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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	

ART UNIT	PAPER NUMBER

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

Order Granting / Denying Request For Ex Parte Reexamination	Control No. 90/009,524	Patent Under Reexamination 6193520	
	Examiner William H. Wood	Art Unit 3992	

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

The request for *ex parte* reexamination filed *17 August 2009* has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a)☐ PTO-892, b)☒ PTO/SB/08, c)☐ Other: _____

1. ☒ The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. ☐ The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 (c) will be made to requester:

a) ☐ by Treasury check or,

b) ☐ by credit to Deposit Account No. _____, or

c) ☐ by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

/William H. Wood/ Primary Examiner, Art Unit 3992	/Sam Rimell/ Primary Examiner, Art Unit 3992	

cc:Requester (if third party requester)

DECISION ON REQUEST FOR REEXAMINATION

Reexamination (*Ex Parte*) has been requested by a patent owner for claims 1, 2, 4, 5, 7, 8, 9, 11, 12, 14, 15, 19 and 21 of U.S. Patent 6,193,520 to Okamoto (herein *Okamoto*) which issued on 02/27/2001.

A substantial new question of patentability affecting claims 1, 2, 4, 5, 7, 8, 9, 11, 12, 14, 15, 19 and 21 of U.S. Patent 6,193,520 to Okamoto is raised by the request for *Ex Parte* reexamination filed 08/17/2009.

Request Established References

The request argues the following patents and/or printed publications provide teachings relevant to the patent claims requested for reexamination:

a) Kato (JP 2-113463), laid-open 01/14/1992. (herein *Kato*)

b) Tsumura (USPN 5,547,202), issued 08/20/1996, filed 12/30/1994. (herein *Tsumura*)

c) Kaniwa (USPN 5,699,370), issued 12/16/1997, filed 02/17/1995. (herein *Kaniwa*)

d) Chernow et al. (USPN 4,999,806), issued 03/12/1991, filed 09/04/1987 (herein *Chernow*)

e) Nakagawa et al. (USPN 4,922,420), issued 05/01/1990, filed 07/23/1987. (herein *Nakagawa*)

f) Hornbuckle (USPN 5,497,479), issued 03/05/1996, filed 02/28/1995. (herein *Hornbuckle*)

g) Bakoglu (USPN 5,632,681), issued 05/27/1997, filed 03/07/1995. (herein *Bakoglu*)

Prosecution History Summary

The Okamoto patent (U.S. Patent 6,193,520) issued from U.S. Application 09/109,784 which was filed on filed 07/02/1998 as a continuation in part of U.S. Application 08/642,560 (now U.S. Patent 5,775,995) filed 05/03/1996 as a division of U.S. Application 08/555,400 (now U.S. Patent 5,735,744) filed 11/09/1995 as a continuation in part of U.S. Application 08/232,862 (now U.S. Patent 5,489,103) filed 04/25/1994 and which claims foreign priority to 5-108303 filed 05/10/1993. The following is a summary of relevant portions of the prosecution history of application 09/109,784.

The following summary is primarily focused on the claims relevant to the reexamination request.

Issued claim 1 is representative:

> A communication system for transmitting at least one of the program, the data, and a combination of the program and data from a host facility to a communication terminal device, said communication terminal device comprising:
> an input device for inputting instructions to execute the program or to process the data,
> receiving means for receiving one of the program, the data, and a combination of the program and data as sent out from said host facility,
> storage means for storing the program, the data, or a combination of the program and data received by said receiving means,

executing means for executing the program stored in said storage means or executing data processing by using the data stored in said storage means, in accordance with instructions from said input device,

clock means for keeping a predetermined time period after said receiving means receives the transmission, and interference means for interfering with execution of said executing means when said clock means counts said predetermined time period; and

said host facility comprising:

storage means for storing at least one of the program, the data, and a combination of the program and data together with the duration data indicative of the predetermined time period to be counted by said clock means, and

sending out means for sending out at least one of the program, the data, and a combination of the program and data together with the duration data stored in said storage means to said communication terminal device.

The subject matter of the patent under reexamination (*Okamoto* 6,193,520) claims 1, 2, 4, 5, 7, 8, 9, 11, 12, 14, 15, 19 and 21 is given priority back to the Japanese patent application 05-108303 with a critical date of May 10, 1993 (05/10/1993).

Prosecution of 6,193,520 (09/109,784). Non-Final Office Action (05/09/2000): rejected some application claims under doctrine of double patenting over claims 1-3 of patent 5,775,995; and objected to some application claims as being allowable if rewritten in independent form. A Terminal Disclaimer was filed 08/04/2000. Notice of Allowance (08/25/2000) allowed all the application claims.

Prosecution of 5,775,995 (08/642,560). Non-Final Office Action (02/26/1997) rejected the claims under 35 U.S.C. 112 and the doctrine of double patenting over claims 1-20 of copending Application 08/555,400. A Terminal Disclaimer was filed. Notice of Allowance (01/26/1998) allowed the three pending claims.

Prosecution of 5,735,744 (08/555,400). Non-Final Office Action (04/04/1997) rejected the claims under 35 U.S.C. 112. Notice of Allowance (10/30/1997) allowed the three pending claims.

Prosecution of 5,489,103 (08/232,862). Non-Final Office Action (03/31/1995): rejected some of the claims under 35 U.S.C. 102(a) as being anticipated by *Teshima* (USPN 5,273,288); rejected some of the claims under 35 U.S.C. 102(b) as being anticipated by *Pearson* (USPN 5,018,726); and rejected some of the claims under 35 U.S.C. 103(a) as being unpatentable over *Teshima* or *Pearson*, either one taken in combination with *Tsumura* (USPN 5,250,747). Applicant's Response (06/22/1995): cancelled the pending claims and added new pending claims, including a limitation to a "charging means"; argued the claims recite a terminal device connected via communication lines to a host facility so that game data is transmitted from the host facility; argued the claims recite game data being deleted in a predetermined time after the game data was transmitted from the host facility to the terminal device; argued *Teshima* disclosed game terminals communicating; argued in *Pearson* game data collected at a central controller; and argued *Tsumura* does not disclose deletion of data in a predetermined time period after the data was received from the host computer. Notice of Allowance (08/16/1995) allowed newly added pending claims.

Substantial New Question of the Request

The requester asserts a substantial new question of patentability with respect to issued claims 1, 2, 4, 5, 7, 8, 9, 11, 12, 14, 15, 19 and 21 of U.S. Patent 6,193,520 (*Okamoto*).

Since Requester did not request reexamination of claims 3, 6, 10, 13, 16-18 and 20 and did not assert the existence of a substantial new question of patentability (SNQ) for such claims (see 35 U.S.C. § 311 (b)(2); see also 37 CFR 1.915b and 1.923), such claims will not be reexamined. This matter was squarely addressed in *Sony Computer Entertainment America Inc., et al. v. Jon W. Dudas*, Civil Action No. 1:05CV1447 (E.D. Va. May 22, 2006), Slip Copy, 2006 WL 1472462. The District Court upheld the Office's discretion to not reexamine claims in an *inter partes* reexamination proceeding other than those claims for which reexamination had specifically been requested. The Court stated:

> "To be sure, a party may seek, and the PTO may grant, ... review of each and every claim of a patent. Moreover, while the PTO in its discretion may review claims for which ..... review was not requested, nothing in the statute compels it to do so. To ensure that the PTO considers a claim for ..... review, § 311 (b)(2) requires that the party seeking reexamination demonstrate why the PTO should reexamine each and every claim for which it seeks review. Here, it is undisputed that Sony did not seek review of every claim under the '213 and '333 patents. Accordingly, Sony cannot now claim that the PTO wrongly failed to reexamine claims for which Sony never requested review, and its argument that AIPA compels a contrary result is unpersuasive."

Only claims 1, 2, 4, 5, 7, 8, 9, 11, 12, 14, 15, 19 and 21 have been evaluated for this issue and only as the SNQ's specify (addressed in the below analysis of the prior art).

Note MPEP 2243, which states:

> "The Office's determination in both the order for reexamination and the examination stage of the reexamination will generally be limited solely to a review of the claim(s) for which reexamination was requested. If the requester was interested in having all of the claims reexamined, requester had the opportunity to include them in its request for reexamination. However, if the requester chose not to do so, those claim(s) for which reexamination was not requested will generally not be reexamined by the Office. It is further noted that 35 U.S.C. 302 requires that "[t]he request must set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested." If the requester fails to apply the art to certain claims, then the requester is not statutorily entitled to reexamination of such claims."

Following is a discussion of the proposed prior art:

Kato

Kato (JP 2-113463) is new prior art. The requester asserts (Request: page 2) *Kato* discloses: an online software "vending machine" for rent-by-the-hour basis of software from developer to user (*Kato*: page 2, lines 5-10 and page 6, lines 9-24).

These disclosures constitute teachings pertinent to claim limitations: "transmitting at least one of the program, the data, and a combination of the program and data stored in a database provided in a distribution center to a requested communication terminal device via communication lines"; "storing the transmitted program, the data, and the combination of the program data in a memory provided in the communication terminal device"; "enabling execution of the program or data processing according to the program, the data, and the combination of the program and data in the memory"; and "interfering with execution". As revealed in the above "Prosecution History Summary", these limitations were important to the allowance of *Okamoto* (USPN 6,193,520).

In light of these teachings, *Kato* is found to provide new prior art teachings that would be considered important to a reasonable examiner in evaluating the patentability of claims 1, 2, 4, 5, 7, 8, 9, 11, 12 and 14. These teachings were not previously considered in the record of U.S. Patent 6,193,520 and are not merely cumulative to prior art already considered by the Office. Accordingly, *Kato* (JP 2-113463) raises a substantial new question of patentability with respect to claims 1, 2, 4, 5, 7, 8, 9, 11, 12 and 14.

Tsumura

Tsumura (USPN 5,547,202) is new prior art. The requester asserts (Request: pages 2-3) *Tsumura* discloses: game data is transferred by a transmitting device to a receiving device (*Tsumura*: column 5, lines 3-17); and "interrupt processing" to interrupt game play (*Tsumura*: column 6, line 54).

These disclosures constitute teachings pertinent to claim limitations: a communication terminal receiving and storing a program transmitted from a host facility; communication terminal executing the program; communication terminal interface means that blocks based on a predetermined time period; and host facility sending the transmitted program and predetermined usage duration data. As revealed in the above "Prosecution History Summary", these limitations were important to the allowance of *Okamoto* (USPN 6,193,520).

In light of these teachings, *Tsumura* is found to provide new prior art teachings that would be considered important to a reasonable examiner in evaluating the

patentability of claims 1, 5, 7, 8, 12, 14, 15, 19 and 21. These teachings were not previously considered in the record of U.S. Patent 6,193,520 and are not merely cumulative to prior art already considered by the Office for the claims of U.S. Patent 6,193,520. Accordingly, *Tsumura* (USPN 5,547,202) raises a substantial new question of patentability with respect to claims 1, 5, 7, 8, 12, 14, 15, 19 and 21.

Kaniwa

Kaniwa (USPN 5,699,370) is new prior art. The requester asserts (Request: pages 3-4) *Kaniwa* discloses: a system for renting software (*Kaniwa*: column 2, line 23); 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" (*Kaniwa*: column 5, lines 35-46).

These disclosures constitute teachings pertinent to claim limitations: a communication terminal receiving and storing a program transmitted from a host facility; communication terminal executing the program; host facility sending the transmitted program and predetermined usage duration data; and "interfering with execution". As revealed in the above "Prosecution History Summary", these limitations were important to the allowance of *Okamoto* (USPN 6,193,520).

In light of these teachings, *Kaniwa* is found to provide new prior art teachings that would be considered important to a reasonable examiner in evaluating the patentability of claims 1, 5, 7, 8, 12 and 14. These teachings were not previously considered in the record of U.S. Patent 6,193,520 and are not merely cumulative to prior art already

considered by the Office for the claims of U.S. Patent 6,193,520. Accordingly, *Kaniwa* (USPN 5,699,370) raises a substantial new question of patentability with respect to claims 1, 5, 7, 8, 12 and 14.

Chernow

Chernow (USPN 4,999,806) is new prior art. The requester asserts (Request: page 4) *Chernow* discloses: leasing or selling programs/software (*Chernow*: column 2, lines 21-36); and electronic payment information coming from the purchaser (*Chernow*: column 2, lines 50-53). Further, *Chernow* discloses: transmitting and storing of the purchased program (*Chernow*: column 3, lines 9-28).

These disclosures constitute teachings pertinent to claim limitations: "transmitting at least one of the program, the data, and a combination of the program and data stored in a database provided in a distribution center to a requested communication terminal device via communication lines"; "storing the transmitted program, the data, and the combination of the program data in a memory provided in the communication terminal device"; "enabling execution of the program or data processing according to the program, the data, and the combination of the program and data in the memory"; and "charging device". As revealed in the above "Prosecution History Summary", these limitations were important to the allowance of *Okamoto* (USPN 6,193,520).

In light of these teachings, *Chernow* is found to provide new prior art teachings that would be considered important to a reasonable examiner in evaluating the patentability of claims 8, 11, 12 and 14. These teachings were not previously

considered in the record of U.S. Patent 6,193,520 and are not merely cumulative to prior art already considered by the Office. Accordingly, *Chernow* (USPN 4,999,806) raises a substantial new question of patentability with respect to claims 8, 11, 12 and 14.

Nakagawa

Nakagawa (USPN 4,922,420) is new prior art. The requester asserts (Request: pages 4-5) *Nakagawa* discloses: loading differing software/games without interchange of storage media (*Nakagawa*: column 2, lines 3-55); and controlling game usage based upon money and time (*Nakagawa*: column 2, lines 31-40). Further, *Nakagawa* discloses: the game system including a modem and an expansion I/O connector (*Nakagawa*: column 4, lines 18-21); money charging techniques (*Nakagawa*: column 10, lines 59-61); and transferring data (*Nakagawa*: column 7, lines 15-21; column 8, lines 64-68; figures 3B and 4B, step S19).

These disclosures constitute teachings pertinent to claim limitations: "transmitting at least one of the program, the data, and a combination of the program and data stored in a database provided in a distribution center to a requested communication terminal device via communication lines"; "storing the transmitted program, the data, and the combination of the program data in a memory provided in the communication terminal device"; "enabling execution of the program or data processing according to the program, the data, and the combination of the program and data in the memory"; and

"interfering with execution". As revealed in the above "Prosecution History Summary", these limitations were important to the allowance of *Okamoto* (USPN 6,193,520).

In light of these teachings, *Nakagawa* is found to provide new prior art teachings that would be considered important to a reasonable examiner in evaluating the patentability of claims 8, 9, 12 and 14. These teachings were not previously considered in the record of U.S. Patent 6,193,520 and are not merely cumulative to prior art already considered by the Office. Accordingly, *Nakagawa* (USPN 4,922,420) raises a substantial new question of patentability with respect to claims 8, 9, 12 and 14.

Hornbuckle

Hornbuckle (USPN 5,497,479) is new prior art. The requester asserts (Request: page 5) *Hornbuckle* discloses: a network of computers for settling electronic payments for product purchase (*Hornbuckle*: column 2, line 55 to column 3, line 12). Further, *Hornbuckle* discloses: the network of computers includes merchant computers and buyer computers for product purchase (*Hornbuckle*: column 3, lines 15-25); and a system for billing for software downloads and usage (*Hornbuckle*: abstract).

These disclosures constitute teachings pertinent to claim limitations: "transmitting at least one of the program, the data, and a combination of the program and data stored in a database provided in a distribution center to a requested communication terminal device via communication lines"; "storing the transmitted program, the data, and the combination of the program data in a memory provided in the communication terminal device"; "enabling execution of the program or data processing according to the

program, the data, and the combination of the program and data in the memory"; and "interfering with execution" for software product (software and/or data) usage. As revealed in the above "Prosecution History Summary", these limitations were important to the allowance of *Okamoto* (USPN 6,193,520).

In light of these teachings, *Hornbuckle* is found to provide new prior art teachings that would be considered important to a reasonable examiner in evaluating the patentability of claims 1, 5, 8 and 11. These teachings were not previously considered in the record of U.S. Patent 6,193,520 and are not merely cumulative to prior art already considered by the Office. Accordingly, *Hornbuckle* (USPN 5,497,479) raises a substantial new question of patentability with respect to claims 1, 5, 8 and 11.

Bakoglu

Bakoglu (USPN 5,632,681) is new prior art. The requester asserts (Request: pages 5-6) *Roskowski* discloses: a system for renting video game software for a pre-determined number of video frames and protecting programs from piracy (*Bakoglu*: column 1, lines 59-67).

However, *Bakoglu* fails to overcome *Okamoto*'s (USPN 6,193,520) priority date of 05/10/1993.

In light of these determinations, *Bakoglu* is not found to provide new prior art teachings that would be considered important to a reasonable examiner in evaluating the patentability of claims 8, 9, 12 and 14. Accordingly, *Bakoglu* (USPN 6,193,520)

does not raise a substantial new question of patentability with respect to claims 8, 9, 12 and 14.

Information Disclosure Statement

MPEP 2256 states in pertinent part,

> 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. The initials of the examiner placed adjacent to the citations on the form PTO/SB/08A and 08B or its equivalent, without an indication to the contrary in the record, do not signify that the information has been considered by the examiner any further than to the extent noted above. (emphasis added)

In concert with MPEP 2256, the references submitted in the Information Disclosure Statement (IDS) filed 08/17/2009 have been considered only to the extent that Requester has "explained the content and relevance".

Important Reexamination Notices

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

Service of Papers

After filing of a request for ex parte 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 parties where-two or more third party requester proceedings are merged) in the reexamination proceeding in the manner provided in 37 CFR 1.248. The document must reflect service or the document may be refused consideration by the Office. See 37 CFR 1.550(f).

Amendment To 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.

In order to ensure full consideration of any amendments, affidavits or declarations, or other documents as evidence of patentability, such documents must be submitted in response to the first Office Action on the merits (which does not result in a close of prosecution). Submissions after the second Office Action on the merits, which is intended to be a final action, will be governed by the requirements of 37 CFR 1.116, after final rejection and 37 CFR 41.33 after appeal, which will be strictly enforced. See MPEP 2250 (IV) for examples to assist in the preparation of proper proposed amendments in reexamination proceedings.

Litigation Reminder

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. 6,193,520 throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

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. 6,193,520 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

Correspondence Information

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

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

By FAX to: (571) 273-9900
Central Reexamination Unit

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

Any inquiry concerning this communication or earlier communications from the Reexamination Legal Advisor or Examiner, or as to the status of this proceeding should be directed to the Central Reexamination Unit at telephone number (571)272-7705.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained form either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR systems, see http://pair-direct.uspto.gov. For questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/William H. Wood/
Primary Examiner, Art Unit 3992
November 13, 2009

Conferees:

/Sam Rimell/
Primary Examiner, Art Unit 3992