated with the second party (consumer) as discussed above (i.e., a non-volatile storage portion of the second memory). See also col. 5, ll. 24-52.

Bush however fails to disclose that the non-volatile storage is "not a tape or a CD."

Cohen however (similarly to Bush, see the section 102 claim rejections based on Cohen in this Office action for additional details) teaches of an audio and video downloading system that also uses a magnetic, hard disk (non-volatile storage that is not or a CD) (col. 4, l. 64 – col. 5, l. 4).

The suggestion/motivation for adding the hard disk as taught by Cohen to Bush would have been to more efficiently access audio and video files because "magnetic media, such as hard disk drives....permit an almost unlimited number of read/write cycles...." (Cohen, col. 4, ll. 3-7). Storing data on magnetic media, such as a hard-disk, would have also increased the security and reliability of the stored data because magnetic, hard disks retain data when the power to the unit is removed (i.e., non-volatile) as would have been notoriously well-known in the art at the time the invention was made.

Therefore, to one of ordinary skill in the art at the time the invention was made, it would have been obvious to add a hard disk as taught by Cohen to the system taught by Bush.

Claim 4 differs substantively from claim 1 in that claim 4 recites that digital "video" signal is transmitted (downloaded) as opposed to the audio signal in claim 1. However, the claim 1 rejection clearly explained how Bush teaches that both audio and video digital signals are downloaded. Therefore, see the claim 1 rejection for additional details.

Claims 44 and 47 differ substantively from claims 1 and 4 in that claims 44 and 47 recite specifically that the second memory includes a second party hard disk. This limitation was addressed in the claim 1 rejection above regarding the obvious addition of a hard disk. Therefore, see the claims 1 and 4 rejections above for additional details.

Regarding **claims 2, 5, 45, and 48**, after the money transfer step, the recording system searches for a recording signal from the remote library (e.g., forward and reverse roll commands) and then for a subsequent video/audio file from the remote library for the purposes of recording, where the video/audio file is stored in the first memory, as discussed above (col. 5, ll. 35-44 and col. 6, ll. 23-48.

Regarding **claims 3, 6, 46, and 49**, Bush teaches of a system for downloading audio and video files from a central library to a user, where the user pays for the audio files and stores the audio files (abstract and Figs. 1 and 6). Bush also teaches that the user provides a credit card number to the second party (library) (col. 4, ll. 44-47, col. 5, ll. 1-3, col. 6, ll. 25-28, and ll. 45-48).

Claim Rejections Based on Freeny

Claim Rejections - 35 USC § 102

Claims 1-6 and 44-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bush in view of U.S. Patent No. 4,837,797 ("Freeny"), of record.

The claim rejections based on Bush in view Freeny differ from the claim rejections based on Bush in view of Cohen above in that Freeny, instead of Cohen, is relied upon to teach a non-volatile storage portion of the second memory that is not a tape or a CD (e.g., a hard disk). Freeny however is available as 102(e) prior art regardless of the effective filing date of the '573 patent. See the Bush in view Cohen rejection above for additional details regarding the specific teachings of Bush.

Freeny (similarly to Bush) teaches of a device that receives and stores audio data (abstract) and that also stores the received messages on a non-volatile storage portion that is not a tape or a CD (e.g., a hard disk) (col. 5, ll. 20-25).

The suggestion/motivation for adding the hard disk as taught by Cohen to Bush would have been to more efficiently access audio and video files because magnetic media, such as hard disk drives permit an almost unlimited number of read/write cycles. Storing data on magnetic media, such as a hard-disk, would have also increased the security and reliability of the stored data because magnetic, hard disks retain data when the power to the unit is removed (i.e., non-volatile) as would have been notoriously well-known in the art at the time the invention was made.

Therefore, to one of ordinary skill in the art at the time the invention was made, it would have been obvious to add a hard disk as taught by Freeny to the system taught by Bush.

Claim Rejections Based on Cohen

Claim Rejections - 35 USC § 102

Claims 1, 2, 4, 5, 44, 45, 47, and 48 are rejected under 35 U.S.C. 102(e) as being anticipated by Cohen.

The filing date of the Cohen patent is December 16, 1988. The earliest priority date of the '573 patent under reexamination however is September 18, 1990, as discussed extensively above in the "Benefit of Earlier Filing Date" section. Thus, Cohen is available as 102(e) type prior art.

With respect to **claim 1**, Cohen clearly teaches a method for transmitting a desired digital movie signal (abstract) comprising video and audio components (col. 1, ll. 7-12 and ll. 46-50) of a first party (central source of audio and video data, Fig. 4) to a second memory (disk storage system 114) of a second party (home viewer) (abstract). Money is electronically transferred via a telephone (telecommunication) line, where the first (central source) and second party (home viewer) is clearly financially distinct (abstract and Fig. 4, telephone line 60). The desired digital movie (video and audio) is in the first memory (principal on line movie storage 12-26, Fig. 4) is connected to and transferred via the telephone (telecommunications) line 60 to the second memory (disk storage system 114), where it is stored (col. 4, ll. 1-68). The digital signal is stored in a non-volatile storage portion of the second memory, that is not a tape or a CD (i.e., the hard disk) (col. 4, l. 64 – col. 5, l. 4).

Claim 4 differs substantively from claim 1 in that claim 4 recites that digital "video" signal is transmitted (downloaded) as opposed to the audio signal in claim 1. However, the claim 1 rejection clearly explained how Cohen teaches that both audio and video digital signals are downloaded. Therefore, see the claim 1 rejection for additional details.

Claims 44 and 47 differ substantively from claims 1 and 4 in that claims 44 and 47 recite specifically that the second memory includes a second party hard disk. This limitation was addressed in the claim 1 rejection above. Therefore, see the claims 1 and 4 rejections above for additional details.

Regarding **claims 2, 5, 45, and 48**, see col. 4, ll. 19-29 and ll. 47-63, where after the money transfer (accounting) step, the system searches for the desired selection by the home viewer and commences downloading.

Claim Rejections - 35 USC § 103

Claims 3, 6, 46, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen as applied to the claims above, and further in view of Bush.

Cohen teaches of telephoning the first party controlling use of the first memory and transferring money (as discussed above in the claim 1 rejection). Cohen however fails to teach providing a credit card number of the second party.

Bush teaches (similarly to Cohen, see the Bush, claim 1 rejection above) of a system for downloading audio and video files from a central library to a user, where the user pays for the audio files and stores the audio files (abstract and Figs. 1 and 6). Bush also teaches that the user provides a credit card number to the second party (library) (col. 4, ll. 44-47, col. 5, ll. 1-3, col. 6, ll. 25-28, and ll. 45-48).

The suggestion/motivation for providing a credit card number to the second party would be to reduce the expenses involved in operating a download service, because financial service organizations, such as credit card organizations, "enable the source 10 to [be] paid be a service fee for the subscriber's use of the system." Bush, col. 2, ll. 58-63. Obviously, providing a credit card number would have been required to use the services of a credit card organization.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add the step of the user providing a credit number to the second party as taught by the audio/video download system of Bush to the audio/video download of Cohen, which teaches that the user pays for the download.

Claim Rejections Based on Akashi

Claim Rejections - 35 USC § 103

Claims 1-6 and 44-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application No. 62-284496 ("Akashi") using the English translation of record, in view Freeny.

Regarding **claims 1, 3, 4, 6, 44, 46, 47, and 49,** Akashi discloses a system for automatically selling recorded music via telecommunication lines (Page 1 through line 1 of Page 2). This system utilizes the telecommunications lines to transmit the recorded music data from a host computer that stores the recorded music data to a personal computer (Page 2 Section 4), which meets the limitation of connecting electronically via telecommunications line the first memory with the second memory such that the desired digital audio signal can pass therebetween, transmitting the desired digital audio signal from the first memory with a transmitter in control and possession of the first party to a receiver having the second memory at a location determined by the second party, said receiver in possession and control of the second party, storing the digital signal in the second memory.

Akashi discloses that the digital music data is purchased automatically but does not expressly detail how the purchase is transacted and whether the data is stored on a non-volatile storage portion of the second memory that is not a tape or a CD.

Freeny discloses a method of electronically distributing and selling audio and video data by way of having the requesting user transmit a consumer credit card number along with their request for the audio and video data (Col. 13, lines 25-29). This step allows the owner of the data to approve the sale and charge the sale to the consumer credit card number (Col. 13, lines 30-31), which meets the limitation of transferring money electronically via a telecommunications lines to the first party at a location remote from the second memory and controlling use of the first

memory from the second party financially distinct from the first party, said second party controlling use and in possession of the second memory, the transferring step includes the steps of telephoning the first party controlling use of the first memory by the second party, providing a credit card number of the second party controlling the second memory to the first party controlling the first memory so the second party is charged money. Freeny also discloses that the received audio and video data is stored on a non-volatile storage that is not a tape or CD (e.g., a hard disk) (col. 5, l. 23-25).

The suggestion/motivation for combining Akashi with Freeny would have been because this method of electronic sale allows the owner of the information to receive directly the compensation for sale of recording and such compensation is received before the reproduction is authorized as taught in Freeny (Col. 13, lines 36-39). The use of a hard disk would have allowed the user to more efficiently access audio and video files because magnetic media, such as hard disk drives, permit an almost unlimited number of read/write cycles. Furthermore, storing data on magnetic media, such as a hard-disk, would have also increased the security and reliability of the stored data because magnetic, hard disks retain data when the power to the unit is removed (i.e., non-volatile) as would have been notoriously well-known in the art at the time the invention was made.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the requesting user's of Akashi transmit a consumer credit card number along with their request for the digital data so that the source unit could approve and

charge the sale of the digital data to the consumer credit card and to store the received audio and video data on a hard disk (non-volatile storage that is not a tape or CD) as taught by Freeny.

Regarding **claims 2, 5, 45, and 48**, Akashi discloses that personal computer contains a CPU (Figure 1). The personal computer sends an access signal to the host computer, and the host computer returns a response signal that contains menu data displayed at the personal computer (Page 3 Paragraph 6). Using the monitor screen, the user chooses desired data using a control unit and sending the selection data to the host computer in the same way the initial transmission was sent (Page 4 Paragraph 1), which meets the limitation of the steps of searching the first memory for the desired digital audio signal and selecting the desired digital audio signal from the first memory.

Response to Arguments

The Office has Jurisdiction to Apply Intervening Patents and Printed Publications in a Reexamination Proceeding To a Patent that Seeks the Section 120 Benefit to the Filing Date of an Earlier Filed Application

On page 10 of the Amendment, the Patent Owner argues that the Office lacks jurisdiction in reexaminations to reassign priority dates for originally issued claims in the absence of a previous continuation-in-part application. Specifically, the Patent Owner argues that it is "impermissible, in the context of a reexamination, to apply 35 U.S.C. § 120 to reassign priority dates for originally issued claims."

Although the Patent Owner's arguments have been carefully considered, they are not deemed persuasive. A rejection may be made in an *ex-parte* reexamination proceeding based on an intervening patent when the patent claims under reexamination, under 35 U.S.C. 120, are entitled only to the filing date of the patent under reexamination. Specifically:

> Rejections may be made in reexamination proceedings based on intervening patents or printed publications where the patent claims under reexamination are entitled only to the filing date of the patent and are not supported by an earlier foreign or United States patent application whose filing date is claimed. For example, under 35 U.S.C. 120, the effective date of these claims would be the filing date of the application which resulted in the patent. Intervening patents or printed publications are available as prior art under In re Ruscetta, 255 F.2d 687, 118 USPQ 101 (CCPA 1958), and In re van Langenhoven, 458 F.2d 132, 173 USPQ 426 (CCPA 1972). See also MPEP § 201.11

MPEP § 2258.I.C, Scope of Reexamination (emphasis added). See also MPEP § 2217.

Furthermore, no priority dates have been "reassigned" by the examiner, rather the examiner simply applied an intervening reference. When an application claims section 120 benefit to an earlier filed application (e.g. continuations, continuations-in-part), the examiner may use an intervening reference (e.g., a printed publication or patent pre-dating the actual filing date of the application, but post-dating the filing date of the different, parent application to which benefit is sought) in a rejection based on the actual filing date of an application claiming section 120 benefit. The Patent Owner may then correct the benefit claim or show that the conditions for claiming benefit to the priority date have been met. MPEP 201.11.

The Patent Owner next argues on page 10:

> It is well established that the primary determination under Section 120 is whether priority is claimed to an earlier application that "fulfills the requirements of Section 112, first paragraph." Callicrate v. Wadsworth Mfg., 427 F.3d 1361, 1373 (Fed. Cir. 2005) (citation omitted). It equally is well established, however, that the scope of a reexamination proceeding is limited to whether

> claims are patentable under 35 U.S.C. §§ 102 and 103 "on the basis of patents and printed publications." 37 C.F.R. § 1.552. The reexamination rules explicitly preclude consideration of issues arising under 35 U.S.C. § 112, except "with respect to subject matter added or deleted in the reexamination proceeding." Id.; see also In re Etter, 756 F.2d 852, 856 (Fed. Cir. 1985) (en banc) ("only new or amended claims are also examined under 35 U.S.C. §§ 112 and 132").

Although the Patent Owner's arguments have been carefully considered, they are not deemed persuasive. Applying 35 U.S.C. § 120 neither requires nor implies that the specification of the '573 patent under reexamination is itself being subjected to a 35 U.S.C. § 112 analysis. Indeed, none of the original six patent claims of the '573 patent have been rejected pursuant to section 112. Rather it is the specification(s) of the Parent application that is being analyzed on that basis. For example, the examiner has taken the position that the Parent application, as originally filed, does not describe certain features recited in the claims of the instant '573 patent under reexamination. The examiner does not argue that the specification, including the claims, of '573 patent under reexamination fails to establish possession of the claimed invention, but rather whether possession of the claimed invention was established before the filing date of the '573 patent in a different U.S. application.

The 35 U.S.C. 102 and 103 rejections based on the intervening patents and publications are also, clearly, an inquiry into patentability "on the basis of patents and printed publications."

An Inquiry Under Section 120 Does Not Revisit Any Substantial Question of Patentability Necessarily Raised and Previously Decided by the Examiner During Prosecution of the Application Corresponding to the '573 Patent

On page 11 of the Amendment, the Patent Owner argues that an:

> [I]nquiry under Section 120 as to whether the language of a particular claim, as filed or amended during an original prosecution, was supported or unsupported by sufficient disclosure is, by definition, not a *new* question.

Although the Patent Owner's arguments have been carefully considered, they are not deemed persuasive. A substantial new question of patentability was raised in this proceeding based on prior patents or printed publications identified in the Request for Reexamination, filed on January 31, 2005 (and as detailed in the Order Granting the Request for *Ex Parte* Reexamination, mailed March 18, 2005). Therefore, the issue of whether a 35 U.S.C. 120 inquiry raises a substantial new question of patentability is irrelevant.

Nonetheless, an inquiry under section 120 does not revisit any substantial question of patentability previously decided by the examiner during prosecution of the application corresponding to the '573 patent. Substantial questions of patentability are "old" only in respect to previously considered patents or printed publications, i.e., those questions based on "old art." See MPEP 2242.II. The intervening patents applied in this reexamination proceeding were not previously considered during prosecution of application leading to the '573 patent under reexamination, and thus do not raise questions of patentability previously considered by the original examiner.

The Patent Owner next argues on page 11:

> Rather, it is an issue that necessarily arises at the time of original filing or amendment, and one that necessarily is before the original examiner. It cannot, therefore, raise a "substantial new question of patentability in reexamination," 35 U.S.C. § 303, because it is never a "new question" at all.

Although the Patent Owner's arguments have been carefully considered, they are not deemed persuasive. A section 120 issue does not "necessarily" arise, as argued by the Patent Owner above, during prosecution of the application leading to patent, thereby precluding all further consideration of priority issues by the Office after the patent issues. For example, in addition to the MPEP § 2258.I.C. as discussed above, the Patent Owner himself may request a reexamination proceeding to correct a failure to adequately claim benefit under 35 U.S.C. 120, see MPEP § 2258.IV.E. Priority issues can also be considered in reissue proceedings, see MPEP § 1402. The inclusion of prior application information in the patent does not necessarily indicate that the claims are entitled to the benefit of the earlier filing date, and furthermore notations in the file history regarding prior application information are only evaluated to ensure that the data itself is accurate, not necessarily that the Patent Owner is entitled to the benefit of the earlier filing date. MPEP § 202.02.

The examiner had no reason to consider the propriety of a benefit claim under section 120 during prosecution of the application leading to the '573 patent under reexamination. The examiner would not have determined the sufficiency of the Parent specification, as originally filed, which is at issue here, unless provoked by a need to use an intervening reference. For example, the prosecution history of the '573 patent reveals that it would have been unnecessary

for the examiner to have reviewed the particular issue of whether a different, earlier filed application established possession of the claims recited in the '573 patent, since no intervening references (e.g., documents pre-dating the actual filing date of the '573 patent, but post-dating the filing date of the Parent application) were cited of record.

Ruscetta and Langenhoven Nowhere Hold That Priority Determinations Under 35 U.S.C. 120 Are Limited To Continuation-in-Part applications, Nonetheless, the Application Corresponding to the '573 Patent Shares the Characteristics of a Continuation-in-Part in its Relationship to the Originally Filed, Parent Application

On page 11 of the Amendment, the Patent Owner argues that MPEP §§ 2258.I.C. and 2217 should be limited to situations where there was a continuation-in-part ("CIP") application because both of the cases cited for support are cases involving CIP(s), namely *In re* Ruscetta, 255 F.2d 687 (CCPA 1958) and *In re* van Langenhoven, 458 F.2d 132 (CCPA 1972).

Although the Patent Owner's arguments have been carefully considered, they are not deemed persuasive. As extensively discussed in the "Benefit of Earlier Filing Date" section above, a review of the prosecution history provides clear and objective evidence that a significant amount of new text (directed to various features) was added in a series of amendments to the application corresponding to the '573 patent that was not present in the originally filed, Parent application. See for example, Tables I and II *supra*. Thus, the '537 patent being reexamined and the specification of the original, Parent application are not congruent, that is, they do not contain the same disclosure with respect to claim support issues. Thus, the application corresponding to the '573 patent shares the characteristics of a continuation-in-part in

its relationship to the originally filed, Parent application. See 37 CFR 1.53.b.2 and MPEP § 201.08.

Nonetheless, Ruscetta and Langenhoven nowhere hold that priority determinations under 35 U.S.C. 120 should be limited to continuation-in-part applications. Instead, both cases are directed to the use of intervening references against the claims of an application that seek the benefit of priority to an earlier filed application under 35 U.S.C. 120. The ability to use an intervening reference is not limited to continuation-in-part applications, but applies to any later filed application claiming benefit of a prior application under 35 U.S.C. 120, such as continuation applications. See MPEP § 201.11, "Claiming the Benefit of an Earlier Filing Date Under 35 U.S.C. 120 and 119(e)"....(B)... [t]he examiner may use an intervening reference in a rejection until applicant corrects the benefit claim or shows that the conditions for claiming the benefit of the prior application have been met." Both continuation and continuations-in-part applications are also related in that they both rely on priority under 35 U.S.C. 120 to obtain the benefit of an earlier filing date. MPEP § 201.11 Furthermore, continuation-in-part applications are related to continuation applications as a "continuing applications" under 37 CFR 1.53(b). Indeed, the application corresponding to the '573 patent under reexamination was filed under the old "file wrapper continuation" procedure, under which both continuation and continuation-in-part applications were filed under the same rule, 37 CFR 1.62. MPEP § 201.06(b), referring to MPEP, 8th Ed., 1st Revision, February 2003. http://www.uspto.gov/web/offices/pac/mpep/mpep_e8r1_0200.pdf). Here, the present reexamination proceeding uses intervening references against the claims of an alleged continuing

application (the '573 patent) that seeks the benefit of priority to an earlier filed application under 35 U.S.C. 120, which is similar to the issues discussed in the Ruscetta and Langenhoven cases.

The Use of Intervening Reference Is Not Limited to Continuation-in-Part Applications, but Applies To Any Later Filed Application Claiming Priority Benefit To a Prior Application under 35 U.S.C. 120, such as Continuation Applications.

On pages 12 and 13 of the Amendment, the Patent Owner argues that examiner lacks the authority to reassign priority dates in the present reexamination proceeding because the original examiner lacked the authority to do so. Specifically, the Patent Owner argues that the original examiner "could not – and did not – reassign priority dates to the original claims" because "if the applicant does not overcome the objection and rejection the applicant has the option of refiling the application as a CIP...." that "in the absence of a CIP an original examiner cannot simply elect to assign a later effective priority date." "Such a procedure would amount to creation of a '*de facto* CIP' by the original examiner, and undertaking plainly unsupported by statue, regulation, case law, or MPEP provision, or any other authority or precedent."

Although the Patent Owner's arguments have been carefully considered, they are not deemed persuasive.

First it is noted that the Patent Owner admits that the original examiner did not address the issue of whether to apply intervening references against the original claims. Thus, the use of intervening references is an open question that will be addressed in this reexamination proceeding.

Second, the ability to use an intervening reference is not limited to continuation-in-part applications, but applies to any later filed application claiming benefit of a prior application under 35 U.S.C. 120, such as continuation applications, as discussed extensively above. See again MPEP § 201.11. If the claims in the later-filed application are not entitled to the benefit of an earlier filing date under section 120, then the examiner should:

> conduct a prior art search based on the actual filing date of the application instead of the earlier filing date. The examiner may use an intervening reference in a rejection until applicant corrects the benefit claim or shows that the conditions for claiming the benefit of the prior application have been met. The effective filing date of the later-filed application is the actual filing date of the later-filed application, not the filing date of the prior-filed application.

MPEP § 201.11 (emphasis added).

Thus, the present (and original) examiner has (had) the authority to apply an intervening reference by relying upon the actual filing date of the application corresponding to the '573 patent until the Patent Owner corrects the section 120 benefit claim or shows that the conditions for claiming benefit of the prior application have been met, even though the original examiner did not exercise such authority, as admitted to by the Patent Owner above and based on the prosecution history as discussed extensively above.

The Original Examiner Did Not Address the Specification as Originally Filed in the '573 Specification, Much Less the Specification as Originally Filed in the **Parent** Application

On pages 13-16 of the Amendment, the Patent Owner argues that the original examiner did "consider the various additions to the specification and concluded those additions did not constitute new matter and the subject claims therefore were supported under Section 112...." The Patent Owner also refers to a Declaration filed under 37 CFR 1.132 and to a chart on pages 14 and 15 of the Amendment.

Although the Patent Owner's arguments have been carefully considered, they are not deemed persuasive. Although the examiner addressed new matter issues in a non-final rejection in the Child application, mailed on February 24, 1992 (as the Patent Owner provided chart demonstrates), these new matter issues were in response to one amendment filed on December 11, 1991, where by the way, both the examiner and Patent Owner only touched upon a subset of the new matter issues described in Table I above. A series of amendments to the specification and claims were filed previously and subsequently to this single amendment in the Parent and Child applications, where each amendment gradually added new matter. See Table II, *supra*. Therefore, it is not clear whether the examiner addressed this issue in regard to the specification as originally filed in the Child application from which the '573 patent issued, much less in regard to the specification as originally filed in the Parent application, which is at issue here. That is, the consideration of any new matter in the December 11, 1991 amendment does not relate back to the specification as originally filed in the Parent application. For the same reasons, the consideration of any issues in the Declaration, filed on June 25, 1992 would also fail to relate back to the Parent application as originally filed (even if the Declaration were considered

persuasive, which it is not, as discussed in the "Benefit of Earlier Filing Date" above). Thus, the prosecution history provides further evidence that the examiner did not consider support in the specification as originally filed in the Parent application.

Patlex Makes Clear that It Does Not Apply to Situations Where the Sufficiency of the Parent Application Has Not Been Decided, Furthermore the Facts in the Patlex Case Differ Considerably from the Facts in the Instant Reexamination Proceeding

On pages 16 and 17 of the Amendment, the Patent Owner argues that in Patlex v. Quigg, 680 F.Supp. 33, 6 USPQ2d 1296 (D.D.C. 1988), the United States District Court for the district of Columbia "addressed a situation substantially identical to the circumstances of the present reexamination" and held that where "an original examiner already has considered and determined the sufficiency of the specification's disclosure under Section 112 and the resulting entitlement of claims to an original priority d ate, there is no 'substantial new' question of patentability for reexamination..." and thus the "Office lacks jurisdiction to 'reexamine' that same issue for those same claims in a subsequent reexamination proceeding."

Although the Patent Owner's arguments have been carefully considered, they are not deemed persuasive. The holding relied on by the Patent Owner reads, in full, "hence, the Court concludes that the examiner and the Board lacked jurisdiction in this case to 'reexamine' the sufficiency of the specification of the 'great-grandparent' application." (Emphasis added). Id., at 37, at 1299. Obviously, this is not a broad holding that a 35 U.S.C. § 120 benefit claim can never be "reexamined" in a reexamination proceeding. Indeed, the Patlex court specifically, and rather clearly, went on to state that the "Court wishes to make clear that it is not deciding

whether the Commissioner has jurisdiction in a reexamination to inquire into the sufficiency of the specification of a "parent" application where the sufficiency of the "parent" application vis-a-vis the claims of the patent being reexamined was not previously determined by the PTO or a court."[20] As discussed extensively above, the original examiner did not consider and determine the sufficiency of the specification in the originally filed, Parent application for the purposes of priority under 35 U.S.C. 120.

Indeed, the facts in the instant reexamination proceeding differ considerably from the facts in Patlex. In Patlex, the Court found that the issues were based upon the fact that the specification of the patent being reexamined was "essentially identical" to the specification of the great-grandparent application for which section 120 benefit was claimed (Id., at 34, at 1297) and that the claims of the great-grandparent were "directed essentially to the invention for [the patent being reexamined]." (Id. at 36, at 1299). As discussed extensively above in the "Benefit of Earlier Filing Date" sections (see Tables I and II), the specification and the claims of the patent being reexamined are substantially different from the specification and claims of the original, Parent application for which section 120 benefit was claimed. A series of amendments subsequent the filing of the original, Parent application has added a substantial amount of new text to the specification and claims of both the parent application and the Child application, which issued as the '573 patent.

[20] In another example, the Federal Circuit recently upheld a priority determination based upon a written description analysis raised by the Office during a reexamination proceeding initiated based on prior art raising a new question of patentability. In re Curtis, 354 F.3d 1347 (Fed. Cir. 2004). See also In re Modine and Guntly, 2001 WL 898541 (Fed. Cir. 2001) (unpublished) (finding lack of priority to an ancestor application during a reexamination of a patent where the reexam was initiated based on prior art raising a new question of patentability.

If a Claim Limitation Is Not Necessarily Disclosed in (Required by) the Written Description of the Originally Filed, Parent Application, It Is Not Present in the Written Description

On pages 18-21 of the Amendment, the Patent Owner argues that the "requirement of an inherency standard under Section 112 is unsupported by *Hyatt, Robertson,* or *Lockwood.*"

Although the Patent Owner's arguments have been carefully considered, they are not deemed persuasive. The case of Hyatt v. Boone, 146 F.3d 1348, 47 USPQ2d 1128 (Fed. Cir. 1998) (emphasis added) (Certiorari Denied), to which the Patent Owner refers to approvingly, is clear in this matter. When an explicit limitation in a claim "is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires that limitation." Id. at 1353 (emphasis added). "It is 'not a question of whether one skilled in the art might be able to construct the patentee's device from the teachings of the disclosure...Rather, it is a question whether the application necessarily discloses that particular device." Id. at 1353-4 (quoting from Jepson v. Coleman, 50 C.C.P.A. 1051, 314 F.2d 533, 536, 136 USPQ 647, 649-50 (CCPA 1963)) (emphasis added). The "written description must include all of the limitations...or the applicant must show that any absent text is necessarily comprehended in the description provided and would have been so understood at the time the patent application was filed." Id. at 1354-55 (emphasis added).

The case of In re Roberston, 169, F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999) was cited for its holding that "missing descriptive matter" that is "necessarily present" also goes to inherency. Id. at 745 (emphasis added).

The case of Lockwood v. American Airlines, Inc., 107 F.3d 1565, 41 USPQ2d 1961 (Fed. Cir. 1997) was cited to emphasize that, although the written description requirement requires that the application necessarily discloses a particular device to one of ordinary skill in the art at the time the application was filed, such a test should not devolve into an inquiry that "combined with the knowledge in the art, would lead one to speculate as to modifications that the inventor might have envisioned, but failed to disclosed. Id. at 1571.

Thus, when an explicit limitation in a claim is not present in the written description whose benefit is sought, such a limitation must be required (necessarily disclosed) by the written description. Thus, if the said limitation is not necessarily disclosed in (required by) the written description, it is not present in the written description.

Certain Claim Limitations Addressed in the Patent Owner's Claim Support Chart Are Not Necessarily Disclosed (Required by) the Written Description of the Originally Filed, Parent Application, and Thus Are Not Present in the Original, Written Description

On pages 21-26 of the Amendment, the Patent Owner provides a chart to show that all of the limitations in claims 1-6 and 44-49 of the '573 patent were supported by the originally filed, Parent application.

Although the Patent Owner's arguments have been duly considered, they are not deemed persuasive. While the chart is certainly appreciated, certain of the claim limitations addressed in the chart are not necessarily disclosed (required by) the written description of the originally filed, Parent application, and thus are not present in the said written description, as extensively discussed by the examiner in the "Benefit of Earlier Filing Date" section *supra*. Thus, the effective filing date (priority) of the instant '573 patent under reexamination remains the latest date at which time the priority chain was broken, namely September 18, 1990 (at the earliest), which is also the actually filing date of the '573 patent.

The Enablement Rejection of Newly Added, Video Download Feature Is Based on Factors, such as Undue Experimentation, and Not upon a "Mass Production" Standard as Argued by the Patent Owner

On pages 27-30 of the Amendment, the Patent Owner argues that, regarding the enablement of various video features recited in claims 4 through 6 by the Parent application, as originally filed, the Office is attempting to apply a "mass production" standard when, "in actuality, the enablement standard of Section 112 has no such requirement."

Although the Patent Owner's arguments have been duly considered, they are not deemed persuasive. Claims 4 through 6 were not rejected under a 35 U.S.C., 112, 1st paragraph, enablement rejection. Nonetheless, the examiner of rejection under the enablement requirement of those newly introduced claims reciting a video download feature was explicitly based upon an undue experimentation factor. Nothing was stated about a "mass production" requirement. For example, the originally filed, Parent application teaches that data (not specifically video data) is

transmitted via a telephone line. Yet the MPEG-1 standard, which was designed to code/decode digital video information and to transmit the video via a telephone (telecommunications) network in NTSC (broadcast) quality for archiving, was only established in 1992. See the 35 U.S.C. 112, 1st paragraph rejection *supra* for additional details. Thus, digital video coding standards for purposes of transmission and file downloading over a telephone line were not settled in 1988. Thus, it would not have been clear to one of ordinary skill how the digital video would have been coded and decoded during transmission over a telephone line. Such a question does not relate to mass production, but whether a single video downloading system as claimed could be made or used without undue experimentation by one of ordinary skill in the art in 1988 facing a lack of industry standards for transmitting digital, video data via a telephone line and also facing a limited disclosure of any video features whatsoever (except for the general statements at the end of the specification regarding video applicability) in the originally filed, Parent application.

Yurt, Goldwasser, and Cohen Are Available of Prior Art Patents

On pages 32-35 of the Amendment, the Patent Owner argues that Yurt, Goldwasser, and Cohen are not available as prior art patents. The publication date of the Yurt patent however is July 21, 1992. The earliest priority date of the '573 Patent under reexamination however is September 18, 1990, as discussed extensively above in the "Benefit of Earlier Filing Date" section. Thus, Yurt is available as both 102(b) and 102(e) type prior art. For similar reasons, Goldwasser and Cohen are also available as prior art.

Patent Owner arguments regarding Bush, Akashi, and Freeny regarding their failure to teach a nonvolatile storage that is not a tape or CD are unpersuasive. For example, Freeny discloses the use of a hard disk (non-volatile storage not a tape or CD) to store the received files, as discussed above. The failure of Bush or Akashi to teach storing the received files on a hard disk cannot be reasonably interpreted as "teaching away" from the use of a hard disk. The "prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). MPEP 2145.X.D.1. Here, Bush does not criticize, discredit, or discourage the use of a hard disk and is therefore insufficient to teach away from the prior art's suggestion that a hard disk could be used to store received files. For example, Cohen, which was an obvious addition to Bush as applied above, teaches of (an explicitly provides a suggestion/motivation for) using a hard disk to store received files.

Response to Declarations

Several Declarations were filed by the Patent Owner on December 27, 2005. These Declarations were considered, but are not deemed persuasive. The Declarations by Justin Douglas Tygar, Ph.D. and Arthur R. Hair appear to argue support features generally, but do not specifically relate to the new matter issues caused by the gradual and repeated introduction of new text after the Great-grandparent application was originally filed, which is the issue here and as extensively discussed above. The Declarations by Kenneth C. Pohlmann and regarding the prior litigation are not directed to the rejections as presently formulated in this Office action.

Conclusion

The Amendment (filed on December 1, 2006) necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a) and § 2271.III.

A shortened statutory period for response to this action is set to expire 2 months from the mailing date of this action.

Any amendment after a final action must include "a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented" in order to be considered. See MPEP § 2260.

The filing of a timely first response to this final rejection will be construed as including a request to extend the shortened statutory period for an additional month, which will be granted even if previous extensions have been granted. In no event, however, will the statutory period for response expire later than SIX MONTHS from the mailing date of the final action. See MPEP § 2265.

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. Further, in 35 U.S.C. 305 and in 37 CFR 1.550(a), it is required that reexamination proceedings "will be conducted with special dispatch within the Office" (37 CFR

1.550(a)). Extension of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

Extensions of time in reexamination proceedings are provided for in 37 CFR 1.550(c). A request for extension of time must be filed on or before the day on which a response to this action is due, and it must be accompanied by the petition fee set forth in 37 CFR 1.17(g). The mere filing of a request will not effect any extension of time. An extension of time will be granted only for sufficient cause, and for a reasonable time specified.

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 U.S. Patent No. 5,191,573 (the "'573" patent under reexamination) 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.

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

By **U.S. Postal Service Mail** to:

Mail Stop "Ex Parte Reexam"
ATTN: Central Reexamination Unit
Commissioner for Patents
P. O. Box 1450
Alexandria VA 22313-1450

By **FAX** to:

(571) 273-9900
Central Reexamination Unit

By **hand** to:

Customer Service Window
Central Reexamination Unit
Randolph Building, Lobby Level
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the Reexamination Legal Advisor or Examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.

Signed:

Roland G. Foster
Central Reexamination Unit, Primary Examiner
Electrical Art Unit 3992
(571) 272-7538

Conferees:

MARK J. REINHART
SPRE-AU 3992
CENTRAL REEXAMINATION UNIT

SCOTT L. WEAVER
CRU EXAMINER-AU 3992

Application Number	Application/Contr l No.	Applicant(s)/Patent under Reexamination	
	90/007,402	5191573	
	Examin r	Art Unit	
	Roland G. Foster	3992	

Index of Claims

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90/007,402	5191573
Examiner	**Art Unit**
Roland G. Foster	3992

√	Rejected	–	(Thr ugh numeral) Cancelled	N	Non-Elect d	A	Appeal
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