IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: **Takeya Okamoto**	)	Title:	**Interactive Communication System for Communicating Video Game and Karaoke Software**
Control Nos.: **90/009,521 & 95/001,234**	)	Patent No.:	**6,488,508**
	)	Art Unit:	**3992**
Reexam Filed: **08/17/2009**	)	Examiner:	**William H. Wood**

AMENDMENT AND RESPONSE

Mail Stop "Inter Partes Reexam"
Attn: Central Reexamination Unit
Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a MERGED *ex parte* reexamination (proceeding 90/009,521) of U.S. Patent No. 6,488,508 (hereafter the '508 Patent) requested by patent owner for claims 1-7 and *inter partes* reexamination (proceeding 95/001,234) requested by a third party for claims 1-7.

This paper is responsive to the Action Closing Prosecution ("ACP") mailed April 19, 2013. Please enter the following claim amendments and consider the appended remarks.

Claim amendments begin on Page 2 of this paper.

Remarks begin on Page 8 of this paper.

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Signed: _____
John Whitaker

Dated: May 20, 2013

IN THE CLAIMS

Please amend the claims as follows:

1. (Original) A software distributing system for transmitting at least one of the program, the data, and a combination of the program and data stored in a database provided in a distribution center to a requested communication terminal device via communication lines, storing the transmitted program, the data, and the combination of the program and data in a memory provided in the communication terminal device, and enabling execution of the program or data processing according to the program, the data, and the combination of the program and data in the memory, said distribution center comprising:

means for transmitting the program, the data, or the combination of the program and data at the request of said communication terminal device to said communication terminal device; and

means for charging a use fee on the use of the transmitted program, the data, or the combination of the program and data in said communication terminal device and for direct debit against an account in a banking institution.

2. (Original) A software distributing system according to claim 1, wherein said charging of the use fee is varied in accordance with the newness of the program, the data, and the combination of the program and data.

3. (Amended) A game information distribution system for transmitting game information stored in a game software database provided in a distribution center to a requested communication terminal device via communication lines, transmitting the game information to at least another communication terminal device to facilitate interactive communication between the at least two communication terminal devices regarding the game information; storing the game information in a memory provided in the respective communication terminal device, and enabling game play in accordance with the game information stored in the memory of the respective communication terminal device,

said distribution center comprising:

means for transmitting the game information at the request of said communication terminal device to said respective communication terminal device; and

means for charging a use fee on the use of the transmitted game information in said respective communication terminal device and for direct debit against an account in a banking institution, wherein the game information comprises game data and the at least two communication terminal devices display the number of players who can participate in the game play.

4. (Amended) A karaoke information and movie data distribution system for transmitting karaoke information stored in a karaoke database and movie data stored in another database provided in a distribution center to a requested communication terminal device via communication lines, storing the karaoke information or the movie data in a memory provided in the communication terminal device, and enabling karaoke music play in accordance with the karaoke information stored in the memory,

said distribution center comprising:

means for transmitting the karaoke information or the movie data at the request of said communication terminal device to said communication terminal device; and

means for charging a use fee on the use of the transmitted karaoke information or the transmitted movie data in said communication terminal device and for direct debit against an account in a banking institution, wherein the use fee is varied in accordance with the newness of the karaoke information or the movie data and the karaoke information comprises word data and accompaniment data associated with a song.

5. (Original) A method of software distribution for transmitting at least one of the program, the data, and a combination of the program and data stored in a database provided in a distribution center to a requested communication terminal device via communication lines, storing the transmitted program, the data, and the combination of the program and data in a memory provided in the communication terminal device; and enabling execution of the program or data processing according to the program, the data, and the combination of the program and data in the memory, said method comprising the steps of:

transmitting the program, the data, or the combination of the program and data at the request of said communication terminal devices to said communication terminal device; and

charging a use fee on the use of the transmitted program, the data, and the combination of the program and data in said communication terminal device and for direct debit against an account in a banking institution.

6. (Amended) A method for game information distribution for transmitting game information stored in a game software database provided in a distribution center to a requested communication terminal device via communication lines, transmitting the game information to at least another communication terminal device to facilitate interactive communication between the at least two communication terminal devices regarding the game information, storing the game information in a memory provided in the respective communication terminal device, and enabling game play in accordance with the game information stored in the memory of the respective communication terminal device, said method comprising the steps of:

transmitting the game information at the request of said communication terminal device to said respective communication terminal device; and

charging a use fee on the use of the transmitted game information in said respective communication terminal device and for direct debit against an account in a banking institution, wherein the game information comprises game data.

7. (Amended) A method for karaoke information distribution for transmitting karaoke information stored in a karaoke database and for movie data distribution for transmitting movie data stored in another database provided in a distribution center to a requested communication terminal device via communication lines, storing the karaoke information or the movie data in a memory provided in the communication terminal device, and enabling karaoke music play in accordance with the karaoke information stored in the memory, said method comprising the steps of:

transmitting the karaoke information or the movie data at the request of said communication terminal device to said communication terminal device; and

charging a use fee on the use of the transmitted karaoke information or the transmitted movie data in said communication terminal device and for direct debit against an account in a banking institution, wherein the karaoke information comprises word data and accompaniment data associated with a song.

8. (New) The software distributing system according to claim 2, wherein newness depends on a length of time the program, the data, or the combination of the program and data has been in the market.

9. (New) The software distributing system according to claim 2, wherein the use fee is charged when the at least one of the program, the data, and combination of the program and data is downloaded.

10. (New) The software distributing system according to claim 2, wherein the communication terminal device displays a scrollable list for selecting the at least one of the program, the data, and the combination of the program and data.

11. (New) The game information distribution system according to claim 3, wherein the use fee is charged when the game information is downloaded.

12. (New) The game information distribution system according to claim 3, wherein the communication terminal device displays a scrollable list for selecting the game information.

13. (New) The game information distribution system according to claim 3, wherein the game data comprises map data.

14. (New) The karaoke information and movie data distribution system according to claim 4, wherein the use fee is charged when the karaoke information or the movie data is downloaded.

15. (New) The method of software distribution according to claim 5, wherein the program comprises a video game.

16. (New) The method of software distribution according to claim 5, wherein the data comprises karaoke information.

17. (New) The method of software distribution according to claim 5, wherein the data comprises a movie.

18. (New) The method of software distribution according to claim 17, wherein the use fee is varied in accordance with the newness of the transmitted program, the data, or the combination of the program and the data.

19. (New) The method of software distribution according to claim 18, wherein the newness depends on a length of time the transmitted program, the data, or the combination of the program and data has been in the market.

20. (New) The method of software distribution according to claim 5, wherein the use fee is charged when the at least one program, the data, and the combination of the program and data is downloaded.

21. (New) The method for game information distribution according to claim 6, wherein the game data comprises map data.

22. (New) The method for game information distribution according to claim 21, wherein the game play comprises a role-playing game.

23. (New) The method for game information distribution according to claim 21, wherein the game information comprises advanced game data related to the game play.

24. (New) The method for game information distribution according to claim 23, wherein the advanced game data comprises additional map data related to the game play.

25. (New) The method for game information distribution according to claim 23, wherein transmitting the advanced game data occurs after completing an event during the game play.

26. (New) A method for game information distribution according to claim 6, wherein the at least two communication terminal devices display the number of players who can participate in the game play.

27. (New) The method for game information distribution according to claim 6, wherein the use fee is charged when the game information is downloaded.

28. (New) The method for game information distribution according to claim 6, wherein the game data comprises position data of characters in the game play for the respective communication terminal devices.

29. (New) The method for karaoke information and movie data distribution according to claim 7, wherein the use fee is charged when the karaoke information or the movie data is downloaded.

30. (New) The method for karaoke information and movie data distribution according to claim 7, wherein the movie data comprises video and audio information of a satellite television service.

31. (New) A software distributing system recited in claim 1, wherein the data is related to the program in the combination of program and data.

REMARKS

Claims 1-7 of the '508 Patent are subject to the present reexamination proceeding. Claims 1, 3-7 stand rejected either as anticipated or obvious in view of the art of record. Claim 2 was confirmed in a prior Office Action but has been rejected in the latest Office Action.

Claims 3-4, and 6-7 have been amended and new claims 8-31 have been added by amendment in this paper. Claims 1-2 and 5 are unamended. Support for the amended claims and the new claims is as set forth below.

No additional independent claim has been added. The total number of claims is 31. Patent Owner has previously paid for 31 total claims.

Response to Rejections

The following arguments are organized to reduce redundancy. Therefore, the following remarks are organized to address the patentable features of the claimed inventions, and then the relevant cited art is analyzed. The Patent Owner maintains the arguments presented in prior responses, but emphasizes the following arguments with respect to the comments made by the third party requester (TPR) and adopted by the Examiner in the Action Closing Prosecution (ACP).

A. "Program, Data, or Combination of Program and Data" Claim Element

As-issued independent Claims 1 and 5 recite "transmitting the program, the data, or a combination of the program and data at the request of said communication terminal device." In the previous response, Patent Owner pointed out that this claim element is not found in the cited art of record. The ACP indicates that Patent Owner's arguments are not persuasive. However, the position stated in the ACP is conclusory and contrary to well-settled law.

1. *Every* Claim Element Must Be Considered

As pointed out by Patent Owner previously, for a claim element to be disclosed by the prior art, "[t]here must be no difference between the claimed invention and the reference

disclosure." *Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991). The ACP (pg 52) states that "it is irrelevant whether 'the '508 Patent itself distinguishes between 'program' and 'data' and further teaches 'combination of the program and data" because, according to the ACP, ***only one*** of these elements needs to be shown. This interpretation completely ignores that the claim also recites "transmitting the program, the data, or the combination of the program and data *at the request of said communication terminal device*." In order for the communication terminal device to be able to request the program, the data, or the combination of the program and data, ***all three must be available***. For example, if there is a device that dispenses coffee, milk, and combination of coffee and milk at the request of a user. The device indeed can only dispense one (e.g., at least one) at the request of the user. Upon request, the user will either get coffee, will get milk, or will get a combination of coffee and milk. Therefore, the Patent Owner's arguments are not contrary to a plain English interpretation.

The ACP attempts to overcome this apparent distinction by suggesting that the claim does not require all three elements. The ACP adopts the TPR's argument that where the claim requires the transmission of *at least one* of three separate elements, that claim is met by a system which is capable of transmitting ***only one*** of those three elements. However, that interpretation of the claim language is simply wrong. Claim terms are not interpreted in a vacuum, devoid of the context of the claim as a whole. See *Hockerson-Halberstadt, Inc. v. Converse Inc.*, 183 F.3d 1369, 1374 (Fed. Cir. 1999) ("proper claim construction ... demands interpretation of the entire claim in context, not a single element in isolation."); *ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1088 (Fed. Cir. 2003) ("While certain terms may be at the center of the claim construction debate, the context of the surrounding words of the claim also must be considered....").

The ACP's conclusion that ***only one*** of the ***three*** claim elements need be shown in the prior art in order to sustain a rejection under Section 102 is flatly wrong. *Matsuda* does not teach

"transmitting the program, the data, or the combination of the program and data at the request of said communication device" as recited by the claims. Accordingly, the rejection is improper and should be withdrawn.

The ACP on page 52 then generally states that "Matsuda shows all these elements." The Patent Owner respectfully disagrees with this position. Rather, *Matsuda* explicitly teaches:

> an information center holding various kinds of information data including game information, educational information, video information, and audio information and corresponding to a current rental store such as a game rental store, a video rental store, or an audio rental store, for example.
>
> *Matsuda*, at page2 5-6.

Thus, the teachings of *Matsuda* limit the information stored in the information center to data that "corresponds to a ***current*** rental store." The Office Action cites nothing to support or suggest that any rental store current at the time the *Matsuda* reference was filed would support the notion that a *combination* of program and data or either the program or the data could be rented either electronically or otherwise.

In addition, the "data" disclosed in *Matsuda* includes various kinds of information data, index data, and code numbers attached to the stored information data. The index data denotes the creator of that software, the main performer, and other cast, and the story. For example, if the information data is audio software, the index data denotes the composer and performers (*Matsuda* on pgs 6-7). There is no indication in *Matsuda* that a **communication terminal device would request** the index data, or the code numbers. Therefore, the 'data' relied on by the ACP and TPR does not teach or suggest the 'data' or 'the combination of the program and data' as recited in the claims. In contrast, the 'data' recited in the claims is requested by the communication terminal device, and not merely some arbitrary other data that is part of data downloaded. For example, in the embodiment described in Column 8, lines 28 to 35 of the

instant patent, when the game progresses and the player wishes to play on a more advanced map data, the player purchases and downloads the advanced map data.

Therefore, ACP's conclusion that only *one* of the *three* claim elements need be shown in the prior art in order to sustain a rejection under Section 102 is flatly wrong. In addition, ACP's argument that *Matsuda* teaches all three claim elements is wrong. As discussed above, *Matsuda* does not teach "transmitting the program, the data, or the combination of the program and data at the request of said communication terminal device" as recited by the claims. Accordingly, the rejection is improper and should be withdrawn.

2. The Claim Must Be Construed In View Of The Specification

Even more surprising is the ACP's suggestion that the teachings of the '508 Patent specification are "irrelevant." That statement could not possibly be more wrong. Countless are the Federal Circuit decisions which hold exactly the opposite. A claim *must* be construed in view of the teachings of the specification and *not* in a lexicographic vacuum. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301 (Fed. Cir. 1999) (claims are not construed in a "lexicographic vacuum, but in the context of the specification and drawings"). For at least this additional reason, the ACP's justification for maintaining this rejection is fatally flawed as being diametrically opposed to well settled law.

The '508 Patent specification distinguishes between "program" and "data" and further teaches a "combination of the program and data." At column 4, lines 21-25, the '508 Patent states that a "combination of program and data" may be transmitted in *addition* to either the program or the data:

> Transmitting a combination of the program and data means, for instance, transmitting a karaoke executing program and the data indicative of karaoke music to be played, or a set of a word processing program and the data indicative of document examples.

Accordingly, in the context of the '508 Patent, the claimed invention must be capable of "transmitting the program, the data, or the combination of the program and the data at the request of said communication terminal device." This claim element is not met by ***merely transmitting arbitrary other data along with the requested information*** as taught in *Matsuda* Instead, the program, the data, or the combination of the program and data is requested for transmission as recited in the claim.

The ACP makes no attempt even to address this teaching. Instead, both the ACP and the TPR attempt to "hand wave" this teaching by arguing that it is "irrelevant" or not required by the claim. However, the claim language speaks for itself. The cited elements are in the claims, it is given meaning by the teachings of the specification, and those teachings *must* be considered. The rejection is improper and it should be withdrawn.

3. The Additional Art Does Not Remedy *Matsuda's* Failings

The ACP also cites additional prior art that had been previously presented earlier in prosecution. More specifically, the ACP cites, independently and in various combinations, *Bush*, *Tsumura*, and *Rhoades* against independent claims 1 and 5 as teaching the "program, data, or combination of program and data" element. However, as shown here, none of those additional references overcomes the failings of *Matsuda*. Accordingly, none of the art of record teaches the claim limitation of "transmitting the program, the data, or the combination of the program and data at the request of said communication terminal device" as recited by the claims. Accordingly, the rejections are improper and should be withdrawn.

(a) *Bush*

The title for *Bush* is "Pay Per View Entertainment System." According to the Abstract, in a pay per view entertainment system, recorded entertainment such as musical works are distributed to subscribers over a cable network. Pay per view systems are quite different than on-

demand systems. Pay per view systems determine the programming of prerecorded entertainment (col. 2, lines 45-46) and provide the same prerecorded programmed entertainment to all subscribers (col. 2, lines 48-50). The prerecorded programmed entertainment includes previews and the entire musical works (col. 1, lines 56-64). When a user wants to record an entire musical work, a selection is made and the musical work is recorded on a cassette (col. 4, lines 7-11, col. 6, lines 11-48). In contrast to the pay per view entertainment system disclosed in *Bush*, the claims in the present reexamination recite "***transmitting*** the program, the data, or the combination of the program and data ***at the request of said communication terminal device***." This element is quite different than the pay per view system disclosed in *Bush* in which the same data (i.e., prerecorded programmed entertainment) is transmitted to all the subscribers and there is no request to transmit any program, data, or combination of the program and data. Thus, for at least this reason, the claims are patentable over *Bush*.

In addition, as described above in Section A1 and A2 with respect to *Matsuda*, *Bush* also does not disclose the program, the data, or the combination of the program and data claim element. *Bush* describes a pay per view system for musical works, and then mentions that the system could include video recordings or computer software. However, contrary to TPR and the ACP's logic, the mere mention of video recordings or computer software, does not remedy Bush's failure to teach or suggest the program, the data, or the ***combination*** of the program and data. Furthermore, there is no teaching or suggestion in *Bush* regarding "***transmitting*** the program, the data, or the combination of the program and data ***at the request of said communication terminal device***." Accordingly, *Bush* does not anticipate any of the claims and also does not overcome the failings of *Matsuda*.

(b) *Tsumura*

Tsumura is directed at a receiving device on which computer games can be played. The receiving device accepts numerous game data transmitted cyclically by the transmission device, selects and stores specified game data and is used to play the game. Nothing in Tsumura teaches anything except transmitting game data (i.e., there is no request to transmit anything). See, generally, *Tsumura* abstract. Rather, *Tsumura* teaches transmitting game data, apparently in one direction only (see col. 5, lines 7-9) and enabling game play (see col. 5, lines 13-17). Nowhere is there even a hint that "program, data, or a combination of program and data" may be requested to be transmitted. Accordingly, *Tsumura* does not overcome the failings of *Matsuda*.

(c) *Rhoades*

In general, *Rhoades* is directed at a digital, interactive communication system designed to provide a plurality of remote subscribers with any one of a variety of stored information service software packages. *Rhoades* discloses at Col. 6, lines 5-7 that a video game software program may be selected. However, *Rhoades* fails to disclose, or even suggest, downloading either "program, data, or a combination of program and data." In fact, it appears that at best *Rhoades* only discloses that the video game software program itself is downloaded and fails to disclose or suggest even transmitting just game data. Accordingly, *Rhoades* does not overcome the failings of *Matsuda*.

The art of record, either alone or in any combination at all, fails to disclose *any* system that is capable of transmitting either a program, or data, *or* a program in combination with data. Accordingly, the limitation of "transmitting the program, the data, and a combination of the program and data" is neither taught nor suggested in the prior art. For at least this reason, Claims 1 and 5 are allowable over the art of record.

B. Patent Owner Maintains and Restates Its Earlier Arguments

Patent Owner reiterates and restates its earlier arguments here for the purpose of preserving these issues for appeal. In short, Patent Owner believes that the ACP has not carried its burden of demonstrating that the subject claim limitations are taught or suggested by the art of record. Accordingly, the remaining claims are patentable and the rejections should be withdrawn.

1. "Facilitate interactive communication" Claim Element

The Examiner has adopted the TPR's argument (AG) that "transmitting...to at least another communication terminal device to facilitate interactive communication between the at least two communication terminal devices" is taught by *Tashiro*. However, the system taught by *Tashiro* falls short of teaching a system through which rented software, such as a game, can be downloaded and then played in an interactive fashion. Rather, the Office Action merely suggests that it would have been obvious to combine *Tashiro* with *Matsuda* out of a motivation for commercial success. *Id.*

The Examiner acknowledges that *Matsuda* does not teach or suggest "transmitting the game information to at least another terminal device to facilitate interactive communication between the at least two communication terminal devices regarding the game information." However, the Examiner contends that *Tashiro* demonstrates having multiple terminals engaged in interactive game play and thereby suggests "transmitting the game information to at least another terminal device to facilitate interactive communication between the at least two communication terminal devices regarding the game information." The Patent Owner disagrees with this position and contends that the Examiner has mischaracterized the teachings of *Tashiro*. For convenience, Claim 3 is copied below with emphasis added:

> 3. A **game information distribution system** for **transmitting game information stored in a game software database provided in a distribution**

> **center** to **a requested communication terminal device** via communication lines, **transmitting the game information to at least another communication terminal device to facilitate interactive communication between the at least two communication terminal devices regarding the game information**; storing the game information in a memory provided in the respective communication terminal device, and **enabling game play in accordance with the game information** stored in the memory of the respective communication terminal device,
>
> said distribution center comprising:
>
> means for **transmitting the game information at the request** of said communication terminal device to said respective communication terminal device; and
>
> means for **charging a use fee on the use of the transmitted game information** in said respective communication terminal device and for **direct debit against an account in a banking institution**, wherein the game information comprises game data and the at least two communication terminal devices display the number of players who can participate in the game play.

Tashiro discloses coin-operated game machines and discloses a video game that is pre-loaded on each coin-operated game machine. The pre-loaded video game is not transmitted to the coin-operated game machine by a "game information distribution system."

The Examiner has already acknowledged that *Matsuda* does not teach or suggest "transmitting the game information to at least another terminal device to facilitate interactive communication between the at least two communication terminal devices regarding the game information." *Tashiro* fails to remedy this lack of disclosure. As recited in the claim, the game information is stored in a game software database provided in a "distribution center." At the request of a communication terminal device, the distribution center transmits the game information to the respective communication terminal device.

Furthermore, Claim 3 recites "the game information comprises game data." Neither *Matsuda* nor *Tashiro* teach or suggest transmitting game data stored in a distribution center to a

respective communication terminal device. As argued above in Section A, the '508 Patent states that when a game (e.g., program) progresses and the player wishes to play on a more advanced map data, the player purchases and downloads the advanced map data (e.g., data). Column 8, lines 34-38, of the '508 Patent states:

> Map data of a role-playing game may be divided according to the progress degree of the story and the divided map data be sold separately. When the game progresses and the player wishes to play on a more advanced map data, the player purchases and downloads the advanced map data.

The Examiner is mischaracterizing "transmission data" taught in *Tashiro* for teaching this limitation. However, the "transmission data" taught in *Tashiro* includes "game state data" and "data identification codes." Col. 3, lines 20-24. The "game state data" is data representative of the progress of the game in each of the game machines and "data identification codes" are used to specify a game machine corresponding to the game state data. Col. 3, lines 24-27. Neither the "game state data" nor the "data identification codes" are stored in a game information distribution system and transmitted to a communication terminal device upon request and then charged a use fee on the use of the transmitted game data as recited in Claim 3. Therefore, neither *Matsuda* nor *Tashiro* teach or suggest "transmitting the game information to at least another communication terminal device to facilitate interactive communication between the at least two communication terminal devices regarding the game information."

In addition, *Matsuda* and *Tashiro* cannot be properly combined because nothing in *Tashiro* suggests that any game information can be downloaded, nor does anything in *Matsuda* suggest that a game may be played cooperatively. There is no motivation at all to combine, despite the Office Action's conclusory statement that commercial success alone is somehow a sufficient suggestion to combine, given that the Office does not indicate from where such knowledge of commercial success would come. The Office fails to identify any actual commercial success that would justify its supposed motivation to combine. A mere conclusory

statement without evidence is insufficient to support an obviousness objection. *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007) (quoting Federal Circuit statement with approval). Neither *Tashiro* nor *Matsuda* teach or suggest the recited claim elements.

The ACP points out that Patent Owner did not address the *Sanbe* reference, and suggests that *Sanbe* and *Matsuda* is a proper and obvious combination. ACP at page 56. However, a combination of *Sanbe* with *Matsuda* is far from either proper or obvious. Indeed, making the conclusory statement that two references can be combined falls fatally short of actually demonstrating that they even *could* be combined. In fact, nothing in *Sanbe* or *Matsuda* suggests such a combination.

Matsuda is a system for electronically transmitting information to a remote location that would otherwise reside at a rental store. The information is then stored at the remote location. See Matsuda at page 7, lines 10-15, page 8 lines 20-27. In contrast, *Sanbe* teaches that karaoke data is centrally stored on a "large hard disk storage device." *Sanbe* at page 945, col. 2. That karaoke data is merely "reproduced" (not stored) on a remote "karaoke reproduction device" for display at a user's home or business. *Sanbe* at page 947, col. 1. Nothing in *Sanbe* suggests renting or storing any data locally (it is only rendered in RAM), and nothing in *Matsuda* teaches or suggests a remote karaoke system. In short, there appears to be no reason to combine the two references other than the ACP's conclusory statement that it could be done. Such a lack of motivation or even reason to combine references is improper. See *In Re Ravi Vaidyanathan*, No. 2009-1404 (Fed. Cir. 2010)(holding that an obviousness rejection requires a reviewable explanation of the evidence and rationale behind the rejection).

For at least these reasons, Claims 3 and 6 are patentable over the prior art of record.

2. "Karaoke information and movie data" Claim Element

Claims 4 and 7 both recite "karaoke information and movie data" that are stored in different databases, and that are both transmitted to a communication terminal device. Almost in passing, the Office Action states that Matsuda teaches storing karaoke information and movie data in different databases. See Office Action at page 28. However, an examination of Matsuda reveals just the opposite. First, nowhere does *Matsuda* teach storing karaoke information and movie data in different databases and making them both available through the same distribution system. In fact, *Matsuda* does not teach even one of any of those three elements. *Matsuda* does not teach storing karaoke information at all. *Matsuda* does not teach storing actual movie data, although Matsuda does teach storing "video information." Nor does *Matsuda* teach storing any information of any kind in *separate* databases.

For a claim to be anticipated by the prior art, "[t]here must be no difference between the claimed invention and the reference disclosure." *Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991). To that end, the failure of the *Matsuda* reference to teach even one of the elements for which it is relied upon renders the Office Action's rejection fatal. For at least this reason, Claims 4 and 7 are patentable over the prior art.

3. "Display a number of players who can participate" Claim Element

ACP states:

> *Matsuda* did not explicitly state wherein the at least two communication terminal devices display the number of players who can participate in the game play. *Tashiro* demonstrated that it was known at the time of invention to display a number of players who can participate in an interactive game play (*Tashiro*: column 6, lines 1-5; figure 7). It would have been obvious to one of ordinary skill in the art at the time of invention to implement the game software system of *Matsuda* with terminals displaying a number of players who can participate in the game play as found in *Tashiro*'s teachings. This implementation would have been obvious because one of ordinary skill in the art would be motivated

> to extend the *Matsuda*'s potentia market and commercial success to as many areas as possible including multiplayer games which are desirable (*Tashiro*: column 1, lines 20-24); and further because such an implementation is an application of known techniques and known elements to yield a predictable result.

Thus, the Examiner contends that *Tashiro* demonstrates this limitation, but does not describe how *Tashiro* actually teaches or suggests this limitation. Rather, the Office Action merely states "*Tashiro* demonstrated that it was known at the time of invention to display a number of players who can participate in an interactive game play."

However, *Tashiro* does not teach displaying a number of people who "can participate" in the game —*Tashiro* does not teach displaying anything related to the number of players who ***can*** play the game. Rather, *Tashiro* teaches only limiting the number of players who can play, by limiting the number of physical game machines. *Tashiro* at col. 6, lines 1-5. At best, *Tashiro* might suggest showing a car for each player who *is* currently *playing* the game, but this does not teach or suggest displaying how many *can* play the game. ACP argues that displaying cars for the players who are playing teach or suggest this claim element. However, even if one could discern the ***number of players who are currently playing*** the game by counting the number of cars on the display, this is quite different than displaying a number of players "***who can participate***" in a game.

Still further, a review of Fig. 7 of *Tashiro* reveals that indeed the system disclosed does not, in fact, display a number of players who *can* participate in gameplay. Rather, Fig. 7 reveals that the system of *Tashiro* merely displays the number of players who *are* participating. Fig. 7 demonstrates that only those players who are in fact currently participating are displayed even though the game may, as described, have a maximum number of players. *Tashiro* at Fig. 7, col. 6, lines 1-5 (only 4 players shown--nowhere shows that 8 players *can participate*).

That particular teaching is especially meaningful in view of the Federal Circuit's recent holding in *Kinetic Concepts, Inc. et al. v. Wake Forest University Health Sciences*, Case 2011-1105, at page 32 (Fed. Cir. August 13, 2012). In *Kinetic Concepts*, Smith & Nephew (Appellee) argued that one piece of prior art taught that "negative pressure" could be used to treat a wound and thereby taught a missing element of other cited references. However, the Federal Circuit disagreed and concluded that the additional reference may have taught the use of "negative pressure" to treat a wound, however it only did so in the context of aspirating pus from an abscess—in essence the other reference "taught away" from the combination.

The same situation exists here. Even if *Tashiro* could be read as suggesting that when eight players are *in fact* playing the same game in which only eight players *can* play, that suggestion is a mere coincidence. Indeed, the teachings of Fig. 7 of *Tashiro* make clear that the number of players shown is actually the number of players who are *in fact* playing and not those who *can* play. Exactly as in Kinetic Concepts, *Tashiro* teaches away from the element for which it is offered.

The difference is also illustrated by the context of the *Tashiro* teachings. *Tashiro* teaches that a group of physical game machines "within the same game space" are multi-player enabled. See *Tashiro* at col. 2, lines 19-20. In that context, there is no need to display the number of players who *can* play—all an individual need do is look around. In contrast, the system addressed by Patent Owner's claims enable geographically disparate players (who cannot simply look around) to know how many players *can* engage in a multi-player game. Therefore, *Tashiro* fails to remedy this lack of disclosure. For at least this reason, the rejections of the claims reciting displaying the number of players "***who can participate***" in the game play should be withdrawn.

C. Specific Grounds of Rejection

1. Ground AW

Claims 1, 5, 17, and 31 were rejected under 35 U.S.C 102(b) as being anticipated by *Matsuda*. The ACP adopted the third party comments in Section III.A. In overview, the ACP either argues that *only one element* needs to be shown or that *Matsuda* shows all three elements. Patent Owner's respectfully disagrees with both these positions as explained above under Section A1 and A2.

2. Ground AX

Claims 1, 5, 17, and 20 were rejected under 35 U.S.C. 102(b) as being anticipated by *Bush*. The ACP adopted the third party comments in section III.B. However, section III.B in the third party comments does not even attempt to provide an argument as to how the *Bush* reference discloses "transmitting ...the combination of the program and data at the request of said communication terminal device." TPR argues that *Bush* discloses a pay-per-view entertainment system for transmitting prerecorded entertainment from source 10 to a subscriber's receiver 14 via a cable network and that *Bush* describes a system for distributing prerecorded entertainment, where the prerecorded entertainment may be in the form of prerecorded musical works, video recordings, or computer software. TPR than characterizes the computer software as 'programs' and musical works as 'data.'

Interestingly, TPR's arguments, which ACP adopted, does not even attempt to address the claim element reciting "transmitting ...the combination of the program and data at the request of said communication terminal device." However, before addressing that failure, Patent Owner provides an overview of the *Bush*, which describes why *Bush* can not possibly teach or suggest the recited claims.

The title for *Bush* is "Pay Per View Entertainment System." According to the Abstract, in a pay per view entertainment system, recorded entertainment such as musical works are distributed to subscribers over a cable network. Pay per view systems are quite different than on-demand systems. Pay per view systems determine the programming of prerecorded entertainment (col. 2, lines 45-46) and provide the same prerecorded programmed entertainment to all subscribers (col. 2, lines 48-50). The prerecorded programmed entertainment includes previews and the entire musical works (col. 1, lines 56-64). When a user wants to record an entire musical work, a selection is made and the musical work is recorded on a cassette (col. 4, lines 7-11, col. 6, lines 11-48). In contrast to the pay per view entertainment system disclosed in *Bush*, the claims in the present reexamination recite "***transmitting*** the program, the data, or the combination of the program and data ***at the request of said communication terminal device***." This element is quite different than the pay per view system disclosed in *Bush* in which the same data (i.e., prerecorded programmed entertainment) is transmitted to all the subscribers and there is no request to transmit any program, data, or combination of the program and data. Thus, for at least this reason, the claims are patentable over *Bush*.

In addition, as described above in Section 1A and 1B with respect to *Matsuda*, *Bush* also does not disclose the program, the data, or the combination of the program and data claim element. *Bush* describes a pay per view system for musical works, and then mentions that the system could include video recordings or computer software. However, contrary to TPR and the ACP, the mere mention of video recordings or computer software, does not remedy Bush's failure to teach or suggest the program, the data, or the combination of the program and data. Furthermore, there is no teaching or suggestion in *Bush* regarding "***transmitting*** the program, the data, or the combination of the program and data ***at the request of said communication terminal device***." Accordingly, the rejection is improper and should be withdrawn.

3. Ground AZ

Claims 2, 8, 18, and 19 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Stokey*. The ACP adopted the third party comments in section III.D. *Stokey* fails to remedy *Matsuda*'s failure to teach all the elements in the independent claims. In fact, *Stokey* does not teach or suggest a "use fee" that is varied in accordance with the newness of the program, the data, and the combination of the program and data. Instead, *Stokey* teaches that products are very expensive when they first appear on the market, then, over a period of time the price declines (first paragraph). Thus, there is no teaching of varying a use fee in accordance with the newness of the program, the data, and the combination of the program and data.

Stokey is an article entitled "Intertemporal Price Discrimination" that is not even related to *Matsuda,* but is being combined in an impermissible hindsight reconstruction of the claims.

4. Ground BA

Claim 9 was rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Stokey* and in further view of *Hornbuckle*. The ACP adopted the third party comments in section III.E. Neither *Stokey* nor Hornbuckle remedy *Matsuda*'s failure to teach all the elements in the independent claims. Here, three references have been impermissibly combined in order to reconstruct the claims in hindsight. However, these three references still do not teach or suggest all the elements recited in the claim 9, which recites "wherein the use fee is charged when the at least one of the program, the data, and combination of the program and data is downloaded."

5. Ground BB

Claim 10 was rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Stokey* and in further view of *Suzuki*. The ACP adopted the third party comments in

section III.F. Neither *Stokey* nor *Suzuki* remedy *Matsuda*'s failure to teach all the elements in the independent claims. In addition, the portions cited in Suzuki for supposedly demonstrating that it was known at the time of the invention to select items from ***a scrollable list*** (col. 5, lines 22-31 and 53-64; col. 6, lines 3-15; and col. 8, lines 14-17) do not even teach or suggest a "scrollable list" as recited in the claim, but merely describes a display with a number and a description identifying a predetermined data-category, such as "1. tune name list", "2. information on the tune presently being played back", or "3. order of playing the requested tunes". The list described in *Suzuki* is actually *a static list that does not even scroll*, which can not possibly teach or suggest ***a scrollable list*** as recited in the claim. Thus, not only are these three references impermissibly combined, the three references, even if it was permissible to combine the three references, would still not teach or suggest all the elements as recited in claim 10. Furthermore, the list disclosed in Suzuki does not allow "selecting the at least one of the program, the data, and the combination of the program and data" because Suzuki, and the other references, do not teach or suggest "the program, the data, and the combination of the program and data."

6. Ground BE

Claims 1, 5, 6, 15, 17, 20-25, 27-28, and 31 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Tsumura.* The ACP adopted the third party comments in section III.I. Tsumura fails to remedy Matsuda's failure to teach all the elements in the independent claims 1 and 5.

According to TPR section III.I argument, TPR argues that Tsumura teaches transmitting a combination of the program and data and refers to section II.A.4 (pg 9) which states that "Tsumura expressly discloses that the transmitted game data includes computer game programs and file data (i.e., a combination of program and data)" citing Tsumura at 7:51-53; 5:3-17; 5:20-23.

Again, ACP by adopting TPR's argument overlooks that the claims recite "***transmitting*** the program, the data, or the combination of the program and data ***at the request of said communication terminal device***". In fact, upon reading the portions cited for supposedly teaching transmitting the combination of the program and data, the Patent Owner contends that *Tsumura* actually **teaches away** from "***transmitting...at the request of said communication terminal device.***" For example, col. 7, line 51 to col. 8, line 39, describe a system in which a plurality of game data is assembled into an incoming stream of game data that is transmitted to a game machine. Each of the game data has an associated ID code. If a code has been input from the control panel that matches one of the storage enable ID codes incorporated into the incoming stream of game data, the game data containing the matching ID code will be stored by the game machine. The game data received by the tuner 32 is not therefore automatically stored in its totality. *Tsumura* states that by transmitting an incoming stream of game data enables the transmission of large volumes of data at extremely high speed and, since the bulk of the communication of the invention depends on broadcasting techniques, traffic congestion has no effect at all on the processing of the incoming data. Therefore, *Tsumura* does not teach or suggest "***transmitting...at the request of said communication terminal device***," but rather discloses a system similar to a pay per view system that has pre-programmed content from which selected content may be stored (i.e., no requests to transmit).

This pay per view configuration is further supported in col. 5, lines 3-23 (cited by TPR) which states "[T]he transmission device 12 and the receiving device 13 are used to carry out data transfer by way of a communication satellite 11. Communication takes place in one direction only, from the transmission device 12 to the receiving device 13." Therefore, *Tsumura* can not possibly teach "***transmitting...at the request of said communication terminal device***" because data transfer is only one way.

Tsumura also fails to teach or suggest the claim element in Claim 6 which recites "***transmitting*** the game information ***at the request of said communication terminal device***."

In addition, there is no teaching or suggestion in *Tsumura* that the request is for program, data, or a combination of the program and data. Accordingly, the rejections are improper and should be withdrawn.

7. Improper Combinations Should Be Withdrawn

In addition to the foregoing grounds for patentability, the ACP makes numerous conclusory combinations to improperly support its rejections. The following grounds of rejection should all be withdrawn as being based on improper combinations supported by no evidence and justified with nothing except hindsight reconstruction: Grounds U, V, X, Y, AB, AG, AH, AI, AJ, AK, AL, AM, AN, AS, AZ, BA, BB, BC, BD, BE, BF, BG, BH, BI, BJ, BK, BL, BM, BN, BO, BS, BT, BU, BV, BW, BX, BY, BZ, CA, and CB.

Those combinations are all improper and should be withdrawn. See *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006); *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007) (quoting Federal Circuit statement with approval).

Support for Claim Changes

Patent Owner has amended claims and submitted new dependent claims to further distinguish the '508 Patent from the art of record.

Claim 3

Claim 3 has been amended to recite "transmitting the game information to at least another communication terminal device to facilitate interactive communication between the at least two communication terminal devices regarding the game information." Support for this limitation is found at least, at column 8, lines 13-27 of the '508 Patent.

Claim 3 has also been amended to recite "game information comprises game data." Support for this limitation is found at least, at column 8, lines 28-30 of the '508 Patent.

Claim 3 has also been amended to recite "the at least two communication terminal devices display the number of players who can participate in the game play." Support for this limitation is found at least, at column 5, lines 59-61 of the '508 Patent.

Claim 4

Claim 4 has been amended to recite "karaoke information and movie data distribution system for transmitting karaoke information stored in a karaoke database and movie data stored in another database." Support for this limitation is found at least, at column 10, lines 10-20 of the '508 Patent.

Claim 4 has also been amended to recite "storing the karaoke information or the movie data in a memory provided in the communication terminal device." Support for this limitation is found at least, at column 10, lines 10-20 of the '508 Patent.

Claim 4 has also been amended to recite "the use fee is varied in accordance with the newness of the karaoke information or movie data." Support for this limitation is found at least, at column 7, lines 13-18 of the '508 Patent.

Claim 4 has also been amended to recite "wherein the karaoke information comprises word data and accompaniment data associated with a song". Support for this limitation is found at least, at column 8, line 66 to column 9, line 11 of the '508 Patent.

Claim 6

Claim 6 has been amended to recite "transmitting the game information to at least another communication terminal device to facilitate interactive communication between the at least two communication terminal devices regarding the game information." Support for this limitation is found at least, at column 8, lines 13-27 of the '508 Patent.

Claim 6 has also been amended to recite "wherein the game information comprises game data." Support for this limitation is found at least, at column 8, lines 28-30 of the '508 Patent.

Claim 7

Claim 7 has been amended to recite a "method for karaoke information distribution for transmitting karaoke information stored in a karaoke database and for movie data distribution for transmitting movie data stored in another database." Support for this limitation is found at least, at column 10, lines 10-20 of the '508 Patent.

Claim 7 has also been amended to recite "storing the karaoke information or the movie data in a memory provided in the communication terminal device." Support for this limitation is found at least, at column 10, lines 10-20 of the '508 Patent.

Claim 7 has also been amended to recite "the use fee is varied in accordance with the newness of the transmitted game information." Support for this limitation is found at least, at column 7, lines 13-18 of the '508 Patent.

Claim 7 has also been amended to recite "wherein the karaoke information comprises word data and accompaniment data associated with a song." Support for this limitation is found at least, at column 8, line 66 to column 9, line 11 of the '508 Patent.

New Claim 8

Claim 8 recites "wherein newness depends on a length of time the program, the data, or the combination of the program and data has been in the market." Support for this limitation is found at least, at column 7, lines 13-18 of the '508 Patent.

New Claim 9

Claim 9 recites "wherein the use fee is charged when the at least one of the program, the data, and combination of the program and data is downloaded." Support for this limitation is found at least, at column 7, lines 20-22 of the '508 Patent.

New Claim 10

Claim 10 recites " wherein the communication terminal device displays a scrollable list for selecting the at least one of the program, the data, and the combination of the program and data." Support for this limitation is found at least, at column 5, lines 59-60 of the '508 Patent.

New Claim 11

Claim 11 recites "wherein the use fee is charged when the game information is downloaded." Support for this limitation is found at least, at column 7, lines 20-22 of the '508 Patent.

New Claim 12

Claim 12 recites "wherein the communication terminal device displays a scrollable list for selecting the game information." Support for this limitation is found at least, at column 5, lines 59-60 of the '508 Patent.

New Claim 13

Claim 13 recites "wherein the game data comprises map data." Support for this limitation is found at least, at column 8, lines 28-30 of the '508 Patent.

New Claim 14

Claim 14 recites "wherein the use fee is charged when the karaoke information or the movie data is downloaded." Support for this limitation is found at least, at column 7, lines 20-22 of the '508 Patent.

New Claim 15

Claim 15 recites "wherein the program comprises a video game." Support for this limitation is found at least, at column 7, lines 37-41 of the '508 Patent.

New Claim 16

Claim 16 recites "wherein the data comprises karaoke information." Support for this limitation is found at least, at column 8, line 66 to column 9, line 11 of the '508 Patent.

New Claim 17

Claim 17 recites "wherein the data comprises a movie." Support for this limitation is found at least, at column 10, lines 10-20 of the '508 Patent.

New Claim 18

Claim 18 recites "wherein the use fee is varied in accordance with the newness of the transmitted program, the data, or the combination of the program and the data." Support for this limitation is found at least, at column 7, lines 13-18 of the '508 Patent.

New Claim 19

Claim 19 recites "wherein the newness depends on a length of time the transmitted program, the data, or the combination of the program and data has been in the market." Support for this limitation is found at least, at column 7, lines 13-18 of the '508 Patent.

New Claim 20

Claim 20 recites "wherein the use fee is charged when the at least one program, the data, and the combination of the program and data is downloaded." Support for this limitation is found at least, at column 7, lines 20-22 of the '508 Patent.

New Claim 21

Claim 21 recites "wherein the game data comprises map data." Support for this limitation is found at least, at column 8, lines 28-30 of the '508 Patent.

New Claim 22

Claim 22 recites "wherein the game play comprises a role-playing game." Support for this limitation is found at least, at column 8, lines 28-29 of the '508 Patent.

New Claim 23

Claim 23 recites "wherein the game information comprises advanced game data related to the game play." Support for this limitation is found at least, at column 8, lines 28-31 of the '508 Patent.

New Claim 24

Claim 24 recites "wherein the advanced game data comprises additional map data related to the game play." Support for this limitation is found at least, at column 8, lines 28-31 of the '508 Patent.

New Claim 25

Claim 25 recites "wherein transmitting the advanced game data occurs after completing an event during the game play." Support for this limitation is found at least, at column 8, lines 28-36 of the '508 Patent.

New Claim 26

Claim 26 recites "wherein the at least two communication terminal devices display the number of players who can participate in the game play." Support for this limitation is found at least, at column 5, lines 60-61 of the '508 Patent.

New Claim 27

Claim 27 recites "wherein the use fee is charged when the game information is downloaded." Support for this limitation is found at least, at column 7, lines 20-22 of the '508 Patent.

New Claim 28

Claim 28 recites "wherein the game data comprises position data of characters in the game play for the respective communication terminal devices." Support for this limitation is found at least, at column 8, lines 23-27 of the '508 Patent.

New Claim 29

Claim 29 recites "wherein the use fee is charged when the karaoke information or the movie data is downloaded." Support for this limitation is found at least, at column 7, lines 20-22 of the '508 Patent.

New Claim 30

Claim 30 recites "wherein the movie data comprises video and audio information of a satellite television service." Support for this limitation is found at least, at column 10, lines 10-20 of the '508 Patent.

New Claim 31

Claim 31 recites "wherein the data is related to the program in the combination of program and data." Support for this limitation is found at least, at column 4, lines 21-25 of the '508 Patent.

Service of Papers

A copy of this submission is being served today on Third Party Requester in accordance with 37 CFR 1.248 by first class mail addressed to Third Party Requester's new address:

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6201 College Blvd
Suite 300
Overland Park, KS 66211

Notice of Pending Litigation

Patent Owner reminds the Patent Office of the current litigation matter, Case No. 2:08-CV-01579-RSM in the Western District of Washington, currently stayed, involving this patent.

Conclusion

Patent Owner respectfully asserts that the amendments and arguments overcome the rejections of all pending claims, and respectfully requests that the Patent Office withdraw those

rejections. In addition, Patent Owner respectfully submits that the new claims, added by this paper, are also patentable over the art of record.

It is Patent Owner's intent and belief that all of the pending grounds of the rejection have been addressed either directly or indirectly through claim dependency. However, if the Patent Office discovers that a ground of rejection was inadvertently missed, given the inordinate number of proposed rejections that have been presented in this matter, Patent Owner respectfully requests an opportunity to address it before final action is taken.

Respectfully submitted,

Dated: 05/20/2012

By: _____

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