

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Attorney Docket No.: 4624.01US12

John Mikkelsen et al.

Confirmation No.: 1253

Application No.: 14/230,938

Examiner: Robert M. Pond

Filed: March 31, 2014

Group Art Unit: 3684

For: MEDIA DELIVERY PLATFORM

AMENDMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Commissioner:

INTRODUCTORY COMMENTS

In response to the Office Action of May 22, 2014, amendment to the above-identified patent application is requested.

The present amendment comprises the following sections:

A. Amendments to the Claims

B. Remarks

Please grant any extension of time necessary for entry; charge any fee due to Deposit Account No. 16-0631.

AMENDMENTS TO THE CLAIMS

A detailed listing of all claims that are, or were, in the present application, irrespective of whether the claim(s) remain(s) under examination in the application is presented below. The claims are presented in ascending order and each includes one status identifier. Those claims not cancelled or withdrawn but amended by the current amendment utilize the following notations for amendment: 1. deleted matter is shown by strikethrough for six or more characters and double brackets for five or fewer characters; and 2. added matter is shown by underlining.

1.(Original) A system for providing media files, the system comprising:

a wireless network accessible by an electronic device;

a content server operably coupled to the wireless network and configured to store a plurality of media files and provide the media files for download to the electronic device; and

a monitoring server operably coupled to the wireless network and configured to record data about every media file downloaded from the content server to the electronic device.

2. (Original) The system of claim 1, wherein each of the plurality of media files comprises at least one of a full, partial, or segment of: a song, a musical score, musical composition, other audio recording, a ringtone, a video, other visual recording, a movie, a film, an image clip, a picture, a clip, an image, a photograph, a television show, a human voice recording, a personal recording, a cartoon, an animation, an audio advertisement, a visual advertisement, or combinations thereof.

3. (Original) The system of claim 1, wherein the monitoring server is further configured to count every media file downloaded from the content server to the electronic device.

4. (Original) The system of claim 1, wherein the data recorded by the monitoring server is at least one of a song title, an artist name, a purchase price, a user name, or a time of delivery.

5. (Original) The system of claim 1, wherein the monitoring server is further configured to aggregate the recorded data and transmit the aggregated data to a third-party device.

6. (Original) The system claim 1, wherein the wireless network uses orthogonal frequency-division multiplex (OFDM) modulation.

7. (Original) The system of claim 1, wherein the content server is further configured to provide an interface for the selection of one of the plurality of media files to be downloaded to the electronic device.

8. (Original) The system of claim 7, wherein the media files are organized on the interface by at least one of: a type of media file, a title, a subject, an actor, an artist, a description of the media file, an alphabetical ordering, or a chronological ordering.

9. (Original) The system of claim 7, wherein the electronic device is at least one of a cellular phone, land line phone, computer, clock, watch, pager, door bell, car alarm, palm pilot, personal calendar, tablet, or laptop-type viewer device.

10. (Original) A method for distributing electronic content to a user operating an electronic device, the method being executable by a computer system that includes server hardware and a database, the method comprising:

providing, by the computer system, a database of electronically-accessible data files, each data file being subject to a copyright owner;

receiving, by the computer system, a selection from the user corresponding to at least one of the data files;

providing, by the computer system and in response to the received selection, a portion of the selected data file to the electronic device;

receiving, by the computer system, a request for the data file for which the portion was provided to the electronic device; and

transmitting, by the computer system, the requested data file to the electronic device.

11. (Original) The method of claim 10, further comprising:

debiting, by the computer system, an account of the user corresponding to a price of the transmitted data file; and

crediting, by the computer system, an account of the copyright owner an amount associated with the price of the transmitted data file.

12. (Original) The method of claim 10, further comprising:

tracking, by the computer system, the user of the electronic device receiving the data file to determine data about the user; and

reporting, by the computer system and to the copyright owner, the data about the user.

13. (Original) The method for distributing electronic content to a user of claim 10, further comprising tracking, by the computer system, the user of the electronic device receiving the portion of the data file to determine data about the user.

14. (Original) The method of claim 10, further comprising providing an interface, by the computer system, for the selection of one of the electronically-accessible data files.

15. (Original) The method of claim 14, wherein the electronically-accessible data files are organized on the interface by at least one of: a type of media file, a title, a subject, an actor, an artist, a description of the media file, an alphabetical ordering, or a chronological ordering.

16. (Original) The method of claim 14, wherein each of the electronically-accessible data files comprises an identifier associated with the copyright owner.

17. (Original) The method of claim 14, wherein the computer system is operably coupled to a network that uses orthogonal frequency-division multiplex (OFDM) modulation.

18. (Currently Amended) A method for distributing electronic content to a user operating an electronic device, the method being executable by a computer system that includes server hardware and a database, the method comprising:

[[means]] step for providing a database of electronically-accessible data files, each data file being subject to a copyright owner;

[[means]] step for-receiving a selection from the user corresponding to at least one of the data files;

[[means]] step for providing, in response to the received selection, a portion of the selected data file to the electronic device;

[[means]] step for receiving a request for the data file for which the portion was provided to the electronic device; and

[[means]] step for transmitting the requested data file to the electronic device.

19. (Currently Amended) The method of claim 18, further comprising:

[[means]] step for debiting an account of the user corresponding to a price of the transmitted data file; and

[[means]] step for crediting an account of the copyright owner an amount associated with the price of the transmitted data file.

20. (Currently Amended) The method of claim 18, further comprising:

[[means]] step for tracking the user of the electronic device receiving the data file to determine data about the user; and

[[means]] step for reporting the data about the user to the copyright owner.

REMARKS

Claims 1-20 are pending. By this Amendment, no claims are cancelled, claims 18-20 are amended and no new claims are added.

35 USC § 112

Claims 18-20 were rejected under 35 U.S.C. 112(b) or 35 U.S.C. 112 (pre-AIA), second paragraph as being indefinite for failing to point out and distinctly claims the subject matter which the inventor, or for pre-AIA, the applicant regards as the invention. Claims 18-20 are amended.

35 USC § 102

Claims 1-5, 7-16 and 18-20 were rejected under 35 USC 102(e) as being anticipated by Fritsch (US 6,247,130).

Applicants respectfully traverse this rejection. Referring to Fritsch, Applicants respectfully submit that Fritsch does not disclose a system for a *wireless network* delivering a digital media from one or more servers to a device with enough specificity, as claimed. Particularly, Fritsch merely discloses a single boilerplate instance where the term “wireless” is used:

As a general overview, the present invention includes a system and method for maintaining a music web site on the Internet. Consumers may access the web site via a personal computer or any other *wired or wireless* Internet access device, such as WebTV, personal digital assistant, cellular telephone, etc., to obtain a variety of services and products.

(Fritsch, col. 2, l. 64 – col. 3, l. 2, emphasis added.) Otherwise, the entirety of Fritsch is directed towards desktop computer or personal computer (PC) access to a vendor’s website.

It is difficult but necessary that the decision maker forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). To reach a proper determination under 35 U.S.C. § 103, the examiner must step backward in time and into the shoes worn by the hypothetical “person of ordinary skill in the art” when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention “as a whole” would have been obvious at that time to that person. (MPEP § 2142.) The disclosure of Fritsch does not rise to the level required such that the claimed invention as a whole would have been obvious to one skilled in the art, at the time the invention was made. Particularly, Fritsch does not disclose the details necessary for wireless delivery of digital media to a wireless device.

For example, referring to the Freidson declaration (“Freidson declaration”) submitted August 5, 2008, in a parent case to the instant case (U.S. Application No. 10/183,756; now US 7,548,875):

At the time of the inventive subject matter set forth in the claims in the subject application to my knowledge, there was no experience or teaching available anywhere in the world with respect to wireless delivery of rich media files to cell phones. Moreover, at that time of the invention cell phones had very small amounts of memory and very slow DSP (digital signal processor), there was not an open operating system to work with or to refer to (e.g. no smartphones) and cell phone data and/or voice channels had very poor bandwidth (actually 9.6 Kbit/sec or less) and rather low quality (permanent loss of signal).

(Paragraph 4.)

Moreover, referring particularly to the problem of wireless delivery of rich media files:

Because of the complete absence of teaching and other circumstances mentioned above at the time of the invention, I had to develop an engineering solution to solve the problem of wireless delivery of rich media files to cell phones. I developed a new and novel conceptual design based on my scientific and technical background in wireless (radio) communication systems, and I made several laboratory prototypes to find and test different complex engineering solutions (e.g. OFDM).

(Freidson declaration, paragraph 5.)

It was unknown at the time of my invention to employ OFDM principles to the wireless delivery method of my invention. It was unknown at the time of my invention to employ OFDM to the wireless delivery over an audio channel to a cell phone because OFDM had not been employed in such a way at that time, and I had to be the first one to make such a phone in which to apply OFDM to, as such phone didn't exist and correspondent hardware/firmware didn't exist.

(Freidson declaration, paragraph 11.)

In contrast, Fritsch is silent as to any of the details of how wireless delivery of digital media to a wireless device might be implemented. Rather, Fritsch describes basic PC-server access over the Internet. For example:

In the preferred embodiment, a PC user logs on to the Internet to access the World Wide Web portion thereof using a web browser program. That is, the PC user selects and enters a URL address for the vendor's web site on her computer, and a communication link is established between the PC user and the selected vendor's web site. The request from the browser goes out to the server using the Internet (HTTP) protocol. Using SQL commands, the server then accesses the database maintaining the requested URL address information, and the HTML-based results are transferred from the database to the server and subsequently to the client's browser for display on the PC user display monitor.

FIG. 1A shows an illustration of the video display screen 10 as viewed by the PC user after connecting to the vendor's web site for distributing musical products.

(Fritsch, col. 3, ll. 34-49.) Fritsch therefore cannot provide disclosure at the level required such that the claimed invention as a whole would have been obvious to one skilled in the art, at the time the invention was made.

35 USC § 103

Claims 6 and 17 were rejected under 35 USC 103(a) as being unpatentable over Fritsch (US 6,247,130) in view of Kontio et al. (US 2005/00004875). Applicants traverse based on the argument above regarding Fritsch.

Applicants further direct the Examiner to a declaration under 37 CFR 1.131 from co-inventors John Mikkelsen and Dr. Robert Freidson, submitted in related application 14/057,672 and attached hereto, showing that the claimed invention was conceived and reduced to practice prior to July 6, 2001, the earliest priority date of Kontio. Applicants respectfully submit that this affidavit is sufficient to show that Applicants' invention at least predates the invention of Kontio. For at least these reasons, Applicants respectfully request that the obviousness rejections based on the combination of Fritsch and Kontio be withdrawn.

Patentable Subject Matter

While the instant claims have not been rejected under 35 U.S.C. § 101, in light of rejections to claims in co-pending continuation cases under 35 U.S.C. § 101 and recent Supreme Court decisions, Applicants make particular mention that the instant claims recite patentable subject matter.

Under the Preliminary Examination Instruction guidelines issued June 25, 2014, in view of the Supreme Court decision in *Alice Corporation Pty. Ltd. v. CLS Bank International, et al.*, Applicants respectfully submit that the instant claims recite patentable subject matter under an analysis of Part 1. The claims do not recite abstract ideas such as, for example, fundamental

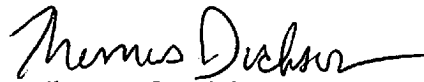
economic practices, methods of organizing human activities, ideas of themselves, or mathematical relationships or mathematical formulas. Instead, the claims recite, for example, methods of wirelessly delivering a digital media from one or more servers to a wireless device means, which is plainly outside of the ideas intended to be deemed non-patentable by the Supreme Court.

Assuming, *arguendo*, that the instant claims are not identified as patentable subject matter under Part 1, the instant claims recite significantly more than any abstract idea itself under an analysis of Part 2. As described above with reference to the Freidson declaration, at the time of invention, the claims recite the inventive results of an engineering solution to the problem of the existing state of wireless delivery of rich media files. As a result, the instant claims provide an improvement to wireless delivery of rich media technology.

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,


Thomas G. Dickson
Registration No. 51616

Customer No. 24113
Patterson Thunte Pedersen, P.A.
4800 IDS Center
80 South 8th Street
Minneapolis, Minnesota 55402-2100
Telephone: 612.349.3004