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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
95/001,234	09/18/2009	6488508	SCEA.146736	4466

20210 7590 04/19/2013

DAVIS & BUJOLD, P.L.L.C.
112 PLEASANT STREET
CONCORD, NH 03301

EXAMINER	
WOOD, WILLIAM H	

ART UNIT	PAPER NUMBER
3992	

MAIL DATE	DELIVERY MODE
04/19/2013	PAPER

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

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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/009,521	08/17/2009	6,488,508	ADC508	6732

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THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS
ERISE IP, PA
6201 COLLEGE BLVD.
OVERLAND PARK, KS 66211

Date:

APR 19 2013

CENTRAL REEXAMINATION UNIT

Transmittal of Communication to Third Party Requester
Inter Partes Reexamination

REEXAMINATION CONTROL NO. : 95001234
PATENT NO. : 6488508
ART UNIT : 3993

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above-identified reexamination proceeding. 37 CFR 1.903.

Prior to the filing of a Notice of Appeal, each time the patent owner responds to this communication, the third party requester of the inter partes reexamination may once file written comments within a period of 30 days from the date of service of the patent owner's response. This 30-day time period is statutory (35 U.S.C. 314(b)(2)), and, as such, it cannot be extended. See also 37 CFR 1.947.

If an ex parte reexamination has been merged with the inter partes reexamination, no responsive submission by any ex parte third party requester is permitted.

All correspondence relating to this inter partes reexamination proceeding should be directed to the Central Reexamination Unit at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

Transmittal of Communication to Third Party Requester *Inter Partes* Reexamination	Control No. 95/001,234 (90/009,521)	Patent Under Reexamination 6488508	
	Examiner WILLIAM H. WOOD	Art Unit 3992	

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

(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

Erise IP, P.A.
6201 College Blvd.
Suite 300
Overland Park, KS 66211

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All correspondence relating to this inter partes reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of the communication enclosed with this transmittal.

ACTION CLOSING PROSECUTION (37 CFR 1.949)	Control No. 95/001,234, 90/009,521	Patent Under Reexamination 6488508
	Examiner WILLIAM H. WOOD	Art Unit 3992

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

Responsive to the communication(s) filed by:
Patent Owner on 11 July, 2012
Third Party(ies) on 27 February, 2013

Patent owner may once file a submission under 37 CFR 1.951(a) within 1 month(s) from the mailing date of this Office action. Where a submission is filed, third party requester may file responsive comments under 37 CFR 1.951(b) within 30-days (not extendable- 35 U.S.C. § 314(b)(2)) from the date of service of the initial submission on the requester. **Appeal cannot be taken from this action.** Appeal can only be taken from a Right of Appeal Notice under 37 CFR 1.953.

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

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

1. ☐ Notice of References Cited by Examiner, PTO-892
2. ☐ Information Disclosure Citation, PTO/SB/08
3. ☐ _____

PART II. SUMMARY OF ACTION:

1a. ☒ Claims 1-32 are subject to reexamination.
1b. ☐ Claims _____ are not subject to reexamination.
2. ☒ Claims 32 have been canceled.
3. ☐ Claims _____ are confirmed. [Unamended patent claims]
4. ☐ Claims _____ are patentable. [Amended or new claims]
5. ☒ Claims 1-31 are rejected.
6. ☐ Claims _____ are objected to.
7. ☐ The drawings filed on _____ ☐ are acceptable ☐ are not acceptable.
8 ☐ The drawing correction request filed on _____ is: ☐ approved. ☐ disapproved.
9 ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119 (a)-(d). The certified copy has: ☐ been received. ☐ not been received. ☐ been filed in Application/Control No _____
10. ☐ Other _____

ACTION CLOSING PROSECUTION

This is an Action Closing Prosecution rejecting amended (02/27/2013) claims 1-31 following a non-final Office Action (06/04/2012).

NOTE: Claim 32 is treated and considered as cancelled by the amendment of 02/27/2013. All future correspondence should treat claim 32 as cancelled. Any future amendments (or discussions of claim status) should explicitly indicate the status of the claims introduced during this reexamination proceeding (see CFR 1.530(d) (2) "a ... proposed added claim should be canceled by a statement canceling the claim").

Reexamination

This is a MERGED *ex parte* (proceeding 90/009,521) and *inter partes* (proceeding 95/001,234) reexamination of U.S. Patent 6,488,508 (herein *Okamoto*) requested by both the patent owner and a third party. A substantial new question of patentability (SNQ) affecting claims 1-7 is raised and reexamination has been ordered in reexamination proceeding 90/009,521 (Request for Reexamination: 08/17/2009; Decision on Request for Reexamination: 09/29/2009). A substantial new question of patentability (SNQ) affecting claims 1-7 is raised and a reexamination has been ordered in reexamination proceeding 95/001,234 (Request for Reexamination: 09/18/2009; Decision on Request for Reexamination: 12/15/2009). Reexamination proceedings 90/009,521 and 95/001,234 are MERGED.

NOTE: In order to ensure clarity, every grounds of rejection (whether proposed by the third party or initiated by the examiner) is given its own unique identifier.

Request Established References

The requests argue the following patents and/or printed publications provide teachings relevant to the patent claims requested for reexamination.

From 95/001,234:

a) Matsuda (JP Patent Publication H03-149693), published 06/26/1991. (herein *Matsuda*)

b) Bush (USPN 4,789,863), issued 12/06/1988, filed 01/13/1988. (herein *Bush*)

c) Roskowski (USPN 5,624,316), issued 04/29/1997, filed 06/06/1994. (herein *Roskowski*)

d) Rhoades (USPN 5,181,107), issued 01/19/1993, filed 09/20/1991. (herein *Rhoades*)

e) Gifford (USPN 5,724,424), issued 03/03/1998, filed 11/29/1995. (herein *Gifford*)

f) Sanbe (JP Patent Publication H04-32898), published 02/04/1992. (herein *Sanbe*)

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

h) Kato (JP Patent Publication H04-10191), published 01/14/1992. (herein *Kato*)

i) Oseki (JP Patent Publication H04-158441), published 06/01/1992. (herein *Oseki*

j) Stefik (USPN 5,638,443), issued 06/10/1997, filed 11/23/1994. (herein *Stefik*)

From 90/009,521:

k) Sanyo (JP 01-289221), laid-open 06/26/1991. (herein *Sanyo*)

l) Roskowski et al. (USPN 5,624,316), issued 04/29/1997, filed 06/06/1994. (herein *Roskowski*)

m) Gifford (USPN 5,724,424), issued 03/03/1998, filed 11/29/1995. (herein *Gifford*)

n) Bush (USPN 4,789,863), issued 12/06/1988, filed 01/13/1988. (herein *Bush*)

Additionally, the third party comments (02/09/2011) propose the following patents and/or printed publications provide teachings relevant to the patent claims requested for reexamination:

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

b) Tashiro et al. (USPN 4,998,199), issued 03/05/1991, filed 09/29/1988. (herein *Tsumura*)

c) Lockton (USPN 5,083,800), issued 01/28/1992, filed 06/07/1990. (herein *Tsumura*)

d) Wolfenstein 3D Instructional Booklet, Id Software, 1992, pp. 1-13. (herein *Wolfenstein*)

e) Super Mario Brothers Instructional Booklet, Nintendo, 1985, pp. 2-18. (herein *Super Mario Bros.*)

f) Suzuki (USPN 5,157,643), issued 10/20/1992, filed 06/15/1989. (herein *Suzuki*)

g) Ballantyne et al. (USPN 5,133,079), issued 07/21/1992, filed 08/28/1990. (herein *Ballantyne*)

h) Morales (USPN 5,291,554), issued 03/01/1994, filed 08/19/1992. (herein *Morales*)

i) Nancy L. Stokey, "Intertemporal Price Discrimination", The Quarterly Journal of Economics, 08/1979, pp. 355-371. (herein *Stokey*)

j) Julia R. Dobrow, "Social and Cultural Aspects of VCR Use", Lawrence ErlBaum Associates, Inc., Hillsdale, New Jersey, 1990, pp. 25-44. (herein *Dobrow*)

Claim Rejections - 35 USC § 102 and § 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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 a patent.

(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 application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 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 negatived by the manner in which the invention was made.

STATUS OF GROUNDS OF REJECTION

The following is a brief *summary* of the status of the adopted, adopted-with-clarification, not adopted and withdrawn grounds of rejection.

Adopted Rejections

The following grounds of rejection (using a unique identifier as described by this office action; see the below explanations for reference to the Third Party comments) are proposed by the Third Party Requester in the comments received *02/27/2013*: AW (claims 1, 5, 17, 31); AX; AZ; BA; BB; BC; BD; BE; BF; BG; BK; BL; BM; BN; BO; and CB.

The following grounds of rejection (using a unique identifier as described by this office action; see the below explanations for reference to the Third Party comments) are

proposed by the Third Party Requester in the comments received *02/09/2011*: U (claims 6, 21-25, 27-28); V (claim 3, 6, 28); X (claim 21-24); Y (claim 23-25); AB; and AG (claims 6, 21-25, 27-28).

Adopted-with-Clarification Rejections

The following grounds of rejection are adopted-with-clarification from the Third Party proposals of *02/27/2013*: BH, BI, BJ, BS, BT, BU, BV, BW, BX, BY, BZ, and CA.

Examiner Initiated and Currently Applied Rejections

The following grounds of rejection are examiner initiated and currently applied (see below) rejections from the non-final office action of *06/04/2012*: AH, AI, AK, AL, AM, AN, and AS.

Not Adopted Rejections

The following grounds of rejection are not adopted from the Request for Reexamination of *09/18/2009*: A, C, D, F, G, H, I, J, K, L, M, N, O, P, Q, and R.

The following grounds of rejection are not adopted from the Third Party proposals of *02/09/2011*: U (claim 3, 5, 9-13, 15, 17-20, 26); V (claim 22); W; X (claim 13); Z (claim 10, 15); AA; AC; AD; AE; AF; and AG (claim 3, 5, 11-13, 15-18, 20, 26).

The following grounds of rejection are not adopted from the Third Party proposals of *02/27/2013*: AW (claim 15); AY;2 BP; BQ; BR; CC; CD; CE; CF; CG; CH; CI; CJ; CK; CL; and CM.

Withdrawn Rejections

The following grounds of rejection were withdrawn in view of the Patent Owner's amendments of *01/18/2011*: B, E, S, and T.

The following grounds of rejection are withdrawn in view of the Patent Owner's amendments of *07/11/2012*: Z (claims 5, 16-17), AJ (claims 7, 32), AO, AP, AQ, AR, AT, AU, and AV.

EXPLANATION OF GROUNDS OF REJECTION

Newly Proposed Third Party Rejections

The following is an *explanation* of the adopted and not adopted third party proposed rejections, in light of the third party comments (02/27/2013) and making use of the numbering scheme described above (providing every ground of rejection a unique identifier).

NOTE: Third Party Requester comments use the terminology "First OA" to indicate the first office action (08/31/2010) and "Office Action" to indicate the second office action (06/04/2012).

NOTE: Patent Owner has amended several claims and has therefore provided the Third Party Requester an opportunity to respond with proposed grounds of rejection (see: 37 CFR 1.947; and MPEP 2666.05). Claims 1 and 5 have been amended to their original form. Claim 7 has been amended to a new form and the limitation of claim 31 is entirely new.

NOTE: Some newly proposed grounds of rejection by the Third Party Requester duplicate existing and in force grounds of rejection for some claims from the non-final office action of 06/04/2012. Presumably this is done in an attempt to list all applicable claims under an appropriate prior art heading.

NOTE: Numerous grounds of rejection in the Third Party Requesters comments (02/27/2013) refer back or cite back to other incorrect grounds of rejection in the Third Party Requester comments. Presumably these errors are unintentional. Though corrected in the below discussion, considerable care should be taken in future correspondence to prevent such confusing citations in order to ensure prosecution is clear and efficient.

Ground AW. (Third Party 02/27/2013 proposed III.A)

Claims 1, 5, 15, 17 and 31 are proposed to be rejected under 35 U.S.C. 102(b) as being anticipated by *Matsuda*.

This rejection is proposed by the third party requester in the third party comments (02/27/2013) and it is **adopted** for claims 1, 5, 17 and 31 for the reasons set forth in the third party comments (section III.A, which is hereby incorporated by reference).

The rejection is **not-adopted** and not applied against claim 15 for the following reasons: *Matsuda* does not explicitly disclose "a video game."

Ground AX. (Third Party 02/27/2013 proposed III.B)

Claims 1, 5, 17 and 20 are proposed to be rejected under 35 U.S.C. 102(b) as being anticipated by *Bush*.

This rejection is proposed by the third party requester in the third party comments (02/27/2013) and it is **adopted** for claims 1, 5, 17 and 20 for the reasons set forth in the third party comments (section III.B, which is hereby incorporated by reference).

Ground AY. (Third Party 02/27/2013 proposed III.C)

Claims 1, 5, 15 and 31 are proposed to be rejected under 35 U.S.C. 102(b) as being anticipated by *Roskowski*.

The rejection is **not-adopted** and not applied against claims 1, 5, 15 and 31 for the following reasons: *Roskowski* does not overcome the *Okamoto* priority date. The addition of language "a combination of the program and data means" during a prosecution point does not preclude the subject matter from being disclosed previous to that point. For example, the 5,775,995 patent (priority dating back to before the example given by the third party requester) uses the phrase "game data" to refer to both the game program and the data on which the program operates (column 5, lines 49-60; also column 6, lines 1-56; a game program must include data from some source in order to function, the disclosure of a game is disclosure of the game and the data operated on by that game). The combination was disclosed prior to Third Party Requester's

example. The original Japanese application has similar language (starting at paragraph 0026).

Ground AZ. (Third Party 02/27/2013 proposed III.D)

Claims 2, 8, 18 and 19 are proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Stokey*.

This rejection is proposed by the third party requester in the third party comments (02/27/2013) and it is **adopted** for claims 2, 8, 18 and 19 for the reasons set forth in the third party comments (section III.D, which is hereby incorporated by reference).

Ground BA. (Third Party 02/27/2013 proposed III.E)

Claim 9 is proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Stokey* and in further view of *Hornbuckle*.

This rejection is proposed by the third party requester in the third party comments (02/27/2013) and it is **adopted** for claim 9 for the reasons set forth in the third party comments (section III.E, which is hereby incorporated by reference).

Ground BB. (Third Party 02/27/2013 proposed III.F)

Claim 10 is proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Stokey* and in further view of *Suzuki*.

This rejection is proposed by the third party requester in the third party comments (02/27/2013) and it is **adopted** for claim 10 for the reasons set forth in the third party comments (section III.F, which is hereby incorporated by reference; it is noted ground AL is on page 30 of the previous office action of 06/04/2012).

Ground BC. (Third Party 02/27/2013 proposed III.G)

Claim 16 is proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Sanbe*.

This rejection is proposed by the third party requester in the third party comments (02/27/2013) and it is **adopted** for claim 16 for the reasons set forth in the third party comments (section III.G, which is hereby incorporated by reference).

Ground BD. (Third Party 02/27/2013 proposed III.H)

Claim 20 is proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Hombuckle*.

This rejection is proposed by the third party requester in the third party comments (02/27/2013) and it is **adopted** for claim 20 for the reasons set forth in the third party comments (section III.H, which is hereby incorporated by reference).

Ground BE. (Third Party 02/27/2013 proposed III.I)

Claims 1, 5, 6, 15, 17, 20-25, 27-28 and 31 are proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Tsumura*.

This rejection is proposed by the third party requester in the third party comments (02/27/2013) and it is **adopted** for claims 1, 5, 6, 15, 17, 20, 21-25, 27-28 and 31 for the reasons set forth in the third party comments (section III.I, which is hereby incorporated by reference).

Ground BF. (Third Party 02/27/2013 proposed III.J)

Claims 21-24 are proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Tsumura* in further view of *Lockton*.

This rejection is proposed by the third party requester in the third party comments (02/27/2013) and it is **adopted** for claims 21-24 for the reasons set forth in the third party comments (section III.J, which is hereby incorporated by reference).

Ground BG. (Third Party 02/27/2013 proposed III.K)

Claims 23-25 are proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Tsumura* in further view of *Wolfenstein 3-D*.

This rejection is proposed by the third party requester in the third party comments (02/27/2013) and it is **adopted** for claims 23-25 for the reasons set forth in the third party comments (section III.K, which is hereby incorporated by reference).

Ground BH. (Third Party 02/27/2013 proposed III.L)

Claims 3, 6, 13, 21-26 and 28 are proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Tashiro*.

This rejection is proposed by the third party requester in the third party comments (02/27/2013) and it is **adopted-with-clarification** for claims 3, 6, 13, 21-26 and 28 for the reasons set forth in the third party comments (section III.L, which is hereby incorporated by reference). It is noted that section III.L refers to section II.A, but means section II.B.

Ground BI. (Third Party 02/27/2013 proposed III.M)

Claim 12 is proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Tashiro* in further view of *Suzuki*.

This rejection is proposed by the third party requester in the third party comments (02/27/2013) and it is **adopted-with-clarification** for claim 12 for the reasons set forth in the third party comments (section III.M, which is hereby incorporated by reference). It is noted that section III.M refers to section II.A, but means section III.L.

Ground BJ. (Third Party 02/27/2013 proposed III.N)

Claims 11 and 27 are proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Tashiro* in further view of *Hombuckle*.

This rejection is proposed by the third party requester in the third party comments (02/27/2013) and it is **adopted-with-clarification** for claims 11 and 27 for the reasons set forth in the third party comments (section III.N, which is hereby incorporated by reference). It is noted that section III.N refers to section II.A, but means section III.L.

Ground BK. (Third Party 02/27/2013 proposed III.O)

Claim 4 is proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Stokey* in further view of *Sanbe*.

This rejection is proposed by the third party requester in the third party comments (02/27/2013) and it is **adopted** for claim 4 for the reasons set forth in the third party comments (section III.O, which is hereby incorporated by reference).

Ground BL. (Third Party 02/27/2013 proposed III.P)

Claim 7 is proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Sanbe*.

This rejection is proposed by the third party requester in the third party comments (02/27/2013) and it is **adopted** for claim 7 for the reasons set forth in the third party comments (section III.P, which is hereby incorporated by reference).

Ground BM. (Third Party 02/27/2013 proposed III.Q)

Claim 14 is proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Stokey* in view of *Sanbe* in further view of *Hombuckle*.

This rejection is proposed by the third party requester in the third party comments (02/27/2013) and it is **adopted** for claim 14 for the reasons set forth in the third party comments (section III.Q, which is hereby incorporated by reference).

Ground BN. (Third Party 02/27/2013 proposed III.R)

Claim 29 is proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Sanbe* in further view of *Hombuckle*.

This rejection is proposed by the third party requester in the third party comments (02/27/2013) and it is **adopted** for claim 29 for the reasons set forth in the third party comments (section III.R, which is hereby incorporated by reference).

Ground BO. (Third Party 02/27/2013 proposed III.S)

Claim 30 is proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Sanbe* in further view of *Morales*.

This rejection is proposed by the third party requester in the third party comments (02/27/2013) and it is **adopted** for claim 30 for the reasons set forth in the third party comments (section III.S, which is hereby incorporated by reference).

Ground BP. (Third Party 02/27/2013 proposed III.T)

Claim 7 is proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Sanbe* in further view of *Baji*.

The rejection is **not-adopted** and not applied against claim 7 for the following reasons: Third Party Requester has not cited any teachings in Baji showing the missing limitations of claim 7; Third Party Requester has not discussed why Baji is necessary at this time.

Ground BQ. (Third Party 02/27/2013 proposed III.U)

Claim 29 is proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Sanbe* in further view of *Baji* and in further view of *Hornbuckle*.

The rejection is **not-adopted** and not applied against claim 29 for the following reasons: claim 7 not properly rejected, see Ground BP.

Ground BR. (Third Party 02/27/2013 proposed III.V)

Claim 30 is proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Sanbe* in further view of *Baji* and in further view of *Morales.*

The rejection is **not-adopted** and not applied against claim 30 for the following reasons: claim 7 not properly rejected, see Ground BP.

Ground BS. (Third Party 02/27/2013 proposed III.W)

Claims 1, 5, 15, 17, 20 and 31 are proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Rhoades* in view of *Bush.*

This rejection is proposed by the third party requester in the third party comments (02/27/2013) and it is **adopted-with-clarification** for claims 1, 5, 15, 17, 20 and 31 for the reasons set forth in the third party comments (section III.W, which is hereby incorporated by reference). It is noted that Third Party comments section III.W refers to section II.B, which is meant to be section III.B.

Ground BT. (Third Party 02/27/2013 proposed III.X)

Claims 2, 8, 9, 18 and 19 are proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Rhoades* in view of *Bush* in further view of *Stokey*.

This rejection is proposed by the third party requester in the third party comments (02/27/2013) and it is **adopted-with-clarification** for claims 2, 8, 9, 18 and 19 for the reasons set forth in the third party comments (section III.X, which is hereby incorporated by reference). It is noted that Third Party comments section III.X refers to section III.AA, which is meant to be section III.W).

Ground BU. (Third Party 02/27/2013 proposed III.Y)

Claim 10 is proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Rhoades* in view of *Bush* in further view of *Stokey* and in further view of *Suzuki*.

This rejection is proposed by the third party requester in the third party comments (02/27/2013) and it is **adopted-with-clarification** for claim 10 for the reasons set forth in the third party comments (section III.Y, which is hereby incorporated by reference). It is noted that Third Party comments section III.Y refers to section III.BB, which is meant to be section III.X. It is further noted that the third party comments implicitly refer to the application of Suzuki found in section III.F (which incorporates Ground AL).

Ground BV. (Third Party 02/27/2013 proposed III.Z)

Claim 16 is proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Rhoades* in view of *Bush* in further view of *Sanbe*.

This rejection is proposed by the third party requester in the third party comments (02/27/2013) and it is **adopted-with-clarification** for claim 16 for the reasons set forth in the third party comments (section III.Z, which is hereby incorporated by reference). It is noted that Third Party comments section III.Z refers to section III.AA, which is meant to be section III.W. It is further noted that the third party comments implicitly refer to the application of Sanbe found in section III.G (which incorporates Ground AP).

Ground BW. (Third Party 02/27/2013 proposed III.AA)

Claims 1, 5, 6, 15, 17, 20-25, 27-28 and 31 are proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Rhoades* in view of *Bush* in further view of *Tsumura*.

This rejection is proposed by the third party requester in the third party comments (02/27/2013) and it is **adopted-with-clarification** for claims 1, 5, 6, 15, 17, 20, 21-25, 27-28 and 31 for the reasons set forth in the third party comments (section III.AA, which is hereby incorporated by reference). It is noted that Third Party comments section III.AA refers to section III.AA, which is meant to be section III.W).

Ground BX. (Third Party 02/27/2013 proposed III.BB)

Claim 16 is proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Rhoades* in view of *Bush* in further view of *Tsumura* and in further view of *Sanbe*.

This rejection is proposed by the third party requester in the third party comments (02/27/2013) and it is **adopted-with-clarification** for claim 16 for the reasons set forth in the third party comments (section III.BB, which is hereby incorporated by reference). It is noted that Third Party comments section III.BB refers to section III.EE, which is meant to be section III.AA. Also, it is noted that Third Party comments section III.BB refers to section III.DD, which is meant to be section III.Z.

Ground BY. (Third Party 02/27/2013 proposed III.CC)

Claims 2, 8, 9, 18 and 19 are proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Bush* in view of *Stokey*.

This rejection is proposed by the third party requester in the third party comments (02/27/2013) and it is **adopted-with-clarification** for claims 2, 8, 9, 18 and 19 for the reasons set forth in the third party comments (section III.CC, which is hereby incorporated by reference). It is further noted that the third party comments implicitly refer to the application of Stokey found in section III.D (which incorporates Ground AH).

Ground BZ. (Third Party 02/27/2013 proposed III.DD)

Claim 10 is proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Bush* in view of *Stokey* and in further view of *Suzuki*.

This rejection is proposed by the third party requester in the third party comments (02/27/2013) and it is **adopted-with-clarification** for claim 10 for the reasons set forth in the third party comments (section III.DD, which is hereby incorporated by reference). It is noted that Third Party comments section III.DD refers to section III.II, which is meant to be section III.BY).

Ground CA. (Third Party 02/27/2013 proposed III.EE)

Claim 16 is proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Bush* in view of *Sanbe*.

This rejection is proposed by the third party requester in the third party comments (02/27/2013) and it is **adopted-with-clarification** for claim 16 for the reasons set forth in the third party comments (section III.EE, which is hereby incorporated by reference). It is further noted that the third party comments implicitly refer to the application of Sanbe found in section III.G (which incorporates Ground AP).

Ground CB. (Third Party 02/27/2013 proposed III.FF)

Claims 1, 5, 15, 17, 20 and 31 are proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Bush* in view of *Tsumura*.

This rejection is proposed by the third party requester in the third party comments (02/27/2013) and it is **adopted** for claims 1, 5, 15, 17, 20 and 31 for the reasons set forth in the third party comments (section III.FF, which is hereby incorporated by reference).

Ground CC. (Third Party 02/27/2013 proposed III.GG)

Claims 2, 8, 18 and 19 are proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Roskowski* in view of *Stokey*.

The rejection is **not-adopted** and not applied against claims 2, 8, 18 and 19 for the following reasons: *Roskowski* does not overcome the *Okamoto* priority date (see above discussion under Ground AY).

Ground CD. (Third Party 02/27/2013 proposed III.HH)

Claim 10 is proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Roskowski* in view of *Suzuki*.

The rejection is **not-adopted** and not applied against claim 10 for the following reasons: *Roskowski* does not overcome the *Okamoto* priority date (see above discussion under Ground AY).

Ground CE. (Third Party 02/27/2013 proposed III.II)

Claim 16 is proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Roskowski* in view of *Sanbe*.

The rejection is **not-adopted** and not applied against claim 16 for the following reasons: *Roskowski* does not overcome the *Okamoto* priority date (see above discussion under Ground AY).

Ground CF. (Third Party 02/27/2013 proposed III.JJ)

Claims 17 and 20 are proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Roskowski* in view of *Bush*.

The rejection is **not-adopted** and not applied against claims 17 and 20 for the following reasons: *Roskowski* does not overcome the *Okamoto* priority date (see above discussion under Ground AY).

Ground CG. (Third Party 02/27/2013 proposed III.KK)

Claim 9 is proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Roskowski* in view of *Stokey* in further view of *Hornbuckle*.

The rejection is **not-adopted** and not applied against claim 9 for the following reasons: *Roskowski* does not overcome the *Okamoto* priority date (see above discussion under Ground AY).

Ground CH. (Third Party 02/27/2013 proposed III.LL)

Claims 1, 5, 15 and 31 are proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Roskowski* in view of *Rhoades*.

The rejection is **not-adopted** and not applied against claims 1, 5, 15 and 31 for the following reasons: *Roskowski* does not overcome the *Okamoto* priority date (see above discussion under Ground AY).

Ground CI. (Third Party 02/27/2013 proposed III.MM)

Claims 2, 8, 18 and 19 are proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Roskowski* in view of *Rhoades* in further view of *Stokey*.

The rejection is **not-adopted** and not applied against claims 2, 8, 18 and 19 for the following reasons: *Roskowski* does not overcome the *Okamoto* priority date (see above discussion under Ground AY).

Ground CJ. (Third Party 02/27/2013 proposed III.NN)

Claim 10 is proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Roskowski* in view of *Rhoades* in view of *Stokey* in further view of *Suzuki*.

The rejection is **not-adopted** and not applied against claim 10 for the following reasons: *Roskowski* does not overcome the *Okamoto* priority date (see above discussion under Ground AY).

Ground CK. (Third Party 02/27/2013 proposed III.OO)

Claim 16 is proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Roskowski* in view of *Rhoades* in further view of *Sanbe*.

The rejection is **not-adopted** and not applied against claim 16 for the following reasons: *Roskowski* does not overcome the *Okamoto* priority date (see above discussion under Ground AY).

Ground CL. (Third Party 02/27/2013 proposed III.PP)

Claims 17 and 20 are proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Roskowski* in view of *Rhoades* in further view of *Bush*.

The rejection is **not-adopted** and not applied against claims 17 and 20 for the following reasons: *Roskowski* does not overcome the *Okamoto* priority date (see above discussion under Ground AY).

Ground CM. (Third Party 02/27/2013 proposed III.QQ)

Claim 9 is proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Roskowski* in view of *Stokey* in further view of *Hornbuckle*.

The rejection is **not-adopted** and not applied against claim 9 for the following reasons: *Roskowski* does not overcome the *Okamoto* priority date (see above discussion under Ground AY).

Previously Proposed Third Party Rejections

The following is an *explanation* of the adopted and not adopted third party proposed rejections, in light of the third party comments (02/09/2011) and making use of the numbering scheme described above.

Ground U. (Third Party 02/09/2011 proposed A.)

Claims 3, 5, 6, 9-13, 15 and 17-28 are proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Tsumura*.

This rejection is proposed by the third party requester in the third party comments (02/09/2011) and it is **adopted** for claims 6, 21-25 and 27-28 for the reasons set forth in the third party comments (section IV.A; which is hereby incorporated by reference).

The rejection is **not-adopted** and not applied against claims 3, 5, 9-13, 15 and 17-20 and 26 for the reasons explained in the non-final office action of 06/04/2012.

Ground V. (Third Party 02/09/2011 proposed B.)

Claims 3, 6, 22 and 28 are proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Tashiro*.

This rejection is proposed by the third party requester in the third party comments (02/09/2011) and it is **adopted** for claims 3, 6 and 28 for the reasons set forth in the third party comments (section IV.B; which is hereby incorporated by reference).

The rejection is **not-adopted** and not applied against claim 22 for the following reasons. Claim 21 is not addressed and not properly rejected by either Matsuda or Matsuda in view of Tashiro. Claim 22 is dependent upon claim 21.

Ground W. (Third Party 02/09/2011 proposed C.)

Claims 3, 11 and 26 are proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Tsumura* in further view of *Super Mario Bros.*

This rejection is proposed by the third party requester in the third party comments (02/09/2011) and it is **not-adopted** and not applied against claims 3, 11, and 26 for the reasons explained in the non-final office action of 06/04/2012.

Ground X. (Third Party 02/09/2011 proposed D.)

Claims 13 and 21-24 are proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Tsumura* in further view of *Lockton*.

This rejection is proposed by the third party requester in the third party comments (02/09/2011) and it is **adopted** for claims 21-24 for the reasons set forth in the third party comments (section IV.D; which is hereby incorporated by reference).

The rejections are **not-adopted** and not applied against claim 13 for the following reasons. The claims ultimately depend upon claim rejections in newly proposed ground of rejection U. (Third Party 02/09/2011 proposed A.) which are not-adopted.

Ground Y. (Third Party 02/09/2011 proposed E.)

Claims 23-25 are proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Tsumura* in further view of *Wolfenstein 3-D*.

This rejection is proposed by the third party requester in the third party comments (02/09/2011) and it is **adopted** for claims 23-25 for the reasons set forth in the third party comments (section IV.E; which is hereby incorporated by reference).

Ground Z. (Third Party 02/09/2011 proposed F.)

Claims 5, 10 and 15-19 are proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Suzuki*. NOTE: In light of the Patent Owner's amendments of 07/11/2012, the rejections of claims 5 and 16-17 under this ground of rejection have been **withdrawn**.

The rejection is **not-adopted** and not applied against claims 10 and 15 for the reasons explained in the non-final office action of 06/04/2012.

Ground AA. (Third Party 02/09/2011 proposed G.)

Claim 12 is proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Tsumura* and in further view of *Suzuki*.

This rejection is proposed by the third party requester in the third party comments (02/09/2011) and it is **not-adopted** and not applied against claim 12 for the following reasons. The claim ultimately depends upon claim rejections in newly proposed ground of rejection U. (Third Party 02/09/2011 proposed A.) which are not-adopted.

Ground AB. (Third Party 02/09/2011 proposed H.)

Claim 12 is proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Tashiro* in further view of *Suzuki*.

This rejection is proposed by the third party requester in the third party comments (02/09/2011) and it is **adopted** for claim 12 for the reasons set forth in the third party comments (section IV.H; which is hereby incorporated by reference).

Ground AC. (Third Party 02/09/2011 proposed I.)

Claims 4, 7 and 31-32 are proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Sanbe*.

This rejection is proposed by the third party requester in the third party comments (02/09/2011) and it is **not-adopted** and not applied against claims 4, 7 and 31-32 for the reasons explained in the non-final office action of 06/04/2012.

Ground AD. (Third Party 02/09/2011 proposed J.)

Claims 14, 29 and 31 are proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Sanbe* in further view of *Ballantyne*.

This rejection is proposed by the third party requester in the third party comments (02/09/2011) and it is **not-adopted** and not applied against claims 14, 29 and 31 for the reasons explained in the non-final office action of 06/04/2012.

Ground AE. (Third Party 02/09/2011 proposed K.)

Claim 30 is proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Sanbe* in further view of *Morales*.

This rejection is proposed by the third party requester in the third party comments (02/09/2011) and it is **not-adopted** and not applied against claim 30 for the reasons explained in the non-final office action of 06/04/2012.

Ground AF. (Third Party 02/09/2011 proposed L.)

Claim 8 is proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda*.

This rejection is proposed by the third party requester in the third party comments (02/09/2011) and it is **not-adopted** and not applied against claim 8 for the reasons explained in the non-final office action of 06/04/2012.

Ground AG. (Third Party 02/09/2011 proposed M.)

Claims 3, 5, 6, 11-13, 15-18 and 20-28 are proposed to be rejected under 35 U.S.C. 103(a) as being unpatentable over *Rhoades* in view of *Bush* in further view of *Tsumura*.

This rejection is proposed by the third party requester in the third party comments (02/09/2011) and it is **adopted** for claims 6, 21-25 and 27-28 for the reasons set forth in the third party comments (section IV.M; which is hereby incorporated by reference).

The rejection is **not-adopted** and not applied against claims 3, 5, 11-13, 15-18, 20 and 26 for the reasons explained in the non-final office action of 06/04/2012.

Examiner Initiated Rejections – 06/04/2012

The following is an explanation of the rejections initiated by the examiner: AH-AV.

Ground AH. (Examiner Initiated 06/04/2012)

Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Stokey*. NOTE: Although, the claim on which claims 2 and 8 are dependent has been amended, the overall combination of limitations is the same at the point of claims 2 and 8.

Claim 2:

Matsuda discloses a software distributing system for transmitting at least one of the program, the data, and a combination of the program and data *(Matsuda: page 5; first full paragraph, "an information rental system in which an information center is linked with a terminal block arranged in a house via communications line, the user of the terminal accesses the center to get desired information, references the index*

information attached to the obtained information to determine whether to rent or not, and, if rental is chosen, the rental information is transmitted to storage means of the terminal block via communications line for use at the terminal block"; and further page 5, last paragraph, "an information center holding various kinds of information data including game information, educational information, video information, and audio information"; page 4, "rental stores each has a system of business in which game software, education software, video software, audio software, and so on are rented"; page 10, section (g), "if the software is to be rented, the software information is transmitted to the storage means of the terminal block via communications line for use at the terminal block") stored in a database provided in a distribution center *(Matsuda: page 6, first full paragraph)* to a requested communication terminal device via communication lines *(Matsuda: page 5, first full paragraph, "information center is linked with a terminal block ... via communications line")*, storing the transmitted program, the data, and the combination of the program and data in a memory provided in the communication terminal device *(Matsuda: page 6, first full paragraph; page 8, "If the software is to be rented, the information data attached with that index data is read from the information data memory 12 of the information center 1 and transmitted to the terminal block 2 via the communication line 3 to be stored in the storage means 23 (105).")*, 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 *(Matsuda: page 7, first full paragraph, "the terminal block 2 may be a personal computer or a workstation"; page 9, top, "the information data stored in the storage means 23 of*

the terminal block 2 is appropriately displayed on the display means 24 or used by hardware means, not shown, for entertainment or education (106). If the information data is audio software, the user enjoys the rented software by means of an audio device"),

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 *(Matsuda: as above)*; 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 *(Matsuda: page 9, bottom "the information center 1 computes a rental fee on the basis of the type of the information data accessed by the terminal block 2 and the number of days during which the information data is rented. The amount of money thus computed is automatically withdrawn from a registered user's bank account (109)")*.

Matsuda does not explicitly state 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. *Stokey* demonstrated that it was known at the time of invention to

vary the use fee of software/information with the newness of the information (*Stokey: page 355, "Products like [computers, computer programs and first-run movies ... durable goods, including information] are often introduced on the market at a relatively high price, at which time they are bought only by individuals who both value them very highly and are very impatient. Over time, as the price declines, consumers to whom the product is less valuable or who are less impatient make their purchases"*). It would have been obvious to one of ordinary skill in the art at the time of invention to implement the information distribution and rental system of *Matsuda* with use fees being varied in accordance with the newness of the information as found in *Stokey*'s teaching. This implementation would have been obvious to one of ordinary skill in the art because: 1) both *Matsuda* and *Stokey* teach pricing for software and information; 2) a distributor/company would be motivated to attempt known theories of profit-maximization; and 3) the above implementation is with known elements being combinable in known ways to produce predictable results.

Claim 8:

Matsuda and *Stokey* disclose 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 *(as above under claim 2)*.

Ground AI. (Examiner Initiated 06/04/2012)

Claims 3, 6, 13, 21-26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Tashiro*.

Claim 3:

The limitations of claim 3 are substantially the same as for claim 2 and as such are rejected in a corresponding manner (though not including the "newness" limitation). Claim 3 adds the limitation of a "game information distribution system" to the mere "software distributing system" of claim 2. *Matsuda* discloses the limitation as well (*Matsuda: page 5, last paragraph, "an information center holding various kinds of information data including game information, educational information, video information, and audio information"*).

Additionally, *Matsuda* did not explicitly state 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. *Tashiro* demonstrated that it was known at the time of invention to establish multiple terminals and for these terminals to engage in interactive game play *(Tashiro: column 3, lines 16-20, 28-34; column 5, lines 47-57)* by transmitting game data associated with the game play between terminals either directly or through a central agent *(Tashiro: column 3, lines 21-27; column 6, lines 1-5; column 10, line 60 to column 11, line 13; figures 7 and 12)*. 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 multiple terminals configured for interactive game play as found in

Tashiro's teaching. This implementation would have been obvious because one of ordinary skill in the art would be motivated to extend the *Matsuda*'s potential 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.

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 potential 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.

Matsuda and *Tashiro* disclose wherein the game information comprises game data *(Matsuda: pages 4-5; Tashiro: column 3, lines 16-20, 28-34; column 5, lines 47-57; column 6, lines 1-5; figure 7, shows transmitting data related to game and charging for game)*.

Claim 6:

The limitations of claim 6 correspond to the limitations of claim 3 and as such are rejected in a corresponding manner to claim 3.

Claim 13:

Matsuda does not explicitly state the game information distribution system according to claim 3, wherein the game data comprises map data. *Tashiro* demonstrated that it was known at the time of invention to make use of games that comprise map data *(Tashiro: column 6, lines 1-5; figures 7 and 11(a) and 11(b))*. It would have been obvious to one of ordinary skill in the art at the time of invention to implement the game software distribution system of *Matsuda* with downloading/transmitting game information that comprises a map as found *Tashiro*'s teaching. This implementation would have been obvious because one of ordinary skill in the art would be motivated to extend the *Matsuda*'s potential market and commercial success to as many areas as possible including multiplayer map 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.

Claim 21:

Matsuda and *Tashiro* disclose the method for game information distribution according to claim 6, wherein the game data comprises map data. *Tashiro*

demonstrated that it was known at the time of invention to make use of games that comprise map data *(Tashiro: column 6, lines 1-5; figures 7 and 11(a) and 11(b))*. It would have been obvious to one of ordinary skill in the art at the time of invention to implement the game software distribution system of *Matsuda* with downloading/transmitting game information that comprises a map as found *Tashiro*'s teaching. This implementation would have been obvious because one of ordinary skill in the art would be motivated to extend the *Matsuda*'s potential market and commercial success to as many areas as possible including multiplayer map 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.

Claim 22:

Matsuda and *Tashiro* disclose the method for game information distribution according to claim 21, wherein the game play comprises a role-playing game *(Tashiro: column 3, lines 16-34; column 5, lines 47-57; column 6, lines 1-5; column 10, line 60 to column 11, line 13; figures 7, 11(a), 11(b) and 12; a racing game is the role of racing)*.

Claim 23:

Matsuda and *Tashiro* disclose the method for game information distribution according to claim 21, wherein the game information comprises advanced game data related to the game play *(Tashiro: column 3, lines 16-34; column 5, lines 47-57; column 6, lines 1-5;*

column 10, line 60 to column 11, line 13; figures 7, 11(a), 11(b) and 12).

Claim 24:

Matsuda and *Tashiro* disclose the method for game information distribution according to claim 23, wherein the advanced game data comprises additional map data related to the game play *(Tashiro: column 3, lines 16-34; column 5, lines 47-57; column 6, lines 1-5; column 10, line 60 to column 11, line 13; figures 7, 11(a), 11(b) and 12; additional map data are additional elements of a map or positioning information).*

Claim 25:

Matsuda and *Tashiro* disclose 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 *(Tashiro: column 3, lines 16-34; column 5, lines 47-57; column 6, lines 1-5; column 10, line 60 to column 11, line 13; figures 7, 11(a), 11(b) and 12).*

Claim 26:

Matsuda does not explicitly state 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. *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 potential 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.

Claim 28:

Matsuda does not explicitly state 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. *Tashiro* demonstrated that it was known at the time of invention to establish multiple terminals and for these terminals to engage in real-time interactive game play *(Tashiro: column 3, lines 16-20, 28-34; column 5, lines 47-57)* by transmitting position data associated with the game play between terminals either directly or through a central agent *(Tashiro: column 3, lines 21-27; column 6, lines 1-5; column 10, line 60 to column 11, line 13; figures 7 and 12)*. 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 multiple terminals configured for real-time interactive game play and position data as found in *Tashiro*'s teaching. This implementation would have been obvious because one of

ordinary skill in the art would be motivated to extend the *Matsuda*'s potential 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.

Ground AJ. (Examiner Initiated 06/04/2012)

Claims 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Stokey* in further view of *Sanbe*. NOTE: In light of the Patent Owner's amendments of 07/11/2012, the rejections of claims 7 and 32 under this ground of rejection have been **withdrawn**.

Claim 4:

The limitations of claim 4 are largely the same as for claim 2 and as such are rejected in a corresponding manner. Claim 4 adds the limitation of a "karaoke information distribution system" to the mere "software distributing system" of claim 2. *Matsuda* does not explicitly state a karaoke information distribution system. *Sanbe* demonstrated that it was known at the time of invention to utilize "a karaoke system characterized in that it comprises a karaoke data transmission device and a plurality of karaoke reproduction devices connected thereto through digital communication lines" where the karaoke transmission device has a large hard disk storage device on which is

recorded multiple song data, subtitle data and image data used for karaoke (*Sanbe: page 2, right column, bottom half*) in order to accomplish the objective of providing a karaoke system "being able to support multiple accesses with a single piece of software, allowing new songs to be accommodated immediately, making it possible to accurately know the karaoke usage conditions, having a small installation footprint and low initial cost, and having no limitations on the number of songs made available" (*Sanbe: page 2, right column, second paragraph*). It would have been obvious to one of ordinary skill in the art at the time of invention to implement the software/game/video/audio distribution system of *Matsuda* with distributing karaoke information as found in *Sanbe*'s teaching. This implementation would have been obvious because one of ordinary skill in the art would be motivated: [1)] to allow karaoke users access to new songs immediately and to have no limitations on the number of songs available to those users (*Sanbe: page 2, right column, second paragraph*); [2)] to spare users the pain of personally visiting stores for software products (*Matsuda: page 4, last paragraph*); and [3)] by both *Matsuda* and *Sanbe* teaching transmitting data from a distribution center with known elements being combinable in known ways to produce predictable results.

Additionally, claim 4 now contains newly added limitations "and movie data stored in another database", several references to the movie data, and "wherein the karaoke information comprises word data and accompaniment data associated with a song". *Matsuda* discloses the first and second *(Matsuda: pages 4-6, video information)*. Sanbe adds another database of karaoke information to the existing databases of

Matsuda. *Sanbe* discloses the third limitation *(Sanbe: page 2, right column, bottom half)*.

Ground AK. (Examiner Initiated 06/04/2012)

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Stokey* in further view of *Hornbuckle*. NOTE: Although, the claims on which claim 9 is dependent have been amended, the overall combination of limitations is the same at the point of claim 9.

Claim 9:

Matsuda and *Stokey* did not explicitly state 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. *Hornbuckle* demonstrated that it was known at the time of invention to charge a fee – billing and usage data uploaded – when information is downloaded (*Hornbuckle: column 16, lines 1-5*). It would have been obvious to one of ordinary skill in the art at the time of invention to implement the software distribution system of *Matsuda* with charging a fee every time information like a game is downloaded as found in *Hornbuckle's* teaching. This implementation would have been obvious because both *Matsuda* and *Hornbuckle* teach transmitting data from a distribution center and the above implementation is with known elements being combinable in known ways to produce predictable results.

Ground AL. (Examiner Initiated 06/04/2012)

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Stokey* in further view of *Suzuki*. NOTE: Although, the claims on which claim 10 is dependent have been amended, the overall combination of limitations is the same at the point of claim 10.

Claim 10:

Matsuda and *Stokey* do not explicitly state 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. *Suzuki* demonstrated that it was known at the time of invention to select items from a scrollable list (*Suzuki*: column 5, lines 22-31 and 53-64; column 6, lines 3-15; and column 8, lines 14-17). It would have been obvious to one of ordinary skill in the art at the time of invention to implement the game rental system and displayed game information of *Matsuda* with selection from a scrollable list as found in *Suzuki*'s teaching. This implementation would have been obvious because one of ordinary skill in the art would be motivated to make use of known mechanisms in a known manner to produce predictable results.

Ground AM. (Examiner Initiated 06/04/2012)

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Tashiro* in further view of *Hombuckle*.

Claim 11:

Matsuda and *Tashiro* did not explicitly state the game information distribution system according to claim 3, wherein the use fee is charged when the game information is downloaded. *Hombuckle* demonstrated that it was known at the time of invention to charge a fee – billing and usage data uploaded – when information is downloaded (*Hombuckle: column 16, lines 1-5*). It would have been obvious to one of ordinary skill in the art at the time of invention to implement the software distribution system of *Matsuda* with charging a fee every time information like a game is downloaded as found in *Hombuckle's* teaching. This implementation would have been obvious because both *Matsuda* and *Hombuckle* teach transmitting data from a distribution center and the above implementation is with known elements being combinable in known ways to produce predictable results.

Ground AN. (Examiner Initiated 06/04/2012)

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Stokey* in view of *Sanbe* and in further view of *Hombuckle*.

Claim 14:

Matsuda, *Stokey* and *Sanbe* did not explicitly state 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. *Hombuckle* demonstrated that it was known at the time of invention to charge a fee – billing and usage data uploaded – when information is downloaded (*Hombuckle: column 16, lines 1-5*). It would have been obvious to one of ordinary skill in the art at the time of invention to implement the software distribution system of *Matsuda* with charging a fee every time information like a game is downloaded as found in *Hombuckle's* teaching. This implementation would have been obvious because both *Matsuda* and *Hombuckle* teach transmitting data from a distribution center and the above implementation is with known elements being combinable in known ways to produce predictable results.

Ground AO. (Examiner Initiated 06/04/2012)

Claim 15 was rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Suzuki* and in further view of *Tashiro*. In light of the Patent Owner's amendments of 07/11/2012, the rejection of claim 15 under this ground of rejection has been **withdrawn**.

Ground AP. (Examiner Initiated 06/04/2012)

Claim 16 was rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Suzuki* and in further view of *Sanbe*. NOTE: In light of the Patent Owner's amendments of 07/11/2012, the rejection of claim 16 under this ground of rejection has been **withdrawn**.

Ground AQ. (Examiner Initiated 06/04/2012)

Claims 18 and 19 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Suzuki* and in further view of *Stokey*. NOTE: In light of the Patent Owner's amendments of 07/11/2012, the rejections of claims 18 and 19 under this ground of rejection have been **withdrawn**.

Ground AR. (Examiner Initiated 06/04/2012)

Claim 20 was rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Suzuki* and in further view of *Hombuckle*. NOTE: In light of the Patent Owner's amendments of 07/11/2012, the rejection of claim 20 under this ground of rejection has been **withdrawn**.

Ground AS. (Examiner Initiated 06/04/2012)

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Tashiro* and in further view of *Hombuckle*.

Claim 27:

Matsuda and *Tashiro* did not explicitly state the method for game information distribution according to claim 6, wherein the use fee is charged when the game information is downloaded. *Hombuckle* demonstrated that it was known at the time of invention to charge a fee – billing and usage data uploaded – when information is downloaded (*Hombuckle: column 16, lines 1-5*). It would have been obvious to one of ordinary skill in the art at the time of invention to implement the software distribution system of *Matsuda* with charging a fee every time information like a game is downloaded as found in *Hombuckle's* teaching. This implementation would have been obvious because both *Matsuda* and *Hombuckle* teach transmitting data from a distribution center and the above implementation is with known elements being combinable in known ways to produce predictable results.

Ground AT. (Examiner Initiated 06/04/2012)

Claim 29 was rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Stokey* in view of *Sanbe* and in further view of *Hombuckle*. NOTE: In light of the Patent Owner's amendments of 07/11/2012, the rejection of claim 29 under

this ground of rejection has been **withdrawn**.

Ground AU. (Examiner Initiated 06/04/2012)

Claim 30 was rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Stokey* in view of *Sanbe* and in further view of *Morales*. NOTE: In light of the Patent Owner's amendments of 07/11/2012, the rejection of claim 30 under this ground of rejection has been **withdrawn**.

Ground AV. (Examiner Initiated 06/04/2012)

Claim 31 was rejected under 35 U.S.C. 103(a) as being unpatentable over *Matsuda* in view of *Stokey* in view of *Sanbe* and in further view of *Ballantyne*. NOTE: In light of the Patent Owner's amendments of 07/11/2012, the rejection of claim 31 under this ground of rejection has been **withdrawn**.

Response to Arguments

Arguments made in the Patent Owner Response (07/11/2012; herein *PO Response*) and comments made in the Third Party Requester Comments (02/27/2013; herein *TPR Comments*) are addressed as follows:

Patent Owner Arguments

Patent Owner argues "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" (PO Response: page 10, specifically; and all of section A. generally).

This argument is fully considered but is not persuasive. Patent Owner presents multiple arguments as to why the limitation is not disclosed by the cited prior art.

First, it is irrelevant whether "the '508 Patent itself distinguishes between 'program' and 'data' and further teaches 'combination of the program and data'" (PO Response: page 9, second paragraph under section A.). The claim requires "at least one of the program, the data, and a combination of the program and data". Matsuda shows at least one of these elements as previously indicated (in fact, Matsuda shows all these elements).

Second, Patent Owner argues there is "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 could be rented either electronically or otherwise" (PO Response: page 10, first full paragraph). This argument is irrelevant as well since the claim language requires "at least one of the program, the data, and a

combination of the program and data" (a combination is not required by the claim language). However, Matsuda itself supports the notion of current rental stores disclosing the combination being rented (Matsuda: page 5, last paragraph, "an information center holding various kinds of information data including game information, educational information, video information, and audio information"; page 4, "rental stores each has a system of business in which game software, education software, video software, audio software, and so on are rented"). Game software is program and data (a game program without game data, of some sort, is useless to a consumer). Further, Matsuda indicates its purpose is to enable this game information (along with other information) to be rented and transmitted for consumers to make use of it. Additionally, under the broadest reasonable interpretation of the claim language in view of the Specification, the word combination does not define the manner of the combination (for example: what constitutes the combination, is it one unit or multiple units transmitted over time; and on definition of a combination is that the program is the executed portion of software and the data is the portion presented to the end-user/consumer/gamer).

Therefore, Patent Owner's arguments here are not persuasive. Primarily since the claim language does not require a combination of program and data. Secondarily, Matsuda discloses the combination in any event.

Patent Owner argues the cited prior art does not disclose "transmitting ... to at least another communication terminal device to facilitate interactive communication between the at least two communication terminal devices" (PO Response: pages 10-13, section B.).

This argument is fully considered but is not persuasive. Patent Owner presents multiple arguments as to why the limitation is not disclosed by the cited prior art.

First, Patent Owner argues the references separately and argues the references do no show limitations for which they are not cited. To clarify, Matsuda discloses "a distribution center" and transmitting game information/data from such a distribution center. Tashiro and Matsuda disclose "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" through Tashiro's multiple terminals and since these terminals engage in interactive game play. These elements of Tashiro are combined with the distribution center and transmitting found in Matsuda. The combination teaches the limitation in question.

Second, Patent Owner argues Tashiro does not disclose "the game information comprises game data" limitation (PO Response: page 12, last full paragraph). Matsuda is cited for teaching this limitation and Patent Owner does not argue otherwise. Matsuda demonstrates transmitting game information/data and charging for the use thereof. Though, Patent Owner has only broadly defined "game data", if at all. Tashiro is cited for transmitting data that is related to game play (the citation of Tashiro is clarified above). Matsuda and Tashiro are properly combined. Tashiro charges for use of its

game and data related to the game. Matsuda discloses "a distribution center" and transmitting "game data" therefrom. Tashiro is combined with that system and enhances it with additional data for which there is also a use charge.

Third, Patent Owner argues Matsuda and Tashiro cannot be properly combined (PO Response: page 13, last paragraph). Patent Owner appears to again look for every claim limitation in each reference, citing this failure as proof of non-combinability. This is incorrect and proper motivation for the combination is provided. Tashiro is cited as demonstrating the desirability of its features, including a plurality of players playing simultaneously (Tashiro: column 1, lines 20-24, "it is desirable ..."). The combination of Tashiro to Matsuda would have been obvious because one of ordinary skill in the art would be motivated to extend Matsuda's applicability to those clients/customers/markets interested in the desirability evidenced by Tashiro (see above citation). Further, Patent Owner simply does not address the motivation that the combination of Tashiro to Matsuda is an application of known techniques and known elements to yield predictable results.

For all these reasons, Patent Owner's arguments presented here are not persuasive.

Patent Owner argues the cited prior art does not disclose "'karaoke information and movie data' that are stored in different databases, and that are

both transmitted to a communication terminal device" (PO Response: page 14, section C.).

This argument is fully considered but is not persuasive. Patent Owner seems to misunderstand the rejection. Matsuda is cited for disclosing "movie data" which is stored in a database. Matsuda's "video information" is "movie data" under the broadest reasonable interpretation of the claim language in view of the specification. Sanbe is cited for disclosing another database storing "karaoke information". Sanbe is properly combined with Matsuda. Incredibly, Patent Owner doesn't mention Sanbe at all, and certainly doesn't deny its teachings or its proper and obvious combination with Matsuda. Therefore, Patent Owner's arguments are not persuasive.

Third Party Comments

Third Party Requester comments on the "Program, Data or Combination of Program and Data" limitation by stating "Patent Owner did not respond to previous rejections of Claims 1 and 5 and those rejections should be reinstated" (TPR Comments: section II.A.1).

Previously withdrawn Grounds of Rejection are not "reinstated" since no such procedure exists. However, it is noted that claims 1 and 5 (now returned to their original

state) are rejected with other proposed Grounds of Rejection (AW, AX, and BS) making use of similar art combinations as previously (B, E, and S).

Third Party Requester comments on the "Program, Data or Combination of Program and Data" limitation by stating "Patent Owner's construction of 'OR' to mean 'AND' should be rejected" (TPR Comments: section II.A.2).

This argument is fully considered and is persuasive (TPR Comments: page 4, last paragraph to page 6, first full paragraph, which is hereby incorporated by reference; excluding discussion of Roskowski).

Third Party Requester comments on the "Program, Data or Combination of Program and Data" limitation by stating "The prior art teaches the transmission of a program and data, and thus the prior art discloses this claim limitation" (TPR Comments: section II.A.3).

This argument is fully considered and is persuasive (TPR Comments: page 7, start of section to page 8, line 7, first full paragraph, which is hereby incorporated by reference; excluding discussion of Roskowski).

Third Party Requester comments on the "Program, Data or Combination of Program and Data" limitation by stating "As taught by the prior art, the transmission of video games requires both a program and data" (TPR Comments: section II.A.4).

This argument is fully considered and is persuasive (TPR Comments: page 8, start of section to page 10, last line, which is hereby incorporated by reference; excluding discussion of Roskowski).

Third Party Requester comments on the "Program, Data or Combination of Program and Data" limitation by stating "Patent Owner's reliance on portions of the specification highlights priority issue for independent claims 1 and 5" (TPR Comments: section II.A.5).

This argument is not persuasive. The addition of language "a combination of the program and data means" during a prosecution point does not preclude the subject matter from being disclosed previous to that point. For example, the 5,775,995 patent (priority dating back to before the example given by the third party requester) uses the phrase "game data" to refer to both the game program and the data on which the program operates (column 5, lines 49-60; also column 6, lines 1-56; a game program must include data from some source in order to function, the disclosure of a game is disclosure of the game and the data operated on by that game). The combination was

disclosed prior to Third Party Requester's example. The original Japanese application has similar language (starting at paragraph 0026).

Third Party Requester comments on the "Facilitates Interactive Communication" limitation by stating "Patent Owner's contention that the interactive communication limitation requires a 'system through which rented software, such as a game, can be downloaded and then played in an interactive fashion' is incorrect; even if it is correct, it is taught by the prior art" (TPR Comments: section II.B.1).

This argument is fully considered and is persuasive (TPR Comments: page 13, start of section II.B.1 to page 14, line 12, which is hereby incorporated by reference; excluding discussion of Tsumura).

Third Party Requester comments on the "Facilitates Interactive Communication" limitation by stating "The prior art teaches 'transmitting game data stored in a distribution center to a respective communication terminal device'" (TPR Comments: section II.B.2).

This argument is fully considered and is persuasive (TPR Comments: page 14, start of section to page 15, line 10, which is hereby incorporated by reference; excluding discussion of Tsumura).

Third Party Requester comments on the "Facilitates Interactive Communication" limitation by stating "The prior art teaches to 'facilitate interactive communication between the art least two communication terminal devices regarding the game information'" (TPR Comments: section II.B.3).

This argument is fully considered and is persuasive (TPR Comments: page 15, start of section to page 18, line 7, which is hereby incorporated by reference; excluding discussion of Tsumura).

Third Party Requester comments on the "Facilitates Interactive Communication" limitation by stating "The prior art of record teaching the 'interactive communication' limitation is properly combinable" (TPR Comments: section II.B.4).

This argument is fully considered and is persuasive (TPR Comments: section II.B.4, which is hereby incorporated by reference).

Third Party Requester comments on the "Karaoke information and movie data" limitations by discussing "Different Databases" (TPR Comments: section II.C.1).

This argument is fully considered and is persuasive (TPR Comments: page 19, last two lines to page 21, line 5, which is hereby incorporated by reference).

Third Party Requester comments on the "Karaoke information and movie data" limitations by discussing "Movies" (TPR Comments: section II.C.2).

This argument is fully considered and is persuasive, though it is unnecessary and improper to incorporate a new obviousness statement here. As used by Matsuda (and evidenced by the citations of Matsuda, including page 6's "video rental store"), video and movie are the same.

Third Party Requester comments "the Zyda Declaration complies with the applicable requirements and should be considered by the Examiner" (TPR Comments: section IV.).

This argument is fully considered and is not persuasive. Third Party Requester does not actually address the points previously presented regarding the Zyda Declaration. For the Third Party Requester's convenience, the original response to the Zyda Declaration is reproduced here (though it is noted that the claims have been amended and the grounds of rejection have been updated since the declaration and the response to the declaration).

In addition to the explanations under the grounds of rejections, the Zyda Declaration under 37 CFR 1.132 filed 02/09/2011 is insufficient to establish a position of adoption of the Third Party proposed grounds of rejection (NOTE: this section refers to the Third Party proposed grounds of rejection of 02/09/2011) based upon the cited prior art as set forth, for the following reasons:

1) The declaration is inadmissible. The declaration under 37 CFR 1.132 filed 02/09/2011 introduces additional prior art which is not necessary to rebut a finding of fact by the examiner or a response by the patent owner. Section II., pages 2-3 of the Third Party Comments, discusses the prior art to be discussed including art which is necessitated by either the patent owner response or examiner findings of fact. At least paragraphs 9, 18 and 22 discuss U.S. Patent 4,814,592 to *Bradt* et al. The Third Party Comments do not assert or list this patent as among those necessary for rebuttal of the patent owner or examiner. Therefore, under 37 CFR 1.948(a) the declaration filed 02/09/2011 is inadmissible.

2) The Zyda Declaration inappropriately expound upon more than the contents or pertinent dates of the prior art patents or printed publications. A request for reexamination must be based on prior art patents and printed publications. 35 U.S.C. § 311(a). However, affidavits or declarations which explain the contents or pertinent dates of prior art patents or printed publications in more detail may be considered in reexamination. See MPEP 2616 and 2258. The Zyda Declaration does not explain the references, but introduces new external teachings to supplement the references. First, in relation to the non-disclosed limitation "the at least two communication terminal

devices display the number of players who can participate in the game play" (claim 3), the Zyda Declaration does not simply explain the references, but discusses and cites additional sources: paragraph 30. Second, in relation to the non-disclosed limitation "... device displays a scrollable list ..." (claim 5; NOTE: this claim has been amended since the Zyda Declaration), the Zyda Declaration does not simply explain the references, but discusses and cites additional sources: paragraphs 34-36. Third, in relation to the non-disclosed limitation "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" (claim 18), the Zyda Declaration does not simply explain the references, but discusses and cites additional sources: paragraphs 18, 20 and 22. The Zyda Declaration repeatedly attempts to incorporate teachings from other sources and does not merely explain the teachings of the cited prior art of the current grounds of rejection as required in reexamination. In fact, under each topic heading the Zyda Declaration actually seems to support the idea that the cited prior art of the grounds of rejection does not disclose the missing limitations. The Zyda Declaration is considered only to the extent it explains the contents or pertinent dates of prior art patents or printed publications in more detail. The Zyda Declaration is not convincing for demonstrating the cited references of the current grounds of rejection demonstrate the above discussed missing limitations.

3) The declaration under 37 CFR 1.132 filed 02/09/2011 is insufficient to clearly establish a statement of fact found as required for obvious analysis. The proposed grounds of rejection do not establish a common sense analysis. The proposed grounds of rejection do not clearly establish the source of certain limitations (see the following

discussion of proper obvious type rejections). Without such citations of source and rational to form a basis for rejection, the Patent Owner is not afforded the opportunity to adequately traverse the rejection.

For example, in Ground A. *Matsuda* does not disclose the limitation "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". Nor does the Ground A. proposal establish a finding of fact for the missing limitation. *Matsuda* does not show the limitation and the current declaration does not even assert that it does (there is no citation in *Matsuda* of newness). The Office Action of 08/31/2010 correctly attested to this fact. Therefore, the declaration fails to overcome the established positions of adoption and non-adoption of the originally proposed grounds of rejection.

4) The declaration under 37 CFR 1.132 filed 02/09/2011 is not persuasive because it is confusing as to the findings of fact for obviousness regarding the "Players", "Scrollable" and "Newness" limitations. For example with regard to the "Players" limitation, the declaration states various facts to be known to one of ordinary skill in the art and available to such a person in a *common sense* analysis (Zyda Declaration: paragraphs 24 and 26). Then the comments and declaration refer to art that apparently might have qualified as prior art printed publications that could have been cited in the request for reexamination (Zyda Declaration: paragraphs 27-28 and 30). The declaration treats the "Scrollable" and "Newness" limitations in the same defective manner.

5) Instead of rebutting the findings of an office action, the declaration attempts to cite new art to replace art originally advanced. Rather than rebutting the findings in the Office action that the cited prior art does not disclose the limitation "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," as recited in claim 2, the requester appears to use the Zyda declaration as a vehicle to cite new art to replace the art originally advanced. 37 CFR 1.948(a)(1) does not permit such substitutions. See MPEP 2666.05.

Action Closing Prosecution

This is an ACTION CLOSING PROSECUTION (ACP); see MPEP § 2671.02.

(1) Pursuant to 37 CFR 1.951(a), the patent owner may once file written comments limited to the issues raised in the reexamination proceeding and/or present a proposed amendment to the claims which amendment will be subject to the criteria of 37 CFR 1.116 as to whether it shall be entered and considered. Such comments and/or proposed amendments must be filed within a time period of 30 days or one month (whichever is longer) from the mailing date of this action. Where the patent owner files such comments and/or a proposed amendment, the third party requester may once file comments under 37 CFR 1.951(b) responding to the patent owner's submission within 30 days from the date of service of the patent owner's submission on the third party requester.

(2) If the patent owner does not timely file comments and/or a proposed amendment pursuant to 37 CFR 1.951(a), then the third party requester is precluded from filing comments under 37 CFR 1.951(b).

(3) Appeal **cannot** be taken from this action, since it is not a final Office action.

Important Reexamination Notices

Extensions of Time

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 314(c) requires that reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.937(a)). Patent Owner extensions of time in *inter partes* reexamination proceedings are provided for in 37 CFR 1.956. Extensions of time are not available for third party requester comments, because a comment period of 30 days from service of patent owner's response is set by statute. 35 U.S.C. 314(b)(2).

Service of Papers

After filing of a request for *inter partes* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party (or parties where two or more third party requester proceedings are merged) in the reexamination proceeding in the manner provided in 37 CFR 1.248. The document must reflect service or the document may be refused consideration by the Office. See 37 CFR 1.550(f) and 1.903.

Litigation Reminder

The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) and 1.985(a) to apprise the Office of any litigation activity, or other prior or

concurrent proceeding, involving Patent No. 6,488,508 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282, 2286, 2682 and 2686.

Correspondence Information

All correspondence relating to this *Inter Partes* reexamination proceeding should be directed:

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

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

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

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

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

/William H. Wood/
Primary Examiner, CRU AU 3992
April 16, 2013

Conferees:

ALEXANDER J. KOSOWSKI
Supervisory Patent Reexamination Specialist
CRU -- Art Unit 3992

/D. B./

Primary Examiner, Art Unit 3992