IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	ADC Technology, Inc.
Patent Number:	6,193,520
Filed:	Jul 2, 1998
Issued:	Feb 27, 2001
Reexam Cntrl No.	**90/009,524**
Title:	Interactive Communication System For Communicating Video Game and Karaoke Software

RESPONSE TO NOTICE OF INCOMPLETE EX PARTE REEXAM REQUEST

Mail Stop *Ex Parte* Re-Exam
Central Reexamination Unit
Commissioner for Patents, USPTO
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Patent Office issued a Notice of Incomplete Ex Parte Reexamination Request on July 17, 2009 in the above-identified matter. In that Notice, the Patent Office indicated that the requestor/patent owner (hereafter "ADC") did not include a Statement of Substantial New Question of Patentability ("SNQ") as required by 37 CFR 1.510(b)(1) for each reference.

In response to that Notice, ADC hereby submits this paper including the previously-omitted SNQs. ADC believes that this paper is a complete response to the pending Notice. If the Patent Office has any questions, or if there are any informalities that may be addressed by telephone, the Office is invited to contact ADC's representative at the contact information provided below.

ADC would further point out that this Request for Reexamination is being submitted in conjunction with Requests for Reexamination of other patents that are closely related to the

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I hereby certify that I deposited this paper with the United States Postal Service on the date indicated below addressed to the United States Patent and Trademark Office at the address given above.

Express Mail Label Number: **EH 678716214 US**
Date: **August 17, 2009**

John Whitaker

above-identified patent. The control numbers for all of the pending Requests, including this one, are: 90/009,520; 90/009,521; 90/009,522; 90/009,523; 90/009,524.

One reference is being omitted from consideration by this response to the outstanding Notice. Accordingly, a new form SB08 with only the references being considered is being presented with this paper.

Statement Pursuant to 37 CFR 1.510(b)(1)

1. SNQ Presented by *Kato* (JP 2-113463)

There is a substantial new question of patentability whether claims 1, 2, 4, 5, 7, 8, 9, 11, 12, and 14 are anticipated by the *Kato* reference. The *Kato* reference is not of record in the file of U.S. Patent 6,193,520, although the Patent Owner cannot be sure if the Examiner reviewed the *Kato* reference during the Patent Office's original prosecution without citing it.

The *Kato* reference teaches, such as at page 2, lines 5-10 and page 6, lines 9-24, an online software "vending machine" that allows for the rental of various software programs. The rental is offered, for example, on a rent-by-the-hour basis. See *Kato* at page 3. The teaching of a system that enables the renting, rather than purchasing, of software via communications lines is a new, non-cumulative technological teaching that was not considered by the Examiner during the prosecution of the above-identified patent. An Examiner could have reasonably concluded that the *Kato* reference was important in determining patentability.

A detailed claim chart applying the *Kato* reference to the subject claims was previously provided as Exhibit A of the originally filed Request for Reexamination. ADC believes that the detailed claim chart set forth in Exhibit A satisfies the requirement that the patent owner must (a) show how at least one reference teaches or suggests each limitation of the subject claims. *See* Instructions to PTOL 2077 Notice of Failure to Comply at page 3, final paragraph.

2. SNQ Presented by *Tsumura* (US 5,547,202)

There is a substantial new question of patentability whether claims 1, 5, 7, 8, 12, 14, 15, 19, and 21 are anticipated by the *Tsumura* reference. The *Tsumura* reference is not of record in the file of U.S. Patent 6,193,520, although the Patent Owner cannot be sure if the Examiner reviewed the *Tsumura* reference during the Patent Office's original prosecution without citing it.

The *Tsumura* reference discloses, such as at col. 5, lines 3-17, system through which game data is transferred from a transmission device to a receiving device. The game data is identified by a number corresponding to a number input from a control panel. The game data may be

played with the help of a data processing device. The Tsumura reference further teaches the use of "interrupt processing" to interrupt game play. Col. 6, line 54. The teaching of a system that enables the retrieval and execution of game data, including "interrupt processing" is a new, non-cumulative technological teaching that was not considered by the Examiner during the prosecution of the above-identified patent. An Examiner could have reasonably concluded that the *Tsumura* reference was important in determining patentability.

A detailed claim chart applying the *Tsumura* reference to the subject claims was previously provided as Exhibit B of the originally filed Request for Reexamination. ADC believes that the detailed claim chart set forth in Exhibit B satisfies the requirement that the patent owner must (a) show how at least one reference teaches or suggests each limitation of the subject claims. *See* Instructions to PTOL 2077 Notice of Failure to Comply at page 3, final paragraph.

3. *Oseki* (JP 4-158441)

Please withdraw the *Oseki* reference from consideration for this Request for Reexamination. The *Oseki* reference was of record in the prosecution of the above-identified patent.

4. SNQ Presented by *Kaniwa* (US 5,699,370)

There is a substantial new question of patentability whether claims 1, 5, 7, 8, 12, and 14 are anticipated by the *Kaniwa* reference. The *Kaniwa* reference is not of record in the file of U.S. Patent 6,193,520, although the Patent Owner cannot be sure if the Examiner reviewed the *Kaniwa* reference during the Patent Office's original prosecution without citing it.

The *Kaniwa* reference teaches, such as at col. 3, lines 51-64, the use of a system for renting software (col. 2, line 23) that is capable of including a "deadline signal" into information that is recorded to indicate a deadline at which the output of a main information signal is "cut off" (col. 5, lines 35-46). The teaching of a system that enables the embedding of a "deadline signal" into information for the purpose of cutting off execution is a new, non-cumulative technological teaching that was not considered by the Examiner during the prosecution of the above-identified patent. An Examiner could have reasonably concluded that the *Kaniwa* reference was important in determining patentability.

A detailed claim chart applying the *Kaniwa* reference to the subject claims was previously provided as Exhibit D of the originally filed Request for Reexamination. ADC believes that the detailed claim chart set forth in Exhibit D satisfies the requirement that the patent owner

must (a) show how at least one reference teaches or suggests each limitation of the subject claims. *See* Instructions to PTOL 2077 Notice of Failure to Comply at page 3, final paragraph.

5. SNQ Presented by *Chernow* (US 4,999,806)

There is a substantial new question of patentability whether claims 8, 11, 12, and 14 are anticipated by the *Chernow* reference. The *Chernow* reference is not of record in the file of U.S. Patent 6,193,520, although the Patent Owner cannot be sure if the Examiner reviewed the *Chernow* reference during the Patent Office's original prosecution without citing it.

The *Chernow* reference teaches, such as at col. 2, lines 21-36, a system that enables the leasing of software. The system includes techniques that protect the transmitted software from being proliferated. In addition, the *Chernow* reference teaches a debit of a user's financial account (e.g., a credit card) and other payment information. Col. 2, lines 50-53. The teaching of a system that enables the debit of a user's credit card account for the leasing of software is a new, non-cumulative technological teaching that was not considered by the Examiner during the prosecution of the above-identified patent. An Examiner could have reasonably concluded that the *Chernow* reference was important in determining patentability.

A detailed claim chart applying the *Chernow* reference to the subject claims was previously provided as Exhibit E of the originally filed Request for Reexamination. ADC believes that the detailed claim chart set forth in Exhibit E satisfies the requirement that the patent owner must (a) show how at least one reference teaches or suggests each limitation of the subject claims. *See* Instructions to PTOL 2077 Notice of Failure to Comply at page 3, final paragraph.

6. SNQ Presented by *Nakagawa* (US 4,922,420)

There is a substantial new question of patentability whether claims 8, 9, 12, and 14 are anticipated by the *Nakagawa* reference. The *Nakagawa* reference is not of record in the file of U.S. Patent 6,193,520, although the Patent Owner cannot be sure if the Examiner reviewed the *Nakagawa* reference during the Patent Office's original prosecution without citing it.

The *Nakagawa* reference teaches, such as at col. 2, lines 3-55, a game software service system that enables the use of a controller to select one game from a menu of games (col. 2, lines 3-8) so that the system can select from a plurality of game programs without interchange of storage mediums. In addition, the system includes a mechanism for varying the level of luminance of the game image on the screen when the residual time for playing a game becomes short (col. 2, lines 34-38). The teaching of a system that combines both the selection of a particular game

from a game menu and that alters the display characteristics of a playing game based on time is a new, non-cumulative technological teaching that was not considered by the Examiner during the prosecution of the above-identified patent. An Examiner could have reasonably concluded that the *Nakagawa* reference was important in determining patentability.

A detailed claim chart applying the *Nakagawa* reference to the subject claims was previously provided as Exhibit F of the originally filed Request for Reexamination. ADC believes that the detailed claim chart set forth in Exhibit F satisfies the requirement that the patent owner must (a) show how at least one reference teaches or suggests each limitation of the subject claims. *See* Instructions to PTOL 2077 Notice of Failure to Comply at page 3, final paragraph.

7. SNQ Presented by *Hornbuckle* (US 5,497,479)

There is a substantial new question of patentability whether claims 1, 5, 8, and 11 are anticipated by the *Hornbuckle* reference. The *Hornbuckle* reference is not of record in the file of U.S. Patent 6,193,520, although the Patent Owner cannot be sure if the Examiner reviewed the *Hornbuckle* reference during the Patent Office's original prosecution without citing it.

The *Hornbuckle* reference teaches, such as at col. 2, line 55 to col. 3, line 12, a system for renting computer software, such as video game software. The system records the actual time the program is being used, and protects the program from theft, copying, vandalism, or modification. The teaching of a video game rental system that combines both the protection of executing the program on other than the downloading receiving device, and the recording of the time the game is being used is a new, non-cumulative technological teaching that was not considered by the Examiner during the prosecution of the above-identified patent. An Examiner could have reasonably concluded that the *Hornbuckle* reference was important in determining patentability.

A detailed claim chart applying the *Hornbuckle* reference to the subject claims was previously provided as Exhibit G of the originally filed Request for Reexamination. ADC believes that the detailed claim chart set forth in Exhibit G satisfies the requirement that the patent owner must (a) show how at least one reference teaches or suggests each limitation of the subject claims. *See* Instructions to PTOL 2077 Notice of Failure to Comply at page 3, final paragraph.

8. SNQ Presented by *Bakoglu* (US 5,632,681)

There is a substantial new question of patentability whether claims 8, 9, 12 and 14 are anticipated by the *Bakoglu* reference. The *Bakoglu* reference is not of record in the file of U.S. Pat-

ent 6,193,520, although the Patent Owner cannot be sure if the Examiner reviewed the *Bakoglu* reference during the Patent Office's original prosecution without citing it.

The *Bakoglu* reference teaches, such as at col. 1, lines 59-67, a system for renting video game software for a pre-determined number of video frames. The system also protects the program from piracy. The teaching of a video game rental system that combines both the protection of executing the program on other than the downloading receiving device, and the limiting of game play to a predetermined number of video frames is a new, non-cumulative technological teaching that was not considered by the Examiner during the prosecution of the above-identified patent. An Examiner could have reasonably concluded that the *Bakoglu* reference was important in determining patentability.

A detailed claim chart applying the *Bakoglu* reference to the subject claims was previously provided as Exhibit H of the originally filed Request for Reexamination. ADC believes that the detailed claim chart set forth in Exhibit H satisfies the requirement that the patent owner must (a) show how at least one reference teaches or suggests each limitation of the subject claims. *See* Instructions to PTOL 2077 Notice of Failure to Comply at page 3, final paragraph.

CONCLUSION

It is believed that the forgoing corrects the deficiencies noted in the pending Notice of Incomplete Ex Parte Reexamination Request. Accordingly, ADC respectfully requests reexamination of claims 1, 2, 4, 5, 7, 8, 9, 11, 12, 14, 15, 19, and 21 of U.S. Patent 6,193,520.

Respectfully submitted,

Dated August 17, 2009

By: _____

John Whitaker
Reg. No. 42,222
(206) 319-1575