

sub-genus created by the express exclusion of certain species in the CIP were not supported by the description of the broader genus in the parent specification. Again, the situation with the present reexamination differs significantly from the cited case law. Claims 1 and 4 recite a non-volatile storage portion of a memory that is not a tape or CD. This is exactly what is described at page 2, lines 23 to 26 of the originally filed specification. In short, the negative limitation recited in Claims 1 and 4 is expressly disclosed in the specification of the parent application. Thus, in the instant case, the scope of the disclosure in the specification was never narrowed with respect to this element, contrary to the situation in *Johnson*. Therefore, the recitation of a non-volatile storage portion of a memory that is not a tape or CD is fully supported by the originally filed specification, as well as the specification of the '573 Patent as issued.

With respect to the other elements recited in Claims 1 through 6, the issue of written support for the claimed matter previously was addressed by Examiner Nguyen during the initial examination of Claims 1 through 6, as recognized by the Office in the Office Action dated March 17, 2007. Moreover, Appellant has thoroughly demonstrated in Sections III(C)(1)(ii) and III(C)(2) above that each element in Claims 1 through 6 is fully supported and enabled by the original specification as filed, as well as the specification for '573 Patent as issued. Therefore, the Board should reverse the Examiner's rejections of Claims 1 through 6 under 35 U.S.C. § 112, first paragraph.

**V. BASED ON THE PROPER PRIORITY DATE FOR THE CLAIMS IN REEXAMINATION, THE REJECTIONS OF CLAIMS 1 THROUGH 6 AND 44 THROUGH 49 BASED ON *COHEN* ARE IMPROPER**

As set forth above, the proper priority for Claims 1 through 6 and 44 through 49 in reexamination is June 13, 1988. Therefore, any rejections under Sections 102 or 103 which rely on references that are not prior art based on the June 13, 1988 priority date are improper and

should be reversed. U.S. Patent 4,949,187 to Cohen (*Cohen*) issued on August 14, 1990 from an application filed on December 16, 1988. Therefore, *Cohen* does not qualify as prior art for the purposes of Sections 102 and 103.

**A. Rejection Of Claims 1, 2, 4, 5, 44, 45, 47 And 48 Under 35 U.S.C. § 102(e) As Anticipated By *Cohen***

Claims 1, 2, 4, 5, 44, 45, 47 and 48 have been rejected under 35 U.S.C. § 102(e) as anticipated by *Cohen*. Because *Cohen* is not available as prior art based on the proper priority date of June 13, 1988 for the '573 Patent, the instant rejection is improper. Therefore, the Board should reverse this rejection.

**B. Rejection Of Claims 1 Through 6 and 44 Through 49 Under 35 U.S.C. § 103(a) Over *Bush* In View Of *Cohen***

Claims 1 through 6 and 44 through 49 have been rejected under 35 U.S.C. § 103(a) as obvious over the combination of U.S. Patent 4,789,863 to Bush (*Bush*) in view of *Cohen*. Because *Cohen* does not qualify as prior art based on the proper June 13, 1988 priority date of the '573 Patent, a combination of *Cohen* and another reference cannot provide a proper basis for an obviousness rejection. As a result, the rejection of Claims 1 through 6 and 44 through 49 based on a combination of *Bush* and *Cohen* is improper. Therefore, the Board should reverse this rejection.

**C. Rejection Of Claims 3, 6, 46 and 49 Under 35 U.S.C. § 103 (a) Over *Cohen* In View Of *Bush***

Claims 3, 6, 46 and 49 have been rejected under 35 U.S.C. § 103(a) over *Cohen* in view of *Bush*. Because *Cohen* does not qualify as prior art based on the proper June 13, 1988 priority date of the '573 Patent, a combination of *Cohen* and another reference cannot provide a proper basis for an obviousness rejection. As a result, the rejection of Claims 3, 6, 46 and 49 based on

a combination of *Bush* and *Cohen* is improper. Therefore, the Board should reverse this rejection.

**VI. CLAIMS 1 THROUGH 6 AND 44 THROUGH 49 ARE PATENTABLE OVER THE REFERENCES OF RECORD THAT ARE PROPER PRIOR ART**

The Office has also presented rejections under 35 U.S.C. § 103(a) that are based on references that qualify as prior art based on the June 13, 1988 priority date for the claims in reexamination. However, the Office has not established a *prima facie* case of obviousness of any of Claims 1 through 6 or 44 through 49 based on these references.

**A. Rejection Of Claims 1 Through 6 And 44 Through 49 Under 35 U.S.C. § 103(a) Over *Bush* In View Of *Freeny I***

Claims 1 through 6 and 44 through 49 have been rejected under 35 U.S.C. § 103(a) as obvious over the combination of *Bush* in view of U.S. Patent 4,837,797 to Freeny (*Freeny I*).

The Office admits that *Bush* does not disclose storing digital audio signals or digital video signals in a non-volatile storage portion of a second memory that is not a tape or a CD as recited in Claims 1 and 4. As further admitted by the Office, *Bush* does not disclose storing digital audio signals or digital video signals in a second party hard disk as recited in Claims 44 and 49.

*Freeny I* discloses a message controller for receiving voice messages and machine readable messages over telephone lines. The apparatus of *Freeny I* is capable of differentiating between voice messages and machine readable messages received over standard telephone equipment, *i.e.* a telephone. When the apparatus of *Freeny I* determines that a received call is a voice message, it causes the user's telephone to ring, thereby alerting the user. When the apparatus of *Freeny I* determines that a received call is a machine readable message, it converts the message to human readable form using a standard printer or display unit. One embodiment

of the apparatus of *Freeny I* indicates it is capable of receiving machine readable messages and storing them on a storage medium that may be a memory chip or hard disk.

However, *Freeny I* does not discuss transmission of digital audio or digital video signals from a first memory to a second memory, let alone the sale of such digital video or digital audio signals. Thus, *Freeny I* bears no relation to the disclosure of *Bush* or the invention recited in Claims 1 through 6 and 44 through 49. The Office apparently has recognized this deficiency in *Freeny I*, because the Office must cite to *Cohen* to show motivation to combine *Bush* and *Freeny I*. However, as set forth above, *Cohen* is not available as prior art based on the priority date of June 13, 1988 for the '573 Patent.

The Supreme Court's recent holding in *KSR Int'L Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (U.S. 2007), does not relieve the Office of the obligation to show motivation to combine two separate references in making out a *prima facie* case of obviousness. Quite to the contrary, the Supreme Court stated: "[t]o determine whether there was an apparent reason to combine the known elements in the way a patent claims, it will often be necessary to look to interrelated teachings of multiple patents; to the effects of demands known to the design community or present in the marketplace; and to the background knowledge possessed by a person having ordinary skill in the art. *To facilitate review, this analysis should be made explicit.*" *KSR*, 127 S. Ct. at 1731 (emphasis added).

Since the Office has not shown any motivation to combine *Bush* and *Freeny I*, a *prima facie* case of obviousness has not been established. Therefore, the Board should reverse this rejection.

**B. Rejection Of Claims 1 Through 6 And 44 Through 49 Under 35 U.S.C. § 103(a)  
Over *Akashi* In View Of *Freeny II***

Claims 1 through 6 and 44 through 49 have been rejected over Japanese Patent Application No. 62-284496 (*Akashi*) in view of U.S. Patent 4,528,643 to Freeny (*Freeny II*). Such a rejection is unfounded. First, the combination of *Akashi* and *Freeny II* would not reach the presently claimed invention. Second, there is no motivation to combine *Akashi* and *Freeny II*.

The Office asserts that *Akashi* shows a system for transmitting recorded music from a host computer that stores recorded music data to a personal computer. The Office then asserts that *Akashi* “does not expressly detail...whether the data is stored on a non-volatile portion of a second memory that is not a tape or CD.” This is incorrect. *Akashi* explicitly discloses a record reproducing device that is a compact disk deck or a digital audio tape recorder. See *Akashi* Translation, p. 2 (Embodiment). In other words, *Akashi* is not ambiguous at all on this point. Thus, not only does *Akashi* fail to disclose transmitting digital audio signals or digital video signals from a first memory to a second memory and storing the digital audio signals or digital video signals in a non-volatile portion of the second memory that is not a tape or CD, *Akashi* expressly teaches away by specifically disclosing and requiring a tape recorder or CD deck.

The Office asserts the deficiencies of *Akashi* are cured by *Freeny II*. Specifically, the Office asserts that *Freeny II* discloses transmitting digital audio signals or digital video signals from a first memory in control and possession of a first party to a second memory in control and possession of a second party, and storing the digital audio signals or digital video signals in a non-volatile storage that is not a tape or CD. The Office further asserts it would have been obvious to implement the non-volatile storage of *Freeny II* in the system of *Akashi* because “[t]he use of a hard disk would have allowed the user to more efficiently access audio and video

files.” The Office bases its position on the conclusion that “a hard-disk, would have also increased the security and reliability of the stored data.”

For several reasons, it would not have been obvious to combine the teachings of *Akashi* and *Freeny II* to arrive at the invention recited in Claims 1 through 6 and 44 through 49. First, *Freeny II* discloses a kiosk-type system for producing “material objects” at a point of sale location where it is the “material object” that is sold to consumers. *Freeny II*, Abstract. Thus, like *Akashi*, *Freeny II* expressly teaches away from storing digital audio signals or digital video signals on a non-volatile storage portion of a second memory that is not a tape or CD in possession and control of a second party. Further, in *Freeny II*, the second memory (information manufacturing machine) for storing the information that is transformed into material objects is in possession and control of the first party. The first party controls access to the information on the second memory by requiring a fee to be paid for the consumer (second party) to access the information stored on the second memory. After the fee is paid, the second party has limited access to the specific information requested for the purpose of making a copy in the form of a material object. In the case of audio or video information, the material object would be in the form of a tape or CD. Therefore, again, both *Akashi* and *Freeny II* contemplate and require supplying audio information to the consumer in the form of a tape or CD. Thus, like *Akashi*, *Freeny II* expressly teaches away from storing digital audio signals or digital video signals on non-volatile storage portion of a second memory that is not a tape or CD in possession and control of a second party.

Additionally, in *Freeny II*, the necessary material object containing the digital audio or digital video signals is produced by accessing information stored on the second memory. The first memory (information control machine) simply supplies reproduction authorization codes in

response to a request for reproduction from the information manufacturing machine. The second party never has access to the first memory, as recited in present Claims 2, 5, 45 and 48.

Both *Akashi* and *Freeny II* solve the same problem: providing audio information, and video information in the case of *Freeny II*, to a consumer in the form of a material object, such as a tape or CD. *Akashi* and *Freeny II* solve this common problem in different and unrelated ways. Nonetheless, neither of the references teaches or discloses the benefits of transmitting digital audio signals or digital video signals from a first memory to a second memory and storing those digital audio signals or digital video signals in a non-volatile portion of the second memory that is not a tape or CD, which is in possession and control of a consumer, *i.e.* a second, financially distinct, party. Therefore, the combination of *Akashi* and *Freeny II* does not teach or suggest every limitation of Claims 1 through 6 or 44 through 49. In fact, because both *Akashi* and *Freeny II* expressly require storing digital audio signals or digital video signals on a tape or CD, they teach away from the invention recited in Claims 1 through 6 and 44 through 49. “[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.” *KSR*, 127 S. Ct. at 1740. As a result, these references cannot be combined to render Claims 1 through 6 obvious.

Even if the combination of *Akashi* and *Freeny II* did teach each and every element of Claims 1 through 6 or 44 through 49 – which they do not – the motivations cited by the Office for combining and/or modifying *Akashi* and *Freeny II* are not found in those references. Moreover, the Office has not cited to any other references or knowledge available to one of ordinary skill in the art in 1988 that would have motivated a skilled artisan to combine and/or modify *Akashi* and *Freeny II* as suggested by the Office. Rather, the Office simply has made vague statements that the security and reliability of hard disks would have been well known at

the time. Such general allegations are insufficient to show motivation to combine these references, particularly since neither one of them even hints at such a modified combination. Again, as the Supreme Court has just admonished: “[a] patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art.” *KSR*, 127 S. Ct. at 1731.

Based on all of the foregoing, the Office has not established a *prima facie* case of obviousness of Claims 1 through 6 and 44 through 49 over the combination of *Akashi* and *Freeny II*. Therefore, the Board should reverse this rejection.

**C. The Secondary Considerations Of Non-Obviousness Support The Finding Of Non-Obviousness Of Claims 1 Through 6 And 44 Through 49**

Although a showing of secondary considerations is not strictly necessary to establish the non-obviousness of Appellant’s invention, such secondary considerations in fact do exist.

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. *Ex parte Remark*, 15 U.S.P.Q.2d 1498, 1502 (Bd. Pat. App. & Interfer. 1990). 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 Co. 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 Int'l Inc., v. AMF, Inc.*, 782 F.2d 995, 1000 (Fed. Cir. 1986).

The invention recited in Claims 1-6 (and Claims 44-49) 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. The invention has in the past achieved significant commercial success. *See, e.g.*, Declaration of Arthur R. Hair submitted with Appellant’s Response dated December 27, 2005.

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 (and Claims 44-49) 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](http://www.napster.com) is a commercially successful system that embodies the features of the claimed invention. The Declaration of Justin Douglas Tygar, Ph.D. (“Tygar Dec. 2005”), a copy of which is filed herewith, supports the assertion that Napster is commercially successful and has copied the claimed invention.

Dr. Tygar determined that Napster has achieved a level of commercial success. *See Tygar Dec. 2005*, 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. 2005*, para. 10. The buyer using Napster has a computer at a home, office, or other location remote from Napster. *See Tygar Dec. 2005*, 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. 2005, 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. 2005, para. 19.*

Additionally, Napster *does not* copy the alleged 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. *See Tygar Dec. 2005, 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 operates. *See Tygar Dec. 2005, para. 18.*

Therefore, it is apparent that Napster chose to copy the system taught by the '573 patent. *See Tygar Dec. 2005, para. 19.* It is also apparent that Napster chose *not* to copy the prior art systems of *Freeny* and *Akashi.* *See Tygar Dec. 2005, para. 20 and 21.* This selective copying by Napster of the invention recited in Claims 1-6 (and Claims 44-49), while Napster ignored the systems of *Freeny* and *Akashi,* provides a sound basis upon which the required nexus between commercial success and Appellant's claimed invention can be found. *See Hughes Tool, 816 F.2d at 1556.* Additionally, Napster's selective copying of Appellant's invention, coupled with Napster's disregard of the *Freeny* and *Akashi* systems, is itself substantive evidence of a

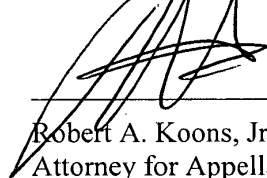
recognized secondary indication of non-obviousness. See *Windsurfing International Inc.*, 782 F.2d 995 (Fed. Cir. 1986).

The foregoing remarks and the Declaration of Dr. Tygar establish the requisite nexus between the commercial success of Napster and Appellant's claimed invention. These remarks and the Declaration of Dr. Tygar similarly have established copying by Napster as a secondary indicia of non-obviousness.

**Conclusion**

Based on the foregoing, the Board should reverse the rejections of Claims 1 through 6 and 44 through 49 under 35 U.S.C. §§ 102(e) and 103(a). Also based on the foregoing, the Board should reverse the rejection of Claims 1 through 6 and 44 through 49 under 35 U.S.C. § 112, first paragraph.

Respectfully submitted,



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**Date: December 15, 2008**

CLAIMS APPENDIX

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 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; connecting electronically via a telecommunications line the first memory with the second memory such that the desired digital audio signal can pass there-between; 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 CD.

2.(Original) 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.(Original) 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.(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 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 there-between; 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.

5.(Original) 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.(Original) 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.

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.



**EVIDENCE APPENDIX**

- 1) Declaration under 37 C.F.R. § 1.132 of Arthur R. Hair, submitted by Appellant in a response dated December 27, 2005 (and again in a response dated February 6, 2006). The Declaration was repeatedly cited on pages 20 to 23 of the February 6, 2006 response to support the argument for secondary considerations of non-obviousness, including copying and commercial success. A copy of the Declaration was included in the response as an exhibit. The Examiner, in an Office Action dated March 20, 2006, considered the Declaration stating on page 5, “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.” Because (a) Appellant’s response having the Declaration attached was entered into the record, (b) Appellant’s commercial success argument was predicated in substantial part on the Declaration, and (c) the Examiner stated he considered the commercial success arguments, it is apparent that the Declaration was considered and entered.
- 2) Declaration under 37 C.F.R. § 1.132 of Dr. J. Douglas Tygar, submitted by Appellant in a response dated December 27, 2005 (and again in a response dated February 6, 2006). The Declaration was repeatedly cited on pages 20 to 23 of the February 6, 2006 response to support the argument for secondary considerations of non-obviousness, including copying and commercial success. A copy of the Declaration was included in the response as an exhibit. The Examiner, in an Office Action dated March 20, 2006, considered the Declaration stating on page 5, “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.” Because (a) Appellant’s response having the Declaration attached was entered into the record, (b) Appellant’s commercial success argument was predicated in substantial part on the Declaration, and (c) the Examiner stated he considered the commercial success arguments, it is apparent that the Declaration was considered and entered.

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  
Patent Number: 5,191,573 ) DESIRED DIGITAL VIDEO OR  
Examiner: Benjamin E. Lanier ) AUDIO SIGNALS  
Pittsburgh, Pennsylvania 15213  
December 23, 2005

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

DECLARATION UNDER 37 C.F.R. §1.132

I, Arthur R. Hair, hereby declare that:

1. I am the sole inventor of United States Patent Nos. 5,191,573; 5,675,734; and 5,966,440.
2. I am Chairman of the Board and Chief Technology Officer of SightSound Technologies, Inc.
3. I assigned my rights in United States Patent Nos. 5,191,573; 5,675,734; and 5,966,440 to the company that ultimately became SightSound Technologies, Inc ("SightSound").  
These patents served SightSound Technologies well and were essential in raising the

capital necessary to launch a company that would build eCommerce systems protected by the patents.

4. With the foregoing three patents in hand, SightSound Technologies achieved many notable firsts, including:
  - first to electronically sell a music download via the Internet;
  - first to electronically sell a movie download via the Internet;
  - first to produce a motion picture specifically for simultaneous electronic distribution worldwide via the Internet;
  - first to electronically sell encrypted movies legally through the Gnutella file-sharing networks, without being in violation of copyrights;
  - first to develop a legal system to sell encrypted music legally through the Napster file-sharing networks, without being in violation of copyrights;
  - first to electronically sell a movie into a movie theater projection booth via the Internet for digital exhibition from a windows workstation; and
  - first to electronically sell a movie into a handheld unit, a Compaq iPac Pocket PC.
  
5. SightSound built five Media eCommerce Systems. Over time, these systems grew from a single server located in Pittsburgh to a geographically distributed system with a central core in Pittsburgh that controlled remote servers located in New York, Los Angeles, Santa Clara, Seattle, Chicago, Washington D.C. and Boston. Version 1 was built in 1995

and Version 2 was built in 1998, both of these versions only sold music. Version 3.1, 3.2 and 3.3 were built between 1999 and 2001 and sold both music and movies. The fifth system built at SightSound Technologies (which we called Version 3.3) was a fully automated, database driven secure Media eCommerce System that had the hardware capacity to rent and/or sell 380,000 movies a day.

6. The foregoing Media eCommerce Systems were covered by one or more claims in each of United States Patent Nos. 5,141,573, 5,675,734 and 5,966,440.

7. The Media eCommerce Systems were designed to support:

- official movie websites;
- banner ads that automatically invoke a download;
- digital cinema (download to the projection booth);
- portable audio/video devices
- database driven websites; and
- peer-to-peer file-sharing networks.

8. Using its Media eCommerce Systems, SightSound Technologies provided client services releasing motion pictures and music for Internet download sale for more than 40 filmmakers, special interest video production companies and recording artists.

SightSound Technologies first offered music for sale via the Internet in download fashion in September 1995. At that time, SightSound Technologies offered music from the band

“The Gathering Field.” Individual songs were priced at 99 cents and the entire album was available for \$6.00. SightSound Technologies went on to build a respectable client roster that included over 65 companies and individuals, including:

- Miramax Films (a subsidiary of the Walt Disney Company)
- Showtime Networks (the Tyson –vs– Norris boxing match)
- Comedy Central (half owned by Fox and half owned by Warner Brothers)
- Lyric Studios (the children’s television program “Barney”)
- WQED TV

9. I have attached as part of this Declaration several announcements and media coverage illustrating the many accomplishments that United States Patent Nos. 5,191,573; 5,675,734; and 5,966,440 assisted SightSound Technologies to achieve.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

23 DECEMBER 2005  
Date

Arthur R. Hair  
Arthur R. Hair

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	)	A SYSTEM FOR TRANSMITTING
	)	DESIRED DIGITAL VIDEO OR
Patent Number: 5,191,573	)	AUDIO SIGNALS
	)	
Examiner: Benjamin E. Lanier		

December 23, 2005

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

DECLARATION UNDER 37 C.F.R. §1.132

I, Justin Douglas Tygar, hereby declare that:

1. I am a tenured, full Professor at the University of California, Berkeley with a joint appointment in the Department of Electrical Engineering and Computer Science (Computer Science Division) and the School of Information Management and Systems.
  
2. I earned an A.B. degree in Math/Computer Science from the University of California, Berkeley, in 1982 and I earned a Ph.D. in Computer Science from Harvard University in 1986.
  
3. I am an expert in software engineering, computer security, and cryptography. I have taught courses in software engineering and computer security at the

undergraduate, master's, and doctorate level at both the University of California, Berkeley and Carnegie Mellon University.

4. I serve in a number of capacities on government, academic, and industrial committees that give advice or set standards in security and electronic commerce. In addition, I have authored numerous publications in the fields of computer science and security in electronic commerce. I have attached a copy of a recent curriculum vita to this declaration as Exhibit A.

5. At the request of counsel, I have compared a currently available system for purchasing digital audio files, namely the online music service offered at [www.napster.com](http://www.napster.com) known as Napster Light<sup>1</sup> (hereinafter "Napster Light"), with the teachings of U.S. Patent 5,191,573 (the "'573 patent").

6. Napster Light is a currently operating service with an apparently wide user base. It is therefore apparent that Napster Light, which uses the teachings of the '734 Patent, has been commercially successful.

7. The '573 Patent generally discloses a method pertaining to the electronic sale and transfer of digital audio or video signals, which are signals containing recorded sound or

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<sup>1</sup> It should be noted that the Napster Light service offered by the entity known currently as Napster, Inc. at [www.napster.com](http://www.napster.com) is separate and distinct from a previous file sharing on-line service offered by an earlier entity entitled Napster. It is my understanding that this prior entity went out of business in 2002, at which time Roxio, Inc. acquired the Napster name and trademark rights. Subsequently, Roxio, Inc. changed their name to Napster, Inc., thus creating the current entity referred to herein as "the new Napster, Inc."



video, such as a musical or video recording, converted into binary form. The steps of the method pertain to the following:

- A first party who is a seller of digital audio or video signals through telecommunication lines. Telecommunication lines can include the Internet. The seller must have control over a computer memory, which includes a hard disk and RAM. The hard disk includes copies of encoded digital audio or video signals, which are the digital audio or video signals configured in a form that would prevent unauthorized copying.

- A second party who is a buyer of the digital audio or video signals. The buyer must possess and control his or her own computer memory. The buyer's memory must be located at a location remote from the location of the memory controlled by the seller.

8. The invention of the '573 patent comprises a number of steps, though not in any particular order except as indicated below. The steps are:

- Forming an end-to-end electronic connection over the telecommunications lines between the computer memory controlled by the seller and the buyer's computer memory, which is controlled by the buyer;

- Transmitting the desired digital audio signal from the first memory to the second memory; and

- Storing the transferred copy of the digital audio or video signals in the buyer's memory.

9. I have accessed Napster Light for the purpose of comparing it to the '734 patent. Based on my review, I have determined the following facts set forth in paragraphs 10 through 20 of this declaration.

10. The operator of Napster Light (i.e., the new Napster, Inc.), the "first party" for the purposes of this comparison, operates a music download system through which digital music files are sold to buyers for download over the internet. The digital music files contain digital representations of sound recordings. I have concluded from viewing information on [www.napster.com](http://www.napster.com) that Napster Light uses a system that includes servers, which have memory that includes hard disks that store digital music for sale over the internet. The new Napster, Inc. appears to control the servers that contain the digital music files for sale.

11. The typical online buyer using Napster Light, the "second party" for the purposes of this comparison, controls a personal computer. For instance, the buyer controls which software to install and run on the computer, what data to store in the computer, and when to operate the computer. The buyer has the computer at a home, office, or other location remote from Napster Light.

12. Using a software application downloaded from a website associated with Napster Light, the online buyer may connect to Napster Light's online music library over the Internet and browse online music catalogs. The buyer forms a connection between his or her computer and the Internet through an Internet Service Provider (ISP) that may be accessed via a dial-up connection using a modem and a telephone line.

13. Using the downloaded software application, the online buyer browses Napster Light's online music catalogs. The online buyer can select a particular digital music file he or she desires.

14. The digital music file is delivered to the online buyer via a download operation that is automatically initiated between Napster Light's servers and the online buyer's computer.

15. The download process occurs by transmitting a copy of the digital music file over the Internet to the online buyer's computer. The transmitted copy is stored in the online buyer's computer hard drive. Throughout this downloading process, the online buyer is in control of his or her computer's memory.

16. The downloaded copy of the digital music is stored to the hard drive of the buyer's computer, from which it can be written to other media such as an optical disk or memory of a portable device.

17. Napster Light does not include a point-of-sale device such as a kiosk, as used in United States Patent No. 4,528,643 to Freeny (the "Freeny Patent").

18. Napster Light does not writing a digital signal from memory directly to an optical disk or digital tape, as taught in Japanese Patent Publication 62-284496 to Akashi (the "Akashi Patent").

19. In view of the foregoing, I have determined that Napster Light embodies the elements taught in the '573 Patent. As a result, it can be concluded that Napster Light has copied the teachings of the '573 Patent.

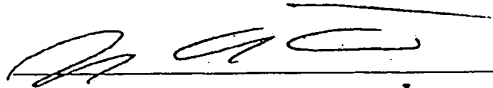
20. Also in view of the foregoing, I have determined that the Napster system does not embody essential elements of the Freeny patent. As a result, it can be concluded that Napster Light has not copied the Freeny patent.

21. Also in view of the foregoing, I have determined that the Napster system does not embody essential elements of the Akashi patent. As a result, it can be concluded that Napster Light has not copied the Akashi patent.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

26 Dec 05

Date



Justin Douglas Tygar, Ph.D.

**RELATED PROCEEDINGS APPENDIX**

- 1) *Sightsound.com Inc. v. N2K, Inc.*, 2:98-cv-00118-DWA (W.D. Pa).  
-“Magistrate Judge’s Report and Recommendation” dated February 8, 2002
  
- 2) *Sightsound Technologies, Inc. v. ROXIO, Inc.*, 2:04-cv-01549-DWA (W.D. Pa).  
- “Memorandum Order and Opinion” dated February 28, 2005, granting Defendants’  
motion to stay
  
- 3) Appeal from final rejection in copending reexamination Control No. 90/007,403.
  
- 4) Appeal from final rejection in copending reexamination Control No. 90/007,407.

IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF PENNSYLVANIA

SIGHTSOUND.COM INCORPORATED,	)
a Pennsylvania Corporation,	)
	)
Plaintiff,	)
	)
v.	)
	)
NSK, INC., a Delaware	)
corporation, CDNOW, INC.,	)
a Pennsylvania Corporation,	)
and CDNOW ONLINE, INC.,	)
a Pennsylvania Corporation,	)
	)
Defendants.	)

Civil Action No. 98-118  
JUDGE DONALD J. LEE  
MAGISTRATE JUDGE BENSON

MAGISTRATE JUDGE'S REPORT AND RECOMMENDATION

I. RECOMMENDATION

It is respectfully recommended that the claims in suit be interpreted as set forth in more detail in the following report.

II. REPORT

This is a patent infringement action filed by the holder of three patents which, as described by plaintiff, "are directed to commercially-acceptable systems and methods for selling music and video in digital form over telecommunications lines." (Docket #69 at 1). Plaintiff, Sightsound.com, Inc. ("Sightsound") accuses defendants N2K, Inc. ("N2K"), CDnow, Inc., and CDnow Online, Inc. (collectively referred to as "CDnow" or "defendants") of infringing multiple claims of U.S. Patent Nos. 5,191,573 ("the '573 Patent"), 5,675,734 ("the '734 Patent"), and 5,966,440 ("the '440 Patent")

through the practice of downloading digital music over the internet.<sup>1</sup>

In view of the numerous claims which have allegedly been infringed, the court encouraged the parties to narrow issues by agreeing, where possible, to interpretations of various claims in the patents. After the parties engaged in this process, however, many disputes remained concerning claim interpretation<sup>2</sup>. Hence, the court scheduled a Markman hearing, and the parties filed claim construction briefs (Docket #s 65, 69 and 75), a joint compilation of exhibits (Docket #s 70-72), and expert reports and declarations filed independently (Docket #s ). A hearing was held before the undersigned on April 18, 19, 20 and May 16, 2001, at which expert testimony, demonstrative evidence, exhibits and argument were offered by the parties (Docket #s 93-96). The undersigned has

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1. Of course, the court is not concerned with the accused product or practice at this point. Claim construction is accomplished "independent of the accused product." Embrix, Inc. v. Service Engineering Corp., 216 F.3d 1343, 1347 (Fed. Cir. 2000); Union Oil Company of California v. Atlantic Richfield Co., 208 F.3d 989, 994 (Fed.Cir. 2000).

2. Plaintiff initially asserted a total of thirty-nine (39) claims which contain thirty-four (34) instances of disputed claim language. The claims-in-suit are claims 1-3 of the '573 patent, claims 1-8, 10-14, and 26-27 of the '734 patent, and claims 1-10, 12-15, 22, and 36-41 of the '440 patent. Plaintiff also seeks to assert claim 11 of the '440 patent, and defendants challenge this on the basis that it was added just prior to the briefing prior the hearing (Docket #75 at 17-18). While the undersigned agrees that claim 11 was submitted late in the day, the terms used therein are not unique. Hence, for purposes of claim construction, no new burden is imposed for the parties or the court by including claim 11 at this stage. The question of the propriety of this claim being considered by the court in ruling on the ultimate issue shall be held in abeyance.



considered all of the briefs, exhibits, testimony and argument submitted. The following conclusions of law are recommended.

1. THE LAW OF CLAIM CONSTRUCTION

Construction of patent claims is a matter exclusively within the province of the court, and is a determination made as a matter of law. Markman v. Westview Instruments, Inc., 517 U.S. 370, 372 (1996); Interactive Gift Express, Inc. v. Compuserve, Inc., 231 F.3d 859, 865 (Fed.Cir. 2000); Markman v. Westview Instruments, Inc., 52 F.3d 967, 979 (Fed. Cir. 1995). In making this determination, "the viewing glass through which the claims are construed is that of a person skilled in the art." Interactive Gift, 231 F.3d at 866.

A. INTRINSIC EVIDENCE

Intrinsic evidence is the most important source of information in construing the language used in a patent. Vitronics Corporation v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir. 1996). "Intrinsic" evidence consists of the claim language, the specification and the prosecution history. Id.; Markman, 52 F.3d at 979. "In construing claims, the analytical focus must begin and remain centered on the language of the claims themselves, for it is that language that the patentee chose to use to 'particularly point[] out and distinctly claim[] the subject matter which the patentee regards as his invention.' 35 U.S.C. §112, ¶2." Interactive Gift, 231 F.3d at 865.

The purpose of a patent is to secure to the patentee "all to which he is entitled" while "appris[ing] the public of what is still open to them." Markman, 517 U.S. at 373. In construing the scope and meaning of a claim, terms used in the claim are to be given their ordinary meaning to one skilled in the art unless it appears from the patent and file history that the terms were used differently by the inventor. Id.; Intellicall, supra; Phillips Electronics v. Universal Electronics, Inc., 930 F.Supp. 986, 997 (D.Del. 1996). Thus, the court must first look to the language of the patent claim. "If the claim language is clear on its face, then [the court's] consideration of the rest of the intrinsic evidence is restricted to determining if a deviation from the clear language of the claim is specified." Interactive Gift, 231 F.3d at 865. A patentee, after all, may "choose to be his own lexicographer and use terms in a manner other than their ordinary meaning." Vitrionics, 90 F.3d at 1582.

The court may also find that a deviation from the plain meaning of the terms used in a patent claim is warranted because the patentee, in amending a claim before the PTO or in arguing to distinguish a reference to prior art, has relinquished part of what would normally be included within a claim's plain meaning. Interactive Gift, 231 F.3d at 865, quoting Elkay Manufacturing Co. v. Ebco Manufacturing Co., 192 F.3d 973, 976 (Fed.Cir. 1999). Hence, "[i]f a patentee takes a position before the PTO, such that a 'competitor would reasonably believe that the applicant had surrendered the relevant subject matter,' the patentee may be barred

from asserting an inconsistent position on claim construction." Katz v. AT&T Corp., 63 F.Supp.2d 583, 591 (E.D.Pa. 1999). This does not mean, however, that every amendment, or every attempt by an applicant during the application process to distinguish prior art, automatically results in a corresponding limitation during claim construction. "Unless altering claim language to escape an examiner rejection, a patent applicant only limits claims during prosecution by clearly disavowing claim coverage." York Products, Inc. v. Central Tractor Farm & Family Center, 99 F.3d 1568, 1575 (Fed.Cir. 1996).

Further, although the specification may be "the single best guide to the meaning of a disputed term." Vitrionics, 90 F.3d at 1582, the court must be careful to use the specification to ascertain the meaning of disputed claim term, and not merely to impose a limit on a claim term. Interactive Gift, 231 F.3d at 865-66; citing Comark Communications, Inc. v. Harris Corp., 156 F.3d 1182, 1186 (Fed.Cir. 1998) ("fine line" exists between "reading a claim in light of the specification" and impermissible practice of "reading a limitation into the claim from the specification.").

#### B. EXTRINSIC EVIDENCE

"In most situations, an analysis of the intrinsic evidence alone will resolve any ambiguity in a disputed claim term. In such circumstances, it is improper to rely on extrinsic evidence." Id., 90 F.3d at 1583. In cases where the scope of the invention is described unambiguously by the intrinsic evidence, it is improper to

consider extrinsic evidence. Id. The public is entitled to rely upon the "public record" of the invention, i.e., the claims, the specification and the file history. Id., citing Markman, 52 F.3d at 978-79. "Allowing the public record to be altered or changed by extrinsic evidence introduced at trial, such as expert testimony, would make this right meaningless." Vitrionics, 90 F.3d at 1583. This same limitation applies whether it is the alleged infringer or the patentee who seeks to alter the scope of the claims. Id.

"Only if there were still some genuine ambiguity in the claims, after review of all available intrinsic evidence, should the trial court have resorted to extrinsic evidence, such as expert testimony . . . ." Vitrionics, 90 F.3d at 1584. Further, even if expert testimony is accepted and properly considered, it should be afforded no weight if it is inconsistent with the specification and file history. Id. Likewise, the inventor's subjective intent, if not expressed in the patent documents, is not entitled to any weight. Id.

In fact, a preferred type of extrinsic evidence, useful to demonstrate how a particular term is used by those skilled in the art, ~~is a prior art reference, whether or not that reference is~~ cited in the specification or file history. Vitrionics, 90 F.3d at 1584. Again, however, consideration of such extrinsic evidence is "unnecessary, indeed improper, when the disputed terms can be understood from a careful reading of the public record." Id.

This does not mean that extrinsic evidence ought never to be considered. On the contrary, extrinsic evidence may be

appropriate for a purpose other than clarifying ambiguous language in the patent:

A judge is not usually a person conversant in the particular technical art involved and is not the hypothetical person skilled in the art to whom a patent is addressed. Extrinsic evidence, therefore, may be necessary to inform the court about the language in which the patent is written. But this evidence is not for the purpose of clarifying ambiguity in claim terminology. It is not ambiguity in the document that creates the need for extrinsic evidence but rather unfamiliarity of the court with the terminology of the art to which the patent is addressed.

Markman, 52 F.3d at 986.<sup>3</sup> The court may, then, and in this instance, did, resort to extrinsic evidence for the purpose of determining "what one of ordinary skill in the art at the time of the invention would have understood [a particular] term to mean." Id.; see also, Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1309 (Fed.Cir. 1999). Technical treatises and dictionaries, although extrinsic evidence, may be consulted "at any time in order to better understand the underlying technology . . . ." Vitrionics, 90 F.3d at 1584. Dictionary definitions may be used by the court "when construing claim terms, so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents." Id.

3. Indeed, as one who felt (and still feels) uncomfortable with the technology of the 20<sup>th</sup> Century, and who will undoubtedly feel increasingly so with the technology of the present century, this explanation from the Court of Appeals in Markman is particularly trenchant.

C. MEANS-PLUS-FUNCTION CLAIMS

Also relevant to the construction of the claims at issue in this case is the "means-plus-function" format of stating patent claims:

An element in a claim for a combination may be expressed as a means of step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

35 U.S.C. §112, ¶6 (1994). "This provision of the patent statute permits a patentee to write a limitation in a combination claim as a means for performing a function without reciting structure, materials or acts in the limitation." Katz, 63 F.Supp.2d at 592. When interpreting a claim written in the "means-plus-function" format, the court must construe the functional language of the claim "to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." 35 U.S.C. §112; Valmont Industries, Inc. v. Reinke Manufacturing Co., Inc., 983 F.2d 1039, 1042 (Fed. Cir. 1993). The patentee, however, must describe in the specification some structure which performs the specified function. Id., at 1042.

In determining whether to apply the statutory procedures of section 112, ¶ 6, the use of the word "means" triggers a presumption that the inventor used this term advisedly to invoke the statutory mandates for means-plus-function clauses. 35 U.S.C. § 112, ¶ 6 (1994); see Greenburg v. Ethicon Endo-Surgery, Inc., 91 F.3d 1580, 1584, 39 USPQ2d 1783, 1787 (Fed. Cir. 1996). Nonetheless, mere incantation of the word "means" in a clause reciting predominantly structure cannot evoke section 112, ¶ 6. [citations omitted]. Conversely, "[t]he

recitation of some structure in a means plus function element does not preclude the applicability of section 112(6)." Laitrim Corp. v. Rexnord, Inc., 939 F.2d 1533, 1536, 10 USPQ2d 1367, 1369 (Fed. Cir. 1991).

York Products, Inc. V. Central Tractor, 99 F.3d 1568, 1574 (Fed. Cir. 1996). Thus, "[t]o invoke this statute, the alleged means-plus-function claim element must not recite a definite structure which performs the described function." Cole v. Kimberly-Clark Corp., 102 F.3d 524, 531 (Fed. Cir. 1996). The court must "decide on an element-by-element basis, based upon the patent and its prosecution history, whether § 112, ¶ 6 applies." Id.

Once having decided that the means-plus-function analysis applies, the court should: (1) determine what function the means performs, and (2) find in the claim language a link between the means and the function. Katz, 63 F.Supp.2d at 593. The specification is next considered, and the court "must determine what structure, material or acts . . . correspond to the word 'means.'" Id., citing Chiuminatta Concrete Concepts, Inc. v. Cardinal Industries, Inc., 145 F.3d 1303, 1308 (Fed.Cir. 1998). There is no specific level of detail necessary in the description of structure, so long as one skilled in the art would identify the structure from the description. Atmel Corp. v. Information Storage Devices, Inc., 198 F.3d 1374, 1381 (Fed.Cir. 1999).

2. SUMMARY OF THE EVIDENCE

A. BACKGROUND AND CLAIM LANGUAGE

The patents-in-suit stem from a patent application initially filed with the United States Patent and Trademark Office (USPTO) in June, 1988. In fact, the '734 and '440 patents are "continuations" of the '573 patent, disclosing additional inventions arising from the original invention. Unsurprisingly, therefore, the patent specifications for the '734 and '440 patents mirror the patent specification for the '573 patent.

The patents each address a "system and associated method for the electronic sales and distribution of digital audio or digital video signals, and more particularly, to a system and method which a user may purchase and receive digital audio or digital video signals from any location which the user has access to telecommunications lines." (Docket #70, Exhibit 51 at 1).

In its first claim, the '573 patent discloses a four-step method of transmitting a digital audio or video signal including steps addressed to: (1) transferring money electronically; (2) connecting two "memories" by telecommunications lines so that a signal can be transmitted from the first to the second; (3) transmitting the signal; and (4) storing the digital signal in the second memory. Claim 2 is a dependent claim, building on the first claim by adding the step of searching for and selecting a desired digital signal from the first memory. Step 3 is, in turn, dependent on claims 1 and 2, and discloses additional steps in transferring money, specifically the steps of telephoning the first party and



providing the second party's credit card number "so the second party is charged money."<sup>4</sup>

The '734 patent, which has claims 1-8, 10-14, and 26-27 in suit, discloses in claim 1 the same basic invention as was disclosed in the '573 patent, but with the addition of steps involving the use of a "hard disk" and "sales random access memory" by the selling party, and "electronic coding" of the signal to prevent unauthorized copying thereof. Claim 2 adds the use of a "second party integrated circuit" and a "control panel" to execute commands during the process described in Claim 1. Claim 3 describes an "incoming random access memory chip" in the buyer's possession which temporarily stores the incoming digital signal until it is transferred to the buyer's hard disk. Claims 4-8 describe the use of a "control integrated circuit" in this process, and claims 10-14 describe the use of "telephone lines" as a type of "telecommunications lines" in the invention disclosed in Claim 4. Claims 26 and 27 summarize much of the preceding claims, and disclose a "means or mechanism for the first party to charge a fee to the second party remote from the second party location."

The '440 patent has sixty-three (63) claims, of which 1-15, 22, and 36-41 are at issue. Again, the claims set forth a method for transferring digital audio or digital video signals, but also disclose methods for playing such digital signals on an integrated system used by the second party.

4. The remaining claims of the '573 patent are not asserted in this suit.

The actual language of a claim is the key consideration in any construction of a patent; that language is not reproduced as an attachment to this Report, but is set out at length in the text as appropriate. So too, certain intrinsic evidence, the patent specifications and prosecution histories, are set forth in relevant part during the analysis portion of this report.

**B. OTHER EVIDENCE**

Other evidence presented, in the nature of declarations, dictionary definitions, expert testimony, etc., will, likewise be set forth in relevant part as necessary to discuss particular issues. However, the court will summarize the testimony presented at the hearing from the expert witnesses (which is premised upon declarations earlier submitted by the parties). This testimony has been relied upon by the undersigned to understand the technology underlying the patents-in-suit, and to determine the level of education and experience which would define "one skilled in the art" in this case. The court will also indicate during the analysis portion which, if any, of the extrinsic evidence has been considered as relevant to the construction of particular claims.

**1. Dr. Tygar**

Justin Douglas Tygar, Ph.D., testified as an expert on behalf of plaintiff (Docket #95 at 4-41). Dr. Tygar is a professor at the University of California at Berkeley in the department of electrical engineering and computer science (*Id.*, at 4). He works in the area of software engineering, computer security and

electronic commerce (Id., at 5). He has also "had occasion" to work with digital audio (Id.). Dr. Tygar is a senior member of the Institute of Electrical and Electronic Engineers (IEEE) (Id.).

Dr. Tygar explained the process of recording sound both by analog and digital means. He explained that a "digital converter" takes an analog representation of a sound wave, samples it at many, many points, measures the signal at each sampling point, representing the measurements with binary numbers (Id., at 8-9). The reverse process is used to change the digital sound representations back into an analog sound wave through a process of "interpolating" a sound wave between the digital signals. This, in turn, can be played through a speaker to create audible sound waves (Id., at 9).

Digital audio may be stored on a compact disk, and then "read" by a laser. The benefits of this technology are obvious to all, most notably the fact that, unlike vinyl records, CD's, unless damaged, will retain the digital information unchanged indefinitely.

"Compressed" digital audio, whereby the binary representation of a sound wave is made smaller by, for example, ~~eliminating repeated signals, is, in Dr. Tygar's opinion, still~~ digital audio (Id., at 3).

Dr. Tygar also testified that there is a difference between digital sound on one hand, and digital instructions for sound on the other. He compared the MIDI format (for "Music Instrument Digital Interface"), or instructions for sound, with sheet music. The MIDI instructions, which are binary, tell the

computer what sounds to make on an internal synthesizer (Id., at 13-14; Docket #74, Exhibit B at 5-8). He contrasted this with a sound wave represented digitally, which, although also stored in binary, permits a computer program to reproduce a sound wave which has been recorded. One of the differences between MIDI and digital sound is that vocals cannot be faithfully represented in MIDI format, while digital sound has no such limitations (Docket #95 at 15). MIDI, although versatile, is, in Dr. Tygar's opinion, simply a series of on/off commands (Id., at 6).

Dr. Tygar also testified concerning the advantages inherent in sending digital music from one computer to another (Id., at 17). There is no need for packaging, no stock problems, low overhead, and presents an easier way to find and keep in storage various types of music (Id., at 17-18).

Part of Dr. Tygar's expert report is also addressed to the nature of telecommunications systems (Docket #74, Exhibit B at 8-14). He testified that about 80% of households have a "direct link" to a telecommunication provider's "central office" (Docket #95 at 18). Although the connection between a private home and a central office is now, and was in 1988, likely to be copper wire carrying electric impulses, the telephone network is mostly digital from the central office until the individual communication reaches the other party's copper lines (Id., at 19). Hence, in 1988, as today, a telephone call could proceed entirely through copper wire as electric impulses, it could be changed into light impulses and travel through fiber optic cable, and it could also travel as radio

waves, or a combination of all three types (Id., at 20). Today, most telecommunications links are established through the fiber optic "backbone network" used by all telecommunications companies (Id., at 19).

There is in the telephone industry a concept known as "multiplexing" which occurs in telephone links. Time Division Multiplexing, or "TDM," occurs when calls are digitized and broken up into segments. These segments are sent in order, with segments from other telephone calls placed in between, then reassembled at the other end (Id., at 21)<sup>5</sup>. In Dr. Tygar's view, this does not create a "continuous physical conduction path" between the person sending and the person receiving a telephone call (Id.).

The Internet uses the same infrastructure as is used by the telephone system, including telephone lines and the fiber optic "backbone" (Id., at 22). There is "end to end connectivity" in an Internet transaction in that the computers at opposite ends of a transmission must establish communication with one another, i.e., a "session." (Id.). On cross-examination, Dr. Tygar conceded that a book he uses in instructing his students provides a definition of "connection" which does not include the Internet, but does include the telephone network (Id., at 37). He believes this to be an error in the text (Id., at 40), and noted when he was recalled as a witness that the same text, at a different point, clearly states

5. For example, if three calls, A, B and C were sent through the TDM process, the segments might share a fiber optic strand in the order ABCABCABCABC. The segments are then reassembled prior to reaching the ultimate destination, AAAA, BBBB, CCCC.

that a type of connection is made over the Internet (Id., at 161), and that the ultimate delivery to the receiving user in an Internet communication is in the same order as it was sent (Id., at 162).

Cell phones use radio waves, and call segments may be "handed off" between cells in a network while the cell phone user is traveling (Id., at 23). This is comparable to the manner in which the Internet uses different means of routing a message, i.e., the path used for different "packets" of information may change.

Dr. Tygar also offered opinions concerning the meaning of various terms in the patent. Briefly, they are that one skilled in the art would not have interpreted the Hair patents (the patents-in-suit, identified by the inventor's name) as covering instructions to produce sound, or MIDI (Id., at 25). Further, the process of compressing or storing digital audio is not in the nature of "computer instructions" (Id., at 27).

Also, the term "telecommunications" as used in the patents-in-suit includes both telephone communications and TCP/IP networks such as the Internet (Id., at 28). Each provides end-to-end connectivity, and uses the same infrastructure (Id., at 29).

~~Further, TDM has many similarities to the packet-switch nature of the Internet (Id.).~~

The term "telephoning" includes both human and machine-initiated calls (Id.).

"Providing payment electronically" can constitute any means of payment which is accomplished over telecommunications lines, such as the buyer providing his or her credit card number, or

the more advanced means of electronic commerce systems now being used on the Internet (Id., at 30).

ii. Professor Larky

Arthur I. Larky, Ph.D., is professor emeritus at Lehigh University where he taught as a tenured professor in electrical engineering and computer science from 1960 until his retirement. (Docket #95 at 44-45; Docket #68). He holds a Ph.D. in electrical engineering (Docket #95 at 47), and has extensive experience teaching the use of computers in the telephone system for Bell Telephone Laboratories from 1962 through 1992 (Id., 47-48). He has also helped design telephone switching systems and performed experimental work for telephone companies (Id., at 49). He was called by the defendants.

Professor Larky reviewed the Hair patents and concluded that one "skilled in the art" for purposes of those patents would be "someone who had a background in computer engineering or a combination of computer engineering and computer programming background and about two years experience in actually doing some things in the field." (Id., at 50-51).

Doctor Larky testified that an integrated circuit (IC) is a microprocessor or the "brains" of a computer (Id., at 53). Random Access Memory (RAM) is the "basic storage unit for programs and data on a computer." (Id., at 54). Although the patent lists "incoming" and "playback" RAM separately, such functions are normally performed by the same "set of chips" in a computer (Id.). The "hard disk" of

a computer is a metal disk which retains information recorded on it until that information is erased (Id., at 55).

Dr. Larky testified that it was common in 1988 to connect two computers directly by means of telephone lines (Id., at 56). One would use the keyboard or the mouse to instruct the computer to make a telephone connection through a modem (Id., at 57-58). Further, there were also, in 1988, services available which would provide computer files for download over telephone lines (Id., at 58). Files which produced audible sounds could also be downloaded in this time frame (Id., at 59).

Professor Larky described the connection made between computers via telephone lines in 1988 as establishing a "direct line connection" in that a wire would connect the computer to the telephone company, and the company would "close the necessary switches" so that the signals reach the other end (Id.). There is, in his view, allowing for the use of fiber optics, "a closed electrical path" from one computer to the other (Id., at 60). The telephone system was using both analog and digital formats in 1988 (Id., at 63).

Important to his discussion of the nature of the connections made is the concept of "conduction path," which has two meanings. The first is an electrical conduction path whereby electrons flow through a wire, and the second denotes a path through which a conversation is conducted, but which is not necessarily purely electrical in nature (Id., at 65).



Dr. Larky also addressed time division multiplexing, or TDM, which, he explained, works because the segments are always in a predetermined order. Hence, the receiving multiplexing equipment parcels the information out in the order in which it is received (Id., at 67-68). Further, each piece of information or segment follows the same path as the first. These segments are not individually "addressed" in any way because they are "in step" and are thus sorted out on the receiving end (Id., at 68, 71). There is also no means for verifying the correct delivery of information (Id., at 72). In Dr. Larky's view, as of 1988, a "solid conduction path" would exist between computers which accessed each other over the telephone system (Id., at 73).

As of 1988, two computers could connect via modem over telephone lines and exchange data (Docket #68 at 7). This is accomplished in "a single, unbroken transmission." Data exchange via a package-switch network occurred in 1988, as it does today, by the "executing computer dividing up data into packets as described by internet protocols, transmitting each packet individually to the second computer by way of network routers. The second computer, after receiving all of the packets, reassembles the data into its original form. During the packet-switch transmission, no "continuous point-to-point conduction path" is established between the computers, and the information is not sent in one unbroken transmission (Id.).

At the hearing, Dr. Larky explained that the information being exchanged in an Internet transmission is broken down into

packets by the sending computer, and that the packets are individually "addressed" so that the particular packet's proper place in order can be identified at the other end of the transmission (Docket #95 at 74). The packets are sent over the telephone system to Internet "nodes," where a computer "looks" at a packet and sends it on to another such node, and so on toward its final destination (Id., at 74). Not all packets from the same transmission necessarily follow the same path (Id., at 75). Also, a particular packet may be detained, with some packets sent later arriving at their destination before packets sent earlier (Id., at 77). A person skilled in the art would have been aware of the existence of the Internet as of 1988 (Id., at 78).

In summary, Dr. Larky indicated that the Internet is connectionless and best-effort and, therefore, inherently less reliable than a telephone connection (Id., at 79). The Internet is "connection-oriented," which means it attempts to do what a connection would do (Id., at 89). He contrasted the use of TDM by the telephone system on the basis that TDM packets are of uniform length, whereas Internet packages are of varying lengths (Id., at 85). A packet used in a switch network has a "checksum" and an "address," consisting of digital information which tells a receiving computer how large the total communication should be, and the ultimate destination, respectively. "Segment" is a term used to identify a TDM bit of information, as opposed to "packet" (Id., at 88).

The Internet operates according to the Transmission Control Protocol and the Internet Protocol ("TCP/IP"), which are part of the Internet Suite of Protocols (Docket #68 at 4). TCP governs how data is broken down into packets, IP governs the routing of the packets, and TCP governs how the packets are recombined (Id.).

On cross-examination, Dr. Larky conceded that connections exist between each router, or on each "leg," of a packet-switch network (Docket #95 at 98-100). In fact, Newton's Telecom Dictionary (Plaintiff's Exhibit A at page 680) states that "TCP first establishes a connection between the two systems that intend to exchange data" (Docket #95 at 102-03). Dr. Larky was also shown a glossary of telecommunications terms from the Federal Standard, marked as Plaintiff's Exhibit B (Id., at 104). There is no date on this exhibit, although there is reference therein to standards adopted in 1994. In that glossary, "telecommunications" is defined as meaning any transmission by wire, radio, optical or other electromagnetic systems (Id.).

Dr. Larky, too, offered an opinion concerning the Hair patents. In his view, one skilled in the art in 1988 would have understood "that the Internet is connectionless" and that "connecting electronically via a telecommunications line" would not apply to Internet communications (Id., at 90). Further, there is no reference to computer networks in the patents or the accompanying papers, and no reference to the Internet or packet-switch networks (Id., at 92).

Dr. Larky also filed a rebuttal declaration (Docket #88) in which he explains that a user of the Internet today normally has a continuous connection with the Internet Service Provider ("ISP") over a telephone line, and that the ISP then "affords access" to the Internet (Id., at 8). There is, however, no "similar connection" formed with the server of the ISP and other routers and servers located on the Internet (Id., at 9).

iii. James A. Moorer, Ph.D.

Also testifying for defendants was James Anderson Moorer, an expert in the field of digital audio signals and digital audio music (Docket #95 at 110-11; Docket #86). He has Bachelor's Degrees in electrical engineering and applied mathematics, and a Ph.D. in computer science (Docket #95 at 113). He has extensive experience with digital audio, including work with Lucasfilm and later for his own firm, Sonic Solutions (Id., at 114). Dr. Moorer has created software which address sound concerns in the film industry (Id., at 114-115), and has published in the area of digital audio, and has taught courses at Stanford University in that field (Id., at 115-16). He built a number of products used in the digital audio field, and composed digital audio music, including the theme played before the feature film in every theater equipped with a THX sound system (Id., at 116-17). He has received numerous awards, including an Emmy and a technical Oscar (Id., at 117).

Dr. Moorer believes one "skilled in the art" for purposes of these patents would possess a degree in engineering or computers.

but that some experience or skill in digital audio or digital music would be necessary as well (Id., at 112).

In 1988, the Pulse Code Modulation ("PCM") format, the format described by Dr. Tygar as a digital representation of a sound wave, would not have been practical in 1988 on account of the size of such files, while MIDI and other formats would have been (Id.). This is because commercially available hard drives at that time were between 10 to 40 megabytes in size for a consumer (Id., at 143), while such hard drives were as large as 85 megabytes for professional applications (Id., at 144). The 85 megabyte size would have allowed for the storage of about 8 minutes of music in PCM format (Id.). To do "thousands" of songs, as referenced in the patents, would have required about 30 gigabytes of storage space, a size not commercially viable for consumers at that time (Id., at 145).

However, thousands of songs could have been stored at that time in MIDI format (Id., at 146). For example, a performance of Beethoven's piano sonata "Für Elise" played for the court in PCM format was 74,000 bytes for 6.7 seconds, while three minutes of the same music in MIDI format was 6,600 bytes (Id., at 148-49). In Dr. Moorer's opinion, MIDI is digital music (Id., at 149), although "[i]n some ways, MIDI operates like the old player pianos, in that it is capable of recording the exact performance without having to record the sounds." (Docket #86 at 10). In fact, he would have chosen MIDI as the commercially viable format in 1988 for the invention disclosed in the patent (Docket #95 at 150).

Further, the CD format in 1988 included both "digitized audio" as well as "music encoded as MIDI data and graphical information as well." (Docket #86 at 3). "Therefore, as of 1988, the complete specification for CD-based audio was not merely sound waves in digital form, but also included instructions of various kinds, optionally including MIDI data." (Id., at 6).

All forms of digital music, MIDI or otherwise, go through a digital to analog converter and then to a speaker (Id., at 121). The audio format for a compact disk was first published in the early 1980's (Id., at 123). One form of representations on a CD is pulse code modulation or PCM (Id.). PCM audio on a compact disk is more than a sound wave converted to binary form (Id., at 124). There are correction codes and instructions which direct the decoding process (Id., at 124-25), as well as instructions which start and stop the individual tracks (Id., at 125). Some CDs in 1988 had MIDI information on them (Id., at 127).

There were forms of digital audio in 1988 other than PCM or MIDI ( Id., at 128; Docket #86 at 5). All of these forms contain some kind of instructions or directions, such as commands to the decoding software and hardware concerning interpretation of the data (Docket #95 at 129). MP3 is another means of digital audio, and it also contains instructions (Id., at 130).

MIDI revolutionized music in the mid-80's, by allowing artists to play complex pieces without doing so all at one time (Id., at 132). MIDI does have limitations, such as the inability to

represent voices well (Id., at 136). MIDI, however, does not lack nuance (Id.).

All methods of producing sound digitally ultimately involve "numbers that describe how to make a sound pressure wave. In other words, they include instructions to a computer decoding device as to how to create a voltage that can then be sent to a loudspeaker or headphone." (Docket #86 at 12).

In Dr. Moorer's opinion, the inventor did not exclude MIDI from the definition of "digital audio music" (Id., at 113). Rather, Mr. Hair was referring to any means of using zeros and ones to encode musical sound (Id., at 138). The witness based his opinion on the fact that the patents do not use words "sound wave" or "sound pressure wave" at any point, and there is no limitation in the patent on the way the music is stored digitally (Id., at 139).

Also, the use of the term "laser retrieval" in the specification means any information which can be placed on CD (Id.). MIDI is not excluded by this language (Id., at 141).

"Software" as used in the patent means a way of representing digital music as opposed to being a physical device (Id., at 142). Thus, any method of creating music from zeros and ones appears acceptable under the patent (Docket #86 at 12).

### 3. CONSTRUCTION OF THE CLAIMS PRESENTED AT THE MARKMAN HEARING

The parties dispute the meaning of numerous terms, many of which are used throughout the three patents-in-suit. The court will

initially focus upon the four terms which the parties recognize as being at the center of the dispute in this matter.

A. "Digital Audio Signal"

This term appears in each of the patents, beginning with the '573 patent in Claim 1, which begins "A method for transmitting a desired *digital audio signal* stored on a first memory . . . ." (Docket #69, Exhibit J at 6) (italics added). Plaintiff maintains that this term should be construed to mean "a sound wave converted to binary form." (Docket #69 at 11). Defendants assert that the term's proper construction should be thus:

A representation of audio in binary form intended to produce an audible sound. It can be recorded sound, a sound effect, or instructions for producing a sound, and need not be a complete song.

(Docket #65 at 15). The essence of the dispute in this instance is whether or not the term "digital audio signal" includes MIDI instructions or computer software programs as opposed to simply digital representations of audible sounds.

MIDI is a means of creating musical sounds by instructing a computer to play a synthesizer to produce a specified tone. By contrast, Pulse Code Modulation, or PCM, is a means of converting a sound wave into binary form so that the same sound wave (or one so close to the original so as to be indistinguishable by the human ear) may be produced when the binary language is interpreted by a computer and sent through a digital/analog converter to a speaker.



Sightsound asserts that the phrase "digital audio music" does not include MIDI representations. Resort to contemporaneous dictionary definitions for those skilled in the art supports this conclusion. The IEEE<sup>6</sup> Standard Dictionary of Electrical and Electronics Terms in 1988 defined "audio" in the context of data transmission as "pertaining to frequencies corresponding to a normally audible sound wave - roughly 15Hz-20Hz." (Docket #69, Exhibit A). "Digital" is defined as "pertaining to data in the form of digits." (Id., Exhibit B). "Signal," again as employed in the context of data transmission, is "(a) a visual, audible or other indication used to convey information; (b) the intelligence, message or effect to be conveyed over a communication system; (c) a signal wave; the physical embodiment of a message." (Id., Exhibit C).

Defendants argue that the phrase "sound wave," which is part of Sightsound's proposed definition of "digital audio signal," is nowhere to be found in the specification. While this is true, "sound wave" is part of the IEEE definition of "audio," and is a source to which one skilled in the art would refer in construing the claim terms. Indeed, Sightsound persuasively argues that, relying upon contemporaneous trade definitions, the term "digital audio signal" refers to "a normally audible sound wave" which has been represented as "data in the form of digits" for purposes of sending or conveying it.

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6. The Institute of Electrical and Electronic Engineers, which is part of an American National Standard (ANSI).

Resort to the specification for purposes of determining if a different meaning was intended by the patentee does nothing to change the meaning of the phrase. The specification of all three patents provides several clues concerning the meaning of "digital audio signal." A review of the specification in some detail at this point will serve to provide needed background for this term, as well as for the other terms which remained to be construed.

First, in rather graceless language in common to the species, the specification contains a description of the 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 telecommunication line.

(Docket #70, Tab 51, '573 Patent at col. 1, lines 9-14). What follows is a description of the then-existing "medium" or "hardware units" of music, which include records, tapes and compact discs (Id., lines 17-68). Throughout this discussion, the disadvantages inherent in the use of "hardware units" for storing, selling and playing back music are discussed. Then, the advent of digitizing sound is discussed:

**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 and 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 . . . .

(Id., lines 50-59). With respect to copyright protection of musical pieces, the specification indicates that, "[i]f music exists on hardware units, it can be copied." (Id., col. 2 lines 8-9).

Thus, the objectives of the invention are listed as providing a new "methodology/system" to: (1) "electronically sell and distribute Digital Electronic Music"; (2) "electronically storing and retrieving Digital Audio Music"; (3) electronically sorting, cuing and selecting Digital Audio Music; and (4) preventing "unauthorized electronic copying" of Digital Audio Music. (Id., lines 10-23).

The specification goes on to explain that Digital Audio Music, in the disclosed invention, is stored on only one piece of "hardware," that being a hard-disk (Id., lines 31-34). This eliminates the former types of "hardware" identified in the specification, namely "records, tapes, or compact discs." (Id., line 34). The reader is further informed that, "[i]nasmuch as Digital Audio Music is software an[d] 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." (Id., lines 63-67). A more concise description of the invention is then provided:

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 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.

(Id., col. 3, lines 3-19). This description is repeated after the preferred embodiment is set forth (Id., col. 5 lines 29-45).

Again, it is helpful to focus the court's inquiry on the crux of the dispute between the parties. Defendants assert that any means of directing a computer to make sound through use of binary code is acceptable as a "digital audio signal" for purposes of the invention. This is so, defendants argue, because the specification identifies "digital audio music" as "music converted into a very basic computer language known as binary" and because the specification refers to Digital Audio Music as "software." (Docket #65 at 16). MIDI is a form of computer "software" in that it consists of instructions, stored in binary form, which will produce sound when interpreted by the computer. "Instructions" to produce sound are, in defendants' view, part of the claimed invention.

Sightsound responds that software programs, such as MIDI, are not properly within the scope of the term "digital audio signal." The manner in which the terms "hardware" and "software" are used in the specification are, Sightsound argues, the most important indicia of the meaning of those terms. The specification consistently refers to any physical storage medium for sound,

whether in binary form or not, as "hardware." Such storage units including records, tapes, compact discs and even the hard drive of a computer. The specification explains that the key advantage to storing music as digital signals is that the digital signal is "software," i.e., it can be transferred to a purchaser without also transferring along with the signal some type of "hardware" unit on which the signal is stored.

There are repeated references in the specification to "music" and "songs." Likewise, the patentee refers to storing music on other media, such as records and tapes, which do not normally contain computer instructions. These references from the specification lead the court to conclude that Sightsound's definition is the preferred one in this case, and that "digital audio signal" does not include all types of computer software or, more specifically, MIDI.<sup>7</sup> Rather, it includes only digital representations of sound waves.

The court understands that, in order to play these digital representations of sound waves, a computer must have instructions for converting the binary into analog form. Hence, as Dr. Moorer pointed out, compact discs include, along with a digital representation of sound waves, instructions concerning how those digital representations are to be interpreted. This, however, does

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7. This conclusion has been reached without reference to extrinsic evidence, with the exception of dictionary references. Further, evidence presented by defendants addressed to the ability of the technology available to the normal consumer in 1988 to handle the transfer of PCM songs is not, at this stage, relevant.

not alter the nature of what is being represented: a recorded sound as opposed to an instruction to a computer to play an instrument which, in turn, will produce a sound.

The specification does not, therefore, support the construction proffered by defendants that "digital audio signal" includes "software programs." The specification does not refer to such programs, and clearly uses "software" in a sense different from what is commonly understood when used to refer to "software programs."<sup>8</sup> Further, the specification focuses upon the common practice of selling musical recordings, and does not mention storing or transferring instructions for playing music.

**B. "First Party/Second Party"**

Again, these are terms utilized throughout the patents-in-suit referring to the two entities which interact during the transfer of the digital signal, e.g., 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 . . . ." (Docket #69, Exhibit J at 6). Plaintiff asserts that the term "party" should be construed as meaning "an entity and/or its agent." Defendants

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8. This ruling does not require resort to extrinsic evidence. If it did, however, the undersigned would find persuasive the testimony of the inventor, Arthur Hair, that MIDI is "a set of instructions" while "digital music is music that is embodied in a digital signal . . . one is a set of instructions and the other is music digitized." (Docket #74, Exhibit A, Tab 2, Hair Deposition at 169:4-10). This is consistent with Dr. Tygar's and Dr. Moorer's testimony, that MIDI, while a means of creating music, is not a representation of a sound wave.

respond that the meaning, each time that the terms are used, should be "a single financially distinct entity at locations separate and distinct from each other."

Sightsound does not contest that, in the context of the claims at issue in this case, the "first party" and "second party" are financially distinct from one another, or that various claims require that the transaction occur when certain items or entities are at distinct locations (Docket #96 at 8). However, Sightsound takes the position that "financially distinct" and "at separate locations" are limitations imposed, where appropriate, in particular claims, and that there is no need to impose them on the definition of the terms "first party/second party" each and every time that those terms are used.

In claim 1 of the '573 patent, the reader is informed that during the transferring money step the "first party" is "at a location remote from the second memory," and that the "second party" is "financially distinct from the first party." (Docket #70, Tab 51). This claim also contains the limitation that the second party is in the position of "controlling use and in possession of the second memory" (Id.). Later in this report, the "control and possession" question is addressed. It is enough to say, however, that the combination of the first party being at a location remote from the second memory, and the second party being in possession and control of the second memory, all but ensures that the first and second party will be at distinct locations. The remaining two

claims in suit from the '573 patent, claims 2 and 3, are dependent claims which also have these limitations.

The '734 patent includes in each of the asserted claims the requirement that the memory of the first party and that of the second party be "remote" from one another (Docket #71, Tab 35, '734 Patent Claims 1, 4, 11, 26)<sup>9</sup>. Hence, the issue of whether the parties are at separate locations is not specifically addressed, although the use of memories at distinct locations would generally describe situations where the parties are with their respective memories. Further, as Sightsound suggests, the claims also include at least one step which requires that money or a fee be charged (Claims 1, 26), or that the digital audio signal is "sold" to the second party (Claim 4), or that there must be a means for "transferring money" between the first and second memories (Claim 11). None of these transactions makes sense unless they occur between parties which are "financially distinct."

Finally, the '440 patent also contains language indicating distinct locations for the first and second party memories (Docket #69, Exhibit K, Claims 2, 12, 22, 36, 41), as well as "charging a fee" or other indicia that the parties are, necessarily, financially distinct (*Id.*, Claims 1, 12, 22, 36, 41).

Therefore, in virtually all of the claims asserted in this case, the "first party" and the second memory, or the first memory

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9. Again, the remaining claims are dependent claims which incorporate these same limitations.



and second memory, must be remote from one another.<sup>10</sup> The context of those claims further requires that the parties be financially distinct in order for their actions to read on the patent. This distinction, however, is not a matter of construction of the terms "first party/second party," but of the language of each particular claim in which those terms are used. In other words, the location and financial distinctions arise, if at all, from other language in the claims, and not from the use of the terms "first party" or "second party." The terms will not be construed to include any location or financial distinctions apart from those imparted in the language of particular claims.<sup>11</sup>

10. The two claims which do not contain such language are Claims 1 and 11 of the '440 patent, although each claim states that the connection between the first and second party memories is to be made through telecommunications lines. It may be possible, therefore, for these claims to apply to a situation where two financially distinct entities have their equipment at the same location, e.g., in the same room, even though the connection between them occurs over telecommunications lines. The court, however, again sees no basis for including within the term "party" the requirement that the parties be at distinct locations. Any further analysis of these claims must await issues which lie beyond claim construction.
11. The court's finding that "financially distinct" is a concept incorporated into each claim-in-suit by the use of the concept of a sale taking place makes it unnecessary for the court to address defendants' argument that the patentee bound himself to "financially distinct" parties through an amendment process before the PTO (See Docket #75 at 7). Since the asserted limitation appears to be contained in each claim asserted by Sightsound, and since Sightsound does not contest that the first party and second party must be financially distinct from one another, there is no need to determine whether the claims must be construed in light of subject matter allegedly abandoned during prosecution of the patents.

There is a further dispute, however, concerning the term "party," and it has to do with Sightsound's insistence that the term includes an entity or an entities' agent. Defendants assert that there is no indication in the patents or the specifications that an "agent" may act on behalf of either the first party or the second party. Defendants also argue that permitting the use of the term "agent" would create a situation where infringement may occur in one state, but not in another, because of differences in the laws of agency from state to state.

Sightsound responds that the term "agent," offered as part of the definition of "party," simply means "someone who stands in the shoes of the first party," and that there is no intent to imply any particular legal relationship (Docket #96 at 9).

In the court's view, the use of the term "party" is clearly meant to include any legally distinct entity which performs the activities described. For example, a corporation could clearly be either the "first party" or the "second party" for purposes of the claims in suit. A corporation acts only through its employees or "agents". Likewise, a person may also act on behalf of another. The court agrees with plaintiff that there is no language in the claims which suggests that "first party" and "second party" must act for themselves in performing the tasks set forth in the claims. Likewise, nothing in the specification indicates that the patentee was restricting himself in such fashion.

On the other hand, defendants are correct that the term "agent" may add ambiguity to a term which is not ambiguous. There

is no need to add such a term to make the meaning of the claims plain.

Reading the claims-in-suit, the court has no difficulty construing the term "party." A party is an entity, whether a corporation or real person, possessing and/or controlling the stated structure, or performing the necessary steps for the claims. One skilled in the art would understand that a party can act through another. Thus, although the term "agent" will not be added to the term party, the term will not be construed so as to require that a party act on its own behalf for purposes of the claims in suit, i.e., a party may, as in all other matters, act through others it authorizes to do so for purposes of the claims in suit.

C. "Control" and "Possession" and related phrases.

"Control," in plaintiff's view, is "the authority to guide or manage." "Possession" is "to have and to hold as property." Plaintiff maintains that these terms should be accorded these meanings wherever used, including when they are used in combination or separately.

Defendants, on the other hand, seek to have each of the following phrases construed as meaning the same thing: "controlling use and possession," "in control and possession," "in possession and control," "controlling," and "controlling use." These must each be construed, in defendants' view, to mean "in physical control and ownership." Therefore, there are two disputes here which are

interwoven. The court must determine what the terms mean and whether they are being used interchangeably.

Initially, it must be noted that both Sightsound and CDnow offer definitions for each term. "Control" in defendants' view is "physical control" while "possession" is "ownership." These terms may be measured against Sightsound's proposed definitions, and then the question whether they are being used interchangeably in the patent may be addressed.

A useful starting point for construing these terms is Claim 1 of the '573 patent:

1. A method of 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 lien [sic] 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 in 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 audio signal in the second memory.

(Docket #69, Tab J, Claim 1) (emphasis added).

The dictionary defines "control" as meaning "exercise authority or influence over: direct" (Docket #69, Exhibit E, The 1995 Webster's II New College Dictionary). "Possess" is defined as "to hold as property or occupy in person; have as something that belongs to one; own" (Webster's New World Dictionary, Third College Edition, 1988). "Possession" is defined as "a possessing or being possessed, as by ownership or occupancy; hold" (Id.). That these dictionary definitions offer slight but important variations of the meaning for the term "possess," only comports, in the court's view, with the common understanding of this prosaic term. One can "possess" one's house as a renter, with a possessory interest assertable against the whole world except, under some circumstances, against the owner, who also enjoys a possessory interest. "Possession" thus does not mean "ownership"; it means "holding as property."

The dispute with respect to "control," however, is whether or not the patents require that physical control be exercised over a particular object, or if the authority to direct the use of the object is sufficient. A review of the claims in suit does not reveal any support for defendants' assertion that physical control over any particular object is required as opposed to the authority to direct the use of that object. Therefore, physical control is not a requirement where the term "control," or any derivation thereof, is used in the claims-in-suit.<sup>12</sup>

12. Defendants also make the argument that referring to the "plain meaning" of the terms used would end in an absurd result (which, in any event, defendants profess would be acceptable to

The issue of the interchangeability of the terms is largely disposed of by recognition that the terms do have generally accepted meanings which are distinct. Thus, in Claim 1 of '573 patent, the first party has "controlling use" of the first memory, while the terms possession and control are used together with respect to the first party vis-a-vis a transmitter, and the second party vis-a-vis both the second memory and a receiver. The claim clearly makes a distinction, with respect to possession, between the first party's memory and the first party's transmitter.

Indeed, being in control of a thing, however, is not the same as being in possession of that same thing. The language of the '573 patent does not indicate to the court, nor would it to one skilled in the art, that the party is "in physical control and ownership" when the party is merely "controlling use" of the first memory.

In the court's view, the fact that the terms control and possession have common meanings which are not identical, and that

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them). Specifically, defendants allude to the third paragraph of Claim 1 of the '573 patent, where the receiver "is in possession and control of the second party." A "plain reading" of this language, in defendants' view, would require the receiver to possess and control the second party, rather than the other way around (Docket #65 at 21-22). The court disagrees. At most, defendants have pointed out the infelicitous placement of a verb. This does not, however, establish that the meaning of the terms in issue are ambiguous. Rather, a reader of normal skill in the art, and with a normal understanding of the English language, will not be confused by the claims which place (or misplace) the terms "possession" and "control." In fact, it does not take one skilled in any art, past a common understanding of English, to understand that "a transmitter in control and possession of the first party" means that the first party controls and possesses the transmitter.

they are not used jointly in all of the relevant patent claims, is strong evidence that each term is intended to convey its own meaning. Also, the dispute is limited in this case to several instances where the first party is asserted to be either "controlling" or "controlling use" of the first memory"<sup>13</sup>

In Claim 4 of the '734 patent, by contrast, the phrase "possession and control" is used only once, and that is in reference to the second party possessing and controlling the second memory (Docket #66, Exhibit 2 at Claim 4, column 10, lines 3-5). Claim 11, by contrast, places the first memory "in possession and control of the first party," and the second memory "in possession and control of the second party." (*Id.*, Column 10, lines 54-56).

Defendants point to the '734 patent specification where it is stated that "the receiver is in possession and control of the second party. The receiver is placed by the second party at a second party location determined by the second party." (Docket #66, Exhibit 2, '734 Patent at 5:56-59). Defendants argue that this, too, evidences that control and possession are required when either term is used in a claim. However, defendants fail to note that

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13. Defendants also assert that the term "controlling" is used individually with respect to the second party controlling the second memory in Claim 3 of the '573 patent (Docket #65, Appendix B at 3. However, that claim is a dependent claim, which includes the limitation from Claim 1 that "said second party controlling use and in possession of the second memory." (Emphasis supplied). Thus, Claim 3, by definition, includes the restriction that the second party controls the use and possesses the second memory. This is, therefore, a non-issue with respect to Claim 3 of the '573 patent.

this language is used in describing the preferred embodiment of the invention. Indeed, the first portion of the first sentence cited by defendants reads in relevant part "preferably having the second memory while the receiver is in possession and control of the second party." (Id., 5:54-55). Further, the cited portion of the specification is addressed to the second party and the second memory. As noted above, the only disputed use of "control" are with reference to the first party and the first memory. Thus, this is not persuasive evidence supporting defendants' argument.

Further, to the extent that any ambiguity might exist, resort to the prosecution history establishes that the examiner, a person skilled in the art, understood "control" to mean "authority to guide or manage." (Docket #70, '573 File History, Tab 13 at 3). This was expressed in the course of explaining the term "control" in light of prior art, the Lightner patent. Likewise, the term "possession" was explained by the applicant in 1991, in the course of distinguishing the patent from the Hughes patent:

[The] Hughes' receiver, although located in the user's home is taught to be owned by the owner of the transmitter and is thus 'in possession' of the owner.

(Id., Tab 34 at 9). Thus, the prosecution history also informs the court that control and possession are separate terms, that possession has an element of holding as property attached to it, and that physical control is not necessary.

The court therefore agrees that the terms control and possession have the meanings of "authority to direct" and "holding



as property," respectively. Further, the court finds that the terms are not used interchangeably in the claims in suit.

D. "First Memory (or hard disk)/Second Memory (or hard disk)"

Defendants assert that, each time the terms "first memory" and "second memory" are used (and they are used throughout the three patents-in-suit) they should be read as being in the "possession and control" of the respective parties. Sightsound responds, much as it did with respect to the location dispute concerning the terms "first party/second party," that "control" and "possession" of the first and second memories are expressly stated in those claims which possess those limitations.

In support of their position, defendants argue that the specification of the patents recites explicitly that the first memory is in the first party's control and possession, and that the "receiver" is in the second party's possession (Docket #70, Tab 51, '573 Patent at col. 3, lines 10-18). The terms "possession" and "control" are used throughout the patents, and the court finds that they are used where and when the patentee intended. In any event, reading them into the patent claims every time the first memory or second memory are mentioned would be an improper reading into the claims of a limitation set forth in the specification. Intervet Am., Inc. v. Kee-Vet, Inc., 887 F.2d 1050, 1053 (Fed.Cir. 1989).

Defendants also assert that, with respect to the '573 patent, the inventor overcame a prior art rejection by asserting that the "second party" has "control of the second memory throughout

the transaction." (Id., Tab 16, at 5-7). Accepting this argument on its face, it proves too little. Claim 1 of the '573 patent explicitly requires (and this requirement carries through to dependent claims 2 and 3) that the second memory is in the second party's possession and control. The reference to the prosecution history made by defendants does not address the possession and control of the first memory by the first party.

The court would be rewriting the claims asserted to read "first memory" and "second memory" to include the restriction that they each be possessed and controlled by the respective parties. Such a reading would, moreover, contradict the express terms of the claims. "In construing claims, the analytical focus must begin and remain centered on the language of the claims themselves, for it is that language that the patentee chose to use to 'particularly point[] out and distinctly claim[] the subject matter which the patentee regards as his invention.' 35 U.S.C. §112, ¶2." Interactive Gift, 231 F.3d at 865. The terms "first memory" and "second memory" will not be construed to include the terms "in the control and possession" of the respective parties unless such language expressly appears in the claim.

E. "Transferring money electronically," "Charging a fee," "providing a credit card number . . . so the second party is charged money," "Selling electronically," "Electronic sales," and "Electronically Selling."

Sightsound asserts that the term "transferring money electronically" should be construed to mean "providing payment electronically." Defendants assert that "transferring money electronically and "charging a fee" should be construed to mean the same thing: "providing an authorization over telecommunications lines which allows the first party access to funds." Put more directly, Sightsound asserts that the claim language permits any type of payment which is accomplished electronically. Defendants assert that the only type of payment arrangements covered by the claim language would be provision of authorization by the buyer, as in providing a credit card number, which permits the seller access to funds.

The '573 patent recites in claim 1 the step of "transferring money electronically via a telecommunications [line]." (Docket #70, Tab 51, Column 6 lines 8-9). Then, in claim 3 (a dependent claim) an additional limitation is recited "wherein the transferring step includes the steps of telephoning the first party . . . by the second party; providing a credit card number of the second party . . . to the first party so the second party is charged money." (Id., lines 29-36).<sup>14</sup> The specification states that this is

14. Defendants' voice a concern that, if Sightsound's definition is accepted, Sightsound may later choose to argue that "payment" would exclude providing authorization for payment, as by providing a credit card number. The court cannot agree. The provision of authorization for use of a credit card is expressly claimed in claim 3 of the '573 patent. Further, while this express language is not used in Claims 11-14 of the '734 (the other instance where "transferring money electronically" appears) Mr. Hair's declaration in the prosecution history of the '573 and '734 patents clearly binds Sightsound to include situations where authorization to charge

"a method for the electronic sales and distribution of digital video and audio signals, and more particularly, to a method by which a user may purchase and receive digital audio or video signal from any location which the user has access to a telecommunication line." (Id., Column 1, lines 9-14).

Defendants assert that missing from the specification is any mention of the word "payment" in relation to the term "transferring money electronically." (Docket #65 at 25). While this is true, the concept of the second party purchasing, i.e., making a payment for and receiving, the "desired digital signals" is manifest. Defendants also argue, however, that the inventor noted during the prosecution history of both the '573 and '734 patents that "[o]ne skilled in the art would know that an electronic sale inherently assumes a transferring of money by providing an account number or a credit card or a debit card number (since that is the only way for electronic sales to occur) coupled with a transferring of a service or product." (Docket #70, Tab 37, at 2; Docket #71, Tab 10, at 2).

In the court's view, there is no need to resort to the prosecution history. The fact that the '573 patent employs "transferring money electronically" as a general term, and includes within that term the concept of providing a credit card number and authorization, establishes clearly that the methods of providing payment electronically over a telecommunications line include but

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a credit card is provided over telecommunications lines.

are not limited to providing authorization to charge a credit card account. If this had been intended, there would have been no reason to use a more general term and then include provision of a credit card account number within that concept.

Also, at issue is the phrase "charging a fee via telecommunications lines," which is language used in claims 2, 36 and 37 of the '440 patent. The context of this claim language also does not limit itself to any specific manner of accomplishing the end result, which is to ensure payment for the services provided through information provided over a telecommunications line.

A related phrase, "providing a credit card number . . . so the second party is charged money" is also disputed by the parties. Defendants assert that this must be accomplished over the telephone, verbally, between two persons, one at each location (Docket #65, Appendix A at 4). Sightsound objects to the inclusion of the "person to person" limitation, and to the verbal exchange requirement (Docket #74 at 24). Indeed, the court can find no support in the plain language of the claims, or the specification, for the requirement that the information be exchanged in a person-to-person call.

Providing authorization to access a credit card account is one means of "transferring money electronically." There is no evidence that the inventor ceded coverage of any other means of making payment for the desired digital signals so long as it is done "over telecommunications lines." In the court's view, "transferring money electronically" is a sufficiently descriptive phrase that no

further description than that set forth above is necessary for its construction.

Related to this discussion is the dispute concerning the terms "selling electronically," "electronic sales," and "electronically selling." Sightsound contends that each of these three terms should be interpreted as meaning "providing a product or service electronically in exchange for payment provided electronically." Defendants agree that these terms each mean the same thing, but would have them be construed to mean "a transaction including authorization over telecommunications lines which allows the first party access to funds, and the providing of a service or product." Defendants present the same argument as they did for the phrase "transferring money electronically." Again, the court is not persuaded.

Defendants further assert that "electronic sales" may include situations where the product is not provided electronically. Sightsound disagrees, and argues that, in the context of these patents, the service must also be provided electronically.

The claims which use these terms all appear in the '734 patent and the later '440 patent. An illustrative example of the use of the language within a claim is claim 4 of the '734 patent wherein a system is described which includes a "means for electronically selling" digital signals, and "electronic sales" of the signals which involve those signals being "electronically transferred" to the second party (Docket #66, Exhibit 2, Column 9 at lines 51-53, 65-67; Column 10, lines 1-6). Thus, the requirement

that the sale include both payment and electronic transfer of the digital signal is express in claim 4 of the '734 patent. Further, the '734 specification begins by describing "[a] method for transferring desired digital . . . signals." (Docket #66, Exhibit 2, Abstract). It sets forth the "forming a connection" requirement, and then describes "the step of selling electronically by the first party to the second party through telecommunications lines, the desired . . . signals . . ." followed by transferring the signals. (Id.) (emphasis added). Also, in support of the '734 patent, Mr. Hair made the following representation:

The terms "electronically sell", "electronic sales" and "electronically sold" are used throughout the specification of the above-identified patent application.

One skilled in the art would know that an electronic sale inherently assumes a transferring of money by providing an account number of a credit card or debit card number which then allows for access to or transferring of a service or product through telecommunications lines."

(Docket #71, Tab 10 at 2) (emphasis supplied).

The language used in the patents, the specification, and the prosecution history each and all indicate that the concept of "electronic sales" or "selling electronically" involves transactions in which both the payment and the provision of services is accomplished "electronically" via "telecommunications lines." Therefore, this is an additional limitation on the claims which include those terms.

F. Terms which include "Telecommunications Line(s)"

Sightsound asserts that the term "telecommunications line," which is used throughout the claims in suit, should be interpreted in all instances to mean "a medium for the transmission of information from one location to another." Defendants respond that this could refer to, among other things, the Pony Express.

Defendants, on the other hand, wish to focus the inquiry upon the use of the term "connecting" in relation to "telecommunications lines," as in the following examples from the various patent claims: "connecting electronically via a telecommunications line," "forming a connection through telecommunications lines," "telecommunications lines connected," "connecting electronically via the telecommunications lines," and "connecting electronically via telecommunications lines." Defendants assert that each of these formulations of the terms "connection" and "telecommunications lines" entails the following construction:

Establishing a continuous point-to-point conduction path using a telephone service providers' circuit-switched network for the transfer of information. These terms do not include a packet-switched network link, such as a TCP/IP link.

The TCP/IP reference is, of course, addressed to the Internet. Defendants take the position that the use of the terms "connect[ion]" and "telecommunications line(s)" bespeak the use of telephone lines and telephone switching services only. A connection over the Internet (which would, in most cases, involve at least some use of telephone lines and the telephone switching system), would not be covered.



The expert testimony in this case was most helpful in describing the distinction between the telephone system and a TCP/IP system such as the Internet. What becomes clear from a review of the testimony and the sources relied upon by the experts, however, is that the distinction which defendants wish to make is not drawn from the claim language, or from the specification.

It is helpful, first, to note that both sides agree that a modem-to-modem connection between two computers over telephone lines would clearly be covered by the claim language. Defendants, however, wish to differentiate from this the process by which an Internet transfer occurs. A common form of such a transaction, and one which was known in 1988, would involve the second party (or buyer) connecting to an internet service provider (ISP) through a modem and over a telephone line. The next part of the process occurs between "nodes" on the packet-switch network (the Internet), until the transmission, in the form of information "packets," reaches another ISP connected to the first party (the seller) by telephone lines. Thus, in each instance, the transmission is ultimately accomplished, at each end, by a traditional telephone communication over telephone lines and through a telephone switching system.

The difference between the two methods of exchanging data occurs in the manner in which the information is sent between the nodes of the packet-switch system, and the manner in which data is sent through a telephone company switching system. However, while a transfer over the Internet differs in some respects from a

transfer made directly between two computers over modems and through telephone lines, there is simply no way of reading the plain language of the claims in suit explicitly or implicitly to exclude any means of transferring information so long as it can occur over telecommunications lines.

Defendants, for example, rely upon Figure 1 from the specification of each patent which shows the respective equipment of the first party and second party connected to a "box" entitled "Telephone Lines 30." Even if the use of the phrase "telephone lines" limited the invention, it is not clear that it would do so to omit the Internet, which is normally connected to individual users by telephone lines in any event. Also, Figure 1 is a representation of the preferred embodiment only. It is improper to read into the patent claims limitations from the specification. Comark Communications, 156 F.3d at 1186 ("fine line" exists between "reading a claim in light of the specification" and impermissible practice of "reading a limitation into the claim from the specification.").

Likewise, defendants' asserted definition of the term "connection" to differentiate telephone communications and an Internet session is not persuasive. Dr. Larky explained in detail how a telephone communication establishes a "continuous point-to-point conduction path," regardless of the use of time division multiplexing (TDM), which results in several different telephone connections sharing the same line. This is so, in his view, because TDM still results in the telephone user having the right to a

specific and consistent pathway through which his or her entire conversation is put through to the other party. Resort to the claims and the specification, however, does not yield any basis for making a distinction between the "connection" made in an Internet session, which produces "end-to-end" connectivity, but not a continuous conduction path, and a telephone connection which produces both end-to-end connectivity and a continuous conduction path.

Defendants resort to the prosecution history and note that the term "telecommunications lines" did not become part of the patent until 1992. The manner in which this was accomplished, in defendants' view, should inform the court's interpretation of that term. The original specification and claims disclosed "electronically transferred via telephone lines" (Docket #70, Tab 4 at 6). This was altered in December, 1988, to "connecting electronically the first memory with the second memory" (*Id.*, Tab 7 at 1). In December, 1991, the first use of the term "telecommunications link" is proposed, and rejected by the examiner as not being well-connected in the system (*Id.*, Tabs 34 and 35). Ultimately, in June, 1992, the term "telecommunications line" was added throughout the claims (*Id.*, Tab 36).

First, defendants assert that, if the term "telecommunications line" is read to reach anything more than a "continuous telephone-circuit network path" this would violate the "written description requirement" which requires a patentee in the initial disclosure to provide an adequate description of what is

being patented. See, Purdue Pharma L.P. v. Faulding Inc., 230 F.3d 1320 (Fed.Cir. 2000). This, however, is a validity issue which the court should not reach at this point. And, in any event, the use of the term "telephone lines" in the initial disclosure does not, in light of the fact that the Internet is normally accessed through telephone lines on each end of a transaction between parties, provide support for limiting the definition of "telecommunications lines" to exclude Internet transactions.<sup>15</sup>

Defendants also seek to limit the reach of the term "telecommunications line" in light of the changes made during the prosecution of the patents from "link" to "line," a small portion of which the court has already described above. A more complete description of the prosecution history is now necessary.

The original term in the application for the '573 patent was "telephone line." Then, in December, 1988, the term "electronically connecting" was proffered and rejected. This rejection was premised upon the Lightner patent (Docket #70, Tab 11). The next attempt was simply to recite "connecting" the first and second memories, but this was also rejected over Lightner and the Hughes patent (Id., Tabs 12 and 13). "Connecting electronically" was added (Id., Tab 16), but again a rejection over

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15. Defendants also assert that "telecommunications lines" is "new matter" which was improperly added to the patent in the years following the initial application. Again, however, defendants seek to introduce a matter normally addressed during the validity stage into the construction phase, and, in any event, it does not serve to raise the distinction which defendants desire.

Hughes resulted because "Hughes . . . shows that the first and second memory are connected electronically . . . such that information can pass therethrough." (Id., tab 30). Claim 11 was amended to state "connecting electronically via a telecommunications link" (Id., Tab 34). The examiner found the term "telecommunications link" to be "not well connected in the system" (Id., Tab 35 at 6). This resulted in the inclusion of the term "telecommunications line" in the next amendment, which was approved (Id., Tab 38 at 6).

Defendants assert that, in view of the prior art, "link" is a broad term, and "line" is a narrower term. Specifically, defendants point to the Hughes patent which discloses "transmitting and recording stations" which are "linked by telephone lines or other signal transmission means" (Defendants' Exhibit 4 at Column 8, lines 39-42). Lightner disclosed a "signal transmission link" with examples thereof including telephone lines, a microwave transmission link and CATV cable (Defendants' Exhibit 8, Column 15, line 47; Column 14, lines 53-55; Figures 10 and 12). Lockwood discloses "any suitable remote links . . . such as phone line data communication links" and an indirect link "via a computerized telecommunication network service such as TELENET." (Defendants' Exhibit 7, Column 4, lines 1-16). TELENET is described in Newton's Telecomm Dictionary, 7<sup>th</sup> Ed., p. 686, as a "private, commercially available network

providing both packet-switched and circuit-switched service to subscribers in North America, Europe and some parts of Asia."<sup>16</sup>

Thus, defendants argue that anything defined in the prior art as a "link" was given up when the Mr. Hair amended his claim from "telecommunications link" to "telecommunications line." This, in defendants' view, includes claiming a packet-switched network, such as that offered by TELENET.

A patentee may limit the definition of a claim term through "altering claim language to escape an examiner rejection" or by "clearly disavowing claim coverage." York Products, Inc. v. Central Tractor Farm & Family Center, 99 F.3d at 1575. Here, in offering the amendment, the patentee gave the following explanation:

The Examiner has also stated that "telecommunication link" is not well connected in the system. Accordingly, "link" has been amended to the more familiar term "line" and "via telephone line" has been added to the connecting step in Claims 11 and 15.

(Docket #70, Tab 38 at 15).

Here, the examiner did not reject the term "link" on the basis that it was taught by the prior art. Rather, the examiner indicated that a term more closely connected with the disclosed invention was required. Thus, the applicant indicated during the amendment not that he was giving up coverage, but that he was amending to include a "more familiar term" in the patent. Hence, this is not a situation where coverage was expressly conceded, nor

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16. Defendants also point to Freeny (Defendants Exhibit 5) and Elkins (Defendants' Exhibit 6) as examples of prior art which use the term "communications link" as a broad term.

would a person skilled in the art believe that any specific coverage had been conceded through this amendment. In fact, neither the examiner nor the patentee ever indicated that there was any difference beyond familiarity between the terms "link" and "line."

Once again, this review of the prosecution history was an attempt by defendants to establish that Sightsound cannot claim coverage of package-switch networks such as the Internet. The court is not convinced that this is so. Thus, the terms "telecommunications line," even when used in the context of "connecting," should not be interpreted as excluding the Internet.

Further, with respect to Sightsound's construction, it is true that "a medium for the transmission of information from one location to another" is much too broad in the context of these patents. This does not mean, however, that Sightsound is attempting to claim coverage of the Pony Express or notes sent by carrier pigeon. Reading the term in context, "telecommunications lines" is used most often in conjunction with the terms "connecting" and "electronically." Where this is done, the coverage claimed is both narrow and clear. Sightsound is claiming an electronic medium of communicating between computers, which requires end-to-end connectivity. The court has not located any language in the patents which would permit any other reading, in context, of the term "telecommunication line(s)".

G. "Sales random access memory chip," "Incoming Random Access Memory Chip," and "Playback Random Access Memory Chip"

Sightsound sees no reason to further define these terms. Defendants assert that "sales random access memory chip," and "sales random access memory," should be interpreted as "a semiconductor storage element within the first memory at the first party location." "Incoming playback memory chip" should be "a semiconductor storage element within the second memory at the second party location," and "playback random access memory chip" should be "a semiconductor storage element within the second memory at the second party location that is separate and distinct from the incoming random access memory chip."

These terms appear in the '734 and '440 patents. Claim 1 of the '734 patent discloses a "first memory" which has a "hard disk having a plurality of digital . . . signals . . . and a sales random access memory chip which temporarily stores a replica of the . . . desired . . . signals" (Docket #69, Exhibit I, Column 8, lines 42-50). Claim 3, which builds upon claims 1 and 2, then discloses that "the second memory includes an incoming random access memory chip which temporarily stores the coded desired . . . signals . . . and a playback random access memory chip for temporarily storing the . . . signals . . . for sequential playback." (*Id.*, Column 9, lines 17-26). Other claims are similar, except that the term "chip" is not included in all iterations.

The specification of the '734 patent also provides a detailed description of the preferred embodiment:



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:

\* \* \*

- 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 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.

(Id., Column 4, lines 32-65).

The focus of the dispute in this case is whether the claims may be read to include configurations where the RAM of a computer is used interchangeably as the "Sales Random Access Memory" and for other functions as part of the first party's control unit, and as the "Incoming Random Access Memory" and "Playback Random Access Memory" as well as other functions in the second party's control unit. Defendants would read each of these phrases as

requiring a separate storage element in the respective computers, apparently without the ability to be used for other purposes for which RAM is typically used on personal computers.

Reading the language of the claims in light of the specification, and particularly the language following the description of the preferred embodiment regarding the intended breadth with respect to the number of components and design of the control units, there is no indication that the inventor limited himself to situations in which particular RAM chips are designated for a specific purpose only. In the court's view, the language cited covers any RAM in a system which is configured to perform the function described, whether or not that is the only function it is configured to perform.

H. "before the forming step . . . commanding the second integrated circuit . . . to initiate the purchase"

This language appears in claims 2 and 3 of the '734 patent and claim 8 of the '440 patent. The parties agree that the language imposes an order with respect to the timing of the claimed steps. Defendants maintain, however, that the language requires that the second part "formulate" the request, and that the second party personally performs the "commanding" step. Sightsound sees no reason to include a "formulating" step when "commanding" is all which is disclosed, and disputes defendants' analysis that an "automated" form of commanding would be outside the scope of the claim language.

The language, in context, reads as follows:

2. A method as described in claim 1 wherein there is a second party integrated circuit which controls and executes commands of the second party, and a second party control panel connected to the second party integrated circuit, and before the forming step, there is a step of 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.

(Docket #69, Exhibit 1, Column 9, lines 9-16). Claim 8 of the '440 patent reads virtually the same (Id., Exhibit K, Column 9, lines 33-41).

While it is clear that the "command" must originate from the second party, there is no indication that this must be accomplished by the second party physically entering a command at any specific time. The claim requires that, before the forming step, the integrated circuit be commanded to initiate the purchase. This command clearly must originate with the second party, but there is no limitation on how the second party can accomplish this. Thus, the limitation that the command be "performed personally" by the second party does not arise from plain language of the claims and, hence, is inappropriate.

The court also sees no basis to change the term "command" to "formulates a request." One skilled in the art would clearly understand the means by which an integrated circuit may be commanded to perform a function. Therefore, the court finds that this language does not impose a limitation requiring that a request be "formulated," or that the command be personally entered by the second party.

I. "Control integrated circuit"

This term appears in several claims in the '734 and '440 patents. Defendants assert that it should be defined as "a microelectronics device with at least 1 transistor." Sightsound does not contest that this is an accurate description of a control integrated circuit, but notes that this is an incomplete definition, as it potentially includes devices, such as an Operational Amplifier (Docket #74, Exhibit B, Tab 3 at 340), which would fit this definition but would make the claimed invention inoperable. Defendants respond that the "control integrated circuits" of the claimed inventions "perform too many functions to be defined with any more specificity." The court, however, sees no need to define them any more specifically than the plain language of the patents suggest: a microelectronics device which is capable of performing the functions identified in the patents.

J. "Regulate the transfer"

This language appears in claim 7 of the '734 patent in describing the role of the integrated circuits with respect to the transfer of signals: "said second party control integrated circuit and said first party control integrated circuit regulate the transfer of the desired digital video or digital audio signals . . . ." (Docket #69, Exhibit I, Column 10, lines 29-32). Identical language appears in claim 15 of the '440 patent (*Id.*, Tab K, Column 11, lines 20-23).

Defendants assert that this means "receive or transmit." Sightsound responds that "the claimed term 'transfer' may not be exactly the same as receive or transmit, as such verbs may describe part of the transfer but not the whole occurrence thereof." (Docket #74 at 29). Clearly, the transfer of the digital signals involves transmitting on one end and receiving on the other. To "regulate" that transfer, however, bespeaks more than simply transmitting or receiving. The use of the term "regulate" indicates that the transmitting and receiving are being controlled, directed or governed. See, Webster's New World Dictionary, Third College Edition (1988). Thus, in the context of the patent claims at issue, the phrase "regulate the transfer" is construed to mean that the first party and second party integrated circuits control the transfer of the digital signals, i.e., control the transmitting and receiving of such signals.

K. "electrical communication/electronically connected"

These terms are used in several claims in the '734 patent and claims 13-15 of the '440 patent, such as in claim 4 of the '734 patent referring to a "first party control unit" which has "a sales random access memory chip electronically connected to the first party hard disk . . ." (Docket #69, Exhibit I, Column 9, lines 44-48). Claim 5 describes "the second memory" which includes "a playback random access memory chip electronically connected to the second party hard disk . . ." (Id., Column 10, lines 7, 10-12). Claim 11 discloses a "means or a mechanism for connecting

electronically via the telecommunications lines the first memory with the second memory such that the desired digital video or digital audio signals can pass therebetween, said connecting means or mechanism in electrical connection with the transferring means or mechanism. . . ." (Id., Column 10, lines 60-61).

Defendants assert that the ordinary and accustomed meaning of "electrical communication" is a connection through "a hard-wired conduction path." Defendants further point out that Figure 1 of the patents illustrates a hard-wired conduction path between all of the elements.

Sightsound responds, first, that even if a hard-wired conduction path is necessary, there is no basis in the claims or specification for requiring that it be "single," as opposed to multiple, hard-wired conduction paths. The court agrees. The term "single" cannot be part of the definition.

Second, Sightsound notes that defendants' definition would require that the parties' respective control units be in a hard-wired conduction path with one another. The court has already analyzed the term "connecting through telecommunications lines," and the court agrees, for the reasons set forth above, that the control units need not be in a hard-wired conduction path while "electronically connected over telecommunications lines."

What remains, however, is a determination of whether the individual components of the first party memory must be connected by a hard-wired conduction path, and whether the same is true for the components of the second party memory. Sightsound states that, as

to invention elements at the same site, "[t]he language of the claims specifically uses these terms to link related elements and it does so by clear and express recitations." (Docket #74, at 30). Thus, the parties are in agreement that, as to invention elements at the same location, "electronically connected" and "electrical communication" each require a hard-wired conduction path.

**L. "Individual songs" and "Temporary Staging Area"**

Defendants assert that "individual songs" should be interpreted as meaning "one or more digital audio signals." This language is used in Claims 26 and 27 of the '734 patent, and is in the context of describing "a plurality of digital audio signals which include a plurality of desired individual songs as desired digital audio signals" (Docket #69, Exhibit I, column 14, lines 41-43). Defendants are correct, therefore, that "individual songs" are a subset of "digital audio signals."

Likewise, the phrase "temporary staging area" is used in reference to the "playback random access memory chip" and the "playback random access memory chip." Specifically, claim 14 of the '440 patent discloses:

14. A system as described in claim 13 wherein the second party control unit includes a second party hard disk which stores a plurality of digital video or digital audio signals, and a playback random access memory chip electronically connected to the second party hard disk for storing a replica of the desired digital video or digital audio signals as a temporary staging area for playback.

(Docket #69, Exhibit K, Column 10, lines 63-67; Column 11, lines 1-2) (emphasis added). Similar language appears in claim 5 of the '734 patent with respect to the use of the "playback random access memory chip" of the second memory. Thus, defendants are correct that, in each instance, the term "temporary staging area" refers to the "random access memory chip" being used for that purpose.

**M. Means-Plus-Function Claims**

The parties also present several claims which employ the means-plus-function format. As a general matter, the parties disagree on the amount of structure necessary for each means-plus-function claim, although there are also two disputes concerning the propriety of analyzing claims as means-plus-function. The claims will be addressed seriatim.

1. "Means [or a mechanism] for electronically selling the desired digital video or digital audio signals" (Claims 4-8 & 10 of the '734 patent, and claims 12-15 of the '440 patent)

The parties agree that this is "means-plus-function" language which occurs in claims 4 and 10 of the '734 patent and claim 12 of the '440 patent<sup>17</sup>. Defendants assert that the phrase as

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17. This limitation also appears by incorporation in dependent claims 5-8 of the '734 patent and 13-15 of the '440 patent.



used in claim 4 of the '734 patent (which uses the term "means," and not "mechanism") should be construed to include the following structure:

A structure equivalent to (i) a continuous hard-wired conduction path directly interconnecting portions of Control Panel 20a and Control IC 20b, (ii) telephone lines 30, and (iii) a continuous hard-wired conduction path directly interconnecting portions of Control Panel 50a and Control IC 50b.

(Docket #65 at 36). Additionally, the language used in claim 12 of the '440 patent (which employs the phrase "means or a mechanism") requires a structure, in defendants' view, consisting of "a continuous hard-wired conduction path directly interconnecting portions of Control Panel 50a, Control IC 50b, Hard Disk 60, Playback RAM Chip 50d and Stereo Speakers 80." (*Id.*, at 40). Sightsound responds, with respect to both forms of the phrase, that "the corresponding structure is a control integrated circuit configured to effect the electronic sale of the digital video or digital audio signals." (Docket #69 at 24).

Thus, the parties have a very basic disagreement (which carries over to each of the remaining means-plus-function claims in dispute) concerning the amount of structure necessary to the disclosed function. Sightsound seeks an interpretation which limits the structure to the control integrated circuit and the particular configuration thereof which will enable the disclosed function to occur.<sup>18</sup> Defendants, on the other hand, seek to include in the

18. As discussed above with respect to the construction of the term "electronically connected," the court does not understand Sightsound to contest that the individual elements of the first party control unit are connected electronically through a

required structure all elements necessary to carry out the "selling," including the structure on the receiving end of the sale, and a "hard-wired conduction path."

Initially, the court agrees that the claim term at issue recites a function, but does not recite a definite structure in support of that function. Hence, this is means-plus-function language, and analysis pursuant to 35 U.S.C. §112(6) is appropriate. Cole v. Kimberly-Clark Corp., supra, 102 F.3d at 531.

Before determining the structure associated with the disclosed means, the court must first determine the meaning of the term "electronically selling." The parties have disputed this language, and the court has already determined that "the requirement that the sale include both payment and electronic transfer of the digital signal is express in claim 4 of the '734 patent." Hence, the function disclosed, a means for "electronically selling," is a means for effectuating the transfer of payment and product over telecommunications lines.

Defendants' inclusion of telephone lines and the structure on the buyer's side of the transaction is, however, improper in this case. Claim 4 of the '734 patent (and claim 12 of the '440 patent) set forth the "means for electronically selling" as part of the "first party control unit." The elements of the buyer's control unit, as well as the telecommunications lines connecting the two

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"hard-wired" connection, and that the same is true with respect to the elements of the second party control unit. Hence, the court will not address this element of the defendants' proposed definition in this or the ensuing claims.

control units, are set forth in separate paragraphs of the same claims, and are clearly not part of the "means" by which the first party control unit accomplishes the function necessary to effectuate the sale.

Thus, the more specific question to be answered in this case is what structure, as part of the first party control unit, is disclosed in the specification as being related to the function of electronically selling? The specification discloses that "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 or second party's Control Unit 50 is possible." (Docket #69, Exhibit I, Column 4, lines 12-16)<sup>19</sup>. Further, "Control Unit 20 has a control panel and control integrated circuit . . . [which] requires the Sales Random Access Memory Chip." (Id., lines 19-23). The reader is also informed that "[t]he Control Units 20 and 50 . . . would be designed specifically to meet the teachings of this invention." (Id., lines 35-37). The design of the control units is further described:

- 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

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19. This is the specification for the '734 patent. Identical language appears in the '440 patent specification (Id., Exhibit J, Column 4).

would prevent unauthorized reproductions of the copyrighted material,

(Id., lines 43-50) (emphasis added). Later in the specification, the "means or mechanism for electronically selling" is discussed.

Preferably, the means or mechanism for electronically selling includes a means or a mechanism for charging a fee via telecommunications lines by the first party to the second party . . . Preferably, the second party has an account and the means or mechanism for charging a fee includes means or mechanism for charging the account of the second party. Preferably, the means or mechanism for charging the account includes means or a mechanism for receiving the credit card number of the second party. The means or mechanism for receiving a credit card number preferably is part of the control integrated circuit 20b.

(Id., Column 7, lines 40-52).

Therefore, the specification discloses that the first party control integrated circuit will be "designed to control and execute the . . . commands of the [first party] and regulate the electronic transfer," and that it will be the "means or mechanism" for charging the account of the buyer. It follows, then, that the "means" for electronically selling, which includes the transfer of the product in return for electronic payment, is a properly programmed control integrated circuit.

2. "Means or mechanism for the first party to charge a fee to the second party" (Claims 26 and 27 of '734 patent).

This language appears in claims 26 and 27 of the '724 patent. Defendants propose that the structure disclosed for this function is:

... equivalent to (1) a continuous hard-wired conduction path directly interconnecting portions of Control Panel 20a and Control IC 20b, (ii) telephone lines 30, and (iii) a continuous hard-wired conduction path directly interconnecting portions of Control Panel 50a and Control IC 50b.

(Docket #65 at 39). Sightsound again responds that the only structure of the disclosed function is "a control integrated circuit configured to enable the first party to charge a fee to the second party." (Docket #69 at 25).

The analysis of this claim proceeds in much the same fashion as the analysis for the prior claim language. The inclusion of telephone lines and the structure associated with the second party control unit is unnecessary because the "means for charging a fee" is expressly made part of the first party control unit only. Thus, the structure the court must discern is the means by which the first party control unit "charges a fee."

The specification discloses that the function of charging a fee is accomplished by the control integrated circuit (*Id.*, Column 7, lines 40-52). Hence, the structure associated with this claim language is an appropriately programmed control integrated circuit.

3. "Means or mechanism for transferring money electronically via a telecommunication line" (Claims 11-14 of '734 patent).

Sightsound again asserts that an appropriately-configured integrated circuit is the necessary structure in claims 11-14 of the '734 patent (Docket #69 at 25). Defendants would describe the required structure thusly:

A structure equivalent to (i) a continuous hard-wired conduction path directly interconnecting portions of Control Panel 20a and Control IC 20b, (ii) telephone lines 30, and (iii) a continuous hard-wired conduction path directly interconnecting portions of Control Panel 50a and Control IC 50b.

(Docket #65 at 38). Again, the same analysis applies, and Sightsound's definition is correct.

4. "Means [or a mechanism] for playing the desired digital video or digital audio signals" (Claims 4-8 and 10 of '734 patent, and claims 12-15 of the '440 patent)

Defendants treat the phrase used in the '734 patent, "a means for playing . . . ." identically as they do the phrase used in claims 12-15 of the '440 patent, "a means or a mechanism for playing . . . ." Both, in defendants' view, require a "structure equivalent to a continuous hard-wired conduction path directly interconnecting portions of Control Panel 50a, Control IC 50b, Hard disk 60, Playback RAM Chip 50d and Stereo Speakers 80." (Docket #65 at 37, 40).

Sightsound argues that the structure is limited to an appropriately configured control integrated circuit "and a video display and/or speakers." (Docket #69 at 26).

Claim 4 of the '734 patent includes the following language in its description of the second party control unit:

a second party control unit having a second party control panel, a second memory connected to a second party control panel, and means for playing the desired digital video or digital audio signals connected to the second memory and the second party control panel, said means for playing operatively controlled by the second party control panel, said second party control unit remote from the first party control unit, said second party control unit placed by the second party at a location determined by the second party . . . .

(Docket #69, Exhibit I, Column 9, lines 54-63)<sup>20</sup>. The claim expressly discloses the connection between the second memory, the second control panel and the "means" for playing the signal. Therefore, defendants' inclusion of the second party control panel and memory (hard disk and RAM), is unnecessary since that structure is expressly described in the claim. The structure which is not disclosed in the claim is the structure which, when directed by the control panel, causes the signals to be played.

The specification provides in this respect:

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 . . . . The Control Integrated Circuit 50b then sends the electronic output back 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.

20. The language used in claim 12 of the '440 patent is identical with the addition of the words "or a mechanism" each time the work "means" is used (Id., Exhibit K, Column 10, lines 34-44).

(Id., Exhibit J, '734 Patent, column 5, lines 2-16). Thus, the structure necessary, in the context of the claims as written, is an appropriately configured control integrated circuit, connected by hard-wire electrical connection to a video display and/or stereo speakers.

5. Means or a mechanism for storing the desired digital video or digital audio signals" (Claims 11-14 of the '734 patent)

Sightsound proffers a structure consisting of "a control integrated circuit configured to effect the storing of the desired digital video or digital audio signals in the memory." (Docket #69 at 27). Defendants have it this way:

A structure equivalent to (i) a continuous hard-wired conduction path directly interconnecting portions of Control Panel 20a, Control IC 20b, and Sales RAM 20c, (ii) telephone lines 30, and (iii) a continuous hard-wired conduction path directly interconnecting portions of Control Panel 50a, Control IC 50b, Hard disk 60, and Incoming RAM 50c.

(Docket #65 at 39).

The claim language, appearing in claim 11 of the '734 patent, and incorporated in claim 12 as well, is part of "a system for transmitting desired" signals, and, in relevant part, provides for a:

means or a mechanism for storing the desired digital video or digital audio signals from the first memory in the second memory, said storing means or mechanism in electrical communication with said receiver or said transmitting means or mechanism and with said second memory.



(Docket #69, Exhibit I, Column 11, lines 33-38). Again, in the context of the claim, the elements being described are associated with the second party memory only. Thus, inclusion of telephone lines connecting the first and second memories is inappropriate, as is the inclusion of any structure on the first party side of the transaction. Further, the second memory is disclosed explicitly in the claim language, as is the connection between the "storing means" and the second memory. What is not disclosed is the structure to accomplish the "storing" in the second memory, and that is the focus of the court's inquiry.

The specification states that "[t]he Control Integrated Circuit 50b stores the replica onto the Play Back Random Access Memory Chip 50d at a high transfer rate." (Id., column 5, lines 9-12). The appropriate structure, then, is the control integrated circuit, which has been configured to effect the storing of the digital signals into the memory.

6. "Means or a mechanism for transmitting the desired digital audio signals from the first memory to the second memory" (Claims 11, 26 and 27 of the '734 patent)

Defendants assert that the language used in each cited claim requires:

A structure equivalent to (i) a continuous hard-wired conduction path directly interconnecting portions of Control Panel 20a, Control IC 20b, and Sales RAM 20c, (ii) telephone lines 30, and (iii) a

continuous hard-wired conduction path directly interconnecting portions of Control Panel 50a, Control IC 50b, Hard disk 60, and Incoming RAM 50c.

(Docket #65 at 38). Sightsound asserts that, as used in claim 11 of the '734 patent, this is not means-plus-function language. With respect to claim 26, plaintiff asserts that the "corresponding structure is a transmitter and a control integrated circuit configured to effect the transmitting of the desired digital video or digital audio signal via the transmitter." (Docket #69 at 27).

Claim 11 discloses the following:

means or a mechanism for transmitting the desired digital video or digital audio signals from the first memory to the second memory, said means or mechanism for transmitting comprising a transmitter connected to the first memory and the telecommunications lines and a receiver connected to the second memory . . . .

(Id., Exhibit I, Column 11, lines 19-24) (emphasis supplied). Sightsound is correct that the structure of the "means or a mechanism for transmitting" is disclosed in the claim language, and, hence, this is not "means-plus-function" language which requires reference to the specification.

The relevant language from claim 26, which describes a "system for transferring digital audio signals," and which sets forth the elements of the first party control unit, reads as follows:

means or mechanism for transmitting the desired digital audio signals from the sales random access memory chip, said means or mechanism for transferring connected to the sales random access memory chip . . . .

(Id., column 14, lines 48-51). Again, the inclusion of any structure which exists between the first and second party control units, or any structure which is part of the second party control unit, is improper because the claim is clearly limited to a description of the first party control unit. Further, the claim sets forth the existence and relationship between the transmitting means and the random access memory. Thus, inclusion of other elements of the first party control unit is unnecessary, and the court must discern the structure associated with the function of transmitting from the first party control unit.

The specification provides that the "Control Integrated Circuits 20b and 50d would be designed to control and execute the respective commands of the [parties] and regulate the electronic transfer . . ." (Id., column 4, lines 43-46). The transmitting function is clearly expressed in the specification, which discloses "a system for transmitting desired digital video or digital audio signals . . ." (Id., column 3, lines 13-14). Thus, the court cannot agree with defendants' proposed required structure. Instead, the corresponding structure is a transmitter connected to a properly programmed control integrated circuit.<sup>21</sup>

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21. Defendants protest that the specifications of the '734 and '440 patents do not contain a description of a "transmitter." One skilled in the art, however, would not have difficulty in determining the nature of a transmitter necessary to perform the function at issue. Atmel Corp. v. Information Storage Devices, Inc., 198 F.3d 1374, 1381 (Fed.Cir. 1999) (No specific level of detail necessary in the description of structure, so long as one skilled in the art would identify the structure from the description.).

7. "Means or mechanism for connecting electronically via the telecommunications link" (Claim 11 of the '734 patent)

Once again, defendants assert that this language requires:

A structure equivalent to (i) a continuous hard-wired conduction path directly interconnecting portions of Control Panel 20a, Control IC 20b, and Sales RAM 20c, (ii) telephone lines 30, and (iii) a continuous hard-wired conduction path directly interconnecting portions of Control Panel 50a, Control IC 50b, Hard disk 60, and Incoming RAM 50c.

(Docket #65 at 38). Sightsound responds that this language is not means-plus-function as utilized in that claim, and the court must refer to that language in context to rule on this issue:

means or a mechanism for connecting electronically via the telecommunications lines the first memory with the second memory such that the desired digital video or digital audio signals can pass therebetween, . . . said connecting means or mechanism comprises a first control unit in possession and control of a first party, and a second control unit in possession and control of a second party . . . .

(Docket #69, Exhibit I, Column 10, lines 65-67; column 11, lines 1-7). The court must agree with Sightsound that the structure of the connecting means is disclosed in the claim. Therefore, there is no need to refer to the specification.

#### I. Order of Steps

Defendants also assert that claims which list steps (Claims 1-3 of the '573 patent, Claims 4, 26 and 28 of the '734 patent, and claim 12 of the '440 patent) should be construed to

require that those steps be performed in the order that they are listed. "Unless the steps of a method actually recite an order, the steps are not ordinarily construed to require one." Interactive Gift Express, Inc. v Compuserve, Inc., et al., 231 F.3d 859, 875 (Fed.Cir. 2000). An order may be imposed, however, if such a requirement is apparent from the claim language, Mantech Environmental Corporation v. Hudson Environmental Services, Inc., 152 F.3d 1368, 1376 (Fed.Cir. 1998), or where such a sequential order is implicit from a review of the claim, the specification and the prosecution history. Loral Fairchild Corp. v. Sony Corp., 181 F.3d 1313, 1322 (Fed. Cir. 1999).

The specification of the '573 patent implies, in two separate paragraphs, that a specific order is required in performing the steps set forth in claims 1-3 (Docket #70, Tab 51, col. 3, lines 3-19; col. 5, lines 29-45). The specification first lists the "transferring money" step and states that "then" the step of connecting electronically occurs. "Next," transmitting the desired audio signal is set forth, and "then" storing the signal in the second memory. The use of these terms clearly implies that they are to be performed in the order in which they are set forth.

Further, Claim 1 of the '573 patent does contain an implied order of at least the final three steps (i.e., the "connecting," "transmitting" and "storing" steps). Indeed, one skilled in the art would recognize that the digital audio signal cannot be transferred until a connection is made such that the signal may pass from the first memory to the second memory. In like

fashion, the signal cannot be stored on the second memory until a connection has been made and the signal has been transmitted from the first memory. Therefore, although there is no explicit language in claims 1-3 of the '573 patent which imposes an order of steps, the plain meaning of the terms used, and the process described, implies such an order. Therefore, the connecting step must precede the transmission step, and the transmission must, in turn, precede the storing on the second memory. There is, however, no such indication that the transferring money step must occur at any specific time in this process.

Claim 2, on the other hand, contains express language imposing an order on the transferring step:

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.

(Emphasis supplied). Plaintiff concedes that this imposes some order upon the steps. Once again, one would necessarily have to select the desired signal from the first memory prior to the first memory transmitting same. Thus, transferring money must occur, for purposes of Claim 2, prior to transmitting (and, of course, prior to storing the transmitted signal on the second memory).

Claim 3, also a dependent claim, builds upon Claim 2 and adds additional steps to be included within the "transferring step." Once again, the steps set forth in Claim 3 must necessarily occur prior to the transmitting and storing steps.

Defendants urge that the transferring of money must be the first step in the method described in claims 1-3 of the '573 patent. The court disagrees. The patentee showed himself to be entirely capable of imposing an order upon steps when he wished to do so. Further, while the specification implies that an order is required, it does not expressly state that this is so. In the court's view, beginning and ending with the language of the claim, it would rewrite Claim 1 of the '573 patent to say that this claim requires the transferring money step to occur first.<sup>22</sup>

Nonetheless, the steps do have an order imposed by logic in light of the method which is described. Connecting electronically must be accomplished prior to the transmitting and storing steps. For similar reasons, the storing step must occur last in the context of Claim 1. The transfer of money, however, need not occur at any specific point. This, however, changes for Claims 2 and 3, which require that the transferring of money occur prior to transmission and storing, but does not impose any order on the transferring and connecting steps.

The court has reviewed Claim 4 of the '734 patent. In that claim, a system is set forth in which the "first party control unit" is described, then the "second party control unit" is described (Docket #69, Exhibit I, Claim.4). The operative language

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22. The parties here have argued their claims construction cases with a clear intent to more favorably position themselves for the next stages of the case. While this is unseemly, it is probable also inevitable. The court, however, cannot indulge in it; we construe the claims and do so without regard to what may come.

in terms of imposing order is contained in the third paragraph of the claim:

telecommunications lines connected to the first party control unit and the second party control unit through which the electronic sales of the desired digital video or digital audio signals occur and through which the desired digital video or digital audio signals are electronically transferred from the sales random access memory chip to the second memory while the second memory is in possession and control of the second party and after the desired digital video or digital audio signals are sold to the second party by the first party.

(Id.) (Emphasis added). This claim clearly states that the digital audio signals are transferred only "after" they are "sold" to the second party. Hence, the only order imposed in this Claim is that the sale of the desired digital audio signal occur prior to transmission of that digital audio signal. The court is not persuaded by defendants' argument that this claim should be interpreted as requiring the electronic transfer of money prior to connecting the first memory to the second memory. The claim does not recite any order in respect to the connection between the first and second memories and the transfer of money.

Claims 26 and 28 of the '734 patent are much the same, with two paragraphs describing the composition of the first and second party control units, respectively, followed by a third paragraph, which differs slightly from claim to claim, but which in each case contains the only language that mandates any order to the steps described. The third paragraph of Claim 26 reads:

telecommunications lines connected to the first party control unit and the second party control unit through which the desired digital audio signals in



the sales random access memory are electronically transferred by the means or mechanism for transferring to the receiver while the second party is in possession and control of the second party control unit and after the desired digital audio signals of the first party's hard disk are sold to the second party by the first party with the means or mechanism for the first party to charge a fee.

(Id., Claim 26). The third paragraph of Claim 28 provides:

telecommunications lines connected to the first party control unit and the second party control unit through which the electronic sales of the desired digital video or digital audio signals occur of the first party's hard disk, and over which the desired digital video or digital audio signals of the first party's hard disk are electronically transferred from the sales random access memory chip to the second memory while the second party is in possession and control of the second memory and after the desired digital video or digital audio signals are sold to the second party by the first party.

(Id., Claim 28). In both Claims 26 and 28, therefore, the transfer of the digital audio (or video) signal is expressly said to occur after the signal has been "sold" to the second party. Otherwise, no order is expressly or implicitly imposed by the claim.

This leaves Claim 12 of the '440 patent. It is set forth in a form similar to the claims from the '734 patent, with the first two paragraphs describing a "first party control unit" and a "second party control unit," respectively. The third paragraph provides as follows:

telecommunications lines connected to the first party control unit and the second party control unit through which the electronic sales of the desired digital video or digital audio signals occur and through which the desired digital video or digital audio signals are electronically transferred from the first memory to the second memory while the second memory is in possession and control of the

second party and after the desired digital video or digital audio signals are sold to the second party by the first party.

(Docket #69, Exhibit K, Claim 12). Once again, the claim expressly states that the sale occurs, followed by the transfer, but is otherwise silent concerning the order of any further steps in the method described.

J. "Telephoning the First Party . . . by the Second Party"

The dispute between the parties with respect to this claim language is whether it requires a person-to-person telephone call. Defendants assert that it does, while Sightsound asserts that it should include any means of initiating a connection over telephone lines, including person-to-machine calls, and machine-to-machine calls.

This language appears in Claim 3 of the '573 patent, claim 1 of the '734 patent, and claims 4 and 39 of the '440 patent. The '573 patent discloses:

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.

(Docket #70, Tab 51, Column 6, lines 29-36). The "transferring step" referred to in claim 3 is contained in claim 1, and reads as follows:

transferring money electronically via a telecommunication lien [sic] 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;

(Id., at lines 8-14). The '734 patent includes the disputed language in claim 1:

1. A method for transferring desired digital video or digital audio signals comprising the steps of:

forming a connection through telecommunications lines between a first memory of a first party at a first party location and a second memory of a second party at a second party location . . .

telephoning the first party controlling use of the first memory by the second part[y];

providing a credit card number of the second party controlling the second memory to the first party . . .

(Docket #69, Exhibit I, Column 8, lines 39-59). The language is included in claims 4 and 39 of the '440 patent as a step included within the process of "charging the account" of the second party. Both claim 4 and claim 39 read as follows:

A method as described in claim [3 or 38] wherein the step of charging the account of the second party 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.

(Docket #69, Exhibit K, Column 9, lines 7-13; Column 14, lines 40-46).

Defendants assert that each use of the "telephoning" language requires a construction that involves "placing a telephone

call by a person at the second party location to a person at the first party location."

Plaintiffs would construe the term "telephoning" to mean "initiating a connection over a telephone line."

Defendants first note that the telephoning step as set forth in each of the claims is separate from the step of "connecting" the memories electronically by telecommunications lines step. Hence, it is argued, "telephoning the first party" must have some meaning other than forming a connection via telephone lines, and that it must not involve a computer-to-computer connection.

The court, however, notes that the telephoning step may be performed by one person to another person, while the "connecting" step necessarily involves an interaction between the machines on either end, hence the language from, e.g., claim 1 of the '734 patent, "forming a connection through telecommunications lines between a first memory of a first party at a first party location and a second memory of a second party at a second party location .

... " Thus, the obvious distinction here is not that the "telephoning" must be person-to-person, but, instead, is that the connecting step cannot be a person-to-person call, but must involve machines. The "telephoning" step, however, is the more expansive term in this respect, and could include a person placing a call, either by dialing a telephone himself, or by instructing a computer or modem to dial a number. Likewise, the receiving end of that communication could be a person, or it could be computer configured to accept the call and to record the information provided. This

type of communication was not unknown to persons of ordinary skill in the art in 1988, and is certainly commonplace today.

Also, reference to the preferred embodiment and Figure 1 of the patent specification, which is a diagram included in each patent, shows the "Control I.C." of the first party connected by "Telephone lines" to the "Control I.C." of the second party. There is no indication in the specification, or in the diagram, that a separate, person to person communication is required for the steps of the claimed invention to be performed, i.e., there are no people, or telephones depicted in Figure 1.

Plaintiff also points to the 1995 Webster's Dictionary definition of "telephoning", which includes: (1) to communicate with by telephone; (2) to call on the telephone; and (3) to transmit by telephone (Plaintiff's Exhibit H). Defendants prefer the 1986 Webster's New Collegiate Dictionary definition, which is "to send by telephone" or "to speak by telephone." In the court's view, each version of the dictionary cited could reasonably be read to include either person-to-person calls or any combination of people and machines on either end. For example, the 1995 definition explicitly states that telephoning means "to communicate" or "to transmit" by telephone, and the 1986 version includes the concept of "to send" by telephone along with "speaking." It is only this final definition, "speaking," which implies a person-to-person communication.

Defendants also note that the inventor referred to the transferring money step and noted that this could be accomplished "such as by telephoning the agent who has the hard disc over the

phone lines . . . ." (Docket #70, Tab 37 at 2). A similar comment was made during the prosecution of the '734 patent (Docket #71, Tab 10 at 2). The use of the words "such as," however, bespeaks the existence of other options for accomplishing this step. Hence, the court does not find that any limitation on the manner of "telephoning" can be read into the patent claims through the prosecution history.<sup>23</sup>

The term "telephoning," therefore, does not include the restriction that it be a person-to-person call, and does not exclude the use of machines on either or both ends of the telephone communication. The court does not believe that further construction of this term is required.

K. CLAIMS 22, 36 AND 41 OF THE '440 PATENT

Defendants seek a ruling by this court that claims 22, 36 and 41 of the '440 patent are identical, or are so nearly so that there is no need to analyze an alleged infringing device separately under each claim. Even a cursory review of the claims establishes that they are, indeed, very similar. However, the court has not been presented with a construction question in this respect.

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23. The court is also unpersuaded by the extrinsic evidence, from the inventor's deposition testimony, that an "example" of an electronic sale would be "calling up and ordering a pair of shoes from L.L. Bean." (Hair Deposition at 179-180). First, this is extrinsic evidence which is not necessary in this instance for the court to construe the claim language. Second, even if it were used, it is merely an example offered by the inventor, and does not bespeak a limit on the language used in the claims.

Instead, defendants assert that the language is so similar, "indistinguishable" in defendants' view, that "it is difficult, if not impossible, to imagine either an accused infringing product or asserted piece of prior art that contains the elements of one of these claims, but not the other two." (Docket #65 at 34).

The court understands, and shares, defendants' anticipation of a substantial narrowing of the claims asserted in this case. Nonetheless, a concern that claims with the same coverage not be asserted so as to streamline this case is not properly addressed during claim construction. There is simply no construction of these claims necessary to answer defendants' question, i.e., whether a prior art challenge or an accused infringing product could be found that reads on one claim but not the others. What is required is for the case to reach the point where such matters can be litigated.<sup>24</sup>

J. "Stored replica/storing a replica/stores a replica"

Several claims in the '734 and '440 patents include the "replica" limitation<sup>25</sup>. It is employed in the first step of Claim 1 of the '734 Patent, referring to the forming of a connection

---

24. And, of course, if the claims are as indistinguishable as defendants maintain, it would do Sightsound no good service to assert all three when a ruling on infringement is sought. The decision to assert one or more of these claims is, however, not a decision to be made by the court in the guise of claim construction.

25. It does not appear in the '573 patent.

this comprises a "complete copy of the digital audio signal that is stored at one time in the random access memory chip." Sightsound has not proposed a construction, but does not disagree that a "replica" is a copy of a digital audio signal and that it is stored in the random access memory chip of either the first or second party control unit. Sightsound maintains, however, that defendants' construction improperly imposes two limitations on the term "stores a replica," the first being a requirement that a complete copy be made first, and the second being that the complete copy would then be stored, all at one time, in the memory. Sightsound contends that a replica may be made and sent from the hard disk to the random access memory, and from there to the second memory, in portions. Indeed, the plain language of the claims set forth above does not indicate that any specific method of creating and storing the replica is required.

Defendants argue that the inventor relinquished any claim to transferring portions of the signals into and out of the sales random access memory. An inventor may, through his action in distinguishing a reference to prior art, relinquish part of what would normally be included within a claim's plain meaning. Interactive Gift, 231 F.3d at 865, quoting Elkay Manufacturing Co., 192 F.3d at 976. The '734 patent initially did not include "replica" in the first three claims, but incorporated it into the fourth:

1. A method for transferring desired digital video or digital audio signals comprising the steps of :



forming a connection through telecommunications lines between a first memory of a first party and a second memory of a second party, said first memory having said desired digital video or digital audio signals;

selling electronically by the first party to the second party through telecommunications lines, the desired digital video or digital audio signals in the first memory; and

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 through telecommunications lines while the second memory is in possession and control of the second party.

2. A method as described in Claim 1 including after the transferring step, the step of storing the desired digital video or digital audio signals in the second memory.

3. A method as described in Claim 2 including before the transferring step, the step of electronically coding the desired digital video or digital audio signals into a configuration which would prevent unauthorized reproduction of the desired digital video or digital audio signals.

4. A method as described in Claim 3 wherein the first memory includes a first party hard disk having a plurality of digital video or digital audio signals, and a sales random access memory chip which temporarily stores a replica of the desired digital video or digital audio signals purchased by the second party for subsequent transfer via telecommunications lines to the second memory of the second party; and including before the transferring step, there is the step of storing a replica of the desired digital video or digital audio signals from the hard disk in to the sales random access memory chip.

(Docket #71, tab 12 at 11-12). The first three claims were rejected, however, as being anticipated by the Freney Patent (Docket #71, Tab 15 at 1). Freney was described by the patent examiner on May 4, 1994, as follows:

Freeny, Jr. a method for transferring digital information which includes forming a connection through telecommunications lines between a first memory of a first party and a second memory of a second party, the first party having the digital signals, selling electronically by the first party to the second party through the telecommunications lines the desired digital signals, transferring the desired digital signals from the first party to the second party through said lines while the second memory is in possession and control of the second party and the step of storing the digital signals in the second memory.

(Docket #71, Tab 15 at 2). Mr. Hair responded to this rejection by cancelling claims 2-4, and rewriting claim 1 as "Claim 4 in independent form with the limitations of any intervening claims." (Id., Tab 17 at 17). In other words, Claims 1-4 as initially presented were combined into the new claim 1. The amendment caused several changes to claim 1, including adding the "store a replica" language and the language incorporating the use of a sales random access memory chip (Id., at 2-3).

Defendants assert that the addition of the "store a replica" language effectively surrendered the option of storing less than a complete copy of the desired signal at one time. The court does not agree.

An amendment to avoid a prior art rejection will surrender coverage included within the plain meaning of a term only when "a patentee takes a position before the PTO, such that a 'competitor would reasonably believe that the applicant had surrendered the relevant subject matter . . . ." Katz, 63 F.Supp.2d at 591. Here, if the rejection by the examiner in light of Freeny could be read to be premised upon the lack of a requirement that the replica be

stored and transferred at one time, then, perhaps, defendants' argument would succeed. The examiner's description of Freeny, though, does not include any mention of transferring all or only a portion of the desired digital signal at one time. Hence, there is no indication that this was the basis for the prior art rejection.

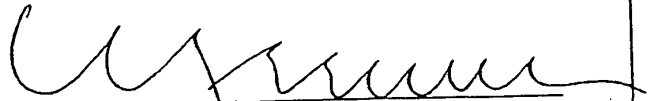
In fact, when one compares the elements lacking in the examiner's description of Freeny, and in proposed claims 1-3, with the new elements which were included in the amended claim 1, it appears that there could have been several bases for the examiner to find Freeny applicable. First, the amended claim 1 incorporates the description of "sales random access memory." Second, the concept of using a "replica" of the desired signal, rather than the signal itself, is introduced. Third, the amendment added the concept of the second party control unit being "remote" from the first party control unit. Hence, even if the lack of the term "replica" was the reason for the rejection, and the court is not convinced that it was, this would only establish that the use of the sales RAM to store such a replica prior to transfer was required to avoid Freeny. Again, the rejection and amendment do not suggest to the reasonable competitor that the inventor was surrendering coverage of a claim which includes transferring portions of the replica into and out of the sales RAM.

Therefore, the various forms of "stores a replica" will not be construed so as to require that a complete replica be stored at one time in the random access memory.

CONCLUSION

It is respectfully recommended that the claims in suit be construed in the manner set forth with more particularity above.

In accordance with the Magistrate's Act, 28 U.S.C. Section 636(b)(1)(B) and (C), and Local Rule 72.1.4 B, the parties are allowed ten (10) days from the date of service to file written objections to this report. Any party opposing the objections shall have seven (7) days from the date of service of objections to respond thereto. Failure to timely file objections may constitute a waiver of any appellate rights.



KENNETH J. BENSON  
UNITED STATES MAGISTRATE JUDGE

Dated: February 8, 2002

cc: Richard F. Rinaldo, Esquire  
Meyer, Unkovic & Scott  
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Pittsburgh, PA 15222

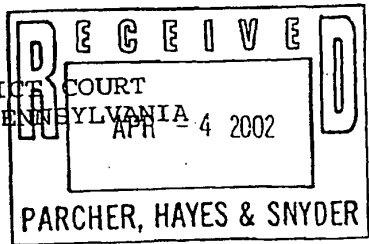
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595  
4/2/02



IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF PENNSYLVANIA

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.

Civil Action No. 98-118  
JUDGE DONALD J. LEE  
MAGISTRATE JUDGE BENSON

MAGISTRATE JUDGE'S REPORT AND RECOMMENDATION

I. RECOMMENDATION

It is respectfully recommended that the Report and Recommendation (Docket #105) of February 8, 2002, be amended so as to clarify that no "hard-wired conduction path" limitation applies to the terms "electrical communication/electronically connected" wherever they appear.

II. REPORT

A Report and Recommendation (Docket #105) was filed in this patent case on February 8, 2002, which recommended that the claims in suit be interpreted as set out in detail therein. All parties were informed of their right to file written objections.

On February 22, 2002, plaintiff Sightsound.com, Inc. filed a Request for Clarification of (or, in the Alternative, an Objection to) One Aspect of Report and Recommendation on Claim Construction

(Docket #107). An order (Docket #108) was entered on February 25, 2002, calling for the defendant to respond to the plaintiff's request/objection by March 4, 2002. Counsel for defendant informed the court by telephone that it would not be responding to the plaintiff's request, presumably relying on their more extensive objections to the Report.

At issue is the recommended construction of the terms "electrical communication/electronically connected" appearing at pages 64-65 of the Report. The terms are used in claims 4-8, 10, 11-14 and 26 of the '734 patent and in claims 13-15 of the '440 patent.

The defendant's proffered construction of the terms at issue began by proposing a requirement of "a continuous hard-wired conduction path . . . ." As the plaintiff correctly notes, the Report recommended a construction that, in respect to nearly all the claims, rejected the proposed "hard-wired conduction path" limitation. But when discussing whether the individual components of the first and second party memories must be connected by a hard-wired conduction path, the Report departed from the approach generally taken and proposed that the court hold that "as to invention elements at the same location 'electronically connected' and 'electrical communication' each require a hard-wired conduction path." (Report and Recommendation at 65). This is the recommendation which the plaintiff requests be clarified or, in the alternative, to which it objects.

The language quoted above was preceded by this clause: "Thus, the parties are in agreement that . . . ." The plaintiff

argues vigorously and persuasively that it is not now, nor has it ever been "in agreement" that the hard-wired conduction path is a limitation on the terms to be interpreted. What the plaintiff did say, and what the undersigned took to be agreement with the defendant, was this:

"Third, with respect to the electrical connection among the invention elements that are in the same location, this [i.e., the defendant's proposed] definition repeats and adds to the language of the claims. The language of the claims specifically uses these terms to link recited elements and it does so by clear and express recitations. Accordingly, the Court should afford these terms their plain and ordinary meaning as they appear in the claims." (Docket #74 at 30).

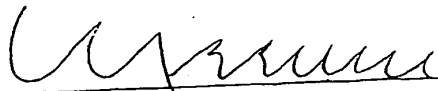
It is clear now that it was error to interpret the plaintiff's language as expressing its agreement with the defendant's proposed construction. Moreover, neither the claims wherein the terms appear nor the specification nor the prosecution history imply that such a limitation as is proposed by the defendant is necessary or was contemplated.

It is respectfully recommended that the Report and Recommendation (Docket #105) filed on February 8, 2002, be amended so as to make clear that no "hard-wired conduction path" limitation applies to the terms "electrical communication/electronically connected" wherever they appear.

In accordance with the Magistrates Act, 28 U.S.C. Section 636(b)(1)(B) and (C), and Local Rule 72.1.4 B, the parties are allowed ten (10) days from the date of service to file written objections to this report. Any party opposing the objections shall have seven (7) days from the date of service of objections to



respond thereto. Failure to timely file objections may constitute a waiver of any appellate rights.

  
KENNETH J. BENSON  
UNITED STATES MAGISTRATE JUDGE

Dated: April 2, 2002

cc: Honorable Donald J. Lee  
United States District Judge

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IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF PENNSYLVANIA

SIGHTSOUND TECHNOLOGIES, INC., )  
 )  
Plaintiff, )  
-vs- )  
Civil Action No. 04-1549 )  
 )  
ROXIO, INC., and NAPSTER LLC., )  
 )  
Defendants. )

AMBROSE, Chief District Judge.

**ORDER OF COURT**

AND NOW, this 28<sup>th</sup> day of February, 2005, after careful consideration, and for the reasons set forth in the accompanying Opinion, the Defendants' Motion to Stay (Docket No. 22) is GRANTED. This case is stayed. The Defendants are to contact this Court immediately upon receiving any notification from the PTO regarding the outcome of the Request for Reexamination. It is further ORDERED that the preliminary Injunction hearing currently scheduled for March 3, 2005 at 1:30 P.M. is canceled. The Motion for Preliminary Injunction (Docket No. 11) is denied without prejudice to reassert once the stay is lifted.

BY THE COURT:

---



Donetta W. Ambrose,  
Chief U. S. District Judge

A- 0001

IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF PENNSYLVANIA

SIGHTSOUND TECHNOLOGIES, INC.,	)	
	)	
Plaintiff,	)	
	)	
-vs-	)	Civil Action No. 04-1549
	)	
ROXIO, INC., and NAPSTER LLC.,	)	
	)	
Defendants.	)	

AMBROSE, Chief District Judge.

**MEMORANDUM OPINION**

As the parties are well aware, Plaintiff Sightsound Technologies, Inc. ("Sightsound") alleges that Defendants Roxio, Inc. ("Roxio") and Napster, L.L.C. ("Napster") have infringed its '573 Patent, its '734 Patent and its '440 Patent. Sightsound has filed a Motion for Preliminary Injunction with respect to particular embodiments of the '734 and the '440 Patents. That Motion remains outstanding and no hearing has yet been held.

Since Sightsound filed its Motion for Preliminary Injunction, Roxio and Napster have filed with the United States Patent and Trademark Organization ("PTO") a Request for Reexamination of the '573 Patent, the '734 Patent and the '440 Patent. Roxio and Napster argue that none of the patents are valid given prior art and double patenting. In light of its Request for Reexamination, Roxio and Napster have filed with this Court a Motion to stay the litigation pending the PTO's reexamination.

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See Docket No. 22. Roxio and Napster allege that a stay would preserve both this Court's and the parties' resources, as reexamination may render this litigation moot or substantially altered. Sightsound opposes the stay. It argues that this Court must first rule on the request for preliminary injunctive relief.

**ANALYSIS**

"A motion to stay an action pending a resolution of a request for re-examination is directed to the sound discretion of the court." Lutron Electronics Co., Inc. v. Genlyte Thomas Group, L.L.C., Civ. No. 3-2702, 2004 WL 953088 at \* 1 n. 2 (E.D. Pa. April 30, 2004), citing, Xerox Corp. v. 3Com Corp., 69 F. Supp.2d 404, 406 (W.D. N.Y. 1999). Staying the litigation and allowing the PTO to process the request for reexamination offers distinct benefits. First, as Congress contemplated, reexamination before the PTO would "permit efficient resolution of questions about the validity of issued patents without recourse to expensive and lengthy infringement litigation." 1980 U.S.C.C.A.N. 6460, 6462-63. Second, as Congress recognized, reexamination procedures allow courts to refer patent validity matters, which may involve complex and technical issues, to the expertise of the PTO. Id., p. 6463.

I think that Congress's purpose in providing for a reexamination procedure is well served by issuing a stay in this litigation. The three factors traditionally analyzed in determining whether to issue a stay - (1) whether a stay would unduly prejudice the non-moving party; (2) whether a stay would simplify issues for trial;

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and (3) whether the case has progressed beyond its initial stages<sup>1</sup> - favor issuing the stay.

For instance, Sightsound will not suffer undue prejudice if the litigation is stayed. I recognize that Sightsound claims it will suffer immediate harm if this Court does not entertain, and grant, its request for preliminary injunctive relief. Yet Sightsound's contention is belied by the fact that it delayed seeking injunctive relief for nearly one and one half years after discovering the Defendants' alleged infringing activity. Further, while Sightsound may suffer some harm if the action is stayed, that harm is not irreparable in nature. Sightsound itself acknowledged that its sole business purpose is to secure licensing arrangements of its patents and / or to secure damages through litigation. This supports the conclusion that Sightsound can be adequately compensated by a monetary award.

A stay would also simplify issues for trial. Indeed, Sightsound does not even argue this point. The reexamination process has, in my view, three possible outcomes. First, the PTO could reject all the patents as invalid. In this case, this litigation can be dismissed. Second, the PTO could affirm all of the patents as they are currently written. In this case, Sightsound's arguments regarding validity gain immeasurable strength and the issue of prior art becomes easier. Third, the PTO could accept, reject and / or modify one or more of the patents. In this instance I would again have the benefit of an expert in the field's take on the prior art. Any

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<sup>1</sup> See In re Laughlin Products, Inc., 265 F. Supp.2d 525, 530 (E.D. Pa. 2003) and Alloc, Inc. v. Unillum Decor N.V., Civ. No. 3-253, 2003 WL 21640372 at \* 2 (D. Delaware July 11, 2003).

one of the three scenarios would likely encourage settlement.

Finally, a stay at this procedural juncture would avoid a duplication of effort by this Court and the PTO. This case has not yet proceeded beyond the initial stages of litigation. No case management order has been issued. The parties have not yet engaged in extensive discovery. I have not yet held a Markman hearing. Resources are better spent pursuing the patent validity issue first before the PTO.

Consequently, because I find that Sightsound will not suffer undue prejudice if a stay is granted, because I think that a stay would likely simplify the matters at issue, and because this case has not yet proceeded beyond the initial stage, I find that a stay is appropriate.

\*\*\*\*\*

DATE FILED: FEBRUARY 28, 2005

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A- 0005

IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF PENNSYLVANIA

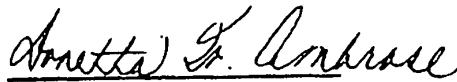
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 Defendants. )

AMBROSE, Chief District Judge.

**ORDER OF COURT**

AND NOW, this 28<sup>th</sup> day of February, 2005, after careful consideration, and for the reasons set forth in the accompanying Opinion, the Defendants' Motion to Stay (Docket No. 22) is GRANTED. This case is stayed. The Defendants are to contact this Court immediately upon receiving any notification from the PTO regarding the outcome of the Request for Reexamination. It is further ORDERED that the preliminary injunction hearing currently scheduled for March 3, 2005 at 1:30 P.M. is canceled. The Motion for Preliminary Injunction (Docket No. 11) is denied without prejudice to reassert once the stay is lifted.

BY THE COURT:



Donetta W. Ambrose,  
Chief U. S. District Judge

A- 0006

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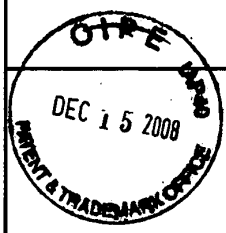
12-16-08

RE-EXAM

<b>CERTIFICATE OF MAILING BY "EXPRESS MAIL" (37 CFR 1.10)</b>		Docket No.	
Applicant(s): <b>Arthur R. Hair</b>		<b>NAPS001</b>	

Application No. <b>90/007,402</b>	Filing Date <b>January 31, 2005</b>	Examiner <b>Roland G. Foster</b>	Customer No. <b>23973</b>	Group Art Unit <b>3992</b>
--------------------------------------	--	-------------------------------------	------------------------------	-------------------------------

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



66155 U.S. PTO  
  
 12/15/08

I hereby certify that this **Amended Brief on Appeal Under 37 C.F.R. 41.37**  
*(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: Director of the United States Patent and Trademark Office, P.O. Box  
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**Lorraine T. Lewis**  
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Attorney's Docket No. NAPS001

Patent

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Arthur R. Hair	:	Group No.: 3992
Serial No.: 90/007,402	:	Examiner: Roland G. Foster
Filed: January 31, 2005	:	Confirmation No. 2998
For: METHOD FOR TRANSMITTING A DESIRED DIGITAL VIDEO OR AUDIO SIGNAL		

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the AMENDED BRIEF ON APPEAL UNDER 37 C.F.R. § 41.37, which was filed with the United States Patent & Trademark Office on December 15, 2008, in Reexamination No. 90/007,402, was served via First Class United States Mail, postage prepaid, this 15th day of December 2008, on the following:

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Attorney for Third Party Reexamination Requester

By:   
Robert A. Koons, Jr.  
Attorney for Appellant (Patentee)



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 12/31/2008

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: 12/31/2008

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(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. 90/007,402.

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)).



UNITED STATES DEPARTMENT OF COMMERCE  
U.S. Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
90007402	1/31/2005	5191573	NAPS001

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EXAMINER

ROLAND G.. FOSTER

ART UNIT	PAPER
3992	20081230


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

**Commissioner for Patents**

The Appellant filed an amended brief on December 15, 2008 correcting the Evidence Appendix deficiencies identified both in the Board of Patent Appeals and Interferences Order, mailed November 13, 2008 and in the resulting Notice of Non-Compliant Appeal Brief, mailed December 4, 2008.

No further action is required by the examiner and the proceeding is returned to the Board of Patent Appeals and Interferences.

  
ROLAND G. FOSTER  
CRU EXAMINER-AU 3992



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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.

90/007,402 01/31/2005 5191573 NAPS001 2998

23973 7590 01/27/2009
DRINKER BIDDLE & REATH
ATTN: INTELLECTUAL PROPERTY GROUP
ONE LOGAN SQUARE
18TH AND CHERRY STREETS
PHILADELPHIA, PA 19103-6996

Table with 1 column: EXAMINER

FOSTER, ROLAND G

Table with 2 columns: ART UNIT, PAPER NUMBER

3992

Table with 2 columns: MAIL DATE, DELIVERY MODE

01/27/2009

PAPER

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

Appeal No: 2009-3609  
Application: 90/007,402  
Appellant: Arthur R. Hair

## Board of Patent Appeals and Interferences Docketing Notice

Application 90/007,402 was received from the Technology Center at the Board on January 12, 2009 and has been assigned Appeal No: 2009-3609.

A review of the file indicates that the following documents have been filed by appellant:

Appeal Brief filed on: January 30, 2008  
Reply Brief filed on: June 23, 2008  
Request for Hearing filed on: June 23, 2008

In all future communications regarding this appeal, please include both the application number and the appeal number.

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By order of the Board of Patent Appeals and Interferences.

Third Party Requester:

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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                      03/12/2009  
DRINKER BIDDLE & REATH  
ATTN: INTELLECTUAL PROPERTY GROUP  
ONE LOGAN SQUARE  
18TH AND CHERRY STREETS  
PHILADELPHIA, PA 19103-6996

EXAMINER
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**Board of Patent Appeals and Interferences**

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 ONE LOGAN SQUARE  
 18TH AND CHERRY STREETS  
 PHILADELPHIA, PA 19103-6996

Appeal No: 2009-3609  
 Appellant: 5191573, Sightsound.com Incorporated(Owner),  
 Application No: Napster, Inc.(3rd Pty. Req.), Albert S. Penilla et al.  
 Hearing Room: 90/007,402  
 Hearing Docket: A  
 Hearing Date: B  
 Hearing Time: Wednesday, June 17, 2009  
 Location: 10:00 AM  
 Madison Building - East Wing  
 600 Dulany Street, 9th Floor  
 Alexandria, Virginia 22313-1450

**NOTICE OF HEARING  
 CONFIRMATION REQUIRED WITHIN TWENTY-ONE DAYS**

Your attention is directed to 37 CFR § 41.47. The above identified appeal will be heard by the Board of Patent Appeals and Interferences on the date indicated. Hearings will commence at the time set and as soon as the argument in one appeal is concluded, the succeeding appeal will be taken up. The time allowed for argument is twenty minutes unless additional time is requested and permitted before the argument is commenced. If there are any inquiries, please contact the Clerk of the Board at 571-272-9797.

The application involved in this appeal has been published. Accordingly, the hearing in this appeal is open to the public.

CONFIRMATION OR WAIVER OF THE HEARING IS REQUIRED. This form must be completed below and facsimile transmitted to both: (1) the USPTO Central fax number (official copy), and (2) the Board of Patent Appeals and Interferences fax number (courtesy copy) within TWENTY-ONE (21) DAYS from the mailing date of this notice indicating confirmation or waiver of the hearing. A copy of this notice may be alternately filed by mail if facsimile is not available.

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\_\_\_\_\_  
 Signature of Attorney/Agent/Appellant

\_\_\_\_\_  
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23973 7590 07/10/2009
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18TH AND CHERRY STREETS
PHILADELPHIA, PA 19103-6996

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex Parte* SIGHTSOUND.COM, INC.

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Appeal 2009-3609  
Application 90/007,402  
Technology Center 3900

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Oral Hearing Held: June 17, 2009

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Before JOSEPH F. RUGGIERO, SCOTT R. BOALICK, and KEVIN F.  
TURNER, *Administrative Patent Judges*.

APPEARANCES:

Examiner Roland G. Foster  
TC 3900

ON BEHALF OF THE APPELLANT:

Michael R. Casey, Esquire  
DAVIDSON, BERQUIST, JACKSON & GOWDEY, L.L.P.  
4300 Wilson, Blvd., 7th Floor  
Arlington, VA 22203

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PROCEEDINGS

JUDGE RUGGIERO: Okay, go.

DR. CASEY: Thank you. Thank you for your indulgence, Your Honor.

Your Honor, unlike the previous two cases, this one is not a question of Yurt and Goldwasser but some other prior art. But the case does still turn, for many of the issues on appeal, on the question of are the claims supported by a filing date early enough to obviate the applied reference as an actual piece of prior art?

The first three rejections in this case that are being appealed are rejections as to whether or not Cohen is prior art -- Cohen and Bush are prior art, and Bush and Cohen are prior art. I would submit to you that Cohen, which was filed December 16th, 1988, is not prior art because the claims are supported by the originally-filed specification, and that's a June 1988 specification. As such, Cohen is not properly prior art before -- against these claims.

So that really reduces us down to the adequate written description and enablement issues that we've already discussed probably more than once. And then the remaining two issues are whether or not the claims are obvious over two combinations: one, Bush and Freeny, which we call Freeny 1; and then a second one, Akashi and Freeny, which we call Freeny 2. Unfortunately, they're two different patents with the same inventor, but hopefully we can distinguish them.

Generally, as set out in the briefs, the combination of Bush and Freeny 1 don't disclose that the end result is supposed to be a storage of audio music

1 -- digital audio or digital video, in a nonvolatile memory that's not a CD or a  
2 tape. The -- as a result, the Freeny 1 is directed towards a totally different  
3 kind of invention. It's a digital -- it's a voice recorder versus a message  
4 recorder. And because of the area that Freeny 1 is in and the area that Bush  
5 is in, there's no actual motivation to combine these references, as has been  
6 described in the office action.

7 So, as described in the rejection, the motivation for combining --  
8 sorry, Your Honor.

9 JUDGE BOALICK: I believe you said that the motivation involved  
10 citations to Cohen as part of the rationale. Is that correct?

11 DR. CASEY: Yes, Your Honor.

12 JUDGE BOALICK: Did I understand that argument?

13 DR. CASEY: As mentioned in the Brief, the motivation to combine  
14 Freeny and -- Freeny 1 and Bush is premised on Cohen providing  
15 motivation, but Cohen is not actually prior art.

16 That takes us back to the original issues, one through three, as to  
17 whether or not Cohen is properly applied. And as a result, absent the  
18 motivation provided by Cohen, there is no evidence in the record that one of  
19 ordinary skill in the art would have made the combination proposed in the  
20 fifth issue -- I'm sorry, the fourth issue on appeal.

21 And then, the last issue is the combination of Akashi and Freeny.  
22 Akashi already discloses a CD and a tape and Freeny discloses an output -- a  
23 kiosk for outputting these physical devices, and those combinations are such  
24 that the -- one who was ordinarily skilled in the art wouldn't have looked to  
25 combine those two because they already had issues that were in common.

1           What was Akashi missing that Freeny was going to help fix? The  
2 Office Action talks about security of hard disks and other reasons like that.  
3 But there is no indication that one of ordinary skill in the art would believe  
4 that Akashi was somehow deficient or that Freeny was somehow deficient,  
5 that they needed to be modified. As a result, without the recognition of the  
6 problem, there can be no motivation to actually try to combine these two.

7           JUDGE BOALICK: How about -- the Examiner pointed out that I  
8 mean, as you've said before, that the very large hard disks were known, you  
9 know, as of -- at least as of 1988, and that really this might be considered  
10 under *KSR* no more than a substitution of known components with no  
11 unexpected results. I mean just substituting a hard drive for an optical drive,  
12 both of which had large capacities. What about that?

13           DR. CASEY: I think, Your Honor, that it misses the exact thing that  
14 has kind of made this invention what it is.

15           The original specification talks about the cumbersomeness of these  
16 disks, and the fact that they cause increased handling, and they require  
17 people to deal with media that they don't want to deal with. Now, that  
18 recognition that, hey, we can get rid of these and substitute with a hard disk,  
19 was that of the Applicant? And to now, in 2009, look back 20 years, it's  
20 very difficult to say, oh yeah, one of ordinary skill in the art would have said  
21 these are interchangeable.

22           But looking back at the time, forward, one of ordinary in the art, when  
23 he had Freeny and Akashi in his hands, wouldn't have even realized that  
24 there was this market to be tapped. That there was going to be this whole  
25 revolution of, God, I can free myself from CDs, and tapes, and the linear



1 problems of searching through tapes, and the optical problems of the hard  
2 disk, and instead, I can use a fast, magnetic disk that's going to provide me  
3 all these advantages. The one person who thought of it, unfortunately  
4 thought of it many, many years too soon, and it took the copyright holders  
5 many years to catch up to the importance of this invention.

6 JUDGE TURNER: Are you sort of stating that while they were  
7 equivalent they wouldn't have been equivalent for this application? I'm  
8 trying to summarize your argument.

9 DR. CASEY: I'm trying to say that the --

10 JUDGE TURNER: Because, certainly, hard disks and CDs would  
11 have been -- I mean in the computers at the time they both would have been  
12 prevalent. So that one could certainly make an argument that they're -- that  
13 one would be obvious over another. It seems to me maybe you're suggesting  
14 that the application of one wouldn't be applicable to the application of the  
15 other?

16 DR. CASEY: I'm saying that the use of one environment versus  
17 another is what's not obvious. In the computer world, you can -- you could  
18 use, you know, bubble memory. You could use core memory. But there are  
19 times when one thing has an actual use and would be appropriate and in  
20 other areas it just isn't. And it takes understanding what that area is before  
21 you can say whether or not these are equivalent. And one of the things that's  
22 missing from the rejection is an analysis of why these two things would have  
23 been considered equivalent in this particular area, such that we could present  
24 evidence to the contrary that in fact it wouldn't have been known. The  
25 motivation here just says, yeah, these things could have been interchanged

1 and there would have been these good results. But where is the evidence  
2 that those are the results that one of ordinary skill in the art 21 years ago  
3 would have expected from that particular modification?

4 JUDGE BOALICK: And I didn't see any, but you hadn't presented  
5 any evidence showing that one of ordinary skill at that time, you know,  
6 would not have thought to use a hard disk in place of a CD or a tape drive?  
7 Is that correct?

8 DR. CASEY: I would have to look back at the entirety of Dr. Tygar's  
9 declaration. I don't know it off the top of my head. If there was evidence,  
10 that's where it would be.

11 JUDGE BOALICK: Okay.

12 DR. CASEY: But until the burden shifts to the Applicant with  
13 evidence that there is some sort of known association, it's not yet the  
14 Applicant's burden to counteract.

15 JUDGE TURNER: But given the fact that we're certainly within our  
16 purview to make a new grounds of rejection, why couldn't we look at Akashi  
17 alone and say that no computers had both, let's say, a CD-R and a hard disk,  
18 and that those were known to a typical user to be equivalent? Why couldn't  
19 we just say that we just say that we would substitute that known equivalent  
20 into Akashi alone, even if that's not the rejection you may be fighting right  
21 now. How would you respond to, let's say, a future rejection?

22 DR. CASEY: Your Honor, I'd have to look at the system that you say  
23 you come up with.

24 One of the problems that I find I run into frequently is an Examiner  
25 tells me, "I would have combined A and B, and I would have gotten your

1 invention." But what I don't get is, if one of ordinary skill in the art would  
2 have taken A and would have taken B -- and don't tell me that you can get  
3 my invention. Show me the system that would have resulted. Show me,  
4 yes, I would have built this instead. And if once we have the this that could  
5 be built, yeah, maybe it reads on the claim, but at least it provides an  
6 evidentiary basis for me to say, okay, these are the assumptions you've  
7 made, now that you've tried to put together this particular system. And,  
8 unfortunately, I don't know that I can speculate on what Akashi, with a CD-  
9 ROM writer would have looked like.

10 I guess I can only say that if that's the rejection that comes out, I hope  
11 we'll get an opportunity to submit evidence that it wouldn't have been in the  
12 form that you're now proposing. And I don't know, in reexamination, what -  
13 - when there's a new grounds of rejection after a Board decision what leeway  
14 there is for filing declarations, but I hope we would be permitted to do so, in  
15 case that's necessary.

16 JUDGE TURNER: Okay. But you certainly would argue against it  
17 now?

18 DR. CASEY: I would, Your Honor.

19 JUDGE TURNER: Okay. That's good. If we're going -- when the  
20 Board asks you if we can do a new grounds of rejection you should always  
21 say no, please don't.

22 DR. CASEY: Yes.

23 JUDGE TURNER: That would be bare minimum.

24 DR. CASEY: Please don't.

25 JUDGE TURNER: Okay.

1 DR. CASEY: Thank you.

2 JUDGE TURNER: I have no further questions.

3 EXAMINER FOSTER: Regarding the obviousness rejections, Cohen  
4 is available as prior art. But, even if it wasn't, it would still be available as  
5 evidence at that approximate time that the invention was made. And in  
6 many cases I relied on explicit motivation to combine the references and  
7 they're all susceptible to a *KSR* analysis, as well.

8 JUDGE TURNER: Can I stop you? Just to go back for a second, if  
9 it's not available as prior art, how would it be available as motivation?

10 EXAMINER FOSTER: It's available as evidence regarding the state  
11 of the art, at approximately the time the invention was made.

12 I'm sorry I can't give you an MPEP cite, but  
13 non-prior art is available, even though it isn't prior art as evidence -- state of  
14 the art at the approximate time the invention was made. But I do believe it is  
15 prior art anyway.

16 I would like to discuss the 112 enablement rejections. And they  
17 mostly concern the new video download features added by amendment.

18 The Examiner has argued that the scope and breadth of these claims  
19 are not reasonably related to the scope of enablement in the original  
20 specification as filed, and that they would have required undue  
21 experimentation than they can use.

22 Now, the Appellant had responded by arguing, "It is clear that short  
23 videos are enabled and nothing more is required." That's on page 10 of the  
24 '402 Reply Brief. And here at the oral arguments they argued that it would  
25

1 have enabled a digital picture telephone, and it doesn't even require real-time  
2 streaming.

3       Thus, if the Board finds these Appellant arguments persuasive to  
4 overcome undue experimentation, the Examiner respectfully asks the Board  
5 to consider were the specification enabling nothing more than a short video  
6 clip, or a digital picture telephone, or non-real-time streaming would be  
7 consummate in scope with the claims, which could literally read on  
8 downloaded video the size of feature-length movies, which is an  
9 embodiment not sufficiently enabled. And there has been recent Federal  
10 Circuit case law moving in this -- to a more strict application of the scope of  
11 enablement requirement, specifically, *Lizard Tech*.

12       Nonetheless, the Examiner believes that the parent application as  
13 originally filed is insufficient to allow one of ordinary skill in the art to make  
14 or use the invention without undue experimentation. The Examiner  
15 provided substantial extrinsic evidence to support this. And I would also  
16 add that the applied prior art provides intrinsic evidence. The best prior  
17 references, I believe, are the intervening patents to Cohen and Yurt. And,  
18 once again, those have different dates, and they were using different --

19       JUDGE TURNER: Can I stop you, just to ask another quick  
20 question? What you seem to be saying, and please correct me if I'm wrong,  
21 is that in order for the claim to be enabled it would have to be enabled for all  
22 the embodiments that would fall under the scope of that claim. Is that what  
23 you're saying?

24       EXAMINER FOSTER: Yes. But in my -- I think the *Lizard Tech*.  
25 case is a good case to look at regarding this issue. The Appellant admitted

1 in the Brief and the admitted here that it disclosed very limited  
2 embodiments, like short video clips, digital picture telephones, and non-real-  
3 time streaming, yet these claims literally would read on the downloading of  
4 full- and true-length movies from the Internet, and that is definitely not --

5 JUDGE TURNER: That seems to be sort of --

6 EXAMINER FOSTER: -- an embodiment that's not enabled by the  
7 specification.

8 JUDGE TURNER: That seems like a little bit of a moving target  
9 though, isn't it? I mean in order to determine enablement, you'd have to  
10 consider all possible embodiments, even embodiments that Appellant -- I  
11 mean that the Applicant didn't cite?

12 EXAMINER FOSTER: There has been concern with the patent bar --  
13 the Federal Circuit's strict application of scope of enablement.

14 JUDGE TURNER: Okay.

15 EXAMINER FOSTER: Okay. But I still believe that the evidence is  
16 sufficient to support that -- the intrinsic evidence that I provided shows that  
17 it would have been -- one of ordinary skill in the art at the time of the  
18 invention would not have -- not only would it not have been beyond the  
19 scope, but one could not have made it without undue experimentation.

20 And, also, the intrinsic evidence, like the Cohen and Yurt prior art.  
21 Which the Appellant hasn't rebutted the merits of those -- that prior art as  
22 applied to the claims. Both describe audio and video download systems in  
23 much more detail. For example, consider figure 4, Cohen, figures 2-A and  
24 2-B of Yurt, to figure one of the Hair patents regarding the video server  
25 details.

1           Generally, the claims are broadly directed to audio and video  
2 download features, and we would expect it to be backed up by a well-  
3 written and specific disclosure, which is not the case here.

4           Okay, I wanted to return to the new matter rejection. I was working  
5 down a list of reasons why that was not -- did not create an issue to bar the  
6 current reexamination. I mentioned that the Examiner never specifically  
7 gave a reason why he withdrew, so that was speculation. That reexam sort  
8 of conducted on the basis of printed publications, not merely priority issues.  
9 But a priority rejection -- a priority determination is distinct from a new  
10 matter rejection. And another reason is that the new matter issues addressed  
11 by the Examiner are a specific subset of the new matter issues that I  
12 addressed in all the reexaminations proceedings regarding priority, and that's  
13 illustrated in table 3 of all the Examiner's Answers. Table 3 is in all the  
14 Examiner's Answers.

15           The Appellant does make an argument, an unpersuasive argument,  
16 about this table. The original Examiner rejected the newly-amended claims  
17 and objected to the amendment in the specification.

18           Now the amendment to this specification on December '91 was more  
19 extensive than the amendment to the claim, so it's -- I guess it's in the  
20 Appellant's interest to interpret this withdrawal as agreeing to the Appellant's  
21 support arguments. Thus the Appellant argues, for example, on pages 20  
22 and 21 of the Brief in the '402 reexamination that the original Examiner,  
23 "Included an objection to the specification as containing new matter under  
24 section 132," to which, "the applicant responded to and overcame the  
25 objection."

1 I just want to point out there's a problem. That's not what happened.  
2 The original Examiner never rejected the -- never objected to the  
3 specification under 132, which governs the matter -- the introduction of new  
4 matter into the disclosure. Instead, the Examiner objected under 35 U.S.C.  
5 112, first paragraph, which might have been incorrect, because 112 covers  
6 claim rejections, not objections to the specification, which is normally 132.

7 Thus, a section 132 new matter objection was never raised by the  
8 original Examiner, contrary to the Appellant's argument. And, furthermore,  
9 the Appellant failed to address the Examiner's objection to the specification,  
10 whether under 112, whether that's correct, whether under 132, or otherwise,  
11 again, contrary to the Appellant's statement.

12 For example, at page 10 of the June 1992 response, the Appellant  
13 states "The specification is objected to under 35 U.S.C. 112, first paragraph,  
14 as failing to provide support for the claimed invention." This does not object  
15 -- this Appellant response does not address the Examiner's new matter --  
16 objection to the new matter being added to the specification.

17 In the subsequent Appellant's arguments and declarations, evidence is  
18 then provided to traverse the 112 claim rejections. Thus there is no basis for  
19 concluding that a new matter introduced in the specification was ever  
20 properly objected to under 132 by the Examiner. And the Appellants  
21 mention that it was subjected to 132 during the oral arguments and it wasn't,  
22 must less that such an objection was withdrawn in the face of Appellant's  
23 argument regarding this objection.

24  
25



1           Indeed, there is not a basis to conclusively determine what happened,  
2 and that's going back to my original point I was making. This is a problem  
3 because the Examiner never explicitly stated what he was doing.

4           JUDGE TURNER: With the patent at issue. Yes. Examiner?

5           EXAMINER FOSTER: Excuse me?

6           JUDGE TURNER: The patent at issue.

7           EXAMINER FOSTER: Yes.

8           JUDGE TURNER: So I'm assuming that was resolved at least  
9 somewhat. It's not still pending. So I would -- I understand that you say that  
10 the record doesn't provide evidence, but I would think a logical inference to  
11 draw would be that it was resolved, at least in the Examiner's mind.

12          EXAMINER FOSTER: What was resolved, I'm sure there issues  
13 resolved.

14          JUDGE TURNER: In this case, you said there was a 112 issue that  
15 was raised that you said perhaps should have been --

16          EXAMINER FOSTER: Under 132.

17          JUDGE TURNER: -- done as a 132.

18          EXAMINER FOSTER: Yeah, and --

19          JUDGE TURNER: But it would seem like that would have to be  
20 resolved, at least in the Examiner's mind, or else she wouldn't have issued --  
21 allowed the patent to issue.

22          EXAMINER FOSTER: Well, but --

23          JUDGE BOALICK: Right. In other words, it doesn't seem like a  
24 reasonable inference to say that well, the Examiner still thought there was a  
25 problem, whether under 132 or 112, first paragraph, and nevertheless,

1 decided to issue the patent. I mean that just -- that doesn't seem to make a  
2 lot of sense. It seems like a more reasonable inference would be that that  
3 issue was resolved in the Examiner's mind before issuing the patent,  
4 especially because it has explicitly been raised.

5 EXAMINER FOSTER: Okay. But I worked through the listed  
6 issues, but regarding this issue, I just wanted to conclude by saying table 3 is  
7 accurate. It lists -- it states that a subset of new matter issues were addressed  
8 by the original Examiner. Not all the new matter issues addressed during  
9 this reexamination proceedings.

10 JUDGE BOALICK: Okay.

11 EXAMINER FOSTER: But as far a priority determination.

12 And, finally, regarding the policy issue, it's unfortunate that the  
13 prosecution history was unclear, but there was also Applicant behavior  
14 introducing and introducing these new matter issues and the specifications  
15 and continuations that in some part provoked this.

16 And I understand that Counsel here today is -- you know, were not the  
17 Patent Owner and the Attorney who originally prosecuted the case.  
18 However, that's what we're left with to work with. Thank you for your  
19 consideration. Good day.

20 DR. CASEY: Your Honor, there was a discussion earlier about  
21 whether a non-prior art can be used as evidence for motivation purposes,  
22 even if it can't be used for prior art purposes.

23 My understanding about the cases where that is true is where a piece  
24 of non-prior art says what happened earlier, and that can be used as evidence  
25 that such an event might have occurred. But this isn't the case here. We're

1 talking about a later person discovering something that is not applicable as  
2 prior art. He's not recounting what happened back in the Roman times and  
3 this is a recall of something that happened and that could be a point to be  
4 investigated. So my understanding is that Cohen is not properly usable as a  
5 motivation in the Bush and Freeny combination.

6         The undue experimentation, it only has to be commensurate in scope  
7 with the claims. It's clear that if you had to be able to enable every single  
8 embodiment that fell within the scope of the claims you would have to  
9 enable things that haven't yet been invented and we'd have to shut the Patent  
10 Office down. Because every time somebody invented a car, if it were run on  
11 a car with a fuel injector, well nobody has invented the fuel injector yet, so it  
12 literally covers a car with a fuel injector. That standard won't work. It just  
13 has to be a reasonable scope based on what was available and what was  
14 known at the time. Inventors are entitled to broad latitude here.

15         There was a discussion about the intervening patents and that they  
16 show enabled technology. Well, one of the things that is important to know  
17 is that disclosures there are not some fancy new chips and entered new  
18 technology that was suddenly available. It's a combination of older  
19 elements. And if the Examiner is saying that these other references which  
20 case shortly after were enabled, then I would submit that in fact it's evidence  
21 that the claims as originally filed by Applicant prior to those claims are also  
22 enabled if they're somewhere in scope.

23         There also was a discussion about whether or not the rejection of the  
24 specification should have been under 112 or 132. I think that 132 is the  
25 proper standard if the Examiner said 112, and that should have been used for

1 claims and people would have understood that no matter what the grounds  
2 was, if it was stated and the Examiner intended it to be the 132, because  
3 we're not talking about claims, and 112, first paragraph, relates to claims.  
4 So I think that we can't all of a sudden throw out the baby with the bathwater  
5 because of the -- the Examiner relied on the wrong section, that she wasn't  
6 relying on the right -- on the right process. So trying to make sure that what  
7 was in the specification or was added to the specification was in fact part of  
8 the original. I think that's all I have.

9 JUDGE TURNER: Questions? Okay.

10 Thank you.

11 DR. CASEY: Thank you, Your Honor.

12 EXAMINER FOSTER: Thank you.

13 (Whereupon, the hearing concluded on June 17, 2009.)

14 Third Party Requester

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90/007,402 01/31/2005 5191573 NAPS001 2998

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ATTN: INTELLECTUAL PROPERTY GROUP
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* DMT LICENSING, LLC  
Appellant and Patent Owner

---

Appeal 2009-003609  
Reexamination Control No. 90/007,402  
U.S. Patent No. 5,191,573  
Technology Center 3900

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Decided: September 4, 2009

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Before JOSEPH F. RUGGIERO, SCOTT R. BOALICK, and  
KEVIN F. TURNER, *Administrative Patent Judges*.

BOALICK, *Administrative Patent Judge*

DECISION ON APPEAL

Appeal 2009-003609  
Reexamination Control No. 90/007,402  
U.S. Patent No. 5,191,573

DMT Licensing, LLC<sup>1</sup> appeals under 35 U.S.C. §§ 134(b) and 306 from a final rejection of claims 1-6 and 44-49.<sup>2</sup> We have jurisdiction under 35 U.S.C. §§ 134(b) and 306.

We heard oral arguments on June 17, 2009, a written transcript of which is included in the record.

We REVERSE.

#### STATEMENT OF THE CASE

This proceeding arose from a request for *ex parte* reexamination filed by Napster, Inc. on January 31, 2005, of United States Patent 5,191,573 (the '573 patent) issued to Arthur R. Hair on March 2, 1993, based on United States Patent Application 07/586,391, filed September 18, 1990.

The instant appeal is related to appeals of two other copending reexaminations: 90/007,403 and 90/007,407. The former reexamination is made with respect to United States Patent 5,675,734 (the '734 patent, Appeal No. 2009-003457) and the latter with respect to United States Patent 5,966,440 (the '440 patent, Appeal No. 2009-003459). The relations between the issued patents and their applications are illustrated in the chart below:

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<sup>1</sup> DMT Licensing, LLC is said to be the real party in interest and current owner of the patent under reexamination. (App. Br. 2.) DMT Licensing, LLC is said to be a wholly-owned subsidiary of GE Intellectual Property Licensing, Inc., which is said to be a wholly-owned subsidiary of General Electric Co. (App. Br. 2.)

<sup>2</sup> Claims 7-43 have been cancelled.

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Appeal No.	Filing Date	Patent No.	Relationship
07/206,497 ("Parent" application)	Jun. 13, 1988	abandoned	-
07/586,391 ("Child" application)	Sep. 18, 1990	5,191,573	Continuation of '497
08/023,398	Feb. 26, 1993	abandoned	Continuation of '391
08/471,964	Jun. 6, 1995	5,966,440	Continuation of '398
08/607,648	Feb. 27, 1996	5,675,734	Continuation of '398

Patentee's invention relates to a system and an associated method for electronic sales and distribution of digital audio or video signals ('573 patent, col. 1, ll. 9-14). A first party, having authorization to distribute digital audio or video, transfers electronically digital copies of the same to a second party for storage in a local memory after a fee has been charged (*id.* at col. 3, l. 60 to col. 6, l. 2).

Claim 1, which we deem to be representative, reads as follows:

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 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 there-between;

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 CD.

The prior art references relied upon by the Examiner in rejecting the claims are:

Freeny ("Freeny II") <sup>3</sup>	4,528,643	Jul. 9, 1985
Bush	4,789,863	Dec. 6, 1988 (filed Jan. 13, 1988)
Freeny ("Freeny I")	4,837,797	Jun. 6, 1989 (filed Jan. 27, 1988)
Cohen	4,949,187	Aug. 14, 1990 (filed Dec. 16, 1988)

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<sup>3</sup> The "Freeny II" and "Freeny I" designations are used by both the Examiner and the Appellant. For consistency, we adopt the same terminology.

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Akashi JP 62-284496 Dec. 10, 1987

Audio Technologies – History of Recordings, <http://www.riaa.com/issues/audio/history.asp> (last visited Sep. 19, 2006).

History of the Compact Disc. – OneOff Media, Inc, <http://www.oneoffcd.com/info/historycd.cfm> (last visited Sep. 19, 2006).

History of MPEG, <http://www2.sims.berkeley.edu/courses/is224/s99/GroupG/report1.html> (last visited Sep. 19, 2006).

Ed Grochowski, IBM HDD Evolution chart, [http://www.storagereview.com/guideImages/z\\_ibm\\_storageevolution.gif](http://www.storagereview.com/guideImages/z_ibm_storageevolution.gif) (last visited Sep. 19, 2006).

The Examiner rejected claims 1-6 and 44-49 under the following bases (Ans. 4-76):

(1) Claims 1-6 and 44-49 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement;

(2) Claims 4-6 and 47-49 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement;

(3) Claims 1-6 and 44-49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bush and Cohen;

(4) Claims 1-6 and 44-49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bush and Freeny I;

(5) Claims 1, 2, 4, 5, 44, 45, 47, and 48 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Cohen;

(6) Claims 3, 6, 46, and 49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cohen and Bush; and

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(7) Claims 1-6 and 44-49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Akashi and Freeny II.

### ISSUES

Appellant contends that the Examiner is acting outside the scope of the Examiner's authority in the review and resulting reassignment of a priority date for the instant claims and, in any event, the claims of the '573 patent find support in the earlier-filed application (App. Br. 14-25). Appellant also argues that the Examiner has applied improper and overly strict standards for both written description and enablement (App. Br. 26-29, 36-39) and that any inquiry into the written description and enablement support for the claims should be limited to newly-claimed subject matter (App. Br. 41-42). Appellant contends that, in any event, the claims find support in the Specification (App. Br. 29-36, 39-44). With respect to the prior art rejections that apply Cohen under § 102 and § 103, Appellant argues that these rejections are improper because Cohen is not prior art (App. Br. 40, 44-46). Regarding the prior art rejection over Bush and Freeny I, Appellant argues that the Examiner has not established a prima facie case of obviousness because "*Freeny I* bears no relation to the disclosure of *Bush*" (App. Br. 47) and because the Examiner cited to Cohen, which Appellant contends is not prior art, in order to show motivation to combine the references (App. Br. 46-47). Regarding the prior art rejection over Akashi and Freeny II, Appellant contends that the combined references

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do not teach or suggest transmitting digital audio or video signals from a first memory to a second memory and storing these signals on a non-volatile storage portion of a second memory that is not a tape or CD and that is in possession and control of a second party (App. Br. 48-50). In addition, Appellant argues that the Examiner has not provided a sufficient reason to combine the teachings of Akashi and Freeny II (App. Br. 50-51). Appellant further points to secondary considerations of non-obviousness with respect to the § 103 rejections (App. Br. 51-54).

The Examiner finds that the application of the intervening prior art is justified because the instant claims are not entitled to the benefit of a filing date of an earlier-filed application (Ans. 5-19, 40-68). The Examiner defends the application of the written description and enablement standards applied (Ans. 20-27, 64-69). The Examiner also made specific findings of support for specific claim elements in the Examiner's "Table I. New Matter Chart" (Ans. 8, 9). In addition, the Examiner defends the substance of the prior art rejections (Ans. 28-40, 69-76).

Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

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The issues arising from the respective positions of Appellant and the Examiner are:

1) Has Appellant shown reversible error in the Examiner's determination that the instant claims are not entitled to the benefit of priority of a filing date of an earlier-filed application?

2) Has Appellant shown reversible error in the Examiner's determination that claims 1-6 and 44-49 are not supported under 35 U.S.C. § 112, first paragraph, in accordance with the written description requirement?

3) Has Appellant shown reversible error in the Examiner's determination that claims 4-6 and 47-49 are not supported under 35 U.S.C. § 112, first paragraph, in accordance with the enablement requirement?

4) Has Appellant shown reversible error in the Examiner's rejections of various claims as anticipated by Cohen or obvious over various combinations of Cohen and Bush?

5) Has Appellant shown reversible error in the Examiner's rejection of various claims under 35 U.S.C. § 103(a) as anticipated by the combination of Bush and Freeny I or the combination of Akashi and Freeny II?

#### FINDINGS OF FACT

1. The '573 patent describes a system and an associated method for electronic sales and distribution of digital audio or video signals ('573 patent, col. 1, ll. 9-14). A first party, having authorization to distribute digital audio or video stored on a first memory of the first party, transfers electronically digital copies of the same to a second party for storage in a local memory (second memory) after a fee has been charged (*id.* at col. 3, l. 60 to col. 6, l. 2; Abstract).
2. The '573 patent describes 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, where the second party is financially distinct from the first party (*id.* at col. 2, ll. 63-67; col. 3, ll. 6-8; col. 5, ll. 32-34; Abstract).
3. The '573 patent further describes electronically connecting the first memory with the second memory via a telecommunications line such that the desired digital audio signal can pass there-between (*id.* at col. 2, ll. 51-67; col. 3, ll. 8-12; Abstract; Fig. 1).
4. The '573 patent describes transmitting the desired digital audio signal from the first memory with a transmitter that is in control

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and possession of the first party to a receiver having the second memory at a location determined by the second party, where the receiver is in the possession and control of the second party (*id.* at col. 2, l. 51-67; col. 3, ll. 13-19 & 60-67; col. 4, ll. 25-44; Abstract; Fig. 1).

5. The '573 patent describes storing the digital signal in a non-volatile storage portion of the second memory, where the non-volatile storage portion is not a tape or CD (*id.* at col. 2, ll. 31-35; col. 3, ll. 17-19; col. 4, ll. 41-43; Abstract).

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6. The following is a reproduction of the Examiner's "Table I. New Matter Chart" (Ans. 8-9):

Table I. New Matter Chart

Feature	Parent Appn. 07/206,497, filed 6/13/88 (Abandoned)		Child Appn. 07/586,391, filed 9/18/90 (5,191,573)	
	Date First Appearing in Claims of Parent Appn.	Date First Appearing in Spec. of Parent Appn.	Date First Appearing in Claims of Child Appn.	Date First Appearing in Spec. of Child Appn.
Hard Disk/Control Unit of Seller/User	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
Electronic sales and distribution of the music		Filing Date of the Original Application -- 6/13/88		Filing Date of the Child Application -- 9/18/90
Broad Statements 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 (12/28/90)		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	7/28/90		Filing Date of the Child Application -- 9/18/90	12/11/91
Specific Video Download Procedures	1/28/90		Filing Date of the Child Application -- 9/18/90	12/11/91 New **
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/physical information to the user regarding downloaded audio content, and not directed to the actual download, processing, and display of video content.



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7. The following is a reproduction of a chart provided by Appellant in rebuttal to the Examiner's Table I in order to demonstrate that the original Examiner had previously considered the same new matter issues during the original prosecution of the '573 patent (App. Br. 20-21).

Feature	Parent Application 07/206,497 filed June 11, 1988		Child Application 07/586,391 filed September 18, 1990		Office Action in Application 07/586,391 and response		Essence of '573 Patent
	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	
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	Objections/ 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	Objections/ 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	Objections/ rejections responded to in June 25, 1992 response	Claims allowed in September 21, 1992 Office Action

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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 in June 25, 1992 response	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

*Bush*

8. Bush describes a pay-per-view entertainment system where subscribers have a receiver that is capable of receiving previews of musical works and, if the subscriber wants to make a recording of the complete work, the subscriber enters appropriate data, the receiver records the desired selection, and a service charge for recording the selection is automatically charged to the subscriber. (Col. 1, ll. 9-13, 45-64.) Bush states that, although the preferred embodiment is for prerecorded musical works, the invention could also apply to video recordings. (Col. 2, ll. 23-27.) For recording

the desired selection, Bush teaches that "[t]he audio signals are recorded on a cassette recording unit." (Col. 4, ll. 7-11.) Bush also teaches that the desired digital audio may be "recorded on an audio cassette or CD at the subscriber's receiver 100." (Col. 5, ll. 25-29; Fig. 5.)

*Freeny I*

9. Freeny I is directed to an electronic message unit that receives incoming calls, determines whether the incoming message is machine-interpretable or a voice message, and, respectively, either outputs the machine-interpretable message without causing an audible ringing of the telephone or outputs a ring signal for voice messages. (Abstract.) In one embodiment, "the electronic message unit 10 includes a message storage 44 which is a storage device adapted to receive and store machine interpretable messages in a storage medium which may be a memory electronic chip, video tape, hard disk or floppy disk." (Col. 5, ll. 20-25; Fig. 1.)

*Akashi*

10. Akashi describes an automated music purchasing system that uses telephone lines to transmit recorded music data from a host computer to a recording/recording reproduction device on a personal computer. (Specification "2. Claims:"; "3. Detailed

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Explanation of the Invention: (4) Means for Solving the Problems.") Akashi teaches that the recording/reproducing device (1) can use recordable optical disks or a digital audio tape recorder. (Specification "3. Detailed Explanation of the Invention: (6) Embodiment.")

*Freeny II*

11. Freeny II describes a system for reproducing information in material objects at a point-of-sale location where the information is provided from a remote location. (Abstract.) Freeny II teaches that an owner authorization code is provided to the point-of-sale location in response to a request to reproduce information in a material object, and that the information is reproduced in the material object in response to receiving the owner authorization code. (Abstract.) The material object is described as including a cassette tape, floppy disk, 8-track tape, reel-to-reel tape, and video disk. (Col. 4, ll. 36-55.)
  
12. Freeny II teaches that an information control machine 12 stores information and receives reproduction requests for the stored information at a particular information manufacturing machine (IMM) 14. (Col. 5, ll. 1-7; Fig. 1.) The IMM 14 receives encoded information via a communication link 18 or 20, stores the received

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encoded information, decodes information in response to receiving an authorization code, and provides decoded information to a reproduction unit 24 via an output line 22. (Col. 5, ll. 21-30; Fig. 1.) The reproduction unit 24 reproduces received information in a material object. (Col. 5, ll. 30-31; Fig. 1.)

#### PRINCIPLES OF LAW

Under the written description requirement of 35 U.S.C. § 112, first paragraph, the disclosure of the application relied upon must reasonably convey to the artisan that, as of the filing date of the application, the inventor had possession of the later-claimed subject matter. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1562-63 (Fed. Cir. 1991).

Under 35 U.S.C. § 120, "in a chain of continuing applications, a claim in a later application receives the benefit of the filing date of an earlier application so long as the disclosure in the earlier application meets the requirements of 35 U.S.C. § 112, ¶ 1, including the written description requirement, with respect to that claim." *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326 (Fed. Cir. 2008) (citing *Transco Prods., Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 556 (Fed. Cir. 1994)). "Although § 120 incorporates the requirements of § 112 ¶ 1, these requirements and the statutory mechanism allowing the benefit of an earlier filing date are separate provisions with distinct consequences. In accordance with § 120, claims to subject matter in a later-filed application not supported

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by an ancestor application in terms of § 112 ¶ 1 are not invalidated; they simply do not receive the benefit of the earlier application's filing date." *Reiffin v. Microsoft Corp.*, 214 F.3d 1342, 1346 (Fed. Cir. 2000).

Under the enablement requirement of 35 U.S.C. § 112, first paragraph, the specification of a patent must enable any person skilled in the art to which it pertains to make and use the claimed invention. Although the statute does not say so, enablement requires that the specification teach those in the art to make and use the invention without "undue experimentation." *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). Whether undue experimentation is required is a conclusion reached by weighing several underlying factual inquiries. *Id.*

"Section 103 forbids issuance of a patent when '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.'" *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 406 (2007). "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). "To facilitate review, this analysis should be made explicit." *KSR*, 550 U.S. at 418.

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## ANALYSIS

### *Rejections under 35 U.S.C. § 112, first paragraph*

We begin by noting that the process of determining whether a claim for the benefit of an earlier filing date under 35 U.S.C. § 120 is proper and supported is separate from the process of determining whether claims are enabled by and have written description support in the application in which they are presented. *See Reiffin v. Microsoft Corp.*, 214 F.3d 1342, 1346 (Fed. Cir. 2000) (holding District Court erred in looking to prior application in chain of continuing applications for support under § 112 of claims granted in two later applications). While the former requires an analysis under 35 U.S.C. § 112, first paragraph, to determine whether there is adequate written description in the cited application to support claims in the subject application, the latter is divorced from considerations of an earlier filing date. In other words, claims should be analyzed to determine whether they lack written description support or enablement with respect to the originally filed application in which they are presented. Determining whether such claims can claim the benefit of an earlier filing date is a separate inquiry. *See id.*; *see also* MPEP § 201.11.

The Examiner's analysis suggests adequate written description and enablement should rest with the parent application for an individual claim in a child application to be supported under 35 U.S.C. § 112, first paragraph. The Examiner argues that the original claims of the instant child patent are not entitled to the benefit of the filing date of its parent because the written

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description of the parent does not support features in the instant claims of the child (Ans. 7-11). Thus, according to the Examiner, support for the instant claims would need to be found in the earlier-filed "parent" application, i.e., 07/206,497, to have adequate support under 35 U.S.C. § 112, first paragraph. We do not agree.

At Oral Hearing in a related case discussing the same issue in the present case, the Examiner responded as follows:

JUDGE BOALICK: . . . as I read the Examiner's answer, it appears that you're saying that there is no written description or enablement in the [parent] application, as opposed to the particular application in which these claims arise. Is that – am I reading you answer correctly?

EXAMINER FOSTER: Yes.

(Oral Hr'g Transcript of 90/007,407, 12:14-18.)

In addition, the Examiner cites MPEP §§ 2258 and 2163.1 (Ans. 20), but those sections are directed to performing analysis for 35 U.S.C. § 112, first paragraph, under different circumstances. Any determination of whether the instant claims have support under 35 U.S.C. § 112, first paragraph, should be made with respect to the instant Specification, i.e., the '573 patent. From our review of the '573 patent Specification and claims, we find no aspect of the instant claims that is unsupported by the instant Specification in terms of written description and/or enablement (*see* FF 1-5).

Specific to new and amended claims which contain a negative limitation, e.g., claim 35 which recites "a non-volatile storage portion of the second memory . . . wherein the non-volatile storage portion is not a tape or



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CD", the Examiner argues that such a limitation has no basis in the original disclosure (Ans. 22-23). The Examiner makes reference to a lack of support in the "parent application" (Ans. 22), which is improper. Similarly, the Examiner's rejection for lack of enablement also discusses the "parent application," and talks about requiring undue experimentation to enable the large size files required for digital video (Ans. 23-27). Again, rejections under 35 U.S.C. § 112, first paragraph, should be made with respect to the Specification that is filed with the subject claims. As such, the Examiner's rejection of claims 1-6 and 44-49 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement and the Examiner's rejection of claims 4-6 and 47-49 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement were made in error.

*Claims of Priority Under 35 U.S.C. § 120*

The Examiner finds, with reference to Table I (Ans. 8-9), "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," (Ans. 7) and concludes that "Appellant 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" (Ans. 9). The Examiner's "Table I. New Matter Chart," (FF 6) looks at the presence of certain features in the "Parent" application and the "Child" application and

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asserts that many features claimed in the "Child" application are not supported in the "Parent" application. (FF 6.)

Appellant provides a detailed description of the original prosecution history of the '573 patent before the original Examiner (App. Br. 9-13, 19-23) and a summary chart (FF 7) in order to demonstrate that the priority date of the claims was previously considered by the original Examiner and is not a new issue. We find the Appellant's evidence and arguments to be more persuasive than the Examiner's. The fact that "a significant amount of new text" (Ans. 7) was added to the specification is not necessarily dispositive of whether new matter has been added. The Examiner points out that during the original prosecution, specifically in the Office Action mailed February 24, 1992, "[t]he original Examiner never rejected -- never objected to the specification under [35 U.S.C.] 132, which governs the matter -- the introduction of new matter into the disclosure. Instead, the [original] Examiner objected [to the Specification] under 35 U.S.C. 112, first paragraph." (Oral Hr'g Transcript 12:2-5; *see also* Ans. 56-57.) However, the Examiner also recognized that this "might have been incorrect, because 112 covers claim rejections, not objections to the specification, which is normally 132." (Oral Hr'g Transcript 12:5-6.) The original Examiner's reference to § 112, first paragraph, rather than § 132 in objecting to the Specification appears to be a typographical error, especially because the original Examiner also rejected the claims under § 112, first paragraph, "for the reasons set forth in the objection to the specification" (Office Action

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mailed Feb. 24, 1992, at 5-6). That the original Examiner allowed the application after the Applicant's response to the objection indicates to us that the original Examiner believed the issue to be resolved. An inference to the contrary would not be reasonable.

The Examiner also argues that descriptions of video download features are not supported by the parent application (Ans. 15-19; *see also* FF 6), specifically that the originally disclosed audio transmission features fail to imply or require any video transmission features. While the Examiner emphasizes that, circa 1988, devices capable of decoding and playing back digital video, storage for the same, and distribution channels of adequate bandwidth did not exist, we find more compelling Appellant's arguments that the Examiner is importing aspects into the claims (Reply Br. 10-15). Appellant argues correctly that the claims do not specify quality, size or bandwidth required for the video signals, and assuming the same to show inadequacy of disclosure is improper (*id.*).

In connection with the discussion above, Appellant argues that the priority date for claims in the instant patent is not a new issue related to patentability (App. Br. 19-25) because the original Examiner assigned a priority date of June 13, 1988 to the claims of the '573 Patent and the Office lacks jurisdiction to review again those issues determined by the original Examiner (*id.*). The Examiner emphasizes that where the sufficiency of the patent application has not been originally decided, the proper priority date to

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assign to claims is within the purview of the reexamination process  
(Ans. 40-63).

Central to this issue is whether *Patlex Corp. v. Quigg*, 680 F. Supp. 33 (D.D.C. 1988), is controlling. In that case, the patent holder sought review of a Board decision affirming the rejection of claims in a reexamination proceeding. A first examiner found a "great-grandparent" application provided an enabling disclosure to a "great-grandchild" application, which issued as the patent. During the reexamination proceedings, a second examiner reconsidered the merits of the first examiner's decision in order to make a rejection based on intervening prior art. However, the court found that "the reexamination statute does not contemplate a 'reexamination' of the sufficiency of a disclosure." *Id.* at 37. The court further found that the Examiner and the Board lacked jurisdiction to reexamine the sufficiency of the specification of the "great-grandparent" application. *Id.*

The Examiner finds that *Patlex* differs from the instant case in several ways (Ans. 62-63). The Examiner finds that, in *Patlex*, the specifications of the "great-grandparent" and "great-grandchild" applications were essentially identical, and that the claims were drawn to the same invention (Ans. 63). The Examiner finds this to be in contradistinction to the instant case where a "substantial amount" of new text was added to both the Specification and the claims (Ans. 63). However, as discussed *supra*, we do not find even a substantial amount of added matter to be dispositive of whether there was proper written description for that added matter. As discussed, the Examiner

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has not shown that the claims, including the recitations to digital video, are not supported by adequate written description to show that the Appellant did not have possession of the same by the time of filing of the Parent application on June 13, 1988. As such, we do not find the Examiner's distinctions between *Patlex* and the instant case to be compelling.

The Examiner also cites *Ex parte Basell*, Appeal No. 2007-0111 (BPAI 2007), *aff'd on other grounds, In re Basell Poliolefine Italia S.P.A.*, 547 F.3d 1371 (Fed. Cir. 2008), as allowing for a rejection based on intervening art because the filing date of the continuation was not entitled to the filing date of the parent (90/007,403 Oral Hr'g Transcript 14:14-21). In the Board's decision, the original examiner never considered the substantive issues of patentability of the claims over a specific piece of prior art because the examiner mistakenly accorded the claims an earlier filing date sufficient to antedate the prior art reference. *Ex parte Basell*, slip op. at 46-47 (BPAI 2007), available at <http://des.uspto.gov/Foia/ReterivePdf?system=BPAI&fINm=fd2007011103-29-2007>. The Board's decision distinguished *Patlex* by saying that, in that case, the specifications were identical and that the original examiner had determined that the original disclosure enabled the subject patent's claims. *Id.*, slip op. at 54. It is on this latter basis that the panel in *Basell* distinguishes and we do not.

As Appellant has argued and we have discussed above, the original application faced a new matter rejection, which was overcome. Thus, similar to *Patlex* and distinguishable from *Basell*, the original Examiner in

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the application for the instant patent considered whether the added texts were new matter and subsequently concluded they were not, such that the patent was allowed to issue. As such, under 35 U.S.C. §§ 301-302, 37 C.F.R. § 1.552(a), 37 C.F.R. § 1.552(c), and MPEP § 2258, the Examiner cannot be allowed to reexamine the sufficiency of the Specification.

*Prior Art Rejections over Cohen and  
Various Combinations of Cohen and Bush*

The anticipation rejection under 35 U.S.C. § 102(e) is over Cohen and two of the rejections under 35 U.S.C. § 103(a) rely on Cohen in combination with Bush. As discussed above, we find that the Examiner has not shown that the instant claims are not entitled to the benefit of the application filed June 13, 1988, i.e., the 07/206,497 application. As Appellant argues (App. Br. 40, 44-46), Cohen is not prior art because Cohen issued from an application filed December 16, 1988. Thus, Cohen cannot be considered prior art to the instant claims under 35 U.S.C. §§ 102 and 103. We find, therefore, that the prior art rejections that rely on Cohen are improper and that the Examiner erred in rejecting the claims over the same.

*Prior Art Rejection over Bush and Freeny I*

The Examiner finds that Bush fails to teach or suggest storing a digital signal in a non-volatile storage portion of the second memory that is not a tape or CD. (Ans. 31, 33.) The Examiner finds that "Freeny I (similarly to

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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)." (Ans. 33.)

Almost identically to the rationale presented in support of the combination of Bush and Cohen (Ans. 31-32), but absent the quotations from Cohen (Ans. 31), the Examiner states that:

The suggestion/motivation for adding the hard disk as taught by Freeny I 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.

(Ans. 34.)

We generally agree with Appellant that the Examiner has not established a prima facie case of obviousness. We agree with Appellant that the Examiner appears to have improperly used Cohen in setting forth the rationale to combine Bush and Freeny I. At oral argument, the Examiner asserted that, in accordance with the MPEP, even if Cohen was not prior art "it would still be available as evidence at that approximate time that the invention was made." (Oral Hr'g Transcript 8:4-5.) We do not agree. MPEP § 2141.03 cites *Ex parte Erlich*, 22 USPQ 1463 (BPAI 1992) for the proposition that "[r]eferences which do not qualify as prior art because they

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postdate the claimed invention may be relied upon to show the level of ordinary skill in the art at or around the time the invention was made." However, *Ex parte Erlich* involved a situation where a later, non-prior art reference discussed the state of the art at a relevant, earlier, time period of the prior art. The current situation is distinguishable because the Examiner has not shown where Cohen discusses the state of the art at or prior to the time of the current invention. Thus, relying on Cohen for motivation to combine Bush and Freeny I is improper. Also, the Examiner has not shown that one of ordinary skill in the art at the time of the invention would have considered the hard disk of the answering machine of Freeny I (FF 9) to be equivalent to the audio tape and CD of the pay-per-view system of Bush (FF 8). Accordingly, we find that Appellant has shown error in this rejection.

*Prior Art Rejection over Akashi and Freeny II*

The Examiner finds that "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." (Ans. 38.) However, the Examiner finds that Freeny II cures these deficiencies, and in particular finds that "Freeny II 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)." (Ans. 38.)



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We generally agree with Appellant that the combination of Akashi and Freeny II does not teach or suggest storing the digital signal in a non-volatile portion of the second memory that is not a tape or CD, where the second memory is controlled by and in the possession of the second party. The Examiner cites (Ans. 38) the teaching in Freeny II of the IMM 14 storing encoded information received from the information control machine 12 prior to decoding this information and reproducing it in a material object using the reproduction unit 24 (FF 12). However, we agree with Appellant that the IMM 14 is under the control and in the possession of the first party, not the second party purchasing the material object. In addition, given the very different manner in which the systems of Akashi and Freeny II function (*see* FF 10-12), we agree with Appellant that the Examiner has not sufficiently articulated a rationale for modifying the system of Akashi with the teachings of Freeny II.

#### CONCLUSIONS

Appellant has shown that the Examiner reversibly erred in determining that:

- (1) Claims 1-6 and 44-49 fail to comply with the written description requirement of 35 U.S.C. § 112, first paragraph;
- (2) Claims 4-6 and 47-49 fail to comply with the enablement requirement of 35 U.S.C. § 112, first paragraph;

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(3) Claims 1-6 and 44-49 are unpatentable over Bush and Cohen under 35 U.S.C. § 103(a);

(4) Claims 1-6 and 44-49 are unpatentable over Bush and Freeny I under 35 U.S.C. § 103(a);

(5) Claims 1, 2, 4, 5, 44, 45, 47, and 48 are anticipated by Cohen under 35 U.S.C. § 102(e);

(6) Claims 3, 6, 46, and 49 are unpatentable over Cohen and Bush under 35 U.S.C. § 103(a); and

(7) Claims 1-6 and 44-49 are unpatentable over Akashi and Freeny II under 35 U.S.C. § 103(a).

#### DECISION

The decision of the Examiner to reject claims 1-6 and 44-49 is REVERSED.

REVERSED

bim

cc:

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

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# Litigation Search Report CRU 3999

Reexam Control No. 90/007,402

**TO: Foster, Roland**  
**Location: CRU**  
**Art Unit: 3992**  
**Date: 02/17/10**

**From: Sharon S. Hoppe**  
**Location: CRU 3999**  
**MDW 7C84**  
**Phone: (571) 272-1586**

**Case Serial Number: 90/007,402**

**Sharon.hoppe@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.

2:04cv1549 Closed



Date of Printing: Feb 17, 2010

**KEYCITE****H US 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. 07/586391)**  
*Construed by*
- H** 2 **SightSound.Com Inc. v. N2K, Inc., 185 F.Supp.2d 445, 2002 Markman 229872 (W.D.Pa. Feb 08, 2002) (NO. CIV.A.98-CV-118) (Markman Order Version)**  
*AND Ruled Valid by*
- H** 3 **Sightsound.com Inc. v. N2K, Inc., 391 F.Supp.2d 321 (W.D.Pa. Oct 24, 2003) (NO. CIV.A. 98-CV-118)**
- H** 4 **SYSTEM FOR TRANSMITTING DESIRED DIGITAL VIDEO OR AUDIO SIGNALS, US PAT 5675734, 1997 WL 1488819 (U.S. PTO Utility Oct 07, 1997) (NO. 08/607648)**  
*Construed by*
- H** 5 **SightSound.Com Inc. v. N2K, Inc., 185 F.Supp.2d 445, 2002 Markman 229872 (W.D.Pa. Feb 08, 2002) (NO. CIV.A.98-CV-118) (Markman Order Version)**  
*AND Ruled Valid by*
- H** 6 **Sightsound.com Inc. v. N2K, Inc., 391 F.Supp.2d 321 (W.D.Pa. Oct 24, 2003) (NO. CIV.A. 98-CV-118)**
- H** 7 **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. 08/471964)**  
*Construed by*
- H** 8 **SightSound.Com Inc. v. N2K, Inc., 185 F.Supp.2d 445, 2002 Markman 229872 (W.D.Pa. Feb 08, 2002) (NO. CIV.A.98-CV-118) (Markman Order Version)**  
*AND Ruled Valid by*
- H** 9 **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**

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

## W.D.Pa. Expert Testimony

- 10 SIGHTSOUND.COM INCORPORATED, a Pennsylvania corporation, Plaintiff, v. N2K, INC., a Delaware corporation, Cdnw, Inc., a Pennsylvania corporation, and Cdnw Online, Inc., a Pennsylvania corporation, Defendants., 1998 WL 34373758 (Expert Report and Affidavit) (W.D.Pa. 1998) **Opening Expert Report of James A. Moorer** (NO. 98-0118)
- 11 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., 2001 WL 34891529 (Expert Deposition) (W.D.Pa. Apr. 19, 2001) **Proceedings** (NO. 98-118)
- 12 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)
- 13 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)
- 14 SIGHTSOUND.COM INCORPORATED, a Pennsylvania corporation, Plaintiff, v. N2K, INC., a Delaware corporation, Cdnw, Inc., a Pennsylvania corporation, and Cdnw 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)
- 15 SIGHTSOUND.COM INCORPORATED a Pennsylvania corporation, Plaintiff, v. N2K, INC., a Delaware Corporation, Cdnw, Inc., a Pennsylvania corporation, and Cdnw Online, 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)
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- 18 SIGHTSOUND.COM, INCORPORATED, Plaintiff, v. N2K, INC., Cdnw, Inc., and Cdnw Online, Inc., Defendants., 2003 WL 24309947 (Partial Expert Testimony) (W.D.Pa. Mar. 9, 2003) **Deposition of Justin Douglas Tygar, Ph.D.** (NO. 98-0118)
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- 20 In the Matter of: SIGHTSOUBD.COM INC., v. N2K, INC. et al., 2003 WL 24309948 (Partial

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- 21 SIGHTSOUND.COM, INC., a Pennsylvania corporation, Plaintiff, v. N2K, INC., a Delaware corporation, Cdnw, Inc., a Pennsylvania corporation, and Cdnw 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)
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**W.D.Pa.**

- 27 SIGHTSOUND.COM INC. v. N2K, INC., ET AL, NO. 2:98cv00118 (Docket) (W.D.Pa. Jan. 16, 1998)

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- (W.D.Pa. 1998) **Opening Expert Report of James A. Moorer** (NO. 98-0118)
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- 31 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)
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- 35 SIGHTSOUND.COM INCORPORATED, a Pennsylvania corporation, Plaintiff, v. N2K, INC., a Delaware corporation, Cdnw, Inc., a Pennsylvania corporation, and Cdnw Online, Inc., a Pennsylvania corporation, Defendants., 2003 WL 24309949 (Partial Expert Testimony) (W.D.Pa. Mar. 3, 2003) **(Partial Testimony)** (NO. 98-0118)
- 36 SIGHTSOUND.COM INCORPORATED, Plaintiff, v. N2K, INC., Cdnw, Inc., and Cdnw Online, Inc., Defendants., 2003 WL 24309947 (Partial Expert Testimony) (W.D.Pa. Mar. 9, 2003) **Deposition of Justin Douglas Tygar, Ph.D.** (NO. 98-0118)
- 37 SIGHTSOUND.COM INCORPORATED, a Pennsylvania corporation, Plaintiff, v. N2K, INC., a Delaware corporation, Cdnw, Inc., a Pennsylvania corporation, and Cdnw Online, Inc., a Pennsylvania corporation, Defendants., 2003 WL 24309950 (Expert Deposition) (W.D.Pa. Mar. 11, 2003) **(Deposition)** (NO. 98-0118)
- 38 In the Matter of: SIGHTSOUBD.COM INC., v. N2K, INC. et al., 2003 WL 24309948 (Partial Expert Testimony) (W.D.Pa. Mar. 12, 2003) **(Partial Testimony)** (NO. 98-0118)
- 39 SIGHTSOUND.COM, INC., a Pennsylvania corporation, Plaintiff, v. N2K, INC., a Delaware corporation, Cdnw, Inc., a Pennsylvania corporation, and Cdnw 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)



- 40 SIGHTSOUND.COM, INC., a Pennsylvania corporation, Plaintiff and, Counterdefendants, v. N2K, INC., a Delaware corporation, CDNOW, Inc., a Pennsylvania corporation, and Cdnw 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)

**W.D.Pa. Trial Motions, Memoranda And Affidavits**

- 41 SIGHTSOUND.COM INC., Plaintiff, v. N2K, INC., Cdnw, Inc., and CDnow Online, Inc., Defendants., 2004 WL 3742179 (Trial Motion, Memorandum and Affidavit) (W.D.Pa. Jan. 12, 2004) **Sightsound's Motion in Limine to Preclude Certain Testimony of James A. Moorer, Ph. D.** (NO. 98-0118)
- 42 SIGHTSOUND.COM INC., Plaintiff, v. N2K, INC., CDnow, Inc., and CDnow Online, Inc., Defendants., 2004 WL 3742180 (Trial Motion, Memorandum and Affidavit) (W.D.Pa. Jan. 12, 2004) **Sightsound's Motion in Limine to Preclude Certain Testimony of Michael Ian Shamos, Ph.D., J.D.** (NO. 98-0118)
- 43 SIGHTSOUND.COM INC., Plaintiff, v. N2K, INC., CDnow, Inc., and CDnow Online, Inc., Defendants., 2004 WL 3742181 (Trial Motion, Memorandum and Affidavit) (W.D.Pa. Jan. 27, 2004) **Defendants' Opposition to Plaintiff's Motion in Limine to Preclude Certain Testimony of James A. Moorer, Ph.D** (NO. 98-0118)
- 44 SIGHTSOUND.COM INC., Plaintiff, v. N2K, INC., Cdnw, Inc., and CDnow Online, Inc., Defendants., 2004 WL 3742182 (Trial Motion, Memorandum and Affidavit) (W.D.Pa. Jan. 27, 2004) **Defendants' Opposition to Plaintiff's Motion in Limine to Preclude Certain Testimony of Michael Shamos, Ph.D, JD.** (NO. 98-0118)

**W.D.Pa.**

- 45 SIGHTSOUND.COM INC. v. N2K, INC., ET AL, NO. 2:98cv00118 (Docket) (W.D.Pa. Jan. 16, 1998)

**Patent Family**

- 46 TRANSMITTING DESIRED DIGITAL VIDEO OR AUDIO SIGNAL - TRANSFERRING MONEY VIA TELECOMMUNICATIONS LINE, CONNECTING ELECTRONICALLY FIRST MEMORY WITH SECOND MEMORY AND TRANSMITTING SIGNAL WITH TRANSMITTER IN CONTROL OF FIRST, Derwent World Patents Legal 1993-093541

**Assignments**

- 47 Action: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS). Number of Pages: 006, (DATE RECORDED: Dec 27, 2005)
- 48 ACTION: NOTICE OF GRANT OF SECURITY INTEREST NUMBER OF PAGES: 006, (DATE RECORDED: Oct 24, 2001)
- 49 ACTION: CHANGE OF NAME (SEE DOCUMENT FOR DETAILS). NUMBER OF PAGES: 016, (DATE RECORDED: May 03, 2000)
- 50 ASSIGNEE(S): PARSEC SIGHT/SOUND,

INC., (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)

**Docket Summaries**

- 54 "SIGHTSOUND TECH v. ROXIO, INC., ET AL", (W.D.PA. Oct 08, 2004) (NO. 2:04CV01549), (35 USC 271 PATENT INFRINGEMENT)

**Litigation Alert**

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

**Prior Art (Coverage Begins 1976)**

- ▶ 56 AUTOMATIC INFORMATION, GOODS AND SERVICES DISPENSING SYSTEM, US PAT 4567359 (U.S. PTO Utility 1986)
- Ⓒ 57 COIN-OPERATED RECORDING MACHINE, US PAT 3990710 (U.S. PTO Utility 1976)
- Ⓒ 58 SOFTWARE VENDING SYSTEM, US PAT 4654799 Assignee: Brother Kogyo Kabushiki Kaisha, (U.S. PTO Utility 1987)
- Ⓒ 59 VENDING SYSTEM FOR REMOTELY ACCESSIBLE STORED INFORMATION, US PAT 3718906 Assignee: Lightner R, (U.S. PTO Utility 1973)
- Ⓒ 60 VIDEO CASSETTE SELECTION MACHINE, US PAT 4647989 (U.S. PTO Utility 1987)

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**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, August 04, 2008**

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<b>Date Filed: 10/08/2004</b>	<b>Class Code: CLOSED</b>
<b>Assigned To: Chief Judge Donetta W Ambrose</b>	<b>Closed: Yes</b>
<b>Referred To:</b>	<b>Statute: 35:271</b>
<b>Nature of suit: Patent (830)</b>	<b>Jury Demand: Both</b>
<b>Cause: Patent Infringement</b>	<b>Demand Amount: \$0</b>
<b>Lead Docket: None</b>	<b>NOS Description: Patent</b>
<b>Other Docket: Dkt in other court: 05-01277</b>	
<b>Dkt in other court: Related, 2:98-cv-118</b>	
<b>Jurisdiction: Federal Question</b>	

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Date	#	Proceeding Text
10/08/2004	1	COMPLAINT with summons issued; jury demand Filing Fee \$ 150.00 Receipt # 05000126 (tt) (Entered: 10/08/2004)
10/08/2004	2	DISCLOSURE statement by SIGHTSOUND TECH (tt) (Entered: 10/08/2004)
10/08/2004	--	COPY of Complaint and Docket Entries mailed to the Commissioner of Patents and Trademarks. (tt) (Entered: 10/08/2004)
11/08/2004	3	RETURN OF SERVICE executed as to ROXIO, INC. 11/5/04 Answer due on 11/26/04 for ROXIO, INC. (tt) (Entered: 11/09/2004)
11/08/2004	4	RETURN OF SERVICE executed as to NAPSTER, L.L.C. 11/5/04 Answer due on 11/26/04 for NAPSTER, L.L.C. (tt) (Entered: 11/09/2004)
11/24/2004	5	ANSWER to Complaint; jury demand and COUNTERCLAIM by ROXIO, INC., NAPSTER, L.L.C. (Attorney William M. Wycoff, Kevin P. Allen, Charles K. Verhoeven, Michael E. Williams) against SIGHTSOUND TECH (tt) Modified on 03/11/2005 (Entered: 11/24/2004)
11/24/2004	6	DISCLOSURE statement by ROXIO, INC., NAPSTER, L.L.C. (tt) (Entered: 11/24/2004)
11/24/2004	7	NOTICE Opting Out of Arbitration by ROXIO, INC., NAPSTER, L.L.C. (tt) (Entered: 11/24/2004)
12/15/2004	8	ANSWER by SIGHTSOUND TECH to [5-2] counterclaims by NAPSTER, L.L.C., ROXIO, INC. (tt) (Entered: 12/16/2004)
12/17/2004	9	Case Management Conference set for 9:15 1/11/05 (tt) (Entered: 12/17/2004)
01/10/2005	10	INITIAL Case Scheduling Conference Statement by ROXIO, INC., NAPSTER, L.L.C. (tt) (Entered: 01/10/2005)
01/10/2005	11	MOTION by SIGHTSOUND TECH for Preliminary Injunction , with Proposed Order. (tt) (Entered: 01/11/2005)
01/10/2005	12	EXHIBITS by SIGHTSOUND TECH to [11-1] motion for Preliminary Injunction (tt) (Entered: 01/11/2005)
01/10/2005	13	BRIEF by SIGHTSOUND TECH in support of [11-1] motion for Preliminary Injunction by SIGHTSOUND TECH (tt) (Entered: 01/11/2005)
01/10/2005	14	DECLARATION of Justin Douglas Tygar, Ph.D. concerning the Operation of Roxio/Napster Re: [11-1] motion for Preliminary Injunction by SIGHTSOUND TECH (tt) (Entered: 01/11/2005)
01/11/2005	15	MOTION by ROXIO, INC., NAPSTER, L.L.C. to Substitute Attorney , with Proposed Order. (tt) (Entered: 01/11/2005)
01/11/2005	16	MOTION by ROXIO, INC., NAPSTER, L.L.C. for Charles K. Verhoeven to Appear Pro Hac Vice ; Filing Fee \$ 40.00 Receipt # 05001581 , with Proposed Order. (tt) (Entered: 01/11/2005)
01/11/2005	17	MOTION by ROXIO, INC., NAPSTER, L.L.C. for Tigran Guledjian to Appear Pro Hac Vice ; Filing Fee \$ 40.00 Receipt # 05001581 , with Proposed Order. (tt) (Entered: 01/11/2005)
01/11/2005	18	MOTION by ROXIO, INC., NAPSTER, L.L.C. for Michael E. Williams to Appear Pro Hac Vice ; Filing Fee \$ 40.00 Receipt # 05001581 , with Proposed Order. (tt) (Entered: 01/11/2005)
01/11/2005	19	Status Conference held 1/11/05 before Chief Judge Donetta W. Ambrose [ Reporter: none ] (tt) (Entered: 01/11/2005)
01/11/2005	--	Deadline updated; Response to Motion set to 2/11/05 for [11-1] motion for Preliminary Injunction ; Reply to Response to Motion set to 2/21/05 for [11-1] motion for Preliminary Injunction ; Motion Hearing set for 1:30 3/3/05 for [11-1] motion for Preliminary Injunction (tt) (Entered: 01/11/2005)
01/11/2005	20	RESPONSE by SIGHTSOUND TECH to defts' [10-1] Initial Case Scheduling Conference Statement. (tt) (Entered: 01/11/2005)
01/11/2005	--	ORDER upon motion granting [15-1] motion to Substitute Attorney ; terminated attorney William M. Wycoff for ROXIO, INC., attorney Kevin P. Allen for ROXIO, INC., attorney William M. Wycoff for NAPSTER, L.L.C., attorney Kevin P. Allen for NAPSTER, L.L.C. and added Laurence Z. Shiekman, Kathryn M. Kenyon for defts. ( signed by Chief Judge Donetta W. Ambrose on 1/11/05 ) CM all parties of record. (tt) (Entered: 01/12/2005)
01/11/2005	--	ORDER upon motion granting [16-1] motion for Charles K. Verhoeven to Appear Pro Hac Vice on

- behalf of defts. ( signed by Chief Judge Donetta W. Ambrose on 1/11/05 ) CM all parties of record. (tt) (Entered: 01/12/2005)
- 01/11/2005 -- ORDER upon motion granting [17-1] motion for Tigran Guledjian to Appear Pro Hac Vice on behalf of defts. ( signed by Chief Judge Donetta W. Ambrose on 1/11/05 ) CM all parties of record. (tt) (Entered: 01/12/2005)
- 01/11/2005 -- ORDER upon motion granting [18-1] motion for Michael E. Williams to Appear Pro Hac Vice on behalf of defts. ( signed by Chief Judge Donetta W. Ambrose on 1/11/05 ) CM all parties of record. (tt) (Entered: 01/12/2005)
- 01/18/2005 21 Status Conference via phone held 1/18/05 before Chief Judge Donetta W. Ambrose [ Reporter: none ] ; Deft wants leave to amend counterclaims related to press release. Pltf doesn't object to motion for leave to amend. Leave granted orally by the Court; Amended counterclaim due 1/25/05. Deft to file a Motion to Stay Case pending outcome of application to Patent & Trademark Office, response due w/in 10 days. (tt) (Entered: 01/19/2005)
- 01/21/2005 22 MOTION by ROXIO, INC., NAPSTER, L.L.C. to Stay Pending Reexamination of Patents in Suit with Proposed Order. (jsp) (Entered: 01/24/2005)
- 01/21/2005 23 BRIEF by ROXIO, INC., NAPSTER, L.L.C. in support of [22-1] motion to Stay Pending Reexamination of Patents in Suit by NAPSTER, L.L.C., ROXIO, INC. (jsp) (Entered: 01/24/2005)
- 01/25/2005 24 FIRST AMENDED ANSWER to Complaint by ROXIO, INC., NAPSTER, L.L.C. amends: [5-1] answer by NAPSTER, L.L.C., ROXIO, INC. and COUNTERCLAIMS against SIGHTSOUND TECH (tt) (Entered: 01/26/2005)
- 01/27/2005 25 MOTION by SIGHTSOUND TECH to Extend Time w/in which to respond to defts' motion to stay pending receipt of defts' request for re-examination of patents and prior art which defts intend to submit to the Patent and Trademark Office , with Proposed Order. (tt) (Entered: 01/28/2005)
- 01/28/2005 26 RESPONSE by ROXIO, INC., NAPSTER, L.L.C. to pltf's [25-1] motion to Extend Time w/in which to respond to defts' motion to stay (tt) (Entered: 01/28/2005)
- 01/28/2005 27 ACCEPTANCE OF SERVICE of First Amended Answer and Counterclaim as to Scott Sander executed 1/26/05 (tt) (Entered: 01/28/2005)
- 01/28/2005 28 BRIEF by SIGHTSOUND TECH in support of [25-1] motion to Extend Time w/in which to respond to defts' motion to stay (tt) (Entered: 01/31/2005)
- 02/02/2005 29 Status Conference via phone held 1/31/05 before Chief Judge Donetta W. Ambrose [ Reporter: none ] ; Pltf's response to motion to stay due 2/11/05 ; Defts' reply due 2/16/05 ; Preliminary injunction date will be scheduled via order on motion to stay ; Defts do not have to file answer to preliminary injunction by March. (tt) (Entered: 02/02/2005)
- 02/02/2005 -- ORDER upon motion granting [25-1] motion to Extend Time w/in which to respond to defts' motion to stay pending receipt of defts' request for re-examination of patents and prior art which defts intend to submit to the Patent and Trademark Office. Defts shall serve on counsel for pltf by overnight delivery sent no later than 2/1/05 any request for re-examination of the patents in suit which defts intend to file with the PTO, including all prior art on which defts plan to rely in such request for re-examination ; Pltf's Response to Motion set to 2/11/05 for defts' [22-1] motion to Stay Pending Reexamination of Patents in Suit ; Defts' Reply Brief due 2/16/05 ; Defts are not required to file an answer to pltf's motion for preliminary injunction until further order of court. ( signed by Chief Judge Donetta W. Ambrose on 1/31/05 ) CM all parties of record. (tt) (Entered: 02/02/2005)
- 02/03/2005 30 MOTION by SIGHTSOUND TECH for Brian S. Mudge to Appear Pro Hac Vice ; Filing Fee \$ 40.00 Receipt # 05001943 , with Proposed Order. (tt) (Entered: 02/04/2005)
- 02/03/2005 31 MOTION by SIGHTSOUND TECH for William K. Wells to Appear Pro Hac Vice ; Filing Fee \$ 40.00 Receipt # 05001943 , with Proposed Order. (tt) (Entered: 02/04/2005)
- 02/03/2005 32 MOTION by SIGHTSOUND TECH for Duncan L. Williams to Appear Pro Hac Vice ; Filing Fee \$ 40.00 Receipt # 05001943 , with Proposed Order. (tt) (Entered: 02/04/2005)
- 02/03/2005 33 MOTION by SIGHTSOUND TECH for Clyde E. Findley to Appear Pro Hac Vice ; Filing Fee \$40.00 05001943 Receipt # 05001943 , with Proposed Order. (tt) (Entered: 02/04/2005)
- 02/04/2005 34 NOTICE of Lodging of Pending Requests for Reexamination by ROXIO, INC., NAPSTER, L.L.C. (tt) (Entered: 02/04/2005)
- 02/04/2005 35 EXHIBITS (VOLUME I) by ROXIO, INC., NAPSTER, L.L.C. to [34-1] notice of lodging of pending requests for reexamination. (tt) (Entered: 02/04/2005)
- 02/04/2005 36 EXHIBITS (VOLUME II) by ROXIO, INC., NAPSTER, L.L.C. to [34-1] notice of lodging of pending requests for reexamination. (tt) (Entered: 02/04/2005)



02/04/2005 37 EXHIBITS (VOLUME III) by ROXIO, INC., NAPSTER, L.L.C. to [34-1] notice of lodging of pending requests for reexamination. (tt) (Entered: 02/04/2005)

02/07/2005 -- ORDER upon motion granting [30-1] motion for Brian S. Mudge to Appear Pro Hac Vice on behalf of pltf. ( signed by Chief Judge Donetta W. Ambrose on 2/4/05 ) CM all parties of record. (tt) (Entered: 02/07/2005)

02/07/2005 -- ORDER upon motion granting [31-1] motion for William K. Wells to Appear Pro Hac Vice on behalf of pltf. ( signed by Chief Judge Donetta W. Ambrose on 2/4/05 ) CM all parties of record. (tt) (Entered: 02/07/2005)

02/07/2005 -- ORDER upon motion granting [32-1] motion for Duncan L. Williams to Appear Pro Hac Vice on behalf of pltf. ( signed by Chief Judge Donetta W. Ambrose on 2/4/05 ) CM all parties of record. (tt) (Entered: 02/07/2005)

02/07/2005 -- ORDER upon motion granting [33-1] motion for Clyde E. Findley to Appear Pro Hac Vice on behalf of pltf. ( signed by Chief Judge Donetta W. Ambrose on 2/4/05 ) CM all parties of record. (tt) (Entered: 02/07/2005)

02/11/2005 38 REPLY by SIGHTSOUND TECH to [24-2] First Amended Counterclaims by NAPSTER, L.L.C., ROXIO, INC. (tt) (Entered: 02/14/2005)

02/11/2005 39 BRIEF by SIGHTSOUND TECH in opposition to Napster's [22-1] motion to Stay Pending Reexamination of Patents in Suit (tt) (Entered: 02/14/2005)

02/11/2005 40 MOTION by SIGHTSOUND TECH, SCOTT SANDER to Dismiss defts' Amended Counterclaims 4-9 . (tt) (Entered: 02/14/2005)

02/11/2005 41 BRIEF by SIGHTSOUND TECH, SCOTT SANDER in support of their [40-1] motion to Dismiss defts' Amended Counterclaims 4-9 (tt) (Entered: 02/14/2005)

02/16/2005 42 REPLY by ROXIO, INC., NAPSTER, L.L.C. in support of their Motion to Stay pending Reexamination of the Patents-In-Suit (tt) (Entered: 02/17/2005)

02/16/2005 43 DECLARATION of William E. Growney (tt) Modified on 02/18/2005 (Entered: 02/17/2005)

02/16/2005 44 MOTION by ROXIO, INC., NAPSTER, L.L.C. to Seal [43-1] Declaration , with Proposed Order. (tt) (Entered: 02/17/2005)

02/17/2005 45 OPPOSITION by SIGHTSOUND TECH to defts' [44-1] motion to Seal [43-1] Declaration (tt) (Entered: 02/18/2005)

02/17/2005 46 NOTICE OF FILING: Supplemental Declaration of Christopher Reese by SIGHTSOUND TECH (FILED UNDER SEAL) (tt) Modified on 02/28/2005 (Entered: 02/18/2005)

02/17/2005 47 REQUEST by SIGHTSOUND TECH for Oral Argument on Motion to Stay . (tt) (Entered: 02/18/2005)

02/18/2005 -- ORDER upon motion denying [44-1] motion to Seal [43-1] Declaration. The declaration speaks only of vague, unsuccessful attempts & no dollar values are set forth. I see no risk of confidential information being disclosed. ( signed by Chief Judge Donetta W. Ambrose on 2/18/05 ) CM all parties of record. (tt) (Entered: 02/18/2005)

02/18/2005 -- ORDER upon motion denying [47-1] motion for Oral Argument on Motion to Stay. The parties have clearly represented their respective positions in the briefs and declarations filed. ( signed by Chief Judge Donetta W. Ambrose on 2/18/05 ) CM all parties of record. (tt) (Entered: 02/18/2005)

02/23/2005 48 MOTION by ROXIO, INC., NAPSTER, L.L.C. to Seal Supplemental Declaration of Christopher Reese , with Proposed Order. (tt) (Entered: 02/23/2005)

02/23/2005 49 OPPOSITION by SIGHTSOUND TECH to defts' [48-1] motion to Seal Supplemental Declaration of Christopher Reese (tt) (Entered: 02/24/2005)

02/28/2005 -- ORDER upon motion granting [48-1] motion to Seal Supplemental Declaration of Christopher Reese. The Supplemental Declaration of Christopher Reese filed 2/17/05 shall be placed under seal. ( signed by Chief Judge Donetta W. Ambrose on 2/28/05 ) CM all parties of record. (tt) (Entered: 02/28/2005)

02/28/2005 50 MEMORANDUM OPINION & ORDER granting defts' [22-1] motion to Stay. The defts are to contact this Court immediately upon receiving any notification from the PTO regarding the outcome of the Request for Reexamination. The preliminary injunction hearing scheduled for 3/3/05 is cancelled . The [11-1] motion for Preliminary Injunction is denied without prejudice to reassert once the stay is lifted. ( signed by Chief Judge Donetta W. Ambrose on 2/28/05 ) CM all parties of record. (tt) (Entered: 02/28/2005)

03/03/2005 51 NOTICE OF APPEAL by SIGHTSOUND TECH from [50-1] memorandum opinion dated 2/28/05

FILING FEE \$ 255 RECEIPT # 2394 TPO issued. (lck) (Entered: 03/07/2005)

03/03/2005 -- Certified copy of Notice of Appeal [51-1] appeal by SIGHTSOUND TECH , certified copy of docket, certified copy of order dated 2/28/05 mailed to USCA; copy of Notice of Appeal and information sheet to ROXIO, INC., NAPSTER, L.L.C. and judge. Copy of information sheet to appellant. (lck) (Entered: 03/07/2005)

03/11/2005 52 Transcript Purchase order re: [51-1] appeal by SIGHTSOUND TECH indicating that no transcript is being ordered. (tt) (Entered: 03/11/2005)

03/21/2005 -- Text not available. (Entered: 03/21/2005)

04/04/2005 53 NOTICE of PTO's Order granting ex parte Reexamination by ROXIO, INC., NAPSTER, L.L.C. (tt) (Entered: 04/04/2005)

07/21/2005 54 MOTION for Relief from Stay with Respect to Defamation Counterclaims by SIGHTSOUND TECHNOLOGIES, INC., SCOTT SANDER. (Attachments: # 1 Proposed Order)(jsp) (Entered: 07/21/2005)

07/21/2005 55 BRIEF in Support re 54 MOTION for Relief from Stay with Respect to Defamation Counterclaims filed by SIGHTSOUND TECHNOLOGIES, INC., SCOTT SANDER. (Attachments: # 1 Part 2 of Brief)(jsp) (Entered: 07/21/2005)

07/22/2005 56 NOTICE: re 54 MOTION for Relief from Stay with Respect to Defamation Counterclaims:Response due on or before 8/4/05. (jlh) (Entered: 07/22/2005)

08/04/2005 57 NOTICE by ROXIO, INC., NAPSTER, L.L.C. of PTO's Issuance of Office Actions in Ex Parte Reexamination (Attachments: # 1 # 2 # 3)(Helmsen, Joseph) (Entered: 08/04/2005)

08/04/2005 58 MOTION for attorney Michael T. Zeller to Appear Pro Hac Vice by ROXIO, INC., NAPSTER, L.L.C.. (Attachments: # 1 Proposed Order)(Kenyon, Kathryn) (Entered: 08/04/2005)

08/04/2005 59 NOTICE by ROXIO, INC., NAPSTER, L.L.C. re 57 Notice (Other) Letter Notice of Prior Filing. (Kenyon, Kathryn) (Entered: 08/04/2005)

08/04/2005 60 BRIEF in Opposition re 54 MOTION for Relief from Stay with Respect to Defamation Counterclaims filed by ROXIO, INC., NAPSTER, L.L.C.. (Attachments: # 1 Exhibit A# 2 Exhibit B# 3 Exhibit C# 4 Exhibit D# 5 Exhibit E# 6 Exhibit F# 7 Exhibit G# 8 Exhibit H)(Kenyon, Kathryn) (Entered: 08/04/2005)

08/04/2005 -- Pro Hac Vice Fees received in the amount of \$ 40 receipt # 4877 re 58 Motion to Appear Pro Hac Vice (ept) (Entered: 08/05/2005)

08/08/2005 61 ORDER granting 58 Motion to Appear Pro Hac Vice . Signed by Judge Donetta W. Ambrose on 8/8/05. (jlh ) (Entered: 08/08/2005)

09/01/2005 62 ORDER denying 54 Motion for Relief from Stay . Signed by Judge Donetta W. Ambrose on 8/31/05. (jlh ) (Entered: 09/01/2005)

09/06/2005 63 NOTICE by SIGHTSOUND TECHNOLOGIES, INC., SCOTT SANDER NOTICE OF FILING TO SUPPLEMENT RECORD (Kerr, Benjamin) (Entered: 09/06/2005)

09/07/2005 64 Minute Entry for proceedings held before Judge Donetta W. Ambrose : Status Conference held on 9/7/2005. Parties to keep Court informed of PTO Action. (jlh ) (Entered: 09/07/2005)

11/02/2005 65 NOTICE by ROXIO, INC., NAPSTER, L.L.C. of PTO's Issuance of Second Office Actions in Ex Parte Reexamination (Attachments: # 1 Exhibit A# 2 Exhibit B# 3 Exhibit C)(Kenyon, Kathryn) (Entered: 11/02/2005)

11/14/2005 66 MANDATE of USCA for the Federal Circuit as to 51 Notice of Appeal filed by SIGHTSOUND TECHNOLOGIES, INC., that the appeal is dismissed, with each party to bear its own costs. (jsp) (Entered: 11/15/2005)

03/02/2006 67 MOTION by Clyde E. Findley to Withdraw as Attorney by SIGHTSOUND TECHNOLOGIES, INC. (jsp) (Entered: 03/02/2006)

05/10/2006 68 NOTICE by ROXIO, INC., NAPSTER, L.L.C. Defendants' Notice of PTO's Issuance of Final Office Actions in Ex Parte Reexamination and Request for Status Conference (Attachments: # 1 Exhibit A)(Kenyon, Kathryn) (Entered: 05/10/2006)

05/10/2006 69 EXHIBITS in Support of 68 Notice (Other) by ROXIO, INC., NAPSTER, L.L.C.. (Kenyon, Kathryn) (Entered: 05/10/2006)

05/10/2006 70 EXHIBITS in Support of 68 Notice (Other) by ROXIO, INC., NAPSTER, L.L.C.. (Kenyon, Kathryn) (Entered: 05/10/2006)

05/10/2006 -- MOTION (Request) for Status Conference by ROXIO, INC., NAPSTER, L.L.C..(with Document 68 ) (jsp) (Entered: 05/11/2006)

05/11/2006 -- CLERK'S OFFICE QUALITY CONTROL MESSAGE. re 68 Notice (Other) ERROR: Document should have been filed as two separate documents. CORRECTION: Attorney advised in future that documents of that nature are to be filed as separate documents. Clerk of Court docketed Request for Status Conference. This message is for informational purposes only. (jsp) (Entered: 05/11/2006)

05/31/2006 71 Minute Entry for proceedings held before Judge Donetta W. Ambrose : Telephone Conference held on 5/31/2006. (Court Reporter none) (jlh ) (Entered: 05/31/2006)

05/31/2006 72 ORDER FOR ADMINISTRATIVE CLOSING.Signed by Judge Donetta W. Ambrose on 5/31/06. (jlh) (Entered: 05/31/2006)

06/02/2006 73 NOTICE by SIGHTSOUND TECHNOLOGIES, INC. Notice of Filing by Sightsound Technologies, Inc. of Sua Sponte Decisions of United States Patent and Trademark Office Vacating Previous Final Office Actions (Rinaldo, Richard) (Entered: 06/02/2006)

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586391 (07) 5191573 March 2, 1993 ,

UNITED STATES PATENT AND TRADEMARK OFFICE GRANTED PATENT

**5191573**

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[Link to Claims Section](#)

March 2, 1993 ,

Method for transmitting a desired , , digital , , video or , , audio signal

**REEXAM-LITIGATE:**

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

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

**INVENTOR:** Hair, Arthur R. - 301 Oaklawn Dr., Pittsburgh, United States of America (US)

**CERT-CORRECTION:**

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

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**ASSIGNEE-AT-ISSUE:**

HAIR; ARTHUR R., United States of America (US)

**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: 007656/0701

May 3, 2000 - CHANGE OF NAME (SEE DOCUMENT FOR DETAILS)., SIGHTSOUND.COM

INCORPORATED 733 WASHINGTON ROAD, SUITE 400MT. LEBANON, PENNSYLVANIA, 15228,  
Reel and Frame Number: 010776/0703

October 24, 2001 - NOTICE OF GRANT OF SECURITY INTEREST, KENYON & KENYON  
ONE BROADWAYNEW YORK, NEW YORK, 10004, SCHWARTZ, ANSEL M. ONE STERLING  
PLAZA 201 N. CRAIG STREET, SUITE 304PITTSBURGH, PENNSYLVANIA, 15213, WATERVIEW  
PARTNERS, LLP ONE STERLING PLAZA 152 WEST 57TH STREET, 46TH FLOORNEW YORK,  
NEW YORK, 10019, D&DF WATERVIEW PARTNERS, L.P. ONE STERLING PLAZA 152  
WEST 57TH STREET, 46TH FLOORNEW YORK, NEW YORK, 10019, Reel and Frame Number:  
012506/0415

December 27, 2005 - ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR  
DETAILS)., DMT LICENSING, LLC ONE INDEPENDENCE WAY PRINCETON NEW JERSEY 08540,  
ONE INDEPENDENCE WAY, PRINCETON, NEW JERSEY, UNITED STATES OF AMERICA (US),  
08540, Reel and Frame Number: 017555/0149

**LEGAL-REP:** Schwartz, Ansel M.

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**PUB-COUNTRY:** United States of America (US)

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December 21, 1993 - CERTIFICATE OF CORRECTION October 2, 1995 - ASSIGNMENT OF  
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**REL-DATA:**

Continuation of Ser. No. 206497 , June 13, 1988 , ABANDONED , September 18, 1990

**US-MAIN-CL:** 369#84 ,

**US-ADDL-CL:** 235#380 , , 235#381 , , 348#E07.071 , , 369#15 , , 369#85 , ,  
G9B#20.002 , , G9B#27.002 , , G9B#27.012 , , G9B#27.019 , , G9B#27.051 ,

**CL:** 369 , , 235 , , 348 , , G9B ,

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

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**IPC-MAIN-CL:** [8] G07F 017#00 (20060101) Core Inventive 20051008 (C I R M EP)

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- IPC-ADDL-CL:** [8] G11B 020#00 (20060101) Core Inventive 20051008 (C I R M EP)
- IPC-ADDL-CL:** [8] G11B 020#00 (20060101) Advanced Inventive 20051008 (A I R M EP)
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- IPC-ADDL-CL:** [8] G11B 027#34 (20060101) Advanced Inventive 20051008 (A I R M EP)
- IPC-ADDL-CL:** [8] G11B 027#10 (20060101) Core Inventive 20051008 (C I R M EP)
- IPC-ADDL-CL:** [8] G11B 027#10 (20060101) Advanced Inventive 20051008 (A I R M EP)
- IPC-ADDL-CL:** [8] G11B 027#34 (20060101) Core Inventive 20051008 (C I R M EP)
- IPC-ADDL-CL:** [8] G11B 027#34 (20060101) Advanced Inventive 20051008 (A I R M EP)
- IPC-ADDL-CL:** [8] H04H 001#02 (20060101) Core Inventive 20051008 (C I R M EP)
- IPC-ADDL-CL:** [8] H04H 001#02 (20060101) Advanced Inventive 20051008 (A I R M EP)
- IPC-ADDL-CL:** [8] H04N 007#173 (20060101) Core Inventive 20051008 (C I R M EP)
- IPC-ADDL-CL:** [8] H04N 007#173 (20060101) Advanced Inventive 20051008 (A I R M EP)

**PRIM-EXMR:** Nguyen; Hoa

**REF-CITED:**

3718906, February 27, 1973, Lightner, United States of America (US), 235#381  
3990710, November 9, 1976, Hughes, United States of America (US), 369#34  
4567359, January 28, 1986, Lockwood, United States of America (US), 235#381  
4647989, March 3, 1987, Geddes, United States of America (US), 235#381  
4654799, March 31, 1987, Ogaki et al., United States of America (US), 364#479

**CORE TERMS:** digital, music, audio, user, memory, song, electronically, hard disk, stored, hardware, video, electronic, playback, methodology, integrated, compact, display, random, disc, telecommunications, transmitting, additionally, tape, telephone lines, receiver, stereo, randomly, album, audio signal, random access memory

**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**

**NO-OF-FIGURES: 2**

**PARENT-PAT-INFO:**

This is a continuation of copending application Ser. No. 07/206,497 filed on Jun. 13, 1988, now abandoned.

**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 transferred from the manufacturing facility to the wholesale warehouse to the retail warehouse to the retail outlet, resulting in lengthy, lag time between music creation and music marketing, as well as incurring unnecessary 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 transferring 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.

**DETEDESC:****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 jockey. 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 been 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:**

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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.

**LOAD-DATE:** November 17, 2009

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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, sightsound, invention, music, summary judgment, signal, prior art, license, consumer ...

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

- ⓘ 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, memory, telecommunication, electronically, patent, audio signals, signal, specification, desired, transferring ...

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

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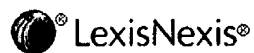
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- 1. [Intellectual Property Today](#), April, 2004, INTERNETINFO.COLUMN; Pg. 49, 718 words, Will the Price of Music Downloads Include Patent License Fees?, BY W. SCOTT PETTY; Scott Petty, a Patent Attorney with King & Spalding, focuses on intellectual 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, Pg. 61 (60), 84020686, 24304 words, The multiple unconstitutionality of business method patents: common sense, congressional consideration, and constitutional history., Pollack, Malla  
... (41.) You may feel uncomfortable with the wrapping method claim because it seems obvious -- as do many currently issued business patents. See, e.g., 146 CONG. REC. E1659 (daily ed. of Oct. 4, 2000) (statement of Rep. Berman) (criticizing recent grant of obvious business patents including U.S. Patent No. **5,191,573** (issued Mar. 2 1993) for a method of selling audiovisual products over the internet and U.S. Patent No. 5,825,651 (issued Oct. 20, 1998) for a method of allowing internet car purchasers to choose options), available at ...
- 3. [Canadian Press Newswire](#), September 4, 2001, Pg. S 4'01, 5191573, 77 words, Trio of alleged drug-smugglers from Montreal elect trial by judge alone
- 4. [Canadian Press Newswire](#), September 4, 2001, Pg. S 4'01, 5191573, 77 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. [Technology Review \(Cambridge, Mass.\)](#), March 1, 2000, Pg. 68, 60121150, 4534 words, Software Patents Tangle the Web; Industry Trend or Event, SHULMAN, SETH  
... Sightsound.com **5,191,573** music downloads ...
- 7. [Mondaq Business Briefing - Hale and Dorr LLP, US](#), November 3, 1999, 02275027, 2050 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. [Mondaq Business Briefing](#), November 3, 1999, 2275027, 2043 words, US: Business Methods Patents - The Effects Of State Street On Electronic Commerce And The Internet SO[Hale and Dorr LLP, US] SO, Alter, Scott M  
... 7. Patent number **5,191,573** and 5,675,734 8. Unlike ...
- 9. [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 ...

- 10. Business Wire, May 19, 1998, Tuesday, 867 words, Digital Sight/Sound Rolls Out First Patented Method for Sale of Digital Audio/Video Over the Internet, LOS ANGELES  
... United States Patents **5,191,573** and 5,675,734. "A2B is a ...

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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                      03/25/2010

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EXAMINER

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CENTRAL REEXAMINATION UNIT

**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)).

<b>Office Action in Ex Parte Reexamination</b>	<b>Control No.</b> 90/007,402	<b>Patent Under Reexamination</b> 5191573	
	<b>Examiner</b> ROLAND G. FOSTER	<b>Art Unit</b> 3992	

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

- a  Responsive to the communication(s) filed on 15 December 2008.      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.      3.  Interview Summary, PTO-474.  
2.  Information Disclosure Statement, PTO/SB/08.      4.  \_\_\_\_\_.

**Part II SUMMARY OF ACTION**

- 1a.  Claims 1-6 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 1-6 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**

***Prosecution Reopened***

**Claims 1-6 and 44-49** were pending in the present reexamination proceeding. Specifically, original, independent claims (claims 1 and 4) were amended, new claims 44-49 were added during this reexamination proceeding, and the remaining new claims cancelled. The rejection of these claims was appealed to the Board of Patent Appeals and Interferences (the "Board"), who rendered a decision on September 4, 2009.

The subject patent under reexamination however, U.S. Patent No. 5,191,573 (the "Hair" patent), issued March 2, 1993 based on United States Application 07/586,391, filed September 18, 1990. The Hair patent also claimed entitlement to the filing date June 13, 1988. Thus, the Hair patent under reexamination was enforceable until March 2, 2010. 35 USC § 154.

During a reexamination proceeding, no amendment may be proposed for entry in an expired patent. 37 C.F.R. §1.530(j). Furthermore, amendments are not effective until the reexamination certificate is used and published. 37 C.F.F. §1.530(k). See also MPEP § 2250.

Thus, the Board's decision decided the propriety of claim rejections subject to amendments effectively withdrawn on March 2, 2010 by the mandatory expiration of the Hair patent term. The original **claims 1-6** however stood rejected before the now (effectively) withdrawn amendments. See the Office action, mailed September 29, 2006. Thus, in accordance with 37 C.F.R. §1.198, prosecution is reopened and a new grounds of rejection is

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made (below) to the originally granted **claims 1-6** as they existed prior to the mandatory withdrawal of all amendments. See also MPEP § 1214.04.

  
Irem Yucel  
TC Director

### *Claim Interpretation*

As discussed above, the Hair patent under reexamination appears to have expired on March 2, 2010. Regarding reexamination of expired patent, MPEP § 2258.I.G states:

In a reexamination proceeding involving claims of an expired patent, claim construction pursuant to the principle set forth by the court in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) (words of a claim “are generally given their ordinary and customary meaning” as understood by a person of ordinary skill in the art in question at the time of the invention) should be applied since the expired claim are not subject to amendment.

Regarding “ordinary and customary meaning,” MPEP § 2111.01.III states:

The ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313, 75 USPQ2d 1321, 1326 (Fed. Cir. 2005) (en banc).

....

The ordinary and customary meaning of a term may be evidenced by a variety of sources, including “the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art.” *Phillips v. AWH Corp.*, 415 F.3d at 1314, 75 USPQ2d at 1327.

In the present Office action, the claims are given their ordinary and customary meaning.

The meaning of each claim term in the office actions is the meaning that the term would have to

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a person of ordinary skill in the art in question at the time of the invention. The ordinary and customary meaning given to the claim terms in the office action are evidenced by the claims themselves and the remainder of the specification. For example, the examiner applies prior art, such as Bush to teach the digital transfer of digital audio and video files via "telecommunication lines" in a manner consistent with the meaning the claim terms would have to one of ordinary skill in the art based on the specification of the Hair patent under reexamination. See the rejection of claim 1 for additional details.

***Claim Rejections Based on Bush***

*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 –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-6** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 4,789,863 ("Bush"), of record.

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 may also be 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



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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 again broadly recites "a telecommunications line," which lacks antecedent basis to the previous recitation of a telecommunications line. Thus, the claim is reasonably interpreted to include one or more telecommunication lines. The examiner interprets a "telecommunications line" to mean transmission of a signal over lines over a distance. The interpretation is consistent with the specification of the Hair patent under reexamination, which provides few details of a telecommunication line, only describing a telephone line as a particular embodiment of a telecommunication line. Fig. 1. See also the Hair U.S. Patent No. 5,675,734, which is claimed by the patent owner to be a continuation of the current patent under reexamination. In that patent, the patent owner states the "telecommunications lines are preferably telephone lines." Col. 7, ll. 52 & 53. Thus, telecommunications lines are reasonably interpreted to not be limited to the preferred embodiment -- telephone lines. This interpretation is also consistent with the interpretation preferred by the patent owner, who argues "telecommunication lines" requires electronic mediums for communicating between computers, which requires end-to-end connectivity. 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

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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.

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**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 home user 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 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). Indeed, Bush further teaches "[f]unds deposited into the central receiving account [of the first party] will also carry the following information" including a credit card transaction type and the card number for that transaction (col. 6, ll. 49-64).

***Claim Rejections Based on Gallagher***

*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 negated by the manner in which the invention was made.

**Claims 1-6** are rejected under 35 U.S.C. 103(a) as being unpatentable over UK Patent Application Publication No. GB 2 178 275 A ("Gallagher") in view of U.S. Patent No. 4,528,643 ("Freeny"), both of which are of record.

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:**

Gallagher teaches transmitting audio and visual signals (page 1, ll. 5-10 and 84-92) stored on a first memory (Fig. 2, which illustrates a "database" comprising storage 23, see also page 1, ll. 60 & 61) of a first party (record company) (page 1, ll. 39-54) to a second memory (Fig. 3, storage medium 32) of a second party (household user).

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

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Gallagher teaches connecting via an electronic, telephone line (telecommunications line) (page 1, ll. 28-32) the first memory (database storage 23) with the second memory (storage medium 32) such that the digital audio (music and music information) passes therebetween (page 1, ll. 39-54).

**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;**

The desired digital audio or video signal is transmitted from the first memory as discussed above using a transmitter (database comprising transmitter/receiver 20) (Fig. 2 and page 1, ll. 68-86) in control and possession of the first party (record company) because the database "belong[s]" to the record company and because the record company controls the unit by choosing what data to transfer to the unit for "sale" to the general public. Page 1, ll. 44-54. The receiver (user unit comprising receiver 30) (Fig. 3) is in possession and control of the second party because the second party (user) determines the location to which the audio/video data is transmitted as broadly recited by the claims, such as the user at home logs onto the user unit, selects the desired data, "buys" the data, and downloads the data to the user's home. Page 1, ll. 87-92 & 100-107 and page 2, l. 92.

**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;**

As discussed above, Gallagher teaches that the digital music data is: 1) "purchased" by the household user (second party) automatically via the telecommunications line (telephone line) and thus the first and second party are financially distinct, 2) the first party is at a location (host) remote from second party (house), and 3) the first party (record company) controls the first memory and the second party (household user) controls and possesses the second memory, Gallagher however fails to specifically detail how the purchase is transacted (e.g., by transferring money electronically via the telecommunication line).

Freeny discloses a method of electronically distributing and selling audio and video data from remote, information control machines 14 (first party) to information control machines 12 (second party) (abstract, col. 4, ll. 35-60, col. 5, ll. 10-15, col. 7, l. 50 - col. 8, l. 28, and col. 11, ll. 10-58) also known as "point of sales" locations (col. 4, ll. 35-60), which include a "consumer's home (point of sale location)" (col. 3, ll. 64-68) 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).

The suggestion/motivation for combining Gallagher with Freeny would have been because Freeny's method of electronic sale allows the selling party to more reliably and receive compensation (increase revenue) for the sale of product because the "owner of the information receives directly the compensation for each sale of a recording and such compensation is received before the reproduction is authorized." Col. 13, lines 36-39. In addition, revenue would have been increased by merely supporting the use of credit card transactions. For

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example, credit cards permit customers to make purchases in cases where they do not have cash on hand, as would have been notoriously well known in the art. Furthermore, providing support for credit card transactions would have increased the speed and efficiency of the financial transaction by eliminating the steps of separately mailing payment to the seller, processing the payment, and then sending the purchased good to the buyer.

In addition, combining prior art elements according to known methods to yield predictable results is obvious. *KSR v. Teleflex*, 550 U.S. 395, 417 (2007). The above analysis establishes that the prior art (Gallagher and Freeny) includes each element claimed, but just not in one single prior art reference. One of ordinary skill in the art at the time the invention was made however would have recognized that in combination, Gallagher and Freeny predictably perform their respective functions as they would have separately. For example, in combination Gallagher still transfers digital audio music to the user after purchase and Freeny still teaches allowing the seller of digital audio and video data to directly receive compensation for sale before transferring the data, such as by supporting credit card transactions. One of ordinary skill in the art would have also recognized that the results of the combination were predictable. For example, even when the second party was in possession of the second memory at the second party's house as clearly taught by Gallagher, the advantage of receiving compensation, and particularly a credit card transaction, from the second party before transferring data (Freeny) would have predictably been the same -- to increase revenue due to more reliable compensation for the sold product and to increased sales due to customers purchasing on credit, to increase

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sales due to customers at home purchasing on credit, and to advantageously increase the speed and efficiency of the financial transaction.

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 Gallagher transmit a consumer credit card number along with their request for the digital audio and video data so that the source unit could approve and charge the sale of the digital data to the consumer credit card before the product (digital audio or video) is released, thereby "transferring money electronically via a telecommunication line" as recited.

**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 Gallagher teaches that both audio and video digital signals are downloaded. Therefore, see the claim 1 rejection for additional details.

Regarding **claims 2 and 5**, Gallagher teaches searching the first memory for the desired digital audio and video signals via a menu selection process (page 1, ll. 102-107). In the claim 1 rejection, from which these claims depend, Freeny was relied upon to teach the obvious addition of transmitting a consumer credit card number along with the request for the audio and video data thereby resulting in the host memory being searched after the transfer of money in order to receive "compensation...before the reproduction is authorized." See also page 13, ll. 25-48.



Regarding **claims 3 and 6**, Gallagher teaches that second party (household user) initiates a connection with the first party via a telephone modem link to initiate the data transfer (i.e., log on, make a selection, and download). Page 1, ll. 28-30 & ll. 101-107. In the claim 1 rejection, from which these claims depend, Freeny was relied upon to teach the obvious addition of transmitting a consumer credit card for charging money.

***Claim Rejections Based on Akashi***

*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 negated by the manner in which the invention was made.

**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 Freeny.

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:**

Akashi teaches transmitting audio signals (digital music) stored on a first memory (recorded music and information stored on a "data base 14" in the host computer) of a first party

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(host or record company) to a second memory (recordable optical discs or digital audio tape in recording/reproducing device (1)) of a second party (household user). Translation, pages 2 & 3, sections (3)-(6). The transfer occurs as a result of the household user's desire to "purchase desired music from home." Page 4, section (7).

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

Akashi teaches connecting via an electronic, telephone line (telecommunications line) the first memory (recorded music on host computer) with the second memory (recordable discs or tape in the recording/reproducing device) such that the digital audio (music and music information) can pass therebetween. Translation, page 2, section (4).

**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;**

The desired digital audio or video signal is transmitted from the first memory as discussed above using a transmitter (host computer 14) (Fig. 4 and translation, page 3, section (6)) in control and possession of the first party (host or record company) maintains" the recorded music it wishes to sell. Page 4, section (7). The receiver (recording/reproducing device 1 comprising modem 3) (translation, page 3, section (6)) is in possession and control of the second party (household user) because the second party determines the location to which the audio/video

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data is transmitted as broadly recited by the claims, such as deciding to "set up as terminals in each user's household" and "purchase desired music from home" which also establishes that said terminal is "in possession and control of the second party." Translation, page 3, section (6); and page 4, section (7).

**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;**

As discussed above, Akashi teaches that the digital music data is: 1) "purchased" by the household user (second party) automatically via the telecommunications line (telephone line) and thus the first and second party are financially distinct, 2) the first party is at a location (host) remote from second party (house), and 3) the first party (host or record company) controls the first memory and the second party (household user) controls and possesses the second memory, Akashi however fails to specifically detail how the purchase is transacted (e.g., by transferring money electronically via the telecommunication line).

Freeny discloses a method of electronically distributing and selling audio and video data from remote, information control machines 14 (first party) to information control machines 12 (second party) (abstract, col. 4, ll. 35-60, col. 5, ll. 10-15, col. 7, l. 50 - col. 8, l. 28, and col. 11, ll. 10-58) also known as "point of sales" locations (col. 4, ll. 35-60), which include a "consumer's home (point of sale location)" (col. 3, ll. 64-68) by way of having the requesting user transmit a

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consumer credit card number along with their request for the audio and video data (col. 13, lines 25-29).

The suggestion/motivation for combining Akashi with Freeny would have been because Freeny's method of electronic sale allows the selling party to more reliably and receive compensation (increase revenue) for the sale of product because the "owner of the information receives directly the compensation for each sale of a recording and such compensation is received before the reproduction is authorized." Col. 13, lines 36-39. In addition, revenue would have been increased by merely supporting the use of credit card transactions. For example, credit cards permit customers to make purchases in cases where they do not have cash on hand, as would have been notoriously well known in the art.

In addition, combining prior art elements according to known methods to yield predictable results is obvious. *KSR v. Teleflex*, 550 U.S. 395, 417 (2007). See the Gallagher in view of Freeny rejection of claim 1 above for further details regarding the *KSR* analysis based upon predictable results. Said *KSR* analysis has not been copied from that rejection, but applies here to the combination of Akashi in view of Freeny for the same reasons. Thus, the analysis will not be repeated here for the sake of brevity.

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 audio and video data so that the source unit could

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approve and charge the sale of the digital data to the consumer credit card before the product (digital audio or video) is released, thereby "transferring money electronically via a telecommunication line" as recited.

**Claim 4** differs substantively from claim 1 in that claim 4 recites the transfer of a digital video signal. As discussed above in the claim 1 rejection, the combination of Akashi in view of Freeny obviously teaches "transferring money electronically via a telecommunications line to the first party at a location remote from a second party." More specifically however, the combination teaches transmission of a credit card number and the transmission of digital audio and video data. That is, Freeny teaches both the concept and advantages as transferring video data for money. For example, Freeny teaches digital video information is transferred to the point of sale device for the creation of "video discs" (col. 4, ll. 35-60, col. 21, ll. 44-55, col. 24, ll. 20-30, col. 34, ll. 39-46).

As an initial matter, the suggestion/motivation for combining Akashi with the audio and video transmission teachings of Freeny would have been same as discussed above in the claim 1 rejection, specifically, Freeny teaches the obvious addition of "transferring money electronically via a telecommunications line" for the sale of both audio and video. Nonetheless, the addition of video transmission would have also been obvious because the transmission of video to a point of sale device, which includes the consumer's home (col. 3, ll. 65-67) would have increased revenue and efficiency by avoiding the need for "manufacturing facilities for reproducing the information in material objects and a distribution network for distributing the material objects to

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the various point of sale locations for sale to the consumer (col. 1, ll. 19-26), where such information includes "motion pictures" and the like (col. 1, ll. 10-14). Finally, the claims do not specify quality, size, or bandwidth required for video signals...." Page 22, Board decision (September 4, 2009). Thus, the addition of even a minimal video capability (highly limited bandwidth) requiring very little structural change to Akashi would still meet the claim language.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to ability the transmit video as taught by Freeny to the audio transmission system taught by Akashi.

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. Translation, 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. Translation, page 4, paragraph (6). Such teachings meet 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. In the claim 1 rejection, from which these claims depend, Freeny was relied upon to teach the obvious addition of transmit a consumer credit card number along with the request for the audio and video data thereby resulting in the host memory being searched after the transfer of money in order to receive "compensation...before the reproduction is authorized." See also col. 13, ll. 25-48.

Regarding **claims 3 and 6**, the Akashi base reference teaches that the second party telephones the first party to initiate the transfer. Translation, page 3 , paragraph (6), "Operation procedures...." The combination of Akashi in view of Freeny, as discussed in the claim 1 rejection above, teaches transferring money electronically in the form of providing a credit card number.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

**Claims 1-6** of the instant Hair patent under reexamination are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-34 of U.S. Patent No. 5,675,734 (the "'734" patent).<sup>1</sup>

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the instant Hair patent under reexamination are broader than the claims in the '573 patent. See *Van Ornum*, where broad claims in continuation applications were rejected as obvious double patenting over previously patented narrow claims. For example, independent claims 1 and 4 of the instant Hair patent are similar to independent claim 16 of the '734 patent, except that limitations directed to a first control panel, first control integrated circuit,

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<sup>1</sup> The instant Hair patent under reexamination appears to have expired March 2, 2010 while the 5,675,734 patent appears to have expired June 13, 2008. Thus the policy of improper timewise extension of a "right to exclude" is at issue regarding the instant, double patenting rejection.

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sales random access memory, incoming random access memory, and playback random access memory are not present in claims 1 and 4 of the instant patent. In addition, no "video" limitations are present in claim 1 of the instant patent. Furthermore, although instant claims 1 and 4 recite the first party and second party are "financially distinct," this limitation fails to patentably distinguish over claim 11 of '734 patent because claim 11 recites money is transferred between first party and second party. Although the parties may belong to the same overall entity (e.g., different divisions of a corporation), if money is actually "transferred" between them, they are financially distinct, otherwise no "transfer" of money would be required in the first place. Finally, claims 1 and 4 of the instant Hair patent are method claims while claim 11 of the '734 patent is an apparatus claim. It would have been obvious however to one of ordinary skill in the art at the time the invention was made to use the apparatus in claim 11 to perform the functions recited in the method of instant claim 1 because the apparatus performs those very same functions.

Claims 1 and 4 of the instant Hair patent are merely broader than claim 1 of the '734 patent as well. Although claims 1 and 4 of the instant Hair patent recite "transferring money" while claim 1 of the '734 patent recites "telephoning the first party" and "providing a credit card number," the "transferring money" limitation is still merely broader. As evidence for this conclusion, see dependent claims 3 and 6 of the instant Hair patent, which recite the "transferring money" step of independent claims 1 and 4 include the "telephoning" and "credit card number" steps.



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Claims 1 and 4 of the instant Hair patent are merely broader than the remaining independent claims of the '734 patent for similar reasons.

Thus, all independent claims of the instant Hair patent are merely broader than all independent claims of the '734 patent.

***Conclusion***

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 CFR 1.116, after final rejection and 37 CFR 41.33 after appeal, which will be strictly enforced.

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extension of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

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 the Hair patent throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

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

By EFS: Registered users may submit via the electronic filing system EFS-Web, at <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>.

By Mail to: Mail Stop *Ex Parte* Reexam  
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  
Randolph Building  
401 Dulany St.  
Alexandria, VA 22314

For EFS-Web transmission, 37 CFR 1.8(a)(1)(i) (C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely if (a) it is transmitted via the Office's electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

Any inquiry concerning this communication should be directed to Roland Foster at telephone number 571-272-7538.


Signed:

/Roland G. Foster/  
Roland G. Foster  
Central Reexamination Unit, Primary Examiner  
Electrical Art Unit 3992  
(571) 272-7538

Conferees:



ESK


<b>Reexamination</b> 	<b>Application/Control No.</b> 90007402	<b>Applicant(s)/Patent Under Reexamination</b> 5191573
	<b>Certificate Date</b>	<b>Certificate Number</b>

<b>Requester Correspondence Address:</b>	<input type="checkbox"/> <b>Patent Owner</b>	<input checked="" type="checkbox"/> <b>Third Party</b>
Albert S. Penilla Martine Penilla & Gencarella, LLP 710 Lakeway Drive, Suite 200 Sunnyvale, CA 94085		

<b>LITIGATION REVIEW</b> <input checked="" type="checkbox"/>	r.g.f. (examiner initials)	03/15/2010 (date)
Case Name		Director Initials
2:04cv1549, closed.		<i>Penilla Head to GM</i>

COPENDING OFFICE PROCEEDINGS	
TYPE OF PROCEEDING	NUMBER
1. None.	

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<b>Search Notes</b>  	<b>Application/Control No.</b> 90007402	<b>Applicant(s)/Patent Under Reexamination</b> 5191573
	<b>Examiner</b> ROLAND G FOSTER	<b>Art Unit</b> 3992

<b>SEARCHED</b>			
<b>Class</b>	<b>Subclass</b>	<b>Date</b>	<b>Examiner</b>

<b>SEARCH NOTES</b>		
<b>Search Notes</b>	<b>Date</b>	<b>Examiner</b>
East text search - see attached search history.	3/15/2010	r.g.f.

<b>INTERFERENCE SEARCH</b>			
<b>Class</b>	<b>Subclass</b>	<b>Date</b>	<b>Examiner</b>

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90/067402  
ATTACH TO PAPER NO. 20100304 SEARCH NOTES REE  
PAGE 1 OF 1  
**EAST Search History (Prior Art)**

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
L1	9632	(hard adj1 (disk or drive)) same (buffer or cache)	USPAT	OR	OFF	2010/03/15 13:55
L2	55	1 and @ad<"19880101"	USPAT	OR	OFF	2010/03/15 13:56

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Re-Examination of PATENT:  
5,191,573  
Control No.: 90/007,402  
Filing Date: 01/31/2005

Confirmation No.: 2998  
Attorney Docket: NAPS001  
Group Art Unit: 3992  
Examiner: Foster, R.  
Date: May 25, 2010

RESPONSE

Hon. Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated March 25, 2010, Applicant respectfully submits the Remarks/Arguments beginning on page 2 of this paper.

Re-Exam Control No. 90/007,402  
Filed: 01/31/2005  
Reply to Office Action of March 25, 2010

REMARKS/ARGUMENTS

Favorable reconsideration of the claims undergoing re-examination, in light of the following discussions, is respectfully requested.

Claims 1-6 are currently undergoing re-examination. No changes have been made to the claims herewith. However, as specified in the Office Action, all previous amendments have now been withdrawn in light of the expiration of the patent.

In the outstanding Office Action, the previous grounds for rejection for the previously pending claims were withdrawn, and several new grounds for rejection have been made. The outstanding rejections are as follows:

(1) Claims 1-6 have been rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 4,789,863 (hereinafter “the ‘863 patent”);

(2) Claims 1-6 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.K. Patent Application Publication No. GB2178275 (hereinafter “Gallagher”) in view of U.S. Patent No. 4,528,643 (hereinafter “the ‘643 patent”);

(3) Claims 1-6 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese Patent Application No. 62-284496 (hereinafter “Akashi”) in view of the ‘643 patent and the ‘434 patent; and

(4) Claims 1-6 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-34 of U.S. Patent No. 5,675,734.

The Rejection of Claims 1-6 under 35 U.S.C. § 102(a) over the ‘863 Patent

Claim 1

Claim 1 recites “storing the digital signal in the second memory.” In light of the specification, it is respectfully submitted that such a limitation is not taught by the ‘863 patent. With respect to the step of “storing the digital signal in the second memory,” the Office Action



Re-Exam Control No. 90/007,402  
Filed: 01/31/2005  
Reply to Office Action of March 25, 2010

alleges that the '863 patent teaches this limitation by citing the cassette tape and CD of the '863 patent and by referring to their discussion in col. 5, lines 24-52. However, cassette tapes and CDs are not "second memories" according to the claims and specification. The specification utilizes a special phrase, "hardware units," when referring to such removable media. The first paragraph of the Background of the Invention in col. 1 expressly describes those media when it states "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." These hardware units are further described in the specification as containing drawbacks in light of their removable nature and their physical distribution (when compared with a hard disk acting as an internal, non-volatile storage device), and it is those drawbacks that the patented invention seeks to overcome. The Background describes the materials of the hardware units as being a disadvantage when it states "The materials used to manufacture the hardware units are subject to damage and deterioration during normal operations, handling, and exposure to the elements." The Background likewise states that hardware units have retrieval and distribution drawbacks when its states "Hardware units limit the ability to play, in a sequence selected by the user, songs from different albums" and "the material cost of the hardware units themselves, further drives up the cost of music to the end user." Further, the Summary of the Invention describes the invention as "eliminating the need to unnecessarily handle records, tapes, or compact discs on a regular basis." Thus, attempting to read the claimed second memories on exactly the type of media that the specification describes as deficient is a misinterpretation of the scope of the claims. See *SciMed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc.*, 242 F.3d 1337 (Fed. Cir. 2001).

As a result, claim 1 is not anticipated by the '863 patent, and dependent claims 2 and 3 are patentable for at least the reasons set forth for the patentability of claim 1 from which they depend. Claim 4 also recites the same "storing the digital signal in the second memory." As was described with respect to claim 1, such a limitation is not taught by the '863 patent. Therefore, the patentability of claim 4 and claims 5 and 6 should be indicated as confirmed for at least the reasons set forth above with respect to claim 1.

Re-Exam Control No. 90/007,402  
Filed: 01/31/2005  
Reply to Office Action of March 25, 2010

The Rejection of Claims 1-6 under 35 U.S.C. § 103(a) as being unpatentable over Gallagher in view of the '643 patent

The Office Action alleges that the combination of Gallagher and the '643 patent renders obvious the recitation of "storing the digital signal in the second memory" as claimed in claim 1. In support of this allegation, the Office Action cites to the storage medium 32 in Gallagher. However, the storage medium 32 is expressly described in the specification, page 1, ll. 89-90, as "a storage medium 32 such as a video tape or optical disk." As was discussed above with respect to the '863 patent, the specification defines such media as "hardware units" and, as would be understood by those of ordinary skill in the art in light of the specification, such "hardware units" are not "second memories." As a result, Gallagher does not teach the step of "storing the digital signal in the second memory."

The '643 patent is not alleged to cure this deficiency of Gallagher, and, therefore, there is no evidence that the combination of references renders obvious the same step not taught by the references individually. As a result, claim 1 is not rendered obvious by the proposed combination of references, and dependent claims 2 and 3 are patentable for at least the reasons set forth for the patentability of claim 1 from which they depend. Claim 4 also recites the same "storing the digital signal in the second memory." As was described with respect to claim 1, such a limitation is not rendered obvious by the proposed combination of references. Therefore, the patentability of claim 4 and claims 5 and 6 should be indicated as confirmed for at least the reasons set forth above with respect to claim 1.

The Rejection of Claims 1-6 under 35 U.S.C. § 103(a) as being unpatentable over Akashi in view of the '643 patent

The Office Action alleges that the combination of Akashi and the '643 patent renders obvious the recitation of "storing the digital signal in the second memory" as claimed in claim 1. In support of this allegation, the Office Action cites to the "recordable optical discs or digital audio tape in recording/reproducing device (1)" in Akashi. As was discussed above with respect to the '863 patent, the specification defines such media as "hardware units" and, as would be

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Reply to Office Action of March 25, 2010

understood by those of ordinary skill in the art in light of the specification, such “hardware units” are not are “second memories.” As a result, Akashi does not teach the step of “storing the digital signal in the second memory.”

The ‘643 patent is not alleged to cure this deficiency of Akashi, and, therefore, there is no evidence that the combination of references renders obvious the same step not taught by the references individually. As a result, claim 1 is not rendered obvious by the proposed combination of references, and dependent claims 2 and 3 are patentable for at least the reasons set forth for the patentability of claim 1 from which they depend. Claim 4 also recites the same “storing the digital signal in the second memory.” As was described with respect to claim 1, such a limitation is not rendered obvious by the proposed combination of references. Therefore, the patentability of claim 4 and claims 5 and 6 should be indicated as confirmed for at least the reasons set forth above with respect to claim 1.

#### The Rejection of Claims 1-6 under the Judicially Created Doctrine of Obviousness-Type Double Patenting

The Office Action alleges that claims 1-6 are unpatentable over claims 1-34 of U.S. Patent No. 5,675,734. The Office Action alleges that the rejection is proper in light of the “policy of improper timewise extension of a ‘right to exclude.’” However, the patent undergoing re-examination is the first patent in the patent family both to be filed and to issue. Thus, the term of the patent undergoing re-examination is the patent by which all other patents are measured to determine if there has been an “improper timewise extension.” The Office Action cites *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982) as supporting the Office Action’s rationale for the rejection. However, as can be seen from the date of the decision -- 1982 --, that decision was rendered at a time when patents were each given their own term of 17 years from issue. In such a case, the term of the later issued patent would extend beyond that of the originally issued patent. Here, however, because of the transition to patent terms of 20 years from the earliest filing date, the reverse is true -- the later issued patent expired before the patent undergoing re-examination. Thus, there is no “extension” at all, and the rejection should be withdrawn.

Re-Exam Control No. 90/007,402  
Filed: 01/31/2005  
Reply to Office Action of March 25, 2010

Consequently, in light of the above discussions, the outstanding grounds for rejection are believed to have been overcome and the patentability of all claims should be confirmed. An early and favorable action to that effect is respectfully requested.

<b>CHARGE STATEMENT:</b> Deposit Account No. 501860, order no. <b>2689-0001</b> .
The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any missing or insufficient fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 ( <u>missing or insufficiencies only</u> ) now or hereafter relative to this application and the resulting Official Document under Rule 20, or credit any overpayment, to our Accounting/ Order Nos. shown above, for which purpose a <u>duplicate</u> copy of this sheet is attached.
<b>This CHARGE STATEMENT <u>does not authorize charge of the issue fee until/unless an issue fee transmittal sheet is filed.</u></b>

CUSTOMER NUMBER <b>42624</b>	Respectfully submitted,  By: / Michael R. Casey /  _____ Michael R. Casey, Ph.D. Registration No.: 40,294
Davidson Berquist Jackson & Gowdey LLP 4300 Wilson Blvd., 7th Floor, Arlington, Virginia 22203 Main: (703) 894-6400 • FAX: (703) 894-6430	

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Re-Examination of PATENT:  
5,191,573  
Control  
No.: 90/007,402  
Filing  
Date: 01/31/2005

Confirmation No.: 2998  
Attorney Docket: NAPS001  
Group Art Unit: 3992  
Examiner: Foster, R.  
Date: May 25, 2010

**INFORMATION DISCLOSURE STATEMENT**

Hon. Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. § 1.56, the attention of the Patent and Trademark Office is hereby directed to the reference(s) listed on the attached PTO-1449. One copy of each non-U.S. Patent reference is attached. It is respectfully requested that the information be expressly considered during the prosecution of this application, and that the reference(s) be made of record therein and appear among the "References Cited" on any patent to issue therefrom.

The submission of any document herewith, which is not a statutory bar, is not intended that any such document constitutes prior art against any of the claims of the present application or is considered to be material to patentability as defined in 37 C.F.R. § 1.56(b). Applicants do not waive any rights to take any action which would be appropriate to antedate or otherwise remove as a competent reference against the claims of the present application.

In re Patent: 5,191,573  
Control No.: 90/007,402  
Page 2 of 2

**CHARGE STATEMENT: Deposit Account No. 501860, order no. 2689-0001.**  
The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any missing or insufficient fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 (missing or insufficiencies only) now or hereafter relative to this application and the resulting Official Document under Rule 20, or credit any overpayment, to our Accounting/Order Nos. shown above, for which purpose a duplicate copy of this sheet is attached

**This CHARGE STATEMENT does not authorize charge of the issue fee until/unless an issue fee transmittal sheet is filed.**

CUSTOMER NUMBER  
**42624**

Respectfully submitted,

Davidson Berquist Jackson & Gowdey LLP  
4300 Wilson Blvd., 7th Floor,  
Arlington Virginia 22203  
Main: (703) 894-6400 • FAX: (703) 894-6430

By: / Michael R. Casey /

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Michael R. Casey  
Registration No.: 40,294

<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> FORM PTO-1449 (modified)  Sheet 1 of 2	Reexam number	90/007,402
	First Named Inventor	5,191,573
	Patent Under Re-Exam	5,191,573
	Issue Date	
	Group Art Unit	3992
	Examiner Name	Foster, R.
	Attorney Docket No.	NAPS001
	Confirmation No.	2998

NON-PATENT REFERENCES			
Examiner Initials*	Cite No.	Non-patent Reference bibliographic information, where available	Notes
	1-1	Apple Inc., Form 10-Q, April 21, 2010.	
	1-2	Blockbuster Changes Course of In-store Duplication Plans, Multimedia & Videodisc Monitor, Vol. 12, No. 6, June 1, 1994 (1 page)	
	1-3	Blockbuster Reaffirms Video Retailing Roots, Video Week, Vol. 14, No. 19, May 17, 1993 (2 pages)	
	1-4	Blockbuster To Test Videogame Downloads In Summer, Audio Week, Vol. 6, No. 12, March 28, 1994 (2 pages)	
	1-5	IBM, Blockbuster join forces on CD venture; Associated Press, May 12, 1993 (2 pages)	
	1-6	Magistrate's Report and Recommendation (Amending Claim Construction), Sightsound.com v. NSK et al., Civil Action No. 98-118, April 2, 2002	
	1-7	Magistrate's Report and Recommendation (on Claim Construction), Sightsound.com v. NSK et al., Civil Action No. 98-118, February 8, 2002	

Examiner Signature		Date Considered	
--------------------	--	-----------------	--

\*Examiner: Initial if reference was considered, whether or not citation is in conformance with MPEP 609. Draw a line through citation if not in conformance and not considered. Include a copy of this form with next communication to applicant. Notes: If identified, the following is provided: EA = English Abstract, T = Translation, PT = Partial Translation, SOR = Statement of Relevancy, PF = Patent Family.

<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> FORM PTO-1449 (modified)	Reexam number	90/007,402
	First Named Inventor	5,191,573
	Patent Under Re-Exam	5,191,573
	Issue Date	
	Group Art Unit	3992
	Examiner Name	Foster, R.
	Attorney Docket No.	NAPS001
	Confirmation No.	2998

Sheet 2 of 2

NON-PATENT REFERENCES			
Examiner Initials*	Cite No.	Non-patent Reference bibliographic information, where available	Notes
	2-1	Memorandum Order of Court (adopting amended claim construction recommendation), Sightsound.com v. NSK et al., Civil Action No. 98-118, November 27, 2002	
	2-2	Music burning kiosks: On the right track; Self Service and Kiosk Association, April 9, 2007 (4 pages)	
	2-3	Sony Music Plans to Test Use of In-Store Digital Kiosks, New York Times, June 10, 1999	
	2-4	Starbucks shuts down its Hear Music kiosks, May 2006 ( <a href="http://brandautopsy.typepad.com/brandautopsy/2006/05/starbucks_shuts.html">http://brandautopsy.typepad.com/brandautopsy/2006/05/starbucks_shuts.html</a> )	
	2-5	Turning Over New Leaf, Consumer Electronics, February 13, 1995 (1 page)	
	2-6		
	2-7		

Examiner Signature		Date Considered	
--------------------	--	-----------------	--

\*Examiner: Initial if reference was considered, whether or not citation is in conformance with MPEP 609. Draw a line through citation if not in conformance and not considered. Include a copy of this form with next communication to applicant. Notes: If identified, the following is provided: EA = English Abstract, T = Translation, PT = Partial Translation, SOR = Statement of Relevancy, PF = Patent Family.



## Electronic Acknowledgement Receipt

<b>EFS ID:</b>	7682991
<b>Application Number:</b>	90007402
<b>International Application Number:</b>	
<b>Confirmation Number:</b>	2998
<b>Title of Invention:</b>	METHOD FOR TRANSMITTING A DESIRED DIGITAL VIDEO OR AUDIO SIGNAL
<b>First Named Inventor/Applicant Name:</b>	5191573
<b>Customer Number:</b>	23973
<b>Filer:</b>	Michael R. Casey
<b>Filer Authorized By:</b>	
<b>Attorney Docket Number:</b>	NAPS001
<b>Receipt Date:</b>	25-MAY-2010
<b>Filing Date:</b>	31-JAN-2005
<b>Time Stamp:</b>	14:51:11
<b>Application Type:</b>	Reexam (Third Party)

### Payment information:

Submitted with Payment	no
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### File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Amendment/Req. Reconsideration-After Non-Final Reject	20100525_573_Response_Cover.pdf	69533 b7had9de90b92fad11d7de4343a332efc8a4b13e	no	1

### Warnings:

### Information:

2	Applicant Arguments/Remarks Made in an Amendment	20100525_573_Response_Remarks.pdf	144974 b093ab07faa2462aa710882859b9e61974ddaa	no	5
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<b>Information:</b>					
3	Transmittal Letter	20100525_IDS.pdf	120716 f49df2f90d0de9bd5e55a1e8338a76c7ef32764	no	2
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4	Information Disclosure Statement (IDS) Filed (SB/08)	20100525_1449.pdf	297531 82787619f6a9c57d66c176b0f1a0a6a7343dc68b	no	2
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<b>Information:</b>					
This is not an USPTO supplied IDS fillable form					
5	NPL Documents	NP0000.pdf	579968 7e117128031fde3a7cbb79d3e501d567accb617	no	60
<b>Warnings:</b>					
<b>Information:</b>					
6	NPL Documents	NP0001.pdf	45694 da5e8c0bfad4184505262c5a0bf454b44ed54863	no	1
<b>Warnings:</b>					
<b>Information:</b>					
7	NPL Documents	NP0002.pdf	57196 0a6dabc551e64555bae1c8a38be13ea515a1bb13	no	2
<b>Warnings:</b>					
<b>Information:</b>					
8	NPL Documents	NP0003.pdf	68295 a5eaf754f8a00accf642ba1db33d9530996c08cd	no	2
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<b>Information:</b>					
9	NPL Documents	NP0004.pdf	48161 c7c388b816aab2256c4a30ba1c07720c7df3789e	no	2
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<b>Information:</b>					
11	NPL Documents	NP0006.pdf	900445 44b4fba7db6d90a36e8daf4d489e3048eeba3f7	no	97
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12	NPL Documents	NP0007.pdf	73907 c3adc1fd11e0a66213ef8ceff03ec09b4b8655	no	3
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<b>Information:</b>					
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15	NPL Documents	NP0010.pdf	58514 ce3ce0a64d662ec1ecd256c1ec00be74fd23e6cf	no	1
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17	Reexam Certificate of Mailing	20100525_COS.pdf	39400 6a4a8542a42aa311674596350b90bfc0e4b7785a	no	1
<b>Warnings:</b>					
<b>Information:</b>					
<b>Total Files Size (in bytes):</b>					2839784

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

**New Applications Under 35 U.S.C. 111**

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

**National Stage of an International Application under 35 U.S.C. 371**

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

**New International Application Filed with the USPTO as a Receiving Office**

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

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 number.

<b>REVOCAION OF POWER OF ATTORNEY WITH NEW POWER OF ATTORNEY AND CHANGE OF CORRESPONDENCE ADDRESS</b>	Application Number:	90/007,402
	Filing Date:	January 31, 2005
	First Named Inventor:	5,191,573
	Group Art Unit:	3992
	Examiner Name:	FOSTER, Roland G.
	Attorney Docket No.:	2689-0010

<b>I hereby revoke all previous powers of attorney given in the above-identified application</b>			
<input type="checkbox"/> A Power of Attorney is submitted herewith.			
<b>OR</b>			
<input checked="" type="checkbox"/> I hereby appoint the practitioners associated with the Customer Number: <u>42624</u>			
<input checked="" type="checkbox"/> Please change the correspondence address for the above-identified application to:			
<input checked="" type="checkbox"/> The address associated with Customer Number: <u>42624</u>			
<b>OR</b>			
<input type="checkbox"/>	Firm or Individual Name		
Address Line 1			
Address Line 2			
City		State	
Country			
Telephone		Fax	
I am the:			
<input type="checkbox"/> Applicant / Inventor			
<input checked="" type="checkbox"/> Assignee of record of the entire interest. See 37 CFR 3.71. <i>Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</i>			
<b>SIGNATURE of Applicant or Assignee of Record</b>			
Name	Ken Glick <i>Assistant Secretary, DMT Licensing, LLC</i>		
Signature			
Date	<i>6/23/2010</i>	Telephone	<i>609-936-6022</i>
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*.			

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 1.14. 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 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 COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

**STATEMENT UNDER 37 CFR 3.73(B)**

Applicant / Patent Owner: HAIR, Arthur R.

Docket No. 2689-0010

Application No. / Patent No. 90/007,402

Filed / Issued Date: January 31, 2005

Entitled: METHOD FOR TRANSMITTING A DESIRED DIGITAL VIDEO OR AUDIO SIGNAL

Assignee: DMT LICENSING, LLC

A corporation

(Name of assignee)

(Type of Assignee: 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 shown below:

1.	From: <u>Arthur R. Hair</u> To: <u>PARSEC SIGHT/SOUND, INC.</u> The document was recorded in the United States Patent and Trademark Office at Reel <u>007656</u> Frame <u>0701</u> , or for which a copy thereof is attached.
2.	From: <u>PARSEC SIGHT/SOUND, INC.</u> To: <u>SIGHTSOUND.COM INCORPORATED</u> The document was recorded in the United States Patent and Trademark Office at Reel <u>010776</u> Frame <u>0703</u> , or for which a copy thereof is attached.
3.	From: <u>SIGHTSOUND TECHNOLOGIES, INC.</u> To: <u>DMT LICENSING, LLC</u> The document was recorded in the United States Patent and Trademark Office at Reel <u>017555</u> Frame <u>0149</u> , or for which a copy thereof is attached.

- 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.

**As required by 37 CFR 3.73(b)(1)(i), the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11.**

[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

June 28, 2010  
\_\_\_\_\_  
Date

Michael R. Casey, Ph.D.  
\_\_\_\_\_  
Printed or Typed Name

703.894.6400  
\_\_\_\_\_  
Telephone Number

Attorney, Registration No. 40,294  
Title: \_\_\_\_\_

## Electronic Acknowledgement Receipt

<b>EFS ID:</b>	7904017
<b>Application Number:</b>	90007402
<b>International Application Number:</b>	
<b>Confirmation Number:</b>	2998
<b>Title of Invention:</b>	METHOD FOR TRANSMITTING A DESIRED DIGITAL VIDEO OR AUDIO SIGNAL
<b>First Named Inventor/Applicant Name:</b>	5191573
<b>Customer Number:</b>	23973
<b>Filer:</b>	Michael R. Casey
<b>Filer Authorized By:</b>	
<b>Attorney Docket Number:</b>	NAPS001
<b>Receipt Date:</b>	28-JUN-2010
<b>Filing Date:</b>	31-JAN-2005
<b>Time Stamp:</b>	14:11:31
<b>Application Type:</b>	Reexam (Third Party)

### Payment information:

Submitted with Payment	no
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### File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Miscellaneous Incoming Letter	Transmittal_06-28-10_2689-00 10.pdf	140328 <small>a73253456e7c6ddfb3fff64a5686e71cfbcb78e</small>	no	1

### Warnings:

### Information:

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<b>Information:</b>					
3	Assignee showing of ownership per 37 CFR 3.73(b).	StatementUnder37CFR_06-28-10_2689-0010.pdf	183854 82ccdcfa2bb3eb56af6b24f3ccaf217dfcd805bc	no	1
<b>Warnings:</b>					
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4	Reexam Certificate of Service	20100628_CERTIFICATE_OF_SERVICE.pdf	40084 c987d91c4d4c79536b83b5b3a2fb481769d5032f	no	1
<b>Warnings:</b>					
<b>Information:</b>					
<b>Total Files Size (in bytes):</b>			522015		
<p><b>This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.</b></p> <p><b><u>New Applications Under 35 U.S.C. 111</u></b>  If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.</p> <p><b><u>National Stage of an International Application under 35 U.S.C. 371</u></b>  If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.</p> <p><b><u>New International Application Filed with the USPTO as a Receiving Office</u></b>  If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.</p>					



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:		Confirmation No.: 2998
5,191,573		Atty. Docket No.: 2689-0010
Appln. No.:	90/007,402	Art Unit: 3992
Filed:	January 31, 2005	Examiner: FOSTER, Roland
Title:	METHOD FOR TRANSMITTING A DESIRED DIGITAL VIDEO OR AUDIO SIGNAL	Date: June 28, 2010

**TRANSMITTAL**

Hon. Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Attached please find the following documents, submitted for filing in connection with the above-identified application:

- Revocation of Power of Attorney with New Power of Attorney and Change in Correspondence Address
- Statement Under 37 CFR 3.73(b)

Our Deposit Account No.: 501860

Our Order No. (Client-Matter No.): 2689-0010

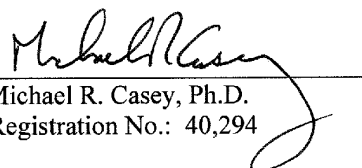
**CHARGE STATEMENT:** The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any missing or insufficient fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 (missing or insufficiencies only) now or hereafter relative to this application and the resulting Official document under Rule 20, or credit any overpayment, to our Account/Order Nos. (or Attorney Docket No.) shown in the heading hereof for which purpose a duplicate copy of this paper is attached.

**This Charge Statement does not authorize charge of the issue fee until/unless an issue fee transmittal form is filed.**

<p>CUSTOMER NUMBER  <b>42624</b></p>
--

Respectfully submitted,

By:

  
Michael R. Casey, Ph.D.  
Registration No.: 40,294

Davidson Berquist Jackson & Gowdey LLP  
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FAX: (703) 894-6430

<p><b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> FORM PTO-1449 (modified)</p> <p>Sheet 1 of 2</p>	Reexam number	90/007,402
	First Named Inventor	5,191,573
	Patent Under Re-Exam	5,191,573
	Issue Date	
	Group Art Unit	3992
	Examiner Name	Foster, R.
	Attorney Docket No.	NAPS001
	Confirmation No.	2998

NON-PATENT REFERENCES			
Examiner Initials*	Cite No.	Non-patent Reference bibliographic information, where available	Notes
/R.F./	1-1	Apple Inc., Form 10-Q, April 21, 2010.	
	1-2	Blockbuster Changes Course of In-store Duplication Plans, Multimedia & Videodisc Monitor, Vol. 12, No. 6, June 1, 1994 (1 page)	
	1-3	Blockbuster Reaffirms Video Retailing Roots, Video Week, Vol. 14, No. 19, May 17, 1993 (2 pages)	
	1-4	Blockbuster To Test Videogame Downloads In Summer, Audio Week, Vol. 6, No. 12, March 28, 1994 (2 pages)	
	1-5	IBM, Blockbuster join forces on CD venture; Associated Press, May 12, 1993 (2 pages)	
	1-6	Magistrate's Report and Recommendation (Amending Claim Construction), Sightsound.com v. NSK et al., Civil Action No. 98-118, April 2, 2002	
	1-7	Magistrate's Report and Recommendation (on Claim Construction), Sightsound.com v. NSK et al., Civil Action No. 98-118, February 8, 2002	

Examiner Signature	/Roland Foster/	Date Considered	08/11/2010
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\*Examiner: Initial if reference was considered, whether or not citation is in conformance with MPEP 609. Draw a line through citation if not in conformance and not considered. Include a copy of this form with next communication to applicant. Notes: If identified, the following is provided: EA = English Abstract, T = Translation, PT = Partial Translation, SOR = Statement of Relevancy, PF = Patent Family.


<p align="center"><b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> FORM PTO-1449 (modified)</p> <p align="center">Sheet 2 of 2</p>	Reexam number	90/007,402
	First Named Inventor	5,191,573
	Patent Under Re-Exam	5,191,573
	Issue Date	
	Group Art Unit	3992
	Examiner Name	Foster, R.
	Attorney Docket No.	NAPS001
	Confirmation No.	2998

NON-PATENT REFERENCES			
Examiner Initials*	Cite No.	Non-patent Reference bibliographic information, where available	Notes
/R.F./	2-1	Memorandum Order of Court (adopting amended claim construction recommendation), Sightsound.com v. NSK et al., Civil Action No. 98-118, November 27, 2002	
	2-2	Music burning kiosks: On the right track; Self Service and Kiosk Association, April 9, 2007 (4 pages)	
	2-3	Sony Music Plans to Test Use of In-Store Digital Kiosks, New York Times, June 10, 1999	
	2-4	Starbucks shuts down its Hear Music kiosks, May 2006 ( <a href="http://brandautopsy.typepad.com/brandautopsy/2006/05/starbucks_shuts.html">http://brandautopsy.typepad.com/brandautopsy/2006/05/starbucks_shuts.html</a> )	
	2-5	Turning Over New Leaf, Consumer Electronics, February 13, 1995 (1 page)	
	2-6		
	2-7		

Examiner Signature	/Roland Foster/	Date Considered	08/11/2010
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\*Examiner: Initial if reference was considered, whether or not citation is in conformance with MPEP 609. Draw a line through citation if not in conformance and not considered. Include a copy of this form with next communication to applicant. Notes: If identified, the following is provided: EA = English Abstract, T = Translation, PT = Partial Translation, SOR = Statement of Relevancy, PF = Patent Family.



<b>Search Notes</b>  	<b>Application/Control No.</b> 90007402	<b>Applicant(s)/Patent Under Reexamination</b> 5191573
	<b>Examiner</b> ROLAND G FOSTER	<b>Art Unit</b> 3992

<b>SEARCHED</b>			
<b>Class</b>	<b>Subclass</b>	<b>Date</b>	<b>Examiner</b>

<b>SEARCH NOTES</b>		
<b>Search Notes</b>	<b>Date</b>	<b>Examiner</b>
Search not updated.	8/1/2010	r.g.f.

<b>INTERFERENCE SEARCH</b>			
<b>Class</b>	<b>Subclass</b>	<b>Date</b>	<b>Examiner</b>

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# Litigation Search Report CRU 3999

Reexam Control No. 90/007,402

**TO: Foster, Roland**  
**Location: CRU**  
**Art Unit: 3992**  
**Date: 08/12/09**

**From: Sharon S. Hoppe**  
**Location: CRU 3999**  
**MDW 7C69**  
**Phone: (571) 272-1586**

**Case Serial Number: 90/007,402**

**Sharon.hoppe@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.

2:04cv1549 Closed

**KEYCITE**

**H** US 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. 07/586391)  
*Construed by*
- H** 2 SightSound.Com Inc. v. N2K, Inc., 185 F.Supp.2d 445, 2002 Markman 229872 (W.D.Pa. Feb 08, 2002) (NO. CIV.A.98-CV-118) (Markman Order Version)  
*AND Ruled Valid by*
- H** 3 Sightsound.com Inc. v. N2K, Inc., 391 F.Supp.2d 321 (W.D.Pa. Oct 24, 2003) (NO. CIV.A. 98-CV-118)
- H** 4 SYSTEM FOR TRANSMITTING DESIRED DIGITAL VIDEO OR AUDIO SIGNALS, US PAT 5675734, 1997 WL 1488819 (U.S. PTO Utility Oct 07, 1997) (NO. 08/607648)  
*Construed by*
- H** 5 SightSound.Com Inc. v. N2K, Inc., 185 F.Supp.2d 445, 2002 Markman 229872 (W.D.Pa. Feb 08, 2002) (NO. CIV.A.98-CV-118) (Markman Order Version)  
*AND Ruled Valid by*
- H** 6 Sightsound.com Inc. v. N2K, Inc., 391 F.Supp.2d 321 (W.D.Pa. Oct 24, 2003) (NO. CIV.A. 98-CV-118)
- H** 7 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. 08/471964)  
*Construed by*
- H** 8 SightSound.Com Inc. v. N2K, Inc., 185 F.Supp.2d 445, 2002 Markman 229872 (W.D.Pa. Feb 08, 2002) (NO. CIV.A.98-CV-118) (Markman Order Version)  
*AND Ruled Valid by*
- H** 9 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

- 10 SIGHTSOUND.COM INCORPORATED, a Pennsylvania corporation, Plaintiff, v. N2K, INC., a Delaware corporation, Cdnw, Inc., a Pennsylvania corporation, and Cdnw Online, Inc., a Pennsylvania corporation, Defendants., 1998 WL 34373758 (Expert Report and Affidavit) (W.D.Pa. 1998) **Opening Expert Report of James A. Moorer** (NO. 98-0118)
- 11 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., 2001 WL 34891529 (Expert Deposition) (W.D.Pa. Apr. 19, 2001) **Proceedings** (NO. 98-118)
- 12 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)
- 13 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)
- 14 SIGHTSOUND.COM INCORPORATED, a Pennsylvania corporation, Plaintiff, v. N2K, INC., a Delaware corporation, Cdnw, Inc., a Pennsylvania corporation, and Cdnw 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)
- 15 SIGHTSOUND.COM INCORPORATED a Pennsylvania corporation, Plaintiff, v. N2K, INC., a Delaware Corporation, Cdnw, Inc., a Pennsylvania corporation, and Cdnw Online, 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)
- 16 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)
- 17 SIGHTSOUND.COM INCORPORATED, a Pennsylvania corporation, Plaintiff, v. N2K, INC., a Delaware corporation, Cdnw, Inc., a Pennsylvania corporation, and Cdnw Online, Inc., a Pennsylvania corporation, Defendants., 2003 WL 24309949 (Partial Expert Testimony) (W.D.Pa. Mar. 3, 2003) **(Partial Testimony)** (NO. 98-0118)
- 18 SIGHTSOUND.COM INCORPORATED, Plaintiff, v. N2K, INC., Cdnw, Inc., and Cdnw Online, Inc., Defendants., 2003 WL 24309947 (Partial Expert Testimony) (W.D.Pa. Mar. 9, 2003) **Deposition of Justin Douglas Tygar, Ph.D.** (NO. 98-0118)
- 19 SIGHTSOUND.COM INCORPORATED, a Pennsylvania corporation, Plaintiff, v. N2K, INC., a Delaware corporation, Cdnw, Inc., a Pennsylvania corporation, and Cdnw Online, Inc., a Pennsylvania corporation, Defendants., 2003 WL 24309950 (Expert Deposition) (W.D.Pa. Mar. 11, 2003) **(Deposition)** (NO. 98-0118)
- 20 In the Matter of: SIGHTSOUBD.COM INC., v. N2K, INC. et al., 2003 WL 24309948 (Partial



- Expert Testimony) (W.D.Pa. Mar. 12, 2003) **(Partial Testimony)** (NO. 98-0118)
- 21 SIGHTSOUND.COM, INC., a Pennsylvania corporation, Plaintiff, v. N2K, INC., a Delaware corporation, Cdnw, Inc., a Pennsylvania corporation, and Cdnw 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)
- 22 SIGHTSOUND.COM, INC., a Pennsylvania corporation, Plaintiff and, Counterdefendants, v. N2K, INC., a Delaware corporation, CDNOW, Inc., a Pennsylvania corporation, and Cdnw 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)

**W.D.Pa. Trial Motions, Memoranda And Affidavits**

- 23 SIGHTSOUND.COM INC., Plaintiff, v. N2K, INC., Cdnw, Inc., and CDnow Online, Inc., Defendants., 2004 WL 3742179 (Trial Motion, Memorandum and Affidavit) (W.D.Pa. Jan. 12, 2004) **Sightsound's Motion in Limine to Preclude Certain Testimony of James A. Moorer, Ph. D.** (NO. 98-0118)
- 24 SIGHTSOUND.COM INC., Plaintiff, v. N2K, INC., CDnow, Inc., and CDnow Online, Inc., Defendants., 2004 WL 3742180 (Trial Motion, Memorandum and Affidavit) (W.D.Pa. Jan. 12, 2004) **Sightsound's Motion in Limine to Preclude Certain Testimony of Michael Ian Shamos, Ph.D., J.D.** (NO. 98-0118)
- 25 SIGHTSOUND.COM INC., v. N2K, INC., et al., 2004 WL 5855261 (Trial Motion, Memorandum and Affidavit) (W.D.Pa. Jan. 12, 2004) **Sightsound's Motion in Limine to Preclude the Testimony of Gerald Mossinghoff** (NO. 98CV00118)
- 26 SIGHTSOUND.COM INC., Plaintiff, v. N2K, INC., CDnow, Inc., and CDnow Online, Inc., Defendants., 2004 WL 3742181 (Trial Motion, Memorandum and Affidavit) (W.D.Pa. Jan. 27, 2004) **Defendants' Opposition to Plaintiff's Motion in Limine to Preclude Certain Testimony of James A. Moorer, Ph.D** (NO. 98-0118)
- 27 SIGHTSOUND.COM INC., Plaintiff, v. N2K, INC., Cdnw, Inc., and CDnow Online, Inc., Defendants., 2004 WL 3742182 (Trial Motion, Memorandum and Affidavit) (W.D.Pa. Jan. 27, 2004) **Defendants' Opposition to Plaintiff's Motion in Limine to Preclude Certain Testimony of Michael Shamos, Ph.D, JD.** (NO. 98-0118)
- 28 SIGHTSOUND.COM INC., v. N2K, INC., et al., 2004 WL 5855262 (Trial Motion, Memorandum and Affidavit) (W.D.Pa. Jan. 27, 2004) **Defendants' Memorandum in Opposition to Sightsound's Motion in Limine to Preclude the Testimony of Gerald Mossinghoff** (NO. 98CV00118)

**Dockets (U.S.A.)**

**W.D.Pa.**

- 29 SIGHTSOUND.COM INC. v. N2K, INC., ET AL, NO. 2:98cv00118 (Docket) (W.D.Pa. Jan. 16, 1998)

## Expert Court Documents (U.S.A.)

### W.D.Pa. Expert Testimony

- 30 SIGHTSOUND.COM INCORPORATED, a Pennsylvania corporation, Plaintiff, v. N2K, INC., a Delaware corporation, Cdnw, Inc., a Pennsylvania corporation, and Cdnw Online, Inc., a Pennsylvania corporation, Defendants., 1998 WL 34373758 (Expert Report and Affidavit) (W.D.Pa. 1998) **Opening Expert Report of James A. Moorer** (NO. 98-0118)
- 31 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., 2001 WL 34891529 (Expert Deposition) (W.D.Pa. Apr. 19, 2001) **Proceedings** (NO. 98-118)
- 32 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)
- 33 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)
- 34 SIGHTSOUND.COM INCORPORATED, a Pennsylvania corporation, Plaintiff, v. N2K, INC., a Delaware corporation, Cdnw, Inc., a Pennsylvania corporation, and Cdnw 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)
- 35 SIGHTSOUND.COM INCORPORATED a Pennsylvania corporation, Plaintiff, v. N2K, INC., a Delaware Corporation, Cdnw, Inc., a Pennsylvania corporation, and Cdnw Online, 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)
- 36 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)
- 37 SIGHTSOUND.COM INCORPORATED, a Pennsylvania corporation, Plaintiff, v. N2K, INC., a Delaware corporation, Cdnw, Inc., a Pennsylvania corporation, and Cdnw Online, Inc., a Pennsylvania corporation, Defendants., 2003 WL 24309949 (Partial Expert Testimony) (W.D.Pa. Mar. 3, 2003) **(Partial Testimony)** (NO. 98-0118)
- 38 SIGHTSOUND.COM, INCORPORATED, Plaintiff, v. N2K, INC., Cdnw, Inc., and Cdnw Online, Inc., Defendants., 2003 WL 24309947 (Partial Expert Testimony) (W.D.Pa. Mar. 9, 2003) **Deposition of Justin Douglas Tygar, Ph.D.** (NO. 98-0118)
- 39 SIGHTSOUND.COM INCORPORATED, a Pennsylvania corporation, Plaintiff, v. N2K, INC., a Delaware corporation, Cdnw, Inc., a Pennsylvania corporation, and Cdnw Online, Inc., a Pennsylvania corporation, Defendants., 2003 WL 24309950 (Expert Deposition) (W.D.Pa. Mar. 11, 2003) **(Deposition)** (NO. 98-0118)

- 40 In the Matter of: SIGHTSOUBD.COM INC., v. N2K, INC. et al., 2003 WL 24309948 (Partial Expert Testimony) (W.D.Pa. Mar. 12, 2003) (**Partial Testimony**) (NO. 98-0118)
- 41 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)
- 42 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)

**W.D.Pa. Trial Motions, Memoranda And Affidavits**

- 43 SIGHTSOUND.COM INC., Plaintiff, v. N2K, INC., Cdnow, Inc., and CDnow Online, Inc., Defendants., 2004 WL 3742179 (Trial Motion, Memorandum and Affidavit) (W.D.Pa. Jan. 12, 2004) **Sightsound's Motion in Limine to Preclude Certain Testimony of James A. Moorer, Ph. D.** (NO. 98-0118)
- 44 SIGHTSOUND.COM INC., Plaintiff, v. N2K, INC., CDnow, Inc., and CDnow Online, Inc., Defendants., 2004 WL 3742180 (Trial Motion, Memorandum and Affidavit) (W.D.Pa. Jan. 12, 2004) **Sightsound's Motion in Limine to Preclude Certain Testimony of Michael Ian Shamos, Ph.D., J.D.** (NO. 98-0118)
- 45 SIGHTSOUND.COM INC., Plaintiff, v. N2K, INC., CDnow, Inc., and CDnow Online, Inc., Defendants., 2004 WL 3742181 (Trial Motion, Memorandum and Affidavit) (W.D.Pa. Jan. 27, 2004) **Defendants' Opposition to Plaintiff's Motion in Limine to Preclude Certain Testimony of James A. Moorer, Ph.D** (NO. 98-0118)
- 46 SIGHTSOUND.COM INC., Plaintiff, v. N2K, INC., Cdnow, Inc., and CDnow Online, Inc., Defendants., 2004 WL 3742182 (Trial Motion, Memorandum and Affidavit) (W.D.Pa. Jan. 27, 2004) **Defendants' Opposition to Plaintiff's Motion in Limine to Preclude Certain Testimony of Michael Shamos, Ph.D, JD.** (NO. 98-0118)

**W.D.Pa.**

- 47 SIGHTSOUND.COM INC. v. N2K, INC., ET AL, NO. 2:98cv00118 (Docket) (W.D.Pa. Jan. 16, 1998)

**Patent Family**

- 48 TRANSMITTING DESIRED DIGITAL VIDEO OR AUDIO SIGNAL - TRANSFERRING MONEY VIA TELECOMMUNICATIONS LINE, CONNECTING ELECTRONICALLY FIRST MEMORY WITH SECOND MEMORY AND TRANSMITTING SIGNAL WITH TRANSMITTER IN CONTROL OF FIRST, Derwent World Patents Legal 1993-093541

**Assignments**

- 49 Action: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS). Number of Pages: 006, (DATE RECORDED: Dec 27, 2005)
- 50 ACTION: NOTICE OF GRANT OF SECURITY INTEREST NUMBER OF PAGES: 006, (DATE RECORDED: Oct 24, 2001)
- 51 ACTION: CHANGE OF NAME (SEE DOCUMENT FOR DETAILS). NUMBER OF PAGES: 016, (DATE RECORDED: May 03, 2000)
- 52 ASSIGNEE(S): PARSEC SIGHT/SOUND, INC., (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)

**Docket Summaries**

- 56 "SIGHTSOUND TECH v. ROXIO, INC., ET AL", (W.D.PA. Oct 08, 2004) (NO. 2:04CV01549), (35 USC 271 PATENT INFRINGEMENT)

**Litigation Alert**

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

**Prior Art (Coverage Begins 1976)**

- ▶ 58 AUTOMATIC INFORMATION, GOODS AND SERVICES DISPENSING SYSTEM, US PAT 4567359 (U.S. PTO Utility 1986)
- C 59 COIN-OPERATED RECORDING MACHINE, US PAT 3990710 (U.S. PTO Utility 1976)
- C 60 SOFTWARE VENDING SYSTEM, US PAT 4654799 Assignee: Brother Kogyo Kabushiki Kaisha, (U.S. PTO Utility 1987)
- C 61 VENDING SYSTEM FOR REMOTELY ACCESSIBLE STORED INFORMATION, US PAT 3718906 Assignee: Lightner R, (U.S. PTO Utility 1973)
- C 62 VIDEO CASSETTE SELECTION MACHINE, US PAT 4647989 (U.S. PTO Utility 1987)

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**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, August 04, 2008**

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<b>Date Filed: 10/08/2004</b>	<b>Class Code: CLOSED</b>
<b>Assigned To: Chief Judge Donetta W Ambrose</b>	<b>Closed: Yes</b>
<b>Referred To:</b>	<b>Statute: 35:271</b>
<b>Nature of suit: Patent (830)</b>	<b>Jury Demand: Both</b>
<b>Cause: Patent Infringement</b>	<b>Demand Amount: \$0</b>
<b>Lead Docket: None</b>	<b>NOS Description: Patent</b>
<b>Other Docket: Dkt in other court: 05-01277</b>	
<b>Dkt in other court: Related, 2:98-cv-118</b>	
<b>Jurisdiction: Federal Question</b>	

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<b>Date</b>	<b>#</b>	<b>Proceeding Text</b>
10/08/2004	1	COMPLAINT with summons issued; jury demand Filing Fee \$ 150.00 Receipt # 05000126 (tt) (Entered: 10/08/2004)
10/08/2004	2	DISCLOSURE statement by SIGHTSOUND TECH (tt) (Entered: 10/08/2004)
10/08/2004	--	COPY of Complaint and Docket Entries mailed to the Commissioner of Patents and Trademarks. (tt) (Entered: 10/08/2004)
11/08/2004	3	RETURN OF SERVICE executed as to ROXIO, INC. 11/5/04 Answer due on 11/26/04 for ROXIO, INC. (tt) (Entered: 11/09/2004)
11/08/2004	4	RETURN OF SERVICE executed as to NAPSTER, L.L.C. 11/5/04 Answer due on 11/26/04 for NAPSTER, L.L.C. (tt) (Entered: 11/09/2004)
11/24/2004	5	ANSWER to Complaint; jury demand and COUNTERCLAIM by ROXIO, INC., NAPSTER, L.L.C. (Attorney William M. Wycoff, Kevin P. Allen, Charles K. Verhoeven, Michael E. Williams) against SIGHTSOUND TECH (tt) Modified on 03/11/2005 (Entered: 11/24/2004)
11/24/2004	6	DISCLOSURE statement by ROXIO, INC., NAPSTER, L.L.C. (tt) (Entered: 11/24/2004)
11/24/2004	7	NOTICE Opting Out of Arbitration by ROXIO, INC., NAPSTER, L.L.C. (tt) (Entered: 11/24/2004)
12/15/2004	8	ANSWER by SIGHTSOUND TECH to [5-2] counterclaims by NAPSTER, L.L.C., ROXIO, INC. (tt) (Entered: 12/16/2004)
12/17/2004	9	Case Management Conference set for 9:15 1/11/05 (tt) (Entered: 12/17/2004)
01/10/2005	10	INITIAL Case Scheduling Conference Statement by ROXIO, INC., NAPSTER, L.L.C. (tt) (Entered: 01/10/2005)
01/10/2005	11	MOTION by SIGHTSOUND TECH for Preliminary Injunction , with Proposed Order. (tt) (Entered: 01/11/2005)
01/10/2005	12	EXHIBITS by SIGHTSOUND TECH to [11-1] motion for Preliminary Injunction (tt) (Entered: 01/11/2005)
01/10/2005	13	BRIEF by SIGHTSOUND TECH in support of [11-1] motion for Preliminary Injunction by SIGHTSOUND TECH (tt) (Entered: 01/11/2005)
01/10/2005	14	DECLARATION of Justin Douglas Tygar, Ph.D. concerning the Operation of Roxio/Napster Re: [11-1] motion for Preliminary Injunction by SIGHTSOUND TECH (tt) (Entered: 01/11/2005)
01/11/2005	15	MOTION by ROXIO, INC., NAPSTER, L.L.C. to Substitute Attorney , with Proposed Order. (tt) (Entered: 01/11/2005)
01/11/2005	16	MOTION by ROXIO, INC., NAPSTER, L.L.C. for Charles K. Verhoeven to Appear Pro Hac Vice ; Filing Fee \$ 40.00 Receipt # 05001581 , with Proposed Order. (tt) (Entered: 01/11/2005)
01/11/2005	17	MOTION by ROXIO, INC., NAPSTER, L.L.C. for Tigran Guledjian to Appear Pro Hac Vice ; Filing Fee \$ 40.00 Receipt # 05001581 , with Proposed Order. (tt) (Entered: 01/11/2005)
01/11/2005	18	MOTION by ROXIO, INC., NAPSTER, L.L.C. for Michael E. Williams to Appear Pro Hac Vice ; Filing Fee \$ 40.00 Receipt # 05001581 , with Proposed Order. (tt) (Entered: 01/11/2005)
01/11/2005	19	Status Conference held 1/11/05 before Chief Judge Donetta W. Ambrose [ Reporter: none ] (tt) (Entered: 01/11/2005)
01/11/2005	--	Deadline updated; Response to Motion set to 2/11/05 for [11-1] motion for Preliminary Injunction ; Reply to Response to Motion set to 2/21/05 for [11-1] motion for Preliminary Injunction ; Motion Hearing set for 1:30 3/3/05 for [11-1] motion for Preliminary Injunction (tt) (Entered: 01/11/2005)
01/11/2005	20	RESPONSE by SIGHTSOUND TECH to defts' [10-1] Initial Case Scheduling Conference Statement. (tt) (Entered: 01/11/2005)
01/11/2005	--	ORDER upon motion granting [15-1] motion to Substitute Attorney ; terminated attorney William M. Wycoff for ROXIO, INC., attorney Kevin P. Allen for ROXIO, INC., attorney William M. Wycoff for NAPSTER, L.L.C., attorney Kevin P. Allen for NAPSTER, L.L.C. and added Laurence Z. Shiekman, Kathryn M. Kenyon for defts. ( signed by Chief Judge Donetta W. Ambrose on 1/11/05 ) CM all parties of record. (tt) (Entered: 01/12/2005)
01/11/2005	--	ORDER upon motion granting [16-1] motion for Charles K. Verhoeven to Appear Pro Hac Vice on

behalf of defts. ( signed by Chief Judge Donetta W. Ambrose on 1/11/05 ) CM all parties of record. (tt) (Entered: 01/12/2005)

01/11/2005 -- ORDER upon motion granting [17-1] motion for Tigran Guledjian to Appear Pro Hac Vice on behalf of defts. ( signed by Chief Judge Donetta W. Ambrose on 1/11/05 ) CM all parties of record. (tt) (Entered: 01/12/2005)

01/11/2005 -- ORDER upon motion granting [18-1] motion for Michael E. Williams to Appear Pro Hac Vice on behalf of defts. ( signed by Chief Judge Donetta W. Ambrose on 1/11/05 ) CM all parties of record. (tt) (Entered: 01/12/2005)

01/18/2005 21 Status Conference via phone held 1/18/05 before Chief Judge Donetta W. Ambrose [ Reporter: none ] ; Deft wants leave to amend counterclaims related to press release. Pltf doesn't object to motion for leave to amend. Leave granted orally by the Court; Amended counterclaim due 1/25/05. Deft to file a Motion to Stay Case pending outcome of application to Patent & Trademark Office, response due w/in 10 days. (tt) (Entered: 01/19/2005)

01/21/2005 22 MOTION by ROXIO, INC., NAPSTER, L.L.C. to Stay Pending Reexamination of Patents in Suit with Proposed Order. (jsp) (Entered: 01/24/2005)

01/21/2005 23 BRIEF by ROXIO, INC., NAPSTER, L.L.C. in support of [22-1] motion to Stay Pending Reexamination of Patents in Suit by NAPSTER, L.L.C., ROXIO, INC. (jsp) (Entered: 01/24/2005)

01/25/2005 24 FIRST AMENDED ANSWER to Complaint by ROXIO, INC., NAPSTER, L.L.C. amends: [5-1] answer by NAPSTER, L.L.C., ROXIO, INC. and COUNTERCLAIMS against SIGHTSOUND TECH (tt) (Entered: 01/26/2005)

01/27/2005 25 MOTION by SIGHTSOUND TECH to Extend Time w/in which to respond to defts' motion to stay pending receipt of defts' request for re-examination of patents and prior art which defts intend to submit to the Patent and Trademark Office , with Proposed Order. (tt) (Entered: 01/28/2005)

01/28/2005 26 RESPONSE by ROXIO, INC., NAPSTER, L.L.C. to pltf's [25-1] motion to Extend Time w/in which to respond to defts' motion to stay (tt) (Entered: 01/28/2005)

01/28/2005 27 ACCEPTANCE OF SERVICE of First Amended Answer and Counterclaim as to Scott Sander executed 1/26/05 (tt) (Entered: 01/28/2005)

01/28/2005 28 BRIEF by SIGHTSOUND TECH in support of [25-1] motion to Extend Time w/in which to respond to defts' motion to stay (tt) (Entered: 01/31/2005)

02/02/2005 29 Status Conference via phone held 1/31/05 before Chief Judge Donetta W. Ambrose [ Reporter: none ] ; Pltf's response to motion to stay due 2/11/05 ; Defts' reply due 2/16/05 ; Preliminary injunction date will be scheduled via order on motion to stay ; Defts do not have to file answer to preliminary injunction by March. (tt) (Entered: 02/02/2005)

02/02/2005 -- ORDER upon motion granting [25-1] motion to Extend Time w/in which to respond to defts' motion to stay pending receipt of defts' request for re-examination of patents and prior art which defts intend to submit to the Patent and Trademark Office. Defts shall serve on counsel for pltf by overnight delivery sent no later than 2/1/05 any request for re-examination of the patents in suit which defts intend to file with the PTO, including all prior art on which defts plan to rely in such request for re-examination ; Pltf's Response to Motion set to 2/11/05 for defts' [22-1] motion to Stay Pending Reexamination of Patents in Suit ; Defts' Reply Brief due 2/16/05 ; Defts are not required to file an answer to pltf's motion for preliminary injunction until further order of court. ( signed by Chief Judge Donetta W. Ambrose on 1/31/05 ) CM all parties of record. (tt) (Entered: 02/02/2005)

02/03/2005 30 MOTION by SIGHTSOUND TECH for Brian S. Mudge to Appear Pro Hac Vice ; Filing Fee \$ 40.00 Receipt # 05001943 , with Proposed Order. (tt) (Entered: 02/04/2005)

02/03/2005 31 MOTION by SIGHTSOUND TECH for William K. Wells to Appear Pro Hac Vice ; Filing Fee \$ 40.00 Receipt # 05001943 , with Proposed Order. (tt) (Entered: 02/04/2005)

02/03/2005 32 MOTION by SIGHTSOUND TECH for Duncan L. Williams to Appear Pro Hac Vice ; Filing Fee \$ 40.00 Receipt # 05001943 , with Proposed Order. (tt) (Entered: 02/04/2005)

02/03/2005 33 MOTION by SIGHTSOUND TECH for Clyde E. Findley to Appear Pro Hac Vice ; Filing Fee \$40.00 05001943 Receipt # 05001943 , with Proposed Order. (tt) (Entered: 02/04/2005)

02/04/2005 34 NOTICE of Lodging of Pending Requests for Reexamination by ROXIO, INC., NAPSTER, L.L.C. (tt) (Entered: 02/04/2005)

02/04/2005 35 EXHIBITS (VOLUME I) by ROXIO, INC., NAPSTER, L.L.C. to [34-1] notice of lodging of pending requests for reexamination. (tt) (Entered: 02/04/2005)

02/04/2005 36 EXHIBITS (VOLUME II) by ROXIO, INC., NAPSTER, L.L.C. to [34-1] notice of lodging of pending requests for reexamination. (tt) (Entered: 02/04/2005)

02/04/2005 37 EXHIBITS (VOLUME III) by ROXIO, INC., NAPSTER, L.L.C. to [34-1] notice of lodging of pending requests for reexamination. (tt) (Entered: 02/04/2005)

02/07/2005 -- ORDER upon motion granting [30-1] motion for Brian S. Mudge to Appear Pro Hac Vice on behalf of pltf. ( signed by Chief Judge Donetta W. Ambrose on 2/4/05 ) CM all parties of record. (tt) (Entered: 02/07/2005)

02/07/2005 -- ORDER upon motion granting [31-1] motion for William K. Wells to Appear Pro Hac Vice on behalf of pltf. ( signed by Chief Judge Donetta W. Ambrose on 2/4/05 ) CM all parties of record. (tt) (Entered: 02/07/2005)

02/07/2005 -- ORDER upon motion granting [32-1] motion for Duncan L. Williams to Appear Pro Hac Vice on behalf of pltf. ( signed by Chief Judge Donetta W. Ambrose on 2/4/05 ) CM all parties of record. (tt) (Entered: 02/07/2005)

02/07/2005 -- ORDER upon motion granting [33-1] motion for Clyde E. Findley to Appear Pro Hac Vice on behalf of pltf. ( signed by Chief Judge Donetta W. Ambrose on 2/4/05 ) CM all parties of record. (tt) (Entered: 02/07/2005)

02/11/2005 38 REPLY by SIGHTSOUND TECH to [24-2] First Amended Counterclaims by NAPSTER, L.L.C., ROXIO, INC. (tt) (Entered: 02/14/2005)

02/11/2005 39 BRIEF by SIGHTSOUND TECH in opposition to Napster's [22-1] motion to Stay Pending Reexamination of Patents in Suit (tt) (Entered: 02/14/2005)

02/11/2005 40 MOTION by SIGHTSOUND TECH, SCOTT SANDER to Dismiss defts' Amended Counterclaims 4-9 . (tt) (Entered: 02/14/2005)

02/11/2005 41 BRIEF by SIGHTSOUND TECH, SCOTT SANDER in support of their [40-1] motion to Dismiss defts' Amended Counterclaims 4-9 (tt) (Entered: 02/14/2005)

02/16/2005 42 REPLY by ROXIO, INC., NAPSTER, L.L.C. in support of their Motion to Stay pending Reexamination of the Patents-In-Suit (tt) (Entered: 02/17/2005)

02/16/2005 43 DECLARATION of William E. Growney (tt) Modified on 02/18/2005 (Entered: 02/17/2005)

02/16/2005 44 MOTION by ROXIO, INC., NAPSTER, L.L.C. to Seal [43-1] Declaration , with Proposed Order. (tt) (Entered: 02/17/2005)

02/17/2005 45 OPPOSITION by SIGHTSOUND TECH to defts' [44-1] motion to Seal [43-1] Declaration (tt) (Entered: 02/18/2005)

02/17/2005 46 NOTICE OF FILING: Supplemental Declaration of Christopher Reese by SIGHTSOUND TECH (FILED UNDER SEAL) (tt) Modified on 02/28/2005 (Entered: 02/18/2005)

02/17/2005 47 REQUEST by SIGHTSOUND TECH for Oral Argument on Motion to Stay . (tt) (Entered: 02/18/2005)

02/18/2005 -- ORDER upon motion denying [44-1] motion to Seal [43-1] Declaration. The declaration speaks only of vague, unsuccessful attempts & no dollar values are set forth. I see no risk of confidential information being disclosed. ( signed by Chief Judge Donetta W. Ambrose on 2/18/05 ) CM all parties of record. (tt) (Entered: 02/18/2005)

02/18/2005 -- ORDER upon motion denying [47-1] motion for Oral Argument on Motion to Stay. The parties have clearly represented their respective positions in the briefs and declarations filed. ( signed by Chief Judge Donetta W. Ambrose on 2/18/05 ) CM all parties of record. (tt) (Entered: 02/18/2005)

02/23/2005 48 MOTION by ROXIO, INC., NAPSTER, L.L.C. to Seal Supplemental Declaration of Christopher Reese , with Proposed Order. (tt) (Entered: 02/23/2005)

02/23/2005 49 OPPOSITION by SIGHTSOUND TECH to defts' [48-1] motion to Seal Supplemental Declaration of Christopher Reese (tt) (Entered: 02/24/2005)

02/28/2005 -- ORDER upon motion granting [48-1] motion to Seal Supplemental Declaration of Christopher Reese. The Supplemental Declaration of Christopher Reese filed 2/17/05 shall be placed under seal. ( signed by Chief Judge Donetta W. Ambrose on 2/28/05 ) CM all parties of record. (tt) (Entered: 02/28/2005)

02/28/2005 50 MEMORANDUM OPINION & ORDER granting defts' [22-1] motion to Stay. The defts are to contact this Court immediately upon receiving any notification from the PTO regarding the outcome of the Request for Reexamination. The preliminary injunction hearing scheduled for 3/3/05 is cancelled . The [11-1] motion for Preliminary Injunction is denied without prejudice to reassert once the stay is lifted. ( signed by Chief Judge Donetta W. Ambrose on 2/28/05 ) CM all parties of record. (tt) (Entered: 02/28/2005)

03/03/2005 51 NOTICE OF APPEAL by SIGHTSOUND TECH from [50-1] memorandum opinion dated 2/28/05

FILING FEE \$ 255 RECEIPT # 2394 TPO issued. (lck) (Entered: 03/07/2005)

03/03/2005 -- Certified copy of Notice of Appeal [51-1] appeal by SIGHTSOUND TECH , certified copy of docket, certified copy of order dated 2/28/05 mailed to USCA; copy of Notice of Appeal and information sheet to ROXIO, INC., NAPSTER, L.L.C. and judge. Copy of information sheet to appellant. (lck) (Entered: 03/07/2005)

03/11/2005 52 Transcript Purchase order re: [51-1] appeal by SIGHTSOUND TECH indicating that no transcript is being ordered. (tt) (Entered: 03/11/2005)

03/21/2005 -- Text not available. (Entered: 03/21/2005)

04/04/2005 53 NOTICE of PTO's Order granting ex parte Reexamination by ROXIO, INC., NAPSTER, L.L.C. (tt) (Entered: 04/04/2005)

07/21/2005 54 MOTION for Relief from Stay with Respect to Defamation Counterclaims by SIGHTSOUND TECHNOLOGIES, INC., SCOTT SANDER. (Attachments: # 1 Proposed Order)(jsp) (Entered: 07/21/2005)

07/21/2005 55 BRIEF in Support re 54 MOTION for Relief from Stay with Respect to Defamation Counterclaims filed by SIGHTSOUND TECHNOLOGIES, INC., SCOTT SANDER. (Attachments: # 1 Part 2 of Brief)(jsp) (Entered: 07/21/2005)

07/22/2005 56 NOTICE: re 54 MOTION for Relief from Stay with Respect to Defamation Counterclaims:Response due on or before 8/4/05. (jlh) (Entered: 07/22/2005)

08/04/2005 57 NOTICE by ROXIO, INC., NAPSTER, L.L.C. of PTO's Issuance of Office Actions in Ex Parte Reexamination (Attachments: # 1 # 2 # 3)(Helmsen, Joseph) (Entered: 08/04/2005)

08/04/2005 58 MOTION for attorney Michael T. Zeller to Appear Pro Hac Vice by ROXIO, INC., NAPSTER, L.L.C.. (Attachments: # 1 Proposed Order)(Kenyon, Kathryn) (Entered: 08/04/2005)

08/04/2005 59 NOTICE by ROXIO, INC., NAPSTER, L.L.C. re 57 Notice (Other) Letter Notice of Prior Filing (Kenyon, Kathryn) (Entered: 08/04/2005)

08/04/2005 60 BRIEF in Opposition re 54 MOTION for Relief from Stay with Respect to Defamation Counterclaims filed by ROXIO, INC., NAPSTER, L.L.C.. (Attachments: # 1 Exhibit A# 2 Exhibit B# 3 Exhibit C# 4 Exhibit D# 5 Exhibit E# 6 Exhibit F# 7 Exhibit G# 8 Exhibit H)(Kenyon, Kathryn) (Entered: 08/04/2005)

08/04/2005 -- Pro Hac Vice Fees received in the amount of \$ 40 receipt # 4877 re 58 Motion to Appear Pro Hac Vice (ept) (Entered: 08/05/2005)

08/08/2005 61 ORDER granting 58 Motion to Appear Pro Hac Vice . Signed by Judge Donetta W. Ambrose on 8/8/05. (jlh ) (Entered: 08/08/2005)

09/01/2005 62 ORDER denying 54 Motion for Relief from Stay . Signed by Judge Donetta W. Ambrose on 8/31/05. (jlh ) (Entered: 09/01/2005)

09/06/2005 63 NOTICE by SIGHTSOUND TECHNOLOGIES, INC., SCOTT SANDER NOTICE OF FILING TO SUPPLEMENT RECORD (Kerr, Benjamin) (Entered: 09/06/2005)

09/07/2005 64 Minute Entry for proceedings held before Judge Donetta W. Ambrose : Status Conference held on 9/7/2005. Parties to keep Court informed of PTO Action. (jlh ) (Entered: 09/07/2005)

11/02/2005 65 NOTICE by ROXIO, INC., NAPSTER, L.L.C. of PTO's Issuance of Second Office Actions in Ex Parte Reexamination (Attachments: # 1 Exhibit A# 2 Exhibit B# 3 Exhibit C)(Kenyon, Kathryn) (Entered: 11/02/2005)

11/14/2005 66 MANDATE of USCA for the Federal Circuit as to 51 Notice of Appeal filed by SIGHTSOUND TECHNOLOGIES, INC., that the appeal is dismissed, with each party to bear its own costs. (jsp) (Entered: 11/15/2005)

03/02/2006 67 MOTION by Clyde E. Findley to Withdraw as Attorney by SIGHTSOUND TECHNOLOGIES, INC. (jsp) (Entered: 03/02/2006)

05/10/2006 68 NOTICE by ROXIO, INC., NAPSTER, L.L.C. Defendants' Notice of PTO's Issuance of Final Office Actions in Ex Parte Reexamination and Request for Status Conference (Attachments: # 1 Exhibit A)(Kenyon, Kathryn) (Entered: 05/10/2006)

05/10/2006 69 EXHIBITS in Support of 68 Notice (Other) by ROXIO, INC., NAPSTER, L.L.C.. (Kenyon, Kathryn) (Entered: 05/10/2006)

05/10/2006 70 EXHIBITS in Support of 68 Notice (Other) by ROXIO, INC., NAPSTER, L.L.C.. (Kenyon, Kathryn) (Entered: 05/10/2006)

05/10/2006 -- MOTION (Request) for Status Conference by ROXIO, INC., NAPSTER, L.L.C..(with Document 68 ) (jsp) (Entered: 05/11/2006)

05/11/2006 -- CLERK'S OFFICE QUALITY CONTROL MESSAGE. re 68 Notice (Other) ERROR: Document should have been filed as two separate documents. CORRECTION: Attorney advised in future that documents of that nature are to be filed as separate documents. Clerk of Court docketed Request for Status Conference. This message is for informational purposes only. (jsp) (Entered: 05/11/2006)

05/31/2006 71 Minute Entry for proceedings held before Judge Donetta W. Ambrose : Telephone Conference held on 5/31/2006. (Court Reporter none) (jlh ) (Entered: 05/31/2006)

05/31/2006 72 ORDER FOR ADMINISTRATIVE CLOSING.Signed by Judge Donetta W. Ambrose on 5/31/06. (jlh) (Entered: 05/31/2006)

06/02/2006 73 NOTICE by SIGHTSOUND TECHNOLOGIES, INC. Notice of Filing by Sightsound Technologies, Inc. of Sua Sponte Decisions of United States Patent and Trademark Office Vacating Previous Final Office Actions (Rinaldo, Richard) (Entered: 06/02/2006)

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586391 (07) 5191573 March 2, 1993

## UNITED STATES PATENT AND TRADEMARK OFFICE GRANTED PATENT

5191573

[Access PDF of Official Patent \\*](#)[Order Patent File History / Wrapper from REEDFAX@](#)[Link to Claims Section](#)

March 2, 1993

Method for transmitting a desired digital video or audio signal

**REEXAM-LITIGATE:**

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

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

**INVENTOR:** Hair, Arthur R. - 301 Oaklawn Dr., Pittsburgh, United States of America (US)**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**PRIORITY:** June 13, 1988 - 07206497, United States of America (US)**ASSIGNEE-AT-ISSUE:**

HAIR; ARTHUR R., United States of America (US)

**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: 007656/0701

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: 010776/0703

October 24, 2001 - NOTICE OF GRANT OF SECURITY INTEREST, 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, D&DF WATERVIEW PARTNERS, L.P. ONE STERLING PLAZA 152 WEST 57TH STREET, 46TH FLOOR NEW YORK, NEW YORK, 10019, Reel and Frame Number: 012506/0415

December 27, 2005 - ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS)., DMT LICENSING, LLC ONE INDEPENDENCE WAY PRINCETON NEW JERSEY 08540, ONE INDEPENDENCE WAY, PRINCETON, NEW JERSEY, UNITED STATES OF AMERICA (US), 08540, Reel and Frame Number: 017555/0149

**LEGAL-REP:** Schwartz, Ansel M.**PUB-TYPE:** March 2, 1993 - Patent (A)**PUB-COUNTRY:** United States of America (US)**LEGAL-STATUS:**

December 21, 1993 - CERTIFICATE OF CORRECTION October 2, 1995 - ASSIGNMENT OF ASSIGNOR'S INTEREST October 2, 1995 - ASSIGNMENT OF ASSIGNOR'S INTEREST October 2, 1995 - ASSIGNMENT May 3, 2000 - ASSIGNMENT May 3, 2000 - ASSIGNMENT October 24, 2001 - ASSIGNMENT October 24, 2001 - ASSIGNMENT October 24, 2001 - ASSIGNMENT October 24, 2001 - ASSIGNMENT October 24, 2001 - ASSIGNMENT October 24, 2001 - ASSIGNMENT October 24, 2001 - ASSIGNMENT October 24, 2001 - ASSIGNMENT October 24, 2001 - ASSIGNMENT March 29, 2005 - REQUEST FOR REEXAMINATION FILED December 27, 2005 - ASSIGNMENT

**FILING-LANG:** English (EN) (ENG)

**PUB-LANG:** English (EN) (ENG)

**REL-DATA:**

Continuation of Ser. No. 206497, June 13, 1988, ABANDONED, September 18, 1990

**US-MAIN-CL:** 369#84

**US-ADDL-CL:** 235#380, 235#381, 348#E07.071, 369#15, 369#85, G9B#20.002, G9B#27.002, G9B#27.012, G9B#27.019, G9B#27.051

**CL:** 369, 235, 348, G9B

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

**IPC-MAIN-CL:** [7] G11B 005#86

**IPC-MAIN-CL:** [8] G07F 017#00 (20060101) Core Inventive 20051008 (C I R M EP)

**IPC-ADDL-CL:** [7] G11B 007#00

**IPC-ADDL-CL:** [7] G11B 011#00

**IPC-ADDL-CL:** [8] G07F 017#16 (20060101) Advanced Inventive 20051008 (A I R M EP)

**IPC-ADDL-CL:** [8] G11B 020#00 (20060101) Core Inventive 20051008 (C I R M EP)

**IPC-ADDL-CL:** [8] G11B 020#00 (20060101) Advanced Inventive 20051008 (A I R M EP)

**IPC-ADDL-CL:** [8] G11B 027#00 (20060101) Core Inventive 20051008 (C I R M EP)

**IPC-ADDL-CL:** [8] G11B 027#00 (20060101) Advanced Inventive 20051008 (A I R M EP)

**IPC-ADDL-CL:** [8] G11B 027#31 (20060101) Core Inventive 20051008 (C I R M EP)

**IPC-ADDL-CL:** [8] G11B 027#34 (20060101) Advanced Inventive 20051008 (A I R M EP)

**IPC-ADDL-CL:** [8] G11B 027#10 (20060101) Core Inventive 20051008 (C I R M EP)

**IPC-ADDL-CL:** [8] G11B 027#10 (20060101) Advanced Inventive 20051008 (A I R M EP)

**IPC-ADDL-CL:** [8] G11B 027#34 (20060101) Core Inventive 20051008 (C I R M EP)

**IPC-ADDL-CL:** [8] G11B 027#34 (20060101) Advanced Inventive 20051008 (A I R M EP)

**IPC-ADDL-CL:** [8] H04H 001#02 (20060101) Core Inventive 20051008 (C I R M EP)

**IPC-ADDL-CL:** [8] H04H 001#02 (20060101) Advanced Inventive 20051008 (A I R M EP)

**IPC-ADDL-CL:** [8] H04N 007#173 (20060101) Core Inventive 20051008 (C I R M EP)

**IPC-ADDL-CL:** [8] H04N 007#173 (20060101) Advanced Inventive 20051008 (A I R M EP)

**PRIM-EXMR:** Nguyen; Hoa

**REF-CITED:**

3718906, February 27, 1973, Lightner, United States of America (US), 235#381

3990710, November 9, 1976, Hughes, United States of America (US), 369#34

4567359, January 28, 1986, Lockwood, United States of America (US), 235#381

4647989, March 3, 1987, Geddes, United States of America (US), 235#381

4654799, March 31, 1987, Ogaki et al., United States of America (US), 364#479

**CORE TERMS:** digital, music, audio, user, memory, song, electronically, hard disk, stored, hardware, video, electronic, playback, methodology, integrated, compact, display, random, disc, telecommunications, transmitting, additionally, tape, telephone lines, receiver, stereo, randomly, album, audio signal, random access memory

**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**

**NO-OF-FIGURES: 2**

**PARENT-PAT-INFO:**

This is a continuation of copending application Ser. No. 07/206,497 filed on Jun. 13, 1988, now abandoned.

**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 transferred from the manufacturing facility to the wholesale warehouse to the retail warehouse to the retail outlet, resulting in lengthy, lag time between music creation and music marketing, as well as incurring unnecessary 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 transferring Digital Audio 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 in 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 jockey. 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 been 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:**  
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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 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 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.

**LOAD-DATE:** November 17, 2009

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- A** 1. [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, memory, telecommunication, electronically, patent, audio signals, signal, specification, desired, transferring ...

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

- ◆** 2. [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, sightsound, invention, music, summary judgment, signal, prior art, license, consumer ...

... Office ("PTO") issued United States Patent No. **5,191,573** ("the '573 Patent") to Mr. Hair who ...

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1. [Canadian Press Newswire](#), September 4, 2001, Pg. S 4'01, 5191573, 77 words, Trio of alleged drug-smugglers from Montreal elect trial by judge alone
2. [Canadian Press Newswire](#), September 4, 2001, Pg. S 4'01, 5191573, 77 words, Trio of alleged drug-smugglers from Montreal elect trial by judge alone(Record in progress)
3. [The Toronto Sun](#), May 19, 2000, Friday,, Final EDITION, NEWS,, Pg. 32, 174 words, KILLER INSULTS VICTIM'S KIN, ALAN CAIRNS, TORONTO SUN, BARRIE
4. [Salon.com](#), March 9, 1999 Tuesday, Feature, 2469 words, How can they patent that?, By Peter Wayner ... card account numbers from prying eyes. Or consider patents [5191573](#) and 5675734, created by Arthur Hair when he lived in ...  
... Milne, an engineer for N2K, is evaluating what patents [5191573](#) and 5675734 mean to his company's plans for selling music ...
5. [Business Wire](#), May 19, 1998, Tuesday, 867 words, Digital Sight/Sound Rolls Out First Patented Method for Sale of Digital Audio/Video Over the Internet, LOS ANGELES
- CORE TERMS:** A2B, Sight, Internet, recordings, download, audio, protection, Sander, Scott, Hair, licensee, patent  
... enjoy patent protection under United States Patents [5,191,573](#) and 5,675,734. "A2B is a superb platform for the download ...
6. [Business Wire](#), May 18, 1998, Monday, 867 words, Digital Sight/Sound Rolls Out First Patented Method for Sale of Digital Audio/Video Over the Internet, LOS ANGELES
- CORE TERMS:** A2B, Sight, Internet, recordings, download, audio, protection, Sander, Scott, Hair, licensee, patent  
... enjoy patent protection under United States Patents [5,191,573](#) and 5,675,734. "A2B is a superb platform for the download ...
7. [Business Wire](#), May 19, 1998, B0IE0BHBYTWR, 839 words, DIGITAL SIGHT/SOUND ROLLS OUT FIRST PATENTED METHOD FOR SALE OF DIGITAL AUDIO/VIDEO OVER THE INTERNET
- CORE TERMS:** Hair, A2B, sight, Internet, audio, recording, download, Sander, Scott, Web, programming, protection, engineer, patent, Microshows, Arthur, EJs, sightsound, digitally, focused, licensee, recorded, fashion, concept, medium, www, com  
... enjoy patent protection under United States Patents [5,191,573](#) and 5,675,734. "A2B is a superb platform for the download ...
8. [Business Wire](#), May 19, 1998, B0IETBZAM6WR, 844 words, DIGITAL SIGHT/SOUND ROLLS OUT FIRST PATENTED METHOD FOR SALE OF DIGITAL
- CORE TERMS:** Hair, A2B, sight, Internet, audio, recording, download, Sander, Scott, Web, programming, protection, engineer, patent, Microshows, Arthur, EJs, sightsound, digitally, focused, licensee, recorded, fashion, concept, medium, www, com  
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9. [Business Wire](#), May 18, 1998, B0IE0BHABEWR, 839 words, DIGITAL SIGHT/SOUND ROLLS OUT FIRST PATENTED METHOD FOR SALE OF DIGITAL AUDIO/VIDEO OVER THE INTERNET
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10. [Business Wire](#), May 18, 1998, B0IESBSA2JWR, 844 words, DIGITAL SIGHT/SOUND ROLLS OUT FIRST PATENTED METHOD FOR SALE OF DIGITAL
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# Patent Assignment Abstract of Title

## Total Assignments: 4

Application #: 07586391

Filing Dt: 09/18/1990

Patent #: 5191573

Issue Dt: 03/02/1993

PCT #: NONE

Publication #: NONE

Pub Dt:

Inventor: ARTHUR R. HAIR

Title: METHOD FOR TRANSMITTING A DESIRED DIGITAL VIDEO OR AUDIO SIGNAL

## Assignment: 1

Reel/Frame: 007656 / 0701

Received: 10/20/1995

Recorded: 10/02/1995

Mailed: 02/21/1996

Pages: 4

Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

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Exec Dt: 09/20/1995

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## Assignment: 2

Reel/Frame: 010776 / 0703

Received: 05/16/2000

Recorded: 05/03/2000

Mailed: 07/14/2000

Pages: 16

Conveyance: CHANGE OF NAME (SEE DOCUMENT FOR DETAILS).

Assignor: PARSEC SIGHT/SOUND, INC.

Exec Dt: 04/26/2000

Assignee: SIGHTSOUND.COM INCORPORATED

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## Assignment: 3

Reel/Frame: 012506 / 0415

Received: 01/30/2002

Recorded: 10/24/2001

Mailed: 04/25/2002

Pages: 6

Conveyance: NOTICE OF GRANT OF SECURITY INTEREST

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Exec Dt: 10/01/2001

Assignees: KENYON & KENYON

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## Assignment: 4

Reel/Frame: 017555 / 0149

Received: 12/30/2005

Recorded: 12/27/2005

Mailed: 05/01/2006

Pages: 6

Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

Assignor: SIGHTSOUND TECHNOLOGIES, INC.

Exec Dt: 11/10/2005

Assignee: DMT LICENSING, LLC

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<b>SERIAL NUMBER</b> 90/007,402	<b>FILING OR 371(c) DATE</b> 01/31/2005 <b>RULE</b>	<b>CLASS</b> 369	<b>GROUP ART UNIT</b> 2655	<b>ATTORNEY DOCKET NO.</b> NAPS001	
<b>APPLICANTS</b> 5191573, Residence Not Provided; SightSound.com Incorporated (Owner), Mt. Lebanon, PA, DMT Licensing, LLC (owner), Napster, Inc. (3rd Pty. Req.), Los Angeles, CA; Princeton, NJ Albert S. Penilla, Sunnyvale, CA					
<b>** CONTINUING DATA *****</b> This application is a REX of 07/586,391 09/18/1990 PAT 5,191,573 <i>BC</i> which is a CON of 07/208,497 08/13/1988 ABN					
<b>** FOREIGN APPLICATIONS *****</b> NONE <i>BC</i>					
Foreign Priority claimed <input type="checkbox"/> yes <input checked="" type="checkbox"/> no		<b>STATE OR COUNTRY</b>	<b>SHEETS DRAWING</b>	<b>TOTAL CLAIMS</b> 6	<b>INDEPENDENT CLAIMS</b> 2
35 USC 119 (a-d) conditions met <input type="checkbox"/> yes <input checked="" type="checkbox"/> no <input type="checkbox"/> Met after					
Verified and Acknowledged		Examiner's Signature <i>Allowance</i>	Initials <i>BC</i>		
<b>ADDRESS</b> Ansel M. Schwartz 425 N. Craig Street Suite 301 Pittsburgh, PA 15213					
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	<b>Certificate Date</b>	<b>Certificate Number</b> <i>02 C1</i>

<b>Requester Correspondence Address:</b>	<input type="checkbox"/> Patent Owner	<input checked="" type="checkbox"/> Third Party
Albert S. Penilla Martine Penilla & Gencarella, LLP 710 Lakeway Drive, Suite 200 Sunnyvale, CA 94085		

<b>LITIGATION REVIEW</b> <input checked="" type="checkbox"/>	r.g.f. (examiner initials)	08/11/2010 (date)
Case Name		Director Initials
2:04cv1549, closed.		<i>Ein Heard for GM</i>

COPENDING OFFICE PROCEEDINGS	
TYPE OF PROCEEDING	NUMBER
1. None.	

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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

42624 7590 08/16/2010

DAVIDSON BERQUIST JACKSON & GOWDEY LLP  
4300 WILSON BLVD., 7TH FLOOR  
ARLINGTON, VA 22203

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 08/16/2010

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



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CENTRAL REEXAMINATION UNIT

**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)).

**Notice of Intent to Issue  
Ex Parte Reexamination Certificate**

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 --

1.  Prosecution on the merits is (or remains) closed in this *ex parte* reexamination proceeding. This proceeding is subject to reopening at the initiative of the Office or upon petition. Cf. 37 CFR 1.313(a). A Certificate will be issued in view of

(a)  Patent owner's communication(s) filed: 25 May 2010.

(b)  Patent owner's late response filed: \_\_\_\_\_.

(c)  Patent owner's failure to file an appropriate response to the Office action mailed: \_\_\_\_\_.

(d)  Patent owner's failure to timely file an Appeal Brief (37 CFR 41.31).

(e)  Other: \_\_\_\_\_.

Status of *Ex Parte* Reexamination:

(f) Change in the Specification:  Yes  No

(g) Change in the Drawing(s):  Yes  No

(h) Status of the Claim(s):

(1) Patent claim(s) confirmed: 1-6.

(2) Patent claim(s) amended (including dependent on amended claim(s)): \_\_\_\_\_

(3) Patent claim(s) cancelled: \_\_\_\_\_.

(4) Newly presented claim(s) patentable: \_\_\_\_\_.

(5) Newly presented cancelled claims: \_\_\_\_\_.

(6) Patent claim(s)  previously  currently disclaimed: \_\_\_\_\_

(7) Patent claim(s) not subject to reexamination: \_\_\_\_\_.

2.  Note the attached statement of reasons for patentability and/or confirmation. Any comments considered necessary by patent owner regarding reasons for patentability and/or confirmation must be submitted promptly to avoid processing delays. Such submission(s) should be labeled: "Comments On Statement of Reasons for Patentability and/or Confirmation."

3.  Note attached NOTICE OF REFERENCES CITED (PTO-892).

4.  Note attached LIST OF REFERENCES CITED (PTO/SB/08 or PTO/SB/08 substitute.).

5.  The drawing correction request filed on \_\_\_\_\_ is:  approved  disapproved.

6.  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

been received.

not been received.

been filed in Application No. \_\_\_\_\_.

been filed in reexamination Control No. \_\_\_\_\_.

been received by the International Bureau in PCT Application No. \_\_\_\_\_.

\* Certified copies not received: \_\_\_\_\_.

7.  Note attached Examiner's Amendment.

8.  Note attached Interview Summary (PTO-474).

9.  Other: \_\_\_\_\_.

cc: Requester (if third party requester)

U.S. Patent and Trademark Office  
PTOL-469 (Rev.6-06)

Notice of Intent to Issue Ex Parte Reexamination Certificate

Part of Paper No 20100809

**NOTICE OF INTENT TO ISSUE EX PARTE REEXAMINATION CERTIFICATE**

***Summary***

Claims 1-6 of U.S. Patent No. 5,191,573 (the "Hair" patent) are currently under reexamination in this proceeding.

***Patentable Claims***

Claims 1-6 are confirmed.

***Reasons for Patentability***

***Double Patenting Rejection Withdrawn***

As an initial matter, the patent owner arguments regarding the double patenting rejection are persuasive. Specifically, there is no improper extension of a right to exclude due to a transition of patent terms from 17 years from issue to 20 years from the earliest filing date. See p. 5 of the response, filed on May 25, 2010 (the "Response"). Thus, the double patenting rejection is withdrawn.

***Claim Interpretation During Reexamination of an Expired Patent***

As discussed in the last Office action mailed March 25, 2010, the Hair patent under reexamination expired and thus the claims are interpreted according to their ordinary and customary meaning. MPEP § 2111.01.III and 2258.I.G. In a reexamination proceeding in which the PTO is considering the patentability of claims of an expired patent which are not subject to amendment, a policy of liberal claim construction should be applied.

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*Ex parte Papst-Motoren*, 1 USPQ2d 1655, 1656 (BPAI 1986). Even so, the plain language of the claim is the primary determinant of patentability.

In the present Office action, the claims are given their ordinary and customary meaning. The meaning of each claim term in the office actions is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention. The ordinary and customary meaning given to the claim terms in the office action are evidenced by the claims themselves and the remainder of the specification.

The patent owner argues with respect to the step of "storing the digital signal in the second memory" (independent claims 1 and 4) that "cassette tapes and CDs [as taught by the prior art] are not 'second memories' according to the claims and specification." Particularly, the patent owner refers to the background section and summary of the invention to support this argument. Response, p. 3. The "Summary of the Invention describes the invention as 'eliminating the need to unnecessarily handle records, tapes, or compact discs on a regular basis.'" *Id.* The patent owner then relates the specification to the scope of the claims by stating "attempting to read the claimed second memories on exactly the type of media that the specification describes as deficient is a misinterpretation of the scope of the claims. See *SciMed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc.* 242 F.3d 1337 (Fed. Cir. 2001)."

In addition, throughout the prosecution of this reexamination proceeding, the patent owner has repeatedly argued that the second memories are not cassette tapes and CD(s). Indeed,

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before the patent expired and all amendments made during the reexamination proceeding were withdrawn (in accordance with the Office action mailed March 20, 2010), the patent owner amended the claims to explicitly recite that the second memory is not a cassette tape or CD. See, e.g., the amendment to independent claims 1 and 4, filed on November 29, 2006.

*The Claimed Invention Distinguishes Over the Bush, Gallagher, Freeny, Akashi Prior Art*

In view of patent expiration, the specification, and the repeated patent owner statements and actions discussed above, the examiner interprets the ordinary and customary meaning of "second memories" as not including cassette tapes, CDs and the like. The prior art "base references" applied in the last Office action mailed March 25, 2010, namely Akashi, Bush and Gallagher, relied upon a second memory in the form of a tape and/or CD. Thus, any combination based upon these references fails to teach the claimed invention.

*The Claimed Invention Distinguishes Over other Art of Record for the Reasons Set Forth in the Board Decision*

Thus, the original claims have essentially the same scope as the amended, original claims did when they were reviewed by the Board of Patent Appeals and Interferences (the "Board") in a decision, mailed September 4, 2009.

In the decision, the Board held most of the prior art relied upon the examiner was not "prior" art. Regarding the issue of priority of those claims features described in Table I (FF 6) under 35 U.S.C. § 120, the Board found the "priority date of the claims was previously considered by the original Examiner and is not a new issue." P. 21. Although the original



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Examiner never objected to the specification under 35 U.S.C. 132, which governs the introduction of new matter into the disclosure, the Board held that this "appears to be a typographical error." *Id.* As for those video download limitations not listed in Table I, the Board noted the examiner's written description analysis that the "original disclosed audio transmission features fail to imply or require any video transmission features." P. 22. To this point, the Board found "more compelling" the Appellant's enablement analysis. *Id.*

One prior art combination relied upon by the examiner, specifically Bush in view of Freeny I, was "prior" art regardless of any 35 U.S.C. § 120 priority issue. The Board however held the Examiner failed to establish a *prima facie* case of obviousness. Specifically, the Board found the suggestion/motivation relied upon by the examiner to add a hard disk (to increase the security and reliability of stored data because hard disks retain data when the power to the unit is removed) was an advantage specific to Cohen (which the Board held not to be prior art) rather than a notoriously well-known advantage of hard disk drives generally. P. 26.

Any comments considered necessary by the Patent Owner regarding the above statement must be submitted promptly to avoid processing delays. Such submission by the Patent Owner should be labeled: "Comments on Statement of Reasons for Patentability and/or Confirmation" and will be placed in the reexamination file.

***Conclusion***

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extension of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

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 the Hair patent throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

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

By EFS: Registered users may submit via the electronic filing system EFS-Web, at <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>.

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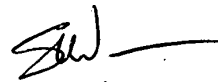
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Any inquiry concerning this communication should be directed to Roland Foster at telephone number 571-272-7538.

Signed:

Conferees:

  
ESK

/Roland G. Foster/  
Roland G. Foster  
Central Reexamination Unit, Primary Examiner  
Electrical Art Unit 3992  
(571) 272-7538



US005191573C1

(12) **EX PARTE REEXAMINATION CERTIFICATE** (7888th)  
**United States Patent**  
**Hair**

(10) **Number:** **US 5,191,573 C1**  
(45) **Certificate Issued:** **Nov. 30, 2010**

(54) **METHOD FOR TRANSMITTING A DESIRED DIGITAL VIDEO OR AUDIO SIGNAL**

(75) **Inventor:** **Arthur R. Hair**, Pittsburgh, PA (US)

(73) **Assignee:** **DMT Licensing, LLC**, Princeton, NJ (US)

**Reexamination Request:**  
No. 90/007,402, Jan. 31, 2005

**Reexamination Certificate for:**  
Patent No.: **5,191,573**  
Issued: **Mar. 2, 1993**  
Appl. No.: **07/586,391**  
Filed: **Sep. 18, 1990**

Certificate of Correction issued Dec. 21, 1993.

**Related U.S. Application Data**

(63) Continuation of application No. 07/206,497, filed on Jun. 13, 1988, now abandoned.

- (51) **Int. Cl.**
- G11B 27/34** (2006.01)
  - G11B 27/031** (2006.01)
  - G11B 27/034** (2006.01)
  - G11B 27/00** (2006.01)
  - G11B 27/10** (2006.01)
  - G11B 20/00** (2006.01)
  - G07F 17/00** (2006.01)
  - G07F 17/16** (2006.01)
  - H04N 7/173** (2006.01)

(52) **U.S. Cl.** ..... **369/84; 235/380; 235/381; 348/E7.071; 369/15; 369/84; 369/85**

(58) **Field of Classification Search** ..... None  
See application file for complete search history.

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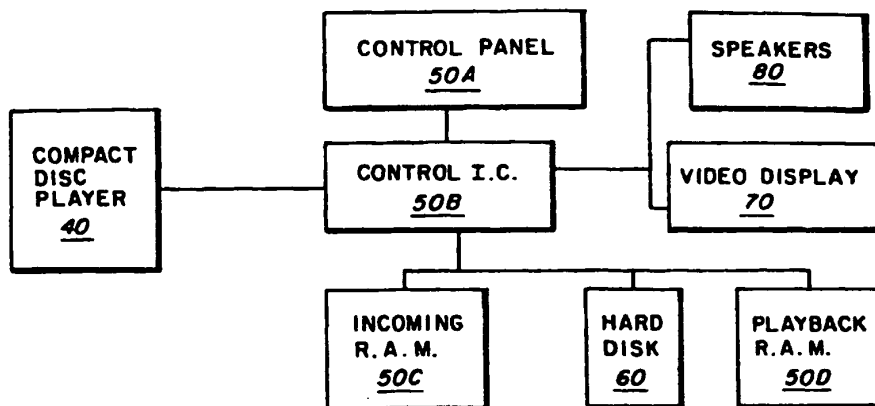
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(Continued)

*Primary Examiner*—Roland G Foster

(57) **ABSTRACT**

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 step 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.



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**1**  
**EX PARTE**  
**REEXAMINATION CERTIFICATE**  
**ISSUED UNDER 35 U.S.C. 307**

NO AMENDMENTS HAVE BEEN MADE TO  
THE PATENT

**2**  
AS A RESULT OF REEXAMINATION, IT HAS BEEN  
DETERMINED THAT:

5 The patentability of claims 1-6 is confirmed.

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