IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application/Control No.: 90/014,223

Filing Date: October 24, 2018

Patent: 8,566,868 B1

Attorney Docket No.: 122905.281304

Examiner: Jalatee Worjloh

Art Unit: 3992

Name of Patentee: John Christopher Harvey and James William Cuddihy

Title of Invention: SIGNAL PROCESSING APPARATUS AND METHODS

December 7, 2018

Mail Stop *Ex parte* REEXAM
ATTN: Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PATENT OWNER'S STATEMENT

Dear Sir:

This paper is a Patent Owner's Statement filed under 37 C.F.R § 1.530 in response to an "Order Granting Request For *Ex Parte* Reexamination" ("Order") mailed November 15, 2018.

REMARKS

Patent Owner thanks the Examiner for their careful review of the Request for *Ex Parte* Reexamination.

In addition to the related proceedings identified in the Information Disclosure Statement filed October 24, 2018, the Patent Owner would like to bring to the Examiner's attention the following co-pending filings, which are all based on the same patent specification(s):

ex parte reexamination request for U.S. Patent 8,713,624, control number 90/014,188;
ex parte reexamination request for U.S. Patent 8,587,720, control number 90/014,189;
ex parte reexamination request for U.S. Patent 8,558,950, control number 90/014,191;
ex parte reexamination request for U.S. Patent 7,734,251, control number 90/014,196;
ex parte reexamination request for U.S. Patent 7,940,931, control number 90/014,220;
Reissue Application re: U.S. Patent 7,801,304, US Patent Application, Serial No. 15/978,302;
Reissue Application re: U.S. Patent 8,752,088, US Patent Application, Serial No. 16/053,853
Reissue Application re: U.S. Patent 7,805,749, US Patent Application, Serial No. 16/183,795;
Reissue Application re: U.S. Patent 7,827,587, US Patent Application, Serial No. 16/194,429.

Patent Owner would like to remind the Examiner of the recently completed reexamination of the instant patent:

ex parte reexamination request for U.S. Patent 8,566,868, control number 90/014,195;

Consideration is requested of amendments to claim 38, and newly added claims 48-72, as presented in this Patent Owner's Statement ("Statement"). Claims 38, and 48-72 are pending. Claims 38 is independent. Claims 48-58 depend on independent claim 38. Claims 59-65 depend on independent claim 17, where claim 17 is not under reexamination. Claims 66-72 depend on independent claim 22, where claim 22 is not under reexamination. All pending claims are marked in accordance with 37 C.F.R. § 1.530(d) (2).

The amended and new claims do not broaden the claim scope of U.S. Patent 8,566,868 B1. As shown below, all new and amended claims are supported by both the instant continuation-in-part patent and the parent patent, U.S. Patent 4,694,490, and claim a priority of November 3, 1981. The Patent Owner notes that all the claims in U.S. Patent No. 8,566,868 B1 were determined by the Examiner who allowed the patent to be supported by U.S. Patent No. 4,694,490 in the Notice of Allowability mailed July 10, 2013.

Patent Owner believes the claims as amended or newly presented are patentable, and respectfully requests the Examiner's review and confirmation of amended claim 38, and added claims 48-72, at their earliest possible convenience.

Support for Claim Changes

Support for amended claim 38, and newly added claims 48-72, can be found at least in Figure 6D and in column 20:11-68 of U.S. Patent 4,694,490, in the section entitled "Co-ordinating Print and Video." Furthermore, U.S. Patent 4,694,490 discloses advertisements may be included in digital data received at a printer (15:65-68); therefore, the printed recipe in the "Co-ordinating Print and Video" example may include advertising. U.S. Patent 4,694,490 discloses that transmitter stations and receiver stations are found "throughout the United States" and are geographically remote. (*See* 1:6-13, 1:42-53.) Figure 1 and columns 6:22-9:25 discloses a signal processor and its operation including the revising of previously installed operating instructions by a remote source using a communication channel carrying only digital information during reprogramming. (*See* Fig. 1, 5:16-22, 9:20-25, 10:4-13.) The receiver station has a plurality of decryption techniques as described at least in columns 4:34-36, 4:65-67, and 8:20-40, and a plurality of methods to select a decryption technique as provided at least in Figures 4A to 4E and in columns 12:68 to 15:25, in the section entitled "Methods for Governing the Reception of Programing." These sections disclose that all manner of information can be decrypted at a receiver station, including at least a portion of the computer program received in the "The French Chef" cooking show. (*See* 20:11-68.) Furthermore, in the "alternate method" of transmitting "The French Chef" recipe, signal processor 200 is tasked, by itself, with both decryption and transfer of the decrypted recipe to the printer, based solely on the encrypted information. Accordingly, the computer instructions that determine how to form the decryption code to decrypt the recipe, and the pathway so that the decrypted recipe is sent to the printer, are all included in the encrypted recipe transmission. (*See* 20:60-68.)

U.S. Patent 4,694,490 discloses processing microwave signals at least in column 7:22-30. Reception of a multi-channel wireless signal is shown at least in Fig. 1, which is part of Fig. 6D from "The French Chef" example. Figures 6F and 6G show a block diagram of a signal processor apparatus and methods as they might be used at a consumer receiver site. (*See* 6:13-15.)

A more detailed description of the cooking show example can be found at least in Figures 7 and 7F and in columns 240:45 to 245:40 of U.S. Patent 8,566,868 B1, in the section entitled

"Automating U. R. Stations ... Examples #9 and #10 Continued Coordinating Computers, Television, and Print." Note the recipe calls for a particular brand of curry paste, hence an advertisement. Furthermore, in U.S. Patent 8,566,868 B1, column 245:16-19 states, "(Whichever transmission method is employed the information of said second message can be encrypted and caused to be decrypted in **any** of the methods described above-for example, in the method of the first message of example #4.)" (Emphasis added.) The second message can be encrypted, and the second message includes computer instructions. U.S. Patent 8,566,868 B1 discloses that transmitter stations and receiver stations are geographically remote. (*See* 11:37-45.) Figure 2 and columns 9:5-10 and 15:18 to 18:31 disclose a signal processor and its operation including the revising of previously installed operating instructions. Plural decryption techniques are described at least in column 2:45-48, 6:19-24, 143:63-144:4, 148:16-21, and 149:5-37 (where Example #7 describes how algorithms A, B, and C are used to decrypt digital video and digital audio) of U.S. Patent 8,566,868 B1. U.S. Patent 8,566,868 B1 discloses processing microwave signals at least in column 11:43-45. Reception of a multi-channel wireless signal is shown at least in Fig. 2, which is part of Fig. 7F from the "Coordinating Computers, Television, and Print" example.

"Received" or "receiving" does not necessarily require direct reception from a remote source at a receiver station; therefore, addition of the word "originated" adds clarity that direct and indirect reception are covered by the claims. As shown in Fig. 3C and discussed in parent U.S. Patent No. 4,694,490, column 12:46-57, and as shown in Fig. 6 and discussed in continuation-in-part U.S. Patent No. 8,566,868 B1, column 173:49-58, a field distribution system 93 may buffer and amplify transmissions using amplifiers 94 and 95. The code may be originated from a remote location, but the last transmission along the communication path may be relatively close to the receiver station; however, the code would be a duplicate at each stage of transmission.

For the amended and newly added claims, Lockwood and Sedman fail to show or suggest at least any digital decryption. U.S. Patent 4,337,483 ("Guillou") describes digital decryption, but provides only one decryption technique. Guillou may change the electronically transmitted "key K" and the physically delivered key "C*i*"; however, the decryption technique that uses these keys never changes. In fact, Guillou's decryption technique is implemented by fixed function

hardware. Guillou fails to show or suggest plural decryption techniques, a computer program, revision of operating instructions, and an instruction based processor.

Prior art concerned with decryption has been reviewed including the following:

Data Encryption Standard, FIPS PUB 46 (1977)

Data Encryption Standard, FIPS Pub 46-1 (1977)

DES Modes of Operation, FIPS Pub 81 (1980)

Barnes *et al.*, U.S. Patent No. 4,172,213. ("Barnes")

Rosenblum, U.S. Patent No. 4,182,933. ("Rosenblum")

Guillou, U.S. Patent No. 4,337,483. ("Guillou")

Guillou, U.S. Patent No. 4,352,011. ("Guillou '011")

Hanas *et al.*, "An Addressable Satellite Encryption System For Preventing Signal Piracy." ("Hanas")

The above prior art discusses encryption and decryption, but is completely silent as to a plurality of decryption techniques at a receiver station. *Arguendo*, even if a plurality of decryption techniques might be considered a natural consequence of having a first decryption technique, which it is not, none of these prior art references show or suggest how to select which decryption technique to use as claimed because they are completely silent as to having a plurality of decryption techniques.

Prior art references concerning the transmission of applications, data, and software in a computer network have been reviewed including the following:

Lockwood *et al.*, U.S. Patent No. 4,359,631. ("Lockwood")

Hedger *et al.*, "Telesoftware - Value Added Teletext." ("Hedger in IEEE")

Hedger, "Telesoftware – Home computing via teletext." ("Hedger in Wireless World")

Metcalfe *et al.*, "Ethernet: Distributed Packet Switching for Local Computer Networks." ("Metcalfe")

Mapp, "Telesoftware for Beginners." ("Mapp")

Viewdata and Videotext 1980-81: A Worldwide Report, Transcript of Viewdata '80, First World Conference on Viewdata, Videotex, and Teletext, London, March 26-28, 1980. ("Viewdata")

Woolfe, *VIDEOTEX: the new television/telephone information services.* ("Woolfe")

Woolfe describes the transmission of "Graphical primitives" on page 167, which Viewdata states on page 619 might be used to "draw a circle about an X-Y coordinate dot position by specifyinq center location and radius of the circle with one command, for example." Hedger and Hedger in Wireless World show a unidirectional (e.g., teletext) system where software such as games, education, and a mortgage calculator may be downloaded to a receiver station. As a one-way system, telesoftware is unable to return any communications. On page 64 in Hedger in Wireless World, the author offers that a "wired system" may benefit from a return pathway, but acknowledges a cost disadvantage and views a two-way type of system as future research. Mapp goes a little further than Hedger by discussing active research into a "dialect of BASIC" (Mapp, pg. 27) to support a two-way, request-response system that might support, for example, stock quotes.

All of these networked computer references that allow transmission of software are completely silent as to any need for encryption, except Viewdata. Viewdata states a PIN or data may be encrypted on pages 193-194, but reasons on page 194,

> "In the domestic market, which I assume will have only standard Prestel sets, I presume there will not be an encryption capability, so it will be a question of designing viewdata banking services which do not require a high degree of security of data communication. My views on this are probably heretical in banking circles. I see no reason why this choice should not be left to customers themselves. Most individuals, myself included, might feel that their own personal financial affairs are sufficiently uninteresting to anybody else that the use of a standard set, a secret code known only to the individual, and a secure bank database are good enough.
>
> "Those not trusting a non-encrypted system, more likely to be businesses, would have to resort either to traditional methods of receiving information from their banks, namely by post, or to invest in more sophisticated terminals which had encryption facilities. The willingness of banks to offer specialisd encrypted services for the few would depend very much on those customers' willingness to pay."

Encryption of data is seen in Viewdata as either (1) up to the user's comfort level, (2) possible if a customer is willing to pay enough, and (3) a customer could resort to traditional methods such as by postal service. (Viewdata, pp. 194, 197, 200.) Regardless, these networked computer references that allow transmission of software are completely silent as to having a plurality of decryption techniques at the receiver station as now claimed.

Furthermore, a two-way communication system based exclusively on the telephone system had no need for a tuner because 1981 modems used at a receiver station lacked frequency divided channels.

Finally, all of the above references are completely silent as to a "receiver station [] arranged for reprogramming said operating instructions by operatively communicating with a source geographically remote from said receiver station, wherein said operatively communicating carries only digital information during said reprogramming," where "said instruction based processor operates according to operating instructions that support said step of executing" as claimed. The claims require reprogramming operating instructions that support executing a computer program. A computer program and operating instructions are not the same element. Lockwood only shows adding a "program." Adding a program in Lockwood lacks revising operating instruction that support executing a received computer program. The same can be said for Hedger, Hedger in Wireless World, and Sedman. Transmission of software in the other prior art also lacks any suggestion of reprogramming operating instructions that support executing a computer program. Furthermore, **re**programming operating instructions is a more advanced process than installing operating instructions because "reprogramming" typically modifies some operating instructions while other operating instructions remain intact. Furthermore, reprogramming operating instructions has the potential to make the entire computing system inoperable if the reprogramming is not successful.

Pending independent claim 38 requires plural decryption techniques, selection of a decryption technique based on at least one digital code received via electronic transmission originated from a location remote from said receiver station, decrypting digitally encrypted data, and said order for said product or said service based on said decrypted digital data. The dependent claims add additional limitations, and do not fall with the independent claim.

Patent Owner respectfully requests return of Form PTO-SB-08A filed October 24, 2018 with the Examiner's initials indicating receipt of the listed prior art and relevant non-patent literature documents.

What is claimed is:

Claims 1-37 have not been amended for purposes of this reexamination.

38. (Amended) A method of controlling a receiver station, said receiver station capable of employing a plurality of decryption techniques, said plurality of decryption techniques already resident at said receiver station prior to said employing, wherein a particular decryption technique is identified based on at least one digital code received via electronic transmission originated from a location remote from said receiver station, each said decryption technique for converting unintelligible digital information into machine readable, machine intelligible digital information, comprising:

receiving, at said receiver station, a computer program electronically transmitted in a communications channel with mass media programming and digitally encrypted data originated from a transmitter station;

decrypting at said receiver station said digitally encrypted data to form decrypted digital data using at least one of said plurality of decryption techniques;

outputting said mass media programming;

downloading said computer program into memory of an instruction based processor at said receiver station to program operation of said instruction based processor; and

executing said computer program using said instruction based processor at said receiver station, which enables said receiver station, in operation, to communicate an order for a product or a service to a remote station that is remote from said receiver station, said order for said product or said service based on said decrypted digital data.

Claims 39-47 have not been amended for purposes of this reexamination.

48. (New) The method of claim 38, wherein said instruction based processor operates according to operating instructions that support said step of executing, wherein said receiver station is arranged for reprogramming said operating instructions by operatively communicating with a source geographically remote from said receiver station, wherein said operatively communicating carries only digital information during said reprogramming.

49. (New) The method of claim 38, wherein said receiver station comprises a tuner for selecting a channel of a wireless transmission, and wherein said step of receiving, at said receiver station, relies on said tuner.

50. (New) The method of claim 49, wherein said tuner tunes to microwave frequencies.

51. (New) The method of claim 38, wherein said mass media programming comprises audio.

52. (New) The method of claim 38, wherein said mass media programming comprises video.

53. (New) The method of claim 38, wherein said mass media programming is in encoded digital form.

54. (New) The method of claim 53, wherein said mass media programming is digitally encrypted, further comprising decrypting said digitally encrypted mass media programming at said receiver station using at least one of said plurality of decryption techniques.

55. (New) The method of claim 54, wherein said digitally encrypted data and said digitally encrypted mass media programming are decrypted using the same decryption technique.

56. (New) The method of claim 53, wherein said mass media programming comprises digitally encoded text.

57. (New) The method of claim 56, wherein said mass media programming is digitally encrypted, further comprising decrypting said digitally encrypted mass media programming at said receiver station using at least one of said plurality of decryption techniques, wherein said digitally encrypted data and said digitally encrypted mass media programming are decrypted using the same decryption technique.

58. (New) The method of claim 38, wherein said step of decrypting is based on a human user input at said receiver station.

59. (New) The method of claim 17, wherein said receiver station is capable of employing a plurality of decryption techniques, said plurality of decryption techniques already resident at said receiver station prior to said employing, wherein a particular decryption technique is indicated

based on at least one digital code received via electronic transmission originated from a location remote from said receiver station, each said decryption technique for converting unintelligible digital information into machine readable, machine intelligible digital information, wherein said data is digitally encrypted, further comprising decrypting said digitally encrypted data at said receiver station using at least one of said plurality of decryption techniques prior to said output, wherein said transmitter station is located remote from said receiver station.

60. (New) The method of claim 59, wherein said at least one digital code is digitally encrypted, further comprising decrypting said digitally encrypted said at least one digital code at said receiver station using at least one of said plurality of decryption techniques, wherein said decrypted said at least one digital code is at least in part used to decrypt said digitally encrypted data.

61. (New) The method of claim 17, wherein said processor operates according to operating instructions that support said step of executing, wherein said receiver station is arranged for reprogramming said operating instructions by operatively communicating with a source geographically remote from said receiver station, wherein said operatively communicating carries only digital information during said reprogramming.

62. (New) The method of claim 17, wherein said receiver station comprises a tuner for selecting a channel of a wireless transmission, and wherein said step of receiving, at said receiver station, relies on said tuner.

63. (New) The method of claim 62, wherein said tuner tunes to microwave frequencies.

64. (New) The method of claim 17, wherein said step of receiving includes receiving said data.

65. (New) The method of claim 64, wherein said data is received at said receiver station in a different transmission than said computer program in said step of receiving.

66. (New) The method of claim 22, wherein said receiver station is capable of employing a plurality of decryption techniques, said plurality of decryption techniques already resident at said receiver station prior to said employing, wherein a particular decryption technique is indicated based on at least one digital code received via electronic transmission originated from a location

remote from said receiver station, each said decryption technique for converting unintelligible digital information into machine readable, machine intelligible digital information, wherein said data is digitally encrypted, further comprising decrypting said digitally encrypted data at said receiver station using at least one of said plurality of decryption techniques, wherein said transmitter station is located remote from said receiver station.

67. (New) The method of claim 66, wherein said at least one digital code is digitally encrypted, further comprising decrypting said digitally encrypted said at least one digital code at said receiver station using at least one of said plurality of decryption techniques, wherein said decrypted said at least one digital code is at least in part used to decrypt said digitally encrypted data.

68. (New) The method of claim 22, wherein said processor operates according to operating instructions that support said step of executing, wherein said receiver station is arranged for reprogramming said operating instructions by operatively communicating with a source geographically remote from said receiver station, wherein said operatively communicating carrying only digital information during said reprogramming.

69. (New) The method of claim 22, wherein said step of receiving includes receiving said data.

70. (New) The method of claim 69, wherein said data is received at said receiver station in a different transmission than said computer program in said step of receiving.

71. (New) The method of claim 22, wherein said receiver station comprises a tuner for selecting a channel of a wireless transmission, and wherein said step of receiving, at said receiver station, relies on said tuner.

72. (New) The method of claim 71, wherein said tuner tunes to microwave frequencies.

Please debit Deposit Account 50-4494 for all related fees concerning this Patent Owner's Statement.

Respectfully submitted,

/Thomas J. Scott, Jr. /

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EXAMINER	
WORJLOH, JALATEE	

ART UNIT	PAPER NUMBER
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MAIL DATE	DELIVERY MODE
01/18/2019	PAPER

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

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

Office Action in Ex Parte Reexamination	Control No. 90/014,223	Patent Under Reexamination 8566868	
	Examiner JALATEE WORJLOH	Art Unit 3992	AIA Status No

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

a. ☑ Responsive to the communication(s) filed on 07 December 2018.
☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.

b. ☐ This action is made FINAL.

c. ☐ A statement under 37 CFR 1.530 has not been received from the patent owner.

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

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

1. ☑ Notice of References Cited by Examiner, PTO-892.
2. ☑ Information Disclosure Statement, PTO/SB/08.
3. ☐ Interview Summary, PTO-474.
4. ☐ _____.

Part II SUMMARY OF ACTION

1a. ☑ Claims 17-27,38 and 48-72 are subject to reexamination.
1b. ☑ Claims 1-16,28-37 and 39-47 are not subject to reexamination.
2. ☐ Claims _____ have been canceled in the present reexamination proceeding.
3. ☐ Claims _____ are patentable and/or confirmed.
4. ☑ Claims 17-27,38 and 48-72 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

Introduction

This Office action is responsive to the communication(s) filed on December 7, 2018. Claim 38 was amended and claims 48-72 added. New claims 59-65 depend on original claim 17 while new claims 66-72 depend on original claim 22. Hence, claims 17-27 will be reexamined.

Further, this is the *ex parte* reexamination of claims 17-27, 38, and 48-72 of U.S. Patent No. 8,566,868 to Harvey et al. ("Harvey") for which a substantial new question of patentability has been deemed to exist.

References Cited

- U.S. Patent No. 4,359,631 to Lockwood et al. ("Lockwood");
- U.S. Patent No. 4, 172,213 to Barnes et al. ("Barnes");
- U.S. Patent No. 4,182,933 to Rosenblum ("Rosenblum");
- U.S. Patent No. 4,337,483 to Guillou ("Guillou");
- U.S. Patent No. 4,352,011 to Guillou ("Guillou '011);
- "The use of MicroCobol for Telesoftware," Vito Sedman ("Sedman");
- Data Encryption Standard, FIPS Pub 46 (1977);
- Data Encryption Standard, FIPS Pub 46-1 (1977);
- DES Modes of Operation, FIPS Pub 81 (1980);
- "An Addressable Satellite Encryption System for Preventing Signal Piracy" to Hanas et al. "Hanas;"
- "Telesoftware-Value Added Teletext" to Hedger et al. ("Hedger in IEEE");
- "Telesoftware-Home computing vie teletext" to Hedger ("Hedger in Wireless World");

- "Ethernet: Distributed Packet Switching for Local Computer Networks" to Metcalfe et al. ("Metcalfe");
- "Telesoftware for Beginners" to Mapp ("Mapp");
- "Viewdata and Videotext 1980-81: A Worldwide Report, Transcript of Viewdata '80, First World Conference on Viewdata, Videotex, and Teletext, London, March 26-28, 1980. ("Viewdata"); and
- "VIDEOTEX: the new television/telephone information services" to Woolfe ("Woolfe").

Patent Owner Statement

Patent Owner (PO) Statement filed December 7, 2018 has been considered.

PO asserts that "Lockwood and Sedman fail to show or suggest at least any digital decryption. Guillou describes digital decryption, but provides only one decryption technique." PO also submits that Data Encryption Standard references, DES Modes of Operation, Barnes, Rosenblum, Guillou, Guillou '011 and Hanas discusses encryption and decryption, but are "completely silent as to a plurality of decryption techniques at a receiver station" or "how to select which decryption technique to used as claimed because they are completely silent as to having a plurality of decryption techniques."

Additionally, PO submits that Lockwood, Hedger in IEEE, Hedger in Wireless World, Metcalfe, Mapp, Viewdata, and Woolfe are all "completely silent as to a "receiver station [] arranged for reprogramming said operating instructions by operatively communicating with a source geographically remote from said receiver station, wherein said operatively communicating carries only digital information during said reprogramming." PO also asserts that

amongst these references only Viewdata discusses encryption, but does not suggest having a plurality of decryption techniques at the receiver station as claimed.

The Examiner agrees that none of the above prior art references expressly disclose a decrypting at a receiver station digital encrypted data to form decrypted digital data using at least one of said plurality of decryption techniques, where the receiver station has a plurality of decryption techniques already resident at said receiver station prior to said employing, wherein a particular decryption technique is identified based on at least one digital code received via electronic transmission originated from a location remote from said receiver station. Also, these references do not expressly disclose "wherein said receiver station is arranged for reprogramming said operating instructions by operatively communicating with a source geographically remote from said receiver station, wherein said operatively communicating carries only digital information during said reprogramming."

Claim Rejections - 35 USC § 112

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

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

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

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

Claims 38-61, 65-68, and 70 are rejected under 35 U.S.C. 112(a) or 35 U.S.C. 112 (pre-AIA), first paragraph, as failing to comply with the written description requirement. The

claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor or a joint inventor, or for pre-AIA the inventor(s), at the time the application was filed, had possession of the claimed invention.

Particularly, PO directed the Office, at pages 4 and 5 of the response, to several sections of U.S. Patent 4,694,490 and Harvey for support of the newly added features. However, these patent specifications do not explicitly describe a receiver that has a plurality of decryption techniques already resident at said receiver station prior to said employing as recited in the claims as required in claims 38, 48-60, 66, and 67 and "wherein said receiver station is arranged for reprogramming said operating instructions by operatively communicating with a source geographically remote from said receiver station, wherein said operatively communications carries only digital information during said reprogramming" as recited in claims 61 and 68.

As per claims 65 and 70, the specification does not describe "wherein said data is received at said receiver station in a different transmission than said computer program in said step of receiving."

Claim Rejections - 35 USC § 103

The following is a quotation of pre-AIA 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, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 17-22, 64, 65, 69, and 70 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Lockwood in view Sedman.

17. A method of providing programming at a receiver station, comprising:

Lockwood at col. 1, ll. 6-10- the invention relates first to automatic reservation and ticketing terminals; second, to programmed audiovisual displays used in connection with the sale of goods and services, and to automatic, around-the-clock service tellers; the receiver station may be the ticketing terminals.

receiving, at said receiver station, a computer program transmitted from a transmitter station under the control of the transmitter station;

Lockwood at Fig. 9-11; col. 6, l. 59- col. 7,l.1- the central processor 30 is able to store and subsequently retrieve data from the on-line mass storage module 31 on command…the operation of the central processor unit 30 which acts as a decision-making machine, is directed from the operational program stored in the read only memory 31. The application program is derived from the on-line mass storage 28.

Col. 3, ll. 17-25 – a second source of data is provided by a mass storage unit 28 which contains information of a more transitory nature such as flight schedules to various destinations, ticket process, weather information, snow conditions at various skiing resorts, hotel occupancy status and other information useful in the planning of a business trip or vacation. This information is periodically updated via a communication link 24 with a remote control center.

The computer programs of Lockwood can be received at a receiver station via transmission using a telephone connection as in Sedman. Sedman at p.400-411.

loading said computer program into memory of a processor at said receiver station to program operation of said processor; and

Col. 3, ll. 17-25 – a second source of data is provided by a mass storage unit 28 which contains information of a more transitory nature such as flight schedules to various destinations, ticket process, weather information, snow conditions at various skiing resorts, hotel occupancy status and other information useful in the planning of a business trip or vacation. This information is periodically updated via a communication link 24 with a remote control center.

Also the claim recites the functional limitation "to program operation of said processor." Functional recitation(s) have been considered but does not patentable distinguish the claim over the prior art because they fail to add any steps are thereby regarded as intend use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001).

executing with said processor at said receiver station, under the control of the transmitter station, said computer program, by processing data, to output advertising at said receiver station.

Lockwood at Fig. 10. And co. 7, l. 62-col. 8, l. 6 -"BEGIN RESERVATION," the user enters an "AIRLINE/FLIGHT #" and other information, which is sent to "REMOTE COMPUTER." The "REMOTE COMPUTER" responds by confirming the reservation, which may be an order for a product or server. "The reservation sequence begins with the display of a mask from the CRT requesting such information as the flight number, number of passengers, and other information such as smoking or non-smoking section preferences. After the mask the mask has been completed by the customer entering his selection, the central processor generates a request message which is sent via the audio communication system to the remote reservation computer. After receiving the confirmation message, the system again offers the customer to

option obtain a hard copy of the reservation information, after which the system offers the option to go directly into a ticket purchase mode, or a return to the basic menu display." The computer program is executed at a ticketing terminal and a seat reservation/ticket information is communicated to a remote site.

Also the claim recites the functional limitation "to output advertising at said receiver station." Functional recitation(s) have been considered but does not patentable distinguish the claim over the prior art because they fail to add any steps are thereby regarded as intend use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001).

As per claims 64 and 69, Lockwood discloses **the step of receiving includes receiving said data** (Figs. 9-11; col. 7, ll. 1-3 – menu text item is considered data).

As per claims 65 and 70, Lockwood discloses **wherein said data is received at said receiver station in a different transmission than said computer program in said step of receiving** (col. 3, ll. 17-25 – the menu item's text is periodically updated via a communication link with a remote control center; col. 7,l.1- the central processor 30 is able to store and subsequently retrieve data from the on-line mass storage module 31 on command…the operation of the central processor unit 30 which acts as a decision-making machine, is directed from the operational program stored in the read only memory 31. The application program is derived from the on-line mass storage 28).

The "wherein clause" has been considered; however, it merely expresses the intended results. See MPEP§ 2111.04. It is not a step that needs to be performed and does not patentable distinguish over the disclosure of the prior art.

18. The method of claim 17, wherein said receiver station comprises a television receiver station, and said transmitter station comprises a television transmitter station.

Lockwood col. 5, ll. 37-41 – the video multiplexer module 35 also is capable of presenting a standard television signal to the CRT device 10. This signal may come from a cable television system or at television receiver external to the terminal system, and is interpreted through the demodulated and decode device.

19. The method of claim 17, wherein said advertising comprises personalized advertising.

Claim 17 recites functional limitation "to output advertising at said receiver station." Functional recitation(s) have been considered but does not patentable distinguish the claim over the prior art because they fail to add any steps are thereby regarded as intend use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001).

Also, the claim recites the advertising comprises personalized advertising, which is non-functional descriptive material, which is not functionally involved in the steps recited. The receiving, loading, and executing steps would be performed the same regardless of the type of advertisment. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404

(Fed. Cir. 1983); *In re* Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made execute the computer program regardless of type of data included because such data does not functionally relate to the steps in the method claimed and because of the subjective interpretation of the data does not patentably distinguish the claimed invention.

20. The method of claim 17, wherein said advertising includes an offer to a user of said receiver station to purchase a good advertised in said advertising by providing input to said receiver station.

See claim 17 above – Lockwood teaches a user providing an input at said receiver station. Also, claim 17 recites functional limitation "to output advertising at said receiver station." Functional recitation(s) have been considered but does not patentable distinguish the claim over the prior art because they fail to add any steps are thereby regarded as intend use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001).

21. The method of claim 20, wherein said offer is personalized.

The claim recites the advertising comprises personalized advertising, which is non-functional descriptive material, which is not functionally involved in the steps recited. The receiving, loading, and executing steps would be performed the same regardless of the type of advertisment. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404

(Fed. Cir. 1983); *In re* Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made execute the computer program regardless of type of data included because such data does not functionally relate to the steps in the method claimed and because of the subjective interpretation of the data does not patentably distinguish the claimed invention.

22. A method of controlling a receiver station, comprising:

Lockwood at col. 1, ll. 6-10- the invention relates first to automatic reservation and ticketing terminals; second, to programmed audiovisual displays used in connection with the sale of goods and services, and to automatic, around-the-clock service tellers; the receiver station may be the ticketing terminals.

receiving, at said receiver station, a computer program transmitted from a transmitter station under the control of the transmitter station;

Lockwood at Fig. 9-11; col. 6, l. 59- col. 7,l.1- the central processor 30 is able to store and subsequently retrieve data from the on-line mass storage module 31 on command…the operation of the central processor unit 30 which acts as a decision-making machine, is directed from the operational program stored in the read only memory 31. The application program is derived from the on-line mass storage 28.

Col. 3, ll. 17-25 – a second source of data is provided by a mass storage unit 28 which contains information of a more transitory nature such as flight schedules to various destinations, ticket process, weather information, snow conditions at various skiing resorts, hotel occupancy status and other information useful in the planning of a business trip or vacation. This information is periodically updated via a communication link 24 with a remote control center.

loading said computer program into memory of a processor at said receiver station to program operation of said processor; and

Col. 3, ll. 17-25 – a second source of data is provided by a mass storage unit 28 which contains information of a more transitory nature such as flight schedules to various destinations, ticket process, weather information, snow conditions at various skiing resorts, hotel occupancy status and other information useful in the planning of a business trip or vacation. This information is periodically updated via a communication link 24 with a remote control center.

Also the claim recites the functional limitation "to program operation of said processor." Functional recitation(s) have been considered but does not patentable distinguish the claim over the prior art because they fail to add any steps are thereby regarded as intend use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001).

executing with said processor at said receiver station, under the control of the transmitter station, said computer program, by processing data, to communicate an order for a product or service from said receiver station to a remote station.

Lockwood at Fig. 10. And co. 7, l. 62-col. 8, l. 6 -"BEGIN RESERVATION," the user enters an "AIRLINE/FLIGHT #" and other information, which is sent to "REMOTE COMPUTER." The "REMOTE COMPUTER" responds by confirming the reservation, which may be an order for a product or server. "The reservation sequence begins with the display of a mask from the CRT requesting such information as the flight number, number of passengers, and other information such as smoking or non-smoking section preferences. After the mask the mask has been completed by the customer entering his selection, the central processor generates a

request message which is sent via the audio communication system to the remote reservation computer. After receiving the confirmation message, the system again offers the customer to option obtain a hard copy of the reservation information, after which the system offers the option to go directly into a ticket purchase mode, or a return to the basic menu display." The computer program is executed at a ticketing terminal and a seat reservation/ticket information is communicated to a remote site.

Also the claim recites the functional limitation "to communicate an order for a product or service." Functional recitation(s) have been considered but does not patentable distinguish the claim over the prior art because they fail to add any steps are thereby regarded as intend use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001).

23. The method of claim 22, wherein said order is generated at said receiver station.

Claim 22 recites the functional limitation "to communicate an order for a product or service." Functional recitation(s) have been considered but does not patentable distinguish the claim over the prior art because they fail to add any steps are thereby regarded as intend use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001).

Also, the "wherein clause" has been considered; however, it merely expresses the intended results. See MPEP§ 2111.04. It is not a step that needs to be performed and does not patentable distinguish over the disclosure of the prior art

24. The method of claim 23, wherein said order comprises a shopping list.

Also, the claim recites the order comprises a shopping list, which is non-functional descriptive material, which is not functionally involved in the steps recited. The receiving, loading, and executing steps would be performed the same regardless of the type of order. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re* Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made execute the computer program regardless of type of data included because such data does not functionally relate to the steps in the method claimed and because of the subjective interpretation of the data does not patentably distinguish the claimed invention.

25. The method of claim 23, further comprising the step of executing a second computer program to generate said order at said receiver station.

Lockwood, Fig. 10 and related text –travelog program, flight schedule program, reservation program, tickets program.

Functional limitation "to generate said order at said receiver station." Functional recitation(s) have been considered but does not patentable distinguish the claim over the prior art because they fail to add any steps are thereby regarded as intend use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001).

26. The method of claim 25, further comprising the step of receiving, at said receiver station, said second computer program transmitted from said transmitter station.

Lockwood at Fig, 8 (remote central station-remote site computer; on-line mass storage); Fig. 9-11; col. 6, l. 59- col. 7,l.1- the central processor 30 is able to store and subsequently retrieve data from the on-line mass storage module 31 on command…the operation of the central processor unit 30 which acts as a decision-making machine, is directed from the operational program stored in the read only memory 31. The application program is derived from the on-line mass storage 28.

Col. 3, ll. 17-25 – a second source of data is provided by a mass storage unit 28 which contains information of a more transitory nature such as flight schedules to various destinations, ticket process, weather information, snow conditions at various skiing resorts, hotel occupancy status and other information useful in the planning of a business trip or vacation. This information is periodically updated via a communication link 24 with a remote control center.

27. The method of claim 22, wherein said transmitter station and said remote station comprise different remote stations.

Lockwood at Fig. 8-11; col. 6, l. 59- col. 7,l.1- the central processor 30 is able to store and subsequently retrieve data from the on-line mass storage module 31 on command…the operation of the central processor unit 30 which acts as a decision-making machine, is directed from the operational program stored in the read only memory 31. The application program is derived from the on-line mass storage 28.

Col. 3, ll. 17-25 – a second source of data is provided by a mass storage unit 28 which contains information of a more transitory nature such as flight schedules to various destinations,

ticket process, weather information, snow conditions at various skiing resorts, hotel occupancy status and other information useful in the planning of a business trip or vacation. This information is periodically updated via a communication link 24 with a remote control center.

Also, the computer programs of Lockwood can be received at a receiver station via transmission using a telephone connection as in Sedman. Sedman at p.400-411.

Claims 62 and 71 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Lockwood and Sedman as applied to claims 17 and 22 respectively above, and further in view of U.S. Patent No. 4225884 to Block et al. ("Block").

Lockwood in view of Sedman discloses a receiver station. Block discloses **a tuner, wherein said step of receiving, at said receiver station relies on said tuner** (col. 3, ll. 62-64 - the scrambled program signal is received by a program signal receiver at the subscriber station; col. 4, ll. 11-14- the subscriber control unit my include one or more subscriber manipulated control which permit the subscriber to selectively tune a conventional tuner in the program signal receiver). At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify Lockwood and Sedman to include the feature of Block. Applying the known technique of Block into the system of Lockwood and Sedman would have been recognized by those of ordinary skill in the art as resulting in an improved system that would have yielded predictable results. Also, the tuner is an efficient means of receiving data.

Also the claim recites the functional limitation "for selecting a channel of a wireless transmission." Functional recitation(s) have been considered but does not patentable distinguish the claim over the prior art because they fail to add any steps are thereby regarded as intend use language. A recitation of the intended use of the claimed invention must result in additional

steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001).

Claims 63 and 72 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Lockwood, Sedman, and Block as applied to claims 62 and 71 respectively above, and further in view of U.S. Patent No. 165,166 to Lightner.

Lockwood and Sedman in view of Block do not expressly disclose the tuner tunes to microwave frequencies. Lightner discloses this feature at Fig. 12, element 160 and 165-167. Applying the known technique of Lightner into the system of Lockwood and Sedman in view of Block would have been recognized by those of ordinary skill in the art as resulting in an improved system that would have yielded predictable results.

Extension of Time

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 reexaminations proceeding. Additionally, 35 U.S.C. 305 requires that ex parte reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extensions of time in ex parte reexamination proceedings are provided for in 37 CFR 1.550(c).

Amendment in Reexamination Proceedings

Patent owner is notified that any proposed amendment to the specification and/or claims in this reexamination proceeding must comply with 37 CFR 1.530(d)-(j), must be formally presented pursuant to 37 CFR § 1.52(a) and (b), and must contain any fees required by

37 CFR § 1.20(c). See MPEP §2250(IV) for examples to assist in the preparation of proper proposed amendments in reexamination proceedings.

Service of Papers

After the filing of a request for reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party (or parities where two or more third party requester proceedings are merged) in the reexamination proceeding in the manner provided in 37 CFR 1.248. See 37 CFR 1.550.

Notification of Concurrent Proceedings

The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 8,566,868 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 proceedings throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282, and 2286.

All correspondence relating to this ex parte reexamination proceeding should be directed:

By Mail to:

Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner of Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to:

(571) 273-9900

Central Reexamination Unit

By Hand:

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at
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EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

/Jalatee Worjloh/
Primary Examiner, Art Unit 3992

Conferees:

/C.S/
Primary Examiner, Art Unit 3992

/HETUL B PATEL/
Supervisory Patent Examiner, Art Unit 3992

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Attorney Docket No.: 122905.281304

Examiner: Jalatee Worjloh

Art Unit: 3992

Name of Patentee: John Christopher Harvey and James William Cuddihy

Title of Invention: SIGNAL PROCESSING APPARATUS AND METHODS

February 22, 2019

Mail Stop *Ex parte* REEXAM
ATTN: Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO OFFICE ACTION

Dear Sir:

This paper is responsive to the Office Action in *Ex Parte* Reexamination mailed on January 18, 2019.

Amendments to the Claims start on page 2.

Remarks start on page 9.

AMENDMENTS TO THE CLAIMS

What is claimed is:

Claims 1-16 have not been amended for purposes of this reexamination.

17. (Original) A method of providing programming at a receiver station, comprising:
receiving, at said receiver station, a computer program transmitted from a transmitter station under the control of the transmitter station;
loading said computer program into memory of a processor at said receiver station to program operation of said processor; and
executing with said processor at said receiver station, under the control of the transmitter station, said computer program, by processing data, to output advertising at said receiver station.

18. (Original) The method of claim 17, wherein said receiver station comprises a television receiver station, and said transmitter station comprises a television transmitter station.

19. (Original) The method of claim 17, wherein said advertising comprises personalized advertising.

20. (Original) The method of claim 17, wherein said advertising includes an offer to a user of said receiver station to purchase a good advertised in said advertising by providing input to said receiver station.

21. (Original) The method of claim 20, wherein said offer is personalized.

22. (Original) A method of controlling a receiver station, comprising:
receiving, at said receiver station, a computer program transmitted from a transmitter station under the control of the transmitter station;
loading said computer program into memory of a processor at said receiver station to program operation of said processor; and
executing with said processor at said receiver station, under the control of the transmitter station, said computer program, by processing data, to communicate an order for a product or service from said receiver station to a remote station.

23. (Amended) The method of claim 22, [wherein] further comprising generating said order [is generated] at said receiver station.

24. (Original) The method of claim 23, wherein said order comprises a shopping list.

25. (Original) The method of claim 23, further comprising the step of executing a second computer program to generate said order at said receiver station.

26. (Original) The method of claim 25, further comprising the step of receiving, at said receiver station, said second computer program transmitted from said transmitter station.

27. (Original) The method of claim 22, wherein said transmitter station and said remote station comprise different remote stations.

Claims 28-37 have not been amended for purposes of this reexamination.

38. (Amended) A method of controlling a receiver station, said receiver station capable of employing a plurality of decryption techniques, said plurality of decryption techniques already resident at said receiver station prior to said employing, wherein a particular decryption technique is identified based on at least one digital code received via electronic transmission originated from a location remote from said receiver station, each said decryption technique for converting unintelligible digital information into machine readable, machine intelligible digital information, comprising:

receiving, at said receiver station, a computer program electronically transmitted in a communications channel with mass media programming and digitally encrypted data originated from a transmitter station;

decrypting at said receiver station said digitally encrypted data to form decrypted digital data using at least one of said plurality of decryption techniques;

outputting said mass media programming;

downloading said computer program into memory of an instruction based processor at said receiver station to program operation of said instruction based processor; and

executing said computer program using said instruction based processor at said receiver station, which enables said receiver station, in operation, to communicate an order for a product or a

service to a remote station that is remote from said receiver station, said order for said product or said service based on said decrypted digital data.

39. (Amended) The method of claim 38, [wherein] further comprising generating said order [is generated] at said receiver station.

40. (Original) The method of claim 39, wherein said order comprises a shopping list.

41. (Original) The method of claim 39, further comprising the step of executing a second computer program to generate said order at said receiver station.

42. (Original) The method of claim 41, further comprising the step of receiving, at said receiver station, said second computer program transmitted from said transmitter station.

43. (Original) The method of claim 38, wherein said transmitter station and said remote station comprise different remote stations.

44. (Original) A method of regulating a receiver station environment, comprising:
receiving, at said receiver station, a computer program transmitted in a communications channel with mass media programming from a transmitter station;
outputting said mass media programming;
downloading said computer program into memory of a processor at said receiver station to program operation of said processor; and
executing said computer program which enables said receiver station, in operation, to regulate said receiver station environment.

45. (Original) The method of claim 44, wherein said receiver station environment comprises a home or office where said receiver station is located.

46. (Original) The method of claim 44, wherein said receiver station comprises a television receiver station.

47. (Original) The method of claim 44, wherein said computer program is effective to regulate a thermostat of an air conditioner or furnace.

48. (New, Amended) The method of claim 38, wherein said instruction based processor operates according to operating instructions that support said step of executing, wherein said receiver station is arranged for reprogramming said operating instructions by operatively communicating with a source remote from said receiver station, wherein said operatively communicating carries only digital information during said reprogramming.

49. (New) The method of claim 38, wherein said receiver station comprises a tuner for selecting a channel of a wireless transmission, and wherein said step of receiving, at said receiver station, relies on said tuner.

50. (New) The method of claim 49, wherein said tuner tunes to microwave frequencies.

51. (New) The method of claim 38, wherein said mass media programming comprises audio.

52. (New) The method of claim 38, wherein said mass media programming comprises video.

53. (New) The method of claim 38, wherein said mass media programming is in encoded digital form.

54. (New) The method of claim 53, wherein said mass media programming is digitally encrypted, further comprising decrypting said digitally encrypted mass media programming at said receiver station using at least one of said plurality of decryption techniques.

55. (New) The method of claim 54, wherein said digitally encrypted data and said digitally encrypted mass media programming are decrypted using the same decryption technique.

56. (New) The method of claim 53, wherein said mass media programming comprises digitally encoded text.

57. (New) The method of claim 56, wherein said mass media programming is digitally encrypted, further comprising decrypting said digitally encrypted mass media programming at said receiver station using at least one of said plurality of decryption techniques, wherein said digitally encrypted data and said digitally encrypted mass media programming are decrypted using the same decryption technique.

58. (New) The method of claim 38, wherein said step of decrypting is based on a human user input at said receiver station.

59. (New) The method of claim 17, wherein said receiver station is capable of employing a plurality of decryption techniques, said plurality of decryption techniques already resident at said receiver station prior to said employing, wherein a particular decryption technique is indicated based on at least one digital code received via electronic transmission originated from a location remote from said receiver station, each said decryption technique for converting unintelligible digital information into machine readable, machine intelligible digital information, wherein said data is digitally encrypted, further comprising decrypting said digitally encrypted data at said receiver station using at least one of said plurality of decryption techniques prior to said output, wherein said transmitter station is located remote from said receiver station.

60. (New) The method of claim 59, wherein said at least one digital code is digitally encrypted, further comprising decrypting said digitally encrypted said at least one digital code at said receiver station using at least one of said plurality of decryption techniques, wherein said decrypted said at least one digital code is at least in part used to decrypt said digitally encrypted data.

61. (New, Amended) The method of claim 17, wherein said processor operates according to operating instructions that support said step of executing, wherein said receiver station is arranged for reprogramming said operating instructions by operatively communicating with a source remote from said receiver station, wherein said operatively communicating carries only digital information during said reprogramming.

62. (New) The method of claim 17, wherein said receiver station comprises a tuner for selecting a channel of a wireless transmission, and wherein said step of receiving, at said receiver station, relies on said tuner.

63. (New) The method of claim 62, wherein said tuner tunes to microwave frequencies.

64. (New) The method of claim 17, wherein said step of receiving includes receiving said data.

65. (New, Amended) The method of claim 17, further comprising receiving said data, at said receiver station, in a different transmission than said computer program in said step of receiving.

66. (New) The method of claim 22, wherein said receiver station is capable of employing a plurality of decryption techniques, said plurality of decryption techniques already resident at said receiver station prior to said employing, wherein a particular decryption technique is indicated based on at least one digital code received via electronic transmission originated from a location remote from said receiver station, each said decryption technique for converting unintelligible digital information into machine readable, machine intelligible digital information, wherein said data is digitally encrypted, further comprising decrypting said digitally encrypted data at said receiver station using at least one of said plurality of decryption techniques, wherein said transmitter station is located remote from said receiver station.

67. (New) The method of claim 66, wherein said at least one digital code is digitally encrypted, further comprising decrypting said digitally encrypted said at least one digital code at said receiver station using at least one of said plurality of decryption techniques, wherein said decrypted said at least one digital code is at least in part used to decrypt said digitally encrypted data.

68. (New, Amended) The method of claim 22, wherein said processor operates according to operating instructions that support said step of executing, wherein said receiver station is arranged for reprogramming said operating instructions by operatively communicating with a source remote from said receiver station, wherein said operatively communicating carrying only digital information during said reprogramming.

69. (New) The method of claim 22, wherein said step of receiving includes receiving said data.

70. (New, Amended) The method of claim 22, further comprising receiving said data, at said receiver station, in a different transmission than said computer program in said step of receiving.

71. (New) The method of claim 22, wherein said receiver station comprises a tuner for selecting a channel of a wireless transmission, and wherein said step of receiving, at said receiver station, relies on said tuner.

72. (New) The method of claim 71, wherein said tuner tunes to microwave frequencies.

REMARKS

A. Status

Patent Owner thanks the Examiner for his careful review of the Request for *Ex Parte* Reexamination and Patent Owner's Statement.

Patent Owner would like to bring to the Examiner's attention the following co-pending filings, which are all based on the same patent specification(s):

ex parte reexamination request for U.S. Patent 8,713,624, control number 90/014,188;
ex parte reexamination request for U.S. Patent 8,587,720, control number 90/014,189;
ex parte reexamination request for U.S. Patent 8,558,950, control number 90/014,191;
ex parte reexamination request for U.S. Patent 7,734,251, control number 90/014,196;
ex parte reexamination request for U.S. Patent 7,940,931, control number 90/014,220;
Reissue Application re: U.S. Patent 7,801,304, US Patent Application, Serial No. 15/978,302;
Reissue Application re: U.S. Patent 8,752,088, US Patent Application, Serial No. 16/053,853
Reissue Application re: U.S. Patent 7,805,749, US Patent Application, Serial No. 16/183,795;
Reissue Application re: U.S. Patent 7,827,587, US Patent Application, Serial No. 16/194,429.

Patent Owner would like to bring to the Examiner's attention the recently completed reexamination, which is based on the same patent specification(s):

ex parte reexamination request for U.S. Patent 8,566,868, control number 90/014,195.

With the Office Action mailed January 18, 2019, claims 17-27, 38, and 48-72 were indicated as subject to reexamination on the face of the Office Action. However, claims 17-27, 38-43, and 48-72 were rejected in the body of the Office Action, wherein claims 17, 22, and 38 are independent. With this Response, claims 23, 39, 48, 61, 65, 68, and 70 are amended to make the limitations clearer, and marked according to 37 C.F.R. § 1.530 (d) (2) and M.P.E.P. § 2250. The amendments neither enlarge the claim scope of U.S. Patent 8,566,868 B1 ("'868 Patent"), nor add new material to the originally issued patent.

Consideration is requested of amendments to the claims, and the remarks below, as presented in this instant Response. The Patent Owner believes the claims as amended here are

patentable, and respectfully requests the Examiner's review and confirmation of claims 17-27, 38-43, and 48-72 at his earliest possible convenience.

B. Prior Art used in the Office Action

- U.S. Patent No. 4,359,631 to Lockwood et al. ("Lockwood");
- U.S. Patent No. 4, 172,213 to Barnes et al. ("Barnes");
- U.S. Patent No. 4, 182,933 to Rosenblum ("Rosenblum");
- U.S. Patent No. 4,337,483 to Guillou ("Guillou");
- U.S. Patent No. 4,352,011 to Guillou ("Guillou '011");
- "The use of MicroCobol for Telesoftware," to Sedman ("Sedman");
- Data Encryption Standard, FIPS Pub 46 (1977);
- Data Encryption Standard, FIPS Pub 46-1 (1977);
- DES Modes of Operation, FIPS Pub 81 (1980);
- "An Addressable Satellite Encryption System for Preventing Signal Piracy" to Hanas et al. ("Hanas");
- "Telesoftware-Value Added Teletext" to Hedger et al. ("Hedger in IEEE");
- "Telesoftware-Home computing vie teletext" to Hedger ("Hedger in Wireless World");
- "Ethernet: Distributed Packet Switching for Local Computer Networks" to Metcalfe et al. ("Metcalfe");
- "Telesoftware for Beginners" to Mapp ("Mapp");
- "Viewdata and Videotext 1980-81: A Worldwide Report, Transcript of Viewdata '80, First World Conference on Viewdata, Videotex, and Teletext," London, March 26-28, 1980. ("Viewdata");
- "VIDEOTEX: the new television/telephone information services" to Woolfe ("Woolfe");
- U.S. Patent No. 4,225,884 to Block ("Block"); and
- U.S. Patent No. 3,947,882 to Lightner ("Lightner").

C. Rejection of Claims 38-43, 48-61, 65-68, and 70 under pre-AIA 35 U.S.C. § 112, first paragraph

1. Introductory Comment

The list of claims rejected in the Office Action under pre-AIA 35 U.S.C. § 112 included claims 44-47; however, no statement by the Examiner was provided as to what limitation(s) in these claims fail to comply with pre-AIA 35 U.S.C. § 112. Accordingly, the Patent Owner will only address claims 38-43, 48-61, 65-68, and 70.

As best as the Patent Owner can understand, the Examiner has rejected claims 38-43, 48-61, 65-68, and 70 under pre-AIA 35 U.S.C. § 112, first paragraph, for lack of proper written description in either the 1981 or 1987 specifications. As there are certain aspects of the Examiner's Action which the Patent Owner finds confusing, it wishes to clarify quite explicitly how it approaches its response to these rejections. The pertinent provisions of Section 112 (emphasis added) are found in paragraphs 1 and 2 and state the following:

> *The specification shall contain a **written description** of the **invention**, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to **enable** any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the **best mode** contemplated by the inventor of carrying out his invention.*
>
> *The **specification** shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his **invention.***

It is axiomatic that the specification to which the claims are appended [in this case, the 1987 specification], not only must describe the invention as required by Section 112, first paragraph, but also is used to define the limitations of the claims for all purposes. *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575 (Fed.Cir.1985). Support in an earlier specification is only needed if priority is an issue. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555 (Fed.Cir.1991). The party seeking to establish a claim of priority to an earlier application must demonstrate that a person skilled in the art would understand that the inventor was "in possession" of the invention because it was disclosed in the earlier application pursuant to the requirements of Section 112 as the claims are construed based on the disclosure of the later application. *Purdue Pharma LP v. Faulding Inc.*, 230 F.3d 1320 (Fed.Cir.2000); see also, *Ralston*, *supra* at 1575. In the Patent Owner's Statement, the Patent Owner sought to demonstrate "written description" support in both the 1981 and 1987 specifications to establish priority to the 1981 filing date. Although the Examiner's Action, mailed January 18, 2019, does not appear to raise a priority issue, it rejects the subject claims on the basis that neither specification provides the proper support. While the Patent Owner is somewhat confused by this rejection, in order to advance the prosecution of this reexamination proceeding, it will demonstrate below "written description" support in both the 1987 and 1981 specifications, thereby establishing both the required "written description" under Section 112 and also priority under 35 U.S.C. § 120.

2. Support for a Receiver Station having a "plurality of decryption techniques already resident at said receiver station prior to said employing"

The claim limitation at issue is a receiver station having a "plurality of decryption techniques already resident at said receiver station prior to said employing," which is required in claims 38-43, 48-60, 66, and 67. The claims also require the "receiver station capable of employing a plurality of decryption techniques." Logically (per the claim) and technologically, a decryption technique cannot be employed at a receiver station unless it is resident at the receiver station. Something cannot be used unless it exists at the place where it is used. Accordingly, the claim limitation, "plurality of decryption techniques … at said receiver station," is all that is necessary to be supported. By providing specification support that a plurality of decryption techniques are available at a receiver station, the full limitation in question is also supported by the specification. What this claim limitation excludes is having only one decryption technique at the receiver station available to be employed, regardless of whether the one decryption technique can be changed or not.

To summarize the specifications' teachings, the receiver stations are informed of decryption techniques, and if necessary, the receiver stations may telephone a remote site to get additional information for proper decryption. The decryption techniques may be pre-determined, or signal(s) / code(s) contained in the programming inform the decryptors of which technique to use. Code(s) are also transmitted to serve as a key upon which incoming programming is decrypted.

Specification support from the '490 Patent and '868 Patent are addressed below individually.

a. U.S. Patent 4,694,490 Support

The claimed "plurality of decryption techniques … at said receiver station" is supported throughout the '490 Patent, which specifically states in the "Summary of Invention" section, "The method provides **techniques** whereby unauthorized use of programing and/or of signals may be prevented." (See '490 Patent, 4:2-4, emphasis added.) Furthermore, the '490 Patent specifically states, "It can tell decrypter, 10, when and how to change decryption patterns, fashions, and **techniques**" (see '490 Patent, 8:39-40, emphasis added), and "decryptors that may convert the received information, in part or in whole, to other digital information according to preset methods or patterns" (see '490 Patent, 4:65-67). The '490 Patent uses plural nouns (e.g., patterns, fashions, techniques, methods) when discussing decryption, meaning a "plurality" is taught. Even though there is no *in haec verba* requirement for the words in the claims, in this case, the word "techniques" is used *verbatim* with regards to decryption. Accordingly, the claimed "plurality of decryption techniques … at said receiver station" is supported.

Furthermore, the '490 Patent teaches that the decryption techniques may be predetermined at the receiver station prior to decrypting the encrypted transmission. "Decrypter, 10, uses conventional decrypter techniques, well known in the art, in a **pre-determined fashion** to decrypt such signals as required." (See '490 Patent, 7:43-46, emphasis added.) "The controller, 20, instructs decrypter, 10, what to decrypt and in what fashion." (See '490 Patent, 9:63-65.) "In any of the cases illustrated in FIGS. 4A through 4E, signal processors, 100, 103, 106, 109, and 112, could also operate in a predetermined fashion and **telephone a remote site to get an additional signal or signals necessary for the proper decryption** and/or transfer of incoming programing transmissions." (See '490 Patent, 15:20-25, emphasis added.)

The decryption techniques may be predetermined in advance of the receipt of encrypted programming, or a determination may be made as to which of the decryption technique(s) to use by incoming signals with the encrypted programming. In either case, the "plurality of decryption techniques [are] already resident at said receiver station prior to said employing."

> "FIG. 4A shows a signal processor, 100, and a programing decrypter and/or interrupt means, 101, each of which receives the same transmission of programing. The devices, 100 and 101, may receive one channel of programing or multiple channels. The signals that enable the decrypter/interrupter, 101, to decrypt and/or transfer programing uninterrupted may be embedded in the programing or may be elsewhere. Signal processor, 100, identifies, evaluates, possibly decrypts, and passes a signal or signals to decrypter/interrupter, 101, either at the time of receipt of such programing or at a delayed time or a combination. The signal or signals instruct decrypter/interrupter, 101, to decrypt the transmission or not to decrypt the transmission or to interrupt the transmission or not to interrupt the transmission. **The signal or signals may also inform decrypter/interrupter, 101, how to decrypt or interrupt the programing if decrypter/interrupter, 101, is capable of multiple means.** The signal or signals may transmit a code or codes necessary for the decryption of the transmission." (See '490 Patent, 13:13-32, emphasis added.)

Several examples within the '490 Patent specification provide details about how a "plurality of decryption techniques … at said receiver station" are used.

First, Fig. 4D shows serial decrypting using two different decryptors 110 and 111. In the "Brief Description of the Drawings," the '490 Patent specification states, "FIG. 4D is a block

diagram of a signal processor and a multiple decrypter/interrupters in series, with signals both before and after programing decryption." (See '490 Patent, 5:52-54.) The '490 Patent specification corresponding to Fig. 4D states, "FIG. 4D shows that a multi-stage decryption/interruption process may be used in which transmissions must be processed by one or more additional decryptor/interruptors, 111, that follow decryptor/interruptor, 110." (See '490 Patent, 14:28-32.) Fig. 4D and its corresponding '490 Patent specification support teaches encrypted programming is decrypted by a first decryptor, then further decrypted by a second decryptor to provide fully decrypted programming. Accordingly, at least Fig. 4D and its corresponding '490 Patent specification teaching supports a "plurality of decryption techniques … at said receiver station."

Second, the serial decryptor topology of Fig. 4D is also used in the "Using Signaling and Decryption Techniques to Control Distribution of Copyrighted Materials" example starting at col. 21, ln. 1, and corresponding to Fig. 6E. In this example, decryptor 224 serves to initially decrypt the *How to Grow Grass* digital book content based on a first encrypted code received from a remote site. The '490 Patent specification states,

> "In the encrypted title, signal processor, 200, identifies one or more signal words. If signal processor, 200, has the customer's name and address and the bookstore is a retail outlet in good standing that **has received from a remote site program information on the predetermined fashions** in affect, signal processor, 200, decrypts the signal word or words and transfers them to decryptor, 224, to serve as the code for the first stage of decryption. Decryptor, 224, then decrypts a part of the encrypted transmission and passes the partly decrypted

transmission to signal stripper, 229, and signal generator, 230." (See '490 Patent, 21:35-46, emphasis added.)

As emphasized above, the '490 Patent specification uses the plural word "fashions" to teach a first "fashion" for decryption of the signal word by decryptor 10 in signal processor 200 to produce a code for decryptor 224, and a second fashion for decryptor 224. As will be discussed below with respect to the "Co-ordinating Print and Video" example, signal processor 200 contains decryptor 10 (with more restricted capabilities) and decryptor 224 is clearly a decryptor. Accordingly, this example already provides support for a "plurality of decryption techniques … at said receiver station." The partially decrypted *How to Grow Grass* digital book content is then transferred to a second decryptor to complete the full decryption.

> "In the decrypted portion of the partially decrypted transmission, signal processor, 200, identifies a second signal word or set of words which it decrypts in a predetermined **fashion** and passes to decryptor, 231, to serve as the code basis for the second stage of decryption." (See '490 Patent, 21:46-51, emphasis.)

This example now adds a third "fashion" for decryption of digital information. Decryptors 224 and 231 would have different techniques because (1) the example teaches that each decryptor has its own "fashion" for decryption, and (2) improving prevention of piracy is gained by having different decryption techniques that must be "broken" to pirate the *How to Grow Grass* digital book content. Accordingly, at least Fig. 6E and its corresponding '490 Patent specification teaching supports a "plurality of decryption techniques … at said receiver station."

Third, the '490 Patent specification teaches other dual decryptor topologies.

"FIG. 4E is a block diagram of a signal processor multiple decryptor/interruptors and with signals from one channel needed for decryption of a second channel." (See '490 Patent, 5:55-57.)

The claimed "plurality of decryption techniques … at said receiver station" is supported at least by Fig. 4E and the '490 Patent specification teaching that states,

"FIG. 4E illustrates how signals transmitted on one channel can govern the decryption and/or transfer of another channel. Signal processor, 112, receives, evaluates, and processes a multiple channel transmission from cable transmission facility, 113. Cable converter box, 114, of which many types are now available, **with means for informing signal processor, 112, which channel of programing it is transferring, receives the same multi-channel transmission and transfers one channel to decryptor/interruptor, 115. The signal or signals necessary for the decryption of the channel that box, 114, passes to decryptor/interruptor, 115, in this case, is not located in the channel transmission.** They may be preprogramed into the signal processor (for example, in programable randon access memory controller, 20, in FIG. 1) or they may be transmitted in a channel other than the channel being transferred from box, 114. If signal processor, 112, has been preprogramed with the signal or signals or if it has been informed of the predetermined fashion for identifying and processing the the needed signal or signals in the incoming transmission from facility, 113, for example, where to look for the signals and when and how, signal processor, 112, can transfer the signal to decryptor/interruptor, 115. The tuner, 119, informs signal processor, 112, what channel box, 114, is switched to whenever box, 114,

is switched or turned on. Signal processor, 112, receives this information probably at buffer/comparator, 8 (referring to FIG. 1), which signal processor, 112, processes the signal from tuner, 119, in a predetermined fashion that causes the signal or signals that relate to the necessary proper operation of decryptor/interruptor, 115. If signal processor, 112, can identify, processes, and transfer the needed signal or signals, decryptor/interruptor, 115, can decrypt and/or transfer the incoming transmission from box, 114, satisfactorily. If signal processor, 112, cannot transfer the needed signal or signals, decryptor/interruptor, 115, cannot decrypt and/or transfer the programing transmission satisfactorily.

"FIG. 4E also illustrates how it may be necessary to decrypt a programing transmission on one channel in order to identify and process correctly the programing transmitted on another. In FIG. 4E, the signal or signals needed to operate decryptor/interruptor, 115, correctly may be on a separate channel of programing that is, itself, encrypted in transmission. **Signal processor, 112, can transfer the correct signal or signals only if cable converter box, 117, is tuned to the proper channel and decryptor/interruptor, 118, can transfer a correctly decrypted transmission to signal processor, 112, for processing.**"

(See '490 Patent, 14:37-15:19, emphasis added.)

In this example, particular programming channels are decrypted by particular decryptors, each programmed with a particular decryption technique. Of interest, this example teaches that the signal processor 112 is programmed to control decryptors 115 and 118 dependent on what channel is being output by the cable converter boxes. This means the decryption of each channel is dependent on how that channel was encrypted at the headend, and each channel may be

encrypted/decrypted independently of the encrypted television programming on the other channel. Accordingly, at least Fig. 4E and its corresponding '490 Patent specification teaching supports a "plurality of decryption techniques … at said receiver station."

Fourth, in another example, the "Co-ordinating Print and Video" example staring at col. 20, ln. 11, in the '490 Patent, the receiver station may tune to a new channel to receive the encrypted digital recipe and decrypt using decrypter 224, or receive the encrypted digital recipe embedded in the "French Chef" cooking show and decrypt using decryptor 10 (Fig. 1) in the signal processor 200. The decoder 203 processes the CATV or broadcast signal in both cases to identify the programming content. In Fig. 1, decrypter 10 is embedded in signal processor 200, and supplied with digital information from buffer/comparator 8, which is supplied by digital information embedded in a CATV or broadcast TV signal. Decrypter 224, as shown in Fig. 6D, may receive information directly from a cable converter box. Decrypter 224 is capable of handling greater bandwidth, such as decrypting encrypted video (see '490 Patent, 14:2-3). Decryptors 10 and 224 have different decryption techniques based on the differences in their capabilities, and the teachings with respect to Fig. 6E discussed above. Accordingly, at least Fig. 6D and its corresponding '490 Patent specification teaching supports a "plurality of decryption techniques … at said receiver station."

Fifth, Figs. 6F-6G, as assembled in Fig. 6J on sheet 3 of 14, show a well-equipped receiver station that supports all examples in the '490 specification. In Fig. 6F, at least two decrypters 225 and 231 are shown. (Based on the '490 Patent specification examples, decrypter 225 should most likely be labelled 224. Decrypter 224 is used in Figs. 6D and 6E, and element

225 is the "local input" in other examples.) Furthermore, as described above with respect to the "Co-ordinating Print and Video" example, the signal processor 200 also contains a decrypter 10 (see Fig. 1). These plurality of decryptors support a plurality of decryption techniques. The plurality of decryptors may decrypt information from different channels because each channel uses a different technique (e.g., Fig. 4E and related specification support). The plurality of decryptors may decrypt in a serial fashion so that both techniques are needed to fully decrypt programming (e.g., Figs. 4D and 6E and related specification support). Only one of the plurality of decryptors may be needed dependent on the type of embedding used for the programming (e.g., in-band or on a dedicated channel) as described in the "Co-ordinating Print and Video" example (i.e., Figs. 6D and related specification support). Each one of the decyptors in this example has different capabilities to support vastly different bandwidths, hence a different technique more suited to that decryptor's capabilities is needed.

b. U.S. Patent 8,566,868 Support

Similarly, the '868 Patent also teaches a "plurality of decryption techniques … at said receiver station." As discussed in the Patent Owner's Statement filed December 7, 2018, plural decryption techniques are described at least in column 2:45-48, 6:19-24, 143:63-144:4, 148:16-21, and 149:5-37 (where Example #7 describes how algorithms A, B, and C are used to decrypt digital video and digital audio) of the '868 Patent. The '868 Patent teaches,

> "In example #7, the program originating studio that originates the 'Wall Street Week' transmission transmits a television signal that consists of so-called 'digital video' and 'digital audio,' well known in the art. Prior to being transmitted, the digital video information is doubly encrypted, by means of

particular cipher algorithms A and B and cipher keys Aa and Ba, in such a way that said information requires decryption at subscriber stations in the fashion described below. The digital audio is transmitted in the clear. Said studio transmits the information of said program to a plurality of intermediate transmission stations by so-called 'landline' means and/or Earth orbiting satellite transponder means, well known in the art.

"Each of said intermediate transmission stations receives the transmission originated by said studio and retransmits the information of said transmission to a plurality of ultimate receiver stations.

"In example #7, the intermediate station that retransmits 'Wall Street Week' program information to the subscriber station of FIG. 4 is a cable television system head end (such as the head end of FIG. 6). Prior to retransmission, said station encrypts the digital audio information of said transmission, in a fashion well known in the art, using particular cipher algorithm C and cipher key Ca, then transmits the information of said program on cable channel 13, commencing at a particular 8:30 PM time on a particular Friday night." (See '868 Patent, 149:12-37.)

Clearly, to decrypt both the digital video and digital audio, a receiver station must have decryption algorithms A, B, and C available and operating simultaneously to present the "Wall Street Week" television show. Accordingly, at least example #7 in the '868 Patent specification supports a "plurality of decryption techniques … at said receiver station."

3. Support for "wherein said receiver station is arranged for reprogramming said operating instructions by operatively communicating with a source geographically remote from said receiver station, wherein said operatively communicating carries only digital information during said reprogramming"

The claim limitation at issue is "wherein said receiver station is arranged for reprogramming said operating instructions by operatively communicating with a source geographically remote from said receiver station, wherein said operatively communicating carries only digital information during said reprogramming," which is required in claims 48, 61, and 68. The Examiner did not identify claim 48, but the same limitation is required in claim 48 as in claims 61 and 68.

To summarize the specifications' teachings, the receiver stations may contact a remote source using a telephone or data transfer network connection to update operating instructions. Telephone communications, a common form of computer-to-computer communication in the 1980s, would necessarily carry only digital information to support the transfer of digital programming. Furthermore, "data," by definition, is digital information.

Specification support from the '490 Patent and '868 Patent are addressed individually.

a. U.S. Patent 4,694,490 Support

The "Summary of the Invention" states the receiver station operates according to operating instructions that may be reprogrammed. The '490 Patent specification states the following:

> "The apparatus has means for external communication and an automatic dialer and can contact remote sites and transfer stored information as required in a

predetermined fashion or fashions. The apparatus has a clock for determining and recording time as required. It has a read only memory for recording permanent operating instructions and other information and **a programmable random access memory controller ("PRAM controller") that permits revision of operating patterns and instructions.** The PRAM controller may be connected to all internal operating units for full flexibility of operations." (See '490 Patent, 5:11-22, emphasis added.)

Fig. 1 shows a block diagram of a signal processor, which contains controller 20 with the "telephone or other data transfer network" connection. "Data," by definition, is digital information. The '490 Patent specification states the following:

"**The signal processor apparatus also has a controller device** which includes programable random access memory controller 20, read only memory 21 that may contain a unique digital code capable of identifying the signal processing apparatus uniquely, **an automatic dialing device 24, and a telephone unit, 22**. **The controller, 20, governs the operation of all operating elements of the apparatus.** The controller, 20, inputs the local oscillator, 6, a sequential pattern to select the various channels to be received by switch, 1, and mixers, 2 and 3. This then allows the channels to be diverted to the detectors, receivers, and decoders in any predetermined pattern desired. The controller, 20, can instruct signal decoders, 30 and 40, when, where, and how to look for signal words, which allows signal words to be received in any pattern or patterns. It can instruct buffer/comparator, 8, how to assemble signal words into signal units and join units together for further transfer and how to determine which signals to pass to

decrypter, 10. **It can tell decrypter, 10, when and how to change decryption patterns, fashions, and techniques.** It can tell processor or monitor, 12, how to determine which signals to pass externally and when and where and how to determine which signals to pass to buffer/comparator, 14. It can tell buffer/comparator, 14, what and how to count, what and how to mark signals, and what-received signals to discard. **The controller, 20, also inputs the digital recorder, 16, to direct it to output the information from the memory of the recorder, 16, to telephone connection, 22, and thence to the collection site at the remote geographical location.** The controller, 20, also controls the automatic telephone dialing device, 24, to allow the apparatus to automatically output its own information in accordance with a predetermined sequence and to change telephone numbers dialed as required." (See '490 Patent, 8:20-55, emphasis added.)

Basically, the signal processor, by using the controller 20, acts to organize and control the entire receiver station apparatus. Furthermore, the controller may have its operating instructions reprogrammed from a remote source using a telephone connection. The '490 Patent specification states the following:

"**The controller**, 20, can shut off any element or elements of the apparatus in whole or in part. It **is interactive with external sources via telephone connection**, 22, **and can be reprogramed from such remote sources**. It follows standard password protection techniques well known in the art." (See '490 Patent, 9:20-25, emphasis added.)

b. U.S. Patent 8,566,868 Support

The "Summary of the Invention" states the receiver station operates according to operating instructions that may be reprogrammed. The '868 Patent specification states the following:

> "The apparatus has means for external communication and an automatic dialer and can contact remote sites and transfer stored information as required in a predetermined fashion or fashions. The apparatus has a clock for determining and recording time as required. It has a read only memory for recording permanent operating instructions and other information and **a programmable random access memory controller ("PRAM controller") that permits revision of operating patterns and instructions.** The PRAM controller may be connected to all internal operating units for full flexibility of operations." (See '868 Patent, 8:67-9:10, emphasis added.)

Fig. 2 shows a block diagram of a signal processor, which contains controller 20 with the "telephone or other data transfer network" connection. "Data," by definition, is digital information. The '868 Patent specification states the following:

> "**Signal processor, 26, has a controller device** which includes programmable RAM controller, 20; ROM, 21, that may contain unique digital code information capable of identifying signal processor, 26, and the subscriber station of said processor, 26, uniquely; **an automatic dialing device 24; and a telephone unit, 22**. A particular portion of ROM, 21, is erasable programmable ROM (hereinafter, "EPROM") or other forms of programmable nonvolatile memory. Under control particular preprogrammed instructions at that portion of

ROM, 21, that is not erasable, **signal processor, 26, has capacity to erase and reprogram said EPROM** in a fashion that is described more fully below. **Controller, 20, has capacity for controlling the operation of all elements of the signal processor** and can receive operating information from said elements. Controller, 20, has capacity to turn off any element or elements of controlled subscriber station apparatus, in whole or in part, and erase any or all parts of erasable memory of said controlled apparatus." (See '868 Patent, 17:55-18:5, emphasis added.)

"As described above, said controller, 39, 44, or 47, controls particular apparatus of its signal decoder and has means for communicating control information to said apparatus. Said controller, 39, 44, or 47, also has means for communicating control information with a controller, 20, of a signal processor, 26. (Said communicating means is shown clearly in FIG. 2D which is discussed below.) **Via said communicating means** and under control of instructions and signals discussed more fully below, **said controller, 20, has capacity to cause information at said EPROM to be erased and to reprogram said microprocessor control instructions at said RAM and said EPROM**." (See '868 Patent, 20:35-46, emphasis added.)

"Controller, 20, has capacity to preprogram (or reprogram) all said decoder apparatus, 27, 28, 29, 30, and 40, and thereby controls the fashions of

detecting, correcting, converting, modifying, identifying, transferring, and other functioning of said decoders." (See '868 Patent, 20:66-21:3.)

"In the present invention, **the signal processor**-26 in FIG. 2; 26 in the signal processor system of FIG. 2D; in the signal processor system, 71, of FIG. 6; 200 in FIG. 7; and elsewhere-**is focal means for the controlling and monitoring subscriber station operations.** It meters communications and enables owners of information to offer their information to subscribers in many fashions on condition of payment. **It has capacity for regulating communications consumption by selectively decrypting or not decrypting encrypted programming and/or control signals and capacity for assembling and retaining meter records at each subscriber station that document the consumption of specific programming and information at said station.** ... **It has capacity for transferring said meter records automatically to one or more remote automated billing stations that account for programming and information consumption and bill subscribers** and said monitor records automatically to one or more remote so-called 'ratings' stations that collect statistical data on programming availability and usage. It has capacities for processing information in many other fashions that will become apparent in this full specification." (See '868 Patent, 15:19-50, emphasis added.)

Basically, the signal processor, by using the controller 20, acts to organize and control the entire receiver station apparatus. Furthermore, the controller may have its operating instructions reprogrammed from a remote source using a telephone connection.

4. Support for "wherein said data is received at said receiver station in a different transmission than said computer program in said step of receiving"

The claim limitation at issue is "wherein said data is received at said receiver station in a different transmission than said computer program in said step of receiving," which is required in claims 65 and 70.

To summarize the specifications' teachings, if a user enters a code to receive a recipe, the receiver station processes instructions to activate local equipment, decrypts a received encrypted code for use with a decrypter to decrypt the recipe, and tunes to a new channel to receive the recipe. Accordingly, the computer program is received on one channel and the recipe is received on a different channel. These two claim elements (i.e., data and computer program) are received in different transmissions.

a. U.S. Patent 4,694,490 Support

In the "Co-ordinating Print and Video" example of the '490 Patent starting at col. 20, ln. 11, the specification states the following:

> "Suppose a viewer watches a television program on cooking techniques that is received on TV set, 202, via box, 201. Julia Childs's "The French Chef' is one such program. Halfway through the program, the host says, 'If you are interested in cooking what we are preparing here and want a printed copy of the

recipe for a charge of only 10 cents, press 567 on your Widget Signal Generator and Local Input.' The viewer then presses buttons 567 on local input, 225, which signal is conveyed to the buffer/comparator, 8 (referring to FIG. 1), of signal processor, 200, to hold and process further in a predetermined fashion. Five minutes later, a signal is identified in the incoming programing on TV set, 202, by decoder, 203, which is also transferred by processor, 204, to buffer/comparator, 8, of signal processor, 200. This signal instructs buffer/comparator, 8, that, if 567 has been received from signal generator, 225, signal processor, 200, should, in a predetermined fashion, **instruct tuner, 223, to tune cable converter box, 222, to the appropriate channel to receive the recipe in encoded digital form** and instruct control means, 226, to activate printer, 221. The signal transmission from processor, 204, also passes a signal word to signal processor, 200, which, in a predetermined fashion, signal processor, 200, decrypts and transfers to decrypter, 224, to serve as the code upon which decrypter, 224, will decrypt the incoming encrypted recipe. Then, as part of the predetermined operation, signal processor, 200, conveys to its data recorder, 16, information that the 567 order was placed by the viewer and all necessary equipment was enabled. **When the transmission of the recipe is received, box 222, transfers the transmission to decrypter, 224, for decryption and thence to printer, 221, for printing.** Other signal decoder, 227, identifies a signal in the transmission received by printer, 221, which it passes via processor, 228, and buffer/comparator, 14, of signal processor, 200, to data recorder, 16. This signal indicates that the recipe, itself, has been received. Subsequently, when signal processor, 200, transfers the data in its data recorder,

16, via telephone to a remote site, that site can determine for billing purposes that the recipe was, first, ordered and, second, delivered." (See '490 Patent, 20:16-59, emphasis added.)

b. U.S. Patent 8,566,868 Support

In the "Automating U. R. Stations ... Examples #9 and #10 Continued Coordinating Computers, Television, and Print" example of the '868 Patent starting at col. 240, ln. 45, the specification states the following:

"(An alternate method for inputting said second message to the microcomputers, 205, at stations where TV567# is entered at a local input, 225, is to embed said message in a particular second transmission that is different from the transmission of said 'Exotic Meals of lndia' programming and to cause a selected All signal decoder, 290, at each one of said stations to receive said second transmission, thereby causing said decoder, 290, to detect and transfer the information of said second message to the microcomputer, 205, of said station. In this alternate method, **executing said check-for-entered-information-and-process instructions of said first SPAM message** causes controller, 20, of signal processor, 200, of **each one of said stations to cause the tuner, 223, of a selected converter box, 222, to tune said box, 222, to receive said second transmission**; to cause the matrix switch, 258, to establish a programming communication link between said selected converter box, 222, and said decoder, 290; to cause the appropriate receiver apparatus of said decoder, 290, to receive said transmission and the appropriate detector and EOFS valve, 39F, to

commence detecting an end of file signal; and to cause an instance of particular covert control information that is in said instruction to be placed at particular control-function-invoking information memory of the controller, 39, of said decoder, 290. In due course, said programming originating studio causes the intermediate transmission station to embed an end of file signal then said second message in said second transmission. Transmitting said end of file signal then said second message causes the apparatus of said decoder, 290, to detect and process properly the information of said **second message**. This method has the advantage of making the information of said instructions relatively invulnerable to programming pirates because the location of said instructions [more precisely, the particular transmission in which said instructions are embedded] is harder to identify without causing meter information [if only of said first message] to be transmitted to remote metering stations.)

"(Whichever transmission method is employed the information of said second message can be encrypted and caused to be decrypted in any of the methods described above-for example, in the method of the first message of example #4.)" (See '868 Patent, 244:47-245:19, emphasis added.)

In this example, the first message with the computer program is transmitted in a first channel using a first transmission, and the data (i.e., recipe) is transmitted in a second message in a second channel using a second transmission. The citation above makes reference to the "check-for-entered-information-and-process instructions" of the computer program, but additional instructions are also transmitted in the computer program of the first message, which

is taught in the example prior to this instant citation. The "check-for-entered-information-and-process instructions" are sufficient to support the claimed "computer program."

D. Rejection of Claims 17-27, 64, 65, 69, and 70 under pre-AIA 35 U.S.C. § 103(a) over Lockwood in view of Sedman

Claim 17 is not obviated by Lockwood and Sedman for numerous reasons as explained below.

First, with regards to the claim limitation of "receiving, at said receiver station, a computer program transmitted from a transmitter station under the control of the transmitter station," the Examiner states for support that in Lockwood "the central processor 30 is able to store and subsequently retrieve data from the on-line mass storage module 31 on command" and "a second source of data is provided by a mass storage unit 28." (See Office Action, page 6.) Lockwood's central processor 30, non-volatile read only memory 31, and on-line mass storage unit 28 are all resident at the self-service terminal (see Lockwood 4:48-56, 6:56-61, 6:65-7:3, 3:17-25, Fig. 8). Lockwood has mislabeled "the on-line mass storage module 31" at col. 6, ll. 60-61, because the on-line mass storage is 28 and the read only memory is 31. The central processor is **never** able to store information in the read only memory 31 because this memory is "read only."

Lockwood states, "A second source of data is provided by a mass storage unit 28 which contains information of a more transitory nature such as flight schedules to various destinations, ticket prices, weather information, snow conditions at various skiing resorts, hotel occupancy status and other information useful in the planning of a business trip or vacation. This information is periodically updated via a communication link 24 with a remote control center."

(See Lockwood, 3:17-25.) None of the information listed is a "computer program" as required by the claims and as would be understood by a POSITA in 1981. All of the information listed is data, and data is not a computer program. The claimed "receiving, at said receiver station, **a computer program** transmitted from a transmitter station under the control of the transmitter station" (emphasis added) is neither shown nor suggested by the Examiner's citations.

Second, the PTAB has made clear that data, commands, and messages are not instructions, and do not obviate instructions. Instructions form a computer program. Lockwood's transitory information is data, which does not show or suggest a computer program.

In the Decision on Appeal, Appeal 2016-005574 for Application No. 08/447724, which is an application having the exact same specification as the instant '868 Patent, the PTAB determined, "[b]ased on that construction, we do not agree with the Examiner that Summers teaches Appellants' claimed 'computer code.' The term 'computer code' cannot be broadly construed to encompass any type of data which might be used in some way in programming a computer, including Summers' 'supplemental data' even if such 'supplemental data' is said 'to program a data storage means 36 (FIG. 2) such as a computer at the receiving end for various purposes' as disclosed by Summers. Reply Br. 20-21 (citing Summers 7:56-62). We agree with Appellants that a skilled artisan would understand the difference between 'computer code' and Summers' 'supplemental data.' Reply Br. 23." (See Appeal 2016-005574, pg. 16.) (Summers is U.S. Patent 3,848,082.) The PTAB clearly delineates the difference between Summer's "supplemental data" and "computer code," which is instructions for a computer.

The PTAB also determined that "instructions" may encompass compiled, assembly language, or higher level language programs. "Those instructions as described by Appellants' Specification provide support for the term 'computer code' and those instructions refer to (1)

'program instruction sets' such as 'compiled machine language code or assembly language code or higher level language programs ... [that] can execute such program information and cause compiling prior to execution' (Spec. 41 :20-21, 53 :34-54: 8); or (2) '[c]omputer program instructions, of the sort well known in the art' (Spec. 356:9-11)." (See Appeal 2016-005574, pp. 15-16.)

Of note, the prior art references of Seth-Smith, Lambert, and Freeman discussed in Appeal 2016-005574 postdate the 1981 priority of claim 17 in the instant '868 Patent; therefore, these references are not prior art and have no bearing on any decision affecting claim 17 in the instant '868 Patent.

The PTAB went on to formulate new grounds of rejection using Hedger's telesoftware paper with Summers' supplemental data. (The Hedger article is "Telesoftware: Home Computing Via Broadcast Teletext," IEEE Transactions on Consumer Electronics. Vol. CE-25. No. 3., July 1979, pp. 279-287, which is covered by the two Hedger articles in the IDS originally filed with the instant '868 Patent reexamination request.) However, Hedger's telesoftware and Summers' supplemental data are transmitted using a broadcast television signal. Lockwood does not use a television signal to receive an electronic transmission comprising digital information. The Patent Owner is aware of references that mention the transmission of telesoftware over a telephone line. However, Winter (U.S. Patent 4,814,972) has a 1986 priority, thus postdates claim 17 in the instant '868 Patent. Sedman ("The use of MicroCobol for Telesoftware," Videotex, Viewdata & Teletext, A Transcript of the Online Conference on Videotex, Viewdata and Teletext, 1980, pp. 399-411) is a forward looking paper providing no explanation of how one would achieve any of the goals the author espouses using technology available in 1980. Sedman only indicates limited utility of telesoftware due to bandwidth issues and the fact that Prestel

already makes data readily available to a user. (See Sedman, pg. 404.) Sedman shows that his paper is purely conceptual by concluding, "This paper has attempted to give an indication of the concept and possible uses of telesoftware in business applications." (See Sedman, pg. 411, emphasis added.)

Again, Lockwood's transitory information is data, which does not show or suggest a computer program. The Examiner's statement that Sedman could be used to transmit "[t]he computer programs of Lockwood" (see Office Action, pg. 6) assumes Lockwood's transitory data is a computer program, which it is not. Lockwood never states the application programs are received at the self-service terminal through transmission.

Third, the instant patent, U.S. Patent 8,566,868, recently completed a reexamination (i.e., control number 90/014,195) over Lockwood in which the Examiner focused on the claims 17 and 22 limitation, "executing with said processor at said receiver station, **under the control of the transmitter station**, said computer program" (emphasis added). The Examiner in 90/014,195 determined this claim limitation was not obviated by a program stored at a receiver station through transmission, which relied on a user activity to cause execution of the program. In other words, if a program is stored at a receiver station through transmission, the program must execute without the user having to select the program to be "under the control of the transmitter station" as claimed.

The Examiner in the instant reexamination again uses only Lockwood to obviate the "executing" step of claims 17 and 22. The Examiner states, "The computer program is executed at a ticketing terminal and a seat reservation/ticket information is communicated to a remote site." (See Office Action, pg. 8.) However, the Examiner has not given any patentable weight to

the claim requirement of "executing with said processor at said receiver station, **under the control of the transmitter station**, said computer program" (emphasis added).

Furthermore, antecedent basis in these claims require the executing of said computer program to be the same program received and loaded in the prior steps. The Examiner has cited Lockwood's transitory information, which is data, not a computer program, or *arguendo* Lockwood's application programs downloaded using Sedman. However, both Lockwood and Sedman require user selection to initiate the programs, which means they are not executed "under the control of the transmitter station" as claimed.

Lockwood clearly states, "The application program is of a 'menu-type' and can be best understood by reference to the flow diagrams of FIGS. 9, 10 and 11." (See Lockwood, 7:1-3.) To start any of the application programs, the user selects a program from a menu. Sedman clearly states, "From the user's point of view, he finds the program he wants via the normal menu selection process." (See Sedman, pg. 404.) As with Lockwood, Sedman uses a menu system to select programs. Furthermore, Sedman's telesoftware provides "[h]aving brought down a program we can go off-line, and treat the terminal as a completely stand-alone machine." (See Sedman, pg. 405.) Sedman does not show or suggest receiving and loading a program that is then executed "under the control of the transmitter station" as required by the claims. Accordingly, Sedman cannot make up for what is missing in Lockwood.

Fourth, The Examiner makes the Patent Owner's and the Examiner's (in the prior reexamination of the instant patent) point by stating, "Lockwood at Fig. 10. And co. 7, 1. 62-col. 8, 1. 6 –'BEGIN RESERVATION,' **the user enters** an 'AIRLINE/FLIGHT#' and other information." (See Office Action, pg. 7, emphasis added.) The Examiner uses the BEGIN RESERVATION program as an example of the claimed "executing;" however, as just discussed,

the BEGIN RESERVATION program would have been selected from a menu, which requires user intervention to start the program. User intervention fails to obviate the claimed "executing with said processor at said receiver station, **under the control of the transmitter station**" (emphasis added). Next, the Examiner points to the user entering information. Again, user intervention fails to obviate the claimed "executing with said processor at said receiver station, **under the control of the transmitter station**" (emphasis added). The Examiner has not given any patentable weight to this emphasized claim requirement, which is an error under M.P.E.P. § 2143.03.

Fifth, the Examiner cites *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) for the proposition that a "recitation of the intended use of the claimed invention must result in additional steps." Intended use or functional language in claims is properly construed as a positive claim limitation, and not merely a statement of purpose or intended use for the invention, when the function or intended use is the essence or a fundamental characteristic of the claimed invention at issue. *Vizio, Inc. Int'l Trade Comm'n*, 605 F.3d 1330 (Fed. Cir. 2010). See, also, *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333 (Fed.Cir. 2003); *Griffin v. Bertina*, 285 F.3d 1029, 1033 (Fed.Cir.2002); *Manning v. Paradis*, 296 F.3d 1098, 1103 (Fed.Cir.2002). For example, in *Griffin v. Bertina*, *supra*, the Federal Circuit construed language in the preamble of the claim describing "[a] method for diagnosing an increased risk for thrombosis," 285 F.3d at 1031, and concluded that "[d]iagnosis is ... the essence of this invention; its appearance in the count gives 'life and meaning' to the manipulative steps," id. at 1033. The Court further noted that, without the statement of the invention's intended purpose in the preamble, the other steps of "obtaining nucleic acid and assaying for a point mutation alone [were] merely academic exercises." Id.

Of course, as noted above, most "intended use" cases, including the case of *Bristol-Myers Squibb Co. v. Ben Venue Labs*, 246 F.3d 1368 (Fed. Cir. 2001) cited by the Examiner, deal with whether statements of purpose of the invention in the preamble are entitled to patentable weight because they limit or "give meaning" to the other limitations in the body of claim. The present case does not involve a preamble but rather positive recitation of action in the process steps in the body of the claim. Therefore, contrary to the Examiner's contention, in claim 17, the claimed steps are not just "statements of intended use" but rather predicates necessary for the actions recited in further steps in the claim. For example, the loading of a computer program is a necessary predicate to executing that program in a further step. Further, in the final step of claim 17, outputting advertising based on the execution of the prior steps is what the invention seeks to achieve and, thus, is the "essence of the invention" in much the same way as "decoding " was in the *Vizio* case. These phrases are recited in the body of the claims, and written in a manner in which they are a requirement of the step. M.P.E.P. § 2111 and more specifically M.P.E.P. § 2111.04 prevents the language at issue from being considered contingent clauses. There is no language in the claim that allows the "loading" and "executing" steps to escape "to program operation of said processor" or "to output advertising at said receiver station," respectively. The Examiner's "intended use" rejections should be withdrawn.

Additionally, by using the *Bristol-Myers Squibb Co.* case in an incorrect fashion, the Examiner has nullified the requirements of "to output advertising at said receiver station" in claim 17 and "to communicate an order for a product or service from said receiver station to a remote station" in claim 22. By making this erroneous decision, the Examiner has created two claims with **exactly** the same language in the body of the claim for claims that have already been

allowed. This fact alone argues against the Examiner's position because the Examiner is **artificially creating statutory double patenting** where it did not exist previously.

For at least the reasons argued above, independent claim 17 is patentable, as are all claims that depend directly or indirectly from claim 17.

Regarding claim 19, the Examiner again raises the *Bristol-Myers Squibb Co.* case for the proposition that a "recitation of the intended use of the claimed invention must result in additional steps." (See Office Action, pg. 9.) The *Bristol-Myers Squibb Co.* case does not make this statement. (See the related discussion in claim 17 above.) Even if this conclusion is reached, the claim language at issue in the *Bristol-Myers Squibb Co.* case is in the preamble, which may have found "effect" if the claim language was in the body of the claim. In the instant claims, the language is already in the body of the claim and must be given patentable weight under M.P.E.P. § 2143.03.

Then the Examiner states, "The receiving, loading, and executing steps would be performed the same regardless of the type of advertisment" with regards to the claimed "personalized advertising." (See Office Action, pg. 9.) This type of statement presumes "advertising" as claimed is inherently known, which is completely absent from the record. A computer program does not inherently output "advertising," let alone "personalized advertising" as claimed. Neither Lockwood nor Sedman show or suggest a computer program that when executed, "under the control of the transmitter station, said computer program, by processing data, to output advertising at said receiver station," let alone "said advertising comprises personalized advertising." The infinitive phrase of "to output advertising" is not conditional, but

instead is a requirement of the executing step. Claim 19 further limits this requirement, which places different limitations on the claim 17 "executing" step by the requirements of claim 19.

Additionally, the Examiner raises *In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) and *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994), for the proposition that claim 19 is "non-functional descriptive material." (See Office Action, pp. 9-10.) As best as the Patent Owner can understand, the Examiner is making a veiled reference to M.P.E.P. § 2111.05.

M.P.E.P. § 2111.05 addresses the analysis of "nonfunctional descriptive material" that is described in that M.P.E.P. section as "printed matter." M.P.E.P. § 2111.05 states, "The first step of the printed matter analysis is the determination that the limitation in question is in fact directed toward printed matter" or as the Examiner describes it "non-functional descriptive material." None of the claim elements make reference to "printed matter" or "nonfunctional descriptive material," such as characters, text, symbols, etc., which are printed on a substrate, or a claim to machine readable media. Furthermore, none of the claim elements encompass mental steps which the so-called "printed matter" rejection has also been found to include. All of the claim elements are physical operations performed on physical apparatus. The Examiner's reasoning for applying a "descriptive material" requirement cannot be understood by the Patent Owner. Any rejection based on a "descriptive material" reason is of the Examiner's own creation without support under M.P.E.P. § 2111.05.

The Examiner appears to fundamentally misunderstand the so-called "printed matter" rejection. As noted above, "printed matter," in this context, refers to information content - however, it may be presented. Although a printed material rejection originally focused on material as in books or texts, it has come to refer to information content generally. As the

Federal Circuit recently pointed out, claim limitations directed to the content of information itself rather to the use of the information in a system are technologically non-functional. Accordingly, they are not entitled to patentable weight because "information" *per se* is not patent eligible subject matter under 35 U.S.C. § 101. *Praxair Distrib., Inc. v. Mallinckrodt Hosp. Prod. IP Ltd.*, 890 F.3d 1024, 1032 (Fed. Cir. 2018). For example, markings on the face of dice were considered "printed matter" and could not support patentability as that subject matter falls outside the scope of § 101. *In re Marco Guldenaar Holding B.V.*, Appeal No. 2017-2465 (Fed. Cir. decided December 28, 2018). See also *AstraZeneca LP v. Apotex, Inc.*, 633 F.3d 1042, 1064 (Fed. Cir. 2010), which held that instructions on how to administer a drug were entitled to no patentable weight in a drug composition claim. Here the Examiner contends that receiving, loading, and executing of the same computer program (due to antecendent basis) that results in a "personalized advertising" not required in the parent claim is "non-functional descriptive material." This is simply not the case. The claim elements are recited functionally as receiving, loading, and executing the same program that outputs personalized advertising.

Then, the Examiner concludes "it would have been obvious to a person of ordinary skill in the art at the time the invention was made execute the computer program regardless of type of data included because such data does not functionally relate to the steps in the method claimed and because of the subjective interpretation of the data does not patentably distinguish the claimed invention." (See Office Action, pg. 10.) The Patent Owner does not understand the factual basis for this statement or how the Examiner intends it to be understood as a part of his rejection of the claim based on the cited art. As a result, the Patent Owner must respond based on what it assumes the Examiner to be using as grounds of rejection.

If the statement is to be understood as a factual assertion, then the Examiner is essentially making an argument under M.P.E.P. § 2144.03, which requires "Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert,* 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be 'capable of such instant and unquestionable demonstration as to defy dispute' (citing *In re Knapp Monarch Co.,* 296 F.2d 230, 132 USPQ 6 (CCPA 1961))."

The Patent Owner has not been provided with prior art for claim 19 that may be analyzed to determine the actual teaching in that prior art, and motivation to combine. The Examiner is taking the position that the existence of the limitations of claim 19 in the prior art in 1981 is "capable of instant and unquestionable demonstration." The reasoning of "would have been obvious to a person of ordinary skill in the art at the time" to establish a fact as to the state of the prior art more than thirty (30) years ago is highly questionable. Under 37 C.F.R. § 1.104 (d) (2), "When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons." Accordingly, if this is the basis for the rejection, the Patent Owner hereby requests either prior art reference(s) or an Examiner affidavit in support of the requirements of claim 19.

If the Examiner is contending that the limitation is not entitled to be given patentable weight because the results which the invention is achieving are somehow nonfunctional, then the Examiner is making a "printed matter" rejection as noted above with respect to the instant claim.

In that case, as noted above, the claim is clear to its objective which is outputting of personalized advertising, a clearly recited function produced by the preceding steps of the claim. Unless the Examiner can provide proper clarification of the rejection which meets the clear requirements of M.P.E.P. respecting such a rejection, the Patent Owner respectfully requests withdrawal of the 35 U.S.C. 103 rejection of claim 19.

Regarding claim 20, the Examiner states "See claim 17 above - Lockwood teaches a user providing an input at said receiver station. Also, claim 17 recites functional limitation 'to output advertising at said receiver station.'" While both of these statements are true, the implication is that Lockwood somehow shows or suggests an advertisement as a result of receiving, loading, and executing with said processor at said receiver station, under the control of the transmitter station, said computer program. These facts are not in the record. The Examiner has not shown that Lockwood shows or suggests the claimed "to output advertising at said receiver station" in claim 17. The Examiner sidestepped this claim 20 limitation element by erroneously invoking the *Bristol-Myers Squibb Co.* case for the proposition that a "recitation of the intended use of the claimed invention must result in additional steps" (see Office Action, pg. 10), which is again used to reject claim 20. The *Bristol-Myers Squibb Co.* case is concerned with limitations in the preamble of claims, and claim preamble amendments after allowance. Neither fact pattern is relevant to the instant claims. (See the related discussion in claim 17 above.)

Without support from prior art, the Patent Owner respectfully requests withdrawal of the rejection of claim 20.

Regarding claim 21, the Examiner raises *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) and *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994), for the proposition that claim 21 is "non-functional descriptive material." (See Office Action, pp. 10-11.) As best as the Patent Owner can understand, the Examiner is making a veiled reference to M.P.E.P. § 2111.05.

M.P.E.P. § 2111.05 addresses the analysis of "nonfunctional descriptive material" that is described in that M.P.E.P. section as "printed matter." M.P.E.P. § 2111.05 states, "The first step of the printed matter analysis is the determination that the limitation in question is in fact directed toward printed matter" or as the Examiner describes it "non-functional descriptive material." None of the claim elements make reference to "printed matter" or "nonfunctional descriptive material," such as characters, text, symbols, etc., which are printed on a substrate, or a claim to machine readable media. Furthermore, none of the claim elements encompass mental steps which the so-called "printed matter" rejection has also been found to include. All of the claim elements are physical operations performed on physical apparatus. The Examiner's reasoning for applying a "descriptive material" requirement cannot be understood by the Patent Owner. Any rejection based on a "descriptive material" reason is of the Examiner's own creation without support under M.P.E.P. § 2111.05.

The Examiner appears to fundamentally misunderstand the so-called "printed matter" rejection. As noted above, "printed matter," in this context, refers to information content - however, it may be presented. Although a printed material rejection originally focused on material as in books or texts, it has come to refer to information content generally. As the Federal Circuit recently pointed out, claim limitations directed to the content of information itself rather to the use of the information in a system are technologically non-functional. Accordingly,

they are not entitled to patentable weight because "information" *per se* is not patent eligible subject matter under 35 U.S.C. § 101. *Praxair Distrib., Inc. v. Mallinckrodt Hosp. Prod. IP Ltd.*, 890 F.3d 1024, 1032 (Fed. Cir. 2018). For example, markings on the face of dice were considered "printed matter" and could not support patentability as that subject matter falls outside the scope of § 101. *In re Marco Guldenaar Holding B.V.*, Appeal No. 2017-2465 (Fed. Cir. decided December 28, 2018). See also *AstraZeneca LP v. Apotex, Inc.*, 633 F.3d 1042, 1064 (Fed. Cir. 2010), which held that instructions on how to administer a drug were entitled to no patentable weight in a drug composition claim. Here the Examiner contends that receiving, loading, and executing of the same computer program (due to antecedent basis) that results in a new result (i.e., personalized offer) not required in the parent claim is "non-functional descriptive material." This is simply not the case. The claim elements are recited functionally as receiving, loading, and executing the same program that provides a personalized offer to purchase an advertised good.

Then, the Examiner concludes "it would have been obvious to a person of ordinary skill in the art at the time the invention was made execute the computer program regardless of type of data included because such data does not functionally relate to the steps in the method claimed and because of the subjective interpretation of the data does not patentably distinguish the claimed invention." (See Office Action, pg. 11.) The Patent Owner does not understand the factual basis for this statement or how the Examiner intends it to be understood as a part of his rejection of the claim based on the cited art. As a result, the Patent Owner must respond based on what it assumes the Examiner to be using as grounds of rejection.

If the statement is to be understood as a factual assertion, then the Examiner is essentially making an argument under M.P.E.P. § 2144.03, which requires "Official notice unsupported by

documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert,* 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.,* 296 F.2d 230, 132 USPQ 6 (CCPA 1961))."

The Patent Owner has not been provided with prior art for claim 21 that may be analyzed to determine the actual teaching in that prior art, and motivation to combine. The Examiner is taking the position that the existence of the limitations of claim 21 in the prior art is "capable of instant and unquestionable demonstration." The reasoning of "would have been obvious to a person of ordinary skill in the art at the time" to establish a fact as to the state of the prior art more than thirty (30) years ago is highly questionable. Under 37 C.F.R. § 1.104 (d) (2), "When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons." Accordingly, if this is the basis for the rejection, the Patent Owner hereby requests either prior art reference(s) or an Examiner affidavit in support of the requirements of claim 21.

If the Examiner is contending that the limitation is not entitled to be given patentable weight because the results which the invention is achieving are somehow nonfunctional, then the Examiner is making a "printed matter" rejection as noted above with respect to the instant claim. In that case, as noted above, the claim is clear to its objective which is including a personalized offer, a clearly recited function produced by the preceding steps of the claim. Unless the

Examiner can provide proper clarification of the rejection which meets the clear requirements of M.P.E.P. respecting such a rejection, the Patent Owner respectfully requests withdrawal of the 35 U.S.C. 103 rejection of claim 21.

Claim 22 is not obviated by Lockwood and Sedman for numerous reasons as explained below.

First, with regards to the claim limitation of "receiving, at said receiver station, a computer program transmitted from a transmitter station under the control of the transmitter station," the Examiner states for support that in Lockwood "the central processor 30 is able to store and subsequently retrieve data from the on-line mass storage module 31 on command" and "a second source of data is provided by a mass storage unit 28." (See Office Action, page 11.) Lockwood's central processor 30, non-volatile read only memory 31, and on-line mass storage unit 28 are all resident at the self-service terminal (see Lockwood 4:48-56, 6:56-61, 6:65-7:3, 3:17-25, Fig. 8). Lockwood has mislabeled "the on-line mass storage module 31" at col. 6, ll. 60-61, because the on-line mass storage is 28 and the read only memory is 31. The central processor is **never** able to store information in the read only memory 31 because this memory is "read only."

Lockwood states, "A second source of data is provided by a mass storage unit 28 which contains information of a more transitory nature such as flight schedules to various destinations, ticket prices, weather information, snow conditions at various skiing resorts, hotel occupancy status and other information useful in the planning of a business trip or vacation. This information is periodically updated via a communication link 24 with a remote control center." (See Lockwood, 3:17-25.) None of the information listed is a "computer program" as required

by the claims and as would be understood by a POSITA in 1981. All of the information listed is data, and data is not a computer program. The claimed "receiving, at said receiver station, **a computer program** transmitted from a transmitter station under the control of the transmitter station" (emphasis added) is neither shown nor suggested by the Examiner's citations.

Second, the PTAB has made clear that data, commands, and messages are not instructions, and do not obviate instructions. Instructions form a computer program. Lockwood's transitory information is data, which does not show or suggest a computer program.

In the Decision on Appeal, Appeal 2016-005574 for Application No. 08/447724, which is an application having the exact same specification as the instant '868 Patent, the PTAB determined, "[b]ased on that construction, we do not agree with the Examiner that Summers teaches Appellants' claimed 'computer code.' The term 'computer code' cannot be broadly construed to encompass any type of data which might be used in some way in programming a computer, including Summers' 'supplemental data' even if such 'supplemental data' is said 'to program a data storage means 36 (FIG. 2) such as a computer at the receiving end for various purposes' as disclosed by Summers. Reply Br. 20-21 (citing Summers 7:56-62). We agree with Appellants that a skilled artisan would understand the difference between 'computer code' and Summers' 'supplemental data.' Reply Br. 23." (See Appeal 2016-005574, pg. 16.) (Summers is U.S. Patent 3,848,082.) The PTAB clearly delineates the difference between Summer's "supplemental data" and "computer code," which is instructions for a computer.

The PTAB also determined that "instructions" may encompass compiled, assembly language, or higher level language programs. "Those instructions as described by Appellants' Specification provide support for the term 'computer code' and those instructions refer to (1) 'program instruction sets' such as 'compiled machine language code or assembly language code

or higher level language programs ... [that] can execute such program information and cause compiling prior to execution' (Spec. 41 :20-21, 53 :34-54: 8); or (2) '[c]omputer program instructions, of the sort well known in the art' (Spec. 356:9-11)." (See Appeal 2016-005574, pp. 15-16.)

Of note, the prior art references of Seth-Smith, Lambert, and Freeman discussed in Appeal 2016-005574 postdate the 1981 priority of claim 22 in the instant '868 Patent; therefore, these references are not prior art and have no bearing on any decision affecting claim 22 in the instant '868 Patent.

The PTAB went on to formulate new grounds of rejection using Hedger's telesoftware paper with Summers' supplemental data. (The Hedger article is "Telesoftware: Home Computing Via Broadcast Teletext," IEEE Transactions on Consumer Electronics. Vol. CE-25. No. 3., July 1979, pp. 279-287, which is covered by the two Hedger articles in the IDS originally filed with the instant '868 Patent reexamination request.) However, Hedger's telesoftware and Summers' supplemental data are transmitted using a broadcast television signal. Lockwood does not use a television signal to receive an electronic transmission comprising digital information. The Patent Owner is aware of references that mention the transmission of telesoftware over a telephone line. However, Winter (U.S. Patent 4,814,972) has a 1986 priority, thus postdates the instant '868 Patent. Sedman ("The use of MicroCobol for Telesoftware," Videotex, Viewdata & Teletext, A Transcript of the Online Conference on Videotex, Viewdata and Teletext, 1980, pp. 399-411) is a forward looking paper providing no explanation of how one would achieve any of the goals the author espouses using technology available in 1980. Sedman only indicates limited utility of telesoftware due to bandwidth issues and the fact that Prestel already makes data readily available to a user. (See Sedman, pg. 404.) Sedman shows that his paper is purely

conceptual by concluding, "This paper has attempted to give an indication of the concept and possible uses of telesoftware in business applications." (See Sedman, pg. 411, emphasis added.)

Again, Lockwood's transitory information is data, which does not show or suggest a computer program. At this point, the Examiner should find claim 22 allowable, along with all claims that depend directly or indirectly from claim 22 because the Examiner has only shown Lockwood to receive transitory data, not a computer program. However, the Patent Owner believes the Examiner forgot to make their prior argument as in claim 17 to include Sedman's transmission of a computer program to enable transmission of Lockwood's application programs. However, Lockwood never states the application programs are received at the self-service terminal through transmission.

Third, the instant patent, U.S. Patent 8,566,868, recently completed a reexamination (i.e., control number 90/014,195) over Lockwood in which the Examiner focused on the claims 17 and 22 limitation, "executing with said processor at said receiver station, **under the control of the transmitter station**, said computer program" (emphasis added). The Examiner in 90/014,195 determined this claim limitation was not obviated by a program stored at a receiver station through transmission, which relied on a user activity to cause execution of the program. In other words, if a program is stored at a receiver station through transmission, the program must execute without the user having to select the program to be "under the control of the transmitter station" as claimed.

The Examiner in the instant reexamination again uses only Lockwood to obviate the "executing" step of claims 17 and 22. The Examiner states, "The computer program is executed at a ticketing terminal and a seat reservation/ticket information is communicated to a remote site." (See Office Action, pg. 13.) However, the Examiner has not given any patentable weight

to the claim requirement of "executing with said processor at said receiver station, **under the control of the transmitter station**, said computer program" (emphasis added).

Furthermore, antecedent basis in these claims require the executing of said computer program to be the same program received and loaded in the prior steps. The Examiner has cited Lockwood's transitory information, which is data, not a computer program, or *arguendo* Lockwood's application programs downloaded using Sedman. However, both Lockwood and Sedman require user selection to initiate the programs, which means they are not executed "under the control of the transmitter station" as claimed.

Lockwood clearly states, "The application program is of a 'menu-type' and can be best understood by reference to the flow diagrams of FIGS. 9, 10 and 11." (See Lockwood, 7:1-3.) To start any of the application programs, the user selects a program from a menu. Sedman clearly states, "From the user's point of view, he finds the program he wants via the normal menu selection process." (See Sedman, pg. 404.) As with Lockwood, Sedman uses a menu system to select programs. Furthermore, Sedman's telesoftware provides "[h]aving brought down a program we can go off-line, and treat the terminal as a completely stand-alone machine." (See Sedman, pg. 405.) Sedman does not show or suggest receiving and loading a program that is then executed "under the control of the transmitter station" as required by the claims. Accordingly, Sedman cannot make up for what is missing in Lockwood.

Fourth, The Examiner makes the Patent Owner's and the Examiner's (in the prior reexamination of the instant patent) point by stating, "Lockwood at Fig. 10. And co. 7, 1. 62-col. 8, 1. 6 –'BEGIN RESERVATION,' **the user enters** an 'AIRLINE/FLIGHT#' and other information." (See Office Action, pg. 12, emphasis added.) The Examiner uses the BEGIN RESERVATION program as an example of the claimed "executing;" however, as just discussed,

the BEGIN RESERVATION program would have been selected from a menu, which requires user intervention to start the program. User intervention fails to obviate the claimed "executing with said processor at said receiver station, **under the control of the transmitter station**" (emphasis added). Next, the Examiner points to the user entering information. Again, user intervention fails to obviate the claimed "executing with said processor at said receiver station, **under the control of the transmitter station**" (emphasis added). The Examiner has not given any patentable weight to this emphasized claim requirement, which is an error under M.P.E.P. § 2143.03.

Fifth, the Examiner cites *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) for the proposition that a "recitation of the intended use of the claimed invention must result in additional steps." Intended use or functional language in claims is properly construed as a positive claim limitation, and not merely a statement of purpose or intended use for the invention, when the function or intended use is the essence or a fundamental characteristic of the claimed invention at issue. *Vizio, Inc. Int'l Trade Comm'n*, 605 F.3d 1330 (Fed. Cir. 2010). See, also, *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333 (Fed.Cir. 2003); *Griffin v. Bertina*, 285 F.3d 1029, 1033 (Fed.Cir.2002); *Manning v. Paradis*, 296 F.3d 1098, 1103 (Fed.Cir.2002). For example, in *Griffin v. Bertina*, *supra*, the Federal Circuit construed language in the preamble of the claim describing "[a] method for diagnosing an increased risk for thrombosis," 285 F.3d at 1031, and concluded that "[d]iagnosis is ... the essence of this invention; its appearance in the count gives 'life and meaning' to the manipulative steps," id. at 1033. The Court further noted that, without the statement of the invention's intended purpose in the preamble, the other steps of "obtaining nucleic acid and assaying for a point mutation alone [were] merely academic exercises." Id.

Of course, as noted above, most "intended use" cases, including the case of *Bristol-Myers Squibb Co. v. Ben Venue Labs*, 246 F.3d 1368 (Fed. Cir. 2001) cited by the Examiner, deal with whether statements of purpose of the invention in the preamble are entitled to patentable weight because they limit or "give meaning" to the other limitations in the body of claim. The present case does not involve a preamble but rather positive recitation of action in the process steps in the body of the claim. Therefore, contrary to the Examiner's contention, in claim 22, the claimed steps are not just "statements of intended use" but rather predicates necessary for the actions recited in further steps in the claim. For example, the loading of a computer program is a necessary predicate to executing that program in a further step. Further, in the final step of claim 22, communicating an order for a product or service based on the execution of the prior steps is what the invention seeks to achieve and, thus, is the "essence of the invention" in much the same way as "decoding " was in the *Vizio* case. These phrases are recited in the body of the claims, and written in a manner in which they are a requirement of the step. M.P.E.P. § 2111 and more specifically M.P.E.P. § 2111.04 prevents the language at issue from being considered contingent clauses. There is no language in the claim that allows the "loading" and "executing" steps to escape "to program operation of said processor" or "to communicate an order for a product or service from said receiver station to a remote station," respectively. The Examiner's "intended use" rejections should be withdrawn.

Additionally, by using the *Bristol-Myers Squibb Co.* case in an incorrect fashion, the Examiner has nullified the requirements of "to output advertising at said receiver station" in claim 17 and "to communicate an order for a product or service from said receiver station to a remote station" in claim 22. By making this erroneous decision, the Examiner has created two claims with **exactly** the same language in the body of the claim for claims that have already been

allowed. This fact alone argues against the Examiner's position because the Examiner is **artificially creating statutory double patenting** where it did not exist previously.

For at least the reasons argued above, independent claim 22 is patentable, as are all claims that depend directly or indirectly from claim 22.

Regarding claim 23, the Examiner's rejection is now moot because the claim has been amended from "said order is generated" to "generating said order." The original claim language already positively required the generation of the order, contrary to the Examiner's rejection under both the *Bristol-Myers Squibb Co.* case and M.P.E.P. § 2111.04. However, to advance prosecution, the amendment now makes moot these rejections. Claim 39 has been amended to parallel the changes in claim 23.

Regarding claim 24, the Examiner raises *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) and *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994), for the proposition that claim 24 is "non-functional descriptive material." (See Office Action, pg. 14.) As best as the Patent Owner can understand, the Examiner is making a veiled reference to M.P.E.P. § 2111.05.

M.P.E.P. § 2111.05 addresses the analysis of "nonfunctional descriptive material" that is described in that M.P.E.P. section as "printed matter." M.P.E.P. § 2111.05 states, "The first step of the printed matter analysis is the determination that the limitation in question is in fact directed toward printed matter" or as the Examiner describes it "non-functional descriptive material." None of the claim elements make reference to "printed matter" or "nonfunctional descriptive material," such as characters, text, symbols, etc., which are printed on a substrate, or

a claim to machine readable media. Furthermore, none of the claim elements encompass mental steps which the so-called "printed matter" rejection has also been found to include. The claimed "order" is generated at the receiver station as a result of the executing, which now has the additional, affirmative requirement of the order including a shopping list. The Examiner's reasoning for applying a "descriptive material" requirement cannot be understood by the Patent Owner. Any rejection based on a "descriptive material" reason is of the Examiner's own creation without support under M.P.E.P. § 2111.05.

The Examiner appears to fundamentally misunderstand the so-called "printed matter" rejection. As noted above, "printed matter," in this context, refers to information content - however, it may be presented. Although a printed material rejection originally focused on material as in books or texts, it has come to refer to information content generally. As the Federal Circuit recently pointed out, claim limitations directed to the content of information itself rather to the use of the information in a system are technologically non-functional. Accordingly, they are not entitled to patentable weight because "information" *per se* is not patent eligible subject matter under 35 U.S.C. § 101. *Praxair Distrib., Inc. v. Mallinckrodt Hosp. Prod. IP Ltd.*, 890 F.3d 1024, 1032 (Fed. Cir. 2018). For example, markings on the face of dice were considered "printed matter" and could not support patentability as that subject matter falls outside the scope of § 101. *In re Marco Guldenaar Holding B.V.*, Appeal No. 2017-2465 (Fed. Cir. decided December 28, 2018). See also *AstraZeneca LP v. Apotex, Inc.*, 633 F.3d 1042, 1064 (Fed. Cir. 2010), which held that instructions on how to administer a drug were entitled to no patentable weight in a drug composition claim. Here the Examiner contends that receiving, loading, and executing of the same computer program (due to antecendent basis) that results in communication of an order with a shopping list "non-functional descriptive material." This is

simply not the case. The claim elements are recited functionally as receiving, loading, and executing the same program that communicates an order to a remote station in claim 22.

Then, the Examiner concludes "it would have been obvious to a person of ordinary skill in the art at the time the invention was made execute the computer program regardless of type of data included because such data does not functionally relate to the steps in the method claimed and because of the subjective interpretation of the data does not patentably distinguish the claimed invention." (See Office Action, pg. 14.) The Patent Owner does not understand the factual basis for this statement or how the Examiner intends it to be understood as a part of his rejection of the claim based on the cited art. As a result, the Patent Owner must respond based on what it assumes the Examiner to be using as grounds of rejection.

If the statement is to be understood as a factual assertion, then the Examiner is essentially making an argument under M.P.E.P. § 2144.03, which requires "Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert,* 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be 'capable of such instant and unquestionable demonstration as to defy dispute' (citing *In re Knapp Monarch Co.,* 296 F.2d 230, 132 USPQ 6 (CCPA 1961))."

The Patent Owner has not been provided with prior art for claim 24 that may be analyzed to determine the actual teaching in that prior art, and motivation to combine. The Examiner is taking the position that the existence of the limitations of claim 24 in the prior art is "capable of instant and unquestionable demonstration." The reasoning of "would have been obvious to a person of ordinary skill in the art at the time" to establish a fact as to the state of the prior art

more than thirty (30) years ago is highly questionable. Under 37 C.F.R. § 1.104 (d) (2), "When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons." Accordingly, if this is the basis for the rejection, the Patent Owner hereby requests either prior art reference(s) or an Examiner affidavit in support of the requirements of claim 24.

If the Examiner is contending that the limitation is not entitled to be given patentable weight because the results which the invention is achieving are somehow nonfunctional, then the Examiner is making a "printed matter" rejection as noted above with respect to the instant claim. In that case, as noted above, the claim is clear to its objective which is the order includes a shopping list, a clearly recited function produced by the preceding steps of the claim. Unless the Examiner can provide proper clarification of the rejection which meets the clear requirements of M.P.E.P. respecting such a rejection, the Patent Owner respectfully requests withdrawal of the 35 U.S.C. 103 rejection of claim 24.

Regarding claim 25, the Patent Owner fundamentally disagrees with the Examiner's conclusions when invoking the *Bristol-Myers Squibb Co.* case. The Patent Owner maintains their position using the discussion about preamble limitations in claim 22 above.

Regarding claim 26, the Examiner states that in Lockwood "the central processor 30 is able to store and subsequently retrieve data from the on-line mass storage module 31 on command" and "a second source of data is provided by a mass storage unit 28." (See Office

Action, page 15.) Lockwood's central processor 30, non-volatile read only memory 31, and on-line mass storage unit 28 are all resident at the self-service terminal (see Lockwood 4:48-56, 6:56-61, 6:65-7:3, 3:17-25, Fig. 8). Lockwood has mislabeled "the on-line mass storage module 31" at col. 6, ll. 60-61, because the on-line mass storage is 28 and the read only memory is 31. The central processor is **never** able to store information in the read only memory 31 because this memory is "read only."

Lockwood states, "A second source of data is provided by a mass storage unit 28 which contains information of a more transitory nature such as flight schedules to various destinations, ticket prices, weather information, snow conditions at various skiing resorts, hotel occupancy status and other information useful in the planning of a business trip or vacation. This information is periodically updated via a communication link 24 with a remote control center." (See Lockwood, 3:17-25.) None of the information listed is a "computer program" as required by the claims and as would be understood by a POSITA in 1981. All of the information listed is data, and data is not a computer program. The claimed "receiving, at said receiver station, **a computer program** transmitted from a transmitter station under the control of the transmitter station" (emphasis added) is neither shown nor suggested by the Examiner's citations.

As discussed above with respect to claim 22, the PTAB has already determined that that data, commands, and messages are not instructions, and do not obviate instructions. Accordingly, Lockwood's transitory data cannot be instructions; therefore, Lockwood fails to show or suggest the claimed "receiving, at said receiver station, said second computer program transmitted from said transmitter station."

Regarding claim 27, the Examiner states with regards to Lockwood, "The application program is derived from the on-line mass storage 28." The on-line mass storage 28 is part of the self-service terminal, and is therefore neither the claimed "transmitter station" nor "remote station." Storing an application program at the receiver station has no bearing on the claim. Next, the Examiner cites Lockwood's transitory data (e.g., flight schedules, weather,hotel occupancy) as support for the claim. However, as discussed above with regards to claim 22, data is not an instruction. The claim requires "receiving, at said receiver station, **a computer program** transmitted from a transmitter station" (emphasis added). Again, receiving data does not obviate receiving a computer program. Then, the Examiner states, "the computer programs of Lockwood can be received at a receiver station via transmission using a telephone connection as in Sedman." (See Office Action, pg. 16.) These citations used for support are completely silent as to information about the stations that transmit to or receive from a receiver station. There is no teaching or suggestion that the stations are different remote stations. Claim 27 is patentable over Lockwood and Sedman.

Regarding claims 64 and 69, the Examiner states, "Lockwood discloses **the step of receiving includes receiving said data** (Figs. 9-11; col. 7, 11. 1-3 - menu text item is considered data)." (See Office Action, pg. 8, emphasis in the original.) As best as the Patent Owner can understand, the Examiner believes the listing of the menu in the application program includes text, and the text is the claimed "data." However, in the patent claims 17 and 22, the Examiner has failed to obviate the claimed "executing with said processor at said receiver station, **under the control of the transmitter station**, said computer program" (emphasis added). The program in Lockwood is run as a standalone program at the self-service terminal with periodic

communication of data to a remote station. The addition of Sedman does not make up for what is missing in Lockwood.

With regards to claims 65 and 70, these claims require antecedent basis for "said data" back to claims 64 and 69, respectively. The Examiner indicated the "menu text" in Lockwood was the "data" in claims 64 and 69. Lockwood states, "The application program is of a 'menu-type' and can be best understood by reference to the flow diagrams of FIGS. 9, 10 and 11. In order to illustrate the capabilities of the terminal, the operational program will be discussed in connection with five operations: the display of travel documentaries, the display of flight schedules, securing reservations on a particular flight, the issuance of a flight ticket, and the control of the vending machine." (See Lockwood, 7:1-9.) The selection of the five (5) operations in Figs. 9, 10, and 11 is never stated in Lockwood to change. Furthermore, even if this menu text were to change, Lockwood is silent as to this menu text being separated from the computer program in which it resides. Accordingly, a new computer program would be transmitted with the new menu text, which does not obviate the claimed "said data is received at said receiver station in a different transmission than said computer program."

Furthermore, contrary to the Examiner's statement, the "wherein clause" of claims 65 and 70 does not merely express the intended result. The claims require the "receiving" step to receive a plurality of transmissions, which modifies the parent claim's requirement of receiving. However, to move prosecution forward, claims 65 and 70 have been amended to recite a new receiving step. Each receiving step is separately required. Claims 65 and 70 are patentable over Lockwood and Sedman.

E. Rejection of Claims 62 and 71 under pre-AIA 35 U.S.C. § 103(a) over Lockwood, Sedman, and Block

Regarding claims 62 and 71, the claims require the step of receiving to rely on a tuner. The parent claim requires, "receiving, at said receiver station, a computer program transmitted from a transmitter station under the control of the transmitter station." Block discloses "[a] scrambled television program signal containing a block of television program material, a program identification code unique to the block of program material, and a program category code, is broadcast." (See Block, Abstract.) A program identification code and a program category code are data. As argued in claims 17 and 22, data is not a computer program. Accordingly, combining Block with Lockwood fails to obviate a transmission of a computer program.

The Examiner also includes Sedman, but several issues prevent Sedman from making up what is missing from the combination of Lockwood and Block. First, the Examiner combined Lockwood and Sedman because they both use a telephone connection for transmission. (See Office Action, pg. 6.) However, the transmission in Block uses broadcast TV. The Examiner has not shown any motivation to combine a broadcast TV patent with a telephone modem patent because the characteristics of each type of transmission are very different. Second, *arguendo*, transmitting a computer program using Sedman's MicroCobol over a broadcast TV signal as in Block still does not obviate "executing with said processor at said receiver station, **under the control of the transmitter station**, said computer program" as required by the parent claims. Block is silent as to transmitting a computer program and Sedman discloses a menu system to imitate a computer program, which fails the claimed "under the control of the transmitter station." Third, the Examiner uses the *Bristol-Myers Squibb Co.* case for the premise that the

"wherein clause" is a recitation of intended use. As argued above in claims 17 and 22, the *Bristol-Myers Squibb Co.* case is concerned with preamble limitations, which is not a fact in the instant claims. Under M.P.E.P. § 2143.03, all claim limitations must be considered. Under M.P.E.P. § 2111.04, the claim language should require the limitations to be performed. In claims 62 and 71, the "wherein clause" requires the receiving to rely on the tuner, and is not optional. Furthermore, the "wherein clause" is not an intended result because no result is stated. The "wherein clause" requires that when the receiving step occurs, a tuner must be used for the receiving. Dependent claims 62 and 71 modify the method step's operation by positively reciting what must be involved to perform that step. Claims 62 and 71 are patentable over Lockwood, Sedman, and Block.

F. Rejection of Claims 63 and 72 under pre-AIA 35 U.S.C. § 103(a) over Lockwood, Sedman, Block, and Lightner

Regarding claims 63 and 72, the claims require the step of receiving to rely on a tuner of microwave frequencies. The parent claim requires, "receiving, at said receiver station, a computer program transmitted from a transmitter station under the control of the transmitter station." Block discloses "[a] scrambled television program signal containing a block of television program material, a program identification code unique to the block of program material, and a program category code, is broadcast." (See Block, Abstract.) A program identification code and a program category code are data. As argued in claims 17 and 22, data is

not a computer program. Accordingly, combining Block with Lockwood fails to obviate a transmission of a computer program.

The Examiner also includes Sedman, but several issues prevent Sedman from making up what is missing from the combination of Lockwood and Block. First, the Examiner combined Lockwood and Sedman because they both use a telephone connection for transmission. (See Office Action, pg. 6.) However, the transmission in Block uses broadcast TV. The Examiner has not shown any motivation to combine a broadcast TV patent with a telephone modem patent because the characteristics of each type of transmission are very different. Second, *arguendo*, transmitting a computer program using Sedman's MicroCobol over a broadcast TV signal as in Block still does not obviate "executing with said processor at said receiver station, **under the control of the transmitter station**, said computer program" as required by the parent claims. Block is silent as to transmitting a computer program and Sedman discloses a menu system to imitate a computer program, which fails the claimed "under the control of the transmitter station."

Then, the Examiner combines Lightner with Lockwood, Sedman, and Block. Lightner does not transmit digital information because the entire patent is concerned with transmission of analog audio recordings. Furthermore, Lightner does not have a processor at a receiver station that can execute a computer program. Also, the Examiner has not explained the motivation to combine Lightner's alternative transmission system that supports analog audio with either digital telephone or digital broadcast TV patents. Lightner discloses microwave transmissions, but the Patent Owner cannot understand why a POSITA would look to an analog audio transmission patent to support digital telesoftware, which by definition requires a telephone modem connection. Claims 63 and 72 are patentable over Lockwood, Sedman, Block, and Lightner.

G. Support for Claim Changes

Support for the claims can be found at least in the Patent Owner's Statement filed December 7, 2018, and in the claim support in the instant Response. Claims 23, 39, 65, and 70 have been amended to add a method step based on the Examiner's rejections, but these claims continue to use the same specification support. The phrase "geographically remote," which was added by amendment in the instant reexamination, has been amended to simply recite "remote" to describe a distance between stations in claims 48, 61, and 68.

The amended and new claims do not enlarge the claim scope of U.S. Patent 8,566,868 B1. Patent Owner believes the claims as amended here are patentable, and respectfully requests the Examiner's review and confirmation of claims 17-27, 38-43, and 48-72 at his earliest possible convenience.

Please debit Deposit Account 50-4494 for all related fees concerning this Response to Office Action.

Respectfully submitted,

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Notice of Intent to Issue Ex Parte Reexamination Certificate	Control No. 90/014,223	Patent Under Reexamination 8566868	
	Examiner JALATEE WORJLOH	Art Unit 3992	AIA Status No

-- 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: 22 February 2019.
   (b) ☐ Patent owner's failure to file an appropriate timely response to the Office action mailed: _____.
   (c) ☐ Patent owner's failure to timely file an Appeal Brief (37 CFR 41.31).
   (d) ☐ The decision on appeal by the ☐ Board of Patent Appeals and Interferences ☐ Court dated _____
   (e) ☐ Other: _____.
2. The Reexamination Certificate will indicate the following:
   (a) Change in the Specification: ☐ Yes ☑ No
   (b) Change in the Drawing(s): ☐ Yes ☑ No
   (c) Status of the Claim(s):
      (1) Patent claim(s) confirmed: 17-22 and 27.
      (2) Patent claim(s) amended (including dependent on amended claim(s)): 23-26 and 38-43
      (3) Patent claim(s) canceled: _____.
      (4) Newly presented claim(s) patentable: 48-72.
      (5) Newly presented canceled claims: _____.
      (6) Patent claim(s) ☐ previously ☐ currently disclaimed: _____
      (7) Patent claim(s) not subject to reexamination: 1-16,28-37 and 44-47.
3. ☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.
4. ☑ 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."
5. ☐ Note attached NOTICE OF REFERENCES CITED (PTO-892).
6. ☐ Note attached LIST OF REFERENCES CITED (PTO/SB/08 or PTO/SB/08 substitute).
7. ☐ The drawing correction request filed on _____ is: ☐approved ☐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
   ☐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: _____.
9. ☐ Note attached Examiner's Amendment.
10. ☐ Note attached Interview Summary (PTO-474).
11. ☐ Other: _____.

All correspondence relating to this reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

/JALATEE WORJLOH/ Primary Examiner, Art Unit 3992	

cc: Requester (if third party requester)

DETAILED ACTION

This Office action terminates the prosecution of *ex parte* reexamination of U.S. Patent No. 8,566,868 to Harvey et al. ("Harvey").

Claims 17-27, 38-43, and 48-72 were subject to reexamination.

Applicant's arguments, see pages 12-34, filed February 22, 2019, with respect to claims 38-61, 65-68, and 70 have been fully considered and are persuasive. The 35 U. S.C. 112, second paragraph of these claims has been withdrawn.

Information Disclosure Statement

Regarding IDS submissions MPEP 2256 recites the following: "Where patents, publications, and other such items of information are submitted by a party (patent owner or requester) in compliance with the requirements of the rules, the requisite degree of consideration to be given to such information will be normally limited by the degree to which the party filing the information citation has explained the content and relevance of the information." Accordingly, the IDS submissions have been considered by the Examiner only with the scope required by MPEP 2256.

STATEMENT OF REASONS FOR PATENTABILITY AND/OR CONFIRMATION

Claims 17-22 and 27 are confirmed. Claims 23-26, 38-43, and 48-72 are deemed patentable.

The following is an examiner's statement of reasons for patentability and/or confirmation of the claims found patentable in this reexamination proceeding:

Lockwood discloses operating program of a central processor is stored in a non-volatile read only memory. The memory contains the programmed code numbers necessary to direct the computer or microcomputer to perform the various functions of the terminal. Intermediate results, variable, etc., required by the operating program reside in the read/write memory. Col. 4, ll. 44-54. Lockwood also describes a user beginning a reservation by entering information. Fig. 10, col. 7, l. 62-col. 8, l. 6. Sedman discusses using telephone network to distribute software programs. p. 400. The reference states that users select programs via a menu selection process. p. 404. Thus, the references fail to teach executing with a processor at said receiver station, under the control of the transmitter station, said computer program, by processing data, to output advertising at said receiver station as recited in independent claim 17; executing with said processor at said receiver station, under the control of the transmitter station, said computer program, by processing data, to communicate an order for a product or service from said receiver to a remote station as recited in independent claim 22 and executing said computer program using said instruction based processor at said receiver station, which enables said receiver station, in operation, to communicate an order for an a product or a service to a remote station that is remote from said receiver station, said order for said product or said service based on said decrypted digital data in independent claim 38.

Any comments considered necessary by 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.

All correspondence relating to this ex parte reexamination proceeding should be directed:

By Mail to:

Mail Stop *Ex Parte* Reexam
Central Reexamination Unit
Commissioner of Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX to:

(571) 273-9900
Central Reexamination Unit

By Hand:

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Registered users of EFS-Web may alternatively submit such correspondence via the electronic filing system EFS-Web, at
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EFS-Web offers the benefit of quick submission to the particular area of the Office that needs to act on the correspondence. Also, EFS-Web submissions are "soft scanned" (i.e., electronically uploaded) directly into the official file for the reexamination proceeding, which offers parties the opportunity to review the content of their submissions after the "soft scanning" process is complete.

/Jalatee Worjloh/
Primary Examiner, Art Unit 3992

Conferees:

/C.S/
Primary Examiner, Art Unit 3992

/HETUL B PATEL/
Supervisory Patent Examiner, Art Unit 3992