REMARKS

Claims 1-17 are pending. By this Amendment, no claims are cancelled, no claims are amended and no new claims are added.

Double Patenting

Claims 1-17 were rejected on the ground of nonstatutory double patenting as being unpatentable over claim 1 of US Patent 7,548,875. Should the claims be indicated as allowable but-for a nonstatutory obviousness-type double patenting rejection in a subsequent Office Action, Applicants will address this issue with the appropriate disclaimer at that time.

35 USC § 103

Claims 1-4, 7-10 and 13-15 were rejected under 35 USC 103(a) as being unpatentable over Frisch (US 6,247,130) in view of Kontio et al. (US 2005/0004875).

Claims 5, 6, 11, 12, 16 and 17 were rejected under 35 USC 103(a) as being unpatentable over Frisch (US 6,247,130) and Kontio et al. (US 2005/0004875), further in view of Chen et al. (US 2003/0115041).

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.

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 of claims 1-17 based on the combination of Fritsch and Kontio, and Fritsch, Kontio and Chen 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,

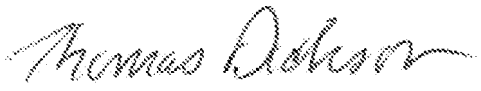
methods of wirelessly delivering a digital media from one or more servers to a wireless device means, which is plainly outside of the ideas intended to be deemed non-patentable by the Supreme Court.

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,



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