

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Attorney Docket No.: 4624.01US11

John Mikkelsen et al.

Confirmation No.: 7483

Application No.: 14/230,906

Examiner: Robert M. Pond

Filed: March 31, 2014

Group Art Unit: 3684

For: MEDIA DELIVERY PLATFORM

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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 December 12, 2014, and in accordance with the automatic extension of time for response provided by 37 CFR § 1.136(a), 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 Those claims not cancelled or withdrawn but amended by the current amendment utilize the following notations for amendment: 1.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. (Currently Amended ) A method for wirelessly transmitting over a cellular network a data file between a cellular phone ~~wireless device~~ and a server, the server comprising a non-transitory virtual storage locker, the method comprising:

receiving a data file from the cellular phone, said cellular phone including a receiver and a digital signal processor configured for receiving and processing data files transmitted by orthogonal frequency-division multiplex modulation;

~~wireless device~~;

storing, in the virtual storage locker, the data file received from the cellular phone ~~wireless device~~;

receiving a request for the data file; and

providing for the transmission of ~~transmitting~~ the data file to the cellular phone ~~wireless device means~~ using orthogonal frequency-division multiplex (OFDM) modulation in response to the received request from the cellular phone.

2. (Original) The method of claim 1, wherein the data file 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. (Cancelled).

4. (Currently Amended) The method of claim 1, wherein receiving the request for the data file comprises receiving the request from a second cellular phone device, and wherein transmitting the data file based on the received request comprises transmitting the data file to the second cellular phone using OFDM modulation device.
5. (Cancelled).
6. (Currently Amended) The method of claim 4, further comprising charging an account associated with a user of the second cellular phone device.
7. (Cancelled).
8. (Currently Amended) The method of claim 1, further comprising providing a representative image of the data files in the virtual storage locker for selection of the data file to be transmitted.
9. (Currently Amended) The method of claim 8 [[7]], wherein providing for selection of the data file to be transmitted comprises listing the data file in alphabetical order among a plurality of data files.

10. (Currently Amended) The method of claim 8 [[7]], wherein providing for selection of the data file to be transmitted comprises listing the data file in chronological order among a plurality of data files.
11. (Cancelled).
12. (Currently Amended) The method of claim 1, further comprising storing at least a portion of the data file on the cellular phone ~~wireless device~~.
13. (Currently Amended) The method of claim 1, further comprising:
  - associating, in response to receiving the data file from the cellular phone ~~wireless device~~,
  - a unique identifier with the data file and a user of the cellular phone ~~wireless device~~;
  - evaluating the unique identifier; and
  - identifying the data file based on the unique identifier in response to receiving the request for the data file.
14. (Currently Amended) A system for wirelessly transmitting a digital data file to a cellular phone ~~wireless device~~, the system comprising:
  - a server including a non-transitory virtual storage locker configured to store a plurality of data files; and

a cellular communication network operably coupling the server and the cellular phone,  
said cellular phone including a receiver and a digital signal processor configured for receiving  
and processing files transmitted by orthogonal frequency-division multiplex modulation;  
~~wireless device,~~

wherein the server is configured to:

receive a data file from the cellular phone ~~wireless device~~ over the  
communication network,

store, in the virtual storage locker, the data file received from the cellular phone  
~~wireless device,~~

receive a request for the data file over the cellular communication network, and  
providing for the transmission of ~~transmit~~ the data file over the cellular  
communication network using orthogonal frequency-division multiplex modulation in  
response to the received request.

15. (Currently Amended) The system of claim 14, wherein the digital data file 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.

16. (Currently Amended) The system of claim 14, wherein the request for the data file is received from the cellular phone ~~wireless device~~, and wherein the data file is transmitted to the cellular phone ~~wireless device~~ in response to the received request.

17. (Currently Amended) The system of claim 14, wherein the request for the data file is received from a second cellular phone ~~wireless device~~, and wherein the data file is transmitted to the second cellular phone ~~wireless device~~ in response to the received request.

18. (Original) The system of claim 17, wherein the server is further configured to debit an account associated with a user of the second device.

19. (Cancelled).

20. (Currently Amended) A method for transmitting compressed digital audio of video data files, the method comprising:

providing a website accessible over a ~~wireless~~ cellular communications network;

providing a library database operably associated ~~coupled~~ to the website, the database configured to store a plurality of data files;

updating the database ~~receiving~~, through the website and over the ~~wireless~~ cellular communications network, a data file received from a first cellular device;

storing, in the database, the data file received from the first cellular device;

providing for the transmission to the first cellular device a representation of at latest a portion of the updated library database, wherein the first cellular device includes a receiver and a digital signal processor configured for receiving and processing files transmitted by orthogonal frequency-division multiplex modulation;

receiving, from the first cellular device, through the website and over the ~~wireless~~ cellular communications network, a request for the received data file ~~from device;~~

~~querying the database for the requested data file; and~~

providing for the transmission of ~~transmitting~~ the data file over the cellular ~~wireless~~ communications network using orthogonal frequency-division multiplex modulation in response to the received request ~~to the second device.~~

Please add new claim 21 as follows:

21. (New) The method for transmitting compressed digital audio of video data files of claim 20, wherein a second cellular device has access to the library database.



REMARKS

Claims 1-20 are pending. By this Amendment, claims 3, 5, 7, 11, and 19 are cancelled, claims 1, 4, 6, 8-10, 12-17, and 20 are amended and new claim 21 is added.

**35 USC § 101**

Claims 1-20 were rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Applicants respectfully traverse. Applicants have amended the independent claims to include limitations regarding elements of a cell phone that clearly warrant removal of the 101 rejection.

Applicants' response is based on the Interim Guidelines on Patent Subject Matter Eligibility promulgated by the USPTO on December 16, 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 digital media from one or more servers to a cell phone, 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. 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, which include a DSP, provide an improvement to wireless delivery of rich media technology. The rejection of the remaining claims should be removed.

### 35 USC § 102

Claims 1-6, 8, 11-18, and 20 were rejected under 35 USC 102(e) as being anticipated by Gudorf (US 2002/0116082), previously applied.

Applicants respectfully traverse. Gudorf discloses a general purpose computer configured to upload to a content server. The only delivery mechanism that has been mentioned in the patent is sending and receiving information over the World Wide Web, such as through web pages or files. For example, as cited by the Office Action:

First, the user encodes audio compact discs from red book format or an analog source into electronic digital files (step 202). The files are preferably compatible With MPEG-3 format or Sony's ATRAC3 format and are encoded *with a general purpose computer*, such as computer 60, or a dedicated device. The user then causes end user computer 60 to access the content server 70 via the Internet 80 (such as by logging onto a Web page) (step 204), supplies its User ID 112 (step 206) and then uploads the files to the content server 70 (step 208).

(Gudorf, para. [0025]; emphasis added.)

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "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). The disclosure of Gudorf does not rise to the level required to anticipate. Particularly, Gudorf does not disclose the details necessary for wireless delivery over a cellular network of digital media to a cell phone device. To further distinguish the present case, applicants have amended to include a cellular communications network. The term “cellular” does not appear in Gudorf.

This is not surprising as applicants have stated in prosecution of the parent case that the technology did not exist when the invention was conceived. 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.)

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

Claims 3, 5, and 11 are cancelled. Thus the rejection of claims 1, 2, 4, 6, 8, 12-18, and 20 should be removed.

**35 USC § 103**

Claims 7 and 9 were rejected under 35 U.S.C. 103(a) as being unpatentable over Gudorf (US 2002/0116082), previously applied, in view of Kontio et al. (US 2005/0004875), previously applied.

Claims 9 and 10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Gudorf (US 2002/0116082), previously applied, in view of Kontio et al. (US 2005/0004875), previously applied, as applied to claim 7, further in view of Nathan et al. (US 6,182,126), previously applied.

Applicants direct the Examiner to the response above. As the independent claims have all been amended, the rejection of the dependent claims are moot.

With respect to Kontio, Applicants further direct the Examiner to a declaration under 37 CFR 1.131 from co-inventors John Mikkelsen and Dr. Robert Freidson, 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 combinations of Gudorf and Kontio, and Gudorf, Kontio and Nathan be withdrawn.

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,

A handwritten signature in black ink, appearing to read "Thomas G. Dickson". The signature is fluid and cursive, with the first name "Thomas" being more prominent.

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