

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Attorney Docket No.: 4624.01US11

John Mikkelsen

Confirmation No.: 7483

Application No.: 14/230,906

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 June 9, 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 Those claims not cancelled or withdrawn but amended by the current amendment utilize the following notations for amendment: 1.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 method for wirelessly transmitting a data file between a wireless device and a server, the server comprising a non-transitory virtual storage locker, the method comprising:
 - receiving a data file from the wireless device;
 - storing, in the virtual storage locker, the data file received from the wireless device;
 - receiving a request for the data file; and
 - transmitting the data file in response to the received request.
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. (Original) The method of claim 1, 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 the wireless device.
4. (Original) The method of claim 1, wherein receiving the request for the data file comprises receiving the request from a second device, and wherein transmitting the data file based on the received request comprises transmitting the data file to the second device.
5. (Original) The method of claim 4, further comprising:

receiving a request for the data file from a third device; and

transmitting the data file in response to the received request to the third device.

6. (Currently Amended) The method of claim [[1]] 4, further comprising ~~debiting~~ charging an account associated with a user of the second device.

7. (Original) The method of claim 1, wherein transmitting the data file in response to the received request comprises transmitting using orthogonal frequency-division multiplex (OFDM) modulation.

8. (Original) The method of claim 1, further comprising providing for selection of the data file to be transmitted.

9. (Original) The method of claim 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. (Original) The method of claim 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. (Original) The method of claim 1, wherein the wireless 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.

12. (Original) The method of claim 1, further comprising storing at least a portion of the data file on the wireless device.

13. (Original) The method of claim 1, further comprising:

associating, in response to receiving the data file from the wireless device, a unique identifier with the data file and a user of the 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. (Original) A system for wirelessly transmitting a data file to a wireless device, the system comprising:

a server including a non-transitory virtual storage locker configured to store a plurality of data files; and

a communication network operably coupling the server and the wireless device,

wherein the server is configured to:

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

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

receive a request for the data file over the communication network, and

transmit the data file over the communication network in response to the received request.

15. (Original) The system of claim 14, 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.

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

17. (Original) The system of claim 14, wherein the request for the data file is received from a second wireless device, and wherein the data file is transmitted to the second 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. (Original) The system of claim 14, wherein the communications network uses orthogonal frequency-division multiplex (OFDM) modulation.

20. (Currently Amended) A method for transmitting data, the method comprising:

providing a website accessible over a wireless communications network;

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

receiving, through the website and over the wireless communications network, a data file from a first device;

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

receiving, through the website and over the wireless communications network, a request for the data file from a second device;

querying the database for the requested data file; and

transmitting the data file over the wireless communications network to the second device.

REMARKS

Claims 1-20 are pending. By this Amendment, no claims are cancelled, claim 6 and 20 are amended and no new claims are added.

35 USC § 112

Claim 6 was rejected under 35 U.S.C. 112(a) or 35 U.S.C. 112(pre-AIA), first paragraph as failing to comply with the written description requirement. Claim 6 is amended to overcome the 112 rejections.

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). Applicant respectfully traverses. 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 of digital media to a wireless device.

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.)

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

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. Rejection of claims 1-6, 8, 11-18 and 20 should be removed.

35 USC § 103

Claims 7 and 19 were rejected under 35 USC 103(a) as being unpatentable over Gudorf (US 2002/0116082) in view of Kontio et al. (US 2005/0004875). Claims 9 and 10 were rejected under 35 USC 103(a) as being unpatentable over Gudorf (US 2002/0116082) and Kontio et al. (US 2005/0004875), as applied to claim 7 above, further in view of Nathan et al (US 6,182,126).

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 Gudorf and Kontio be withdrawn. Rejection of claims 7, 9, 10 and 19 should be removed.

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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