

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U. S. Patent No. 6,193,520
Reexam Control No.: TBD

Currently in Litigation Styled: *ADC Technologies, Inc. v. Microsoft Corporation, et al.*, Case No. 2:08-CV-01579-RSM (W.D. Wash.)

Issued: February 27, 2001

Filed: July 2, 1998

Applicant: Takeya Okamoto

Title: Interactive Communication System for
Communicating Video Game and Karaoke Software

Request for *Ex Parte* Reexamination of U.S. Patent No. 6,193,520

MAIL STOP "EX PARTE REEXAMINATION"
ATTN: CENTRAL REEXAMINATION UNIT
COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

Sir:

Microsoft Corporation ("Requester") requests reexamination under 35 U.S.C. §§ 301-307 and 37 C.F.R. § 1.510 *et seq.* of Claims 1-2, 4-5, 7-9, 11-12, 14-16, 18-19 and 21 of U.S. Patent No. 6,193,520 ("the '520 patent" or "the patent"), a copy of which is attached as Exhibit 1. The '520 patent issued on February 27, 2001, to Takeya Okamoto, and is believed to be currently assigned to ADC Technology, Inc ("ADC"). This is a new reexamination request. ADC's '520 patent is currently the subject of another *ex parte* reexamination request, Control No. 90/009,524, which, according to PAIR, was filed by ADC on August 17, 2009 ("ADC's '520 Reexam Request"). Requester requests that its Request be granted, and that it be merged with ADC's '995 Reexam Request.

The '520 patent is also the subject of pending litigation *ADC Technologies, Inc. v. Microsoft Corporation, et al.*, Case No. 2:08-CV-01579-RSM filed October 27, 2008 in the United States District Court for the Western District of Washington, Seattle Division (the "Litigation"). Claim construction proceedings have not yet begun in the Litigation, in which Requester is a party. Additionally, the parties have agreed to, and the Court has granted a stay pending the outcome of reexamination requests to be filed on the five patents in suit. (*See* further discussion, *infra.*). Requester respectfully submits that, on the basis of previously uncited patents and printed publications, including Applicant's own published 1994 Okamoto Japanese Application, substantial new questions exist as to the patentability of Claims 1-2, 4-5, 7-9, 11-12, 14-16, 18-19 and 21 of the '520 patent. This reexamination request satisfies the requirements of 37 C.F.R. § 1.510(b) as follows:

37 C.F.R. § 1.510(b)(1): A statement of each substantial new question of patentability is provided in Section VII, Paragraphs B and C. A table summarizing the substantial new questions of patentability ("SNQs"), and cross-referencing the pages where each SNQ may be found, is located at page 10 of this Request.

37 C.F.R. § 1.510(b)(2): Reexamination of Claims 1-2, 4-5, 7-9, 11-12, 14-16, 18-19 and 21 of the '520 patent is requested. A detailed explanation of application of the prior art to each Claim element is provided in Section VII by further reference to the Claim chart[s] attached as Appendices A-Q.

37 C.F.R. § 1.510(b)(3): This reexamination request is based on the prior art references listed in Section I, Paragraph A, and attached as Exhibits 7-23.¹

¹ In addition, the prior art references listed in Section I, Paragraph A are also listed in Exhibit 24, which is an equivalent of Form PTO/SB/08, PTO-1449.

37 C.F.R. § 1.510(b)(4): A copy of the ‘520 patent is attached as Exhibit 1. Additionally, a copy of the ‘520 patent file history, including the List of Prior Art Cited by Applicant, and the Terminal Disclaimer filed by Applicant, is attached as Exhibit 2.

37 C.F.R. § 1.510(b)(5): A certification of service of this reexamination request on the patentee at the address of record is provided on the last page of this reexamination request.

I. THE PRIOR ART REFERENCES THAT PRESENT SUBSTANTIAL NEW QUESTIONS OF PATENTABILITY

A. References Raising Substantial New Questions Of Patentability

The following references present substantial new questions of patentability, *e.g.*, anticipation under 35 U.S.C. § 102 and obviousness under 35 U.S.C. § 103, of Claims 1-2, 4-5, 7-9, 11-12, 14-16, 18-19 and 21 of the ‘520 patent, and are listed on an Information Disclosure Statement (1449), attached as Exhibit 24:

- | | |
|------------|--|
| Exhibit 7 | Takeya Okamoto, Japanese Laid-Open Patent Application No. 06-334780, published on December 2, 1994 (hereinafter “ 1994 Okamoto Japanese Application ”)(includes an English translation, in accordance with 37 CFR 1.510(b)(3)); |
| Exhibit 8 | Fred Chernow <i>et al.</i> , U.S. Patent No. 4,999,806, issued March 12, 1991 (hereinafter “ Chernow ”); |
| Exhibit 9 | Makoto Kato, Japanese Laid-Open Patent Application No. 04-10191, published on January 14, 1992 (hereinafter “ Kato ”) (includes an English translation, in accordance with 37 CFR 1.510(b)(3)); |
| Exhibit 10 | Katsuya Nakagawa, <i>et al.</i> , U.S. Patent No. 4,922,420, issued May 1, 1990 (hereinafter “ Nakagawa ”); |
| Exhibit 11 | Oseki Masayoshi, Japanese Laid-Open Patent Application No. 04-158441, published on June 1, 1992 (hereinafter “ Oseki ”) (includes an English translation, in accordance with 37 CFR 1.510(b)(3)); |
| Exhibit 12 | Halil L. Bakoglu, <i>et al.</i> , U.S. Patent No. 5,632,681, issued May 27, 1997 from an application filed on March 7, 1995 (hereinafter “ Bakoglu ”); |
| Exhibit 13 | Norton Garfinkle, U.S. Patent No. 5,400,402, issued March 21, 1995, from an application filed on June 7, 1993 (hereinafter “ Garfinkle ”); |

- Exhibit 14 Gary N. Griswold, U.S. Patent No. 5,940,504, issued August 17, 1999, from an application filed on June 29, 1992 (hereinafter “**Griswold**”);
- Exhibit 15 Gary D. Hornbuckle, U.S. Patent No. 5,497,479, issued March 5, 1996, from an application filed on February 28, 1995 (hereinafter “**Hornbuckle**”);
- Exhibit 16 Kouji Kaniwa *et al.*, U.S. Patent No. 5,699,370, issued December 16, 1997, from an application filed on February 17, 1995 (hereinafter “**Kaniwa**”);
- Exhibit 17 David J. McCarten, U.S. Patent No. 5,959,596, issued September 28, 1999, from an application filed on June 24, 1993 (hereinafter “**McCarten**”);
- Exhibit 18 Mihoji Tsumura, U.S. Patent No. 5,547,202, issued August 20, 1996, from an application filed on December 30, 1994 (hereinafter “**Tsumura**”);
- Exhibit 19 Thomas E. Cooper *et al.*, U.S. Patent No. 5,757,907, issued May 26, 1998, from an application filed April 25, 1994 (hereinafter “**Cooper**”);
- Exhibit 20 Sanyo Electric Co., Ltd., Japanese Laid-Open Patent Application No. 03-149693, published on June 26, 1991 (hereinafter “**Sanyo**”) (includes an English translation, in accordance with 37 CFR 1.510(b)(3));
- Exhibit 21 Suzuki Katsuyoshi *et al.*, Japanese Laid-Open Patent Application No. 01-166218, published on June 30, 1989 (hereinafter “**Suzuki**”) (includes an English translation, in accordance with 37 CFR 1.510(b)(3));
- Exhibit 22 Fernando Morales, U.S. Patent No. 5,291,554, issued March 1, 1994, from an application filed on August 19, 1992 (hereinafter “**Morales**”); and
- Exhibit 23 James Russo, U.S. Patent No. 5,619,247, issued April 8, 1997, from an application filed on February 24, 1995 (hereinafter “**Russo**”).

B. Listing Of SNQs

SNQ	Substantial New Questions of Patentability Relating to the '520 Patent
A.	Claims 1, 4-5, 7-8, 11-12, and 14 are anticipated by Chernow under 35 U.S.C. § 102(b)
B.	Claims 1-2, 4-5, 7-9, 11-12, and 14 are anticipated by Kato under 35 U.S.C. § 102(b)
C.	Claims 8-9, 12, and 14 are anticipated by Nakagawa under 35 U.S.C. § 102(b)
D.	Claims 1, 4-5, 7-8, 11-12, and 14 are anticipated by Oseki under 35 U.S.C. § 102(b)
E.	Claims 8-9, 12, and 14 are anticipated by Bakoglu under 35 U.S.C. § 102(b)
F.	Claims 8, 11-12, and 14 are anticipated by Hornbuckle under 35 U.S.C. § 102(b)
G.	Claims 1, 4-5, 7-8, 11-12, and 14 are anticipated by Garfinkle under 35 U.S.C. § 102(a)
H.	Claims 1, 5, 7-8, 12, and 14 are anticipated by Kaniwa under 35 U.S.C. § 102(e)
I.	Claims 1, 5, 7-8, 12, and 14 are anticipated by McCarten under 35 U.S.C. § 102(e)
J.	Claims 1-2, 5, 7-8, 12, 14-15, 19, and 21 are anticipated by Tsumura under 35 U.S.C. § 102(e)
K.	Claims 1-2, 5, 7, 12, and 14 are obvious over Bakoglu under 35 U.S.C. § 103(a)
L.	Claims 1-2, 5, and 7 are obvious over Bakoglu in view of Cooper under 35 U.S.C. § 103(a)

SNQ	Substantial New Questions of Patentability Relating to the '520 Patent
M.	Claims 4 and 11 are obvious over Bakoglu in view of Sanyo under 35 U.S.C. § 103(a)
N.	Claims 15-16, 19, and 21 are obvious over Bakoglu in view of Tsumura under 35 U.S.C. § 103(a)
O.	Claim 18 is obvious over Bakoglu in view of Tsumura, in further view of Sanyo under 35 U.S.C. § 103(a)
P.	Claims 5, 7-8, 12, and 14 are obvious over Bakoglu under 35 U.S.C. § 103(a)
Q.	Claims 2, 8-9, 11-12, and 14 are obvious over Chernow in view of Suzuki under 35 U.S.C. § 103(a)
R.	Claims 7-8, 11-12, and 14 are obvious over Garfinkle under 35 U.S.C. § 103(a)
S.	Claims 2, 8-9, and 11-12 are obvious over Garfinkle in view of Suzuki under 35 U.S.C. § 103(a)
T.	Claims 1-2, 5, and 7 are obvious over Griswold under 35 U.S.C. § 103(a)
U.	Claims 1-2, 5, 7-9, and 12 are obvious over Griswold in view of Suzuki under 35 U.S.C. § 103(a)
V.	Claims 1, 4-5, 7, 12, and 14 are obvious over Hornbuckle under 35 U.S.C. § 103(a)
W.	Claims 1-2, 4-5, 7, and 9 are obvious over Hornbuckle in view of Suzuki under 35 U.S.C. § 103(a)
X.	Claims 2 and 9 are obvious over Kaniwa in view of Suzuki under 35 U.S.C. § 103(a)

SNQ	Substantial New Questions of Patentability Relating to the '520 Patent
Y.	Claims 4 and 11 are obvious over Kaniwa in view of Morales under 35 U.S.C. § 103(a)
Z.	Claims 5, 7, 12, and 14 are obvious over Kato under 35 U.S.C. § 103(a)
AA.	Claims 5, 7, 12, and 14 are obvious over Kato in view of Kaniwa under 35 U.S.C. § 103(a)
BB.	Claims 15-16, 18-19, and 21 are obvious over Kato in view of Tsumura under 35 U.S.C. § 103(a)
CC.	Claims 19 and 21 are obvious over Kato in view of Tsumura, in further view of Kaniwa under 35 U.S.C. § 103(a)
DD.	Claims 2 and 9 are obvious over McCarten in view of Suzuki under 35 U.S.C. § 103(a)
EE.	Claims 4 and 11 are obvious over McCarten in view of Morales under U.S.C. § 103(a)
FF.	Claims 5 and 12 are obvious over McCarten under U.S.C. § 103(a)
GG.	Claims 5 and 12 are obvious over McCarten in view of Kaniwa under U.S.C. § 103(a)
HH.	Claims 1-2, 4-5, 7, 12, and 14 are obvious over Nakagawa under U.S.C. § 103(a)
II.	Claims 1-2, 5, and 7 are obvious over Nakagawa in view of Suzuki under U.S.C. § 103(a)
JJ.	Claim 4 is obvious over Nakagawa in view of Sanyo under U.S.C. § 103(a)

SNQ	Substantial New Questions of Patentability Relating to the '520 Patent
KK.	Claim 4 is obvious over Nakagawa in view of Suzuki, in further view of Sanyo under U.S.C. § 103(a)
LL.	Claims 5, 7, 12, and 14 are obvious over Nakagawa in view of Kaniwa under U.S.C. § 103(a)
MM.	Claims 5 and 7 are obvious over Nakagawa in view of Suzuki, in further view of Kaniwa under U.S.C. § 103(a)
NN.	Claims 5, 7, 12 and 14 are obvious over Oseki under U.S.C. § 103(a)
OO.	Claims 2 and 9 are obvious over Oseki in view of Suzuki under U.S.C. § 103(a)
PP.	Claims 5 and 12 are obvious over Oseki in view of Kaniwa under U.S.C. § 103(a)
QQ.	Claims 15, 18-19, and 21 are obvious over Oseki in view of Tsumura under U.S.C. § 103(a)
RR.	Claim 16 is obvious over Oseki in view of Tsumura, in further view of Suzuki under U.S.C. § 103(a)
SS.	Claim 19 is obvious over Oseki in view of Tsumura, in further view of Kaniwa under U.S.C. § 103(a)
TT.	Claims 1-2, 4-5, 7-9, 11-12, and 14 are obvious over Russo under U.S.C. § 103(a)
UU.	Claims 1-2, 4-5, 7-9, 11-12, and 14 are obvious over Russo in view of Suzuki under U.S.C. § 103(a)

SNQ	Substantial New Questions of Patentability Relating to the '520 Patent
VV.	Claims 1-2, 5, 7, 9, 14-16, 19, and 21 are obvious over Tsumura under U.S.C. § 103(a)
WW.	Claims 1-2, 5, 7, and 9 are obvious over Tsumura in view of Suzuki under U.S.C. § 103(a)
XX.	Claims 4, 11, and 18 are obvious over Tsumura in view of Sanyo under U.S.C. § 103(a)
YY.	Claim 4 is obvious over Tsumura in view of Suzuki, in further view of Sanyo under U.S.C. § 103(a)
ZZ.	Claims 8-9, 11-12, and 14 are obvious over 1994 Okamoto Japanese Application in view of Kaniwa under U.S.C. § 103(a)
AAA.	Claims 15-16, 18-19, and 21 are obvious over 1994 Okamoto Japanese Application in view of Tsumura under U.S.C. § 103(a)

C. Summary Of SNQs/Proposed Rejections And Page References

SNQ/ (Proposed Rejection Paragraphs)	Primary Reference	Secondary Reference(s) ("In View Of") – Rejection Grounds	Claims	Pg # For SNQ	Appendices Applying Prior Art To Claims
A. (1)-(8)	Chernow	(None) – 102(b)	1, 4-5, 7-8, 11- 12, 14	Pg. 107	Appendix A
B. (9)-(18)	Kato	(None) – 102(b)	1-2, 4-5, 7-9, 11-12, 14	Pg. 110	Appendix B
C. (19)-(22)	Nakagawa	(None) – 102(b)	8-9, 12, 14	Pg. 113	Appendix C
D. (23)-(30)	Oseki	(None) – 102(b)	1, 4-5, 7-8, 11- 12, 14	Pg. 115	Appendix D
E. (31)-(34)	Bakoglu	(None) – 102(b)	8-9, 12, 14	Pg. 118	Appendix E
F. (35)-(38)	Hornbuckle	(None) – 102(b)	8, 11-12, 14	Pg. 121	Appendix G
G. (39)-(46)	Garfinkle	(None) – 102(a)	1, 4-5, 7-8, 11- 12, 14	Pg. 123	Appendix F
H. (47)-(52)	Kaniwa	(None) – 102(e)	1, 5, 7-8, 12, 14	Pg.127	Appendix H
I. (53)-(58)	McCarten	(None) – 102(e)	1, 5, 7-8, 12, 14	Pg. 130	Appendix I
J. (59)-(68)	Tsumura	(None) – 102(e)	1-2, 5, 7-8, 12, 14-15, 19, 21	Pg. 133	Appendix J
K. (69)-(74)	Bakoglu	(None) – 103(a)	1-2, 5, 7, 12, 14	Pg. 137	Appendix E
L. (75)-(78)	Bakoglu	Cooper – 103(a)	1-2, 5, 7	Pg. 144	Appendices E, K
M. (79)-(80)	Bakoglu	Sanyo – 103(a)	4, 11	Pg. 148	Appendices E, L
N. (81)-(84)	Bakoglu	Tsumura – 103(a)	15-16, 19, 21	Pg. 149	Appendices E, J

SNQ/ (Proposed Rejection Paragraphs)	Primary Reference	Secondary Reference(s) ("In View Of") – Rejection Grounds	Claims	Pg # For SNQ	Appendices Applying Prior Art To Claims
O. (85)	Bakoglu	Tsumura, in further view of Sanyo – 103(a)	18	Pg. 151	Appendices E, J, L
P. (86)-(90)	Chernow	(None) – 103(a)	5, 7-8, 12, 14	Pg. 152	Appendix A
Q. (91)-(96)	Chernow	Suzuki – 103(a)	2, 8-9, 11-12, 14	Pg. 154	Appendices A, M
R. (97)-(101)	Garfinkle	(None) – 103(a)	7-8, 11-12, 14	Pg. 157	Appendix F
S. (102)-(106)	Garfinkle	Suzuki – 103(a)	2, 8-9, 11-12	Pg. 159	Appendices F, M
T. (107)-(110)	Griswold	(None) – 103(a)	1-2, 5, 7	Pg. 161	Appendix N
U. (111)-(117)	Griswold	Suzuki – 103(a)	1-2, 5, 7-9, 12	Pg. 164	Appendices N, M
V. (118)-(123)	Hornbuckle	(None) – 103(a)	1, 4-5, 7, 12, 14	Pg. 168	Appendix G
W. (124)-(129)	Hornbuckle	Suzuki – 103(a)	1-2, 4-5, 7, 9	Pg. 172	Appendices G, M
X. (130)-(131)	Kaniwa	Suzuki – 103(a)	2, 9	Pg. 175	Appendices H, M
Y. (132)-(133)	Kaniwa	Morales – 103(a)	4, 11	Pg. 177	Appendices H, O
Z. (134)-(137)	Kato	(None) – 103(a)	5, 7, 12, 14	Pg. 178	Appendix B
AA. (138)-(141)	Kato	Kaniwa – 103(a)	5, 7, 12, 14	Pg. 179	Appendices B, H
BB. (142)-(146)	Kato	Tsumura – 103(a)	15-16, 18-19, 21	Pg. 181	Appendices B, J

SNQ/ (Proposed Rejection Paragraphs)	Primary Reference	Secondary Reference(s) ("In View Of") – Rejection Grounds	Claims	Pg # For SNQ	Appendices Applying Prior Art To Claims
CC. (147)-(148)	Kato	Tsumura, in further view of Kaniwa – 103(a)	19, 21	Pg. 184	Appendices B, J, H
DD. (149)-(150)	McCarten	Suzuki – 103(a)	2, 9	Pg. 185	Appendices I, M
EE. (151)-(152)	McCarten	Morales – 103(a)	4, 11	Pg. 186	Appendices I, O
FF. (153)-(154)	McCarten	(None) – 103(a)	5, 12	Pg. 187	Appendix I
GG. (155)-(156)	McCarten	Kaniwa – 103(a)	5, 12	Pg. 188	Appendices I, H
HH. (157)-(163)	Nakagawa	(None) – 103(a)	1-2, 4-5, 7, 12, 14	Pg. 190	Appendix C
II. (164)-(167)	Nakagawa	Suzuki – 103(a)	1-2, 5, 7	Pg. 193	Appendices C, M
JJ. (168)	Nakagawa	Sanyo – 103(a)	4	Pg. 197	Appendices C, L
KK. (169)	Nakagawa	Suzuki, in further view of Sanyo – 103(a)	4	Pg. 198	Appendices C, M, L
LL. (170)-(173)	Nakagawa	Kaniwa – 103(a)	5, 7, 12, 14	Pg. 199	Appendices C, H
MM. (174)-(175)	Nakagawa	Suzuki, in further view of Kaniwa – 103(a)	5, 7	Pg. 201	Appendices C, M, K
NN. (176)-(179)	Oseki	(None) – 103(a)	5, 7, 12, 14	Pg. 203	Appendix D
OO. (180)-(181)	Oseki	Suzuki – 103(a)	2, 9	Pg. 204	Appendices D, M

SNQ/ (Proposed Rejection Paragraphs)	Primary Reference	Secondary Reference(s) ("In View Of") – Rejection Grounds	Claims	Pg # For SNQ	Appendices Applying Prior Art To Claims
PP. (182)-(183)	Oseki	Kaniwa – 103(a)	5, 12	Pg. 205	Appendices D, H
QQ. (184)-(187)	Oseki	Tsumura – 103(a)	15, 18-19, 21	Pg. 207	Appendices D, J
RR. (188)	Oseki	Tsumura, in further view of Suzuki – 103(a)	16	Pg. 209	Appendices D, J, M
SS. (189)	Oseki	Tsumura, in further view of Kaniwa – 103(a)	19	Pg. 210	Appendices D, J, H
TT. (190)-(199)	Russo	(None) – 103(a)	1-2, 4-5, 7-9, 11-12, 14	Pg. 212	Appendix P
UU. (200)-(209)	Russo	Suzuki – 103(a)	1-2, 4-5, 7-9, 11-12, 14	Pg. 215	Appendices P, M
VV. (210)-(219)	Tsumura	(None) – 103(a)	1-2, 5, 7, 9, 14-16, 19, 21	Pg. 220	Appendix J
WW. (220)-(224)	Tsumura	Suzuki – 103(a)	1-2, 5, 7, 9	Pg. 224	Appendices J, M
XX. (227)	Tsumura	Sanyo – 103(a)	4, 11, 18	Pg. 227	Appendices J, L
YY. (228)	Tsumura	Suzuki, in further view of Sanyo – 103(a)	4	Pg. 228	Appendices J, M, L
ZZ. (229)-(233)	1994 Okamoto Japanese Application	Kaniwa – 103(a)	8-9, 11-12, 14	Pg. 229	Appendices Q, H
AAA. (234)-(238)	1994 Okamoto Japanese Application	Tsumura – 103(a)	15-16, 18-19, 21	Pg. 233	Appendices Q, J

II. APPLICANT'S PATENTS ON COMMUNICATION SYSTEMS

A. Applicant's Patents

The '520 patent applicant, Mr. Okamoto ("Applicant"), has filed a number of patent applications and received a number of patents. Five of these patents are asserted against Requester and one or both of Nintendo Corporation of America, Inc., and/or Sony Computer Entertainment of America Inc. in the Litigation. As of this filing, ADC has filed reexamination requests on each of the five patents identified below, and Requester has filed or will file reexamination requests on each. The following table lists these five patents and indicates (in **bold**) the patent that is the subject of this request:

U.S. Pat. No.	Application	Filed	Issued	ADC Reexam. No.	Requester Reexam. No.
5,775,995	08/642,550	May 3, 1996	Jul. 7, 1998	90/009,523	TBD
6,193,520	09/109,784	Jul. 2, 1998	Feb. 27, 2001	90/009,524	TBD
6,488,508	09/733,541	Dec. 8, 2000	Dec. 3, 2002	90/009,521	TBD
6,702,585	10/307,886	Dec. 2, 2002	Mar. 9, 2004	90/009,522	TBD
6,875,021	10/713,713	Nov. 14, 2003	Apr. 5, 2005	90/009,520	TBD

B. Applicant's Other Applications

In addition to the issued patents, Mr. Okamoto has a number of pending and/or abandoned patent applications that purport to relate to or claim priority (in whole or in part) to the patents identified above and/or their related applications, including at least the following applications:

09/734,469 (abandoned)

11/090,420 (abandoned)

11/598,961 (pending)

III. OVERVIEW OF THE '520 PATENT

A. Field Of The Purported Invention

The alleged invention of the '520 patent relates to an interactive communication system for transmitting video game and karaoke software from a host facility to communication terminal devices. ('520 patent, Col. 1, lines 10-12).

None of this was new in 1998, when the application leading to the '520 patent was filed. Nor was any of this new six years before, in April, 1994, when the first application in Applicant's claimed chain of priority was filed.²

B. Claims Of The '520 Patent

There are a total of 3 independent claims (claims. 1, 8 and 15) and 18 dependent claims.

Independent Claims 1, 8, and 15 are similar. Specifically, Claim 1 recites:

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,

² It is Requester's position that Applicant's first application, filed in April 1994, does not provide an enabling written description of the full scope of the '520 patent claims at issue in this Request, and therefore that the claims are not entitled to be backdated to April, 1994, or any date prior to the date that the '520 patent application was filed. Unless otherwise noted, the prior art included in this Request is presumed prior art (as set forth in the description of each piece of prior art) under at least 35 U.S.C. § 102(a) and (e) (for patents) or 102(a) (for other printed publications), even if Applicant were entitled to backdate his claims.

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.

('520 Patent, Claim 1). (Emphasis added).

The only difference between Claim 1 and the other independent claims is in the bolded language above. Claim 8 replaces the language bolded above with:

clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing

(*Id.*, Claim 8).

Claim 15 replaces it with:

clock means for keeping a predetermined time period after said execution means ends the execution of the program or data processing to count a time period during which at least one of the program, the data, and a combination of the program and data is continuously unused

(*Id.*, Claim 15).

Dependent Claims 2, 9 and 16 add a second clock means and related alarm means to warn that interference will soon be performed (*see, e.g.*, Claim 2):

second clock means for keeping a second predetermined time period shorter than said predetermined time period counted by said clock means, and

alarm means for issuing an alarm when said second clock means counts said second predetermined time period, and thereby informing that interference by said interference means with execution of said executing means will soon be performed.

(*Id.*, Claim 2).

Dependent Claims 3, 10 and 17, which add a third clock means, are not subject to this Request.

Dependent Claims 4, 11 and 18 recite interference by deletion (*see, e.g.*, Claim 4):

interference means comprises means for deleting at least one of the program, the data, and a combination of the program and data stored in said storage means.

(*Id.*, Claim 4).

Dependent Claims 5, 12 and 19 recite a display, and accomplishing interference by blocking the view of said display (*see, e.g.*, Claim 5):

said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed, and

said interference means comprises means for blocking the view of what is displayed on said screen.

(*Id.*, Claim 5).

Dependent Claims 6, 13 and 20, which recite interference by invalidating operation of an input device, are not subject to this Request.

Dependent Claims 7, 14 and 21 recite sound generating means, and accomplishing interference by preventing sound generation by said sound generating means (*see, e.g.*, Claim 7):

sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing, wherein said interference means comprises means for preventing said sound generating means from generating the sound.

(*Id.*, Claim 7).

C. Prosecution History Of The ‘520 Patent

The ‘520 patent application was filed on July 2, 1998, including 21 claims. (‘520 Application, Exhibit 2, Pgs. 32-75).³ On May 8, 2000, the Examiner mailed an Office Action objecting to Claims 4, 6-7, 11, 13-14, 18 and 20-21, and subjecting the remaining claims to a restriction/election requirement. (*Id.*, Pgs. 107-113). The Office Action stated that these various requirements could be met by submitting a terminal disclaimer.⁴ (*Id.*, Pg. 110).

In response, on August 4, 2000, Applicant submitted an Amendment and Terminal Disclaimer, limiting the patent term of the ‘520 patent to that of its parent, U.S. Patent No. 5,775,995 (the ‘995 patent”). (*Id.*, Pgs. 115-117). A notice of Allowance followed on August 25, 2000, (*id.*, Pgs. 118-119), and the patent issued on February 27, 2001.

Post issuance, Applicant submitted two certificates of correction, on February 26 and March 27, 2008, which certificates issued on March 25, 2008 and April 25, 2008, respectively. (*Id.*, Pgs. 27 and 28, respectively). The later-issued certificate, which superseded the earlier, changed the earliest claim of priority from the May 3, 1996 date of filing of the ‘995 patent application (the “‘995 Patent Application”, Exhibit 4) to claim priority through an application filed on November 9, 1995 (the “‘744 Patent Application, Exhibit 5), to an earlier application, filed on April 25, 1994 (the “‘103 Patent Application”, Exhibit 6). (*See* ‘520 patent file history, Pg. 28).

D. Claim Construction Of The ‘520 Patent

Claims in reexamination are given their broadest reasonable interpretation consistent with the specification. *See* MPEP § 2258. As noted above, claim construction proceedings have not yet begun in the Litigation and the litigation is presently stayed pending the outcome of any

³ References to page numbers are to Requester’s page numbers for this exhibit, which page numbers are added for Examiner’s ease of reference.

⁴ Examiner also required a change to Claims 3, 10, and 17, which are not at issue in this Request. Therefore, Examiner’s required changes to those claims, and Applicant’s response thereto, are not discussed herein.

reexamination of the five ADC patents at issue therein. Regardless, the PTO may adopt broader or different constructions than those ultimately determined in the Litigation as claim construction orders are not binding on the PTO. Requester emphasizes that the interpretation of the '520 patent claims reflected in this Request does not necessarily reflect the construction that Requester believes should be given to the claims, but is consistent with manner in which ADC has attempted to apply the claims in its infringement contentions in the Litigation.⁵

**E. Overview Of The Applicant's Admissions
Regarding The Claims And The State Of The Prior Art**

While the claims of the '520 patent naturally are the primary focus of this Request, the system described (to some extent) in the patent's specification, as well as the prosecution history of the patent and the text of related patents each provides important context for those claims. Thus, this section summarizes the '520 patent's description of its alleged invention, as well as Applicant's statements regarding the basis for allowability of the challenged claims, as well as other statements by Applicant regarding the scope of the prior art and of the claims at issue.

Requester summarizes in the following Subparagraphs, and includes for reference as Exhibits 2-6, copies of the following documents, which contain admissions made by Applicant and statements from the Examiner made during prosecution of the '520 patent, as well as patents that are related to the '520 patent, and statements from the owner of the patent during the Litigation.⁶ These exhibits are not being used in this Request as the basis for additional proposed rejections, but are

⁵ Requester does not admit that any interpretations of any of the claims or constructions of claim terms that may be set forth herein would also be proper in the Litigation or in other court proceedings that do not apply the "broadest reasonable interpretation" standard applied during reexamination. *See* MPEP § 2258.I.G. Rather, Applicant is in no position to argue that Requester, in interpreting these claims consistent with ADC's own contentions in the Litigation (*see* below), is applying a construction that is broader than the broadest reasonable construction.


⁶ In citing to these references, Requester does not admit that Applicant's priority claims to related applications are proper.

included to inform the Applicant's and/or Examiner's view of the scope of the claims, and/or to compare the claims to applications to which Applicant claims priority.

Exhibit 2 '520 patent file history (including citations to prior art and terminal disclaimer).

1. Applicant's Admissions In The Litigation

During the Litigation, ADC has served infringement contentions seeking to read certain claims of the '520 patent on Requester's systems. These contentions, attached as Exhibit 3, constitute Admissions by Applicant contained in a court record regarding the scope of the claims, and may be incorporated into the construction of certain claim terms used in the SNQs, below. *See*, for example, Exhibit 3, Pg. 5, wherein ADC equates "prevent[ing] further game play" with "blocking the view of what is displayed on said screen":

said interference means comprises means for blocking the view of what is displayed on said screen.	<p>The Accused Product includes interference means that interferes with the display upon the expiration of a predetermined time period.</p> <p>Upon the expiration of the predetermined time period, the interference means causes the display means to alter the display to prevent further game play, such as with an advertisement, release date of the game, or the like. The interference means also prevents further execution, such as illustrated in the following screen display:</p>  <p>The above screen display interferes with the display by indicating that a game will be released for purchase in the future.</p>
--	--

Reexam Figure 1 - Excerpt of ADC's Infringement Contentions, Exhibit 3, Pg. 13

2. Applicant's "Priority" Applications

- Exhibit 4 United States Patent Application No. 08/642,560, filed on May 3, 1996, which issued into United States Patent No. 5,775,995 (the "'995 Patent Application");
- Exhibit 5 United States Patent Application No. 09/555,400 filed on November 9, 1995, which issued into United States Patent No. 5,735,744 (the "'744 Patent Application"); and
- Exhibit 6 United States Patent Application No. 08/232,862, filed on April 25, 1994, which issued into United States Patent No. 5,489,103 (the "'103 Patent Application").

IV. APPLICANT IS NOT ENTITLED TO AN EARLY PRIORITY DATE FOR THE CLAIMS OF THE '520 PATENT

As a threshold matter, in considering the Request for Reexamination of the '520 patent, it is proper to consider whether the applications to which the '520 patent claims priority have an adequate written description to support Applicant's priority claims. For a discussion of this practice, *see* MPEP § 2616:

The statement applying the prior art may, where appropriate, point out that claims in the patent for which reexamination is requested are entitled only to the filing date of that patent and are not supported by an earlier foreign or United States patent application whose filing date is claimed. For example, even where a patent is a continuing application under 35 U.S.C. 120, the effective date of some of the claims could be the filing date of the child application which resulted in the patent, because those claims were not supported in the parent application. Therefore, any intervening patents or printed publications would be available as prior art. *See In re Ruscetta*, 255 F.2d 687, 118 USPQ 101 (CCPA 1958), *In re van Langenhoven*, 458 F.2d 132, 173 USPQ 426 (CCPA 1972). *See also* MPEP § 201.11.

At least some of the claims of the '520 patent are not entitled to a priority date earlier than the date that the '520 patent application was filed: July 2, 1998. This is so because, for example, they recite limitations that have no support in the parent application to/through which they must claim priority. Other claims are not entitled to a priority date earlier than November 9, 1995, the

date of filing of the '744 Patent Application, as they claim subject matter disclosed for the first time therein.⁷

To gain the benefit of the filing date of an earlier filed application, the claims in the later filed application must comply with § 112, ¶ 1 as to each application in the chain of priority. (See MPEP § 201.11, reproduced below.)

There are several conditions for a later-filed application to receive the benefit of the filing date of a prior-filed application under 35 U.S.C. 120, 121, or 365(c), or, provided the later-filed application is not a design application (see 35 U.S.C. 172), under 35 U.S.C. 119(e). The conditions are briefly summarized as follows:

(A) The prior-filed application must disclose the claimed invention of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112 for a benefit claim under 35 U.S.C. 120, 121, or 365(c), and also for a benefit claim under 35 U.S.C. 119(e).

Reexam Figure 2 - Excerpt of MPEP § 201.11

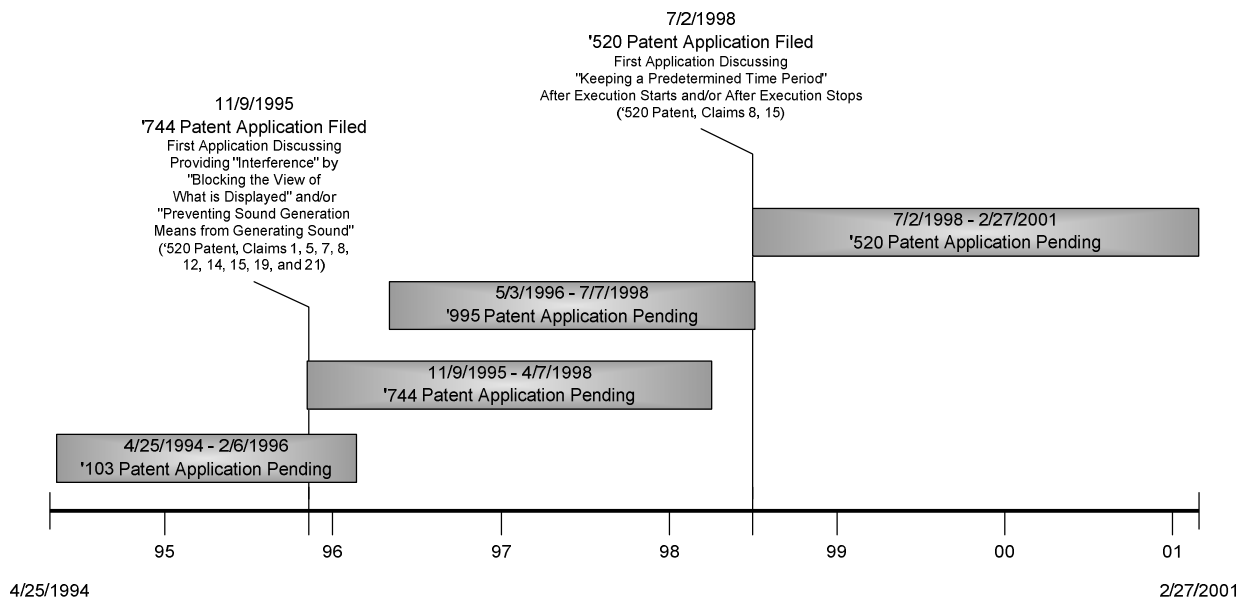
The MPEP explicitly acknowledges that a requester may challenge the priority date of the patent claims. (See MPEP § 2217, Pg. 28, below.)

The statement applying the prior art may, where appropriate, point out that claims in the patent for which reexamination is requested are entitled only to the filing date of the patent and are not supported by an earlier foreign or United States patent application whose filing date is claimed. For example, the effective date of some of the claims in a patent which resulted from a continuing application under 35 U.S.C. 120 could be the filing date of the continuing application since those claims were not supported in the parent application. Therefore, intervening patents or printed publications are available as prior art. See *In re Ruscetta*, 255 F.2d 687, 118 USPQ 101 (CCPA 1958), *In re van Langenhoven*, 458 F.2d 132, 173 USPQ 426 (CCPA 1972). See also MPEP § 201.11.

Reexam Figure 3 - Excerpt of MPEP § 2217

⁷ In so stating, Requester does not admit that any claims are, in fact, entitled to a November 9, 1995 effective filing date.
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As in *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565 (Fed. Cir. 1997), applicant has a series of applications claiming priority back to an original application. However, in *Lockwood*, because intervening applications in the chain failed to maintain continuity of disclosure as to certain structures disclosed in the patent at issue, the patent at issue was not entitled to claim an earlier priority date for those claims. (*Id.*, 107 F.3d at 1571-1572.) In *Lockwood*, because there was an inadequate written description under 35 U.S.C. § 112 in the patents through which the applicant claimed 35 U.S.C. § 120 priority, the claims containing the unsupported limitation were not entitled to an earlier filing date, and could even be invalidated by the earlier patent. (*Id.*) The *Lockwood* court went on to state that even where subject matter in a patent would be obvious in light of an earlier application's disclosure, where limitations are not expressly disclosed in the earlier application, as required by § 112, the applicant is not entitled to claim priority to that application. (*Id.*, 107 F.3d at 1572).



Reexam Figure 4 – Earliest Possible Priority Dates For Certain '520 Patent Claims

As summarized in the Figure above, and as further detailed below, Claims 8-9, 11-12, 14-16, 18-19 and 21 of the '520 patent are not entitled to the benefit of any earlier application's priority date because the parent applications through which priority must be claimed did not provide the

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required supporting disclosure, and/or did not provide an enabling disclosure sufficient to set forth the full scope of the claimed subject matter to one of ordinary skill in the art. Further Claims 1-2, 4-5 and 7 of the '520 patent are not entitled to claim priority before November 9, 1995, because the '103 Patent Application to which priority is claimed did not provide the required supporting disclosure.

A. Numerous “Means” Claims Cannot Claim Priority To Earlier Applications, Either Because They Are New Matter, Or Broadening, And Therefore Unsupported

35 U.S.C. § 112, ¶ 1 requires that:

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.

Further, 35 U.S.C. § 112, ¶ 2 requires that claims “particularly point[] out and distinctly claim[] the subject matter which the applicant regards as his invention.” For means-plus-function elements, which are statutorily limited to the “corresponding structure, material, or acts described in the specification and equivalents thereof,” (35 U.S.C. § 112, ¶ 6), section 112, ¶ 2 requires that the specification must permit one of ordinary skill in the art to “know and understand what structure corresponds to the means limitation.” *Biomedino, LLC v. Waters Techs. Corp.*, 490 F.3d 946, 949-50 (Fed. Cir. 2007) (internal citation omitted).

A number of claims of the '520 patent include so-called means-plus-function limitations. The patentee's use of “means for” leads to a presumption that the elements in question are means-plus-function claim terms, falling within the purview of § 112, ¶ 6. The parent applications to the '520 patent discloses no structure corresponding to many of the “means-plus-function” claim terms,

as recited below, and the ‘103 Patent Application lacks structure to support additional claim limitations.

**1. Claims 5, 7-8, 12, 14-15, 19 and 21
Recite Matter That Was Included For The First Time
Either In The ‘520 Application Or In The ‘744 Patent Application**

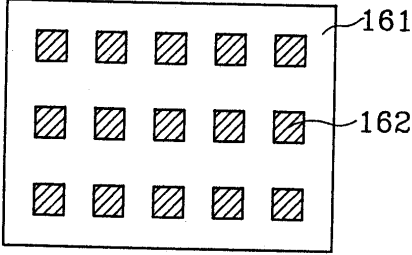
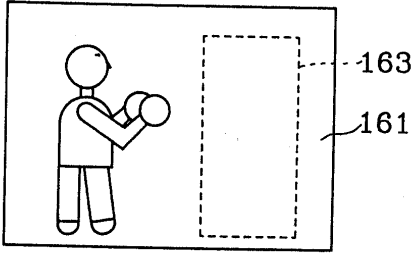
Claims 5, 7-8, 12, 14-15, 19 and 21 recite limitations that are nowhere to be found in the earliest applications in the ‘520 patent’s chain of priority. Rather, they are referenced only in portions of the specification that were added later, either when the ‘744 Patent Application was filed on November 5, 1995, or when the ‘520 patent application was filed on July 2, 1998.

**a) Claims 5, 12 and 19, Reciting “Means for
Blocking The View Of What Is Displayed”
Are Not Entitled To Claim Priority Before November 9, 1995**

The parent applications prior to the filing of the ‘744 Patent Application on November 9, 1995 did not disclose providing interference in any manner other than deletion. The ‘744 Patent Application was the first application in Applicant’s chain of priority that included the concept of providing interference by blocking the view of the display, recited in Claims 5, 12 and 19.

(Compare ‘744 Patent Application, Exhibit 5, with ‘103 Patent Application, Exhibit 6:

‘744 Patent Application (Filed November 9, 1995)	‘103 Patent Application (Filed April 25, 1994)
“Figures 8A through 8D are illustrations showing various forms of modified interference means which interfere with the progress of t game;” (‘744 Patent Application, Pg. 9).	<i>(no corresponding disclosure)</i>

<p>‘744 Patent Application (Filed November 9, 1995)</p>	<p>‘103 Patent Application (Filed April 25, 1994)</p>
 <p>(‘744 Patent Application, FIG. 8a).</p>	<p>(no corresponding disclosure)</p>
 <p>(‘744 Patent Application, FIG. 8b).</p>	<p>(no corresponding disclosure)</p>
<p>“1. A communication system having a host facility and communication terminal device capable of communicating with said host facility, said communication terminal device comprising:</p> <p>a controller for inputting instructions to play game, receiving means for receiving game data as sent out from said host facility,</p> <p>game data storage means for storing the game data received by said receiving means,</p> <p>game executing means for executing game by using the game data stored in said game data storage means, in accordance with instructions from said controller,</p>	<p>“1. A communication terminal device connectable to a host facility via communication lines, comprising:</p> <p>game data storage means for storing game data;</p> <p>game operation means for allowing a player to play game after game data is stored within said game data storage means and before the game data stored is deleted;</p> <p>input means for inputting identifying information identifying a game to be played;</p> <p>request transmitting means for transmitting to</p>

<p>‘744 Patent Application (Filed November 9, 1995)</p>	<p>‘103 Patent Application (Filed April 25, 1994)</p>
<p>display means having a screen for displaying the progress of game by said game executing means,</p> <p>clock means for keeping a predetermined time period after said receiving means received the game data, and</p> <p>interference means for interfering with the execution of said game executing means by blocking the view on the screen on which the progress of game is displayed by display means when said clock means counts said predetermined time period,</p> <p>said host facility comprising:</p> <p>data file storage for storing game data as well as duration data indicative of the predetermined time period to be counted by said clock means, and</p> <p>sending out means for sending out the game data and the duration data stored in said data file storage to said communication terminal device.”</p> <p>(‘744 Patent Application, Claim 1, Pg. 28). (Emphasis and line breaks added).</p>	<p>said host facility the identifying information inputted at said input means and for requesting game data corresponding to the game to be played;</p> <p>receiving means for receiving the game data as sent out from said host facility;</p> <p>clock means for keeping a predetermined time period after said receiving means received the game data;</p> <p>storage control means for controlling said game data storage means to store the game data as received by said receiving means and for deleting, when said clock means determines that said predetermined time period has elapsed, the game data stored within said game data storage means.”</p> <p>(‘103 Patent Application, Claim 1, Pg. 25). (Emphasis and line breaks added).</p>
<p>“In the above described embodiment, the game data stored in the memory 8 is deleted in order to interfere with the progress of game. Alternative arrangements to this are provided by the present invention, as shown</p>	<p><i>(no corresponding disclosure)</i></p>

‘744 Patent Application (Filed November 9, 1995)	‘103 Patent Application (Filed April 25, 1994)
<p>in FIGS. 8A through 8D. In the arrangement of FIG. 8A, the view on a screen 161 of the monitor 16 is blocked with patterns of stripes 162 displayed thereon. Instead, the view displayed on the screen may be partly deleted. In the arrangement shown in FIG. 8B, only an opponent of boxing game, who is to be displayed on an area 163 of the screen 161, is deleted. Still another alternative is provision of a switch 131 shown in FIG. 8C for a speaker circuit, which, when turned off, withholds the sound that would otherwise be issued from the speaker 13 during the game. Further alternative is provision of a switch 61 shown in FIG. 8D which invalidates the operation on the input device 6 or the controller 31. The switches 131 and 61 may be mechanical components or may be software operation. For instance, actuation of the sound source 10 may be halted by the CPU 5, or the CPU 5 may reject signals from the input device 6 or the controller 31. As still further alternative, the power of the personal communicator may be turned off when the CPU 5 determines that a predetermined time has elapsed after the game data was received.”</p> <p>(‘744 Patent Application, Page 25). (Emphasis added).</p>	
<p>“An interactive communication system is proposed for communicating software of video games or karaoke music from a host facility or distributor to end users. The system includes a communication terminal device provided at the end user. The communication terminal device includes a computer and a device for performing interactive communication with the host facility. The communication terminal device also includes temporary storage device in which video game data or karaoke data received from the host facility is temporarily stored.</p>	<p>“An interactive communication system is proposed for communicating software of video games or karaoke music from a host facility or distributor to end users. The system includes a communication terminal device provided at the end user. The communication terminal device includes a computer and a device for performing interactive communication with the host facility. The communication terminal device also includes temporary storage device in which video game data or karaoke data received from the host facility is temporarily stored.</p>

‘744 Patent Application (Filed November 9, 1995)	‘103 Patent Application (Filed April 25, 1994)
<p>Game data stored in the temporary storage device is automatically deleted after a predetermined time period.</p> <p>Instead of the data deletion, the system can block the view displayed on the screen of the terminal device when a predetermined time has elapsed.</p> <p>The game data can be transmitted from broadcasting station to the terminal device via broadcasting wave.”</p> <p>(‘744 Patent Application, “Abstract of the Disclosure,” Pg. 36). (Emphasis and line breaks added).</p>	<p>The communication terminal device further includes outputting means for outputting the game data or karaoke data.</p> <p>Game data stored in the temporary storage device is automatically deleted after a predetermined time period.”</p> <p>(‘103 Patent Application, “Abstract of the Disclosure,” Pg. 32). (Line breaks added).</p>

Therefore, these claims’ recitation of “means for blocking the view of what is displayed” to provide interference, is new matter not entitled to claim priority before November 9, 1995.

**b) Claims 7, 14 and 21, Reciting “Means for Preventing Said Sound Generating Means From Generating Sound”
Are Not Entitled To Claim Priority Before November 9, 1995**

The ‘744 Patent Application was also the first application in Applicant’s chain of priority that included the concept of providing interference by preventing the operation of the sound generating means (*see, e.g.*, ‘744 Patent Application, Pg. 25, Fig. 8C), recited in claims 7, 14 and 21 of the ‘520 patent. (*Compare* ‘744 Patent Application, Exhibit 5, *with* ‘103 Patent Application, Exhibit 6. Therefore, these claims’ recitation of “means for preventing said sound generating means from generating the sound” to provide interference is new matter, and is not entitled to claim priority before November 9, 1995.

**c) Claims 8 and 15 (And Their Dependents),
Reciting “Clock Means” Are Not Entitled To Claim
Priority Beyond The Filing Date Of The ‘520 Application**

The parent specifications prior to the filing of the ‘520 Application described measuring a fixed time period from the time that data is received to the time that it is deleted. (*See, e.g.*, ‘995 Patent Application, Pg. 4). None of these applications, however, included a description of measuring “a predetermined time period after said executing means starts execution of the program or data processing.” (‘520 patent, Claim 8), or “a predetermined time period after said execution means ends the execution of the program or data processing to count a time period during which at least one of the program, the data, and a combination of the program and data is continuously unused.” (*Id.*, Claim 15). For at least this reason, Claims 8 and 15, and their dependents, are not entitled to claim priority beyond July 2, 1998, the date of filing of the ‘520 Application.

**2. Claims 1, 8 and 15 (And Their Dependents) Reciting “Interference
Means” Are Too Broad To Be Supported By The Parent Application,
And Therefore Cannot Claim Priority Before November 9, 1995**

Just as one of ordinary skill in the art must understand the structure corresponding to a claimed function, he must also understand the metes and bounds of the claimed invention. Where a claimed “invention” is broadened by a later disclosure, these broader claims are not entitled to claim priority to a narrower “invention” claimed in an earlier application.

As set forth above, the parent applications prior to the filing of the ‘744 Patent Application on November 9, 1995 did not disclose providing interference in any manner other than deletion. For the first time, the ‘744 Patent Application disclosed providing other methods of interference, such as blocking the view of the display (*e.g.*, ‘744 Patent Application, Pg. 25; Figs 8a, 8b), disabling the sound generating means (*e.g., id.*, Pg. 25; Fig. 8c), and invalidating the operation of an input device or personal communicator. (*e.g., id.*, Pgs. 25-26; Fig. 8d) None of these had been disclosed in

Applicant's earlier patents. (*Compare* '744 Patent Application, Exhibit 5, *with* '103 Patent Application, Exhibit 6 *and* 1994 Okamoto Japanese Application, Exhibit 7.)

Because all of these newly disclosed mechanisms for providing interference are within the scope of the "interference means" limitation in these claims, and because none of these mechanisms were disclosed prior to the filing of the '744 Patent Application, Claims 1, 8 and 15, and their dependents, are not entitled to claim priority before November 9, 1995.

B. Summary Of Earliest Possible Priority Dates

As a result of the foregoing, the claims of the '520 Patent are not entitled to any priority date earlier than the following:

- Claims 1-2, 4-5 and 7 – November 9, 1995 (due to broader scope of "interference means")⁸
- Claims 8-9, 11-12, 14-15, 19 and 21 – July 2, 1998 (due to newly disclosed calculation of predetermined time periods "after said execution means starts" or "after said execution means ends" kept by "clock means").⁹

V. THE PRIOR ART DESCRIBED THE CLAIMED INVENTION

A. The Prior Art Described The Same "Solution" That Applicant Claimed Was Novel During Prosecution Of The '520 Patent Application

None of the "solutions" purportedly disclosed for the first time by Applicant were new at all. As demonstrated by the voluminous library of anticipating references below, Applicant was merely reciting old ideas and combining them to claim something "old" as "new." Already known were means for communicating a program/data from a host to a user, charging the user for a licensed

⁸ Claim 5 would further not be entitled to claim before November 9, 1995 (due to specific recitation of "blocking the view of what is displayed" first disclosed with the filing of the '744 Patent Application), while Claim 7 would not be entitled to claim before November 9, 1995 (due to specific recitation of "preventing said sound generating means from generating sound" also first disclosed with the filing of the '744 Patent Application).

⁹ Claims 8-9, 11-12, 14-16, 18-19 and 21 would otherwise not be entitled to any date earlier than November 9, 1995 (due to broader scope of "interference means" first disclosed with the filing of the '744 Patent Application), and Claims 12 and 19 would further not be entitled to claim before November 9, 1995 (due to specific recitation of "blocking the view of what is displayed" also first disclosed with the filing of the '744 Patent Application), while Claims 14 and 21 would

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period of use for such program/data, and interfering with the use of that program/data at the end of the period, or if other conditions of the license are not met by the user. Also known was providing a warning near the end of the licensing period, and providing various forms of interference, including deletion, blocking the display, or interfering with sound generation. In short, everything Applicant claims in the '520 Patent was already known in the prior art. Therefore Claims 1-2, 4-5, 7-9, 11-12, 14-16, 18-19 and 21 of the '520 patent are invalid, and should be rejected.

1. The Chernow Prior Art

The idea of a software distribution system was not new when the '520 Application was filed, nor was it new even when Applicant's earliest priority applications were filed. Rather, U.S. Patent No. 4,999,806, which issued to Fred Chernow on March 12, 1991, entitled "Software Distribution System," discloses most of the elements claimed by Applicant, and all of the elements recited in a number of the claims of the '520 Patent. Chernow was neither cited by the Applicant, nor cited or relied upon by the Examiner during prosecution of the '520 patent, is not cumulative to the references considered during the original prosecution, and, as demonstrated below and in the specific SNQs, raises new questions of patentability as to certain claims of the '520 patent.

a) A communication system for transmitting a program and/or data from a host facility to a communication terminal device

Chernow discloses providing software (*e.g.*, a game) which may be used for a limited time on a user's computer after downloading it from a host computer:

The hardware in its simplest form comprises a computer with a modem attached to an ordinary telephone line. In a large installation, the seller's computer might be a main frame with many telephone lines and modems. Whatever the size of the installation, the computer and modems are preferably able to support both incoming and outgoing phone calls [*i.e.* bi-directional communication] as well as a variety of baud rates.

further not be entitled to claim before November 9, 1995 (due to specific recitation of "preventing said sound generating means from generating sound" also first disclosed with the filing of the '744 Patent Application).

(Chernow, Col. 2, lines 23-30).

The Interactive Program is located on the Computer (seller's computer) and provides all of the functions necessary to complete a transaction with a customer.

(*Id.*, Col. 5, lines 55-58).

Another object of this invention is to permit the purchaser to rent the protected software for a specific number of runs which would be useful, e.g. if the software were a game.

(*Id.*, Col. 2, lines 6-9).

b) An input device

Chernow further discloses allowing a customer to choose a category of software to download, and therefore explicitly or inherently discloses an input device:

Menus are displayed on the customer's monitor (or terminal) to permit the customer to choose which category of software is to be explored.

(*Id.*, Col. 6, lines 1-5).

c) Receiving means

Chernow further discloses that the customer's computer receives the software from the control transfer program:

Under control of the Control Transfer Program, a Storing Program and the Target Program (the program 10 being purchased) are transmitted to the purchaser.

(*Id.*, Col. 3, lines 9-11).

n. Execute the Control Transfer Program and transmit the Storing Program and the Target Program to the customer's computer. This is done once the Primary Protection Program has been run and there is reasonable assurance that neither of these programs can be copied without authorization.

(*Id.*, Col. 8, lines 28-33).

d) Storage means

Chernow further discloses storing the program on both the host computer and the purchaser's computer or other means of storage:

(1) At communication terminal

The Storing Program is a program for modifying the Target Program (the program being purchased) as the latter is being stored on the purchaser's hard disk or floppy disk.

(*Id.*, Col. 3, lines 9-14).

(2) At host facility

The hardware requirements are that the computer must be capable of utilizing modems, have a large rapid access storage capacity (e.g., a hard disk), meet the processing power requirements and have the ability to back up stored files.

(*Id.*, Col. 10, lines 27-32).

4. Computer Storage Capacity

The storage capacity must be sufficient to accommodate all of the programs required to interact with the customer and complete a sale, the database, and one each of the complete stock of Target Programs for sale.

(*Id.*, Col. 11, lines 1-4).

The [seller's] computer also contains sufficient memory and disk space to accommodate a library of the software programs available for lease or sale, an index file to permit buyers to browse through the names, brief descriptions and prices for leasing or purchasing of the available software, and the software necessary to perform the requisite tasks.

(*Id.*, Col. 2, lines 30-36).

The Database contains an index file of all available Target Programs for lease or purchase. This index is accessible by customers who telephone into the central computer. It also contains pricing information, approximate time to transfer and a brief description of each Target Program.

(*Id.*, Col. 8, lines 63-68).

e) **Executing means**

Chernow further describes the customer executing the program once received:

Describe how to execute the program and return control of the customer's computer to the customer. At this point the transfer of the purchased program has been completed.

(*Id.*, Col. 8, lines 53-57).

f) **Clock means**

Chernow further discloses clock means for measuring a predetermined time, for use in determining the period during which the customer may use the leased software.

(1) **Timing from receipt**

In the preferred embodiment, the Storing Program notes the exact physical location of the software on the disk, ***the exact time and date the software was stored on the disk***, and the serial number of the operating system. The Storing Program then embeds this information into the stored software. When the software is put to use, it will at some point during its operation look for the exact location at which it is stored on disk, the time it was stored and the serial number of the operating system. If these parameters as determined by the software do not agree with those embedded in the software by the Storing Program, the software will either not run or erase itself.

(*Id.*, Col. 4, lines 23-36).

(2) **Timing from start of execution**

The Chernow software is further capable of measuring a term of use beginning with execution or use of the program or software on the customer's computer:

The term of use for the leased software can either be a period of time or a number of runs. The specific information can be encryptically stored within the leased software. When leased software is used, the number of runs remaining under the lease or a periodic update of the time remaining under lease is encryptically recorded within the program image in memory and on disk.

(*Id.*, Col. 5, lines 10-18).

A method as defined in Claim 5, wherein said step of modifying said particular program comprises modifying said particular program so that *it may be used for only a predetermined period of time*.

(*Id.*, Claim 8, Col. 14, lines 33-36).

g) Interference means

Chernow further discloses interfering with use of the software after the lease period has expired:

Another object of this invention is to permit the purchaser to rent the protected software for a period of time after which it will self destruct.

(*Id.*, Col. 2, lines 3-5).

With this system in place, it becomes possible to lease software for a prescribed term of use.

(*Id.*, Col. 4, line 68 – Col. 5, line 2).

The Storing Program performs a number of tasks. One example of these tasks and a suitable order for their performance is as follows, with reference to the flow chart of FIG. 2.

* * *

c. The central computer is contacted to determine if the Target Program is to be leased or purchased. An alternative to this contact could be accomplished by preprogramming the Storing Program with this information prior to transferring it to the customer's computer. If leased, the details of the lease arranged are passed onto the Storing Program so that they may be incorporated into the Target Program. This information is encrypted by the Storage Program and placed in the Target Program.

(*Id.*, Col. 9, lines 45-48; Col. 10, lines 3-12).

(1) Deletion

Interference may be accomplished by deletion of the program:

At the conclusion of the term of use, the software renders itself unusable or erases itself from the user's disk.

(*Id.*, Col. 5, lines 16-18).

(2) Blocking view of display

Alternatively, Chernow discloses rendering the software unusable (*see id.*), which effectively blocks the program from being displayed on the user's monitor, which otherwise describes the program information:

Send a message of the satisfactory completion of the transfer of the Target Program to the customer's monitor or terminal. Describe how to execute the program and return control of the customer's computer to the customer. At this point the transfer of the purchased program has been completed.

(*Id.*, Col. 8, lines 52-57).

Therefore, Chernow inherently discloses interference by blocking display of the program after the end of the lease term.¹⁰

(3) Preventing sound generation

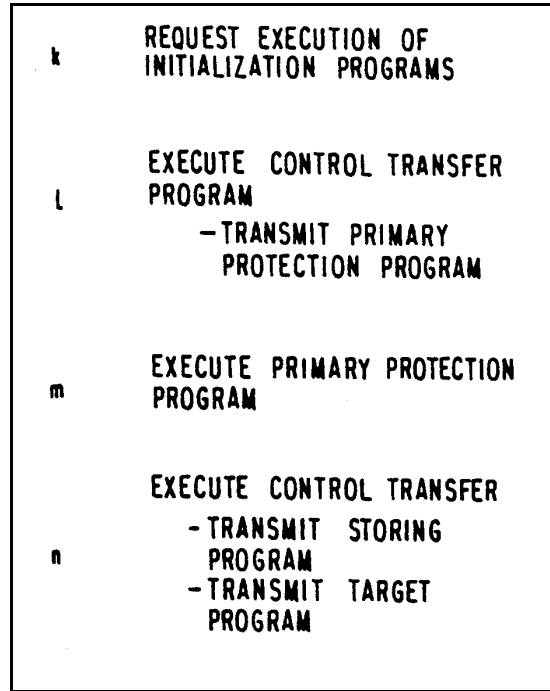
Chernow inherently discloses preventing generation of any sound from the selected program after the lease period ends, because the program itself is disabled. (*See id.*, Col. 5, lines 16-18).¹¹

h) Sending out means

Chernow further provides a means for sending out the program to the customer's computer:

¹⁰ This view of deleting or disabling execution of a program as inherently disclosing blocking the view of the display, cited throughout this Request, is consistent with ADC's infringement contentions, which equate disabling use of the program with blocking the display of said program. *See, e.g.*, Exhibit 3, Pg. 13.

¹¹ This view of deleting or disabling execution of a program as inherently disclosing preventing sound generation, cited throughout this Request, is consistent with ADC's infringement contentions, which equate disabling use of the program with blocking the display. *See, e.g.*, Exhibit 3, Pg. 13.



Reexam Figure 5 – Chernow, FIG. 1B

The requisite tasks of the software include...transmitting requested software and special programs, and activating the special programs that protect the transmitted software from being proliferated.

(*Id.*, Col. 2, lines 37-40).

Under control of the Control Transfer Program, a Storing Program and the Target Program (the program 10 being purchased) are transmitted to the purchaser.

(*Id.*, Col. 3, lines 9-11).

2. The Kato Prior Art

Japanese Laid Open Patent Application No. H04-10191, to Makoto Kato, published on January 14, 1992, discloses an “Online Software Automatic Vending Machine.” Kato discloses most of the elements that Applicant claimed were novel, and contains all of the elements of a number of the ‘520 patent claims, including means for transferring and storing software, means for measuring a period of authorized use, and means for interfering with said use after the end of the predetermined period. Kato was neither cited by the Applicant, nor cited or relied upon by the

Examiner during prosecution of the '520 patent, is not cumulative to the references considered during the original prosecution, and, as demonstrated below and in the specific SNQs, raises new questions of patentability as to certain claims of the '520 patent.

a) A communication system for transmitting a program and/or data from a host facility to a communication terminal device

Kato discloses providing software (e.g., music or games) which may be used for a limited time on a user's computer after downloading it from a host computer:

In carrying out the present invention and according to one aspect thereof, there is provided a software automatic sale environment in which a host station is provided for collectively storing and managing various kinds of software provided by software developers, the host station being connected online to a software automatic vending machine via telephone line.

(Kato, Pg. 7).

[T]he development of the software to be run on these computers is very active, ranging over various fields, from so-called business software including word processors, spreadsheets, and databases to computer graphics, music, games, and so on.

(*Id.*, Pg. 5).

b) An input device

Kato further discloses an input device:

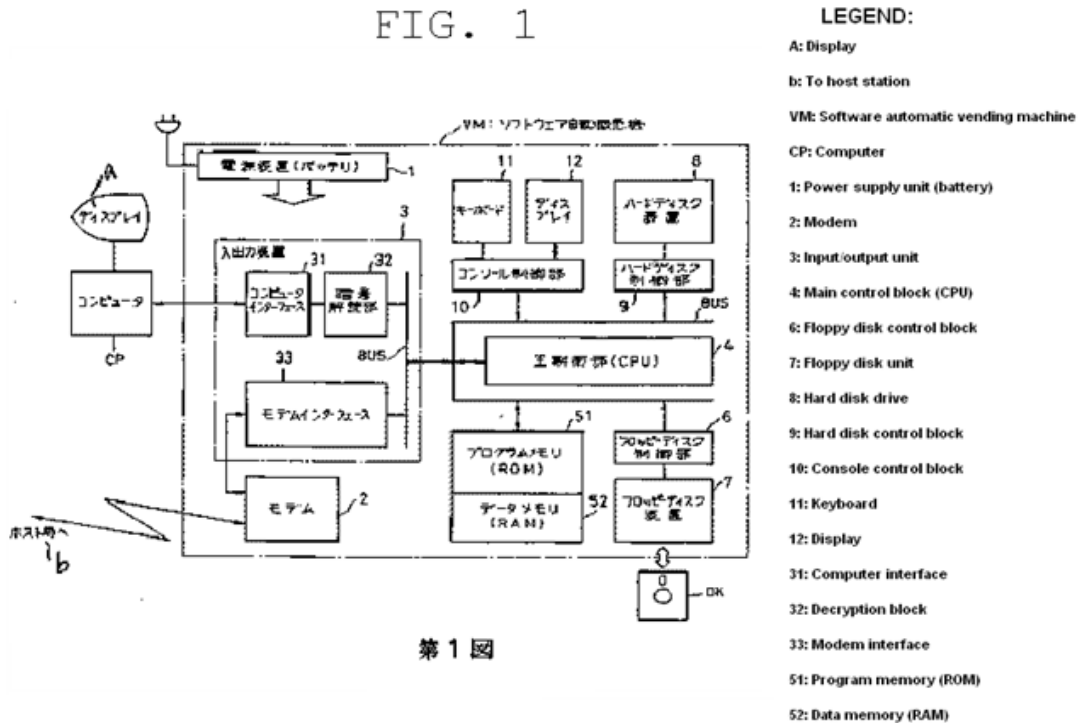
In the software automatic vending machine shown in FIG. 8, 11 denotes a keyboard, 12 denotes a display, and 7 denotes a floppy disk unit, which are detachably connected to a computer main body via cables, not shown. The keys mentioned in FIG. 8 on the above-mentioned keyboard 11, "M" key is for displaying a software menu screen, "R" key is for displaying the use, contract record, etc. of the software purchased so far through the software automatic vending machine, "S" key is pressed to save the data and the like generated by use of various kinds of software to a diskette (or a floppy disk) loaded on the above-mentioned floppy disk unit 7, "O" key is pressed beforehand to execute, through the above-mentioned keyboard 11 and the display 12 of the software automatic vending machine, such a communications operation with the host station as placing an order for software to be described later, "C" key is pressed to call the host station, "Y" key is pressed to select "Yes" to question by "Yes (Y) or

No (N)” from the software automatic vending machine, “N” key is pressed to select “No” to question by “Yes (Y) or No (N)” from the software automatic vending machine, a key group 11a is a numeric key group, a key group 11b is an arrow key group (or a cursor moving key group), and 11c denotes the Enter key.

(*Id.*, Pgs. 11-12).

c) Receiving means

Kato further discloses receiving means for the software being purchased:



Reexam Figure 6 – Kato, FIG. 1

In this software automatic vending machine, reference numeral 1 denotes a power supply unit (or a battery) for supplying power to each component of the software automatic vending machine and reference numeral 2 denotes a modem, incorporated in the software automatic vending machine, for modulating and demodulating various kinds of information including software to be transferred with the above-mentioned host station H via telephone line into signals having predetermined formats.

(*Id.*, Pg. 13). (See also *id.*, Pgs. 13-14; FIG. 1).

d) Storage means

Kato further discloses means for storing the data received, both at the communication terminal and the host facility:

(1) At communication terminal

It should be noted that the second storage means is a recording media (including a hard disk drive or the like for example) that has a storage capacity enough for collectively storing all necessary above-described software automatic-sale-contracted so that, by supplying software (programs) from this recording media to a target computer that uses the software, this software automatic vending machine may be regarded as an external storage unit of a kind for that computer, thereby allowing the use of the computer with a sufficient margin with respect to storage capacity.

(*Id.*, Pgs. 8-9).

Further, in the software automatic vending machine of this embodiment, [...] reference numeral 8 denotes a hard disk unit for storing the software transmitted from a host station H and the information such as a software accumulated use record and a software accumulated contract record [...].

(*Id.*, Pg. 16). (*See also id.*, Pgs. 7-8, 25-26, 36; FIG. 1).

(2) At host facility

As shown in FIG. 7, the present invention premises the arrangement of a host station H that is capable of collectively storing and managing various kinds of software provided by software developing corporations or persons. This host station H includes a storage block H1 based on a mass storage media for storing these various kinds of software [...].

(*Id.*, Pg. 10).

[T]he development of the software to be run on these computers is very active, ranging over various fields, from so-called business software including word processors, spreadsheets, and databases to computer graphics, music, games, and so on.

(*Id.*, Pg. 5). (*See also id.*, Pgs. 19-20; FIG. 7).

e) Executing means

Kato further discloses means for executing a program or data:

In the present embodiment, reference numeral 4 denotes a main control block (CPU) for entirely controlling each operation of the software automatic vending machine, reference numeral 51 denotes a program memory (a ROM for example) storing beforehand various control programs to be executed by the main control block 4, reference numeral 52 denotes a data memory (a RAM for example) for storing various kinds of data such as the purchase contract information inputted through the above-mentioned keyboard 11 and the data that is generated every time a control operation is executed by the main control block 4. Substantially, main control and processing as the software automatic vending machine are executed by means of the above-mentioned components.

(*Id.*, Pg. 14).

Further, in the software automatic vending machine of this embodiment, [...] reference numeral 10 denotes a console control block for transmitting user commands entered through the above-mentioned keyboard 11 to the main control block 4 and controlling the display operation of the above-mentioned display 12 under the control of the main control block 4.

(*Id.*, Pg. 16). (*See also id.*, Pgs. 26-27; FIG. 1).

f) Clock means

Kato further discloses measuring the time period of allowed usage, either from receipt or execution of the software:

(1) Timing from receipt

(12) If the user is determined to be qualified in the determination of the user qualification, the contract software is transmitted from the host station in aforementioned protected status (superimposed with an encryption signal) (step S125 shown in FIG. 3 (b)). Therefore, the software automatic vending machine (the main control block 4) stores the transmitted software in the above-mentioned hard disk unit 8 in the protected status (step S126 shown in FIG. 3(b)) and stores the information (added to the transmitted software) indicative of the encryption pattern of the encryption signal superimposed on the software into the data memory 52, thereby disconnecting the above-mentioned logically connected line upon completion of the transmission (step S127 shown in FIG. 3(b)).

(13) Next, the main control block 4 starts a timer incorporated therein (hereafter referred to as a contract timer) (step S128 shown in FIG. 3(b)) and displays a screen for example as shown in FIG. 5(e) on the

display 12 as software use information (step S129 shown in FIG. 3(b)). It should be noted that this use information always displayed on the display 12 until the contract time is reached while updating the information in “Time Left” box. The use information can be displayed also on the display of the user’s computer CP in the subsequent operation mode “Computer Operation”. In this case, pressing a predetermined defined key (“Home” key for example) window-displays the use information in one part of the display screen.

(*Id.*, Pgs. 25-26).

(15) Concurrently with the above-mentioned processing, the main control block 4 always monitors the contract time by referencing the above-mentioned contract timer (step S132 shown in FIG. 3(b)) and, at the same time, monitors any computer operation for ending the execution of the contract software (an application program), such as the pressing of “End” key for example, through the computer interface 31 (step S133 shown in FIG. 3(b)). [...] If it is determined that the contract time has been reached during the above-mentioned monitoring period (step S132 shown in FIG. 3(b)), the main control block 4 also stops this contract timer (step S137 shown in FIG. 3(b)). It should be noted that, in the monitoring of the contract time, the user may be notified of the expiration before a certain period of time (five minutes for example).

(*Id.*, Pgs. 28-29). (*See also id.*, Pgs. 30-31).

(2) Timing from start of execution

If the user selects “End” for example (step S145 shown in FIG. 3(c)), then the main control block 4 switches the above-mentioned screen to a screen as shown in FIG. 5(f) for example as an account screen (step S146 shown in FIG. 3(c)) and closes an account based on the actual execution time of the contract software (in the case of the end due to the expiration of the contract time, the execution time is the contract time; in the case of the end halfway through the contract time, the execution time is a time from the startup of the above-mentioned contract timer to the discontinuation thereof by the above-mentioned processing (15)). Then, the result of the accounting is transmitted to the host station (step S147 shown in FIG. 3(c)) and, at the same time, written to a predetermine record data storing area of the hard disk unit 8 (step S148 shown in FIG. 3(c)), thereby disconnecting the logical line connection status at that point of time (step S149 shown in FIG. 3(c)). Further, the main control block 4 automatically deletes the contract software stored in the hard disk unit 8 (step S150 shown in FIG. 3(c)), thereby ending all processing associated with “Rental mode” as the software automatic vending machine.

(*Id.*, Pgs. 30-31). (*See also id.*, Pgs. 25-26, 28-29, above).

**(3) Second clock timing
shorter period, providing warning alarm**

Kato further discloses keeping a second shorter time period to notify the user of the pending expiration of the software license:

It should be noted that, in the monitoring of the contract time, the user may be notified of the expiration before a certain period of time (five minutes for example).

(*Id.*, Pgs. 28-29).

g) Interference means

Kato further discloses providing means for interfering with use of the software, including deletion. (*See, e.g.*, Pgs. 28-29, 30-31, above).

(1) Blocking view of display

Kato further discloses a display, on which software is viewed.

In the software automatic vending machine shown in FIG. 8, 11 denotes a keyboard, 12 denotes a display, and 7 denotes a floppy disk unit, which are detachably connected to a computer main body via cables, not shown.

(*Id.*, Pgs. 11-12).

Further, in the software automatic vending machine of this embodiment, [...] reference numeral 10 denotes a console control block for transmitting user commands entered through the above-mentioned keyboard 11 to the main control block 4 and controlling the display operation of the above-mentioned display 12 under the control of the main control block 4.

(*Id.*, Pg. 16). (*See also id.*, Pgs. 11, 40-41; FIG. 1).

Kato's disclosed interference would inherently interfere with this display. (*See id.*, Pgs. 28-29, 30-31, above; *see also id.*, Pgs. 7-8, 14-16, 37-38, and 38-39).

(2) Preventing sound generation

Kato discloses the software including music, and therefore explicitly or inherently discloses a system having a sound generation means:

The recent popularization of personal computers, office computers, workstations, and so on (hereafter generically referred to as computers) is remarkable. At the same time, the development of the software to be run on these computers is very active, ranging over various fields, from so-called business software including word processors, spreadsheets, and databases to computer graphics, music, games, and so on.

(*Id.*, Pg. 5).

When the software to be sold through these software automatic vending machine VM1 through VMn is actually used, these software automatic vending machine VM1 through VMn are externally connected to computers CP used by users.

(*Id.*, Pg. 11). (*See also id.*, Pg. 6; FIG. 7).

Kato's disclosed interference would inherently interfere with this sound generation. (*See id.*, Pgs. 28-29, 30-31, above; *see also id.*, Pgs. 7-8, 14-16, 37-38, and 38-39).

h) Sending out means

Kato further discloses means for sending out the software:

This host station H includes [...] a management block H2 for managing the software stored in the storage block H1 and provides and executes various user services to be described later as the host station H, a modem H3, connected via a plurality of software automatic vending machines according to the present invention and a telephone line, for modulating and demodulating the software and various kinds of information to be transmitted and received between the software automatic vending machines and the above-mentioned management block H2 into signals of predetermined formats.

(*Id.*, Pgs. 10-11).

As shown in FIG. 7, VM1 through VMn are indicative of software automatic vending machines interconnected through the modem H3 of the above-mentioned host station H and telephone lines.

(*Id.*, Pg. 11). (*See also id.*, Pgs. 8, 11, 13-14, 25, 36-37; FIG. 7).

3. The Nakagawa Prior Art

United States Patent No. 4,922,420, entitled “Video Game Software Selection Data Processing System,” issued on May 1, 1990 to Katsuya Nakagawa *et al.*, discloses most of the elements claimed by Applicant, and all of the elements recited in a number of the claims of the ‘520 Patent. Nakagawa was neither cited by the Applicant, nor cited or relied upon by the Examiner during prosecution of the ‘520 patent, is not cumulative to the references considered during the original prosecution, and, as demonstrated below and in the specific SNQs, raises new questions of patentability as to certain claims of the ‘520 patent.

a) A communication system for transmitting a program and/or data from a host facility to a communication terminal device

Nakagawa discloses a communication system for transferring game software from a host:

[T]he principal object of the present invention is to provide a novel game software service system 45 capable of selection of a plurality of game programs without interchange of storage mediums.

(Nakagawa, Col. 1, lines 44-47).

An expansion box interface 126 is connected to the expansion multi-pin connector 34 as shown in FIG. 1, and in this embodiment, a CATV interface 128 is installed to enable coupling with a CATV system.

(*Id.*, Col. 7, lines 15-18).

Furthermore, a remote control function can be constituted also using this system.

* * *

Also, by using the AC power line, for example, exchange of arbitrary game software data can be also performed between the front and the room.

* * *

In addition, in the above-described embodiment, to facilitate exchange of the game software, the memory cartridge 18 is loaded from the outside of the main unit 12, but it may be loaded in an attachable/detachable manner in the main unit 12.

(*Id.*, Col. 11, lines 50-51, 57-59, 64-68).

[T]he principal object of the present invention is to provide a novel game software service system 45 capable of selection of a plurality of game programs without interchange of storage mediums.

(*Id.*, Col. 1, lines 44-47).

b) An input device

Nakagawa discloses an input device:

Controllers 22a and 226 which play the game and are utilized to select the game cartridge 18 loaded in each 35 slot 16 and also a light gun 23 for playing shooting game are connected to the front panel 14.

(*Id.*, Col. 3, lines 34-37).

When a controller is operated to select the game software, a menu showing respective game programs of the storage media loaded in the slots is displayed on the screen of the monitor connected thereto. When a game software displayed in that menu is selected by the second operating means such as a controller, the game by that selected game software is made playable by the enabling means.

(*Id.*, Col. 2, lines 3-10). (*See also id.*, FIGS. 1, 22a, 22b).

c) Receiving means

Nakagawa further discloses receiving means:

As described above, the μ P 60 and the PPU 62 receive data from the respective ROMs of the game cartridge 18 connected selectively by the selector 116, perform proper data processing, and give the audio signal and the video signal to the interface 104, respectively.

(*Id.*, Col. 12, lines 6-11).

d) Storage means

Nakagawa further discloses storage means, both at the communication terminal, and the host facility:

(1) At communication terminal

Thereafter, in the step S209, likewise the previous step S11, the number of the cartridge to be set next, that is, the bank number is set in the S-RAM control area of the working RAM 86.

(*Id.*, Col. 10, lines 44-47). (*See also id.*, FIG. 3B, block 86 [Working RAM] and associated text; FIG. 6, blocks S207 [Transfer Program] & S209 [Set Bank Number] and associated text; FIGS. 1, 22a, 22b).

(2) At host facility

As shown in FIG. 1, a plurality of slots 16 (16 slots including a built-in slot 16a) are installed, and the game cartridge 18 is loaded in each of the slots 16. A plurality of game cartridges 18 and one monitor memory pack 18a loaded in such a manner constitutes one block by a predetermined number (four in this embodiment), and in this embodiment, since 16 slots 16 (16a) are formed, four blocks BLK0-BLK3 20 are formed. Each of the blocks BLK0-BLK3 is composed of four banks BK0-BK3, respectively.

(*Id.*, Col. 6, lines 23-32). (*See also id.*, FIG. 3c, and associated text).

[E]ach of the game cartridges, that is, the banks BK1-BK3 includes a program memory and a character memory.

(*Id.*, Col. 6, lines 47-49).

e) Executing means

Nakagawa further discloses means for executing the software:

In addition, the controllers 22a and 22b are connected to the μ P 60 through the controller I/O 92. Then, the μ P 60 gives a select signal to the selector 116 in response to an operation of either of the controller 22a and 22b, and the game can be played by operating the controllers 22a and 22b.

(*Id.*, Col. 12, lines 59-64) (*See also id.*, Col. 2, lines 3-10, above; FIG. 1, block 60 [CPU]; FIG. 7, block 60 [μ P]).

f) Clock means

Nakagawa further discloses clock means.

(1) First clock

Nakagawa discloses means for keeping a first time period, measuring time from deposit of funds, and the duration of use of the program:

In one embodiment, when coins are put in, timer means is operated and a time count is started, and a game image is displayed on the screen of the monitor.

(*Id.*, Col. 2, lines 31-33).

On the other hand, attending [sic] on a selection of the kind of game by the player, in response to a signal outputted from the μ P 60, any one of the clocks ϕ 1- ϕ 3 given from the clock generator 142 is selected by the clock selecting circuit 144, being given to the AND gate 146. At this time, the carrier signal or count-up signal of the counter 148 is the low level, and accordingly, a clock from the clock selecting circuit 144 is given to the counter 148 starts to count.

(*Id.*, Col. 13, lines 60-68).

(2) **Second clock timing shorter period**

Nakagawa further discloses keeping a second time period to warn that the first time period is expiring:

When the residual time determined according to the amount of money of the coins put in becomes short, the level of luminance of the game image on the screen of the monitor is varied by varying means, and the screen blinks. This variation in the level of luminance, that is, blinking notices the player in advance that the playing time allowed by the put-in coins will soon expire.

(*Id.*, Col. 2, lines 34-40).

The data set by the data setter 156 is any one of values 0-1023 counted by the counter 148, ***and data equivalent to a time a little shorter than the timer time of play allowed*** by the unit amount of money of the coins put-in is set. Accordingly, a signal from the comparator 154 is outputted as the "near end" signal for notifying in advance that the game is brought to an end after a lapse of the time according to the amount of money of the coins put in at that time.

(*Id.*, Col. 13, lines 34-42).

g) **Warning alarm**

Nakagawa further provides an alarm to warn the user that time is expiring:

In accordance with this embodiment, a previous notice of the game end can be made to the player by variation in the luminance (blinking) on the screen of the monitor by the varying means. Accordingly, the

deficiency that the gaming machine is stopped suddenly despite that the game is under playing can be avoided unlike the conventional coin-operated video gaming machine.

(*Id.*, Col. 2, lines 41-48).

The interface 104 includes a level shifter 136 for shifting up or shifting down the signal level, preferably the luminance level of the video signal in particular out of the video signal and the audio signal to be given. The level shifter 136 operates in response to an output from an AND gate 138. A "near end" signal and a clock $\phi 4$ from the coin box 52 are given to two inputs of AND gate 138. Accordingly, the level shifter 136 changes the luminance level of the video signal to be given in response to the period of the clock $\phi 4$ when the "near end" signal is given.

(*Id.*, Col. 12, lines 12-22).

Accordingly, on the screen of the TV receiver 32, so-called blinking is produced that the luminance of display varies little by little in response to the change in the luminance level. Consequently, the player can know that the rest of the gaming time allowed by the coins put in is short by watching the screen of the TV receiver 32.

(*Id.*, Col. 14, lines 29-35). (*See also id.*, Col. 2, lines 34-40, above).

**h) Interference means, inherently including
blocking view of display and/or preventing sound generation**

Nakagawa further discloses interference means, and inherently discloses blocking a display and preventing sound generation as a result of the interference:

The reset controlling circuit 96 is connected to the controller switch-over circuit 94. When the key switch 24 is turned on, when reset switches (not illustrated) of the controllers 22a and 22b are depressed, or when a presettable timer 98 expires, the reset controlling circuit 96 outputs a reset signal to the CPU 60 in response to any signal thereof. Specifically, the reset controlling circuit 96 includes a circuit for selecting any one of various reset signals from the reset switch 28, the controller switch-over circuit 94 and the presettable timer 98 as described later and a flag for deciding the reset signal having come and storing it, and is enabled by the chip enable signal CE3 from the address decoder 82.

(*Id.*, Col. 5, lines 46-60).

[I]f the player does not put in additional coins again, the counter counts "1024", and the count-up signal becomes the high level. Accordingly, the timer-on signal falls as shown in FIG. 8B, and the monostable multivibrator 132 included in the reset circuit 96 is triggered. Accordingly, a pulse is outputted from the monostable multivibrator 132, being given to the reset signal generating circuit 134. Accordingly, as shown in FIG. 8F, from the reset signal generating circuit 134, a reset signal is given to the μ P 60 simultaneously with a count-up of the counter 148. Thereby, the μ P 60 is reset and thereafter the game playing cannot be continued.

(*Id.*, Col. 14, lines 36-47). (*See also id.*, Col. 2, lines 34-40, above).

Nakagawa further discloses a display and sound generating means.

[T]he audio signal is outputted from the CPU 60 and the video signal is outputted from the PPU 62. These two signals are given to the RF modulator 106 through the AV-RF controller 104. Then, the signal from the RF modulator 106 is given to the monitor, that is, television receiver 32, and thereby such a display of information can be performed.

(*Id.*, Col. 9, line 54 – Col. 10, line 2).

On the rear panel 40, further an output terminal 44 which can be connected to a video input terminal (not illustrated) of the monitor or the TV receiver 32 and an audio output terminal 46 which can be connected to an audio input terminal (not illustrated) of the TV receiver 32 are installed.

(*Id.*, Col. 4, lines 22-27).

The video signal from the RF modulator 106 is outputted from the above-described video output terminal 44 as shown in FIG. 2, and the audio signal is outputted from the audio output terminal 46.

(*Id.*, Col. 6, lines 16-20). (*See also id.*, Col. 2, lines 3-10, above; FIGS. 1, 32).

Nakagawa's disclosed interference would inherently interfere with this display and/or sound generation:

Furthermore, where the reset signal from the presettable timer 98 has been given during play of the game, in the next step S43, expiration of the presettable timer 98 is displayed, and processing proceeds to the step S27.

(*Id.*, Col. 9, lines 51-54).

Then, when the time of a length according to the amount of money of the coins put in elapses, the game is brought to an end by a time-up signal from the presetable timer 98.

(*Id.*, Col. 11, lines 40-43).

[I]f the player does not put in additional coins again, the counter counts "1024", and the count-up signal becomes the high level. Accordingly, the timer-on signal falls as shown in FIG. 8B, and the monostable multivibrator 132 included in the reset circuit 96 is triggered. Accordingly, a pulse is outputted from the monostable multivibrator 132, being given to the reset signal generating circuit 134. Accordingly, as shown in FIG. 8F, from the reset signal generating circuit 134, a reset signal is given to the μ P 60 simultaneously with a count-up of the counter 148. Thereby, the μ P 60 is reset and thereafter the game playing cannot be continued.

(*Id.*, Col. 14, lines 36-47).

Then, after blinking has been produced, if no coin is put in, the μ P 60 is reset intact, and the game playing after that cannot be continued.

(*Id.*, Col. 15, lines 2-4).

Additionally, Nakagawa discloses that the monitor can be turned off in response to inputs relating to calculation monies paid.

Furthermore, a remote control function can be constituted also using this system. For example, by using the CATV interface 128, calculation of charged money can be performed in the working area of the CPU 60 or the power supply of the system including the TV receiver 32 as a monitor can be turned on or off through the CATV line of the hotel or the like.

(*Id.*, Col. 11, lines 50-55).

Turning off the monitor would interfere with both display and sound generation.

i) Sending out means

Nakagawa further discloses means for sending out software:

The respective banks BK0-BK3 of each of the blocks BLK0-BLK3 are connected in parallel so as to be located in an overlapped manner in the same address space when viewed from the CPU 60 and the PPU 62, but only the bank (game cartridge 18) corresponding to one game software selected by the menu mode is enabled selectively.

(*Id.*, Col. 6, lines 37-43).

Also, by using the AC power line, for example, exchange of arbitrary game software data can be also performed between the front and the room.

* * *

In addition, in the above-described embodiment, to facilitate exchange of the game software, the memory cartridge 18 is loaded from the outside of the main unit 12, but it may be loaded in an attachable/detachable manner in the main unit 12.

(*Id.*, Col. 11, lines 57-59, 64-68).

4. The Oseki Prior Art

Japanese Laid Open Patent Application No. H04-158441, to Oseki Masayoshi, published on June 1, 1992, discloses a “Software Lending System And Loaned Software Copy Prevention Method.” Oseki discloses most of the elements that Applicant claimed were novel, and contains all of the elements of a number of the ‘520 patent claims, including means for transferring and storing software, means for measuring a period of authorized use, and means for interfering with said use after the end of the predetermined period. Oseki was neither cited by the Applicant, nor cited or relied upon by the Examiner during prosecution of the ‘520 patent, is not cumulative to the references considered during the original prosecution, and, as demonstrated below and in the specific SNQs, raises new questions of patentability as to certain claims of the ‘520 patent.

a) A communication system for transmitting a program and/or data from a host facility to a communication terminal device

Oseki discloses a system for lending software for a period of use via communication lines from a provider to an end user:

In this software lending system, first, the user uses the transmission means 7 to transmit information, such as the name of the AP file that they wish to use and their member number, etc., to the provider via the line 6. This request information is received by the receiving means 2 on the provider side. This information is passed to the management means 3, which confirms whether that member has been registered, if

they are registered, it then performs management of AP lending costs, etc., and as long as there are no particular problems, sends the AP file name to the reading means 4. The reading means 4 reads this AP file from the memory means 1 and sends it to the transmission means 5, which transmits it to the user.

(Oseki, Pg. 5).

On the user side, information, such as this AP file, etc., is saved to a memory whose contents are deleted when there is a power outage without battery backup, etc., or when the power is turned OFF. Once saving of the entire AP file to this memory has been completed, control shifts to the AP file and the AP file is executed, and after execution is completed (or when a specified time has lapsed from the time the AP was loaned, or when this AP is run and the quantity of data input by the user reaches a set quantity, or when the quantity of produced data output reaches a set quantity), control shifts to the deletion means 10 and the AP file is deleted.

(*Id.*, Pg. 5).

b) An input device

Oseki further inherently discloses an input device, by virtue of reciting a user side wherein the user makes requests. (*Id.*, Pgs. 4-5).

c) Receiving means

Oseki discloses means for receiving the loaned programs:

Figure 8 is a flowchart that shows the processing sequence for the AP file receiving processing RECV in Figure 7. In this receiving processing, which corresponds to the transmission processing on the provider side in Figure 2, the AP file sent in this transmission processing is received and it is determined whether receiving was completed normally, and in the event of abnormal receiving, the error flag is turned ON and processing returns to the program in Figure 7, and in the event of normal receiving, the error flag is turned OFF and processing returns to the program in Figure 7.

(*Id.*, Pg. 7).

d) Storage means

Oseki further discloses storage means, both at the communications terminal and at the host facility:

(1) **At communication terminal**

(See, e.g., *id.*, Pg. 5, above).

(2) **At host facility**

First, the software provider side comprises a memory means 1 on which various application software (hereinafter, AP) is stored, a means 2 to receive AP file read information related to requests from users, a member AP lending management means 3 that analyzes information from users to confirm member numbers, etc., a means 4 that receives instructions from this management means 3 and reads the AP file desired by the user from the memory means 1, and a means 5 that transmits the read AP file to the user via the line 6.

(*Id.*, Pg. 4).

e) **Executing means**

Oseki also discloses executing the loaned software on the user side:

Figure 9 is a flowchart that shows the processing sequence for the AP execution processing APEXE in Figure 7. Execution of the AP is essentially dependent on the AP itself, but generally, initialization processing is performed, then normal processing is performed until there is an end command, and when an end command is received, execution of the AP is terminated. However, assuming that it is possible that the AP will be run for a long period of time, there is a chance that problems will arise from the viewpoint of copyright protection. Therefore, a command to automatically terminate the AP is issued when the cumulative AP run time or AP memory existence time passes a specified time, or when the number of key entries reaches a specified number, or when the amount of produced data output reaches a specified amount, so that data and the like produced by running the AP up to that point are saved to disk or the like and execution is forcibly terminated.

(*Id.*, Pg. 7).

f) **Clock means**

Oseki discloses keeping a predetermined loan period, either from receipt or from execution:

(1) **Timing from receipt**

Therefore, a command to automatically terminate the AP is issued when the cumulative AP run time or AP memory existence time passes a specified time, or when the number of key entries reaches a specified number, or when the amount of produced data output reaches a

specified amount, so that data and the like produced by running the AP up to that point are saved to disk or the like and execution is forcibly terminated.

(*Id.*).

(2) **Timing from start of execution**

6. A loaned software copy prevention method that is characterized by software that has been loaded to a user via communication lines from a software provider, which stores a multiplicity of software on a memory device, being automatically deleted when the run time reaches a set time during its execution by the user.

(*Id.*, Pg. 2).

g) **Interference means**

Oseki further discloses interfering with program execution after a predetermined time period, either by deleting or disabling the program. (*See, e.g., id.*, Pg. 5, above).

Thus, the AP file is deleted after execution of the AP file is completed so that it cannot be illegally copied.

(*Id.*).

Figure 7 is a flowchart that shows the main processing sequence on the user side. First, AP file receiving processing RECV is performed. Then, it is determined whether receiving was completed normally, and if it was abnormal, error processing is performed and processing is terminated. If it was normal, execution processing for that AP APEXE is performed, and once that is completed, the AP is deleted so that this AP cannot be run again by the user (if the user wishes to run the AP again, they have to rent it again from the provider), and processing is terminated.

(*Id.*, Pgs. 6-7).

By also disclosing a computer accepting user inputs and running software for a user, Oseki also inherently discloses a display and sound generation means. By disclosing disabling the program after a set time period or event, Oseki inherently discloses that any display of said program or sound generated by said program would also be disabled.

h) Sending out means

Oseki also discloses means for sending out the loaned software:

Figure 4 is a flowchart that shows the processing sequence for the AP file transmission processing SEND in Figure 3. First, line connection is performed to connect the provider and the user via the line 6. Then, the member number is received and member number confirmation processing MNOC is performed. If as a result of that confirmation processing, that member is not already registered (enrolled), the transmission error flag is turned ON and processing returns to the program in Figure 3. If the member is already registered, the loaned AP file name is received and that AP file is sent. Then, it is determined whether transmission was completed normally, and if it was normal, the transmission error flag is turned OFF and processing returns to the program in Figure 3. If transmission was not normal, the transmission error flag is turned ON and processing returns to the program in Figure 3.

(*Id.*, Pg. 6).

5. The Bakoglu Prior Art

United States Patent No. 5,632,681, entitled “Universal Electronic Video Game Renting/Distributing System,” issued on May 27, 1997, from an application filed on March 7, 1995 by Halil Bakoglu *et al.*, discloses most of the elements claimed by Applicant, and all of the elements recited in a number of the claims of the ‘520 Patent. Bakoglu was neither cited by the Applicant, nor cited or relied upon by the Examiner during prosecution of the ‘520 patent, is not cumulative to the references considered during the original prosecution, and, as demonstrated below and in the specific SNQs, raises new questions of patentability as to certain claims of the ‘520 patent.

a) A communication system for transmitting a program and/or data from a host facility to a communication terminal device

Bakoglu discloses a communication system for transmitting video games for rental:

It is an object of this invention to provide a portable video game cartridge which can be plugged into a video game machine base unit, such as Nintendos [SIC], Sega GenesisTM video game machine or Atari's JaguarTM video game machine. The cartridge will allow a video game program to be used by receiving the video program over a telephone network or cable system.

(Bakoglu, Col. 1, lines 54-60).

The current invention describes a way of distributing and controlling the usage of a video game program (or any software program) by using a "watchdog mechanism" and by limiting the "life" of a game by limiting the total number of graphic frames that a video machine can generate. It offers a simple and effective way of software renting and distribution where game machines have no timer.

(*Id.*, Col. 1, lines 61-67).

b) An input device

Bakoglu further discloses an input device, namely a video game base unit. (*See id.*, Col. 1, lines 54-60, above).

c) Receiving means

Bakoglu further discloses receiving means for receiving the game ordered by the user:

This invention is a video game cartridge which can be plugged into a video game machine for enabling a user to receive and play a video game for a predetermined number of frames. The cartridge has a receiver for receiving the video program and for receiving a frame count indicating the number of video frames of the video game program that the user is authorized to play. The video program and frame count is then stored in a memory of the cartridge. The cartridge also has a counter which changes the frame count when the user is actively playing the video game program. When the user is not playing the video game program, the counter ceases to change its count. Finally when the counter reaches a predetermined limit, the user is prevented from further playing the video game program.

(*Id.*, Col. 2, lines 19-33).

FIG. 2 illustrates the components of the video game cartridge unit 100. It consists of modem 201, microcontroller 202, flash memory 203 and an interface 204 to the video game base unit 102. The modem 201 performs the interface to the telephone or cable network. It can optionally perform decompression of received game or software if necessary. The received game is stored in flash memory 203. The game comes with its "life" which is indicated by the total number of graphic frames the video game machine 102 is authorized to generate when the game is actively played. For example, the game machine could render game graphics frame by frame at the rate of thirty frames [sic] per second.

(*Id.*, Col. 2, line 62 – Col. 3, line 6).

d) Storage means

Bakoglu further discloses means for storing the game, both at the communication terminal (*see id.*, Col. 2, line 62 – Col. 3, line 6, above) and the host facility (*Id.*, FIGS. 1-2).

e) Executing means

Bakoglu further discloses a means for executing the downloaded game:

This invention is generally an apparatus and method for enabling a user to request and use a program where the user receives the program and a frame count indicating the number of frames of the program that the user is authorized to execute or use. This program and the frame count is then stored in a memory. When the user is actively providing input to the program, the frame count changes. The frame count will cease to change when the user is not providing input to the program. When the count reaches a predetermined limit, the user is prevented from continuing use of the program.

(*Id.*, Col. 2, lines 8-18).

When a video game base unit 102 is powered on, a user could either play a game (or games) stored in the programmable game cartridge 100 or place an order of a new game (either for rental or for purchase) to the game or program server 101. The cartridge 100 contains screen assistance (and voice assistance) to help place an order for a video game program to the server 101.

(*Id.*, Col. 2, lines 55-61).

f) Clock means

Bakoglu further discloses renting the game for a specified period of time, either by limiting the amount of time, or the number of frames of video:

The use of expiration date or time for voiding the game is an obvious approach if the video game base unit 102 comes with a timer. Since this patent application assumes a game base unit 102 which has no timer (which is the case of many existing game machines), the "life" of the rented game is determined by the total number of graphic frames that the base game unit can generate. This "life", or frame count, is what a renter gets when a game is down loaded. It is stored into a location in the flash memory 203. The location into which the frame count is stored in the flash memory is determined randomly by the

video server at the time of the game down loading. The video game can resume at any time when it is being turned on, provided there is available frame count stored in the designated random location. The microcontroller 202 can pick up the frame count and allow the renting period, and thus the game or software, to be continued. As the rented game is being played, the frame count is decremented. When the user turns off the power, the hourglass routine in memory 203 will first store the remaining frame count to a random location in the non-volatile memory 203 and then shut down the game. The rental expires when there is no frame count remaining. The microcontroller 202 will not allow any portion of the game to be played by the game base unit 102 when the frame count reaches zero.

(*Id.*, Col. 3, lines 17-41).

A video game cartridge that can be plugged into a video game machine to enable a user to request and play a video game for a predetermined number of video frames. The cartridge has a receiver for receiving the video game program and the predetermined frame count in response to a request from the user. The program and frame count is then stored in a memory of the cartridge. Finally, the cartridge has a counter which changes its value when the user is actively playing the video game program. The counter ceases to change its value when the user is not playing the video game program. When the counter reaches a predetermined limit, the user is no longer authorized to play the video game program.

(*Id.*, Abstract).

g) Warning alarm

Bakoglu further discloses providing a warning when the time of use is soon to expire:

DESCRIPTION OF THE PREFERRED EMBODIMENT

Microcontroller (202) can also give advance warning when the rental is about to expire. Rental extension, if desired, can be downloaded again by the server (101) through a telephone or cable connection. Thus, server (101) in FIG. 1 has complete control over the game playing time, which should reflect the user's request for renting the game.

(*Id.*, Col. 4, lines 19-26).

h) Interference means

Bakoglu further discloses rendering the game unusable at the end of the rental period, and thus inherently discloses rendering the display and sound generation associated with the game unusable:

When the counter reaches a predetermined limit, the user is no longer authorized to play the video game program.

(*Id.*, Abstract).

When the user is actively providing input to the program, the frame count changes. The frame count will cease to change when the user is not providing input to the program. When the count reaches a predetermined limit, the user is prevented from continuing use of the program.

(*Id.*, Col. 2, lines 13-18).

The cartridge also has a counter which changes the frame count when the user is actively playing the video game program. When the user is not playing the video game program, the counter ceases to change its count. Finally when the counter reaches a predetermined limit, the user is prevented from further playing the video game program.

(*Id.*, Col. 2, lines 26-33).

The rental expires when there is no frame count remaining. The microcontroller 202 will not allow any portion of the game to be played by the game base unit 102 when the frame count reaches zero.

(*Id.*, Col. 3, lines 36-41).

i) Sending out means

Bakoglu further discloses means for sending out the game to be rented:

FIG. 1 illustrates a sample diagram of a electronic game or program renting system setup. The dotted line encloses the portable and programmable game cartridge unit 100 that can be plugged into a video game machine base unit 102, such as Sega Genesis™ video game machine, and remotely be connected to a video game server 101 via a modem connection. The connection to the remote video server can be through cable TV, or other telecommunication facilities.

(*Id.*, Col. 2, lines 47-54). (*See also id.*, FIGS. 1-2).

6. The Garfinkle Prior Art

United States Patent No. 5,400,402, entitled “System For Limiting Use Of Down-Loaded Video-On-Demand Data,” issued on March 21, 1995, from an application filed on June 7, 1993 by Norton Garfinkle, discloses most of the elements claimed by Applicant, and all of the elements recited in a number of the claims of the ‘520 Patent. Garfinkle was neither cited by the Applicant, nor cited or relied upon by the Examiner during prosecution of the ‘520 patent, is not cumulative to the references considered during the original prosecution, and, as demonstrated below and in the specific SNQs, raises new questions of patentability as to certain claims of the ‘520 patent.

a) A communication system for transmitting a program and/or data from a host facility to a communication terminal device

Garfinkle discloses a means for downloading and storing programs to be viewed for a fixed period of time, then disabling use thereafter:

A digital data system that includes a control system at a customer site that blocks access to a down-loaded stored program after it has been viewed a predetermined number of times (e.g., once), or after a predetermined interval, or any combination thereof.

(Garfinkle, Abstract).

This invention relates generally to video-on-demand systems, and more particularly to an improved system for controlling the use of video programs that have been down-loaded from a central station and stored at a customer's site.

(*Id.*, Col. 1, lines 7-11).

There have been a number of proposals for so-called video-on-demand systems. In certain of these proposals, a customer who wants to view a particular video program (e.g., a movie, a video game, or printed text material) will contact a central station and request a program, which will be down-loaded, at high speed, and stored at the customer's site, for later viewing.

(*Id.*, Col. 1, lines 13-19).

The link 12 serves to down-load, at high speed, a video program to a specific customer address from which an order has been placed from a

remote customer site 10. A customer order, depending on the link 12, can be placed over link 12 from the remote site 10 via an order entry unit 24 through which an order may be placed using a keyed-in code. The advantage of such an order entry unit 24 is that it presents a standard order format to the central station 14.

(*Id.*, Col. 2, line 66 – Col. 3, line 7).

b) An input device

Garfinkle discloses an input device. (*Id.*).

c) Receiving means

Garfinkle also discloses means for receiving the rented program. (*Id.*).

d) Storage means

Garfinkle further discloses means for storing the game, both at the communication terminal and the host facility.

(1) At communication terminal

The remote customer site components include a television set 18 and a digital video memory 20 such as a hard disk memory, a FLASH memory, a tape memory, optical disk memory or other suitable memory for storing the down-load video data. A microprocessor-based memory interface and memory control unit 22 provides an interface between the link 12 and the memory 20. It loads the data into assigned memory address locations. It retrieves the stored digital video data, and converts it to an analogue signal for display on the television 18. Control unit 22 also erases or otherwise (e.g., scrambles) limits access to the stored data after a use limit specified by the central station or fixed at the customer site have been met or exceeded, as will be described in greater detail in connection with FIGS. 2 and 3.

(*Id.*, Col. 3, lines 12-26).

(2) At host facility

Referring now to FIG. 1 of the drawings, it illustrates a typical video-on-demand system with which the use control system of this invention is applicable. A customer site, indicated within the dashed block 10, is connected by a high-speed data link 12 to a remote central station 14. ... Typically, the video data will be stored in digital form at the central station and at the customer site.

(*Id.*, Col. 2, lines 54-63).

e) Executing means

Garfinkle further discloses means for executing the downloaded video data:

Access to the video data storage memory 20 from the television set 18 is via the microprocessor 30 and a memory read/write control unit 44. Commands from the microprocessor 30 cause the controller 44 to store, retrieve and erase video data in memory 20.

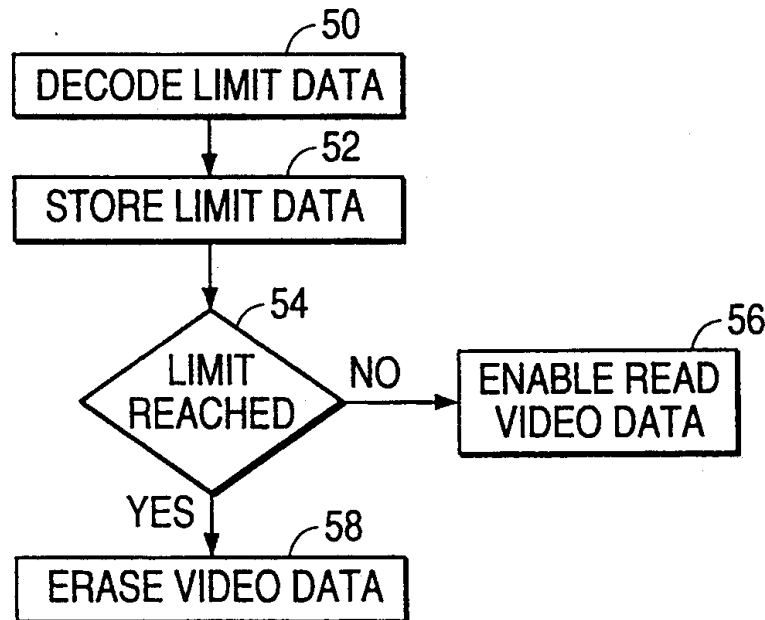
(*Id.*, Col. 4, lines 25-29).

If the result of the comparison step at block 54 is negative, the microprocessor 30 processes access requests from the television set 18 to the video data stored in memory 20 as indicated at block 56. If the result of the comparison step at block 54 is affirmative, the microprocessor 30 issues a command to controller 44 to erase the video data stored in memory 20 or to otherwise block access to the data by the television set 18.

(*Id.*, Col. 4, lines 40-48). (*See also id.*, Col. 3, lines 12-26, above).

f) Clock means timing from receipt or based on execution

Garfinkle discloses clock means allowing for the user to view the downloaded video for a period of time, or a number of uses:



Reexam Figure 7 – Garfinkle, FIG. 3

Briefly, the nature of this invention is the provision of a control system at the customer site that operates independently of the central station once the program has been down-loaded. In one embodiment, the control system erases or scrambles the stored program after it has been viewed a predetermined number of times (e.g., once), and in another embodiment the program is erased or scrambled after a predetermined interval (e.g., 24 hours). In one embodiment the stored program is erased after a predetermined interval or after a predetermined number of accesses or any combination thereof based on fixed criteria stored at the customer site. In another embodiment, the down-loaded data includes instructions that specify and controls the number of times the stored data may be accessed, or the period during which the stored material may be accessed, or any combination thereof. In each embodiment, a control system at the customer's site limits further access to the stored program after the limit has been reached.

(*Id.*, Col. 2, lines 18-36).

This may be timed from receipt, or based on execution:

Referring now to FIG. 2, in one embodiment of the invention the system limits the user to a prescribed time period (e.g., 24 hours) within which the user can view the stored program. During this period the user can access the stored program as many times as desired. In another embodiment of the invention, the system limits the user to a prescribed number of times that he is allowed to view the stored program. The time limit, or the prescribed number of times, can be encoded at the central station in instructions that accompany the down-loaded data. In this case, the period or the number of views may be specified when the customer orders the program. In one embodiment the period or number of views is fixed by the central station; in another embodiment the period or number of views may be specified by the customer when he orders the program.

(*Id.*, Col. 3, lines 27-42).

g) Interference means

Garfinkle discloses disabling the use of the downloaded data after the rental period has lapsed:

A digital data system that includes a control system at a customer site that blocks access to a down-loaded stored program after it has been viewed a predetermined number of times (e.g., once), or after a predetermined interval, or any combination thereof.

(*Id.*, Abstract).

Briefly, the nature of this invention is the provision of a control system at the customer site that operates independently of the central station once the program has been down-loaded. In one embodiment, the control system erases or scrambles the stored program after it has been viewed a predetermined number of times (e.g., once), and in another embodiment the program is erased or scrambled after a predetermined interval (e.g., 24 hours). In one embodiment the stored program is erased after a predetermined interval or after a predetermined number of accesses or any combination thereof based on fixed criteria stored at the customer site. In another embodiment, the down-loaded data includes instructions that specify and controls the number of times the stored data may be accessed, or the period during which the stored material may be accessed, or any combination thereof. In each embodiment, a control system at the customer's site limits further access to the stored program after the limit has been reached.

(*Id.*, Col. 2, lines 18-36).

(1) Deletion

Interference may be by deletion:

Access to the video data storage memory 20 from the television set 18 is via the microprocessor 30 and a memory read/write control unit 44. Commands from the microprocessor 30 cause the controller 44 to store, retrieve and erase video data in memory 20.

(*Id.*, Col. 4, lines 25-29).

(2) Blocking view of display or preventing sound generation

Interference may also be by blocking display access to display information or preventing generation of sound by the audio/video display means, e.g., the television set:

Referring now to FIG. 3 in addition to FIG. 2, in operation, the limit data is decoded from the down-loaded data stream, as indicated at block 50. This limit data may comprise a time limit or limit the number of accesses to the data, or both. The limit data is stored at block 52 in register 34 and a comparison is made at decision block 54 to determine if the limit has been reached. In the case of a time limit, this comparison can be made with the time-of-day clock 38 and with a limit on the number of accesses, the comparison can be made with access data from microprocessor 30. If the result of the comparison step at block 54 is negative, the microprocessor 30 processes access requests from the television set 18 to the video data stored in memory 20 as indicated at block 56. If the result of the comparison step at block 54 is affirmative, the microprocessor 30 issues a command to

controller 44 to erase the video data stored in memory 20 or to otherwise block access to the data by the television set 18.

(*Id.*, Col. 3, line 43 – Col. 4, line 48).

h) Sending out means

Garfinkle further discloses means for sending out the video data to the user:

The link 12 serves to down-load, at high speed, a video program to a specific customer address from which an order has been placed from a remote customer site 10. A customer order, depending on the link 12, can be placed over link 12 from the remote site 10 via an order entry unit 24 through which an order may be placed using a keyed-in code. The advantage of such an order entry unit 24 is that it presents a standard order format to the central station 14.

(*Id.*, Col. 2, line 66 – Col. 3, line 7).

7. The Hornbuckle Prior Art

United States Patent No. 5,497,479, entitled “Method And Apparatus For Remotely Controlling And Monitoring The Use Of Computer Software,” issued on March 5, 1996, from an application filed on February 28, 1995 by Gary Hornbuckle, discloses most of the elements claimed by Applicant, and all of the elements recited in a number of the claims of the ‘520 Patent. Hornbuckle was neither cited by the Applicant, nor cited or relied upon by the Examiner during prosecution of the ‘520 patent, is not cumulative to the references considered during the original prosecution, and, as demonstrated below and in the specific SNQs, raises new questions of patentability as to certain claims of the ‘520 patent.

a) A communication system for transmitting a program and/or data from a host facility to a communication terminal device

Hornbuckle discloses a means for transmitting and renting computer software (*e.g.*, video games) from a host to a user’s computer:

In a software rental system according to the principles of the present invention, a control module is installed on or in cooperation with the customer's computer (hereafter also target computer), and the customer pays for services, i.e., the use of the software, received.

(Hornbuckle, Col. 2, lines 52-56).

Specifically, the customer in a software rental system may rent any program of an entire library of computer programs at any time, rather than waiting for a particular time slot during which a particular program would be available.

(*Id.*, Col. 2, lines 60-63).

By means of the present invention, an authorized user at the target computer is able to "download" programs or data, via a telephone line and a programmable remote control module (RCM) connected at each end thereof from a central or host computer.

(*Id.*, Col. 3, lines 23-26).

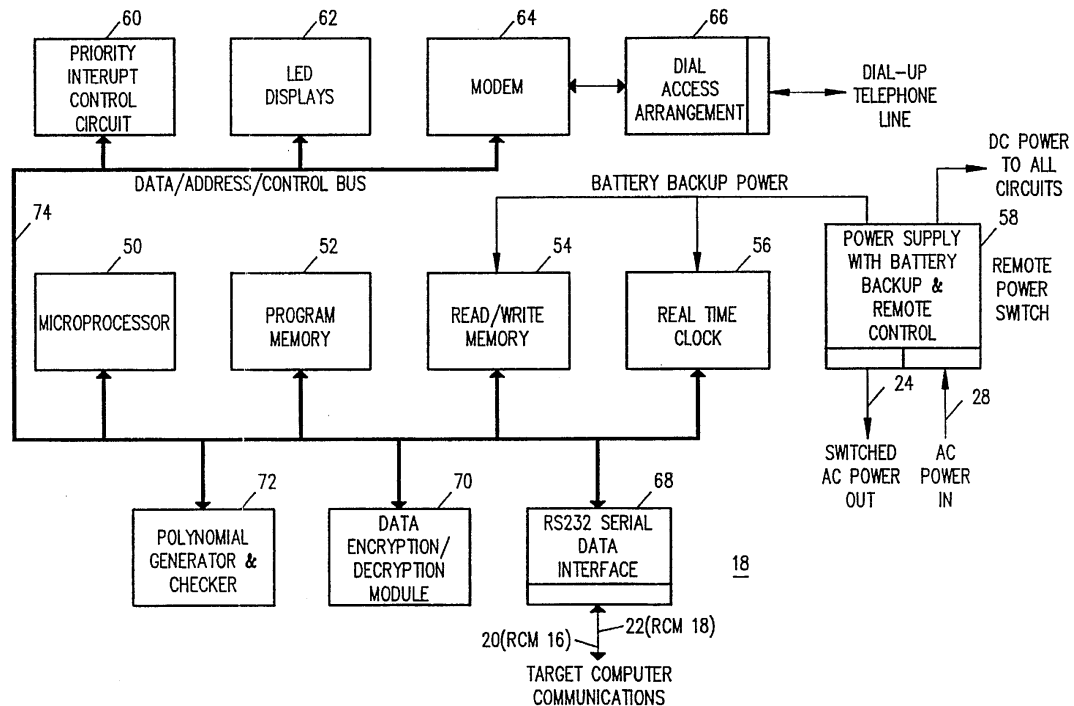


FIG. 2

Reexam Figure 8 – Hornbuckle, FIG. 2

b) An input device

Hornbuckle discloses an input device for use with the game, (*e.g.*, a computer or video game system):

A user makes a game selection via a joy stick or other input device provided with the video game system. For example, the host computer

may transmit (i.e., download) a menu to be displayed on the user's television set screen providing a selection of games available for use. Additionally, the host computer may be utilized to transmit advertising and promotional material relating to new games and other services to be displayed with the game menu.

(*Id.*, Col. 4, lines 13-21).

The game computer 15 conventionally utilizes readily available plug-in ROM game cartridges (not shown) which a user purchases. The game computer 15 and hence the progress of the game being played is controlled by well-known control devices 19 such as a joy stick or a combination of rocker switches and buttons.

(*Id.*, Col. 14, line 67 – Col. 15, line 3).

c) Receiving means

Hornbuckle further discloses means for receiving the rented software or game(s):

Moreover, it is not necessary to install a separate transmission system, such as a TV cable system, to access programs, since they are downloaded over conventional telephone lines. Finally, the software available for rent is not broadcast over the entire system, but rather individual programs are down-loaded to the user's system from the host only after selection by the user.

(*Id.*, Col. 2, line 64 – Col. 3, line 3).

Referring now to FIG. 1, software rental system 10 generally comprises host computer 12, target computer 14, remote control module (RCM) 16 associated with the host computer 12, and RCM 18 associated with the target computer 14. Communication between the host computer 12 and the target computer 14 and their respective RCMs 16 and 18 is accomplished via a standard serial RS232 communications link.

(*Id.*, Col. 5, lines 9-16).

The target computer 14 is the computer of any user, and may be a workstation, minicomputer, or even a mainframe. However, for purposes of software rental, the most likely target computer is expected to be a personal computer, owned and operated by a user in a home or office setting.

(*Id.*, Col. 5, lines 25-29).

d) Storage means

Hornbuckle further discloses storage means, both at the communications terminal and the host facility:

(1) At communication terminal

Since the game software is stored in the RCM memory, a telephone line connection is not required except to download additional game software and to transmit usage and other billing data to the host computer.

(*Id.*, Col. 4, lines 7-11).

Referring now also to FIGS. 2, 3A and 3B, RCM 16 comprises microprocessor 50, program memory 52, read/write memory 54, real-time clock (RTC) 56, power supply 58, priority interrupt control circuit 60, light-emitting diode (LED) displays 62, modem 64, dial access arrangement (DAA) 66, RS232 serial data interface 68, data encryption/decryption module 70, and polynomial generator and checker (PGC) 72.

(*Id.*, Col. 6, lines 24-31).

Program memory 52 is any conventional read-only memory (ROM) and is used to store the program executed by microprocessor 50 in performing the functions of RCM 18. An erasable/programmable read-only memory (EPROM), e.g., a 27128, may be used for program memory 52 when the modification of functions performed by RCM 18 may be desirable. However, an equivalent conventional ROM is acceptable and, typically, is a lower cost device.

(*Id.*, Col. 6, lines 45-52).

(2) At host facility

Typically, available game software is stored in the host computer 12 which is centrally located in order to provide rental service to a large number of authorized users.

(*Id.*, Col. 14, lines 56-59).

e) Executing means

Hornbuckle further discloses means for executing the rented program:

Microprocessor 50 is any conventional microprocessor, but may be a multi-port integrated circuit device, such as an 8031 microprocessor,

the ROM-less version of the 8051 microprocessor 50 (FIG. 2) and the speed of the communications link between the host computer 12 and the target computer 14 (FIG. 1) are not critical to systems constructed according to the principles of the present invention.

(*Id.*, Col. 6, lines 33-39).

Assuming that a customer wishes to run a rental software package protected in accordance with the present invention, the user follows exactly the same procedures for loading the software package from the associated peripheral storage device to the internal memory of target computer 14 as if an unrented version of the same package were being run.

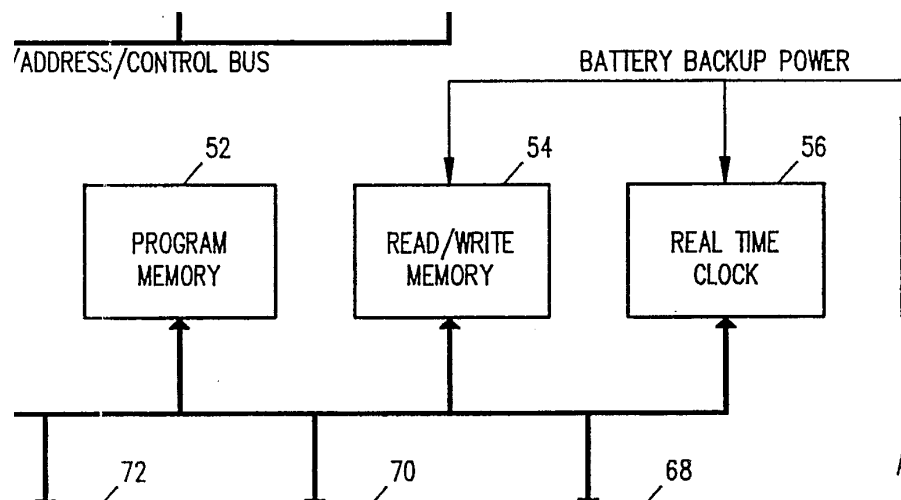
(*Id.*, Col. 13, lines 19-24).

The rental program with the decrypted key module now stored in the internal memory of target computer 14 will operate in exactly the same manner as it would if it were not a rental package (i.e., the same way as if it were a purchased program).

(*Id.*, Col. 13, lines 38-42).

f) Clock means

Hornbuckle discloses a clock means for monitoring and recording the time of use of the rental.



Reexam Figure 9 – Clock Means in Hornbuckle, FIG. 2

The control module used in the proposed software rental system performs many more functions than its counterpart in the pay-for-view television system. For example, it controls and verifies that use of a

program is authorized; it records the actual time that the program is used; . . .

(*Id.*, Col. 3, lines 4-8).

RTC 56 is, preferably, an ICM 7170 device manufactured by Intersil. The latter circuit maintains the date and time to the nearest 0.01 second. The occurrence of a leap year is automatically accommodated. RTC 56 is connected to the power supply 58 and receives battery backup therefrom in case of power failure. RTC 56 functions in a conventional manner to provide control and time information, upon request, to microprocessor 50. This enables the RCM 18 to perform its function of developing time, accounting and billing data relative to customer access to and use of programs initially stored in the host computer 12. Such time and billing data are provided to the host computer 12 by RCM 18 on command from the host computer 12.

(*Id.*, Col. 6, line 59 – Col. 7, line 4). (*See also, id.*, Col. 6, lines 24-31, above).

g) Interference means

Hornbuckle discloses means for interfering with the use of the program after the period of authorized use.

(1) Deletion

This includes deletion:

However, when execution of the rental program is complete, control reverts back to the OSP module. The OSP module then automatically erases the rental program including the key module from the RAM of target computer 14 and notifies RCM 18 that the period of use or rental period has stopped. The elapsed time between the starting and stopping of the rental program, as well as the time and date information, are recorded in memory 54 of RCM 18 for subsequent, off-line processing.

(*Id.*, Col. 13, lines 42-50).

**(2) Blocking view of display
and/or preventing sound generation**

Hornbuckle further discloses display means and means for generating sound:

The output of the game computer is coupled to the television 13 via cable 31 and typically comprises video and audio signals generated by

the game computer 15 under the control of the game software and the user via user input device 19.

(*Id.*, Col. 15, lines 3-7).

Hornbuckle discloses erasing the program upon completion of use; however, in view of its disclosure of a display and means for generating sound associated with the program, Hornbuckle's disclosed deletion of the program would prevent it from generating sound or display.

h) Sending out means

Hornbuckle further discloses a means for sending the program from the host computer to the user's computer:

Certain applications of the system 10 (as shown in FIG. 1), in particular for the business of software rental, typically will be configured so that the host computer 12 sends and receives data/messages to and from the target computer 14 over the public switched telephone network 26. As also indicated above, RCMs 16 and 18 serve as interface devices to connect the host computer 12 and the target computer 14, respectively, to the telephone network 26. Obviously, while designed to work with the public switched telephone network the present invention can be configured to work with any communications link between the host and target computers.

(*Id.*, Col. 9, lines 35-46).

Similarly, as described hereinabove with regard to FIG. 1, communication between the host computer 12 and the game computer 15 and their respective RCMs 29 and 21 is accomplished via a standard serial RS232 communication link or other suitable communication link. In operation, the host computer 12 is linked to the game computer's RCM 21 via the host RCM 29 and the public switched telephone network 26.

(*Id.*, Col. 14, lines 49-56).

8. The Kaniwa Prior Art

United States Patent No. 5,699,370, entitled "Information Recording And Reproduction Apparatus To Be Controlled By Temporal Information," issued on December 16, 1997, from an application filed on February 17, 1995 by Kouji Kaniwa *et al.*, discloses most of the elements

claimed by Applicant, and all of the elements recited in a number of the claims of the '520 Patent. Kaniwa was neither cited by the Applicant, nor cited or relied upon by the Examiner during prosecution of the '520 patent, is not cumulative to the references considered during the original prosecution, and, as demonstrated below and in the specific SNQs, raises new questions of patentability as to certain claims of the '520 patent.

a) A communication system for transmitting a program and/or data from a host facility to a communication terminal device

Kaniwa discloses a system for transmitting a program and/or data:

The present invention relates to an information recording and reproduction apparatus for recording and reproducing a digital information signal supplied through a transmission line, or more in particular, to an information recording and reproduction apparatus comprising a mechanism for protecting the copyright of the digital information transmitted and recorded, and an information recording and reproduction apparatus capable of reproducing the digital information signal supplied and recorded through a transmission line by temporally expanding it to the desired transmission rate at the time of reproduction.

(Kaniwa, Col. 1, lines 9-19).

The information desired by the user may of course be transmitted through the transmission line 37 which may be a bidirectional transmission line such as a bidirectional CATV transmission line as well as through the telephone line 50.

(*Id.*, Col. 7, lines 40-44).

b) An input device

Kaniwa discloses an input device:

In FIG. 1, the input information signal supplied through the input terminal 7 is applied to the channel selector 12. The channel selector 12 selects the information signal of the desired channel in accordance with the channel-designating signal CH supplied from the system controller 19 and supplies the selected signal to the demodulation circuit 13. The channel-designating signal CH is set by the user command signal supplied through the input/output terminal 8.

(*Id.*, Col. 8, lines 22-29).

c) Receiving means

Kaniwa also discloses means for receiving the transmitted program/data:

The demodulation circuit 13 demodulates the input information signal modulated into a signal form suitable for the transmission line 37, converts the input demodulation signal into the original digital signal, and supplies the resultant signal to the PCM decoder 14. The PCM decoder 14 detects and corrects the error of the digital information signal input and supplies the resultant digital information signal to the DSP 16 in the next stage, while at the same time detecting the index signal and supplying it to the system controller 19. Further, a sync signal for detecting the data block structure is separated and supplied to the drum servo circuit 20.

(*Id.*, Col. 8, lines 30-40).

d) Storage means

Kaniwa further discloses storage means, both at the communications terminal and the host facility:

(1) At communication terminal

The system controller 19 supplied with the index signal selects the data required for reproduction such as the information representing the type of the recording information signal or the information on the temporal compression ratio from among the index signals and supplies the selected signal to the DSP 16 and also to the display system (not shown) through the input/output terminal 8. The information on the index signal is thus indicated to the user. The DSP 16 converts the digital information signal supplied from the PCM decoder 14 and the index signal required for reproduction supplied from the system controller 19 into a signal form suitable for magnetic recording and reproduction. More specifically, in order to deal with the code error in magnetic recording and reproduction operation, the data are divided into blocks, address data are added, and also a strong error detection and correction code such as an interleave or Reed-Solomon code are added. An example block structure of the recording information signal is shown in FIG. 3. The digital information and the index signal applied to the DSP 16 are arranged as shown at the lower part of FIG. 3 with the information recorded in one track (the track-formed by one scan of the magnetic head) as a unit. After an outer check code is added in a vertical direction, an inner check code is added in horizontal direction. The inner check code is generated, as shown in the upper part of FIG. 3, for both the data A with address information and the data B. As described above, the recording information signal

with the error detection and correction code added thereto is applied to the modulation circuit 17 with the block sync signal (hereinafter referred to as the "sync") indicating the block head before the address information. The modulation circuit 17 modulates the recording information signal into a digital signal of 8-10 conversion, for example, suitable for magnetic recording and applies it to a recording amplifier 18 as a serial signal. The recording amplifier 18 amplifies the recording digital signal to a level suitable for magnetic recording and records it on the magnetic tape through magnetic heads 3a, 3b with an optimal recording rent.

(*Id.*, Col. 8, line 40 – Col. 9, line 11)

(2) **At host facility**

FIG. 2 shows the operating environment of an information recording and reproduction apparatus according to the invention. In FIG. 2, the section defined by the dashed line 36 represents a transmitting office system for supplying a digital information signal. Numeral 37 designates a transmission line for the digital information signal. The section defined by the dashed line 38 represents a viewer (user) system having an information recording and reproduction apparatus system according to the invention. The transmitting office 36 comprises a digital VTR 39 and a disc unit 40 or a semiconductor recording and reproduction apparatus 41 including a large-capacity memory, for example, for compressing the information and time axis of the digital information signal (main digital information signal) using the MPEG scheme or the like and supplying the resultant signal to a PCM encoder 42 at a predetermined transmission rate.

(*Id.*, Col. 7, lines 8-23).

e) **Executing means**

Kaniwa also discloses executing means:

Also, the system controller 19, with the index signal applied thereto, determines the reproduction mode by the reproduction index signal on the one hand while the information preferably to be supplied to the user such as the type of the recorded date/time and recording information is supplied to a display system (not shown) through the input/output terminal 8.

(*Id.*, Col. 18, lines 53-59).

f) Clock means

Kaniwa further discloses a clock means, including a keeping a predetermined time of use, or after download:

The reproduction means reproduces the recorded main information signal and the deadline signal. The temporal information generating means generates a signal representing temporal information such as date and time by means of a timer or the like for counting a stable clock or by detecting the temporal information supplied through the transmission line. The comparator means compares the deadline signal reproduced by the reproduction means with the temporal information signal generated or detected by the temporal information generating means to see whether the temporal information (time, including the date or the like) exceeds the deadline at the time of reproduction and supplies a comparison signal to the cut-off means.

(*Id.*, Col. 5, line 57 – Col. 6, line 3).

In the embodiment shown in FIG. 12, the reproduction deadline is set by an absolute date and time without regard to the date/time of information transmission and recording. According to the present embodiment, in contrast, the reproducible period is limited by a relative reproducible period which is set with respect to the date and time the information is transmitted and recorded. [...] In FIG. 15, the deadline information detection circuit 27 is eliminated, while a valid period information detection circuit 107, a recording date/time information detection circuit 108 and an arithmetic circuit 109 are newly added.

(*Id.*, Col. 20, line 63 – Col. 21, line 22).

According to the second embodiment described above, the valid reproduction period information with an 8-byte index signal ID8 to IDF assigned thereto as information on the year, month, day and time is used for recording and reproduction. In many cases, however, the valid period may alternatively be set in the number of hours or days with equal effect.

(*Id.*, Col. 22, lines 19-25).

g) Interference means to cut off display, prevent sound generation

Kaniwa further discloses interfering with the program/data when the allotted time expires.

Kaniwa discloses both a display and sound generation means:

In the case where the transmission information is a video or audio signal, the information is expanded (defrozen), converted into an analog signal and output to a TV monitor 48. In the case where the transmission information signal is a program or data used for computer equipment or the like, on the other hand, the signal is reproduced at a transmission rate suited to external equipment by means of an external command (control signal), and supplied to a digital information unit 49 such as a computer.

(*Id.*, Col. 7, lines 53-62).

Kaniwa further discloses that the signal upon which these rely is cut off at a predetermined time:

The signal cut-off circuit 30 supplied with the reproduction digital signal from the DSP 25 performs the switching operation for connecting and disconnecting the input reproduction digital signal to the memory circuit 39 in the next stage in accordance with the control signal supplied from the comparator circuit 29. This switching operation is accomplished in such a manner that as will be seen from the foregoing description, in the case where the date/time of the reproduction point has passed the reproduction deadline, the reproduction digital signal is cut off, while in the case where the date/time of the reproduction point is within the reproduction deadline, the reproduction digital signal is applied to the memory circuit 31.

(*Id.*, Col. 19, lines 17-29).

h) Sending out means

Kaniwa further discloses means for transmitting the program/data from the host to the user.

(*See, e.g., id.*, Col. 7, lines 8-23, above).

9. The McCarten Prior Art

United States Patent No. 5,959,596, entitled "Airline-Based Video Game And Communications System," issued on September 28, 1999, from an application filed on June 24, 1993 by David J. McCarten *et al.*, discloses most of the elements claimed by Applicant, and all of the elements recited in a number of the claims of the '520 Patent. McCarten was neither cited by the Applicant, nor cited or relied upon by the Examiner during prosecution of the '520 patent, is not cumulative to the references considered during the original prosecution, and, as demonstrated below

and in the specific SNQs, raises new questions of patentability as to certain claims of the '520 patent.

a) A communication system for transmitting a program and/or data from a host facility to a communication terminal device

McCarten discloses transmitting application software (e.g., games) from a host station to a communication device:

The present invention is directed to a video game/communications system for providing any passenger in the airplane an opportunity to actively participate in video game play or to use other data processing/communication services accessible via an onboard distributed processing communications system.

(McCarten, Col. 1, lines 27-32).

The system downloads application software to the seat display units from the master computer.

(*Id.*, Abstract).

b) An input device

McCarten further discloses an input device(s):

The video game processing board 82 is also coupled to a video game controller which may be the hand-held controller used in conjunction with the Super Nintendo Entertainment System (SNES) sold by the assignee of the present invention.

(*Id.*, Col. 6, lines 60-64).

It is contemplated that the seat display units may include a port for receiving a keyboard input which, in one illustrative embodiment of the present invention, is distributed by airline personnel upon request. Alternatively, the system may be expanded to include, in association with at least some seats in the airplane, a keyboard which is rotated into operating position upon selection of word processing 45 or facsimile services 37.

(*Id.*, Col. 4, lines 46-54).

c) Receiving means

McCarten discloses means for receiving the software from the host:

The memory board 102 receives a high speed synchronous serial input which includes program information downloaded from the master control unit via tuner 86 such as shown in FIG. 4.

(*Id.*, Col. 9, lines 14-17).

If the game program file is not resident in memory or if a forced download was determined to occur in block 255, then the downloading process starts (258). The downloading then process is performed (259) until completion (260). The downloading process is performed as described above in conjunction with FIGS. 3A and 3B.

(*Id.*, Col. 15, lines 30-35).

d) Storage means

McCarten further discloses means for storing the program/data, both at the host and the communications terminal:

(1) At communication terminal

The video game processing board 82 includes a video game computer board 100 and a memory board 102 both of which are described in further detail below.

(*Id.*, Col. 8, lines 3-6).

The memory board 102 includes storage devices for storing downloaded game program, game character data and other applications program information. The memory board 102 additionally includes a boot read-only memory (ROM) whose boot program executed upon power on determines whether the pseudo static RAM in the memory board 102 contains the expected program information and performs other operations as explained below in conjunction with FIGS. 9A-9C.

(*Id.*, Col. 8, lines 10-18).

(2) At host facility

The master control computer 2 preferably stores video game and other programs in its memory 3, which may include a hard disk memory system. Such programs are ultimately downloaded to a passenger's seat display unit (SDU) for execution.

(*Id.*, Col., 3, lines 6-10).

e) Executing means

McCarten further discloses means for executing the program/data:

The SDU is itself a multiprocessor system which permits a wide range of video game programs to be executed by a video game computer system. It includes interface processors and associated hardware and software which enable high speed downloading operations to be efficiently performed.

(*Id.*, Col. 2, lines 7-9).

If the user opts for video game play (15), then the available game titles and/or descriptions thereof will be displayed to the user (17). Thereafter, the master control unit 2 initiates a video game program downloading process which is explained in detail below in conjunction with FIGS. 3A and 3B (19). The system then begins executing the game program and the passenger is able to play the selected video game.

(*Id.*, Col. 4, lines 60-65).

f) Clock means and Interference means

McCarten further discloses clock means to measure a time of use, and to block access after such time expires:

The memory board 102 also includes a halt controller 196 which is coupled to microcontroller 190. The halt controller 196 is designed to couple a halt signal to the video game computer. The halt signal may be generated to halt game play after a predetermined time period, e.g., 1 hour after initiation, so that the user may be prompted to request further playing time and to pay for such time

(*Id.*, Col.10, lines 66 – Col. 11, line 5).

McCarten discloses both video and audio means (*see, e.g., id.*, FIG. 5, AUDIO L & AUDIO R; Col. 9, lines 27-30 (video signals); Col. 14, lines 19-24 (audio processing unit)), which are blocked at the predetermined time.

g) Sending out means

Finally, McCarten discloses means for sending out the requested program(s):

The system downloads application software to the seat display units from the master computer.

(*Id.*, Col. 1, lines 53-54).

The master computer initiates a high speed video game program downloading process to enable the user to play the selected video game.

(*Id.*, Col. 2, lines 11-14).

10. The Tsumura Prior Art

United States Patent No. 5,547,202, entitled “Computer Game Device,” issued on August 20, 1996, from an application filed on December 30, 1994 by Mihoji Tsumura, discloses most of the elements claimed by Applicant, and all of the elements recited in a number of the claims of the ‘520 Patent. Tsumura was neither cited by the Applicant, nor cited or relied upon by the Examiner during prosecution of the ‘520 patent, is not cumulative to the references considered during the original prosecution, and, as demonstrated below and in the specific SNQs, raises new questions of patentability as to certain claims of the ‘520 patent.

a) A communication system for transmitting a program and/or data from a host facility to a communication terminal device

Tsumura discloses a system for transmitting large volumes of data (e.g., video game data) for use by a user at a remote location:

FIG. 1 is a block diagram illustrating the nature of radio transmission via a communications satellite from a transmission device to a receiving device, in which 11 is a communications satellite, 12 a transmission device and 13 a receiving device.

(Tsumura, Col. 4, lines 14-18).

The invention relates to the communication of large volumes of data of the type used in computer games.

(*Id.*, Col. 1, lines 9-10).

b) An input device

Tsumura further discloses an input device:
In re Patent No. 6,193,520

We will now outline by reference to FIG. 8 an alternative embodiment of the invention illustrating different approaches to the collection of charges and to the suspension of a game before it is finished. The drawing illustrates a known configuration in which 81 is a CPU which is used to run programs and control peripheral equipment, 82 is a memory device holding data relating to specified computer games, 83 is panel of input keys that are used to play the game, and 84 is a visual display unit which is used both to play the game and also to display information when necessary.

(*Id.*, Col. 10, line 61 – Col. 11, line 4).

c) Receiving means

Tsumura further discloses means for receiving the transmission of the program/data:

The configuration of the receiving device 13 is shown in FIG. 3. In the figure, 31 is an antenna for the receipt of signals from the satellite, 32 is a tuner, 33 is a CPU that analyzes the digital data received and controls the terminal device as appropriate, and 34 is a RAM, which used by the CPU 33 both as a buffer and as memory space for data processing. 35 is a large-scale memory device that is used to store the digital data received, 36 is a control panel that is used to specify and save the required game data and 37 is a data processing device that is used to process the selected data as appropriate.

(*Id.*, Col. 4, lines 40-50).

d) Storage means

Tsumura further discloses means for storing the program/data, both at the host, and at the communications terminal:

(1) At communication terminal

We will now explain the operation of the receiving side. The radio waves received by way of the antenna 31 are all input to the tuner 32. However, this does not mean that all the game data received needs to be stored and there are times when it will be enough simply to select those items of data that are required. The control panel 36 can be used for this purpose. In other words, if the order (numbers) that has already been assigned to the game data is input from the control panel 36, this will be processed by the CPU 33, the data strings input serially from the tuner 32 will be checked and game data with numbers with which the file type code B matches stored in the large scale memory device 35. The large-scale memory device 35 normally consists of a hard disk or optical disk. The RAM 34 acts as a buffer memory which copes

with the extremely high speed of the data transmission by temporarily storing each item of data as it is received and then matching it with a number input from the control panel 36 and transferring only game data with a matching number to the large-scale memory device 35. When the required data has been transferred into the large-scale memory 35, the tuner 32 will discard any remaining data unless it receives fresh instructions from the control panel 36.

(*Id.*, Col. 5, line 54 – Col. 6, line 9).

(2) At host facility

As shown in FIG. 2, the main components of the transmission device 12 are a computer 21, which is used to control transmission, a database 22, which contains the data for transmission, and a transmitter 23, the radio waves emitted by said transmitter 23 being beamed at said communications satellite 11 by way of an antenna 24. The transmission database 22 contains the data for a plurality of computer games, said data being arranged in the form of files and transmitted cyclically in a prescribed order.

(*Id.*, Col. 4, lines 18-26).

e) Executing means

Tsumura further discloses means for executing the program (*e.g.*, the video game):

It is obviously possible, in this sort of case, simply to read the required game data out of the large-scale memory device 35 and into the data processing device 37 in order to play the game. However, this would also create the need to access the large-scale memory 35 by way of the CPU 33 fairly frequently during the course of a game. If a need also arose, while the game was in progress, for new input data to be transferred from the tuner 32 into the large-scale memory 35, this would call for more complex processing in the form of, for example, an interrupt write operation or dummy parallel processing and this would in turn call for the use of a more powerful CPU 33. We have dealt with this problem with the help of the dedicated read memory device 51 shown in FIG. 5. This device enables the required type of game data to be read out of the mass of game data held in the large-scale memory device 35 and transferred to the dedicated read memory device 51 which is then accessed by the data processing device 37 in order to play the game.

(*Id.*, Col. 6, lines 33-51).

f) Clock means measuring time from first use, or from last use before discontinuing a game, and providing advance warning

Tsumura further discloses means for measuring a predetermined time period for use of the program/data, either by measuring a predetermined time after the game is first downloaded/used, or after the game is no longer in use, and providing a warning before game play is disabled:

In the case of games like role playing games that can take a long time to play, on the other hand, it would be desirable to incorporate an additional charge facility that would function automatically at fixed intervals during the course of a game. The CPU's 71 internal clock, for example, could be used to calculate the unit time and to call for the insertion of an additional fee before a predetermined length of time has elapsed, and to cause the game to be discontinued as soon as that length of time has elapsed if the required additional fee has not been paid. An alternative arrangement would be to cause the game program to pause for a predetermined length of time after the game has been discontinued in order to allow time for the player to put more money in the machine. The pause could be released and the game continued if the requisite additional charge is paid within the time allowed.

(*Id.*, Col. 9, lines 56-65).

This would include discontinuing outputs to/by both the disclosed display means and sound generation means:

38 is an output terminal which outputs both display and audio signals to externally connected visual display and audio units to enable the game to proceed.

(*Id.*, Col. 4, lines 50-52).

g) Sending out means

Tsumura finally discloses sending out means for transmitting the program/data:

As shown in FIG. 2, the main components of the transmission device 12 are a computer 21, which is used to control transmission, a database 22, which contains the data for transmission, and a transmitter 23, the radio waves emitted by said transmitter 23 being beamed at said communications satellite 11 by way of an antenna 24.

(*Id.*, Col. 4, lines 18-23).

11. The Griswold Prior Art

United States Patent No. 5,940,504, entitled “Licensing Management System And Method In Which Datagrams Including An Address Of A Licensee And Indicative Of Use Of A Licenses Product Are Sent From The Licensee’s Site,” issued on August 17, 1999, from an application filed on June 29, 1992 by Gary N. Griswold, discloses or suggests most if not all of the elements claimed by Applicant in a number of the claims of the ‘520 Patent. Griswold was neither cited by the Applicant, nor cited or relied upon by the Examiner during prosecution of the ‘520 patent, is not cumulative to the references considered during the original prosecution, and, as demonstrated below and in the specific SNQs, raises new questions of patentability as to certain claims of the ‘520 patent.

a) A communication system for transmitting a program and/or data from a host facility to a communication terminal device

Griswold discloses a communication system for transmitting licensed software from a host to a user:

In the present invention, the licensed product is implemented on a network node attached to a communications network that includes the licensor.

(Griswold, Col. 4, lines 6-8).

By including in product 1 both information and software which controls the information, product 1 is an executable product. Non-software information in product 1 is preferably encrypted so that it cannot be easily extracted from the product.

(*Id.*, Col. 5, lines 34-38).

b) An input device

Griswold further discloses an input device(s):

The network node may be a computer, a CD-ROM player, a tele-computer or other multimedia machine, or any other appropriate device. The node may also be an intelligent type of consumer electronic device used for presenting information, such as an

intelligent television, VCR, videodisk player, music CD player, audio tape player, telephone or other similar device. Further, the communications network may be any two-way network such as a computer network, telephone network, a cellular telephone network or other wireless network, a two-way cable TV network, or any other equivalent system.

(*Id.*, Col. 4, lines 8-18).

c) Receiving means

Griswold discloses receiving means at the network node. (*See above*).

d) Storage means

Griswold further discloses storage means, both at the communications terminal and the host facility:

(1) At communication terminal

However, product 1 can be electronically delivered over communications lines to the licensee and therefore might exist in the memory of the licensee's machine, rather than any physical media. In the case of a product such as music, radio programs and the like, product 1 may even be broadcast to the licensee's site for playback; thus, the product 1 would not even be "resident" in the licensee's machine.

(*Id.*, Col. 11, lines 47-54).

(2) At host facility

In the present invention, a licensed product generates request "datagrams," messages transmitted over a communications network. The request datagrams are sent to the licensor's site. At the licensor's site the datagram is compared to information stored in a license database. After the comparison, a reply datagram is sent to the licensee. Upon receiving the reply datagram, the licensed product reacts in accordance with the instructions therewithin.

(*Id.*, Col. 3, line 62 – Col. 4, line 2).

FIG. 2 shows representative diagrams of the contents and formats of data at licensee's site, contained in datagrams, and at licensor's site;

(*Id.*, Col. 4, lines 55-57).

e) Executing means

Griswold further discloses means for executing the program/data at the user's computer.

(*See id.*, Col. 4, lines 6-18, above).

f) Clock means measuring allowed usage period

Griswold discloses clock means measuring a predetermined time period for use.

A license management system and method for recording the use of a licensed product, and for controlling its use in accordance with the terms of the license. A licensed product invokes a license check monitor at regular time intervals. The monitor generates request datagrams which identify the licensee and the product and sends the request datagrams over a communications facility to a license control system. The license control system maintains a record of the received datagrams, and compares the received datagrams to data stored in its licensee database. Consequently, the license control system transmits reply datagrams with either a denial or an approval message to the monitor. The monitor terminates further use of the product if it receives a denial message. The monitor generates its own denial message if its request datagrams are unanswered after a predetermined interval of time. The datagrams are counted at the control system to provide billing information.

(*Id.*, Abstract).

License record 5 contains information on licenses. Licensee network address 30 identifies a precise network node which is licensed to use product 1. If request datagrams are received which do not originate from known licensee network addresses 30, reply datagrams containing denial messages are transmitted. Product model number 31 is the model number of a licensed product. Termination date 32 is the expiration date of a license. When the license of a product is issued for an unlimited duration, termination date 32 should reflect a date very far into the future, relative to the licensing date.

The present embodiment allows licenses to be paid for in a lease-like or rental fashion. If a licensee were to rent or lease product 1, paid through date 33 would reflect the date through which the licensee has paid for using the product. Grace period 34 is the time interval for which the licensee is allowed to be delinquent before services are disconnected. Grace period 34 would reflect a very large time interval if the license is not of a lease-like or rental type. When the license provides for a limit on the number of concurrent uses of a product 1, number of processes licensed 35 contains the limiting number. When

the license does not provide for such a limit, number of processes 35 should be a very large number.

(*Id.*, Col. 7, lines 3-26).

g) Warning alarm

Griswold further discloses providing a warning before the actual expiration of a grace period, after which the licensed data is no longer available:

FIG. 5 shows the operation of the "Reply Datagram is Overdue" procedure. Step 104.1 compares time since the last datagram was sent 36 to disconnect allowed interval 19, which, as described above, is the interval that product 1 is allowed to operate even if a reply is overdue. If time since send 36 is smaller than disconnect allowed interval 19, datagram 3 is retransmitted via executing step 103.9 in FIG. 4. Step 104.2 "disconnects" product 1 from further service, if time since send 36 is greater than disconnect allowed interval 19.

Step 104.2 comprises a sequence of sub-steps 104.2.1-104.2.3. Step 104.2.1 assigns number 5 to authorization code 27 in the current datagram being processed. Value 5 is interpreted by monitor 2 as a denial. Step 104.2.2 sets message text 28 to the following: "A reply from licensor to numerous authorization requests was never received. This product must be connected to a communications network in order to function." Step 104.2.3 transfers system control to step 105.3 in FIG. 6. Step 105.3 processes the current denial datagram 3 as if it were just received.

(*Id.*, Col. 8, lines 40-67).

h) Interference means to interfere with display/sound generation

Griswold further discloses interfering with use of the licensed product(s) after the end of the licensing period. (*See id.*, Abstract, above).

Griswold further discloses a display and sound generation means. (*See id.*, Col. 4, lines 6-18, above). This display no longer displays or plays audio for the licensed program after the termination of the license period:

In the present invention, a licensed product generates request "datagrams," messages transmitted over a communications network. The request datagrams are sent to the licensor's site. At the licensor's site the datagram is compared to information stored in a license

database. After the comparison, a reply datagram is sent to the licensee. Upon receiving the reply datagram, the licensed product reacts in accordance with the instructions therewithin. For example if a reply datagram contained a "denial," the licensed product would display an appropriate message to the user and then suspend further execution of its programs.

(*Id.*, Col. 3, line 62 – Col. 4, line 5).

i) Sending out means

Griswold further discloses means for sending out the program/data. (*See, e.g.*, Col. 11, lines 47-54, above).

12. The Russo Prior Art

United States Patent No. 5,619,247, entitled "Stored Program Pay-Per-Play," issued on April 8, 1997, from an application filed on February 24, 1995 by James Russo, discloses or suggests most if not all of the elements claimed by Applicant in a number of the claims of the '520 Patent. Russo was neither cited by the Applicant, nor cited or relied upon by the Examiner during prosecution of the '520 patent, is not cumulative to the references considered during the original prosecution, and, as demonstrated below and in the specific SNQs, raises new questions of patentability as to certain claims of the '520 patent.

a) A communication system for transmitting a program and/or data from a host facility to a communication terminal device

Russo discloses a method for transmitting different media to a user's computer from a remote host:

In an alternative embodiment, storage facilities could be made available to subscribers from regional program server computers, or even designated program storage means located at a centralized distribution facility, such as a cable provider.

(Russo, Col. 3, lines 24-28).

Although this discussion centers on cable delivery in general and video programming in particular, other delivery media and programming,

including audio-only, video games, etc., are easily accommodated as alternatives.

(*Id.*, Col. 3, lines 42-46).

b) An input device

Russo discloses an input device:

In practice, it may be advantageous to implement both the cable box 4 and record/play controller 10 as a single unit, as suggested by the broken lines 11 in FIG. 1. In such a configuration, the controller may be utilized in either uni-directional or bi-directional environments. The controller 10 optionally may include various devices (not shown) for user input and controller output, such as keyboard units, bar-code scanners, infrared remote-control units, integrated CRT displays, on-screen television displays, voice-activated input or computer-generated voice output, or touch-screen accessories to be fitted either to the CRT facilities or to the television set 8.

(*Id.*, Col. 3, line 65 – Col. 4, line 5).

c) Receiving means

Russo further discloses receiving means:

FIG. 2 provides a more detailed diagram illustrating a more comprehensive embodiment of the invention. Program information is received along line 102 and, if derived from a multi-channel source such as a cable input, demodulated by tuner 104 to produce a baseband signal along path 106. In the event that line 102 already carries a baseband signal, for example, in the case of a separate tuning facility forming part of a remote or independent associated unit, tuner 104 may be bypassed as indicated by the broken line 105.

(*Id.*, Col. 6, lines 54-62).

d) Storage means

Russo further discloses storage means, both at the communications terminal, and the host facility:

Selected program materials preferably may be stored in the program storage unit 14, comprised of magnetic, optical, or magneto-optical discs, or any of the various magnetic-tape-based storage media. The storage technique employed may be sophisticated for example, by recording data-compressed information on arrays of disks or magnetic

tapes, including auto-changer facilities to switching between media, or more straightforwardly, for example, using a conventional VHS video cassette recorder, preferably with extended recording time. Whereas standard cassettes have recording times as long as 8 hours, special cassettes with capacities of 10 hours or more recording time are currently available.

Program signals are preferably supplied to the program storage unit 14 through a cable box tuner 4. In the case that program signals are recorded using some form of signal scrambling, either the program storage unit or the cable converter box will incorporate provisions for descrambling the signal during playback.

In the preferred embodiment, the program storage unit 14 preferably is located at the subscriber site. However, in an alternative embodiment, the physical storage could be a part of a larger storage unit located at the cable transmission facility, or at one of several intermediate storage facilities, for example, serving groups of subscribers, located in the transmission paths between the cable transmission facility and the subscriber sites. In this case, the subscriber would be allocated a specific portion of the overall storage capacity available, and would be able to use that storage capacity as desired.

(*Id.*, Col. 4, lines 10-38).

e) Executing means

Russo discloses providing executing means for the program/data:

It is preferred that all control functions be carried out by a central controller 150, preferably in the form of a microprocessor or single-chip microcomputer of commercial design, which are available by various manufacturers such as Intel Corporation and Motorola, Inc. The controller 150 communicates with most of the functional blocks of a system over a bi-directional data bus 152, and address/control lines used to select a particular subsystems and memory storage areas to carry out the various functions.

(*Id.*, Col. 9, lines 24-32).

f) Clock means

Russo discloses a clock means for measuring a time during which free use is allowed, after which the user is charged.

As mentioned, the mere selection of a program for viewing may not instantly result in a charge, but the operator may instead be entitled to

enjoy the program for a predetermined amount of time after which a charge will take place. Preferably, a warning will also appear on the screen and indicate the amount of time remaining for this free preview. For example, by means of a count-down timer or clock, after which the program will continue, but now on a pay-per-view basis.

(*Id.*, Col. 10, line 63 to Col. 11, line 4).

g) Warning alarm

Russo further discloses keeping a second time, shorter than the time of free use, and providing a warning before the predetermined free use period expires. (*See id.*, Col. 10, line 63 to Col. 11, line 4, above).

h) Interference means

Russo further discloses interference, in the form of deletion, after the use of the licensed resource is completed:

After enjoying the same program in its entirety, various options are available, including saving that program on the high-capacity medium as part of an on-site library, or [alternatively], the selection may be automatically erased during or immediately subsequent its retrieval, to free up space on the high-capacity medium.

(*Id.*, Col. 11, lines 11-15).

Russo also discloses a display and sound generating means:

While the following discussion is again primarily concerned with the storage and retrieval of video information, the reader is reminded that audio information also falls within the scope of this invention, either as the audio information typically included with video information or as audio information only, applied simply as high quality sound, including stereo sound, whether in analog or digital form.

(*Id.*, Col. 6, line 63 – Col. 7, line 3).

Thus, Russo's disclosure of deleting the program would inherently disclose keeping the program from being displayed and/or from generating sound.

i) Sending out means

Russo further discloses sending out means:

It should also be noted that, while in the preferred embodiment such supplemental information may be derived from the program provider along path 102, either in an unused portion of one or more channels or through the use of an unused channel in its entirety, such supplemental information may alternatively be acquired either through a telecommunications facility depicted by block 140 or through an RF receiver depicted by block 142. In the case of the telecommunications subsystem, it is implied that block 140 includes dialing capabilities, modulation/demodulation capabilities, and so forth, enabling the system to automatically dial out to a predetermined number and receive such supplemental information through an automatic process without requiring assistance.

(*Id.*, Col. 8, line 64 to Col. 9, line 11). (*See also id.*, Col.6, lines 54-62, above).

13. The Cooper Prior Art

United States Patent No. 5,757,907, entitled "Method And Apparatus For Enabling Trial Period Use Of Software Products: Method And Apparatus For Generating A Machine-Dependent Identification," issued on May 26, 1998, from an application filed on April 25, 1994 by Thomas Edward Cooper, *et al.*, discloses both clock and interference means claimed by Applicant in the '520 Patent. Cooper was neither cited by the Applicant, nor cited or relied upon by the Examiner during prosecution of the '520 patent, is not cumulative to the references considered during the original prosecution, and, as demonstrated below and in the specific SNQs, raises new questions of patentability as to certain claims of the '520 patent.

a) Clock means

In particular, unlike some of the other prior art references, Cooper disclosed beginning a predetermined time period either by looking at the time the software/data was downloaded, or alternatively at the time that it was first used:

The trial mode of operation may be defined by either a timer, or a counter. A timer can be used to count down a particular predefined period (such as thirty days); alternatively, the counter can be used to decrement through a predefined number of trial "sessions" which are allowed during the trial mode of operation.

(*Id.*, Col. 8, lines 39-43).

User 211 must communicate additionally with source 209 in order to obtain permanent access to the software product. The product key allows user 211 to obtain access to the software product for a particular predefined time interval, or for a particular number of predefined "sessions." As time passes, the user's clock or counter runs down. At the termination of the trial period, further access is denied. Therefore, the user 211 must take affirmative steps to contact source 209 and purchase a permanent key which is communicated to user 211 and which permanently unlocks a product to allow unrestricted access to the software product.

(*Id.*, Col. 9, lines 27-38).

b) Interference means

Thereafter, Cooper discloses interfering with the use of the software/data. (*See id.*).

14. The Sanyo Prior Art

Japanese Laid-Open Patent Application No. H3-149693, entitled "Information Rental System," published June 26, 1991, from an application filed on November 7, 1989 by Sanyo Electric Co., Ltd., discloses many of the elements of a communications system for transmitting and controlling access to use of data/programs, e.g., video rentals, claimed in the '520 Patent. Sanyo was neither cited by the Applicant, nor cited or relied upon by the Examiner during prosecution of the '520 patent, is not cumulative to the references considered during the original prosecution, and, as demonstrated below and in the specific SNQs, raises new questions of patentability as to certain claims of the '520 patent.

Unlike several of the other prior art references, which disclose interference with usage of the data/program after the expiration of a predetermined period, Sanyo discloses deleting the data, ensuring that a user will not be able to circumvent the access restrictions placed on his/her use:

When the listening of music, the viewing of video, the use of a game or the education by means of education software has come to an end and the rented information data becomes unnecessary for the user, the user sends a message of returning the used software to the information center 1 (107). Receiving the message, the information center 1 gives a command to the terminal block 2 to delete the information data from

the storage means 23 of the terminal block 2, thereby deleting the contents of the storage means 23 (108).

(Sanyo, Pg. 9; *see also* Pgs. 2-3).

15. The Suzuki Prior Art

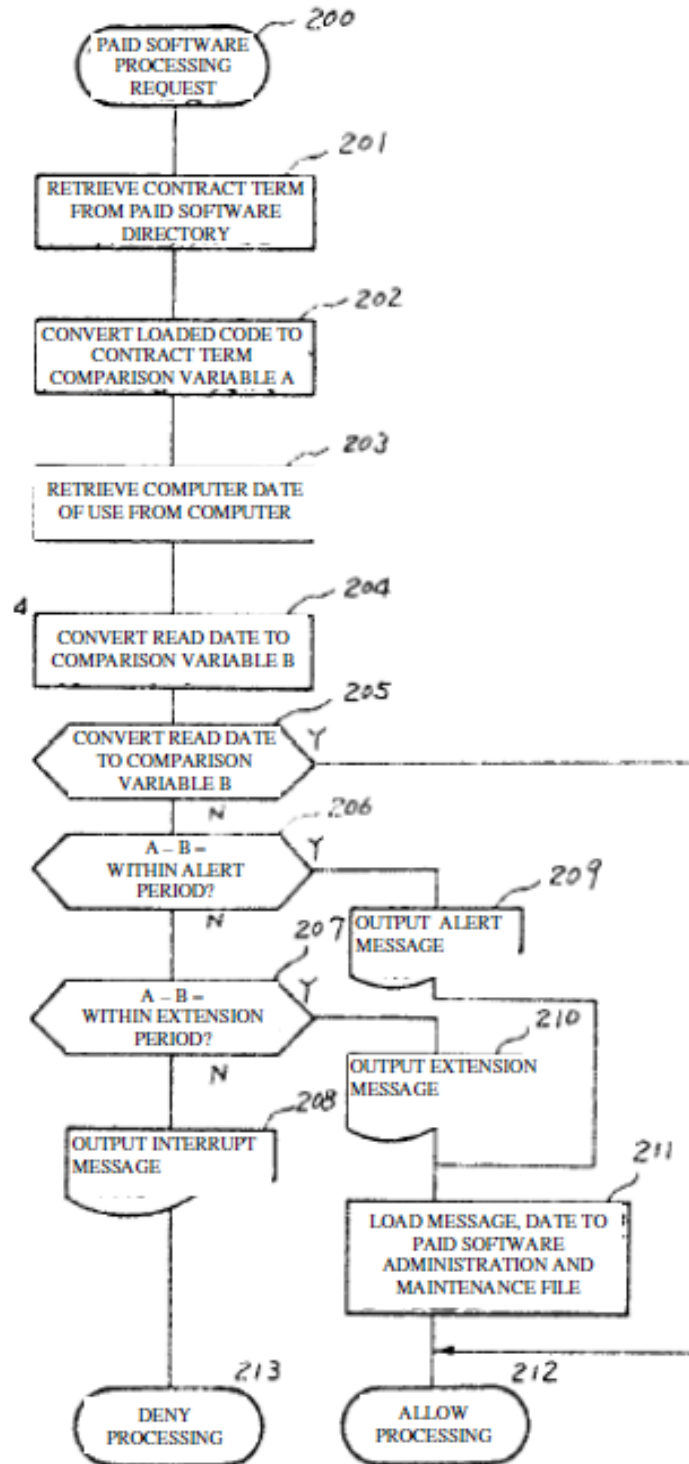
Japanese Laid-Open Patent Application No. H01-166218, to Katsuyoshi Suzuki *et al.*, was published on June 30, 1989, and discloses a paid software administration and maintenance system. In particular, Suzuki discloses both means for providing interference when the term of use of software expires, and providing a warning before the end of the lease period that said period is set to expire. Suzuki was neither cited by the Applicant, nor cited or relied upon by the Examiner during prosecution of the '520 patent, is not cumulative to the references considered during the original prosecution, and, as demonstrated below and in the specific SNQs, raises new questions of patentability as to certain claims of the '520 patent.

a) First and second clock means – multiple time periods

Suzuki discloses clock means for keeping a predetermined time period during which usage of the software is allowed. In particular Suzuki discloses keeping a time period after which a user is warned that software time limit has expired, and a second period after which the software becomes unusable:

The above purpose is achieved by outputting messages divided into alert, extension, and interruption according to ranges of the difference between comparison variables *when comparing the contract expiration and the date of computer use, and providing alerts and extensions to users*, accumulating information on the results of comparisons in a paid software administration and maintenance file, and periodically forwarding it to the maker.

(Suzuki, Pg. 3). (Emphasis added).



Reexam Figure 10 – Suzuki, FIG. 2

When a paid software delivery request is generated (100), the contract term is loaded to a directory writer. (101) The loaded contract term is encrypted and converted, and then (102) written to the directory of the paid software being delivered. (103) Additional information, such as

an interruption grace period, etc., can also be written as information to the directory in addition to the contract term. Since the contract term is encrypted, the user is unable to manipulate it in anyway. In addition, no matter how the paid software might be copied, it cannot be illegally used since it will be copied together with the directory as a unit. Furthermore, since the contract term is loaded to part of the directory as several bytes of encrypted information, there is virtually no change in the volume of the paid software. Next, when a paid software processing request is generated by the user (201), the contract term is loaded from the directory of the paid software in the operation system (201). The encrypted contract term information that has been loaded is converted to term comparison variable A (202). Next, the date of computer use is read from the computer (203) and converted to comparison variable B (204).

Next, A and B are compared, and processing is permitted (212) if it is within the contract term (205). Within an alert period (206), an alert message is output, or an extension message is output within an interruption grace period (207), and then the aforementioned message and the date of use are written to the paid software administration and maintenance file (211) and processing is allowed. (212) *If the interruption extension term has lapsed, processing is rejected (213).*

(*Id.*, Pg. 4). (Emphasis added).

b) Warning alarm

At the end of the first time period, when the user's time has expired, Suzuki discloses providing a warning, notifying the user that time has expired, but providing a period during which the user may "renew" before interference takes effect:

For paid software that has reached its contract expiration, *an alert message is output* before the expiration is reached and an interruption message is periodically output even after the expiration has been reached. Thus, work will not be spontaneously interrupted and the like since the user is granted an extension.

(*Id.*, Pg. 3). (Emphasis added).

c) Interference means

Suzuki discloses interference means that takes effect when a term of use for software ends:

For paid software that has reached its contract expiration, an alert message is output before the expiration is reached and an interruption message is periodically output even after the expiration has been

reached. Thus, work will not be spontaneously interrupted and the like since the user is granted an extension.

(Suzuki, Pg. 3).

Next, A and B are compared, and processing is permitted (212) if it is within the contract term (205). Within an alert period (206), an alert message is output, or an extension message is output within an interruption grace period (207), and then the aforementioned message and the date of use are written to the paid software administration and maintenance file (211) and processing is allowed. (212) *If the interruption extension term has lapsed, processing is rejected (213).*

(*Id.*, Pg. 4). (Emphasis added).

16. The Morales Prior Art

United States Patent No. 5,291,554, entitled “Shared-Price Custom Video Rentals Via Interactive TV,” issued on March 1, 1994, from an application filed on August 19, 1992 by Fernando Morales, discloses many of the elements of a communications system for transmitting and controlling access to use of data/programs, e.g., video rentals, claimed in the ‘520 Patent. (See, e.g., Morales, Col. 5, lines 66-68; Col. 1, lines 10-13; Col. 2, lines 51-55). Morales was neither cited by the Applicant, nor cited or relied upon by the Examiner during prosecution of the ‘520 patent, is not cumulative to the references considered during the original prosecution, and, as demonstrated below and in the specific SNQs, raises new questions of patentability as to certain claims of the ‘520 patent.

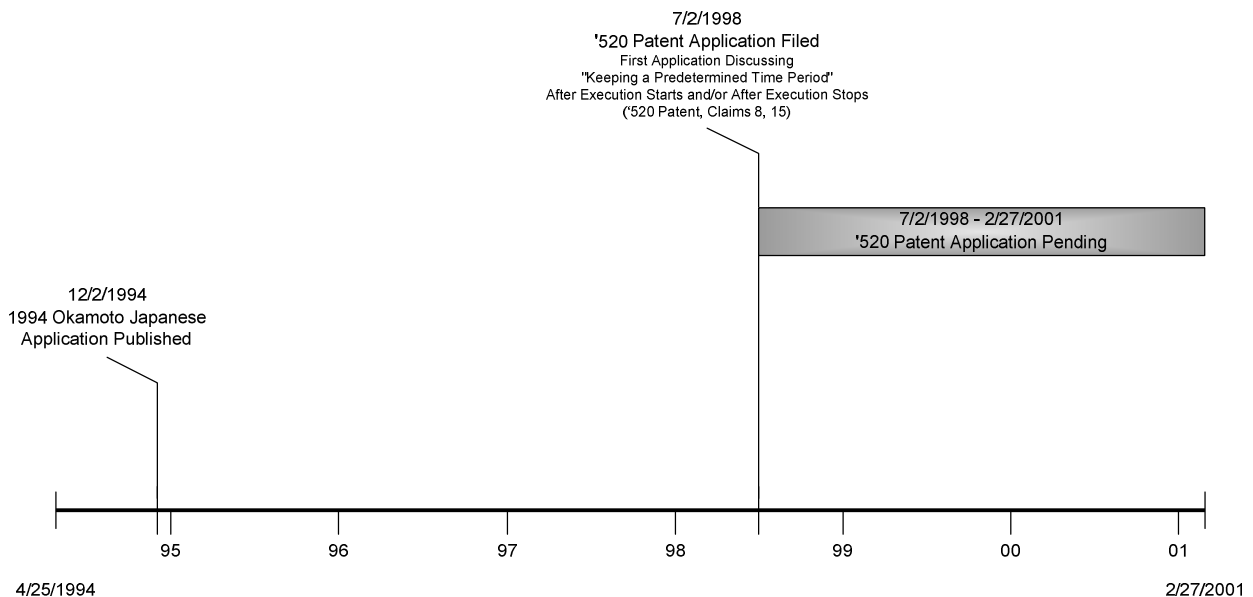
Unlike several of the other prior art references, which disclose interference with usage of the data/program after the expiration of a predetermined period, Morales discloses deleting the data, ensuring that a user will not be able to circumvent the access restrictions placed on his/her use:

To assure a single viewing, the one-shot software of section 52 is downloaded from the interactive data control center. This software is programmed to self destruct and erase after one viewing.

(*Id.*, Col. 6, lines 25-29; *see also id.*, Col. 3, lines 12-23; Col. 4, lines 56-64; Col. 5, lines 33-37).

B. Applicant's Own Japanese Application Is Invalidating Prior Art

Applicant's Japanese Laid-open Application, JP 5-108,303, filed May 10, 1993, and published December 2, 1994 as JP 6-334780 ("1994 Okamoto Japanese Application") contains features that render obvious many of the claims in the '520 patent. Additionally, because it was published more than one year before the '520 Application was filed (*see* timeline, below) it is available as prior art for any claims that are not entitled to Claim priority to an earlier application. (*See* discussion of '520 patent claims not entitled to an early priority date, beginning at Section IV, Pg. 21, above.) In other words, it is prior art to at least independent Claims 8 and 15, and their dependents.



**Reexam Figure 11 – 1994 Okamoto Japanese Application
Published More Than One Year Before '520 Application**

The 1994 Tokamoto Japanese Application, while of record in the '520 Application file history, was never cited or relied upon by the Examiner during prosecution of the '520 patent, is not cumulative to the references considered during the original prosecution, and, as demonstrated below and in the specific SNQs, raises new questions of patentability as to certain claims of the '520

patent. It is prior art under 35 USC § 102(b) for those '520 patent claims not entitled to a priority date earlier than the filing date of the '520 patent application.

The specification for the 1994 Okamoto Japanese Application is substantially similar to the specifications filed with the application that issued into Applicant's '103 Patent (compare Exhibit 6 *with* Exhibit 7). Because the '520 patent claims priority as a continuation-in-part of the '995 Patent Application, which itself is a division of the '744 Patent Application, which is a continuation-in-part of the '103 Patent Application, Applicant is expected to concede that at least some of the claims of the '520 patent are rendered obvious by the 1994 Okamoto Japanese Application, on the basis that these claims are not entitled to an earlier priority date.

The 1994 Okamoto Japanese Application discloses many elements recited in the claims of the ‘520 patent.¹² For example, compare the elements of Claim 1 of the ‘520 patent with corresponding elements in Claims 1, 5 of the 1994 Okamoto Japanese Application:

<p>‘520 Patent, Claim 1</p>	<p>1994 Okamoto Japanese Application, Claims 1, 3</p>
<p>1. 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:</p> <p>an input device for inputting instructions to</p>	<p>[Claim 1] A communicator comprising: a communication means which is connected to a communication line, and transmits or receives via said communication lines;</p> <p>and a computer which outputs control commands</p>

¹² Requester does not admit that the 1994 Okamoto Japanese Application enables the full scope of any of the ‘520 patent claims, especially since, e.g., Claim 1 of the ‘520 Application was broadened to include additional forms of interference not disclosed in earlier applications. (*See* Section IV, above).

‘520 Patent, Claim 1	1994 Okamoto Japanese Application, Claims 1, 3
<p>execute the program or to process the data,</p> <p>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,</p> <p>storage means for storing the program, the data, or a combination of the program and data received by said receiving means,</p> <p>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,</p> <p>clock means for keeping a predetermined time period after said receiving means receives the transmission, and</p> <p>interference means for interfering with execution of said executing means when said clock means counts said predetermined time period; and</p>	<p>with respect to the said communication means, and inputs the data from the above communication line via the above communication means and transmits the data to the above communication line via the above communication means;</p> <p>[transmits or receives via said communication lines;] (<i>See</i> earlier portion of Claim 1, above, for this language).</p> <p>the communicator wherein, at least, in case the data inputted from the above communication line is game information constituted by images or images and audio, it comprises an input data temporary memory means which temporarily stores the said game information,</p> <p>and also the above described computer comprises a game information output means by which in case the data stored in the said input data temporary memory means is game information, the game information is outputted to the internal or external image display means, and in case there are audio data also, the data is outputted to the internal or external audio output means.</p> <p>[Claim 3] A game software distribution system using a communicator wherein said system comprises a distribution center connected to enable transmission and reception with the communicator according to Claim 1 or Claim 2, and in case there is a game request to above described distribution center via above described communication line from above described communicator, the game information corresponding to the request from the distribution center is transmitted to the</p>

‘520 Patent, Claim 1	1994 Okamoto Japanese Application, Claims 1, 3
<p>said host facility comprising:</p> <p>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</p> <p>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.</p>	<p>applicable communicator via the above described communication line, and also the game information that was transmitted and is temporarily stored in the above described input data temporary memory means is erased after a specified time after the transmission.</p> <p>[said system comprises a distribution center] (See earlier portion of Claim 3, above, for this language).</p> <p>[<i>inherent</i>]</p> <p>[said system comprises a distribution center connected to enable transmission and reception with the communicator according to Claim 1 or Claim 2, and in case there is a game request to above described distribution center via above described communication line from above described communicator, the game information corresponding to the request from the distribution center is transmitted to the applicable communicator via the above described communication line] (See earlier portion of Claim 3, above, for this language).</p>

In the comparison above, every element of Claim 1 of the ‘520 Patent corresponds to a similar disclosure in the parallel claims (Claims 1 and 3) from the 1994 Okamoto Japanese Application, other than the claimed storage in the host facility (called a “distribution center” in the earlier application). Storage at the “distribution center” is arguably inherently in the claims of the 1995 Okamoto Japanese Application, however, given that the game data sent out by the “distribution

center” must be stored somewhere. Further, the 1994 Okamoto Japanese Application discloses storage in the distribution center elsewhere:

[0019] The distribution center 100 comprises a game software data base 101, a karaoke information base 103 and other data base (group) 105; a game information transmitter 111, a karaoke information transmitter 113 and other information transmitter 115 to search information from the corresponding data base of each 101, 103 and 105 and transmit them; and a control unit 120 which controls each data transmitter 111, 113, 115 and a head end 130 to output or input external signals.

(1994 Okamoto Japanese Application, Para. 19; *see also* Fig. 2).

In addition, the 1994 Okamoto Japanese Application discloses the second clock means and alarm (*id.*, Paras. 33-34; Fig. 7), interference by deletion (*id.*, Claim 3; Paras. 10, 12, 54; Fig. 7), and both a display and sound generating means (*id.*, Claim 4, Paras. 6, 8, 14-15, 47; Figs. 1, 3-6).

Therefore, as further set forth in the SNQs, below, the 1994 Okamoto Japanese Application, in view of references set forth below, renders obvious a number of the ‘520 patent’s claims, on the basis that those claims are not entitled to a priority date prior to the filing of the ‘520 Application.

VI. EACH CITED REFERENCE RAISES A SUBSTANTIAL NEW QUESTION OF PATENTABILITY

Each of the prior art references cited in this Request was at least filed prior to the time that the application to which the ‘520 patent claims priority was filed, or, in the case of claims for which Requester argues that Applicant cannot Claim priority, was filed before the date that the ‘520 patent application was filed. Each anticipatory reference is therefore available as prior art under at least 35 U.S.C. § 102(e) regardless of Applicant’s priority date, other than the 1994 Okamoto Japanese Application, which is available as prior art under 35 U.S.C. § 102(b) for those claims that are not entitled to claim priority to Applicant’s earlier applications. A number of references, noted below, are also available under 35 U.S.C. § 102(b), regardless of Applicant’s claimed priority date. All references are available under § 103 for obviousness.

Nothing in the public record suggests that the Patent Office considered any of the cited prior art references during prosecution of the '520 patent. None of the cited prior art references, either taken alone or in combination, is/are cumulative to the references considered during the original prosecution. As demonstrated below and in the specific SNQs, each of the cited prior art references raises new questions of patentability as to certain claims of the '520 patent.

Accordingly, each of these references is "new" art. Because each reference is "new" art, a substantial new question of patentability is raised when any one of the references is considered alone, or when a combination of two or more of the references render the claims obvious is considered.

As shown in more detail below, these references raise substantial new questions of patentability as to Claims 1-2, 4-5, 7-9, 11-12, 14-16, 18-19 and 21 of the '520 patent.

Additionally, several recent legal decisions are important in determining whether a Claim is obvious over the prior art. These are discussed in Section VII, Paragraph C, below.

**VII. STATEMENT IDENTIFYING EACH SUBSTANTIAL
NEW QUESTION OF PATENTABILITY PURSUANT TO
37 C.F.R. § 1.510(B)(1) AND THE APPLICATION OF EACH CITED
REFERENCE TO THE CLAIMS PURSUANT TO 37 C.F.R. § 1.510(b)(2)**

The claims of the '520 patent should be rejected for the reasons identified below. The supporting claim charts in Appendices A-Q identify the specific portion of each reference that discloses the respective Claim element cross-referenced in each proposed rejection.¹³

A. Legal Standards For Reexamination

A request for *ex parte* reexamination is appropriately granted where the Requester demonstrates the existence of a substantial new question of patentability for at least one Claim of the

¹³ Requester does not admit that any interpretations of the claims that may be set forth herein would also be proper in the Litigation or in other court proceedings that do not apply the "broadest reasonable interpretation" standard applied during reexamination. See MPEP § 2258.I.G.

patent. *See* Manual of Patent Examining Procedure (MPEP), Section 2642(I). Section 2642(I) sets forth the standard for this determination (emphasis in original):

A prior art patent or printed publication raises a substantial question of patentability where there is a substantial likelihood that a reasonable Examiner would consider the prior art patent or printed publication **important** in deciding whether or not the Claim is patentable. If the prior art patents and/or publications would be considered important, then the Examiner should find “a substantial new question of patentability” unless the same question of patentability has already been decided as to the Claim in a final holding of invalidity by the Federal court system or by the Office in a previous examination.

Patents and/or printed publications already cited/considered in an earlier concluded examination may also raise substantial new questions of patentability where such patents/printed publications are being presented or viewed in a new light, or in a different way, as compared with their use or understanding in earlier concluded examination(s), and are submitted as invalidating prior art references based on new arguments and/or interpretations contained in the reexamination Request. *See* MPEP § 2642(II)(A), citing *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351 (Bd. Pat. App. & Inter. 1984).

Finally, consistent with initial examinations, the scope given to Claim language during reexamination is broad: “During reexamination, claims are given the broadest reasonable interpretation consistent with the specification and limitations in the specification are not read into the claims. (*In re Yamamoto*, 211 F.2d 1569, 222 USPQ 934 (Fed. Cir. 1984)).” MPEP § 2258.I.G.

B. Rejections Under 35 U.S.C. § 102

1. Rejections Under 35 U.S.C. § 102(b)

The following is a quotation of 35 U.S.C. § 102(b), which forms the basis for proposed anticipation rejections, SNQs A through F, below:

A person shall be entitled to a patent unless . . .

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country,

more than one year prior to the date of the application for patent in the United States . . .

SNQ A. Chernow

Claims 1, 4-5, 7-8, 11-12, and 14 of the ‘520 patent are anticipated under 35 U.S.C. § 102(b) by Chernow.

A substantial new question is raised by Chernow as to Claims 1, 4-5, 7-8, 11-12, and 14 of the ‘520 patent. Chernow was neither cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, it is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendix A, important in determining whether or not the claims are patentable. In particular, as set forth herein, Chernow contains within its four corners each and every limitation of Claims 1, 4-5, 7-8, 11-12, and 14, arrayed or combined in the same way as in each claim. For this reason, Chernow raises a substantial new question of patentability with respect to Claims 1, 4-5, 7-8, 11-12, and 14.

(1) **Claim 1.** As set forth in Claim 1, Chernow discloses 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. (Chernow, Col. 1, lines 5-7; Col. 2, lines 23-30; Col. 5, lines 55-58; Col. 2, lines 6-9; Col. 5, lines 5-9; Col. 12, lines 40-44; Col. 10, lines 20-23). Chernow further discloses an input device for inputting instructions to execute the program or to process the data. (Chernow, Col. 6, lines 1-5). Chernow further discloses 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. (Chernow, Col. 3, lines 9-11; Col. 8, lines 28-33). Chernow further discloses storage means for storing the program, the data, or a combination of the program and data received by said receiving means. (Chernow, Col. 3, lines 9-14). Chernow further discloses 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. (Chernow, Col. 8, lines 53-57; Col. 3, lines 24-28). Chernow further discloses clock means for keeping a predetermined time period after said receiving means receives the transmission. (Chernow, Col. 4, lines 23-36). Chernow further discloses interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (Chernow, Col. 2, lines 3-5; Col. 4, line 68 – Col. 5, line 2; Col. 9, lines 45-48; Col. 10, lines 3-12; Col. 5, lines 10-18; Col. 4, lines 23-36). Chernow further discloses a 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 (Chernow, Col. 10, lines 27-32; Col. 11, lines 1-4; Col. 2, lines 30-36; Col. 8, lines 63-68), 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. (Chernow, Col. 2, lines 22-23, lines 37-40; Col 3, lines 9-11; Col. 8, lines 28-33; FIG. 1B). (*See* Appendix A, Elements 1-11).

(2) **Claim 4.** Claim 4 depends upon Claim 1. (*See* above). As set forth in Claim 4, Chernow further discloses that said interference means comprises means for deleting at least one of the program, the data, and a combination of the program and data stored in said storage means. (Chernow, Col. 2, lines 3-5; Col. 4, line 68 – Col. 5, line 2; Col. 5, lines 10-18; Col. 4, lines 23-36). (*See* Appendix A, Elements 16-17).

(3) **Claim 5.** Claim 5 depends upon Claim 1. (*See* above). As set forth in Claim 5, Chernow discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (Chernow, Col. 8, lines 52-57). Chernow further discloses, either explicitly or inherently, that said interference means comprises means for blocking the view of what is displayed on said screen. (Chernow, Col.

4, line 68 – Col 5, line 2; Col. 5, lines 10-18; Col. 4, lines 23-36). (*See* Appendix A, Elements 18-20).

(4) **Claim 7.** Claim 7 depends upon Claim 1. (*See* above). As set forth in Claim 7, by disclosing a computer and monitor, Chernow implicitly or inherently discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing. (Chernow, Col. 8, lines 52-57). Chernow further discloses, either explicitly or inherently, that said interference means comprises means for preventing said sound generating means from generating the sound. (Chernow, Col. 4, line 68 – Col. 5, line 2; Col. 5, lines 10-18; Col. 4, lines 23-36). (*See* Appendix A, Elements 21-23).

(5) **Claim 8.** Claim 8 is similar to Claim 1 (*see* above), except that it replaces the language “clock means for keeping a predetermined time period after said receiving means receives the transmission” with “clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing.” Chernow explicitly or inherently discloses clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing. (Chernow, Col. 5, lines 10-18; Col. 4, lines 23-36; Claim 8, Col. 14, lines 33-36). (*See* Appendix A, Elements 24-34).

(6) **Claim 11.** Claim 11 depends upon Claim 8. (*See* above). The analysis with respect to Claim 11 is the same as with respect to Claim 4. (*See* above; *see also* Appendix A, Elements 39-40).

(7) **Claim 12.** Claim 12 depends upon Claim 8. (*See* above). The analysis with respect to Claim 12 is the same as with respect to Claim 5. (*See* above; *see also* Appendix A, Elements 41-43).

(8) **Claim 14.** Claim 14 depends upon Claim 8. (*See above*). The analysis with respect to Claim 14 is the same as with respect to Claim 7. (*See above; see also Appendix A, Elements 44-46*).

SNQ B. Kato

Claims 1-2, 4-5, 7-9, 11-12, and 14 of the ‘520 patent are anticipated under 35 U.S.C. § 102(b) by Kato.

A substantial new question is raised by Kato as to Claims 1-2, 4-5, 7-9, 11-12, and 14 of the ‘520 patent. Kato was neither cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, it is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendix B, important in determining whether or not the claims are patentable. In particular, as set forth herein, Kato contains within its four corners each and every limitation of Claims 1-2, 4-5, 7-9, 11-12, and 14, arranged or combined in the same way as in each claim. For this reason, Kato raises a substantial new question of patentability with respect to Claims 1-2, 4-5, 7-9, 11-12, and 14.

(9) **Claim 1.** As set forth in Claim 1, Kato discloses 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. (Kato, Pgs. 5, 7). Kato further discloses an input device for inputting instructions to execute the program or to process the data. (Kato, Pgs. 11-12, 40-41; FIG. 1). Kato further discloses 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. (Kato, Pgs. 13-14; FIG. 1). Kato further discloses storage means for storing the program, the data, or a combination of the program and data received by said receiving means. (Kato, Pgs. 8-9, 16, 7-8, 25-26, 26; FIG. 1). Kato further discloses 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. (Kato, Pgs. 14, 16, 26-27; FIG. 1). Kato further discloses clock means for keeping a predetermined time period after said receiving means receives the transmission. (Kato, Pgs. 25-26, 28-29, 30-31; FIGS. 3b and 5e). Kato further discloses interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (Kato, Pgs. 28-29, 30-31, 7-8, 14-16, 37-39). Kato further discloses a 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 (Kato, Pgs. 10, 5, 19-20; FIG. 7), 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. (Kato, Pgs. 10-11, 8, 13-14, 25, 36-37; FIG. 7). (*See Appendix B, Elements 1-11*).

(10) **Claim 2.** Claim 2 depends upon Claim 1. (*See above*). As set forth in Claim 2, Kato discloses second clock means for keeping a second predetermined time period shorter than said predetermined time period counted by said clock means. (Kato, Pgs. 26, 28-29). Kato further discloses alarm means for issuing an alarm when said second clock means counts said second predetermined time period, and thereby informing that interference by said interference means with execution of said executing means will soon be performed. (Kato, Pgs. 28-29). (*See Appendix B, Elements 12-15*).

(11) **Claim 4.** Claim 4 depends upon Claim 1. (*See above*). As set forth in Claim 4, Kato further discloses that said interference means comprises means for deleting at least one of the program, the data, and a combination of the program and data stored in said storage means. (Kato, Pgs. 28-29, 30-31, 7-8, 14-16, 37-38, 38-39). (*See Appendix B, Elements 16-17*).

(12) **Claim 5.** Claim 5 depends upon Claim 1. (*See above*). As set forth in Claim 5, Kato discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (Kato, Pgs. 11-12, 40-41; FIG. 1). Kato further inherently discloses that said interference means comprises means for blocking the view of what is displayed on said screen. (Kato, Pgs. 28-29, 30-31, 7-8, 14-16, 37-39). (*See Appendix B, Elements 18-20*).

(13) **Claim 7.** Claim 7 depends upon Claim 1. (*See above*). As set forth in Claim 7, Kato explicitly or inherently discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing. (Kato, Pgs. 5, 11, 6; FIG. 7). Kato further inherently discloses that said interference means comprises means for preventing said sound generating means from generating the sound. (Kato, Pgs. 28-29, 30-31, 7-8, 14-16, 37-39). (*See Appendix B, Elements 21-23*).

(14) **Claim 8.** Claim 8 is similar to Claim 1 (*see above*), except that it replaces the language “clock means for keeping a predetermined time period after said receiving means receives the transmission” with “clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing.” Kato discloses clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing. (Kato, Pgs. 26, 28-29, 30-31, 25-26). (*See Appendix B, Elements 24-34*).

(15) **Claim 9.** Claim 9 depends upon Claim 8. (*See above*). The analysis with respect to Claim 9 is the same as with respect to Claim 2. (*See above; see also Appendix B, Elements 35-38.*)

(16) **Claim 11.** Claim 11 depends upon Claim 8. (*See above*). The analysis with respect to Claim 11 is the same as with respect to Claim 4. (*See above; see also Appendix B, Elements 39-40.*)

(17) **Claim 12.** Claim 12 depends upon Claim 8. (*See above*). The analysis with respect to Claim 12 is the same as with respect to Claim 5. (*See above; see also Appendix B, Elements 41-43.*)

(18) **Claim 14.** Claim 14 depends upon Claim 8. (*See above*). The analysis with respect to Claim 14 is the same as with respect to Claim 7. (*See above; see also Appendix B, Elements 44-46.*)

SNQ C. Nakagawa

Claims 8-9, 12, and 14 of the ‘520 patent are anticipated under 35 U.S.C. § 102(b) by Nakagawa.

A substantial new question is raised by Nakagawa as to Claims 8-9, 12, and 14 of the ‘520 patent. Nakagawa was neither cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, it is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendix C, important in determining whether or not the claims are patentable. In particular, as set forth herein, Nakagawa contains within its four corners each and every limitation of Claims 8-9, 12, and 14, arranged or combined in the same way as in each claim. For this reason, Nakagawa raises a substantial new question of patentability with respect to Claims 8-9, 12, and 14.

(19) **Claim 8.** As set forth in Claim 8, Nakagawa discloses 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. (Nakagawa, Col. 1, lines 44-47; Col. 7, lines 15-18; Col. 11, lines 50-51, 57-59, 64-68; Col. 1, lines 44-47). Nakagawa further discloses an input device for inputting instructions to execute the program or to process the data. (Nakagawa, FIGS. 1, 22a & 22b; Col. 3, lines 34-37; Col. 2, lines 3-10). Nakagawa further discloses 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. (Nakagawa, Col. 12, lines 6-11). Nakagawa further discloses storage means for storing the program, the data, or a combination of the program and data received by said receiving means. (Nakagawa, FIG. 3B, block 86 [Working RAM] and associated text; FIG. 6, blocks S207 [Transfer Program] & S209 [Set Bank Number] and associated text; Col. 10, lines 44-47).

Nakagawa further discloses 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. (Nakagawa, FIG. 1, block 60 [CPU]; FIG. 7, block 60 [μ P]; Col. 2, lines 3-10; Col. 12, lines 59-64). Nakagawa further discloses clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing. (Nakagawa, Col. 2, lines 31-33; Col. 13, lines 60-68). Nakagawa further discloses interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (Nakagawa, Col. 5, lines 46-60; Col. 2, lines 34-40; Col. 14, lines 36-47). Nakagawa further discloses a 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 (Nakagawa, FIG. 3C and associated text; Col. 6, lines 23-32; Col. 6, lines 47-49), 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. (Nakagawa, Col. 6, lines 37-43; Col. 11, lines 50-51, 57-59, 64-68). (*See* Appendix C, Elements 24-34).

(20) Claim 9. Claim 9 depends upon Claim 8. (*See* above). As set forth in Claim 9, Nakagawa discloses second clock means for keeping a second predetermined time period shorter than said predetermined time period counted by said clock means. (Nakagawa, Col. 2, lines 34-40; Col. 13, lines 34-42). Nakagawa further discloses alarm means for issuing an alarm when said second clock means counts said second predetermined time period, and thereby informing that

interference by said interference means with execution of said executing means will soon be performed. (Nakagawa, Col. 2, lines 34-48; Col. 12, lines 12-22; Col. 14, lines 29-35). (*See* Appendix C, Elements 35-38.)

(21) **Claim 12.** Claim 12 depends upon Claim 8. (*See* above). As set forth in Claim 12, Nakagawa discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (Nakagawa, FIGS. 1, 32; Col. 9, line 54 – Col. 10, line 2; Col. 4, lines 22-27; Col. 2, lines 3-10; Col. 6, lines 16-20). Nakagawa further discloses that said interference means comprises means for blocking the view of what is displayed on said screen. (Nakagawa, Col. 9, lines 51-54; Col. 11, lines 40-43; Col. 14, lines 36-47; Col. 15, lines 2-4). (*See* Appendix C, Elements 41-43.)

(22) **Claim 14.** Claim 14 depends upon Claim 8. (*See* above). As set forth in Claim 14, Nakagawa discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing. (Nakagawa, Col. 9, line 54 – Col. 10, line 2; Col. 4, lines 22-27; Col. 6, lines 16-20). Nakagawa further discloses that said interference means comprises means for preventing said sound generating means from generating the sound. (Nakagawa, Col. 11, lines 50-55; Col. 14, lines 36-47). (*See* Appendix C, Elements 44-46.)

SNQ D. Oseki

Claims 1, 4-5, 7-8, 11-12, and 14 of the ‘520 patent are anticipated under 35 U.S.C. § 102(b) by Oseki.

A substantial new question is raised by Oseki as to Claims 1, 4-5, 7-8, 11-12, and 14 of the ‘520 patent. Oseki was neither cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, it is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendix D, important in determining whether or not the claims are patentable. In

particular, as set forth herein, Oseki contains within its four corners each and every limitation of Claims 1, 4-5, 7-8, 11-12, and 14, arranged or combined in the same way as in each claim. For this reason, Oseki raises a substantial new question of patentability with respect to Claims 1, 4-5, 7-8, 11-12, and 14.

(23) Claim 1. As set forth in Claim 1, Oseki discloses 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. (Oseki, Pgs. 3-5). Oseki further discloses, either explicitly or inherently, an input device for inputting instructions to execute the program or to process the data. (Oseki, Pg. 5). Oseki further discloses 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. (Oseki, Pgs. 4-7). Oseki further discloses storage means for storing the program, the data, or a combination of the program and data received by said receiving means. (Oseki, Pg. 5). Oseki further discloses 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. (Oseki, Pgs. 4-7). Oseki further discloses clock means for keeping a predetermined time period after said receiving means receives the transmission. (Oseki, Pgs. 5, 7). Oseki further discloses interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (Oseki, Pgs. 3-7; Claims 1-2, 5-6, Pgs. 1-2). Oseki further discloses a 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 (Oseki, Pgs. 1-2, 4-5), 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. (Oseki, 1-2, 4-6). (*See Appendix D, Elements 1-11*).

(24) **Claim 4.** Claim 4 depends upon Claim 1. (*See above*). As set forth in Claim 4, Oseki further discloses that said interference means comprises means for deleting at least one of the program, the data, and a combination of the program and data stored in said storage means. (Oseki, Oseki, Pgs. 3-7; Claims 1-2, 5-6, Pgs. 1-2). (*See Appendix D, Elements 16-17*).

(25) **Claim 5.** Claim 5 depends upon Claim 1. (*See above*). As set forth in Claim 5, Oseki inherently discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed, by virtue of disclosing a computer that runs software for a user and receives information from the user to make requests. (*e.g.*, Oseki, Pgs. 4-5). Oseki further inherently discloses that said interference means comprises means for blocking the view of what is displayed on said screen. This disclosure is inherent from the fact that Oseki discloses deleting and/or disabling the program, which would cause it to not be displayed to the user. (Oseki, Pgs. 3-7; Claims 1-2, 5-6, Pgs. 1-2). (*See Appendix D, Elements 18-20*).

(26) **Claim 7.** Claim 7 depends upon Claim 1. (*See above*). As set forth in Claim 7, Oseki inherently discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing, by disclosing a computer that runs software from the user. (Oseki, 4-5). Oseki further inherently discloses that said interference means comprises means for preventing said sound generating means from generating the sound. This disclosure is inherent from the fact that Oseki discloses deleting and/or disabling the program, which would cause it to not trigger the sound generating means to generate sound. (Oseki, Oseki, Pgs. 3-7; Claims 1-2, 5-6, Pgs. 1-2). (*See Appendix D, Elements 21-23*).

(27) **Claim 8.** Claim 8 is similar to Claim 1 (*see above*), except that it replaces the language “clock means for keeping a predetermined time period after said receiving means receives the transmission” with “clock means for keeping a predetermined time period after said executing

means starts execution of the program or data processing.” Oseki discloses clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing. (Oseki, Pgs. 2, 5, 7). (*See* Appendix D, Elements 24-34).

(28) **Claim 11.** Claim 11 depends upon Claim 8. (*See* above). The analysis with respect to Claim 11 is the same as with respect to Claim 4. (*See* above; *see also* Appendix D, Elements 39-40).

(29) **Claim 12.** Claim 12 depends upon Claim 8. (*See* above). The analysis with respect to Claim 12 is the same as with respect to Claim 5. (*See* above; *see also* Appendix D, Elements 41-43).

(30) **Claim 14.** Claim 14 depends upon Claim 8. (*See* above). The analysis with respect to Claim 14 is the same as with respect to Claim 7. (*See* above; *see also* Appendix D, Elements 44-46).

SNQ E. Bakoglu

Claims 8-9, 12, and 14 of the ‘520 patent are anticipated under 35 U.S.C. § 102(b) by Bakoglu.¹⁴

A substantial new question is raised by Bakoglu as to Claims 8-9, 12, and 14 of the ‘520 patent. Bakoglu was neither cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, it is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendix E, important in determining whether or not the claims are patentable. In particular, as set forth herein, Bakoglu contains within its four corners each and every limitation of Claims 8-9, 12, and 14, arranged or combined in the same way as in each claim. For this reason, Bakoglu raises a substantial new question of patentability with respect to Claims 8-9, 12, and 14.

¹⁴ On the basis that Claim 8 and its dependents are not entitled to a filing date earlier than July 2, 1998 (*see* priority discussion above), Bakoglu is prior art under 35 U.S.C. § 102(b). Otherwise, it is prior art under § 102(e).
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(31) **Claim 8.** As set forth in Claim 8, Bakoglu discloses 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. (Bakoglu, Abstract; Col. 1, lines 5-6, 9-37, 54-67; Col. 2, lines 8-33; Col. 2, line 47 – Col. 3, line 6; FIGS. 1-2). Bakoglu further discloses an input device for inputting instructions to execute the program or to process the data. (Bakoglu, Col. 1, lines 54-60; Col. 2, lines 8-18; Col. 2, line 47-54; FIGS. 1-2). Bakoglu further discloses 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. (Bakoglu, Col 1, lines 5-6, 28-37, 54-60; Col. 2, lines 8-33; Col. 2, line 47 – Col. 3, line 6; FIGS. 1-2). Bakoglu further discloses storage means for storing the program, the data, or a combination of the program and data received by said receiving means. (Bakoglu, Col. 2, lines 8-33; Col. 2, line 55 – Col. 3, line 6; FIGS. 1-2). Bakoglu further discloses 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. (Bakoglu, Col. 1, lines 54-60; Col. 2, lines 8-18; Col. 2, line 47 – Col. 3, line 6; FIGS. 1-2). Bakoglu further discloses clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing. (Bakoglu, Abstract; Col. 1, lines 28-37, 54-60; Col. 2, lines 8-33; Col. 3, lines 1-15, 17-41; FIG. 3). Bakoglu further discloses interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (Bakoglu, Abstract; Col. 1, lines 28-37, 61-67; Col. 2, lines 8-33; Col. 3, lines 7-15, 17-41; FIG. 3). Bakoglu further discloses a 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 (Bakoglu, FIGS. 1-2), 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. (Bakoglu, Col. 1, lines 5-6, 28-37, 54-60; Col. 2, lines 8-18, 47-54; FIGS. 1-2). (*See* Appendix E, Elements 24-34).

(32) **Claim 9.** Claim 9 depends upon Claim 8. (*See* above). As set forth in Claim 9, Bakoglu discloses second clock means for keeping a second predetermined time period shorter than said predetermined time period counted by said clock means. (Bakoglu, Col. 4, lines 19-26). Bakoglu further discloses alarm means for issuing an alarm when said second clock means counts said second predetermined time period, and thereby informing that interference by said interference means with execution of said executing means will soon be performed. (*Id.*). (*See* Appendix E, Elements 35-38).

(33) **Claim 12.** Claim 12 depends upon Claim 8. (*See* above). As set forth in Claim 12, Bakoglu discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (Bakoglu, Col. 1, lines 54-60; Col. 2, line 55 – Col. 3, line 6; FIGS. 1-2). Bakoglu further discloses that said interference means comprises means for blocking the view of what is displayed on said screen. (Bakoglu, Abstract, Claims 5-7; Col. 1, lines 28-37, 61-67; Col. 2, lines 8-33; Col. 3, lines 7-15, 17-41; FIG. 3). (*See* Appendix E, Elements 41-43).

(34) **Claim 14.** Claim 14 depends upon Claim 8. (*See* above). As set forth in Claim 14, Bakoglu discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing. (Bakoglu, Col. 1, lines 54-60; Col. 2, lines 55-61; FIGS. 1-2). Bakoglu further inherently discloses that said interference means comprises means for preventing said sound generating means from generating the sound. (Bakoglu, Abstract, Claims 5-7; Col. 1, lines 28-37, 61-67; Col. 2, lines 8-33; Col. 3, lines 7-15, 17-41; FIG. 3). (*See* Appendix E, Elements 44-46).

SNQ F. Hornbuckle

Claims 8, 11-12, and 14 of the ‘520 patent are anticipated under 35 U.S.C. § 102(b) by Hornbuckle.¹⁵

A substantial new question is raised by Hornbuckle as to Claims 8, 11-12, and 14 of the ‘520 patent. Hornbuckle was neither cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, it is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendix G, important in determining whether or not the claims are patentable. In particular, as set forth herein, Hornbuckle contains within its four corners each and every limitation of Claims 8, 11-12, and 14, arranged or combined in the same way as in each claim. For this reason, Hornbuckle raises a substantial new question of patentability with respect to Claims 8, 11-12, and 14.

(35) Claim 8. As set forth in Claim 8, Hornbuckle discloses 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. (Hornbuckle, Abstract, Col. 2, lines 52-56, 60-63; Col. 3, lines 23-36; Col. 3, line 58 – Col. 4, line 21; Col. 5, lines 9-16; Col. 14, lines 41-49; Col. 16, lines 12-22, 60-65; FIGS. 1, 4). Hornbuckle further discloses an input device for inputting instructions to execute the program or to process the data. (Hornbuckle, Col. 4, lines 13-21; Col. 14, line 67 – Col. 15, line 3; FIGS. 1, 4). Hornbuckle further discloses 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. (Hornbuckle, Col. 2, line 64 – Col. 3, line 3; Col. 5, lines 9-16, 25-29, 35-37; Col. 6, lines 14-18, 24-31, 53-58; Col. 7, line 61 – Col. 8, line 7; Col. 9, lines 35-46; Col. 13, lines 11-15; Col. 14, lines 49-56; Col. 15, lines 9-20, 38-43; Col. 16, lines 12-22; Figs 1-2, 4-5). Hornbuckle further

¹⁵ On the basis that Claim 8 and its dependents are not entitled to a filing date earlier than July 2, 1998 (*see* priority discussion above), Hornbuckle is prior art under 35 U.S.C. § 102(b). Otherwise, it is prior art under § 102(e).
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discloses storage means for storing the program, the data, or a combination of the program and data received by said receiving means. (Hornbuckle, Col. 4, lines 7-11; Col. 5, lines 25-29; Col. 6, lines 24-31, 45-52; Col. 12, lines 29-34; Col. 13, lines 11-15; Col. 15, lines 9-20; Col. 16, lines 12-22; Col. 17, lines 1-7; FIGS. 1-2, 4-5). Hornbuckle further discloses 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. (Hornbuckle, Col. 6, lines 24-31, 33-39; Col. 13, lines 19-24, 38-42; Col. 14, lines 60-64; Col. 15, lines 9-20; Col. 16, lines 22-24; FIGS. 2, 5). Hornbuckle further discloses clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing. (Hornbuckle, Col. 3, lines 4-8; Col. 6, lines 24-31; Col. 6, line 59 – Col. 7, line 4; Col. 11, lines 27-33, 49-53; Col. 13, lines 32-37, 42-54; Col. 15, lines 9-20; FIGS. 2, 5). Hornbuckle further discloses interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (Hornbuckle, Col. 13, lines 42-50; Col. 13, line 51 – Col. 14, line 3). Hornbuckle further discloses a 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 (Hornbuckle, Col. 5, lines 17-18; Col. 6, lines 24-31, 45-58; Col. 14, lines 56-59; Col. 15, lines 9-20; FIGS. 1-2, 4-5), 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. (Hornbuckle, Col. 2, line 64 – Col. 3, line 3; Col. 4, lines 4-7, 13-21; Col. 5, lines 9-16, 35-37; Col. 6, lines 4-10, 24-31; Col. 7, line 61 – Col. 8, line 7; Col. 9, lines 35-46; Col. 14, lines 49-56; Col. 15, lines 9-20, 38-43; Col. 16, lines 12-22; FIGS. 1, 4-5). (*See* Appendix G, Elements 24-34).

(36) **Claim 11.** Claim 11 depends upon Claim 8. (*See above*). As set forth in Claim 11, Hornbuckle further discloses that said interference means comprises means for deleting at least one of the program, the data, and a combination of the program and data stored in said storage means. (Hornbuckle, Col. 13, line 42 – Col. 14, line 3). (*See Appendix G, Elements 39-40.*)

(37) **Claim 12.** Claim 12 depends upon Claim 8. (*See above*). As set forth in Claim 12, Hornbuckle discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (Hornbuckle, Col. 4, lines 13-21; Col. 14, lines 60-64; Col. 15, lines 3-7; FIGS. 1, 4). Hornbuckle further inherently discloses that said interference means comprises means for blocking the view of what is displayed on said screen. (Hornbuckle, Col. 13, line 42 – Col. 14, line 3). (*See Appendix G, Elements 41-43.*)

(38) **Claim 14.** Claim 14 depends upon Claim 8. (*See above*). As set forth in Claim 14, Hornbuckle discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing. (Hornbuckle, Col. 5, lines 9-16; Col. 15, 3-7). Hornbuckle further inherently discloses that said interference means comprises means for preventing said sound generating means from generating the sound. (Hornbuckle, Col. 13, line 42 – Col. 14, line 3). (*See Appendix G, Elements 44-46.*)

2. Rejections Under 35 U.S.C. § 102(a)

The following is a quotation of 35 U.S.C. § 102(a), which forms the basis for proposed anticipation rejection, SNQ G, below:

A person shall be entitled to a patent unless . . .

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent . . .

SNQ G. Garfinkle

Claims 1, 4-5, 7-8, 11-12, and 14 of the ‘520 patent are anticipated under 35 U.S.C. § 102(a) by Garfinkle.¹⁶

A substantial new question is raised by Garfinkle as to Claims 1, 4-5, 7-8, 11-12, and 14 of the ‘520 patent. Garfinkle was neither cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, it is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendix F, important in determining whether or not the claims are patentable. In particular, as set forth herein, Garfinkle contains within its four corners each and every limitation of Claims 1, 4-5, 7-8, 11-12, and 14, arranged or combined in the same way as in each claim. For this reason, Garfinkle raises a substantial new question of patentability with respect to Claims 1, 4-5, 7-8, 11-12, and 14.

(39) Claim 1. As set forth in Claim 1, Garfinkle discloses 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. (Garfinkle, Abstract; Col. 1, lines 7-11, 13-19; Col. 2, lines 54-63; Col. 2, line 66 – Col. 3, line 7; Col. 3, lines 12-16). Garfinkle further discloses an input device for inputting instructions to execute the program or to process the data. (Garfinkle, Col. 2, line 66 – Col. 3, line 7). Garfinkle further discloses 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. (Garfinkle, Col. 1, lines 7-11, 13-19; Col. 2, lines 54-59; Col. 2, line 66 – Col. 3, line 7; Figs 1, 2; Claims 1-3). Garfinkle further discloses storage means for storing the program, the data, or a

¹⁶ On the basis that Claim 1 and its dependents are not entitled to a filing date earlier than November 9, 1995 (*see* priority discussion above), Garfinkle is prior art under 35 U.S.C. § 102(a) for Claims 1, 4-5, and 7. Otherwise, it is prior art under § 102(e). On the basis that Claim 8 and its dependents are not entitled to a filing date earlier than July 2, 1998 (*see* priority discussion above), Garfinkle is prior art under 35 U.S.C. § 102(b) for Claims 8, 11-12, and 14. Otherwise, it is prior art under § 102(e). Regardless of their priority date Garfinkle is prior art under at least 35 U.S.C. § 102(e) for the remaining claims (1, 4-5, and 7).

combination of the program and data received by said receiving means. (Garfinkle, Col. 2, lines 54-63; Col. 3, lines 12-26; Figs 1, 2; Claims 1-3). Garfinkle further discloses 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. (Garfinkle, Col. 3, lines 12-26; Col. 4, lines 25-29, 40-48; FIGS. 1-2; Claims 1-3). Garfinkle further discloses clock means for keeping a predetermined time period after said receiving means receives the transmission. (Garfinkle, Col. 2, lines 18-36; Col. 3, line 27 – Col. 4, line 48). Garfinkle further discloses interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (Garfinkle, Abstract; Col. 2, lines 18-36, 46-50; Col. 3, lines 22-26; Col. 3, line 43 – Col. 4, line 29). Garfinkle further discloses a 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 (Garfinkle, Col. 2, lines 54-63), 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. (Garfinkle, Col. 1, lines 7-11, 13-19; Col. 2, lines 54-59; Col. 2, line 66 – Col. 3, line 7; FIGS. 1-2; Claims 1-3). (*See* Appendix F, Elements 1-11).

(40) **Claim 4.** Claim 4 depends upon Claim 1. (*See* above). As set forth in Claim 4, Garfinkle further discloses that said interference means comprises means for deleting at least one of the program, the data, and a combination of the program and data stored in said storage means. (Garfinkle, Col. 2, lines 18-36; Col. 3, lines 22-26, 43-50; Col. 4, line 25-48; FIG. 3; Claim 3). (*See* Appendix F, Elements 16-17).

(41) **Claim 5.** Claim 5 depends upon Claim 1. (*See* above). As set forth in Claim 5, Garfinkle discloses that said communication terminal device comprises display means having a

screen on which the progress of execution of the program or data processing is displayed. (Garfinkle, Col. 3, lines 12-21; FIGS. 1-2; Claims 1-3). Garfinkle further discloses that said interference means comprises means for blocking the view of what is displayed on said screen. (Garfinkle, Abstract; Col. 2, lines 18-36, 46-50; Col. 3, lines 22-26; Col. 3, line 43 – Col. 4, line 48; FIG. 3; Claims 1-3). (See Appendix F, Elements 18-20).

(42) **Claim 7.** Claim 7 depends upon Claim 1. (See above). As set forth in Claim 7, Garfinkle inherently discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing. (Garfinkle, Col. 3, lines 12-16). Garfinkle further discloses that said interference means comprises means for preventing said sound generating means from generating the sound. (Garfinkle, Abstract; Col. 2, lines 18-36; Col. 3, lines 22-26; Col. 4, lines 30-48; Claims 1-2). (See Appendix F, Elements 21-23).

(43) **Claim 8.** Claim 8 is similar to Claim 1 (see above), except that it replaces the language “clock means for keeping a predetermined time period after said receiving means receives the transmission” with “clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing.” Garfinkle further discloses clock means for keeping a predetermined time period after said receiving means receives the transmission, as well as means for basing use of the rented data on the number of uses. (Garfinkle, Col. 2, lines 18-36; Col. 3, line 27 – Col. 4, line 48). In view of this, Garfinkle inherently discloses clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing. (See Appendix F, Elements 24-34).

(44) **Claim 11.** Claim 11 depends upon Claim 8. (See above). The analysis with respect to Claim 11 is the same as with respect to Claim 4. (See above; see also Appendix F, Elements 39-40.)

(45) **Claim 12.** Claim 12 depends upon Claim 8. (*See* above). The analysis with respect to Claim 12 is the same as with respect to Claim 5. (*See* above; *see also* Appendix F, Elements 41-43.)

(46) **Claim 14.** Claim 14 depends upon Claim 8. (*See* above). The analysis with respect to Claim 14 is the same as with respect to Claim 7. (*See* above; *see also* Appendix F, Elements 44-46.)

3. **Rejections Under 35 U.S.C. § 102(e)**

The following is a quotation of 35 U.S.C. § 102(e), which forms the basis for proposed anticipation rejections, SNQs H through J, below:

A person shall be entitled to a patent unless . . .

(e) the invention was described in . . . a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent . . .

SNQ H. **Kaniwa**

Claims 1, 5, 7-8, 12, and 14 of the ‘520 patent are anticipated under 35 U.S.C. § 102(e) by Kaniwa.¹⁷

A substantial new question is raised by Kaniwa as to Claims 1, 5, 7-8, 12, and 14 of the ‘520 patent. Kaniwa was neither cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, it is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendix H, important in determining whether or not the claims are patentable. In particular, as set forth herein, Kaniwa contains within its four corners each and every limitation of Claims 1, 5, 7-8, 12, and 14, arranged or combined in the same way as in each claim. For this

¹⁷ On the basis that Claim 8 and its dependents are not entitled to a filing date earlier than July 2, 1998 (*see* priority discussion, above), Kaniwa is prior art under 35 U.S.C. § 102(b) for Claims 8, 12, and 14. Otherwise, it is prior art under § 102(e). Regardless of their priority date, Kaniwa is prior art under at least 35 U.S.C. § 102(e) for the remaining claims (1, 5, and 7).

reason, Kaniwa raises a substantial new question of patentability with respect to Claims 1, 5, 7-8, 12, and 14.

(47) **Claim 1.** As set forth in Claim 1, Kaniwa discloses 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. (Kaniwa, Col. 1, lines 9-19; Col. 7, lines 40-44, 53-65; Col. 3, lines 19-22; Col. 24, lines 32-38; Abstract). Kaniwa further discloses an input device for inputting instructions to execute the program or to process the data. (Kaniwa, Col. 8, line 1 – Col. 9, line 11; FIGS. 2, 12, 15-16). Kaniwa further discloses 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. (Kaniwa, Col. 8, line 1 – Col. 9, line 11; FIGS. 2, 12, 15-16). Kaniwa further discloses storage means for storing the program, the data, or a combination of the program and data received by said receiving means. (Kaniwa, Col. 8, line 1 – Col. 9, line 11; FIGS. 2, 12, 15-16). Kaniwa further discloses 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. (Kaniwa, Col. 18, lines 53-59; Col. 8, lines 1-21; Col. 19, lines 17-49; FIGS. 2, 12, 15-16). Kaniwa further discloses clock means for keeping a predetermined time period after said receiving means receives the transmission. (Kaniwa, Col. 5, line 57 – Col. 6, line 3; Col. 18, line 39 – Col. 19, line 9; Col. 20, line 63 – Col. 21, line 22; Col. 21, lines 25-59; Col. 11, line 55 – Col. 12, line 34; Col. 17, lines 61-65; Col. 18, lines 22-38; Col. 19, lines 5-58; Col. 21, line 64 – Col. 22, line 36; Col. 22, line 56 – Col. 24, line 2; FIGS. 12, 15-16). Kaniwa further discloses interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (Kaniwa, Col. 19, lines 17-49; Col. 19, line 54 – Col. 20, line 4; Col. 19, lines 5-58; Col. 21, lines 25-63; FIGS. 12, 15-16). Kaniwa further discloses a 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 (Kaniwa, Col. 7, lines 8-38, 53-65; Col. 3, lines 19-22; Col. 21, lines 30-36; Col. 24, lines 32-38; FIG. 2.), 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. (Kaniwa, Col. 7, lines 8-53; Col. 21, lines 25-36; Col. 19, lines 10-16; Col. 21, lines 30-36; FIG. 2.). (*See* Appendix H, Elements 1-11).

(48) Claim 5. Claim 5 depends upon Claim 1. (*See* above). As set forth in Claim 5, Kaniwa discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (Kaniwa, Col. 7, lines 53-62; Col. 8, line 1 – Col. 9, line 11; Col. 18, line 39 – Col. 19, line 9; FIGS. 1-2, 12, 15-16). Kaniwa further discloses that said interference means comprises means for blocking the view of what is displayed on said screen. (Kaniwa, Col. 19, line 54 – Col. 20, line 4; Col. 21, lines 25-63; FIGS. 12, 15-16.). (*See* Appendix H, Elements 18-20).

(49) Claim 7. Claim 7 depends upon Claim 1. (*See* above). As set forth in Claim 7, Kaniwa discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing. (Kaniwa, Col. 7, lines 53-62; Col. 8, line 1 – Col. 9, line 11; Col. 18, line 39 – Col. 19, line 9; FIGS. 1-2, 12, 15-16). Kaniwa further discloses that said interference means comprises means for preventing said sound generating means from generating the sound. (Kaniwa, Col. 19, line 5 – Col. 20, line 4; Col. 21, lines 25-63; FIGS. 12, 15-16.). (*See* Appendix H, Elements 21-23).

(50) Claim 8. Claim 8 is similar to Claim 1 (*see* above), except that it replaces the language “clock means for keeping a predetermined time period after said receiving means receives the transmission” with “clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing.” Kaniwa discloses clock means for

keeping a predetermined time period after said executing means starts execution of the program or data processing. (Kaniwa, Col. 5, line 57 – Col. 6, line 3; Col. 18, line 39 – Col. 19, line 9; Col. 20, line 63 – Col. 21, line 22; Col. 21, lines 25-59; Col. 22, lines 19-25; Col. 11, line 55 – Col. 12, line 34; Col. 17, lines 61-65; Col. 18, lines 22-38; Col. 19, lines 5-58; Col. 21, line 64 – Col. 22, line 36; Col. 22, line 56 – Col. 24, line 2; FIGS. 12, 15-16). (*See* Appendix H, Elements 24-34).

(51) **Claim 12**. Claim 12 depends upon Claim 8. (*See* above). The analysis with respect to Claim 12 is the same as with respect to Claim 5. (*See* above; *see also* Appendix H, Elements 41-43).

(52) **Claim 14**. Claim 14 depends upon Claim 8. (*See* above). The analysis with respect to Claim 14 is the same as with respect to Claim 7. (*See* above; *see also* Appendix H, Elements 44-46).

SNQ I. McCarten

Claims 1, 5, 7-8, 12, and 14 of the ‘520 patent are anticipated under 35 U.S.C. § 102(e) by McCarten.

A substantial new question is raised by McCarten as to Claims 1, 5, 7-8, 12, and 14 of the ‘520 patent. McCarten was neither cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, it is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendix I, important in determining whether or not the claims are patentable. In particular, as set forth herein, McCarten contains within its four corners each and every limitation of Claims 1, 5, 7-8, 12, and 14, arranged or combined in the same way as in each claim. For this reason, McCarten raises a substantial new question of patentability with respect to Claims 1, 5, 7-8, 12, and 14.

(53) **Claim 1.** As set forth in Claim 1, McCarten discloses 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. (McCarten, FIG. 2, block 15-21; FIGS. 3A, 3B and associated text; Col. 1, lines 27-32; Abstract; Col. 4, lines 60-65; Col. 15, line 66 –Col. 16, line 2). McCarten further discloses an input device for inputting instructions to execute the program or to process the data. (McCarten, Col. 6, line 60-64; Col. 4, line 46-54). McCarten further discloses 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. (McCarten, FIG. 3A, block 40 (Download Data Received); Col. 5, lines 54-55, 61-65; Col. 9, lines 14-17; Col. 15, lines 30-35). McCarten further discloses storage means for storing the program, the data, or a combination of the program and data received by said receiving means. (McCarten, FIG. 5, block 102 (Memory Board); Col. 8, lines 3-6, 10-18; Col. 10, lines 20-28; FIG. 3A, block 68 (Write To Memory); Col. 6, lines 26-27; Col. 15, lines 39-43). McCarten further discloses 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. (McCarten, FIG. 4, blocks 82 (Video Game Processing Board), 84 (Microcontroller Interface) and associated text; FIG. 8 (Exemplary Computer/Video Game Processing System); Col. 2, lines 7-9; Col. 4, 60-65; Col. 6, lines 35-38; FIG. 3B, block 80, Execute Program (File); Col. 15, lines 43-47; Col. 14, 3-8). McCarten further discloses clock means for keeping a predetermined time period after said receiving means receives the transmission. (McCarten, Col. 10, line 66 – Col. 11, line 5). McCarten further discloses interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (McCarten, Col. 10, line 66 – Col. 11, line 5). McCarten further discloses a 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 (McCarten, FIG. 1, block 2 (Master Control Computer), block 3 (memory) and associated text; Abstract; Col. 3, lines 6-10), 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. (McCarten, Col. 1, lines 53-54; Col. 2, lines 11-14; Col. 15, lines 30-35). (*See* Appendix I, Elements 1-11).

(54) Claim 5. Claim 5 depends upon Claim 1. (*See* above). As set forth in Claim 5, McCarten discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (McCarten, FIG. 4, block 90 (LCD Display); Col. 1, lines 48-52; Col. 7, lines 23-26, 38-45). McCarten further discloses that said interference means comprises means for blocking the view of what is displayed on said screen. (McCarten, Col. 10, line 66 – Col. 11, line 5). (*See* Appendix I, Elements 18-20).

(55) Claim 7. Claim 7 depends upon Claim 1. (*See* above). As set forth in Claim 7, McCarten discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing. (McCarten, FIG. 5, AUDIO L & AUDIO R; Col. 9, lines 27-30; Col. 14, lines 19-24). McCarten further discloses that said interference means comprises means for preventing said sound generating means from generating the sound. (McCarten, Col. 10, line 66 – Col. 11, line 5). (*See* Appendix I, Elements 21-23).

(56) Claim 8. Claim 8 is similar to Claim 1 (*see* above), except that it replaces the language “clock means for keeping a predetermined time period after said receiving means receives the transmission” with “clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing.” McCarten discloses clock means for

keeping a predetermined time period after said executing means starts execution of the program or data processing. (McCarten, Col. 10, line 66 – Col. 11, line 5). (*See* Appendix I, Elements 24-34).

(57) **Claim 12**. Claim 12 depends upon Claim 8. (*See* above). The analysis with respect to Claim 12 is the same as with respect to Claim 5. (*See* above; *see also* Appendix I, Elements 41-43.)

(58) **Claim 14**. Claim 14 depends upon Claim 8. (*See* above). The analysis with respect to Claim 14 is the same as with respect to Claim 7. (*See* above; *see also* Appendix I, Elements 44-46.)

SNQ J. Tsumura

Claims 1-2, 5, 7-8, 12, 14-15, 19, and 21 of the ‘520 patent are anticipated under 35 U.S.C. § 102(e) by Tsumura.¹⁸

A substantial new question is raised by Tsumura as to Claims 1-2, 5, 7-8, 12, 14-15, 19, and 21 of the ‘520 patent. Tsumura was neither cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, it is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendix J, important in determining whether or not the claims are patentable. In particular, as set forth herein, Tsumura contains within its four corners each and every limitation of Claims 1-2, 5, 7-8, 12, 14-15, 19, and 21, arranged or combined in the same way as in each claim. For this reason, Tsumura raises a substantial new question of patentability with respect to Claims 1-2, 5, 7-8, 12, 14-15, 19, and 21.

(59) **Claim 1**. As set forth in Claim 1, Tsumura discloses a communication system for transmitting at least one of the program, the data, and a combination of the program and data from a

¹⁸ On the basis that Claims 8 and 15 and their dependents are not entitled to a filing date earlier than July 2, 1998 (*see* priority discussion above), Tsumura is prior art under 35 U.S.C. § 102(b) for Claims 8, 12, 14-15, 19, and 21. Otherwise, it is prior art under § 102(e). Regardless of their priority date, Tsumura is prior art under at least 35 U.S.C. § 102(e) for the remaining claims (Claims 1, 5, and 7).

host facility to a communication terminal device. (Tsumura, Col. 4, lines 14-18; Col. 1, lines 9-10, 16-18; FIG. 1). Tsumura further discloses an input device for inputting instructions to execute the program or to process the data. (Tsumura, Col. 10, line 61 – Col. 11, line 4; Col. 8, lines 50-60; Col. 9, lines 24-31). Tsumura further discloses 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. (Tsumura, Col. 4, lines 40-52; Col. 7, lines 62-66; Col. 5, lines 54-56; Col. 8, lines 50-60; FIGS. 3, 5). Tsumura further discloses storage means for storing the program, the data, or a combination of the program and data received by said receiving means. (Tsumura, Col. 4, lines 40-52; Col. 5, line 54 – Col. 6, line 9; Col. 1, lines 10-12; Col. 6, lines 28-33; Col. 8, lines 50-60; Col. 9, lines 24-31; Col. 10, line 61 – Col. 11, line 4; FIG. 3). Tsumura further discloses 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. (Tsumura, Col. 4, lines 40-52; Col. 6, lines 9-21, 33-51; Col. 7, lines 1-14; Col. 8, lines 50-60; Col. 9, lines 39-42; Col. 10, line 61 – Col. 11, line 4; Col. 11, lines 60-62; Col. 14, lines 30-38; FIG. 3.). Tsumura further discloses, either implicitly or inherently, clock means for keeping a predetermined time period after said receiving means receives the transmission. (Tsumura, Col. 9, lines 56-65). Tsumura further discloses interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (Tsumura, Col. 9, lines 56-65). Tsumura further discloses a 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 (Tsumura, Col. 4, lines 18-26; FIG. 2), 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. (Tsumura, Col. 4, lines 18-23; Col. 5, lines 18-53; Col. 9, lines 3-10; FIG. 2.). (*See* Appendix J, Elements 1-11).

(60) **Claim 2.** Claim 2 depends upon Claim 1. (*See* above). As set forth in Claim 2, Tsumura discloses second clock means for keeping a second predetermined time period shorter than said predetermined time period counted by said clock means (Tsumura, Col. 9, lines 56-65). Tsumura further discloses alarm means for issuing an alarm when said second clock means counts said second predetermined time period, and thereby informing that interference by said interference means with execution of said executing means will soon be performed. (Tsumura, Col. 9, lines 56-65). (*See* Appendix J, Elements 12-15).

(61) **Claim 5.** Claim 5 depends upon Claim 1. (*See* above). As set forth in Claim 5, Tsumura discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (Tsumura, Col. 4, lines 40-52; Col. 8, line 50 – Col. 9, line 3; Col. 4, lines 40-52; Col. 6, lines 10-14; Col. 10, line 61 – Col. 11, line 4; FIG. 3.). Tsumura further discloses that said interference means comprises means for blocking the view of what is displayed on said screen. (Tsumura, Col. 9, lines 56-65). (*See* Appendix J, Elements 18-20).

(62) **Claim 7.** Claim 7 depends upon Claim 1. (*See* above). As set forth in Claim 7, Tsumura discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing. (Tsumura, Col. 4, lines 40-52; Col. 6, lines 10-14; FIG. 3). Tsumura further discloses that said interference means comprises means for preventing said sound generating means from generating the sound. (Tsumura, Col. 9, lines 56-65). (*See* Appendix J, Elements 21-23).

(63) **Claim 8.** Claim 8 is similar to Claim 1 (*see* above), except that it replaces the language “clock means for keeping a predetermined time period after said receiving means receives

the transmission” with “clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing.” Tsumura discloses clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing. (Tsumura, Col. 9, lines 56-65). (*See* Appendix J, Elements 24-34).

(64) **Claim 12.** Claim 12 depends upon Claim 8. (*See* above). The analysis with respect to Claim 12 is the same as with respect to Claim 5. (*See* above; *see also* Appendix J, Elements 41-43).

(65) **Claim 14.** Claim 14 depends upon Claim 8. (*See* above). The analysis with respect to Claim 14 is the same as with respect to Claim 7. (*See* above; *see also* Appendix J, Elements 44-46).

(66) **Claim 15.** Claim 15 is similar to Claim 1 (*see* above), except that it replaces the language “clock means for keeping a predetermined time period after said receiving means receives the transmission” with “clock means for keeping a predetermined time period after said execution means ends the execution of the program or data processing to count a time period during which at least one of the program, the data, and a combination of the program and data is continuously unused.” Tsumura discloses clock means for keeping a predetermined time period after said execution means ends the execution of the program or data processing to count a time period during which at least one of the program, the data, and a combination of the program and data is continuously unused. (Tsumura, Col. 9, lines 56-65). (*See* Appendix J, Elements 47-57).

(67) **Claim 19.** Claim 19 depends upon Claim 15. (*See* above). The analysis with respect to Claim 19 is the same as with respect to Claim 5. (*See* above; *see also* Appendix J, Elements 63-65).

(68) **Claim 21.** Claim 21 depends upon Claim 15. (*See above*). The analysis with respect to Claim 21 is the same as with respect to Claim 7. (*See above; see also Appendix J, Elements 66-68*).

C. Rejections Under 35 U.S.C. § 103(a)¹⁹

The following is a quotation of 35 U.S.C. § 103(a), which forms the basis of all obviousness rejections, as set forth in SNQs K through AAA, below:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Legal Standards for Obviousness

a) The “Obviousness” Analysis Under KSR

On April 30, 2007, the Supreme Court of the United States issued an opinion in the case of *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). The Court rejected a rigid application of the “teaching/suggestion/motivation” (or “TSM”) test and reaffirmed the use of a more expansive and flexible approach to the obviousness question. The Supreme Court stated:

We begin by rejecting the rigid approach of the Court of Appeals. Throughout this Court’s engagement with the question of obviousness, our cases have set forth an expansive and flexible approach inconsistent with the way the Court of Appeals applied its TSM test here. To be sure, *Graham* recognized the need for “uniformity and definiteness.” 383 U. S., at 18. Yet the principles laid down in *Graham* reaffirmed the “functional approach” of *Hotchkiss*, 11 How. 248. See 383 U. S., at 12. To this end, *Graham* set forth a broad inquiry and invited courts, where appropriate, to look at any secondary considerations that would prove instructive. *Id.*, at 17.

(*Id.*, 127 S. Ct. at 1739).

¹⁹ None of the proposed rejections set forth below was considered during prosecution of the ‘520 patent, nor in ADC’s ‘520 Reexam Request. For a discussion of how each individual reference was treated during the original examination of the ‘520 patent, see description of the references in Section V, above.

The Supreme Court's pronouncements and guidelines for the obviousness analysis are particularly instructive for the present Reexamination Request since, as shown herein, the claims (as apparently construed by the patentee) are anticipated by the prior art or a mere substitution or combination of prior art elements providing the same predictable use and function for which they are well-known by one of ordinary skill in the art. For instance, the Supreme Court stated:

Neither the enactment of §103 nor the analysis in *Graham* disturbed this Court's earlier instructions concerning the need for caution in granting a patent based on the combination of elements found in the prior art. For over a half century, the Court has held that a "patent for a combination which only unites old elements with no change in their respective functions . . . obviously withdraws what is already known into the field of its monopoly and diminishes the resources available to skillful men." *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147, 152 (1950). This is a principal reason for declining to allow patents for what is obvious. The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results. Three cases decided after *Graham* illustrate the application of this doctrine.

In *United States v. Adams*, 383 U. S. 39, 40 (1966), a companion case to *Graham*, the Court considered the obviousness of a "wet battery" that varied from prior designs in two ways: It contained water, rather than the acids conventionally employed in storage batteries; and its electrodes were magnesium and cuprous chloride, rather than zinc and silver chloride. **The Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.** 383 U. S., at 50-51. It nevertheless rejected the Government's Claim that Adams's battery was obvious. The Court relied upon the corollary principle that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious. *Id.*, at 51-52. When Adams designed his battery, the prior art warned that risks were involved in using the types of electrodes he employed. The fact that the elements worked together in an unexpected and fruitful manner supported the conclusion that Adams's design was not obvious to those skilled in the art.

In *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, the Court elaborated on this approach. The subject matter of the patent before the Court was a device combining two pre-existing elements: a radiant-heat burner and a paving machine. The device, the Court concluded, did not

create some new synergy: The radiant-heat burner functioned just as a burner was expected to function; and the paving machine did the same. The two in combination did no more than they would in separate, sequential operation. *Id.*, at 60-62. In those circumstances, “while the combination of old elements performed a useful function, it added nothing to the nature and quality of the radiant-heat burner already patented,” and the patent failed under §103. *Id.*, at 62 (footnote omitted).

Finally, in *Sakraida v. AG Pro, Inc.*, 425 U. S. 273 (1976), the Court derived from the precedents the conclusion that **when a patent “simply arranges old elements with each performing the same function it had been known to perform” and yields no more than one would expect from such an arrangement, the combination is obvious. *Id.*, at 282.**

The principles underlying these cases are instructive when the question is whether a patent claiming the combination of elements of prior art is obvious. When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. **For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida* and *Anderson’s-Black Rock* are illustrative—a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.**

(*Id.*, 127 S. Ct. at 1739-40, emphasis added).

b) PTO Examination Guidelines For Determining Obviousness

In view of KSR, the PTO amended its guidelines used to determine obviousness of claimed subject matter, providing several rationales on which a Claim of obviousness may be based:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” KSR, 550 U.S. at ___, 82 USPQ2d at 1396. Exemplary rationales that may support a conclusion of obviousness include:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. See MPEP § 2143 for a discussion of the rationales listed above along with examples illustrating how the cited rationales may be used to support a finding of obviousness. See also MPEP § 2144 - § 2144.09 for additional guidance regarding support for obviousness determinations.”

MPEP § 2141(III).

c) **Obviousness May Also Be Inferred From The Lack Of Disclosure Of Structure To Perform Recited Function**

The United States Court of Customs and Patent Appeals has held that an applicant’s failure to specifically describe any “equipment or techniques” for performing a claimed method could support an inference that the claimed method is not novel.

We agree with the solicitor's principal contentions that appellant's claims are directed to what is essentially a tape lending library operation wherein the library makes the copies as demand warrants and that **all of the equipment and technical knowledge required to perform the claimed method is admittedly old. The latter admission** is to be found in part in express statements in appellant's specification and in part **is deducible from the fact that it assumes anyone desiring to carry out the process would know of the**

equipment and techniques to be used, none being specifically described.

In re Fox, 471 F.2d 1405, 1407 (CCPA 1973). (Emphasis added). In *Fox*, therefore, the Court affirmed the examiner's rejection of applicant's method claims as obvious, where the applicant provided no description of a structure and techniques to perform the claimed methods. *See also Ex Parte Richard P. Mettke*, 2008 WL 4448201, *19 (Bd. Pat. App. & Interf.):

In order to render a claimed apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method. See [In re Payne](#), 606 F.2d 303, 314 (CCPA 1979). Appellant does not argue that the references were not enabling to one of ordinary skill in the art, i.e., that it was not within the level of ordinary skill in the art to add access to the Internet as taught by Exhibit C, 4 or access to online service providers as taught by Exhibit D. Indeed, **if Appellant argued that the references were not enabling, his own disclosure would have to be rejected as nonenabling because it provides no more detail than the references.** See [In re Epstein](#), 32 F.3d 1559, 1568 (Fed. Cir. 1994) ("Rather, the Board's observation that appellant did not provide the type of detail in his specification that he now argues is necessary in prior art references supports the Board's finding that one skilled in the art would have known how to implement the features of the references and would have concluded that the reference disclosures would have been enabling.")

(*Id.* at *19, emphasis added, additional citations omitted).

SNQ K. Bakoglu

Claims 1-2, 5, 7, 12, and 14 of the '520 patent are obvious under 35 U.S.C § 103(a) over Bakoglu.

A substantial new question is raised by Bakoglu as to Claims 1-2, 5, 7, 12, and 14 of the '520 patent. Bakoglu was neither cited by Applicant, nor cited or considered by Examiner during the original examination of the '520 patent. As such, it is so-called "new art." Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendix E, important in determining whether or not the claims are patentable. In particular, as set forth herein, Bakoglu recites or renders obvious each and every limitation and the

claimed invention as a whole of Claims 1-2, 5, 7, 12, and 14. For this reason, Bakoglu raises a substantial new question of patentability with respect to Claims 1-2, 5, 7, 12, and 14.

(69) **Claim 1.** As set forth in Claim 1, Bakoglu discloses 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. (Bakoglu, Abstract; Col. 1, lines 5-6, 9-37, 54-67; Col. 2, lines 8-33; Col. 2, line 47 – Col. 3, line 6; FIGS. 1-2). Bakoglu further discloses an input device for inputting instructions to execute the program or to process the data. (Bakoglu, Col. 1, lines 54-60; Col. 2, lines 8-18; Col. 2, lines 47-54; FIGS. 1-2). Bakoglu further discloses 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. (Bakoglu, Col. 1, lines 5-6, 28-37, 54-60; Col. 2, 8-33; Col. 2, line 47 – Col. 3, line 6; FIGS. 1-2). Bakoglu further discloses storage means for storing the program, the data, or a combination of the program and data received by said receiving means. (Bakoglu, Col. 2, lines 8-33; Col. 2, line 55 – Col. 3, line 6; FIGS. 1-2). Bakoglu further discloses 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. (Bakoglu, Col. 1, lines 54-60; Col. 2, lines 47-54; Col. 2, lines 8-18; Col. 2, line 55 – Col. 3, line 6; FIGS. 1-2). Bakoglu further discloses clock means for measuring a predetermined period of time of use of downloaded software. (Bakoglu, Abstract; Col. 1, lines 28-37, 54-60; Col. 2, lines 8-33; Col. 3, lines 1-15, 17-41; FIG. 3). Bakoglu further states that “[t]he use of expiration date or time for voiding the game is an obvious approach if the video game base unit 102 comes with a timer.” (Bakoglu, Col. 3, lines 17-19). Thus, setting this expiration date from the time software is received is either implicitly disclosed, or would be an obvious variation requiring no technological insight.

Bakoglu further discloses interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (Bakoglu, Abstract; Col. 1,

lines 28-37, 61-67; Col. 2, lines 8-33; Col. 3, lines 7-15, 17-41; FIG. 3). Bakoglu further discloses a 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 (Bakoglu, FIGS. 1-2), 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. (Bakoglu, Col. 1, lines 5-6, 28-37, 54-60; Col. 2, lines 8-18, 47-54; FIGS. 1-2). (*See* Appendix E, Elements 1-11).

(70) **Claim 2.** Claim 2 depends upon Claim 1. (*See* above). As set forth in Claim 2, Bakoglu discloses second clock means for keeping a second predetermined time period shorter than said predetermined time period counted by said clock means. (Bakoglu, Col. 4, lines 19-26). Bakoglu further discloses alarm means for issuing an alarm when said second clock means counts said second predetermined time period, and thereby informing that interference by said interference means with execution of said executing means will soon be performed. (*Id.*). (*See* Appendix E, Elements 12-15).

(71) **Claim 5.** Claim 5 depends upon Claim 1. (*See* above.) As set forth in Claim 5, Bakoglu discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (Bakoglu, Col. 1, lines 54-60; Col. 2, line 55 – Col. 3, line 6; FIGS. 1-2). Bakoglu further discloses that said interference means comprises means for blocking the view of what is displayed on said screen. (Bakoglu, Abstract, Claims 5-7; Col. 1, lines 28-37, 61-67; Col. 2 lines 8-33; Col. 3, lines 7-15, 17-41; FIG. 3). To the extent that the means for blocking a view of the screen is not deemed either expressly or inherently disclosed in Bakoglu, it would have been obvious in view of Bakoglu's

disclosure of display means for displaying a game, and its further disclosure rendering the game unusable. (*See* Appendix E, Elements 18-20).

(72) **Claim 7.** Claim 7 depends upon Claim 1. (*See* above). As set forth in Claim 7, Bakoglu discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing. (Bakoglu, Col. 1, lines 54-60; Col. 2, lines 55-61; FIGS. 1-2). Bakoglu further inherently discloses that said interference means comprises means for preventing said sound generating means from generating the sound. (Bakoglu, Abstract, Claims 5-7; Col. 1, lines 28-37, 61-67; Col. 2, lines 8-33; Col. 3, 7-15, 17-41; FIG. 3).

To the extent that the means for preventing said sound generating means from generating the sound is not deemed either expressly or inherently disclosed in Bakoglu, it would have been obvious in view of Bakoglu's disclosure of sound generating means associated with a game, and its further disclosure of rendering the game unusable. (*See* Appendix E, Elements 21-23).

(73) **Claim 12.** Claim 12 depends upon Claim 8, which is anticipated by Bakoglu. (*See* above). The analysis with respect to Claim 12 is the same as with respect to Claim 5. (*See* above; *see also* Appendix E, Elements 41-43).

(74) **Claim 14.** Claim 14 depends upon Claim 8, which is anticipated by Bakoglu. (*See* above). The analysis with respect to Claim 14 is the same as with respect to Claim 7. (*See* above; *see also* Appendix E, Elements 44-46).

SNQ L. Bakoglu in view of Cooper

Claims 1-2, 5, and 7 of the '520 patent are obvious under 35 U.S.C § 103(a) over Bakoglu in view of Cooper.

A substantial new question is raised by Bakoglu in view of Cooper as to Claims 1-2, 5, and 7 of the '520 patent. Neither reference was cited by Applicant, nor cited or considered by Examiner during the original examination of the '520 patent. As such, each is so-called "new art." Requester

submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendices E and K, important in determining whether or not the claims are patentable. In particular, as set forth herein, Bakoglu in view of Cooper teaches or suggests each and every limitation of Claims 1-2, 5, and 7. For this reason, Bakoglu in view of Cooper raises a substantial new question of patentability with respect to Claims 1-2, 5, and 7.

The motivation to combine Bakoglu with Cooper arises from the nature of the problem to be solved, and is contained in Bakoglu itself (see below): namely, both disclose closely related systems for controlling access to programs based on period of use. Replacing Bakoglu's system, which disables software after a predetermined number of frames, with the Cooper system, which disables a program after a fixed time period, would be an obvious substitution, particularly in view of Bakoglu's statement that such an approach would be an obvious variation. (Bakoglu, Col. 3, line 17-19).

(75) Claim 1. As set forth in Claim 1, Bakoglu discloses 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. (Bakoglu, Abstract; Col. 1, lines 5-6, 9-37, 54-67; Col. 2, lines 8-33; Col. 2, line 47 – Col. 3, line 6; FIGS. 1-2). Bakoglu further discloses an input device for inputting instructions to execute the program or to process the data. (Bakoglu, Col. 1, lines 54-60; Col. 2, lines 8-18; Col. 2, lines 47-54; FIGS. 1-2). Bakoglu further discloses 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. (Bakoglu, Col. 1, lines 5-6, 28-37, 54-60; Col. 2, lines 8-33; Col. 2, line 47 – Col. 3, line 6; FIGS. 1-2). Bakoglu further discloses storage means for storing the program, the data, or a combination of the program and data received by said receiving means. (Bakoglu, Col. 2, line 8-33; Col. 2, line 55 – Col. 3, line 6; FIGS. 1-2). Bakoglu further discloses 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. (Bakoglu, Col. 1, lines 54-60; Col. 2, lines 8-18; Col. 2, line 47 – Col. 3, line 6; FIGS. 1-2). Bakoglu further discloses clock means for measuring a predetermined period of time of use of downloaded software. (Bakoglu, Abstract; Col. 1, lines 28-37, 54-60; Col. 2, lines 8-33; Col. 3, lines 1-15, 17-41; FIG. 3). Bakoglu further states that “[t]he use of expiration date or time for voiding the game is an obvious approach if the video game base unit 102 comes with a timer.” (Bakoglu, Col. 3, lines 17-19). Thus, setting this expiration date from the time software is received is either implicitly disclosed, or would be an obvious variation requiring no technological insight.

Additionally, Cooper discloses keeping a predetermined time period from receipt (Cooper, Col. 8, lines 39-43; Col. 9, lines 27-38), and interfering with execution thereafter. (Cooper, Col. 9, lines 27-38).

Bakoglu further discloses interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (Bakoglu, Abstract; Col. 1, lines 28-37, 61-67; Col. 2, lines 8-33; Col. 3, lines 7-15, 17-41; FIG. 3). Bakoglu further discloses a 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 (Bakoglu, FIGS. 1-2), 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. (Bakoglu, Col. 1, lines 5-6, 28-37, 54-60; Col. 2, lines 8-18, 47-54; FIGS. 1-2). (See Appendices E and K, Elements 1-11).²⁰

²⁰ Throughout this request, obviousness combinations making reference to multiple appendices refer only to those elements of those appendices referred to in the SNQs. Appendices are not intended to suggest any SNQs beyond those set forth herein, and are not intended to suggest the absence or presence in the prior art of elements that are not specifically addressed in the SNQs.

(76) **Claim 2.** Claim 2 depends upon Claim 1. (*See above*). As set forth in Claim 2, Bakoglu discloses second clock means for keeping a second predetermined time period shorter than said predetermined time period counted by said clock means (Bakoglu, Col. 4, lines 19-26). Bakoglu further discloses alarm means for issuing an alarm when said second clock means counts said second predetermined time period, and thereby informing that interference by said interference means with execution of said executing means will soon be performed. (*Id.*). (*See* Appendices E and K, Elements 12-15).

(77) **Claim 5.** Claim 5 depends upon Claim 1. (*See above*). As set forth in Claim 5, Bakoglu discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (Bakoglu, Col. 1, lines 54-60; Col. 2, lines 55-61; Col. 2, line 62 – Col. 3, line 6; FIGS. 1-2). Bakoglu further discloses that said interference means comprises means for blocking the view of what is displayed on said screen. (Bakoglu, Abstract, Claims 5-7; Col. 1, lines 28-37, 61-67; Col. 2, lines 8-33; Col. 3, lines 7-15, 17-41; FIG. 3).

To the extent that the means for blocking a view of the screen is not deemed either expressly or inherently disclosed in Bakoglu, it would have been obvious in view of Bakoglu's disclosure of display means for displaying a game, and its further disclosure rendering the game unusable. (*See* Appendices E and K, Elements 18-20).

(78) **Claim 7.** Claim 7 depends upon Claim 1. (*See above.*) As set forth in Claim 7, Bakoglu discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing. (Bakoglu, Col. 1, lines 54-60; Col. 2, lines 55-61; FIGS. 1-2). Bakoglu further inherently discloses that said interference means comprises means for preventing said sound generating means from generating the sound. (Bakoglu, Abstract, Claims 5-7; Col. 1, lines 28-37, 61-67; Col. 2, lines 8-33; Col. 3, lines 7-15, 17-41; FIG. 3).

To the extent that the means for preventing said sound generating means from generating the sound is not deemed either expressly or inherently disclosed in Bakoglu, it would have been obvious in view of Bakoglu's disclosure of sound generating means associated with a game, and its further disclosure of rendering the game unusable. (*See* Appendices E and K, Elements 21-23).

SNQ M. Bakoglu in view of Sanyo

Claims 4 and 11 of the '520 patent are obvious under 35 U.S.C § 103(a) over Bakoglu in view of Sanyo.

A substantial new question is raised by Bakoglu in view of Sanyo as to Claims 4 and 11 of the '520 patent. Neither reference was cited by Applicant, nor cited or considered by Examiner during the original examination of the '520 patent. As such, each is so-called "new art." Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendices E and L, important in determining whether or not the claims are patentable. In particular, as set forth herein, Bakoglu in view of Sanyo teaches or suggests each and every limitation of Claims 4 and 11. For this reason, Bakoglu in view of Sanyo raises a substantial new question of patentability with respect to Claims 4 and 11.

The motivation to combine Bakoglu with Sanyo arises from the nature of the problem to be solved: namely, both disclose closely related systems for controlling access to programs based on time of use. Replacing Bakoglu's system, which disables software after a predetermined time period lapses, with the Sanyo system, which deletes the program, would have been a simple substitution, yielding a predictable result, without undue experimentation.

(79) Claim 4. Claim 4 depends upon Claim 1, which is anticipated by or obvious over Bakoglu. (*See* above). As set forth in Claim 4, Bakoglu discloses interference means disabling a program (Bakoglu, Abstract; Col. 1, lines 28-37, 61-67; Col. 2, lines 8-33; Col. 3, lines 7-15, 17-41; FIG. 3), of which deletion would be an obvious variation.

Additionally, Sanyo discloses interference by deletion. (Sanyo, Pgs. 2-3, 9). (*See* Appendices E and L, Elements 16-17).

(80) **Claim 11**. Claim 11 depends upon Claim 8, which is anticipated by Bakoglu. (*See* above). The analysis with respect to Claim 11 is the same as with respect to Claim 4. (*See* above; *see also* Appendices E and L, Elements 39-40).

SNQ N. Bakoglu in view of Tsumura

Claims 15-16, 19, and 21 of the ‘520 patent are obvious under 35 U.S.C § 103(a) over Bakoglu in view of Tsumura.

A substantial new question is raised by Bakoglu in view of Tsumura as to Claims 15-16, 19, and 21 of the ‘520 patent. Neither reference was cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, each is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendices E and J, important in determining whether or not the claims are patentable. In particular, as set forth herein, Bakoglu in view of Tsumura teaches or suggests each and every limitation of Claims 15-16, 19, and 21. For this reason, Bakoglu in view of Tsumura raises a substantial new question of patentability with respect to Claims 15-16, 19, and 21.

It would have been obvious to combine Bakoglu with Tsumura, as it involves a simple substitution: namely, replacing a system that measures time from the *start* of execution of downloaded content, with one that measures time from the *end* of execution, which can be accomplished without undue experimentation, yielding predictable results.

(81) **Claim 15**. Claim 15 is similar to Claim 1, which is anticipated by or obvious over Bakoglu (*see* above), except that it replaces the language “clock means for keeping a predetermined time period after said receiving means receives the transmission” with “clock means for keeping a predetermined time period after said execution means ends the execution of the program or data

processing to count a time period during which at least one of the program, the data, and a combination of the program and data is continuously unused.” Bakoglu discloses clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing. (Bakoglu, Abstract; Col. 1, lines 28-37, 54-60; Col. 2, lines 8-33; Col. 3, lines 1-15, 17-41; FIG. 3).

Tsumura, on the other hand, discloses means for keeping a predetermined time period after said execution means *ends* the execution of the program or data processing to count a time period during which at least one of the program, the data, and a combination of the program and data is continuously unused. (Tsumura, Col. 9, lines 56-65). (*See* Appendices E and J, Elements 47-57).

(82) **Claim 16.** Claim 16 depends upon Claim 15. (*See* above). As set forth in Claim 16, Bakoglu discloses second clock means for keeping a second predetermined time period shorter than said predetermined time period counted by said clock means. (Bakoglu, Col. 4, lines 19-26). Bakoglu further discloses alarm means for issuing an alarm when said second clock means counts said second predetermined time period, and thereby informing that interference by said interference means with execution of said executing means will soon be performed. (*Id.*). (*See* Appendices E and J, Elements 58-60).

(83) **Claim 19.** Claim 19 depends upon Claim 15. (*See* above). As set forth in Claim 19, Bakoglu discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (Bakoglu, Col. 1, lines 54-60; Col. 2, line 55 – Col. 3, line 6; FIGS. 1-2). Bakoglu further discloses that said interference means comprises means for blocking the view of what is displayed on said screen. (Bakoglu, Abstract, Claims 5-7; Col. 1, lines 28-37, 61-67; Col. 2, lines 8-33; Col. 3, lines 7-15, 17-41; FIG. 3).

To the extent that the means for blocking a view of the screen is not deemed either expressly or inherently disclosed in Bakoglu, it would have been obvious in view of Bakoglu's disclosure of display means for displaying a game, and its further disclosure rendering the game unusable.

Additionally, Tsumura discloses a display for game play (Tsumura, Col. 4, lines 40-52; Col. 8, line 50 – Col. 9, line 3; Col. 4, lines 40-52; Col. 6, lines 10-14; Col. 10, line 61 – Col. 11, line 4; FIG. 3), and interfering with said display at the termination of a game. (*Id.*, Col. 9, lines 56-65). (See Appendices E and J, Elements 63-65).

(84) Claim 21. Claim 21 depends upon Claim 15. (*See* above). As set forth in Claim 21, Bakoglu discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing. (Bakoglu, Col. 1, lines 54-60; Col. 2, lines 55-61; FIGS. 1-2). Bakoglu further inherently discloses that said interference means comprises means for preventing said sound generating means from generating the sound. (Bakoglu, Abstract, Claims 5-7; Col. 1, lines 28-37, 61-67; Col. 2, lines 8-33; Col. 3, lines 7-15, 17-41; FIG. 3).

To the extent that the means for preventing said sound generating means from generating the sound is not deemed either expressly or inherently disclosed in Bakoglu, it would have been obvious in view of Bakoglu's disclosure of sound generating means associated with a game, and its further disclosure of rendering the game unusable.

Additionally, Tsumura discloses sound generating means for game play (Tsumura, Col. 4, lines 40-52; Col. 6, lines 10-14; FIG. 3.), and interfering with said display at the termination of a game. (*Id.*, Col. 9, lines 56-65). (See Appendices E and J, Elements 66-68).

SNQ O. Bakoglu in view of Tsumura, in further view of Sanyo

Claim 18 of the '520 patent is obvious under 35 U.S.C § 103(a) over Bakoglu in view of Tsumura, in further view of Sanyo.

A substantial new question is raised by Bakoglu in view of Tsumura, in further view of Sanyo as to Claim 18 of the '520 patent. None of these references was cited by Applicant, nor cited or considered by Examiner during the original examination of the '520 patent. As such, each is so-called "new art." Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendices E, J, and L, important in determining whether or not the claims are patentable. In particular, as set forth herein, Bakoglu in view of Tsumura, in further view of Sanyo teaches or suggests each and every limitation of Claim 18. For this reason, Bakoglu in view of Tsumura, in further view of Sanyo raises a substantial new question of patentability with respect to Claim 18.

It would have been obvious to combine Bakoglu with both Tsumura and Sanyo, for the reasons set forth above.

(85) Claim 18. Claim 18 depends upon Claim 15, which is obvious over Bakoglu in view of Tsumura. (*See above*). As set forth in Claim 18, Bakoglu discloses interference means disabling a program (Bakoglu, Abstract; Col. 1, lines 28-37, 61-67; Col. 2, lines 8-33; Col. 3, lines 7-15, 17-41; FIG. 3), of which deletion would be an obvious variation. Additionally, Sanyo discloses interference by deletion. (Sanyo, Pgs. 2-3, 9). (*See above; see also* Appendices E, J, and L, Elements 61-62).

SNQ P. Chernow

Claims 5, 7-8, 12, and 14 of the '520 patent are obvious under 35 U.S.C § 103(a) over Chernow.

A substantial new question is raised by Chernow as to Claims 5, 7-8, 12, and 14 of the '520 patent. Chernow was neither cited by Applicant, nor cited or considered by Examiner during the original examination of the '520 patent. As such, it is so-called "new art." Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts

that follow in Appendix A, important in determining whether or not the claims are patentable. In particular, as set forth herein, Chernow recites or renders obvious each and every limitation and the claimed invention as a whole of Claims 5, 7-8, 12, and 14. For this reason, Chernow raises a substantial new question of patentability with respect to Claims 5, 7-8, 12, and 14.

(86) Claim 5. Claim 5 depends upon Claim 1, which is anticipated by Chernow. (*See* above). As set forth in Claim 5, Chernow discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (Chernow, Col. 8, lines 52-57).

To the extent that it is not deemed to be explicitly or inherently disclosed, it would have been obvious that, as part of Chernow's rendering the software unusable, its interference means could include means for blocking the view of what is displayed on said screen. (Chernow, Col. 4, line 68 – Col. 5, line 2; Col. 5, line 10-18; Col. 4, line 23-36). (*See* Appendix A, Elements 18-20).

(87) Claim 7. Claim 7 depends upon Claim 1, which is anticipated by Chernow. (*See* above.) As set forth in Claim 7, by disclosing a computer and monitor, even if Chernow is deemed to not implicitly or inherently discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing, it would have been obvious to include sound generating means, as they were well known in the art at the time of the invention. (Chernow, Col. 8, lines 52-57).

To the extent that it is not deemed to be explicitly or inherently disclosed, it would have been obvious that, as part of Chernow's rendering the software unusable, its interference means could include that said interference means comprises means for preventing said sound generating means from generating the sound. (Chernow, Col. 4, line 68 – Col. 5, line 2; Col. 5, lines 10-18; Col. 4, lines 23-36). (*See* Appendix A, Elements 21-23).

(88) **Claim 8.** Claim 8 is similar to Claim 1, which is anticipated by Chernow (*see above*), except that it replaces the language “clock means for keeping a predetermined time period after said receiving means receives the transmission” with “clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing.”

To the extent that Chernow is deemed to not explicitly or inherently disclose clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing, it would have been obvious in view of Chernow’s disclosure of a lease based on being “used for only a predetermined period of time.” (Chernow, Col. 5, lines 10-18; Col. 4, lines 23-36; Claim 8, Col. 14, lines 33-36). (*See Appendix A, Elements 24-34*).

(89) **Claim 12.** Claim 12 depends upon Claim 8. (*See above*). The analysis with respect to Claim 12 is the same as with respect to Claim 5. (*See above; see also Appendix A, Elements 41-43*).

(90) **Claim 14.** Claim 14 depends upon Claim 8. (*See above*). The analysis with respect to Claim 14 is the same as with respect to Claim 7. (*See above; see also Appendix A, Elements 44-46*).

SNQ Q. Chernow in view of Suzuki

Claims 2, 8-9, 11-12, and 14 of the ‘520 patent are obvious under 35 U.S.C § 103(a) over Chernow in view of Suzuki.

A substantial new question is raised by Chernow in view of Suzuki as to Claims 2, 8-9, 11-12, and 14 of the ‘520 patent. Neither reference was cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, each is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendices A and M, important in determining whether or not the claims are patentable. In particular, as set forth herein, Chernow in view of Suzuki teaches

or suggests each and every limitation of Claims 2, 8-9, 11-12, and 14. For this reason, Chernow in view of Suzuki raises a substantial new question of patentability with respect to Claims 2, 8-9, 11-12, and 14.

The motivation to combine Chernow with Suzuki arises from the nature of the problem to be solved: namely, both disclose closely related systems for distributing and controlling access to and usage of fee-based software. Thus, one of ordinary skill in the art would have naturally looked to Suzuki's system for administering software to improve upon the fee-based system disclosed in Chernow, yielding a predictable result, without undue experimentation.

(91) Claim 2. Claim 2 depends upon Claim 1, which is anticipated by Chernow. (*See* above). As set forth in Claim 2, Suzuki discloses second clock means for keeping a second predetermined time period shorter than said predetermined time period counted by said clock means (Suzuki, Pgs. 3, 5). Suzuki further discloses alarm means for issuing an alarm when said second clock means counts said second predetermined time period, and thereby informing that interference by said interference means with execution of said executing means will soon be performed. (Suzuki, Pgs. 2-3, 5). (*See* Appendices A and M, Elements 12-15).

(92) Claim 8. Claim 8 is similar to Claim 1, which is anticipated by Chernow (*see* above), except that it replaces the language "clock means for keeping a predetermined time period after said receiving means receives the transmission" with "clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing."

To the extent that Chernow is deemed to not explicitly or inherently discloses clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing, it would have been obvious in view of Chernow's disclosure of a lease based on being "used for only a predetermined period of time." (Chernow, Col. 5, lines 10-18; Col. 4, lines 23-36; Claim 8, Col. 14, lines 33-36).

Additionally, Suzuki discloses means for keeping a predetermined time period after said executing means starts execution of the program or data processing. (Suzuki, Pgs. 2-4). (*See* Appendices A and M, Elements 24-34).

(93) **Claim 9.** Claim 9 depends upon Claim 8. (*See* above). The analysis with respect to Claim 9 is the same as with respect to Claim 2. (*See* above; *see also* Appendices A and M, Elements 35-38).

(94) **Claim 11.** Claim 11 depends upon Claim 8. (*See* above). As set forth in Claim 11, Chernow further discloses that said interference means comprises means for deleting at least one of the program, the data, and a combination of the program and data stored in said storage means. (Chernow, Col. 2, lines 3-5; Col. 4, line 68 – Col. 5, line 2; Col. 5, lines 10-18; Col. 4, lines 23-36). (*See* Appendices A and M, Elements 39-40).

(95) **Claim 12.** Claim 12 depends upon Claim 8. (*See* above). As set forth in Claim 12, Chernow discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (Chernow, Col. 8, lines 52-57). Chernow further discloses, either explicitly or inherently, that said interference means comprises means for blocking the view of what is displayed on said screen. (Chernow, Col. 4, line 68 – Col. 5, line 2; Col. 5, lines 10-18; Col. 4, lines 23-36). (*See* Appendices A and M, Elements 41-43).

(96) **Claim 14.** Claim 14 depends upon Claim 8. (*See* above). As set forth in Claim 14, by disclosing a computer and monitor, Chernow implicitly or inherently discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing. (Chernow, Col. 8, lines 52-57). Chernow further discloses, either explicitly or inherently, that said interference means comprises means for preventing said sound

generating means from generating the sound. (Chernow, Col. 4, line 68 – Col. 5, line 2; Col. 5, lines 10-18; Col. 4, lines 23-36). (*See* Appendices A and M, Elements 44-46).

SNQ R. Garfinkle

Claims 7-8, 11-12, and 14 of the ‘520 patent are obvious under 35 U.S.C § 103(a) over Garfinkle.

A substantial new question is raised by Garfinkle as to claims 7-8, 11-12, and 14 of the ‘520 patent. Garfinkle was neither cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, it is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendix F, important in determining whether or not the claims are patentable. In particular, as set forth herein, Garfinkle recites or renders obvious each and every limitation and the claimed invention as a whole of Claims 7-8, 11-12, and 14. For this reason, Garfinkle raises a substantial new question of patentability with respect to claims 7-8, 11-12, and 14.

(97) **Claim 7.** Claim 7 depends upon Claim 1, which is anticipated by Garfinkle. (*See* above). As set forth in Claim 7, Garfinkle inherently discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing. (Garfinkle, Col. 3, lines 12-16). Garfinkle further discloses that said interference means comprises means for preventing said sound generating means from generating the sound. (Garfinkle, Abstract; Col. 2, lines 18-36; Col. 3, lines 22-26; Col. 4, lines 30-48; Claims 1-2). Alternatively, such an approach would be obvious in light of Garfinkle’s disclosure of sound generating means and limiting (e.g., “scrambling”) access to the stored data. (*See* Appendix F, Elements 21-23).

(98) **Claim 8.** Claim 8 is similar to Claim 1, which is anticipated by Garfinkle (*see* above), except that it replaces the language “clock means for keeping a predetermined time period

after said receiving means receives the transmission” with “clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing.”

Garfinkle further discloses clock means for keeping a predetermined time period after said receiving means receives the transmission, as well as means for basing use of the rented data on the number of uses. (Garfinkle, Col. 2, lines 18-36; Col. 3, line 27 – Col. 4, line 48).

In view of this, Garfinkle inherently discloses clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing. Alternatively, such an approach would be an obvious alternative, requiring no particular technological insight to implement. (*See* Appendix F, Elements 24-34).

(99) **Claim 11**. Claim 11 depends upon Claim 8. (*See* above). As set forth in Claim 11, Garfinkle further discloses that said interference means comprises means for deleting at least one of the program, the data, and a combination of the program and data stored in said storage means. (Garfinkle, Col. 2, lines 18-36; Col. 3, lines 22-26, 43-50; Col. 4, lines 25-48; FIG. 3; Claim 3). (*See* Appendix F, Elements 39-40).

(100) **Claim 12**. Claim 12 depends upon Claim 8. (*See* above). As set forth in Claim 12, Garfinkle discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (Garfinkle, Col. 3, lines 12-21; FIGS. 1-2; Claims 1-3). Garfinkle further discloses that said interference means comprises means for blocking the view of what is displayed on said screen.

Alternatively, such an approach would be obvious in light of Garfinkle’s disclosure of display means and limiting (e.g., “scrambling”) access to the stored data. (Garfinkle, Abstract; Col. 2, lines 18-36, 46-50; Col. 3, lines 22-26; Col. 3, line 43 – Col. 4, line 48; FIG. 3; Claims 1-3). (*See* Appendix F, Elements 41-43.)

(101) **Claim 14**. Claim 14 depends upon Claim 8. (*See* above). The analysis with respect to Claim 14 is the same as with respect to Claim 7. (*See* Appendix F, Elements 44-46.)

SNQ S. Garfinkle in view of Suzuki

Claims 2, 8-9, and 11-12 of the ‘520 patent are obvious under 35 U.S.C § 103(a) over Garfinkle in view of Suzuki.

A substantial new question is raised by Garfinkle in view of Suzuki as to Claims 2, 8-9, and 11-12 of the ‘520 patent. Neither reference was cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, each is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendices F and M, important in determining whether or not the claims are patentable. In particular, as set forth herein, Garfinkle in view of Suzuki teaches or suggests each and every limitation of Claims 2, 8-9, and 11-12. For this reason, Garfinkle in view of Suzuki raises a substantial new question of patentability with respect to Claims 2, 8-9, and 11-12.

The motivation to combine Garfinkle with Suzuki arises from the nature of the problem to be solved: namely, both disclose closely related systems for distributing and controlling access to and usage of fee-based software. Thus, one of ordinary skill in the art would have naturally looked to Suzuki’s system for administering software to improve upon the fee-based system disclosed in Garfinkle, yielding a predictable result, without undue experimentation.

(102) **Claim 2**. Claim 2 depends upon Claim 1, which is anticipated by Garfinkle. (*See* above.) As set forth in Claim 2, Suzuki discloses second clock means for keeping a second predetermined time period shorter than said predetermined time period counted by said clock means (Suzuki, Pgs. 3, 5). Suzuki further discloses alarm means for issuing an alarm when said second clock means counts said second predetermined time period, and thereby informing that interference

by said interference means with execution of said executing means will soon be performed. (Suzuki, Pgs. 2-3, 5). (*See* Appendices F and M, Elements 12-15).

(103) **Claim 8.** Claim 8 is similar to Claim 1, which is anticipated by Garfinkle (*see* above), except that it replaces the language “clock means for keeping a predetermined time period after said receiving means receives the transmission” with “clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing.” Garfinkle further discloses clock means for keeping a predetermined time period after said receiving means receives the transmission, as well as means for basing use of the rented data on the number of uses. (Garfinkle, Col. 2, lines 18-36; Col. 3, line 27 – Col. 4, line 48).

In view of this, Garfinkle inherently discloses clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing. Alternatively, such an approach would be an obvious alternative, requiring no particular technological insight to implement.

Additionally, Suzuki discloses means for keeping a predetermined time period after said executing means starts execution of the program or data processing. (Suzuki, Pgs. 2-4). (*See* Appendices F and M, Elements 24-34).

(104) **Claim 9.** Claim 9 depends upon Claim 8. (*See* above). The analysis with respect to Claim 9 is the same as with respect to Claim 2. (*See* above; *see also* Appendices F and M, Elements 35-38).

(105) **Claim 11.** Claim 11 depends upon Claim 8. (*See* above). As set forth in Claim 11, Garfinkle further discloses that said interference means comprises means for deleting at least one of the program, the data, and a combination of the program and data stored in said storage means. (Garfinkle, Col. 2, lines 18-36; Col. 3, lines 22-26, 43-50; Col. 4, lines 25-48; FIG. 3; Claim 3). (*See* Appendices F and M, Elements 39-40).

(106) **Claim 12.** Claim 12 depends upon Claim 8. (*See above*). As set forth in Claim 12, Garfinkle discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (Garfinkle, Col. 3, lines 12-21; FIGS. 1-2; Claims 1-3).

Garfinkle further discloses that said interference means comprises means for blocking the view of what is displayed on said screen. Alternatively, such an approach would be obvious in light of Garfinkle's disclosure of display means and limiting (e.g., "scrambling") access to the stored data. (Garfinkle, Abstract; Col. 2, lines 18-36, 46-50; Col. 3, lines 22-26; Col. 3, line 43 – Col. 4, line 48; FIG. 3; Claims 1-3). (*See Appendices F and M, Elements 41-43*).

SNQ T. Griswold

Claims 1-2, 5, and 7 of the '520 patent are obvious under 35 U.S.C § 103(a) over Griswold.

A substantial new question is raised by Griswold as to Claims 1-2, 5, and 7 of the '520 patent. Griswold was neither cited by Applicant, nor cited or considered by Examiner during the original examination of the '520 patent. As such, it is so-called "new art." Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendix N, important in determining whether or not the claims are patentable. In particular, as set forth herein, Griswold recites or renders obvious each and every limitation and the claimed invention as a whole of Claims 1, 2, 5, and 7. For this reason, Griswold raises a substantial new question of patentability with respect to Claims 1, 2, 5, and 7.

(107) **Claim 1.** As set forth in Claim 1, Griswold discloses 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. (Griswold, Abstract, Col. 1, lines 16-32, 52-67; Col. 2, lines 1-10; Col. 4, lines 6-18; Col. 5, lines 34-38; 44-67; Col. 7, lines 3-26; Col. 11, lines 33-

39; Col. 11, line 47 – Col. 12, line 4). Griswold further discloses an input device for inputting instructions to execute the program or to process the data. (Griswold, Col. 4, lines 6-18). Griswold further discloses 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. (Griswold, Col. 4, lines 6-18; Col. 11, lines 47-54; FIG. 1). Griswold further discloses storage means for storing the program, the data, or a combination of the program and data received by said receiving means. (Griswold, Col. 4, lines 6-18; Col. 11, lines 47-54; FIG. 1). Griswold further discloses 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. (Griswold, Col. 4, lines 6-18).

Griswold further discloses clock means for keeping a predetermined time period after said receiving means receives the transmission. (Griswold, Col. 7, lines 3-26). While Griswold discloses these means as resident on the host computer, putting them at the communications terminal would have been an obvious variation requiring no technological insight.

Griswold further discloses interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (Griswold, Abstract; Col. 1, lines 23-32; Col. 2, lines 1-26; Col. 2, line 37 – Col. 3, line 7; Col. 3, lines 35-41; Col. 3, line 62 – Col. 4, line 5; Col. 4, lines 19-28; Col. 5, lines 39-67; Col. 6, lines 8-35, 56-65; Col. 7, lines 3-26; Col. 7, lines 34-64; Col. 8, lines 40-67; Col. 9, lines 1-14; Col. 9, line 31 – Col. 10, line 9; Col. 10, line 30 – Col. 11, line 20; Col. 11, line 47 – Col. 12, line 19; Col. 13, lines 1-28; Col. 14, lines 15-35; FIGS. 1-2, 3, 6). Griswold further discloses a 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 (Griswold, Col. 11, lines 47-54; Col. 3, line 62 – Col. 4, line 2; Col. 4, lines 55-57; FIGS. 1, 2), 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. (Griswold, Col. 11, line 47-54). (See Appendix N, Elements 1-11).

(108) Claim 2. Claim 2 depends upon Claim 1. (See above). As set forth in Claim 2, Griswold discloses second clock means for keeping a second predetermined time period shorter than said predetermined time period counted by said clock means (Griswold, Col. 7, lines 3-26; Col. 8, lines 40-67). Griswold further discloses alarm means for issuing an alarm when said second clock means counts said second predetermined time period, and thereby informing that interference by said interference means with execution of said executing means will soon be performed. (Griswold, Col. 1, lines 16-22; Col. 6, lines 56-65; Col. 7, lines 3-26; Col. 8, lines 25-29, 40-67; Col. 9, lines 1-14, 31-41; Col. 10, line 30 – Col. 11, line 20; Col. 12, lines 5-19). (See Appendix N, Elements 12-15).

(109) Claim 5. Claim 5 depends upon Claim 1. (See above). As set forth in Claim 5, Griswold discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (Griswold, Col. 4, lines 6-18). Griswold further discloses that said interference means comprises means for blocking the view of what is displayed on said screen. (Griswold, Abstract; Col. 1, lines 23-32; Col. 2, lines 1-26; Col. 2, line 37 – Col. 3, line 7; Col. 3, lines 35-41; Col. 3, line 62 – Col. 4, line 5; Col. 4, lines 19-28; Col. 5, lines 39-67; Col. 6, lines 8-35, 56-65; Col. 7, lines 3-26, 34-64; Col. 8, lines 40-67; Col. 9, lines 1-14; Col. 9, line 31 – Col. 10, line 9; Col. 10, line 30 – Col. 11, line 20; Col. 11, line 47 – Col. 12, line 19; Col. 13, lines 1-28; Col. 14, lines 15-35; FIGS. 1-3, 6). (See Appendix N, Elements 18-20).

(110) Claim 7. Claim 7 depends upon Claim 1. (See above). As set forth in Claim 7, Griswold discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing. (Griswold, Col. 4, lines 16-18).

Therefore, Griswold's disclosure of interference with the licensed program at the termination of the licensed period (*see* Griswold, Abstract; Col. 1, lines 23-32; Col. 2, lines 1-26; Col. 2, line 37 – Col. 3, line 7; Col. 3, lines 35-41; Col. 3, line 62 – Col. 4, line 5; Col. 4, lines 19-28; Col. 5, lines 39-67; Col. 6, lines 8-35, 56-65; Col. 7, lines 3-26, 34-64; Col. 8, lines 40-67; Col. 9, lines 1-14; Col. 9, line 31 – Col. 10, line 9; Col. 10, line 30 – Col. 11, line 20; Col. 11, line 47 – Col. 12, line 19; Col. 13, lines 1-28; Col. 14, lines 15-35; FIGS. 1-3, 6), discloses or suggests, either inherently, or implicitly, preventing sound generation means from generating sound. (*See* Appendix N, Elements 21-23).

SNQ U. Griswold in view of Suzuki

Claims 1-2, 5, 7-9, and 12 of the '520 patent are obvious under 35 U.S.C § 103(a) over Griswold in view of Suzuki.

A substantial new question is raised by Griswold in view of Suzuki as to Claims 1-2, 5, 7-9, and 12 of the '520 patent. Neither reference was cited by Applicant, nor cited or considered by Examiner during the original examination of the '520 patent. As such, each is so-called "new art." Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendices N and M, important in determining whether or not the claims are patentable. In particular, as set forth herein, Griswold in view of Suzuki teaches or suggests each and every limitation of Claims 1-2, 5, 7-9, and 12. For this reason, Griswold in view of Suzuki raises a substantial new question of patentability with respect to Claims 1-2, 5, 7-9, and 12.

The motivation to combine Griswold with Suzuki arises from the nature of the problem to be solved: namely, both disclose closely related systems for distributing and controlling access to and usage of fee-based software. Thus, one of ordinary skill in the art would have naturally looked to

Suzuki's system for administering software to improve upon the fee-based system disclosed in Griswold, yielding a predictable result, without undue experimentation.

(111) **Claim 1.** As set forth in Claim 1, Griswold discloses 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. (Griswold, Abstract, Col. 1, lines 16-32, 52-67; Col. 2, lines 1-10; Col. 4, lines 6-18; Col. 5, lines 34-38, 44-67; Col. 7, lines 3-26; Col. 11, lines 33-39; Col. 11, line 47 – Col. 12, line 4). Griswold further discloses an input device for inputting instructions to execute the program or to process the data. (Griswold, Col. 4, lines 6-18). Griswold further discloses 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. (Griswold, Col. 4, lines 6-18; Col. 11, lines 47-54; FIG. 1). Griswold further discloses storage means for storing the program, the data, or a combination of the program and data received by said receiving means. (Griswold, Col. 4, lines 6-18; Col. 11, lines 47-54; FIG. 1). Griswold further discloses 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. (Griswold, Col. 4, lines 6-18).

Griswold further discloses clock means for keeping a predetermined time period after said receiving means receives the transmission. (Griswold, Col. 7, lines 3-26). While Griswold discloses these means as resident on the host computer, putting them at the communications terminal would have been an obvious variation requiring no technological insight.

Additionally, Suzuki discloses clock means for keeping a predetermined time period after said receiving means receives the transmission (Suzuki, Pgs. 2-4) and interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (*Id.*).

Griswold further discloses interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (Griswold, Abstract; Col. 1, lines 23-32; Col. 2, lines 1-26; Col. 2, line 37 – Col. 3, line 7; Col. 3, lines 35-41; Col. 3, line 62 – Col. 4, line 5; Col. 4, lines 19-28; Col. 5, lines 39-67; Col. 6, lines 8-35, 56-65; Col. 7, lines 3-26, 34-64; Col. 8, lines 40-67; Col. 9, lines 1-14; Col. 9, line 31 – Col. 10, line 9; Col. 10, line 30 – Col. 11, line 20; Col. 11, line 47 – Col. 12, line 19; Col. 13, lines 1-28; Col. 14, lines 15-35; FIGS. 1-2, 3, 6). Griswold further discloses a 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 (Griswold, Col. 11, lines 47-54; Col. 3, line 62 – Col. 4, line 2; Col. 4, lines 55-57; FIGS. 1, 2), 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. (Griswold, Col. 11, lines 47-54). (*See* Appendices N and M, Elements 1-11).

(112) Claim 2. Claim 2 depends upon Claim 1. (*See* above). As set forth in Claim 2, Griswold discloses second clock means for keeping a second predetermined time period shorter than said predetermined time period counted by said clock means (Griswold, Col. 7, lines 3-26; Col. 8, lines 40-67). Griswold further discloses alarm means for issuing an alarm when said second clock means counts said second predetermined time period, and thereby informing that interference by said interference means with execution of said executing means will soon be performed. (Griswold, Col. 1, lines 16-22; Col. 6, lines 56-65; Col. 7, lines 3-26; Col. 8, lines 25-29, 40-67; Col. 9, lines 1-14, 31-41; Col. 10, line 30 – Col. 11, line 20; Col. 12, line 5-19).

Alternatively, to the extent it is deemed not fully disclosed in Griswold, Suzuki discloses second clock means for keeping a second predetermined time period shorter than said predetermined time period counted by said clock means (Suzuki, Pgs. 3, 5). Suzuki further discloses alarm means

for issuing an alarm when said second clock means counts said second predetermined time period, and thereby informing that interference by said interference means with execution of said executing means will soon be performed. (Suzuki, Pgs. 2-3, 5). (*See* Appendices N and M, Elements 12-15).

(113) Claim 5. Claim 5 depends upon Claim 1. (*See* above). As set forth in Claim 5, Griswold discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (Griswold, Col. 4, lines 6-18). Griswold further discloses that said interference means comprises means for blocking the view of what is displayed on said screen. (Griswold, Abstract; Col. 1, lines 23-32; Col. 2, lines 1-26; Col. 2, line 37 – Col. 3, line 7; Col. 3, lines 35-41; Col. 3, line 62 – Col. 4, line 5; Col. 4, lines 19-28; Col. 5, line 39–67; Col. 6, lines 8-35, 56-65; Col. 7, lines 3-26, 34-64; Col. 8, lines 40-67; Col. 9, lines 1-14; Col. 9, line 31 – Col. 10, line 9; Col. 10, lines 30 – Col. 11, line 20; Col. 11, line 47 – Col. 12, line 19; Col. 13, lines 1-28; Col. 14, lines 15-35; FIGS. 1-3, 6). (*See* Appendices N and M, Elements 18-20).

(114) Claim 7. Claim 7 depends upon Claim 1. (*See* above). As set forth in Claim 7, Griswold discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing. (Griswold, Col. 4, lines 16-18).

Therefore, Griswold's disclosure of interference with the licensed program at the termination of the licensed period (*see* Griswold, Abstract; Col. 1, lines 23-32; Col. 2, lines 1-26; Col. 2, line 37 – Col. 3, line 7; Col. 3, lines 35-41; Col. 3, line 62 – Col. 4, line 5; Col. 4, lines 19-28; Col. 5, lines 39–67; Col. 6, lines 8-35, 56-65; Col. 7, lines 3-26; Col. 7, lines 34-64; Col. 8, lines 40-67; Col. 9, lines 1-14; Col. 9, line 31 – Col. 10, line 9; Col. 10, line 30 – Col. 11, line 20; Col. 11, line 47 – Col. 12, line 19; Col. 13, lines 1-28; Col. 14, lines 15-35; FIGS. 1-3, 6), discloses or suggests, either inherently, or implicitly, preventing sound generation means from generating sound. (*See* Appendices N and M, Elements 21-23).

(115) **Claim 8.** Claim 8 is similar to Claim 1 (*see above*), except that it replaces the language “clock means for keeping a predetermined time period after said receiving means receives the transmission” with “clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing.”

Griswold discloses clock means for keeping a predetermined time period after said receiving means receives the transmission. (Griswold, Col. 7, lines 3-26). While Griswold discloses these means as resident on the host computer, putting them at the communications terminal would have been an obvious variation requiring no technological insight.

Additionally, Suzuki discloses means for keeping a predetermined time period after said executing means starts execution of the program or data processing. (Suzuki, Pgs. 2-4). (*See* Appendices N and M, Elements 24-34).

(116) **Claim 9.** Claim 9 depends upon Claim 8. (*See above*). The analysis with respect to Claim 9 is the same as with respect to Claim 2. (*See above; see also* Appendices N and M, Elements 35-38.)

(117) **Claim 12.** Claim 12 depends upon Claim 8. (*See above*). The analysis with respect to Claim 12 is the same as with respect to Claim 5. (*See above; see also* Appendices N and M, Elements 41-43).

SNQ V. Hornbuckle

Claims 1, 4-5, 7, 12, and 14 of the ‘520 patent are obvious under 35 U.S.C § 103(a) over Hornbuckle.

A substantial new question is raised by Hornbuckle as to Claims 1, 4-5, 7, 12, and 14 of the ‘520 patent. Hornbuckle was neither cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, it is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim

charts that follow in Appendix G, important in determining whether or not the claims are patentable. In particular, as set forth herein, Hornbuckle recites or renders obvious each and every limitation and the claimed invention as a whole of Claims 1, 4-5, 7, 12, and 14. For this reason, Hornbuckle raises a substantial new question of patentability with respect to Claims 1, 4-5, 7, 12, and 14.

(118) Claim 1. As set forth in Claim 1, Hornbuckle discloses 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. (Hornbuckle, Abstract, Col. 2, lines 52-56, 60-63; Col. 3, lines 23-36, 58-65; Col. 3, line 66 – Col. 4, line 21; Col. 5, lines 9-16; Col. 14, lines 41-49; Col. 16, lines 12-22, 60-65; FIGS. 1, 4). Hornbuckle further discloses an input device for inputting instructions to execute the program or to process the data. (Hornbuckle, Col. 4, lines 13-21; Col. 14, line 67 – Col. 15, line 3; FIGS. 1, 4). Hornbuckle further discloses 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. (Hornbuckle, Col. 2, line 64 – Col. 3, line 3; Col. 5, lines 9-16, 25-29, 35-37; Col. 6, lines 14-18, 24-31, 53-58; Col. 7, line 61 – Col. 8, line 7; Col. 9, lines 35-46; Col. 13, lines 11-15; Col. 14, lines 49-56; Col. 15, lines 9-20, 38-43; Col. 16, lines 12-22; Figs 1-2, 4-5). Hornbuckle further discloses storage means for storing the program, the data, or a combination of the program and data received by said receiving means. (Hornbuckle, Col. 4, lines 7-11; Col. 5, lines 25-29; Col. 6, lines 24-31, 45-52; Col. 12, lines 29-34; Col. 13, lines 11-15; Col. 15, lines 9-20; Col. 16, lines 12-22; Col. 17, lines 1-7; FIGS. 1-2, 4-5). Hornbuckle further discloses 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. (Hornbuckle, Col. 6, lines 24-31, 33-39; Col. 13, lines 19-24, 38-42; Col. 14, lines 60-64; Col. 15, lines 9-20; Col 16, lines 22-24; FIGS. 2, 5).

Hornbuckle further discloses clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing. (Hornbuckle, Col. 3, lines 4-8; Col. 6, lines 24-31; Col. 6, line 59 – Col. 7, line 4; Col. 11, lines 27-33, 49-53; Col. 13, lines 32-37, 42-54; Col. 15, lines 9-20; FIGS. 2, 5). In view of this disclosure, it would have been obvious to instead include clock means for keeping a predetermined time period after said receiving means receives the transmission.

Hornbuckle further discloses interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (Hornbuckle, Col. 13, lines 42-50; Col. 13, line 51 – Col. 14, line 3). Hornbuckle further discloses a 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 (Hornbuckle, Col. 5, lines 17-18; Col. 6, lines 24-31, 45-58; Col. 14, lines 56-59; Col. 15, lines 9-20; FIGS. 1-2, 4-5), 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. (Hornbuckle, Col. 2, lines 64 – Col. 3, lines 3; Col. 4, lines 4-7, 13-21; Col. 5, lines 9-16; 35-37; Col. 6, lines 4-10, 24-31; Col. 7, line 61 – Col. 8, line 7; Col. 9, lines 35-46; Col. 14, lines 49-56; Col. 15, lines 9-20, 38-43; Col. 16, lines 12-22; FIGS. 1, 4-5). (*See* Appendix G, Elements 1-11).

(119) Claim 4. Claim 4 depends upon Claim 1. (*See* above). As set forth in Claim 4, Hornbuckle further discloses that said interference means comprises means for deleting at least one of the program, the data, and a combination of the program and data stored in said storage means. (Hornbuckle, Col. 13, line 42 – Col. 14, line 3). (*See* Appendix G, Elements 16-17).

(120) Claim 5. Claim 5 depends upon Claim 1. (*See* above). As set forth in Claim 5, Hornbuckle discloses that said communication terminal device comprises display means having a

screen on which the progress of execution of the program or data processing is displayed.

(Hornbuckle, Col. 4, lines 13-21; Col. 14, lines 60-64; Col. 15, lines 3-7; FIGS. 1, 4). Hornbuckle further inherently discloses that said interference means comprises means for blocking the view of what is displayed on said screen. (Hornbuckle, Col. 13, line 42 – Col. 14, line 3).

Alternatively, in view of Hornbuckle's disclosure of a display, and of deleting the program after use, it would have been obvious to instead disable the program so that it cannot be displayed on the user's computer, which is an obvious substitution requiring no technological insight. (*See* Appendix G, Elements 18-20).

(121) Claim 7. Claim 7 depends upon Claim 1. (*See* above). As set forth in Claim 7, Hornbuckle discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing. (Hornbuckle, Col. 5, lines 9-16; Col. 15, lines 3-7). Hornbuckle further inherently discloses that said interference means comprises means for preventing said sound generating means from generating the sound.

Alternatively, in view of Hornbuckle's disclosure of sound generation means, and of deleting the program after use, it would have been obvious to instead disable the program so that it cannot generate sound on the user's computer, which is an obvious substitution requiring no technological insight. (Hornbuckle, Col. 13, line 42 – Col. 14, line 3). (*See* Appendix G, Elements 21-23).

(122) Claim 12. Claim 12 depends upon Claim 8, which is anticipated by Hornbuckle. (*See* above). The analysis with respect to Claim 12 is the same as with respect to Claim 5. (*See* above; *see also* Appendix G, Elements 41-43.)

(123) Claim 14. Claim 14 depends upon Claim 8, which is anticipated by Hornbuckle. (*See* above). The analysis with respect to Claim 14 is the same as with respect to Claim 7. (*See* above; *see also* Appendix G, Elements 44-46.)

SNQ W. Hornbuckle in view of Suzuki

Claims 1-2, 4-5, 7, and 9 of the ‘520 patent are obvious under 35 U.S.C § 103(a) over Hornbuckle in view of Suzuki.

A substantial new question is raised by Hornbuckle in view of Suzuki as to Claims 1-2, 4-5, 7, and 9 of the ‘520 patent. Neither reference was cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, each is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendices G and M, important in determining whether or not the claims are patentable. In particular, as set forth herein, Hornbuckle in view of Suzuki teaches or suggests each and every limitation of Claims 1-2, 4-5, 7, and 9. For this reason, Hornbuckle in view of Suzuki raises a substantial new question of patentability with respect to Claims 1-2, 4-5, 7, and 9.

The motivation to combine Hornbuckle with Suzuki arises from the nature of the problem to be solved: namely, both disclose closely related systems for distributing and controlling access to and usage of fee-based software. Thus, one of ordinary skill in the art would have naturally looked to Suzuki’s system for administering software to improve upon the fee-based system disclosed in Hornbuckle, yielding a predictable result, without undue experimentation.

(124) Claim 1. As set forth in Claim 1, Hornbuckle discloses 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. (Hornbuckle, Abstract, Col. 2, lines 52-56, 60-63; Col. 3, lines 23-36, 58-65; Col. 3, line 66 – Col. 4, line 21; Col. 5, lines 9-16; col. 14, lines 41-49; Col. 16, lines 12-22, 60-65; FIGS. 1, 4). Hornbuckle further discloses an input device for inputting instructions to execute the program or to process the data. (Hornbuckle, Col. 4, lines 13-21; Col. 14, line 67 – Col. 15, line 3; FIGS. 1, 4). Hornbuckle further discloses 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. (Hornbuckle, Col. 2, line 64 – Col. 3, line 3; Col. 5, lines 9-16, 25-29, 35-37; Col. 6, lines 14-18, 24-31, 53-58; Col. 7, line 61 – Col. 8, line 7; Col. 9, lines 35-46; Col. 13, lines 11-15; Col. 14, lines 49-56; Col. 15, lines 9-20, 38-43; Col. 16, lines 12-22; Figs 1-2, 4-5). Hornbuckle further discloses storage means for storing the program, the data, or a combination of the program and data received by said receiving means. (Hornbuckle, Col. 4, lines 7-11; Col. 5, lines 25-29; Col. 6, lines 24-31, 45-52; Col. 12, lines 29-34; Col. 13, lines 11-15; Col. 15, lines 9-20; Col. 16, lines 12-22; Col. 17, lines 1-7; FIGS. 1-2, 4-5). Hornbuckle further discloses 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. (Hornbuckle, Col. 6, lines 24-31, 33-39; Col. 13, lines 19-24, 38-42; Col. 14, lines 60-64; Col. 15, lines 9-20; Col. 16, lines 22-24; FIGS. 2, 5).

Hornbuckle further discloses clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing. (Hornbuckle, Col. 3, lines 4-8; Col. 6, lines 24-31; Col. 6, line 59 – Col. 7, line 4; Col. 11, lines 27-33, 49-53; Col. 13, lines 32-37, 42-54; Col. 15, lines 9-20; FIGS. 2, 5). In view of this disclosure, it would have been obvious to instead include clock means for keeping a predetermined time period after said receiving means receives the transmission.

Additionally, Suzuki discloses clock means for keeping a predetermined time period after said receiving means receives the transmission (Suzuki, Pgs. 2-4) and interference means for interfering with execution of said executing means when said clock means counts said predetermined time period (*id.*).

Hornbuckle further discloses interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (Hornbuckle, Col.

13, line 42 – Col. 14, line 3). Hornbuckle further discloses a 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 (Hornbuckle, Col. 5, lines 17-18; Col. 6, lines 24-31, 45-58; Col. 14, lines 56-59; Col. 15, lines 9-20; FIGS. 1-2, 4-5), 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. (Hornbuckle, Col. 2, line 64 – Col. 3, line 3; Col. 4, lines 4-7, 13-21; Col. 5, lines 9-16, 35-37; Col. 6, lines 4-10, 24-31; Col. 7, line 61 – Col. 8, line 7; Col. 9, lines 35-46; Col. 14, lines 49-56; Col. 15, lines 9-20, 38-43; Col. 16, lines 12-22; FIGS. 1, 4-5). (*See* Appendices G and M, Elements 1-11).

(125) **Claim 2.** Claim 2 depends upon Claim 1. (*See* above.) As set forth in Claim 2, Suzuki discloses second clock means for keeping a second predetermined time period shorter than said predetermined time period counted by said clock means (Suzuki, Pgs. 3, 5). Suzuki further discloses alarm means for issuing an alarm when said second clock means counts said second predetermined time period, and thereby informing that interference by said interference means with execution of said executing means will soon be performed. (Suzuki, Pgs. 2-3, 5). (*See* Appendices G and M, Elements 12-15).

(126) **Claim 4.** Claim 4 depends upon Claim 1. (*See* above). As set forth in Claim 4, Hornbuckle further discloses that said interference means comprises means for deleting at least one of the program, the data, and a combination of the program and data stored in said storage means. (Hornbuckle, Col. 13, line 42 – Col. 14, line 3). (*See* Appendices G and M, Elements 16-17).

(127) **Claim 5.** Claim 5 depends upon Claim 1. (*See* above). As set forth in Claim 5, Hornbuckle discloses that said communication terminal device comprises display means having a

screen on which the progress of execution of the program or data processing is displayed. (Hornbuckle, Col. 4, lines 13-21; Col. 14, lines 60-64; Col. 15, lines 3-7; FIGS. 1, 4).

Hornbuckle further inherently discloses that said interference means comprises means for blocking the view of what is displayed on said screen. (Hornbuckle, Col. 13, line 42 – Col. 14, line 3). Alternatively, in view of Hornbuckle's disclosure of a display, and of deleting the program after use, it would have been obvious to instead disable the program so that it cannot be displayed on the user's computer, which is an obvious substitution requiring no technological insight. (*See* Appendices G and M, Elements 18-20).

(128) Claim 7. Claim 7 depends upon Claim 1. (*See* above). As set forth in Claim 7, Hornbuckle discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing. (Hornbuckle, Col. 5, lines 9-16; Col. 15, lines 3-7).

Hornbuckle further inherently discloses that said interference means comprises means for preventing said sound generating means from generating the sound. Alternatively, in view of Hornbuckle's disclosure of sound generation means, and of deleting the program after use, it would have been obvious to instead disable the program so that it cannot generate sound on the user's computer, which is an obvious substitution requiring no technological insight. (Hornbuckle, Col. 13, line 42 – Col. 14, line 3). (*See* Appendices G and M, Elements 21-23).

(129) Claim 9. Claim 9 depends upon Claim 8, which is anticipated by Hornbuckle. (*See* above). The analysis with respect to Claim 9 is the same as with respect to Claim 2. (*See* above; *see also* Appendices G and M, Elements 35-38).

SNQ X. Kaniwa in view of Suzuki

Claims 2 and 9 of the '520 patent are obvious under 35 U.S.C § 103(a) over Kaniwa in view of Suzuki.

A substantial new question is raised by Kaniwa in view of Suzuki as to Claims 2 and 9 of the '520 patent. Neither reference was cited by Applicant, nor cited or considered by Examiner during the original examination of the '520 patent. As such, each is so-called "new art." Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendices H and M, important in determining whether or not the claims are patentable. In particular, as set forth herein, Kaniwa in view of Suzuki teaches or suggests each and every limitation of Claims 2 and 9. For this reason, Kaniwa in view of Suzuki raises a substantial new question of patentability with respect to Claims 2 and 9.

The motivation to combine Kaniwa with Suzuki arises from the nature of the problem to be solved: namely, both disclose closely related systems for controlling access to programs based on time of use. Upgrading Kaniwa's system, based on time of first use, with Suzuki's system, providing a warning before interference would have been a simple substitution, yielding a predictable result, without undue experimentation.

(130) Claim 2. Claim 2 depends upon Claim 1, which is anticipated by Kaniwa. (*See* above.) As set forth in Claim 2, Suzuki discloses second clock means for keeping a second predetermined time period shorter than said predetermined time period counted by said clock means (Suzuki, Pgs. 3, 5). Suzuki further discloses alarm means for issuing an alarm when said second clock means counts said second predetermined time period, and thereby informing that interference by said interference means with execution of said executing means will soon be performed. (Suzuki, Pgs. 2-3, 5). (*See* Appendices H and M, Elements 12-15).

(131) Claim 9. Claim 9 depends upon Claim 8, which is anticipated by Kaniwa. (*See* above.) The analysis with respect to Claim 9 is the same as with respect to Claim 2. (*See* above; *see also* Appendices H and M, Elements 35-38.)

SNQ Y. Kaniwa in view of Morales

Claims 4 and 11 of the ‘520 patent are obvious under 35 U.S.C § 103(a) over Kaniwa in view of Morales.

A substantial new question is raised by Kaniwa in view of Morales as to Claims 4 and 11 of the ‘520 patent. Neither reference was cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, each is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendices H and O, important in determining whether or not the claims are patentable. In particular, as set forth herein, Kaniwa in view of Morales teaches or suggests each and every limitation of Claims 4 and 11. For this reason, Kaniwa in view of Morales raises a substantial new question of patentability with respect to Claims 4 and 11.

The motivation to combine Kaniwa with Morales arises from the nature of the problem to be solved: namely, both disclose closely related systems for controlling access to programs based on period of use. Replacing Kaniwa’s system, which disables software after a predetermined time period expires, with the Morales system, which deletes the information, would be an obvious substitution, requiring no technological insight, and would yield expected results without undue experimentation.

(132) Claim 4. Claim 4 depends upon Claim 1, which is anticipated by Kaniwa. (*See* above.) As set forth in Claim 4, Kaniwa further discloses that said interference means comprises means for interfering with at least one of the program, the data, and a combination of the program and data stored in said storage means. (Kaniwa, Col. 19, lines 17-49; Col. 19, line 54 – Col. 20, line 4; Col. 19, lines 5-58; Col. 21, lines 25-63; FIGS. 12, 15-16). Deleting such data would have been an obvious variation, requiring no technological insight.

Additionally, Morales discloses deletion of the data to interfere with unauthorized use. (Morales, Col. 6, lines 25-29; Col. 3, lines 12-23; Col. 4, lines 56-64; Col. 5, lines 33-37). (*See* Appendices H and O, Elements 16-17).

(133) **Claim 11**. Claim 11 depends upon Claim 8, which is anticipated by Kaniwa. (*See* above). The analysis with respect to Claim 11 is the same as with respect to Claim 4. (*See* above; *see also* Appendices H and O, Elements 39-40.)

SNQ Z. Kato

Claims 5, 7, 12, and 14 of the ‘520 patent are obvious under 35 U.S.C § 103(a) over Kato.

A substantial new question is raised by Kato as to Claims 5, 7, 12, and 14 of the ‘520 patent. Kato was neither cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, it is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendix B, important in determining whether or not the claims are patentable. In particular, as set forth herein, Kato recites or renders obvious each and every limitation and the claimed invention as a whole of Claims 5, 7, 12, and 14. For this reason, Kato raises a substantial new question of patentability with respect to Claims 5, 7, 12, and 14.

(134) **Claim 5**. Claim 5 depends upon Claim 1, which is anticipated by Kato. (*See* above). As set forth in Claim 5, Kato discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (Kato, Pgs. 11-12, 40-41; FIG. 1).

To the extent that it is deemed not expressly or inherently disclosed, it would have been obvious, in light of Kato’s disclosure of interference means and display means, that said interference

means comprises means for blocking the view of what is displayed on said screen. (Kato, Pgs. 28-29, 30-31, 7-8, 14-16, 37-39). (*See* Appendix B, Elements 18-20).

(135) **Claim 7.** Claim 7 depends upon Claim 1. (*See* above). As set forth in Claim 7, Kato explicitly or inherently discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing. (Kato, Pgs. 5, 11, 6; FIG. 7).

To the extent that it is deemed not expressly or inherently disclosed, it would have been obvious, in light of Kato's disclosure of interference means and inherent disclosure of sound generation means, that said interference means comprises means for preventing said sound generating means from generating the sound. (Kato, Pgs. 28-29, 30-31, 7-8, 14-16, 37-39). (*See* Appendix B, Elements 21-23).

(136) **Claim 12.** Claim 12 depends upon Claim 8, which is anticipated by Kato. (*See* above). The analysis with respect to Claim 12 is the same as with respect to Claim 5. (*See* above; *see also* Appendix B, Elements 41-43.)

(137) **Claim 14.** Claim 14 depends upon Claim 8, which is anticipated by Kato. (*See* above). The analysis with respect to Claim 14 is the same as with respect to Claim 7. (*See* above; *see also* Appendix B, Elements 44-46.)

SNQ AA. Kato in view of Kaniwa

Claims 5, 7, 12, and 14 of the '520 patent are obvious under 35 U.S.C § 103(a) over Kato in view of Kaniwa.

A substantial new question is raised by Kato in view of Kaniwa as to Claims 5, 7, 12, and 14 of the '520 patent. Neither reference was cited by Applicant, nor cited or considered by Examiner during the original examination of the '520 patent. As such, each is so-called "new art." Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the

detailed claim charts that follow in Appendices B and H, important in determining whether or not the claims are patentable. In particular, as set forth herein, Kato in view of Kaniwa teaches or suggests each and every limitation of Claims 5, 7, 12, and 14. For this reason, Kato in view of Kaniwa raises a substantial new question of patentability with respect to Claims 5, 7, 12, and 14.

The motivation to combine Kato with Kaniwa arises from the nature of the problem to be solved: namely, both disclose closely related systems for distributing and controlling access to and usage of licensed software and/or information. Thus, one of ordinary skill in the art would have naturally looked to Kaniwa's system for limiting access to licensed material to improve upon the system disclosed in Kato, yielding a predictable result, without undue experimentation.

(138) Claim 5. Claim 5 depends upon Claim 1, which is anticipated by Kato. (*See above*). As set forth in Claim 5, Kato discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (Kato, Pgs. 11-12, 40-41; FIG. 1). To the extent that it is deemed not expressly or inherently disclosed, it would have been obvious, in light of Kato's disclosure of interference means and display means, that said interference means comprises means for blocking the view of what is displayed on said screen. (Kato, Pgs. 28-29, 30-31, 7-8, 14-16, 37-39).

Additionally, Kaniwa discloses both a display means (Kaniwa, Col. 7, lines 53-62; Col. 8, line 1 – Col. 9, line 11; Col. 18, line 39 – Col. 19, line 9; FIGS. 1-2, 12, and 15-16), and interference means for blocking the view of said display (Kaniwa, Col. 19, lines 17-49; Col. 19, line 54 – Col. 20, line 4; Col. 19, lines 5-58; Col. 21, lines 25-63; FIGS. 12, 15-16). (*See Appendices B and H, Elements 18-20*).

(139) Claim 7. Claim 7 depends upon Claim 1, which is anticipated by Kato. (*See above*). As set forth in Claim 7, Kato explicitly or inherently discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or

data processing. (Kato, Pgs. 5, 11, 6; FIG. 7). To the extent that it is deemed not expressly or inherently disclosed, it would have been obvious, in light of Kato's disclosure of interference means and inherent disclosure of sound generation means, that said interference means comprises means for preventing said sound generating means from generating the sound. (Kato, Pgs. 28-29, 30-31, 7-8, 14-16, 37-39).

Additionally, Kaniwa discloses both sound generating means (Kaniwa, Col. 7, lines 53-62; Col. 8, line 1 – Col. 9, line 11; Col. 18, line 39 – Col. 19, line 9; FIGS. 1-2, 12, 15-16), and interference means for interfering with said sound generating means (Kaniwa, Col. 19, lines 17-49; Col. 19, line 54 – Col. 20, line 4; Col. 19, lines 5-58; Col. 21, lines 25-63; FIGS. 12, 15-16). (*See* Appendices B and H, Elements 21-23).

(140) Claim 12. Claim 12 depends upon Claim 8, which is anticipated by Kato. (*See* above). The analysis with respect to Claim 12 is the same as with respect to Claim 5. (*See* above; *see also* Appendices B and H, Elements 41-43).

(141) Claim 14. Claim 14 depends upon Claim 8, which is anticipated by Kato. (*See* above). The analysis with respect to Claim 14 is the same as with respect to Claim 7. (*See* above; *see also* Appendices B and H, Elements 44-46).

SNQ BB. Kato in view of Tsumura

Claims 15-16, 18-19, and 21 of the '520 patent are obvious under 35 U.S.C § 103(a) over Kato in view of Tsumura.

A substantial new question is raised by Kato in view of Tsumura as to Claims 15-16, 18-19, and 21 of the '520 patent. Neither reference was cited by Applicant, nor cited or considered by Examiner during the original examination of the '520 patent. As such, each is so-called "new art." Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendices B and J, important in determining whether or not

the claims are patentable. In particular, as set forth herein, Kato in view of Tsumura teaches or suggests each and every limitation of Claims 15-16, 18-19, and 21. For this reason, Kato in view of Tsumura raises a substantial new question of patentability with respect to Claims 15-16, 18-19, and 21.

It would have been obvious to combine Kato with Tsumura, as it involves a simple substitution: namely, replacing a system that measures time from the *start* of execution of downloaded content, with one that measures time from the *end* of execution, which can be accomplished without undue experimentation, yielding predictable results.

(142) Claim 15. Claim 15 is similar to Claim 1, which is anticipated by Kato (*see* above), except that it replaces the language “clock means for keeping a predetermined time period after said receiving means receives the transmission” with “clock means for keeping a predetermined time period after said execution means ends the execution of the program or data processing to count a time period during which at least one of the program, the data, and a combination of the program and data is continuously unused.” Kato discloses clock means for keeping a predetermined time period after said executing means *starts* execution of the program or data processing. (Kato, Pgs. 26, 28-29, 30-31, 25-26).

Tsumura, on the other hand, discloses means for keeping a predetermined time period after said execution means *ends* the execution of the program or data processing to count a time period during which at least one of the program, the data, and a combination of the program and data is continuously unused. (Tsumura, Col. 9, lines 56-65). (*See* Appendices B and J, Elements 47-57).

(143) Claim 16. Claim 16 depends upon Claim 15. (*See* above). As set forth in Claim 16, Kato discloses second clock means for keeping a second predetermined time period shorter than said predetermined time period counted by said clock means (Kato, Pgs. 26, 28-29). Kato further discloses alarm means for issuing an alarm when said second clock means counts said second

predetermined time period, and thereby informing that interference by said interference means with execution of said executing means will soon be performed. (Kato, Pgs. 28-29). (*See* Appendices B and J, Elements 58-60).

(144) Claim 18. Claim 18 depends upon Claim 15. (*See* above). As set forth in Claim 18, Kato further discloses that said interference means comprises means for deleting at least one of the program, the data, and a combination of the program and data stored in said storage means. (Kato, 28-29, 30-31, 7-8, 14-16, 37-38, 38-39). (*See* Appendices B and J, Elements 61-62).

(145) Claim 19. Claim 19 depends upon Claim 15. (*See* above). As set forth in Claim 19, As set forth in Claim 5, Kato discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (Kato, Pgs. 11-12, 40-41; FIG. 1).

To the extent that it is deemed not expressly or inherently disclosed, it would have been obvious, in light of Kato's disclosure of interference means and display means, that said interference means comprises means for blocking the view of what is displayed on said screen. (Kato, Pgs. 28-29, 30-31, 7-8, 14-16, 37-39). (*See* Appendices B and J, Elements 63-65).

(146) Claim 21. Claim 21 depends upon Claim 15. (*See* above). As set forth in Claim 21, Kato explicitly or inherently discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing. (Kato, Pgs. 5, 11, 6; FIG. 7).

To the extent that it is deemed not expressly or inherently disclosed, it would have been obvious, in light of Kato's disclosure of interference means and inherent disclosure of sound generation means, that said interference means comprises means for preventing said sound generating means from generating the sound. (Kato, Pgs. 28-29, 30-31, 7-8, 14-16, 37-39). (*See* Appendices B and J, Elements 66-68).

SNQ CC. Kato in view of Tsumura, in further view of Kaniwa

Claims 19 and 21 of the ‘520 patent are obvious under 35 U.S.C § 103(a) over Kato in view of Tsumura, in further view of Kaniwa.

A substantial new question is raised by Kato in view of Tsumura, in further view of Kaniwa as to Claims 19 and 21 of the ‘520 patent. None of these reference was cited by Applicant, nor was any of these references cited or considered by Examiner during the original examination of the ‘520 patent. As such, each is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendices B, J, and H, important in determining whether or not the claims are patentable. In particular, as set forth herein, Kato in view of Tsumura, in further view of Kaniwa teaches or suggests each and every limitation of Claims 19 and 21. For this reason, Kato in view of Tsumura, in further view of Kaniwa raises a substantial new question of patentability with respect to Claims 19 and 21.

It would have been obvious to combine Kato with both Tsumura and Kaniwa, for the reasons set forth above.

(147) Claim 19. Claim 19 depends upon Claim 15, which is obvious over Kato in view of Tsumura. (*See above*). As set forth in Claim 19, Kato discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (Kato, Pgs. 11-12, 40-41; FIG. 1). To the extent that it is deemed not expressly or inherently disclosed, it would have been obvious, in light of Kato’s disclosure of interference means and display means, that said interference means comprises means for blocking the view of what is displayed on said screen. (Kato, Pgs. 28-29, 30-31, 7-8, 14-16, 37-39).

Additionally, Kaniwa discloses both a display means (Kaniwa, Col. 7, lines 53-62; Col. 18, line 1 – Col. 19, line 9; FIGS. 1-2, 12, and 15-16), and interference means for blocking the view of

said display (Kaniwa, Col. 19, line 5 – Col. 20, line 4; Col. 21, lines 25-63; FIGS. 12, 15-16). (*See* Appendices B, J, and H, Elements 63-65.)

(148) **Claim 21.** Claim 21 depends upon Claim 15, which is obvious over Kato in view of Tsumura. (*See* above). As set forth in Claim 21, Kato explicitly or inherently discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing. (Kato, Pgs. 5, 11, 6; FIG. 7).

To the extent that it is deemed not expressly or inherently disclosed, it would have been obvious, in light of Kato's disclosure of interference means and inherent disclosure of sound generation means, that said interference means comprises means for preventing said sound generating means from generating the sound. (Kato, Pgs. 28-29, 30-31, 7-8, 14-16, 37-39).

Additionally, Kaniwa discloses both sound generating means (Kaniwa, Col. 7, lines 53-62; Col. 8, line 1 – Col. 9, line 11; Col. 18, line 39 – Col. 19, line 9; FIGS. 1-2, 12, 15-16), and interference means for interfering with said sound generating means (Kaniwa, Col. 19, lines 17-49; Col. 19, line 54 – Col. 20, line 4; Col. 19, lines 5-58; Col. 21, lines 25-63; FIGS. 12, 15-16). (*See* Appendices B, J, and H, Elements 66-68).

SNQ DD. McCarten in view of Suzuki

Claims 2 and 9 of the '520 patent are obvious under 35 U.S.C § 103(a) over McCarten in view of Suzuki.

A substantial new question is raised by McCarten in view of Suzuki as to Claims 2 and 9 of the '520 patent. Neither reference was cited by Applicant, nor cited or considered by Examiner during the original examination of the '520 patent. As such, each is so-called "new art." Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendices I and M, important in determining whether or not the claims are patentable. In particular, as set forth herein, McCarten in view of Suzuki teaches or

suggests each and every limitation of Claims 2 and 9. For this reason, McCarten in view of Suzuki raises a substantial new question of patentability with respect to Claims 2 and 9.

The motivation to combine McCarten with Suzuki arises from the nature of the problem to be solved: namely, both disclose closely related systems for controlling access to programs based on time of use. Upgrading McCarten's system, based on time of first use, with Suzuki's system, providing a warning before interference would have been a simple substitution, yielding a predictable result, without undue experimentation.

(149) **Claim 2.** Claim 2 depends upon Claim 1, which is anticipated by McCarten. (*See above*). As set forth in Claim 2, Suzuki discloses second clock means for keeping a second predetermined time period shorter than said predetermined time period counted by said clock means (Suzuki, Pgs. 3, 5). Suzuki further discloses alarm means for issuing an alarm when said second clock means counts said second predetermined time period, and thereby informing that interference by said interference means with execution of said executing means will soon be performed. (Suzuki, Pgs. 2-3, 5). (*See Appendices I and M, Elements 12-15*).

(150) **Claim 9.** Claim 9 depends upon Claim 8, which is anticipated by McCarten. (*See above*). The analysis with respect to Claim 9 is the same as with respect to Claim 2. (*See above; see also Appendices I and M, Elements 35-38*).

SNQ EE. McCarten in view of Morales

Claims 4 and 11 of the '520 patent are obvious under 35 U.S.C § 103(a) over McCarten in view of Morales.

A substantial new question is raised by McCarten in view of Morales as to Claims 4 and 11 of the '520 patent. Neither reference was cited by Applicant, nor cited or considered by Examiner during the original examination of the '520 patent. As such, each is so-called "new art." Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the

detailed claim charts that follow in Appendices I and O, important in determining whether or not the claims are patentable. In particular, as set forth herein, McCarten in view of Morales teaches or suggests each and every limitation of Claims 4 and 11. For this reason, McCarten in view of Morales raises a substantial new question of patentability with respect to Claims 4 and 11.

The motivation to combine McCarten with Morales arises from the nature of the problem to be solved: namely, both disclose closely related systems for controlling access to programs based on period of use. Replacing McCarten's system, which disables software after a predetermined time period expires, with the Morales system, which deletes the information, would be an obvious substitution, requiring no technological insight, and would yield expected results without undue experimentation.

(151) Claim 4. Claim 4 depends upon Claim 1, which is anticipated by McCarten. (*See* above.) As set forth in Claim 4, McCarten further discloses interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (McCarten, Col. 10, line 66 – Col. 11, line 5). Deleting such data would have been on obvious variation, requiring no technological insight.

Additionally, Morales discloses deletion of the data to interfere with unauthorized use. (Morales, Col. 6, lines 25-29; Col. 3, lines 12-23; Col. 4, lines 56-64; Col. 5, lines 33-37). (*See* Appendices I and O, Elements 16-17).

(152) Claim 11. Claim 11 depends upon Claim 8, which is anticipated by McCarten. (*See* above). The analysis with respect to Claim 11 is the same as with respect to Claim 4. (*See* above; *see also* Appendices I and O, Elements 39-40).

SNQ FF. McCarten

Claims 5 and 12 of the '520 patent are obvious under 35 U.S.C § 103(a) over McCarten.

A substantial new question is raised by McCarten as to Claims 5 and 12 of the '520 patent. McCarten was neither cited by Applicant, nor cited or considered by Examiner during the original examination of the '520 patent. As such, it is so-called "new art." Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendix I, important in determining whether or not the claims are patentable. In particular, as set forth herein, McCarten recites or renders obvious each and every limitation and the claimed invention as a whole of Claims 5 and 12. For this reason, McCarten raises a substantial new question of patentability with respect to Claims 5 and 12.

(153) Claim 5. Claim 5 depends upon Claim 1, which is anticipated by McCarten. (*See* above). As set forth in Claim 5, McCarten discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (McCarten, FIG. 4, block 90 (LCD Display); Col. 1, lines 48-52; Col. 7, lines 23-26, 38-45). McCarten further discloses that said interference means comprises means for blocking the view of what is displayed on said screen. (McCarten, Col. 10, line 66 –Col. 11, line 5).

Alternatively, blocking the display would be an obvious variation requiring no technological insight. (*See* Appendix I, Elements 18-20).

(154) Claim 12. Claim 12 depends upon Claim 8, which is anticipated by McCarten. (*See* above.) The analysis with respect to Claim 12 is the same as with respect to Claim 5. (*See* above; *see also* Appendix I, Elements 41-43.)

SNQ GG. McCarten in view of Kaniwa

Claims 5 and 12 of the '520 patent are obvious under 35 U.S.C § 103(a) over McCarten in view of Kaniwa.

A substantial new question is raised by McCarten in view of Kaniwa as to Claims 5 and 12 of the '520 patent. Neither reference was cited by Applicant, nor cited or considered by Examiner

during the original examination of the '520 patent. As such, each is so-called "new art." Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendices I and H, important in determining whether or not the claims are patentable. In particular, as set forth herein, McCarten in view of Kaniwa teaches or suggests each and every limitation of Claims 5 and 12. For this reason, McCarten in view of Kaniwa raises a substantial new question of patentability with respect to Claims 5 and 12.

The motivation to combine McCarten with Kaniwa arises from the nature of the problem to be solved: namely, both disclose closely related systems for distributing and controlling access to and usage of licensed software and/or information. Thus, one of ordinary skill in the art would have naturally looked to Kaniwa's system for limiting access to licensed material to improve upon the system disclosed in McCarten, yielding a predictable result, without undue experimentation.

(155) Claim 5. Claim 5 depends upon Claim 1, which is anticipated by McCarten. (*See* above). As set forth in Claim 5, McCarten discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (McCarten, FIG. 4, block 90 (LCD Display); Col. 1, lines 48-52; Col. 7, lines 23-26, 38-45). McCarten further discloses that said interference means comprises means for blocking the view of what is displayed on said screen. (McCarten, Col. 10, line 66 –Col. 11, line 5).

Additionally, Kaniwa discloses both a display means (Kaniwa, Col. 7, lines 53-62; Col. 8, line 1 to Col. 9, line 11; Col. 18, line 39 – Col. 19, line 9; FIGS. 1-2, 12, and 15-16), and interference means for blocking the view of said display (Kaniwa, Col. 19, line 5 – Col. 20, line 4; Col. 21, lines 25-63; FIGS. 12, 15-16). (*See* Appendix I and H, Elements 18-20).

(156) Claim 12. Claim 12 depends upon Claim 8, which is anticipated by McCarten. (*See* above.) The analysis with respect to Claim 12 is the same as with respect to Claim 5. (*See* above; *see also* Appendix I and H, Elements 41-43.)

SNQ HH. Nakagawa

Claims 1-2, 4-5, 7, 12, and 14 of the ‘520 patent are obvious under 35 U.S.C § 103(a) over Nakagawa.

A substantial new question is raised by Nakagawa as to Claims 1-2, 4-5, 7, 12, and 14 of the ‘520 patent. Nakagawa was neither cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, it is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendix C, important in determining whether or not the claims are patentable. In particular, as set forth herein, Nakagawa recites or renders obvious each and every limitation and the claimed invention as a whole of Claims 1-2, 4-5, 7, 12, and 14. For this reason, Nakagawa raises a substantial new question of patentability with respect to Claims 1-2, 4-5, 7, 12, and 14.

(157) Claim 1. As set forth in Claim 1, Nakagawa discloses 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. (Nakagawa, Col. 1, lines 44-47; Col. 7, lines 15-18; Col. 11, lines 50-51, 57-59, 64-68). Nakagawa further discloses an input device for inputting instructions to execute the program or to process the data. (Nakagawa, FIGS. 1, 22a & 22b; Col. 3, lines 34-37; Col. 2, lines 3-10). Nakagawa further discloses 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. (Nakagawa, Col. 12, lines 6-11). Nakagawa further discloses storage means for storing the program, the data, or a combination of the program and data received by said receiving means. (Nakagawa, FIG. 3B, block 86 [Working RAM] and associated text; FIG. 6, blocks S207 [Transfer Program] & S209 [Set Bank Number] and associated text; Col. 10, lines 44-47). Nakagawa further discloses 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. (Nakagawa, FIG.1, block 60 [CPU]; FIG. 7, block 60 [μP]; Col. 2, lines 3-10; Col. 12, lines 59-64).

Nakagawa further discloses clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing. (Nakagawa, Col. 2, lines 31-33; Col. 13, lines 60-68). In view of this, it would have been obvious to use clock means for keeping a predetermined time period after said receiving means receives the transmission, which is an obvious design choice requiring no technological insight.

Nakagawa further discloses interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (Nakagawa, Col. 5, lines 46-60; Col. 2, lines 34-40; Col. 14, lines 36-47). Nakagawa further discloses a 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 (Nakagawa, FIG. 3C and associated text; Col. 6, lines 23-32; 47-49), 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. (Nakagawa, Col. 6, lines 37-43; Col. 11, lines 50-51, 57-59, 64-68). (*See* Appendix C, Elements 1-11).

(158) Claim 2. Claim 2 depends upon Claim 1. (*See* above). As set forth in Claim 2, Nakagawa discloses second clock means for keeping a second predetermined time period shorter than said predetermined time period counted by said clock means (Nakagawa, Col. 2, lines 34-40; Col. 13, lines 34-42). Nakagawa further discloses alarm means for issuing an alarm when said second clock means counts said second predetermined time period, and thereby informing that interference by said interference means with execution of said executing means will soon be

performed. (Nakagawa, Col. 2, lines 34-48; Col. 12, lines 12-22; Col. 14, lines 29-35). (*See* Appendix C, Elements 12-15).

(159) Claim 4. Claim 4 depends upon Claim 1. (*See* above). As set forth in Claim 4, Nakagawa further discloses interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (Nakagawa, Col. 5, lines 46-60; Col. 2, lines 34-40; Col. 14, lines 36-47).

In view of this, it would have been an obvious variation that, instead of disabling the software, it could be deleted, as set forth in Claim 4. (*See* Appendix C, Elements 16-17).

(160) Claim 5. Claim 5 depends upon Claim 1. (*See* above). As set forth in Claim 5, Nakagawa discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (Nakagawa, FIGS. 1, 32; Col. 9, line 54 – Col. 10, line 2; Col. 4, lines 22-27; Col. 2, lines 3-10; Col. 6, lines 16-20). Nakagawa further discloses that said interference means comprises means for blocking the view of what is displayed on said screen. (Nakagawa, Col. 9, lines 51-54; Col. 11, lines 40-43; Col. 14, lines 36-47; Col. 15, lines 2-4).

To the extent that it is deemed not explicitly or inherently disclosed therein, in view of Nakagawa's disclosure of interference with execution of the game, interfering with the view of the display would be an obvious modification requiring no technological insight. (*See* Appendix C, Elements 18-20).

(161) Claim 7. Claim 7 depends upon Claim 1. (*See* above). As set forth in Claim 7, Nakagawa discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing. (Nakagawa, Col. 9, line 54 – Col. 10, line 2; Col. 4, lines 22-27; Col. 6, lines 16-20). Nakagawa further discloses that said interference means comprises means for preventing said sound generating means from generating the sound.

To the extent that it is deemed not explicitly or inherently disclosed therein, in view of Nakagawa's disclosure of interference with execution of the game, interfering with the sound generating means would be an obvious modification requiring no technological insight. (Nakagawa, Col. 11, lines 50-55; Col. 14, lines 36-47). (*See* Appendix C, Elements 21-23).

(162) **Claim 12.** Claim 12 depends upon Claim 8, which is anticipated by Nakagawa. (*See* above). The analysis with respect to Claim 12 is the same as with respect to Claim 5. (*See* above; *see also* Appendix C, Elements 41-43).

(163) **Claim 14.** Claim 14 depends upon Claim 8, which is anticipated by Nakagawa. (*See* above). The analysis with respect to Claim 14 is the same as with respect to Claim 7. (*See* above; *see also* Appendix C, Elements 44-46).

SNQ II. Nakagawa in view of Suzuki

Claims 1-2, 5, and 7 of the '520 patent are obvious under 35 U.S.C § 103(a) over Nakagawa in view of Suzuki.

A substantial new question is raised by Nakagawa in view of Suzuki as to Claims 1-2, 5, and 7 of the '520 patent. Neither reference was cited by Applicant, nor cited or considered by Examiner during the original examination of the '520 patent. As such, each is so-called "new art." Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendices C and M, important in determining whether or not the claims are patentable. In particular, as set forth herein, Nakagawa in view of Suzuki teaches or suggests each and every limitation of Claims 1-2, 5, and 7. For this reason, Nakagawa in view of Suzuki raises a substantial new question of patentability with respect to Claims 1-2, 5, and 7.

The motivation to combine Nakagawa with Suzuki arises from the nature of the problem to be solved: namely, both disclose closely related systems for controlling access to programs based on time of use. Replacing Nakagawa's system, based on time of first use, with Suzuki's system, based

on receipt of the software would have been a simple substitution, yielding a predictable result, without undue experimentation.

(164) Claim 1. As set forth in Claim 1, Nakagawa discloses 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. (Nakagawa, Col. 1, lines 44-47; Col. 7, lines 15-18; Col. 11, lines 50-51, 57-59, 64-68). Nakagawa further discloses an input device for inputting instructions to execute the program or to process the data. (Nakagawa, FIGS. 1, 22a & 22b; Col. 3, lines 34-37; Col. 2, lines 3-10). Nakagawa further discloses 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. (Nakagawa, Col. 12, lines 6-11). Nakagawa further discloses storage means for storing the program, the data, or a combination of the program and data received by said receiving means. (Nakagawa, FIG. 3B, block 86 [Working RAM] and associated text; FIG. 6, blocks S207 [Transfer Program] & S209 [Set Bank Number] and associated text; Col. 10, lines 44-47). Nakagawa further discloses 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. (Nakagawa, FIG.1, block 60 [CPU]; FIG. 7, block 60 [μ P]; Col. 2, lines 3-10; Col. 12, lines 59-64).

Nakagawa further discloses clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing. (Nakagawa, Col. 2, lines 31-33; Col. 13, lines 60-68). In view of this, it would have been obvious to use clock means for keeping a predetermined time period after said receiving means receives the transmission, which is an obvious design choice requiring no technological insight.

Nakagawa further discloses interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (Nakagawa, Col. 5,

lines 46-60; Col. 2, lines 34-40; Col. 14, lines 36-47). Nakagawa further discloses a 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 (Nakagawa, FIG. 3C and associated text; Col. 6, lines 23-32; Col. 6, lines 47-49), 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. (Nakagawa, Col. 6, lines 37-43; Col. 11, line 50-51, 57-59, 64-68).

Additionally, Suzuki discloses clock means for keeping a predetermined time period after said receiving means receives the transmission (Suzuki, Pgs. 2-4) and interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (*Id.*). (*See* Appendices C and M, Elements 1-11).

(165) Claim 2. Claim 2 depends upon Claim 1. (*See* above). As set forth in Claim 2, Nakagawa discloses second clock means for keeping a second predetermined time period shorter than said predetermined time period counted by said clock means (Nakagawa, Col. 2, lines 34-40; Col. 13, lines 34-42). Nakagawa further discloses alarm means for issuing an alarm when said second clock means counts said second predetermined time period, and thereby informing that interference by said interference means with execution of said executing means will soon be performed. (Nakagawa, Col. 2, lines 34-48; Col. 12, lines 12-22; Col. 14, lines 29-35).

Suzuki further discloses second clock means for keeping a second predetermined time period shorter than said predetermined time period counted by said clock means (Suzuki, Pgs. 3, 5). Suzuki further discloses alarm means for issuing an alarm when said second clock means counts said second predetermined time period, and thereby informing that interference by said interference means with

execution of said executing means will soon be performed. (Suzuki, Pgs. 2-3, 5). (*See* Appendices C and M, Elements 12-15).

(166) Claim 5. Claim 5 depends upon Claim 1. (*See* above.) As set forth in Claim 5, Nakagawa discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (Nakagawa, FIGS. 1, 32; Col. 9, line 54 – Col. 10, line 2; Col. 4, lines 22-27; Col. 2, lines 3-10; Col. 6, lines 16-20). Nakagawa further discloses that said interference means comprises means for blocking the view of what is displayed on said screen. (Nakagawa, Col 9, lines 51-54; Col. 11, lines 40-43; Col. 14, lines 36-47; Col. 15, lines 2-4).

To the extent that it is deemed not explicitly or inherently disclosed therein, in view of Nakagawa's disclosure of interference with execution of the game, interfering with the view of the display would be an obvious modification requiring no technological insight. (*See* Appendices C and M, Elements 18-20).

(167) Claim 7. Claim 7 depends upon Claim 1. (*See* above). As set forth in Claim 7, Nakagawa discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing. (Nakagawa, Col. 9, line 54 – Col. 10, line 2; Col. 4, lines 22-27; Col. 6, lines 16-20). Nakagawa further discloses that said interference means comprises means for preventing said sound generating means from generating the sound.

To the extent that it is deemed not explicitly or inherently disclosed therein, in view of Nakagawa's disclosure of interference with execution of the game, interfering with the sound generating means would be an obvious modification requiring no technological insight. (Nakagawa, Col. 11, lines 50-55; Col. 14, lines 36-47). (*See* Appendices C and M, Elements 21-23).

SNQ JJ. Nakagawa in view of Sanyo

Claim 4 of the ‘520 patent is obvious under 35 § 103(a) over Nakagawa in view of Sanyo.

A substantial new question is raised by Nakagawa in view of Sanyo as to Claim 4 of the ‘520 patent. Neither reference was cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, each is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendices C and L, important in determining whether or not the claims are patentable. In particular, as set forth herein, Nakagawa in view of Sanyo teaches or suggests each and every limitation of Claim 4. For this reason, Nakagawa in view of Sanyo raises a substantial new question of patentability with respect to Claim 4.

The motivation to combine Nakagawa with Sanyo arises from the nature of the problem to be solved: namely, both disclose closely related systems for controlling access to programs based on time of use. Replacing Nakagawa’s system, which disables software after a predetermined time period lapses, with the Sanyo system, which deletes the program, would have been a simple substitution, yielding a predictable result, without undue experimentation.

(168) Claim 4. Claim 4 depends upon Claim 1, which is obvious over Nakagawa. (*See* above). As set forth in Claim 4, Nakagawa further discloses interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (Nakagawa, Col. 5, lines 46-60; Col. 2, lines 34-40; Col. 14, lines 36-47).

In view of this, it would have been an obvious variation that, instead of disabling the software, it could be deleted.

Additionally, Sanyo discloses deletion. (Sanyo, Pgs. 2-3, 9). (*See* Appendices C and L, Elements 16-17).

SNQ KK. Nakagawa in view of Suzuki, in further view of Sanyo

Claim 4 of the ‘520 patent is obvious over Nakagawa in view of Suzuki, in further view of Sanyo.

A substantial new question is raised by Nakagawa in view of Suzuki, in further view of Sanyo as to Claim 4 of the ‘520 patent. None of these references was cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, each is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendices C, M, and L, important in determining whether or not the claims are patentable. In particular, as set forth herein, Nakagawa in view of Suzuki, in further view of Sanyo teaches or suggests each and every limitation of Claim 4. For this reason, Nakagawa in view of Suzuki, in further view of Sanyo raises a substantial new question of patentability with respect to Claim 4.

It would have been obvious to combine Nakagawa with both Suzuki and Sanyo, for the reasons set forth above.

(169) Claim 4. Claim 4 depends upon Claim 1, which is obvious over Nakagawa in view of Suzuki. (*See above*). As set forth in Claim 4, Nakagawa further discloses interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (Nakagawa, Col. 5, lines 46-60; Col. 2, lines 34-40; Col. 14, lines 36-47).

In view of this, it would have been an obvious variation that, instead of disabling the software, it could be deleted.

Additionally, Sanyo discloses deletion. (Sanyo, Pgs. 2-3, 9). (*See Appendices C, M, and L, Elements 16-17*).

SNQ LL. Nakagawa in view of Kaniwa

Claims 5, 7, 12, and 14 of the ‘520 patent are obvious under 35 U.S.C § 103(a) over Nakagawa in view of Kaniwa.

A substantial new question is raised by Nakagawa in view of Kaniwa as to Claims 5, 7, 12, and 14 of the ‘520 patent. Neither reference was cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, each is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendices C and H, important in determining whether or not the claims are patentable. In particular, as set forth herein, Nakagawa in view of Kaniwa teaches or suggests each and every limitation of Claims 5, 7, 12, and 14. For this reason, Nakagawa in view of Kaniwa raises a substantial new question of patentability with respect to Claims 5, 7, 12, and 14.

The motivation to combine Nakagawa with Kaniwa arises from the nature of the problem to be solved: namely, both disclose closely related systems for distributing and controlling access to and usage of licensed software and/or information. Thus, one of ordinary skill in the art would have naturally looked to Kaniwa’s system for limiting access to licensed material to improve upon the system disclosed in Nakagawa, yielding a predictable result, without undue experimentation.

(170) Claim 5. Claim 5 depends upon Claim 1, which is obvious over Nakagawa. (*See* above). As set forth in Claim 5, Nakagawa discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (Nakagawa, FIGS. 1, 32; Col. 9, line 54 – Col. 10, line 2; Col. 4, lines 22-27; Col. 2, lines 3-10; Col. 6, lines 16-20). Nakagawa further discloses that said interference means comprises means for blocking the view of what is displayed on said screen. (Nakagawa, Col. 9, lines 51-54; Col. 11, lines 40-43; Col. 14, lines 36-47; Col. 15, lines 2-4).

To the extent that it is deemed not explicitly or inherently disclosed therein, in view of Nakagawa's disclosure of interference with execution of the game, interfering with the view of the display would be an obvious modification requiring no technological insight.

Additionally, Kaniwa discloses both a display means (Kaniwa, Col. 7, lines 53-62; Col. 8, lines 40-47; Col. 8, lines 1-21; Col. 8, line 22 – Col. 9, line 11; Col. 18, line 39 to Col. 19, line 9; FIGS. 1-2, 12, and 15-16), and interference means for blocking the view of said display (Kaniwa, Col. 19, line 5 – Col. 20, line 4; Col. 21, lines 25-63; FIGS. 12, 15-16). (*See* Appendices C and H, Elements 18-20).

(171) Claim 7. Claim 7 depends upon Claim 1, which is obvious over Nakagawa. (*See* above). As set forth in Claim 7, Nakagawa discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing. (Nakagawa, Col. 9, line 54 – Col. 10, line 2; Col. 4, lines 22-27; Col. 6, lines 16-20). Nakagawa further discloses that said interference means comprises means for preventing said sound generating means from generating the sound.

To the extent that it is deemed not explicitly or inherently disclosed therein, in view of Nakagawa's disclosure of interference with execution of the game, interfering with the sound generating means would be an obvious modification requiring no technological insight. (Nakagawa, Col. 11, lines 50-55; Col. 14, lines 36-47).

Additionally, Kaniwa discloses both sound generating means (Kaniwa, Col. 7, lines 53-62; Col. 8, line 1 – Col. 9, line 11; Col. 18, line 39 – Col. 19, line 9; FIGS. 1-2, 12, 15-16), and interference means for interfering with said sound generating means (Kaniwa, Col. 19, line 5 – Col. 20, line 4; Col. 21, lines 25-63; FIGS. 12, 15-16). (*See* Appendices C and H, Elements 21-23).

(172) **Claim 12.** Claim 12 depends upon Claim 8, which is anticipated by Nakagawa. (*See above*). The analysis with respect to Claim 12 is the same as with respect to Claim 5. (*See above; see also* Appendices C and H, Elements 41-43.)

(173) **Claim 14.** Claim 14 depends upon Claim 8, which is anticipated by Nakagawa. (*See above*). The analysis with respect to Claim 14 is the same as with respect to Claim 7. (*See above; see also* Appendices C and H, Elements 44-46).

SNQ MM. Nakagawa in view of Suzuki, in further view of Kaniwa

Claims 5 and 7 of the ‘520 patent are obvious under 35 U.S.C § 103(a) over Nakagawa in view of Suzuki, in further view of Kaniwa.

A substantial new question is raised by Nakagawa in view of Suzuki, in further view of Kaniwa as to Claims 5 and 7 of the ‘520 patent. None of these references was cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, each is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendices C, M, and H, important in determining whether or not the claims are patentable. In particular, as set forth herein, Nakagawa in view of Suzuki, in further view of Kaniwa teaches or suggests each and every limitation of Claims 5 and 7. For this reason, Nakagawa in view of Suzuki, in further view of Kaniwa raises a substantial new question of patentability with respect to Claims 5 and 7.

It would have been obvious to combine Nakagawa with both Suzuki and Kaniwa, for the reasons set forth above.

(174) **Claim 5.** Claim 5 depends upon Claim 1, which is obvious over Nakagawa in view of Suzuki. (*See above*). As set forth in Claim 5, Nakagawa discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (Nakagawa, FIGS. 1, 32; Col. 9, line 54 – Col. 10, line 2;

Col. 4, lines 22-27; Col. 2, lines 3-10; Col. 6, lines 16-20). Nakagawa further discloses that said interference means comprises means for blocking the view of what is displayed on said screen. (Nakagawa, Col. 9, lines 51-54; Col. 11, lines 40-43; Col. 14, lines 36-47; Col. 15, lines 2-4).

To the extent that it is deemed not explicitly or inherently disclosed therein, in view of Nakagawa's disclosure of interference with execution of the game, interfering with the view of the display would be an obvious modification requiring no technological insight.

Additionally, Kaniwa discloses both a display means (Kaniwa, Col. 7, lines 53-62; Col. 8, lines 40-47; Col. 8, line 1 – Col. 9, line 11; Col. 18, line 39 – Col. 19, line 9; FIGS. 1-2, 12, and 15-16), and interference means for blocking the view of said display (Kaniwa, Col. 19, line 5 – Col. 20, line 4; Col. 21, lines 25-63; FIGS. 12, 15-16). (*See* Appendices C, M, and H, Elements 18-20).

(175) Claim 7. Claim 7 depends upon Claim 1, which is obvious over Nakagawa in view of Suzuki. (*See* above). As set forth in Claim 7, Nakagawa discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing. (Nakagawa, Col. 9, line 54 – Col. 10, line 2; Col. 4, lines 22-27; Col. 6, lines 16-20). Nakagawa further discloses that said interference means comprises means for preventing said sound generating means from generating the sound.

To the extent that it is deemed not explicitly or inherently disclosed therein, in view of Nakagawa's disclosure of interference with execution of the game, interfering with the sound generating means would be an obvious modification requiring no technological insight. (Nakagawa, Col. 11, lines 50-55; Col. 14, lines 36-47).

Additionally, Kaniwa discloses both sound generating means (Kaniwa, Col. 7, lines 53-62; Col. 8, line 1 – Col. 9, line 11; Col. 18, line 39 to Col. 19, line 9; FIGS. 1-2, 12, 15-16), and interference means for interfering with said sound generating means (Kaniwa, Col. 19, line 5 – Col. 20, line 4; Col. 21, lines 25-63; FIGS. 12, 15-16). (*See* Appendices C, M, and H, Elements 21-23).

SNQ NN. Oseki

Claims 5, 7, 12, and 14 of the ‘520 patent are obvious under 35 U.S.C § 103(a) over Oseki.

A substantial new question is raised by Oseki as to Claims 5, 7, 12, and 14 of the ‘520 patent. Oseki was neither cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, it is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendix D, important in determining whether or not the claims are patentable. In particular, as set forth herein, Oseki recites or renders obvious each and every limitation and the claimed invention as a whole of Claims 5, 7, 12, and 14. For this reason, Oseki raises a substantial new question of patentability with respect to Claims 5, 7, 12, and 14.

(176) Claim 5. Claim 5 depends upon Claim 1, which is anticipated by Oseki. (*See* above). As set forth in Claim 5, Oseki inherently discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed, by virtue of disclosing a computer that runs software for a user and receives information from the user to make requests. (*e.g.*, Oseki, Pgs. 4-5).

Otherwise, such a display would have been obvious to one of ordinary skill in the art, understanding the way that computers at the time operated, including a display.

Oseki further inherently discloses that said interference means comprises means for blocking the view of what is displayed on said screen. This disclosure is inherent from the fact that Oseki discloses deleting and/or disabling the program, which would cause it to not be displayed to the user. (Oseki, Pgs. 3-7; Claims 1-2, 5-6, Pgs. 1-2). (*See* Appendix D, Elements 18-20).

(177) Claim 7. Claim 7 depends upon Claim 1, which is anticipated by Oseki. (*See* above). As set forth in Claim 7, Oseki inherently discloses sound generating means for generating a

predetermined sound in accordance with the progress of execution of the program or data processing, by disclosing a computer that runs software from the user. (Oseki, 4-5).

Otherwise, such a display would have been obvious to one of ordinary skill in the art, understanding that computers at the time typically provided sound generation for programs.

Oseki further inherently discloses that said interference means comprises means for preventing said sound generating means from generating the sound. This disclosure is inherent from the fact that Oseki discloses deleting and/or disabling the program, which would cause it to not trigger the sound generating means to generate sound. (Oseki, Oseki, Pgs. 3-7; Claims 1-2, 5-6, Pgs. 1-2). (*See* Appendix D, Elements 21-23).

(178) **Claim 12**. Claim 12 depends upon Claim 8, which is anticipated by Oseki. (*See* above). The analysis with respect to Claim 12 is the same as with respect to Claim 5. (*See* above; *see also* Appendix D, Elements 41-43).

(179) **Claim 14**. Claim 14 depends upon Claim 8, which is anticipated by Oseki. (*See* above). The analysis with respect to Claim 14 is the same as with respect to Claim 7. (*See* above; *see also* Appendix D, Elements 44-46).

SNQ OO. Oseki in view of Suzuki

Claims 2 and 9 of the ‘520 patent are obvious under 35 U.S.C § 103(a) over Oseki in view of Suzuki.

A substantial new question is raised by Oseki in view of Suzuki as to Claims 2 and 9 of the ‘520 patent. Neither reference was cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, each is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendices D and M, important in determining whether or not the claims are patentable. In particular, as set forth herein, Oseki in view of Suzuki teaches or suggests each and

every limitation of Claims 2 and 9. For this reason, Oseki in view of Suzuki raises a substantial new question of patentability with respect to Claims 2 and 9.

The motivation to combine Oseki with Suzuki arises from the nature of the problem to be solved: namely, both disclose closely related systems for controlling access to programs based on time of use. Upgrading Oseki's system, based on time of first use, with Suzuki's system, providing a warning before interference would have been a simple substitution, yielding a predictable result, without undue experimentation.

(180) Claim 2. Claim 2 depends upon Claim 1, which is anticipated by Oseki. (*See above*). As set forth in Claim 2, Suzuki discloses second clock means for keeping a second predetermined time period shorter than said predetermined time period counted by said clock means (Suzuki, Pgs. 3, 5). Suzuki further discloses alarm means for issuing an alarm when said second clock means counts said second predetermined time period, and thereby informing that interference by said interference means with execution of said executing means will soon be performed. (Suzuki, Pgs. 2-3, 5). (*See Appendices D and M, Elements 12-15*).

(181) Claim 9. Claim 9 depends upon Claim 8, which is anticipated by Oseki. (*See above*). The analysis with respect to Claim 9 is the same as with respect to Claim 2. (*See above; see also Appendices D and M, Elements 35-38.*)

SNQ PP. Oseki in view of Kaniwa

Claims 5 and 12 of the '520 patent are obvious under 35 U.S.C § 103(a) over Oseki in view of Kaniwa.

A substantial new question is raised by Oseki in view of Kaniwa as to Claims 5 and 12 of the '520 patent. Neither reference was cited by Applicant, nor cited or considered by Examiner during the original examination of the '520 patent. As such, each is so-called "new art." Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim

charts that follow in Appendices D and H, important in determining whether or not the claims are patentable. In particular, as set forth herein, Oseki in view of Kaniwa teaches or suggests each and every limitation of Claims 5 and 12. For this reason, Oseki in view of Kaniwa raises a substantial new question of patentability with respect to Claims 5 and 12.

The motivation to combine Oseki with Kaniwa arises from the nature of the problem to be solved: namely, both disclose closely related systems for distributing and controlling access to and usage of licensed software and/or information. Thus, one of ordinary skill in the art would have naturally looked to Kaniwa's system for limiting access to licensed material to improve upon the system disclosed in Oseki, yielding a predictable result, without undue experimentation.

(182) Claim 5. Claim 5 depends upon Claim 1, which is anticipated by Oseki. (*See* above). As set forth in Claim 5, Oseki inherently discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed, by virtue of disclosing a computer that runs software for a user and receives information from the user to make requests. (*e.g.*, Oseki, Pgs. 4-5). Otherwise, such a display would have been obvious to one of ordinary skill in the art, understanding the way that computers at the time operated, including a display.

Oseki further inherently discloses that said interference means comprises means for blocking the view of what is displayed on said screen. This disclosure is inherent from the fact that Oseki discloses deleting and/or disabling the program, which would cause it to not be displayed to the user. (Oseki, Pgs. 3-7; Claims 1-2, 5-6, Pgs. 1-2).

Additionally, Kaniwa discloses both a display means (Kaniwa, Col. 7, lines 53-62; Col. 8, line 1 – Col. 9, line 11; Col. 18, line 39 – Col. 19, line 9; FIGS. 1-2, 12, and 15-16), and interference means for blocking the view of said display (Kaniwa, Col. 19, line 5 – Col. 20, line 4; Col. 21, lines 25-63; FIGS. 12, 15-16). (*See* Appendices D and H, Elements 18-20).

(183) **Claim 12.** Claim 12 depends upon Claim 8, which is anticipated by Oseki. (*See* above). The analysis with respect to Claim 12 is the same as with respect to Claim 5. (*See* above; *see also* Appendices D and H, Elements 41-43).

SNQ QQ. Oseki in view of Tsumura

Claims 15, 18-19, and 21 of the ‘520 patent are obvious under 35 U.S.C § 103(a) over Oseki in view of Tsumura.

A substantial new question is raised by Oseki in view of Tsumura as to Claims 15, 18-19, and 21 of the ‘520 patent. Neither reference was cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, each is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendices D and J, important in determining whether or not the claims are patentable. In particular, as set forth herein, Oseki in view of Tsumura teaches or suggests each and every limitation of Claims 15, 18-19, and 21. For this reason, Oseki in view of Tsumura raises a substantial new question of patentability with respect to Claims 15, 18-19, and 21.

It would have been obvious to combine Oseki with Tsumura, as it involves a simple substitution: namely, replacing a system that measures time from the *start* of execution of downloaded content, with one that measures time from the *end* of execution, which can be accomplished without undue experimentation, yielding predictable results.

(184) **Claim 15.** Claim 15 is similar to Claim 1, which is anticipated by Oseki (*see* above), except that it replaces the language “clock means for keeping a predetermined time period after said receiving means receives the transmission” with “clock means for keeping a predetermined time period after said execution means ends the execution of the program or data processing to count a time period during which at least one of the program, the data, and a combination of the program and

data is continuously unused.” Oseki discloses clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing. (Oseki, Pgs. 2, 5, 7).

Tsumura, on the other hand, discloses means for keeping a predetermined time period after said execution means *ends* the execution of the program or data processing to count a time period during which at least one of the program, the data, and a combination of the program and data is continuously unused. (Tsumura, Col. 9, lines 56-65). (*See* Appendices D and J, Elements 47-57).

(185) Claim 18. Claim 18 depends upon Claim 15. (*See* above). As set forth in Claim 18, Oseki further discloses that said interference means comprises means for deleting at least one of the program, the data, and a combination of the program and data stored in said storage means. (Oseki, Oseki, Pgs. 3-7; Claims 1-2, 5-6, Pgs. 1-2). (*See* Appendices D and J, Elements 61-62.)

(186) Claim 19. Claim 19 depends upon Claim 15. (*See* above). As set forth in Claim 19, Oseki inherently discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed, by virtue of disclosing a computer that runs software for a user and receives information from the user to make requests. (*e.g.*, Oseki, Pgs. 4-5).

Otherwise, such a display would have been obvious to one of ordinary skill in the art, understanding the way that computers at the time operated, including a display.

Oseki further inherently discloses that said interference means comprises means for blocking the view of what is displayed on said screen. This disclosure is inherent from the fact that Oseki discloses deleting and/or disabling the program, which would cause it to not be displayed to the user. (Oseki, Pgs. 3-7; Claims 1-2, 5-6, Pgs. 1-2).

Additionally, Tsumura discloses a display for game play (Tsumura, Col. 4, lines 40-52; Col. 8, line 50 – Col. 9, line 3; Col. 6, lines 10-14; Col. 10, line 61 – Col. 11, line 4; FIG. 3.), and

interfering with said display at the termination of a game (*Id.*, Col. 9, lines 56-65). (*See* Appendices D and J, Elements 63-65.)

(187) **Claim 21.** Claim 21 depends upon Claim 15. (*See* above). As set forth in Claim 21, Oseki inherently discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing, by disclosing a computer that runs software from the user. (Oseki, 4-5).

Otherwise, such a display would have been obvious to one of ordinary skill in the art, understanding that computers at the time typically provided sound generation for programs.

Oseki further inherently discloses that said interference means comprises means for preventing said sound generating means from generating the sound. This disclosure is inherent from the fact that Oseki discloses deleting and/or disabling the program, which would cause it to not trigger the sound generating means to generate sound. (Oseki, Oseki, Pgs. 3-7; Claims 1-2, 5-6, Pgs. 1-2).

Additionally, Tsumura discloses sound generating means for game play (Tsumura, Col. 4, lines 40-52; Col. 6, lines 10-14; FIG. 3), and interfering with said display at the termination of a game (*Id.*, Col. 9, lines 56-65). (*See* Appendices D and J, Elements 66-68).

SNQ RR. Oseki in view of Tsumura, in further view of Suzuki

Claim 16 of the ‘520 patent is obvious over Oseki in view of Tsumura, in further view of Suzuki.

A substantial new question is raised by Oseki in view of Tsumura, in further view of Suzuki as to Claim 16 of the ‘520 patent. None of these references was cited by Applicant, nor were any cited or considered by Examiner during the original examination of the ‘520 patent. As such, each is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendices D, J, and M, important in

determining whether or not the claims are patentable. In particular, as set forth herein, Oseki in view of Tsumura, in further view of Suzuki teaches or suggests each and every limitation of Claim 16. For this reason, Oseki in view of Tsumura, in further view of Suzuki raises a substantial new question of patentability with respect to Claim 16.

It would have been obvious to combine Oseki with both Tsumura and Suzuki, for the reasons set forth above.

(188) Claim 16. Claim 16 depends upon Claim 15, which is obvious over Oseki in view of Tsumura. (*See above*) As set forth in Claim 16, Suzuki discloses second clock means for keeping a second predetermined time period shorter than said predetermined time period counted by said clock means (Suzuki, Pgs. 3, 5). Suzuki further discloses alarm means for issuing an alarm when said second clock means counts said second predetermined time period, and thereby informing that interference by said interference means with execution of said executing means will soon be performed. (Suzuki, Pgs. 2-3, 5). (*See* Appendices D, J, and M, Elements 58-60.)

SNQ SS. Oseki in view of Tsumura, in further view of Kaniwa

Claim 19 of the ‘520 patent is obvious over Oseki in view of Tsumura, in further view of Kaniwa.

A substantial new question is raised by Oseki in view of Tsumura, in further view of Kaniwa as to Claim 19 of the ‘520 patent. None of these references was cited by Applicant, nor was any cited or considered by Examiner during the original examination of the ‘520 patent. As such, each is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendices D, J, and H, important in determining whether or not the claims are patentable. In particular, as set forth herein, Oseki in view of Tsumura, in further view of Kaniwa teaches or suggests each and every limitation of Claim 19.

For this reason, Oseki in view of Tsumura, in further view of Kaniwa raises a substantial new question of patentability with respect to Claim 19.

It would have been obvious to combine Oseki with both Tsumura and Kaniwa, for the reasons set forth above.

(189) Claim 19. Claim 19 depends upon Claim 15, which is obvious over Oseki in view of Tsumura. (*See* above). As set forth in Claim 19, Oseki inherently discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed, by virtue of disclosing a computer that runs software for a user and receives information from the user to make requests. (*e.g.*, Oseki, Pgs. 4-5).

Otherwise, such a display would have been obvious to one of ordinary skill in the art, understanding the way that computers at the time operated, including a display.

Oseki further inherently discloses that said interference means comprises means for blocking the view of what is displayed on said screen. This disclosure is inherent from the fact that Oseki discloses deleting and/or disabling the program, which would cause it to not be displayed to the user. (Oseki, Pgs. 3-7; Claims 1-2, 5-6, Pgs. 1-2).

Additionally, Tsumura discloses a display for game play (Tsumura, Col. 4, lines 40-52; Col. 8, line 50 – Col. 9, line 3; Col. 6, lines 10-14; Col. 10, line 61 – Col. 11, line 4; FIG. 3.), and interfering with said display at the termination of a game (*Id.*, Col. 9, lines 56-65).

Additionally, Kaniwa discloses both a display means (Kaniwa, Col. 7, lines 53-62; Col. 8, line 1 – Col. 9, line 11; Col. 18, line 39 – Col. 19, line 9; FIGS. 1-2, 12, and 15-16), and interference means for blocking the view of said display (Kaniwa, Col. 19, line 5 – Col. 20, line 4; Col. 21, lines 25-63; FIGS. 12, 15-16). (*See* Appendices D, J, and H, Elements 63-65).

SNQ TT. Russo

Claims 1-2, 4-5, 7-9, 11-12, and 14 of the ‘520 patent are obvious under 35 U.S.C § 103(a) over Russo.

A substantial new question is raised by Russo as to Claims 1-2, 4-5, 7-9, 11-12, and 14 of the ‘520 patent. Russo was neither cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, it is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendix P, important in determining whether or not the claims are patentable. In particular, as set forth herein, Russo recites or renders obvious each and every limitation and the claimed invention as a whole of Claims 1-2, 4-5, 7-9, 11-12, and 14. For this reason, Russo raises a substantial new question of patentability with respect to Claims 1-2, 4-5, 7-9, 11-12, and 14.

(190) Claim 1. As set forth in Claim 1, Russo discloses 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. (Russo, Col. 3, lines 24-28, 42-46; Col. 6, line 63 – Col. 7, line 23). Russo further discloses an input device for inputting instructions to execute the program or to process the data. (Russo, Col. 3, line 65 – Col. 4, line 5; Col. 9, lines 33-37). Russo further discloses 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. (Russo, Col. 6, lines 54-62; Col. 3, lines 46-48; Col. 4, lines 22-27; Col. 8, line 64 – Col. 9, line 11). Russo further discloses storage means for storing the program, the data, or a combination of the program and data received by said receiving means. (Russo, Col. 4, lines 10-38; Col. 3, lines 3-6; Col. 7, lines 24-44). Russo further discloses 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. (Russo, Col. 9, lines 24-32; Col. 7, lines 16-21). Russo further discloses clock means

for keeping a predetermined time period of free use for the licensed program/data. (Russo, Col. 10, line 63 – Col. 11, line 4). Thus, it would have been obvious to include a clock measuring a predetermined time after receipt.

Russo further discloses interference means for interfering with execution of said executing means after use is complete (Russo, Col. 11, lines 11-15). It would have been an obvious variation to interfere with the executing means, not after use, but after the passing of the predetermined time period set by the system, as set forth above.

Russo further discloses a 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 (Russo, Col. 4, lines 29-35; Col. 3, lines 24-28, 42-46; Col. 6, line 63 – Col. 7, line 23), 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. (Russo, Col. 6, lines 55-58; Col. 8, line 64 – Col. 9, line 11; Col. 4, lines 29-35; Col. 7, lines 3-9). (*See* Appendix P, Elements 1-11).

(191) Claim 2. Claim 2 depends upon Claim 1. (*See* above). As set forth in Claim 2, Russo discloses second clock means for keeping a second predetermined time period shorter than said predetermined time period counted by said clock means (Russo, Col. 10, line 63 – Col. 11, line 4). Russo further discloses alarm means for issuing an alarm when said second clock means counts said second predetermined time period, and thereby informing that interference by said interference means with execution of said executing means will soon be performed. (Russo, Col. 10, line 63 – Col. 11, line 4). (*See* Appendix P, Elements 12-15).

(192) Claim 4. Claim 4 depends upon Claim 1. (*See* above). As set forth in Claim 4, Russo further discloses that said interference means comprises means for deleting at least one of the

program, the data, and a combination of the program and data stored in said storage means. (Russo, Col. 11, lines 11-15). (*See* Appendix P, Elements 16-17).

(193) **Claim 5.** Claim 5 depends upon Claim 1. (*See* above). As set forth in Claim 5, Russo discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (Russo, Col. 3, lines 51-54; Col. 3, line 65 – Col. 4, line 5). Russo further discloses interfering with further use of the program, by deletion. (Russo, Col. 11, lines 11-15).

Russo's disclosure of deleting the program would inherently disclose keeping the program from being displayed and/or from generating sound. Alternatively, such an approach would have been an obvious variation. (*See* Appendix P, Elements 18-20).

(194) **Claim 7.** Claim 7 depends upon Claim 1. (*See* above). As set forth in Claim 7, Russo discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing. (Russo, Col. 6, line 63 – Col. 7, line 3). Russo further discloses interfering with further use of the program, by deletion. (Russo, Col. 11, lines 11-15).

Russo's disclosure of deleting the program would inherently disclose keeping the program from being displayed and/or from generating sound. Alternatively, such an approach would have been an obvious variation. (*See* Appendix P, Elements 21-23).

(195) **Claim 8.** Claim 8 is similar to Claim 1 (*see* above), except that it replaces the language "clock means for keeping a predetermined time period after said receiving means receives the transmission" with "clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing." Russo discloses clock means for keeping a predetermined time period after said executing means starts execution of the program or data

processing. (Russo, Col. 10, line 63 – Col. 11, line 4; Col. 11, lines 11-15). (*See* Appendix P, Elements 24-34).

(196) **Claim 9**. Claim 9 depends upon Claim 8. (*See* above). The analysis with respect to Claim 9 is the same as with respect to Claim 2. (*See* above; *see also* Appendix P, Elements 35-38).

(197) **Claim 11**. Claim 11 depends upon Claim 8. (*See* above). The analysis with respect to Claim 11 is the same as with respect to Claim 4. (*See* above; *see also* Appendix P, Elements 39-40).

(198) **Claim 12**. Claim 12 depends upon Claim 8. (*See* above). The analysis with respect to Claim 12 is the same as with respect to Claim 5. (*See* above; *see also* Appendix P, Elements 41-43).

(199) **Claim 14**. Claim 14 depends upon Claim 8. (*See* above). The analysis with respect to Claim 14 is the same as with respect to Claim 7. (*See* above; *see also* Appendix P, Elements 44-46).

SNQ UU. Russo in view of Suzuki

Claims 1-2, 4-5, 7-9, 11-12, and 14 of the ‘520 patent are obvious under 35 U.S.C § 103(a) over Russo in view of Suzuki.

A substantial new question is raised by Russo in view of Suzuki as to Claims 1-2, 4-5, 7-9, 11-12, and 14 of the ‘520 patent. Neither reference was cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, each is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendices P and M, important in determining whether or not the claims are patentable. In particular, as set forth herein, Russo in view of Suzuki teaches or suggests each and every limitation of Claims 1-2, 4-5, 7-9, 11-12, and 14. For this reason,

Russo in view of Suzuki raises a substantial new question of patentability with respect to Claims 1-2, 4-5, 7-9, 11-12, and 14.

The motivation to combine Russo with Suzuki arises from the nature of the problem to be solved: namely, both disclose closely related systems for distributing and controlling access to and usage of fee-based software. Thus, one of ordinary skill in the art would have naturally looked to Suzuki's system for administering software to improve upon the fee-based system disclosed in Russo, yielding a predictable result, without undue experimentation.

(200) Claim 1. As set forth in Claim 1, Russo discloses 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. (Russo, Col. 3, lines 24-28, 42-46; Col. 6, line 63 – Col. 7, line 23). Russo further discloses an input device for inputting instructions to execute the program or to process the data. (Russo, Col. 3, line 65 – Col. 4, line 5; Col. 9, lines 33-37). Russo further discloses 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. (Russo, Col. 6, lines 54-62; Col. 3, lines 46-48; Col. 4, lines 22-27; Col. 8, line 64 – Col. 9, line 11). Russo further discloses storage means for storing the program, the data, or a combination of the program and data received by said receiving means. (Russo, Col. 4, lines 10-38; Col. 3, lines 3-6; Col. 7, lines 24-44). Russo further discloses 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. (Russo, Col. 9, lines 24-32; Col. 7, lines 16-21). Russo further discloses clock means for keeping a predetermined time period of free use for the licensed program/data. (Russo, Col. 10, line 63 – Col. 11, line 4). Thus, it would have been obvious to include a clock measuring a predetermined time after receipt.

Russo further discloses interference means for interfering with execution of said executing means after use is complete (Russo, Col. 11, lines 11-15). It would have been an obvious variation to interfere with the executing means, not after use, but after the passing of the predetermined time period set by the system, as set forth above.

Additionally, Suzuki discloses clock means for keeping a predetermined time period after said receiving means receives the transmission (Suzuki, Pgs. 2-4) and interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (*Id.*).

Russo further discloses a 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 (Russo, Col. 4, lines 29-35; Col. 3, lines 24-28, 42-46; Col. 6, line 63 – Col. 7, line 23), 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. (Russo, Col. 6, lines 55-58; Col. 8, line 64 – Col. 9, line 11; Col. 4, lines 29-35; Col. 7, lines 3-9). (*See* Appendices P and M, Elements 1-11).

(201) Claim 2. Claim 2 depends upon Claim 1. (*See* above). As set forth in Claim 2, Russo discloses second clock means for keeping a second predetermined time period shorter than said predetermined time period counted by said clock means (Russo, Col. 10, line 63 – Col. 11, line 4). Russo further discloses alarm means for issuing an alarm when said second clock means counts said second predetermined time period, to let the user know that the charge period is soon to begin. (Russo, Col. 10, line 63 – Col. 11, line 4). In view of this, it would be obvious to use this warning to warn of pending interference if program use is interfered with pending the payment of a charge by the user.

Additionally, Suzuki discloses second clock means for keeping a second predetermined time period shorter than said predetermined time period counted by said clock means (Suzuki, Pgs. 3, 5). Suzuki further discloses alarm means for issuing an alarm when said second clock means counts said second predetermined time period, and thereby informing that interference by said interference means with execution of said executing means will soon be performed. (Suzuki, Pgs. 2-3, 5). (*See* Appendices P and M, Elements 12-15).

(202) Claim 4. Claim 4 depends upon Claim 1. (*See* above). As set forth in Claim 4, As set forth in Claim 4, Russo further discloses that said interference means comprises means for deleting at least one of the program, the data, and a combination of the program and data stored in said storage means. (Russo, Col. 11, lines 11-15). (*See* Appendices P and M, Elements 16-17).

(203) Claim 5. Claim 5 depends upon Claim 1. (*See* above). As set forth in Claim 5, Russo discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (Russo, Col. 3, lines 51-54; Col. 3, line 65 – Col. 4, line 5). Russo further discloses interfering with further use of the program, by deletion. (Russo, Col. 11, lines 11-15).

Russo's disclosure of deleting the program would inherently disclose keeping the program from being displayed and/or from generating sound. Alternatively, such an approach would have been an obvious variation. (*See* Appendices P and M, Elements 18-20).

(204) Claim 7. Claim 7 depends upon Claim 1. (*See* above). As set forth in Claim 7, Russo discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing. (Russo, Col. 6, line 63 – Col. 7, line 3.). Russo further discloses interfering with further use of the program, by deletion. (Russo, Col. 11, lines 11-15).

Russo's disclosure of deleting the program would inherently disclose keeping the program from being displayed and/or from generating sound. Alternatively, such an approach would have been an obvious variation. (*See* Appendices P and M, Elements 21-23).

(205) Claim 8. Claim 8 is similar to Claim 1 (*see* above), except that it replaces the language "clock means for keeping a predetermined time period after said receiving means receives the transmission" with "clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing." Russo discloses clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing. (Russo, Col. 10, line 63 – Col. 11, line 4; Col. 11, lines 11-15).

Additionally, to the extent it is deemed not fully disclosed in Russo, Suzuki discloses means for keeping a predetermined time period after said executing means starts execution of the program or data processing. (Suzuki, Pgs. 2-4). (*See* Appendices P and M, Elements 24-34).

(206) Claim 9. Claim 9 depends upon Claim 8. (*See* above). The analysis with respect to Claim 9 is the same as with respect to Claim 2. (*See* above; *see also* Appendices P and M, Elements 35-38).

(207) Claim 11. Claim 11 depends upon Claim 8. (*See* above). The analysis with respect to Claim 11 is the same as with respect to Claim 4. (*See* above; *see also* Appendices P and M, Elements 39-40).

(208) Claim 12. Claim 12 depends upon Claim 8. (*See* above). The analysis with respect to Claim 12 is the same as with respect to Claim 5. (*See* above; *see also* Appendices P and M, Elements 41-43).

(209) Claim 14. Claim 14 depends upon Claim 8. (*See* above). The analysis with respect to Claim 14 is the same as with respect to Claim 7. (*See* above; *see also* Appendices P and M, Elements 44-46).

SNQ VV. Tsumura

Claims 1-2, 5, 7-9, 14-16, 19, and 21 of the ‘520 patent are obvious under 35 U.S.C § 103(a) over Tsumura.

A substantial new question is raised by Tsumura as to Claims 1-2, 5, 7-9, 14-16, 19, and 21 of the ‘520 patent. Tsumura was neither cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, it is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendix J, important in determining whether or not the claims are patentable. In particular, as set forth herein, Tsumura recites or renders obvious each and every limitation and the claimed invention as a whole of Claims 1-2, 5, 7-9, 14-16, 19, and 21. For this reason, Tsumura raises a substantial new question of patentability with respect to Claims 1-2, 5, 7-9, 14-16, 19, and 21.

(210) Claim 1. As set forth in Claim 1, Tsumura discloses 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. (Tsumura, Col. 4, lines 14-18; Col. 1, lines 9-10, 16-18; FIG. 1). Tsumura further discloses an input device for inputting instructions to execute the program or to process the data. (Tsumura, Col. 10, line 61 – Col. 11, line 4; Col. 8, lines 50-60; Col. 9, lines 24-31). Tsumura further discloses 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. (Tsumura, Col. 4, lines 40-52; Col. 7, lines 62-66; Col. 5, lines 54-56; Col. 8, lines 50-60; FIGS. 3, 5). Tsumura further discloses storage means for storing the program, the data, or a combination of the program and data received by said receiving means. (Tsumura, Col. 4, lines 40-52; Col. 5, line 54 – Col. 6, line 9; Col. 1, lines 10-12; Col. 6, lines 28-33; Col. 8, lines 50-60; Col. 9, lines 24-31; Col. 10, line 61 – Col. 11, line 4; FIG. 3). Tsumura further discloses 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. (Tsumura, Col. 4, lines 40-52; Col. 6, lines 9-21, 33-51; Col. 7, lines 1-14; Col. 8, lines 50-60; Col. 9, lines 39-42; Col. 10, line 61 – Col. 11, line 4; Col. 11, lines 60-62; Col. 14, lines 30-38; FIG. 3.). Tsumura further discloses clock means for keeping a predetermined time period until use of the program/data is discontinued, and therefore implicitly or inherently discloses that such time period is measured from the time said receiving means received the software program. (Tsumura, Col. 9, lines 56-65).

Alternatively, in view of Tsumura's disclosure of keeping a predetermined time until use of the program/data is discontinued, measuring this time from receipt would have been an obvious variation, requiring no technological insight.

Tsumura further discloses interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (Tsumura, Col. 9, lines 56-65). Tsumura further discloses a 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 (Tsumura, Col. 4, lines 18-26; FIG. 2), 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. (Tsumura, Col. 4, lines 18-23; Col. 5, lines 18-53; Col. 9, lines 3-10; FIG. 2.). (*See* Appendix J, Elements 1-11).

(211) Claim 2. Claim 2 depends upon Claim 1. (*See* above). As set forth in Claim 2, Tsumura discloses second clock means for keeping a second predetermined time period shorter than said predetermined time period counted by said clock means (Tsumura, Col. 9, lines 56-65). Tsumura further discloses alarm means for issuing an alarm when said second clock means counts

said second predetermined time period, and thereby informing that interference by said interference means with execution of said executing means will soon be performed.

Alternatively, to the extent that Tsumura's disclosure of a warning is not deemed to be an "alarm," using an alarm to warn the user of the upcoming time at which play will be discontinued would have been on obvious variation requiring no technological insight. (Tsumura, Col. 9, lines 56-65). (*See* Appendix J, Elements 12-15).

(212) Claim 5. Claim 5 depends upon Claim 1. (*See* above). As set forth in Claim 5, Tsumura discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (Tsumura, Col. 4, lines 40-52; Col. 8, line 50 – Col. 9, line 3; Col. 6, lines 10-14; Col. 10, line 61 – Col. 11, line 4; FIG. 3). Tsumura further discloses that said interference means comprises means for blocking the view of what is displayed on said screen. (Tsumura, Col. 9, lines 56-65). (*See* Appendix J, Elements 18-20).

(213) Claim 7. Claim 7 depends upon Claim 1. (*See* above). As set forth in Claim 7, Tsumura discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing. (Tsumura, Col. 4, lines 40-52; Col. 6, lines 10-14; FIG. 3). Tsumura further discloses that said interference means comprises means for preventing said sound generating means from generating the sound. (Tsumura, Col. 9, lines 56-65). (*See* Appendix J, Elements 21-23).

(214) Claim 9. Claim 9 depends upon Claim 8, which is anticipated by Tsumura. (*See* above). The analysis with respect to Claim 9 is the same as with respect to Claim 2. (*See* above; *see also* Appendix J, Elements 35-38).

(215) **Claim 14**. Claim 14 depends upon Claim 8, which is anticipated by Tsumura. (*See* above). The analysis with respect to Claim 14 is the same as with respect to Claim 7. (*See* above; *see also* Appendix J, Elements 44-46).

(216) **Claim 15**. Claim 15 is similar to Claim 8, which is anticipated by Tsumura (*see* above), except that it replaces the language “clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing.” with “clock means for keeping a predetermined time period after said execution means ends the execution of the program or data processing to count a time period during which at least one of the program, the data, and a combination of the program and data is continuously unused.” Tsumura discloses clock means for keeping a predetermined time period after said execution means ends the execution of the program or data processing to count a time period during which at least one of the program, the data, and a combination of the program and data is continuously unused. (Tsumura, Col. 9, lines 56-65). (*See* Appendix J, Elements 47-57).

(217) **Claim 16**. Claim 16 depends upon Claim 15. (*See* above). The analysis with respect to Claim 16 is the same as with respect to Claim 2. (*See* above; *see also* Appendix J, Elements 58-60).

(218) **Claim 19**. Claim 19 depends upon Claim 15. (*See* above). The analysis with respect to Claim 19 is the same as with respect to Claim 5. (*See* above; *see also* Appendix J, Elements 63-65).

(219) **Claim 21**. Claim 21 depends upon Claim 15. (*See* above). The analysis with respect to Claim 21 is the same as with respect to Claim 7. (*See* above; *see also* Appendix J, Elements 66-68).

SNQ WW. Tsumura in view of Suzuki

Claims 1-2, 5, 7, and 9 of the ‘520 patent are obvious under 35 U.S.C § 103(a) over Tsumura in view of Suzuki.

A substantial new question is raised by Tsumura in view of Suzuki as to Claims 1-2, 5, 7, and 9 of the ‘520 patent. Neither reference was cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, each is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendices J and M, important in determining whether or not the claims are patentable. In particular, as set forth herein, Tsumura in view of Suzuki teaches or suggests each and every limitation of Claims 1-2, 5, 7, and 9. For this reason, Tsumura in view of Suzuki raises a substantial new question of patentability with respect to Claims 1-2, 5, 7, and 9.

The motivation to combine Tsumura with Suzuki arises from the nature of the problem to be solved: namely, both disclose closely related systems for distributing and controlling access to and usage of fee-based software. Thus, one of ordinary skill in the art would have naturally looked to Suzuki’s system for administering software to improve upon the fee-based system disclosed in Tsumura, yielding a predictable result, without undue experimentation.

(220) Claim 1. As set forth in Claim 1, Tsumura discloses 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. (Tsumura, Col. 4, lines 14-18; Col. 1, lines 9-10, 16-18; FIG. 1). Tsumura further discloses an input device for inputting instructions to execute the program or to process the data. (Tsumura, Col. 10, line 61 – Col. 11, line 4; Col. 8, lines 50-60; Col. 9, lines 24-31). Tsumura further discloses 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. (Tsumura, Col. 4, lines 40-52; Col. 7, lines 62-66; Col. 5, lines 54-56; Col. 8, lines 50-60; FIGS. 3, 5). Tsumura

further discloses storage means for storing the program, the data, or a combination of the program and data received by said receiving means. (Tsumura, Col. 4, lines 40-52; Col. 5, line 54 – Col. 6, line 9; Col. 1, lines 10-12; Col. 6, lines 28-33; Col. 8, lines 50-60; Col. 9, lines 24-31; Col. 10, line 61 – Col. 11, line 4; FIG. 3). Tsumura further discloses 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. (Tsumura, Col. 4, lines 40-52; Col. 6, lines 9-21, 33-51; Col. 7, lines 1-14; Col. 8, lines 50-60; Col. 9, lines 39-42; Col. 10, line 61 – Col. 11, line 4; Col. 11, lines 60-62; Col. 14, lines 30-38; FIG. 3). Tsumura further discloses clock means for keeping a predetermined time period until use of the program/data is discontinued, and therefore implicitly or inherently discloses that such time period is measured from the time said receiving means received the software program. (Tsumura, Col. 9, lines 56-65).

Alternatively, in view of Tsumura's disclosure of keeping a predetermined time until use of the program/data is discontinued, measuring this time from receipt would have been an obvious variation, requiring no technological insight.

Additionally, Suzuki discloses clock means for keeping a predetermined time period after said receiving means receives the transmission (Suzuki, Pgs. 2-4) and interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (*Id.*).

Tsumura further discloses interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (Tsumura, Col. 9, lines 56-65). Tsumura further discloses a 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 (Tsumura, Col. 4, lines 18-26; FIG. 2), 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. (Tsumura, Col. 4, lines 18-23; Col. 5, lines 18-53; Col. 9, lines 3-10; FIG. 2). (*See* Appendices J and M, Elements 1-11).

(221) Claim 2. Claim 2 depends upon Claim 1. (*See* above). As set forth in Claim 2, Tsumura discloses second clock means for keeping a second predetermined time period shorter than said predetermined time period counted by said clock means. (Tsumura, Col. 9, lines 56-65). Tsumura further discloses alarm means for issuing an alarm when said second clock means counts said second predetermined time period, and thereby informing that interference by said interference means with execution of said executing means will soon be performed.

Alternatively, to the extent that Tsumura's disclosure of a warning is not deemed to be an "alarm," using an alarm to warn the user of the upcoming time at which play will be discontinued would have been on obvious variation requiring no technological insight.

Additionally, Suzuki discloses second clock means for keeping a second predetermined time period shorter than said predetermined time period counted by said clock means (Suzuki, Pgs. 3, 5). Suzuki further discloses alarm means for issuing an alarm when said second clock means counts said second predetermined time period, and thereby informing that interference by said interference means with execution of said executing means will soon be performed. (Suzuki, Pgs. 2-3, 5). (*See* Appendices J and M, Elements 12-15).

(222) Claim 5. Claim 5 depends upon Claim 1. (*See* above). As set forth in Claim 5, Tsumura discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (Tsumura, Col. 4, lines 40-52; Col. 8, line 50 – Col. 9, line 3; Col. 6, lines 10-14; Col. 10, line 61 – Col. 11, line 4; FIG. 3). Tsumura further discloses that said interference means comprises means for blocking the

view of what is displayed on said screen. (Tsumura, Col. 9, lines 56-65). (*See* Appendices J and M, Elements 18-20).

(223) **Claim 7.** Claim 7 depends upon Claim 1. (*See* above). As set forth in Claim 7, Tsumura discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing. (Tsumura, Col. 4, lines 40-52; Col. 6, lines 10-14; FIG. 3). Tsumura further discloses that said interference means comprises means for preventing said sound generating means from generating the sound. (Tsumura, Col. 9, lines 56-65). (*See* Appendices J and M, Elements 21-23).

(224) **Claim 9.** Claim 9 depends upon Claim 8, which is anticipated by Tsumura. (*See* above). The analysis with respect to Claim 9 is the same as with respect to Claim 2. (*See* above; *see also* Appendices J and M, Elements 35-38).

SNQ XX. Tsumura in view of Sanyo

Claims 4, 11, and 18 of the ‘520 patent are obvious under 35 U.S.C § 103(a) over Tsumura in view of Sanyo.

A substantial new question is raised by Tsumura in view of Sanyo as to Claims 4, 11, and 18 of the ‘520 patent. Neither reference was cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, each is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendices J and L, important in determining whether or not the claims are patentable. In particular, as set forth herein, Tsumura in view of Sanyo teaches or suggests each and every limitation of Claims 4, 11, and 18. For this reason, Tsumura in view of Sanyo raises a substantial new question of patentability with respect to Claims 4, 11, and 18.

The motivation to combine Tsumura with Sanyo arises from the nature of the problem to be solved: namely, both disclose closely related systems for controlling access to programs based on

time of use. Replacing Tsumura's system, which disables software after a predetermined time period lapses, with the Sanyo system, which deletes the program, would have been a simple substitution, yielding a predictable result, without undue experimentation.

(225) Claim 4. Claim 4 depends upon Claim 1, which is obvious over Tsumura. (*See* above). As set forth in Claim 4, Tsumura discloses interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (Tsumura, Col. 9, lines 56-65).

Deleting the game rather than interfering with it would have been an obvious variation, requiring no technological insight.

Additionally, Sanyo discloses deletion. (Sanyo, Pgs. 2-3, 9). (*See* Appendices J and L, Elements 16-17).

(226) Claim 11. Claim 11 depends upon Claim 8, which is anticipated by Tsumura. (*See* above). The analysis with respect to Claim 11 is the same as with respect to Claim 4. (*See* above; *see also* Appendices J and L, Elements 39-40).

(227) Claim 18. Claim 18 depends upon Claim 15, which is anticipated by Tsumura. (*See* above). The analysis with respect to Claim 18 is the same as with respect to Claim 4. (*See* above; *see also* Appendices J and L, Elements 61-62).

SNQ YY. Tsumura in view of Suzuki, in further view of Sanyo

Claim 4 of the '520 patent is obvious under 35 U.S.C. § 103(a) over Tsumura in view of Suzuki, in further view of Sanyo.

A substantial new question is raised by Tsumura in view of Suzuki, in further view of Sanyo as to Claim 4 of the '520 patent. None of these references was cited by Applicant, nor was any cited or considered by Examiner during the original examination of the '520 patent. As such, each is so-called "new art." Requester submits that a reasonable examiner would consider this teaching, as set

forth below and in the detailed claim charts that follow in Appendices J, M, and L, important in determining whether or not the claims are patentable. In particular, as set forth herein, Tsumura in view of Suzuki, in further view of Sanyo teaches or suggests each and every limitation of Claim 4. For this reason, Tsumura in view of Suzuki, in further view of Sanyo raises a substantial new question of patentability with respect to Claim 4.

It would have been obvious to combine Tsumura with both Suzuki and Sanyo, for the reasons set forth above.

(228) Claim 4. Claim 4 depends upon Claim 1, which is obvious over Tsumura in view of Suzuki. (*See above*). As set forth in Claim 4, Tsumura discloses interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (Tsumura, Col. 9, lines 56-65).

Deleting the game rather than interfering with it would have been an obvious variation, requiring no technological insight.

Additionally, Sanyo discloses deletion. (Sanyo, Pgs. 2-3, 9). (*See* Appendices J, M, and L, Elements 16-17).

SNQ ZZ. 1994 Okamoto Japanese Application in view of Kaniwa

Claims 8-9, 11-12, and 14 of the ‘520 patent are obvious under 35 U.S.C § 103(a) over 1994 Okamoto Japanese Application in view of Kaniwa.

A substantial new question is raised by 1994 Okamoto Japanese Application in view of Kaniwa as to Claims 8-9, 11-12, and 14 of the ‘520 patent. Neither reference was cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, each is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendices Q and H, important in determining whether or not the claims are patentable. In particular, as set forth herein,

1994 Okamoto Japanese Application in view of Kaniwa teaches or suggests each and every limitation of Claims 8-9, 11-12, and 14. For this reason, 1994 Okamoto Japanese Application in view of Kaniwa raises a substantial new question of patentability with respect to Claims 8-9, 11-12, and 14.

(229) Claim 8. As set forth in Claim 8, 1994 Okamoto Japanese Application discloses 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. (1994 Okamoto Japanese Application, Title; Abstract; Claims 1, 3-5; Paras. 6, 10, 14, 16; Fig. 2). 1994 Okamoto Japanese Application further discloses an input device for inputting instructions to execute the program or to process the data. (1994 Okamoto Japanese Application, Claims 1, 4; Paras. 6-7, 22; Fig. 1). 1994 Okamoto Japanese Application further discloses 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. (1994 Okamoto Japanese Application, Claims 1, 3-5, Paras. 6-7, 10, 14, 16; Fig. 6). 1994 Okamoto Japanese Application further discloses storage means for storing the program, the data, or a combination of the program and data received by said receiving means. (1994 Okamoto Japanese Application, Claims 1, 3-4; Paras. 6, 8, 10, 14-16; Fig. 1). 1994 Okamoto Japanese Application further discloses 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. (1994 Okamoto Japanese Application, Abstract; Claims 1, 4; Paras. 6, 8, 15, 17; Fig. 1). 1994 Okamoto Japanese Application further discloses clock means for keeping a predetermined time period after said receiving means receives the program or data. (1994 Okamoto Japanese Application, Claim 3; Paras. 33-34; Fig. 1).

Using the clock means to measure a predetermined time from execution would be an obvious variation.

Kaniwa discloses such a clock means for keeping a predetermined time period after said executing means starts execution of the program or data processing. (Kaniwa, Col. 5, line 57 – Col. 6, line 3; Col. 18, line 39 – Col. 19, line 9; Col. 20, line 63 – Col. 21, line 22; Col. 21, lines 25-59; Col. 22, lines 19-25; Col. 11, line 55 – Col. 12, line 34; Col. 17, lines 61-65; Col. 18, lines 22-38; Col. 19, lines 5-58; Col. 21, line 64 – Col. 22, line 36; Col. 22, line 56 – Col. 24, line 2; FIGS. 12, 15-16).

1994 Okamoto Japanese Application further discloses interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (1994 Okamoto Japanese Application, Claim 3; Paras. 10, 12, 54; Fig. 7). 1994 Okamoto Japanese Application further discloses a 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 (1994 Okamoto Japanese Application, Claims 3, 5; Para. 19; Fig. 2), 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. (1994 Okamoto Japanese Application, Claims 3, 5; Paras. 10, 16, 19-21; Fig. 2). (*See* Appendices Q and H, Elements 24-34).

(230) Claim 9. Claim 9 depends upon Claim 8. (*See* above). As set forth in Claim 9, 1994 Okamoto Japanese Application discloses second clock means for keeping a second predetermined time period shorter than said predetermined time period counted by said clock means. (1994 Okamoto Japanese Application, Paras. 34-35; Fig. 7). 1994 Okamoto Japanese Application further discloses alarm means for issuing an alarm when said second clock means counts said second predetermined time period, and thereby informing that interference by said interference means with execution of said executing means will soon be performed. (1994 Okamoto Japanese Application, Paras. 34-35; Fig. 7). (*See* above; *see also* Appendices Q and H, Elements 35-38).

(231) **Claim 11.** Claim 11 depends upon Claim 8. (*See above*). As set forth in Claim 11, 1994 Okamoto Japanese Application further discloses that said interference means comprises means for deleting at least one of the program, the data, and a combination of the program and data stored in said storage means. (1994 Okamoto Japanese Application, Claim 3; Paras. 10, 12, 54; Fig. 7). (*See Appendix Q and H, Elements 39-40*).

(232) **Claim 12.** Claim 12 depends upon Claim 8. (*See above*). As set forth in Claim 12, 1994 Okamoto Japanese Application discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (1994 Okamoto Japanese Application, Claim 4; Paras. 6, 8, 14-15, 47; Figs. 1, 3-6).

In view of 1994 Okamoto Japanese Application's further disclosure of interference means, blocking the view of what is displayed on said screen would have been an obvious variation, requiring no technological insight.

Additionally, Kaniwa discloses both a display means (Kaniwa, Col. 7, lines 53-62; Col. 8, lines 40-47; Col. 8, lines 1-21; Col. 8, line 22 to Col. 9, line 11; Col. 18, line 39 to Col. 19, line 9; FIGS. 1-2, 12, and 15-16), and interference means for blocking the view of said display (Kaniwa, Col. 19, lines 17-49; Col. 19, line 54 to Col. 20, line 4; Col. 19, lines 5-58; Col. 21, lines 25-63; FIGS. 12, 15-16). (*See Appendix Q and H, Elements 41-43*).

(233) **Claim 14.** Claim 14 depends upon Claim 8. (*See above*). As set forth in Claim 14, 1994 Okamoto Japanese Application discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing. (1994 Okamoto Japanese Application, Claim 4; Paras. 6, 8, 14-15, 47; Fig. 1).

In view of 1994 Okamoto Japanese Application's further disclosure of interference means, preventing said sound generating means from generating the sound would have been an obvious variation requiring no technological insight.

Additionally, Kaniwa discloses both sound generating means (Kaniwa, Col. 7, lines 53-62; Col. 8, lines 40-47; Col. 8, lines 1-21; Col. 8, line 22 to Col. 9, line 11; Col. 18, line 39 to Col. 19, line 9; FIGS. 1-2, 12, 15-16), and interference means for interfering with said sound generating means (Kaniwa, Col. 19, lines 17-49; Col. 19, line 54 to Col. 20, line 4; Col. 19, lines 5-58; Col. 21, lines 25-63; FIGS. 12, 15-16). (*See* Appendix Q and H, Elements 44-46.)

SNQ AAA. 1994 Okamoto Japanese Application in view of Tsumura

Claims 15-16, 18-19, and 21 of the ‘520 patent are obvious under 35 U.S.C § 103(a) over 1994 Okamoto Japanese Application in view of Tsumura.

A substantial new question is raised by 1994 Okamoto Japanese Application in view of Tsumura as to Claims 15-16, 18-19, and 21 of the ‘520 patent. Neither reference was cited by Applicant, nor cited or considered by Examiner during the original examination of the ‘520 patent. As such, each is so-called “new art.” Requester submits that a reasonable examiner would consider this teaching, as set forth below and in the detailed claim charts that follow in Appendices Q and J, important in determining whether or not the claims are patentable. In particular, as set forth herein, 1994 Okamoto Japanese Application in view of Tsumura teaches or suggests each and every limitation of Claims 15-16, 18-19, and 21. For this reason, 1994 Okamoto Japanese Application in view of Tsumura raises a substantial new question of patentability with respect to Claims 15-16, 18-19, and 21.

It would have been obvious to combine 1994 Okamoto Japanese Application with Tsumura, as it involves a simple substitution: namely, replacing a system that measures time from the *start* of execution of downloaded content, with one that measures time from the *end* of execution, which can be accomplished without undue experimentation, yielding predictable results.

(234) Claim 15. As set forth in Claim 15, 1994 Okamoto Japanese Application discloses 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. (1994 Okamoto Japanese Application, Title; Abstract; Claims 1, 3-5; Paras. 6, 10, 14, 16; Fig. 2). 1994 Okamoto Japanese Application further discloses an input device for inputting instructions to execute the program or to process the data. (1994 Okamoto Japanese Application, Claims 1, 4; Paras. 6-7, 22; Fig. 1). 1994 Okamoto Japanese Application further discloses 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. (1994 Okamoto Japanese Application, Claims 1, 3-5, Paras. 6-7, 10, 14, 16; Fig. 6). 1994 Okamoto Japanese Application further discloses storage means for storing the program, the data, or a combination of the program and data received by said receiving means. (1994 Okamoto Japanese Application, Claims 1, 3-4; Paras. 6, 8, 10, 14-16; Fig. 1). 1994 Okamoto Japanese Application further discloses 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. (1994 Okamoto Japanese Application, Abstract; Claims 1, 4; Paras. 6, 8, 15, 17; Fig. 1).

1994 Okamoto Japanese Application further discloses clock means for keeping a predetermined time period after said receiving means receives the program or data. (1994 Okamoto Japanese Application, Claim 3; Paras. 33-34; Fig. 1). In view of this, keeping a predetermined time period after said execution means ends the execution of the program or data processing to count a time period during which at least one of the program, the data, and a combination of the program and data is continuously unused would be an obvious variation requiring no technological insight.

Tsumura, on the other hand, discloses means for keeping a predetermined time period after said execution means *ends* the execution of the program or data processing to count a time period during which at least one of the program, the data, and a combination of the program and data is continuously unused. (Tsumura, Col. 9, lines 56-65).

1994 Okamoto Japanese Application further discloses interference means for interfering with execution of said executing means when said clock means counts said predetermined time period. (1994 Okamoto Japanese Application, Claim 3; Paras. 10, 12, 54; Fig. 7). 1994 Okamoto Japanese Application further discloses a 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 (1994 Okamoto Japanese Application, Claims 3, 5; Para. 19; Fig. 2), 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. (1994 Okamoto Japanese Application, Claims 3, 5; Paras. 10, 16, 19-21; Fig. 2). (*See* Appendices Q and J, Elements 47-57).

(235) Claim 16. Claim 16 depends upon Claim 15. (*See* above). As set forth in Claim 16, 1994 Okamoto Japanese Application discloses second clock means for keeping a second predetermined time period shorter than said predetermined time period counted by said clock means. (1994 Okamoto Japanese Application, Paras. 34-35; Fig. 7). 1994 Okamoto Japanese Application further discloses alarm means for issuing an alarm when said second clock means counts said second predetermined time period, and thereby informing that interference by said interference means with execution of said executing means will soon be performed. (1994 Okamoto Japanese Application, Paras. 34-35; Fig. 7). (*See* Appendices Q and J, Elements 58-60).

(236) Claim 18. Claim 18 depends upon Claim 15. (*See* above). As set forth in Claim 18, 1994 Okamoto Japanese Application further discloses that said interference means comprises means for deleting at least one of the program, the data, and a combination of the program and data stored in said storage means. (1994 Okamoto Japanese Application, Claim 3; Paras. 10, 12, 54; Fig. 7). (*See* Appendices Q and J, Elements 61-62.)

(237) **Claim 19.** Claim 19 depends upon Claim 15. (*See above*). As set forth in Claim 19, 1994 Okamoto Japanese Application discloses that said communication terminal device comprises display means having a screen on which the progress of execution of the program or data processing is displayed. (1994 Okamoto Japanese Application, Claim 4; Paras. 6, 8, 14-15, 47; Figs. 1, 3-6).

In view of 1994 Okamoto Japanese Application's further disclosure of interference means, means for blocking the view of what is displayed on said screen would have been an obvious variation, requiring no technological insight.

Additionally, Tsumura discloses a display for game play (Tsumura, Col. 4, lines 40-52; Col. 8, line 50 – Col. 9, line 3; Col. 6, lines 10-14; Col. 10, line 61 – Col. 11, line 4; FIG. 3.), and interfering with said display at the termination of a game (*Id.*, Col. 9, lines 56-65). (*See Appendices Q and J, Elements 63-65.*)

(238) **Claim 21.** Claim 21 depends upon Claim 15. (*See above.*) As set forth in Claim 21, 1994 Okamoto Japanese Application discloses sound generating means for generating a predetermined sound in accordance with the progress of execution of the program or data processing. (1994 Okamoto Japanese Application, Claim 4; Paras. 6, 8, 14-15, 47; Fig. 1).

In view of 1994 Okamoto Japanese Application's further disclosure of interference means, preventing said sound generating means from generating the sound would have been an obvious variation requiring no technological insight.

Additionally, Tsumura discloses sound generating means for game play (Tsumura, Col. 4, lines 40-52; Col. 6, lines 10-14; FIG. 3), and interfering with said display at the termination of a game (*Id.*, Col. 9, lines 56-65). (*See Appendices Q and J, Elements 66-68.*)

VIII. CONCLUSION

For at least the reasons set forth above, it is clear that this Request raises new questions of patentability in connection with Claims 1-2, 4-5, 7-9, 11-12, 14-16, 18-19 and 21 of the '520 patent, because Claims 1-2, 4-5, 7-9, 11-12, 14-16, 18-19 and 21 are invalid in view of the prior art references. Therefore, it is respectfully requested that this Request be granted and that Claims 1-2, 4-5, 7-9, 11-12, 14-16, 18-19 and 21 of the '520 patent be finally rejected.

Respectfully submitted,

KLARQUIST SPARKMAN, LLP

One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204
Telephone: (503) 595-5300
Facsimile: (503) 595-5301

By /Joseph T. Jakubek/
Joseph T. Jakubek
Registration No. 34190

Corrected Certificate of Service in Compliance With 37 C.F.R. § 1.510(b)(5)

The undersigned certifies that copies of the Request for *Ex Parte* Reexamination, and Exhibits 1-24 and Appendices A-Q thereto were served on the purported owner of the patent at the last address of record:

ADC Technology, Inc.
c/o Davis and Bujold
Fourth Floor
500 N. Commercial Street
Manchester, NH 03101

and on counsel for ADC in the Litigation:

ADC Technology, Inc.
c/o Whitaker Law Group
1420 Fifth Avenue, Suite 2200
Seattle, WA 98101

in accordance with 37 C.F.R. § 1.510(b)(5), on the 4th day of September, 2009.

Respectfully submitted,

KLARQUIST SPARKMAN, LLP

One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204
Telephone: (503) 595-5300
Facsimile: (503) 595-5301

By /Joseph T. Jakubek/
Joseph T. Jakubek
Registration No. 34190