

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Attorney Docket No.: 4624.01US03

John Mikkelsen

Confirmation No.: 7568

Application No.: 14/057,672

Examiner: Robert M. Pond

Filed: October 18, 2013

Group Art Unit: 3684

For: MEDIA DELIVERY PLATFORM

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PRELIMINARY AMENDMENT

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

Commissioner:

INTRODUCTORY COMMENTS

Prior to examination, please amend the above-identified application as follows:

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 Those claims not cancelled or withdrawn but amended by the current amendment utilize the following notations for amendment: 1.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 of wirelessly delivering a digital media from one or more servers to a wireless device ~~means~~, the digital media comprising at the wireless device including a digital signal processor configured for receiving digital media transmitted by orthogonal frequency-division multiplex (OFDM) modulation, least one of digital audio data or digital visual data or a combination thereof, the method comprising:

configuring the digital media for transmission by having the digital media compressed and ~~compressing the digital media~~; storing the compressed digital media in one or more storage mediums; and

transmitting at least a portion of the digital media to the wireless device means,

wherein the digital media comprises at least one of a full, partial, or segment of: a song, a musical score, a musical composition, a ringtone, a video or video segment, a movie or movie segment, a film or film segment, 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.

2. (Canceled)

3. (Currently Amended) The method of claim ~~[[2]]~~ 1, further comprising providing selection of the compressed digital media to be transmitted to the wireless device ~~means~~.

4. (Currently Amended) The method of claim ~~[[2]]~~ 1, further comprising providing the compressed digital media as an alert message or ringtone for the wireless device ~~means~~.

5. (Currently Amended) The method of claim [[2]] 1, wherein the wireless device ~~means~~ is a cell phone.

6. (Original) The method of claim 5, further comprising storing at least a portion of the compressed digital media on the cell phone.

7. (Currently Amended) The method of claim [[2]] 1, further comprising storing at least a portion of the compressed digital media on the wireless device ~~means~~.

8. (Currently Amended) The method of claim [[2]] 1, further comprising charging a fee for access to compressed digital media to be transmitted to the wireless device ~~means~~.

9. (Currently Amended) A method of wirelessly ~~delivering~~ providing a digital media from a server to a wireless device ~~means~~, the wireless device including a digital signal processor configured for receiving digital media transmitted by orthogonal frequency-division multiplex (OFDM) modulation, the digital media comprising at least one of digital audio data or a digital visual data or a combination thereof, the method comprising:

compressing the digital media;

storing the compressed digital media on the server; and

transmitting at least a portion of the compressed digital media from the server to the wireless device means, wherein the transmission includes the use of ~~orthogonal frequency-division multiplex~~ (OFDM[[D]]) modulation over a cellular connection.

10. (Original) The method of wirelessly delivering the digital media of claim 9, wherein the digital media file comprises at least one of a full, partial, or segment of: a song, a musical score, a musical composition, a ringtone, a video or video segment, a movie or movie segment, a film or film segment, an image clip, a clip, an image, a photograph, a picture, a television show, a human voice recording, a personal recording, a cartoon, an animation, an audio advertisement, a visual advertisement, or combinations thereof.

11. (Currently Amended) The method of claim 9, further providing selecting the compressed digital media to be transmitted to the wireless device means.

12. (Currently Amended) The method of claim 9, wherein the wireless device means is a cell phone.

13. (Original) The method of claim 12, further comprising storing at least a portion of the compressed digital media on the cell phone.

14. (Currently Amended) The method of claim 9, further comprising storing at least a portion of the compressed digital media on the wireless device means.

15. (Currently Amended) The method of claim 9, further comprising charging a fee for access to the compressed digital media to be transmitted to the wireless device ~~means~~.

16. (Currently Amended) A method of wirelessly delivering a data file from one or more servers to a wireless device ,the wireless device including a digital signal processor configured for receiving digital media transmitted by orthogonal frequency-division multiplex modulation , the method comprising:

receiving a data file from the wireless device, wherein the data file may be routed through a network ;

storing the data file received from the wireless device in a virtual storage locker on the the one or more servers;

receiving a request for the data file; and

transmitting the data file to the wireless device using orthogonal frequency-division multiplex (~~OFDM~~) modulation based on the received request.

17. (Previously Presented) The method of claim 16, further providing for selection of the data file to be transmitted to the wireless device.

18. (Previously Presented) The method of claim 16, wherein the wireless device is a cell phone.

19. (Previously Presented) The method of claim 18, further comprising storing at least a portion of the data file on the cell phone.

20. (Previously Presented) The method of claim 16, further comprising charging a fee for transmitting the data file to the wireless device.

21. (Currently Amended) A method of wirelessly ~~delivering~~ providing a data file for transmission from one or more servers to a wireless device, the wireless device including a digital signal processor configured for receiving digital media transmitted by orthogonal frequency-division multiplex modulation, the method comprising:

optimizing the data file according to an optimization scheme;

transmitting, through a network that may include one or more servers, the optimized data file ~~from the one or more servers~~ to the wireless device.

22. (Currently Amended) The method of claim 21, wherein transmitting the optimized data file from the one or more servers to the wireless device means includes the use of orthogonal frequency-division multiplex (OFDM) modulation.

23-25. (Canceled)

26. (Previously Presented) The method of claim 16, wherein receiving the request for the data file comprises receiving the request from the wireless device, and wherein transmitting

the data file based on the received request comprises transmitting the data file to a device other than the wireless device.

27. (Previously Presented) The method of claim 16, wherein receiving the request for the data file comprises receiving the request from a device other than the wireless device.

28. (Currently Amended) The method of claim [[10]] 21, wherein optimizing the data file according to an optimization scheme comprises:

converting the data file to mono by summing of a left channel and a right channel if the data file is stereo and the wireless device is configured only for mono playback;

normalizing an amplitude of the data file;

converting the data file according to a selected sampling frequency;

performing a pre-emphasis filtering on the data file;

re-normalizing the data file; and

compressing the data file according to a compression scheme.



REMARKS

Claims 1-22 and 26-28 are pending. By this Amendment, claims 1, 3-5, 7-9, 11, 12, 14-16, 21, 22 and 28 are amended, no claims are added and claim 2 is canceled. Claim 28 has been amended according to the Examiner's request to change dependence from claim 10 to claim 21. (Office Action, page 3.)

Support for the amendments to the claims and the new claims can be found throughout the application as filed. Therefore, no new matter is added.

**Response to Double Patenting Rejections**

Claims 1-22 and 26-28 stand rejected on the ground of nonstatutory double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,548,875. Claims 1-22 and 26-28 were rejected on the ground of nonstatutory double patenting as being unpatentable over claims 98 and 127 of copending Application No. 12/322,615. 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 by terminal disclaimer at that time.

**Response to Rejections Under 35 U.S.C. § 103**

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,247,130 to Fritsch ("Fritsch") in view of U.S. Patent No. 6,278,976 to Kochian ("Kochian"). Claims 2, 3, and 5-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fritsch in view of Kochian, further in view of U.S. Patent No. 6,470,030 to Park et al. ("Park"). Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable

over Fritsch, Kochian, and Park, further in view of U.S. Patent No. 6,418,330 to Lee ("Lee"). Claims 16, 17, 26, and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Pub. No. 2002/0116082 to Gudorf ("Gudorf") in view of Park. Claims 18-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gudorf and Park further in view of Fritsch. Claims 21 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fritsch in view of U.S. Patent Application Pub. No. 2003/0115041 to Chen et al. ("Chen"). Claim 22 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Fritsch and Chen, further in view of Park. Applicants respectfully traverse these rejections, including insofar as they may apply to the amended claims.

Referring to the rejections based at least in part on Fritsch [Claims 1-15, 18-21 and 28], Applicants respectfully submit that Fritsch does not disclose methods of *wirelessly* delivering a digital media from one or more servers to a wireless device means 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 respectfully submit that this affidavit evidence and remarks are sufficient to show that Fritsch is deficient in describing the limitations for which it is used as the basis for rejection. For at least these reasons, Applicants respectfully request that the obviousness rejections based on the combinations of Fritsch and Kochian; Fritsch, Kochian and Park; Fritsch,

Kochian, Park, and Lee; Gudorf, Park, and Fritsch; Fritsch and Chen; and Fritsch, Chen, and Park be withdrawn.

Referring to claim 16, Applicants respectfully submit that the Office Action has not made a *prima facie* case of obviousness. Claim 16 requires, in combination with the other elements of the claim, “receiving a data file from [a] wireless device.” The cited references do not disclose, teach, or include evidence of receiving a data file from a *wireless device*, whether taken alone or in combination.

The Office Action cites to Gudorf as evidence of such a limitation. However, Gudorf discloses a general purpose computer configured to upload to a content server. 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]; Office Action, p. 16, emphasis added.)

Most fundamentally, a general purpose computer, such as computer 60 in Gudorf, is not a wireless device. A general purpose computer simply cannot provide evidence of a wireless device. Moreover, at least for the reasons discussed above with respect to claim 1 and the state of the art of wireless devices as would readily understood by one skilled in the art, the disclosure of basic general purpose computer-server access over the Internet cannot provide evidence of “receiving a data file from [a] wireless device,” as required by the claim.

Park fails to remedy the deficiencies of Gudorf. Therefore, claim 16, is allowable at least for these reasons. Claims 17, 26, and 27 depend from claim 16 and are therefore also allowable, the rejection of claims 17, 26, and 27 being traversed but not expressly argued in view of the allowability of the underlying base claim.

### **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.

Without acquiescing to the obviousness rejections stated above, applicants have amended claims in view of the *Alice* decision and in order to more clearly distinguish the claims from prior art.

### Conclusion

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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