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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Application Number: 14/795,141
Filing Date: 9 Jul 2015
Appellant(s): NAKAI et al.

Stephen J. Pachol
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 04/04/2020.

(1) Grounds of Rejection to be Reviewed on Appeal

Every ground of rejection set forth in the Office action dated 01/13/2020 from which the appeal is taken is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

NEW GROUNDS OF REJECTION

None.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner.

- Under §112(b), the Examiner withdraws rejections related to "the server system" coupled with the function of "transmit" for claim 6 for means plus function; "unable to be executed" and "can be executed" for claims 1 and 14 for hybrid claims; and the language of the server system or information processing apparatus "is configured for" for claims 3, 6, 7, 8.
- Under §112(d), rejection(s) related to claim 3 is withdrawn.

(2) Response to Argument

I. Summary of Claimed Subject Matter

I (A). Attorney Argument(s) Improvement

Appellant submits that "[u]sing the 'change data' in this manner allows the system to remotely distribute content to various devices before the content is available for sale thus advantageously **reducing** overall load on the system (especially near time of purchase) thereby **improving overall communication latency**." Br. at 5 (emphasis added). The language of "communication latency" never appears in section cited by Appellant. This is an attorney argument. *See* MPEP 2145(I) ("The arguments of counsel cannot take the place of evidence in the record."). Rather, the Spec. discloses in a single

sentence: "[The system is] capable of dispersing a load on a side that distribute a content." *Id.* at ll. 23-25; see also *id* at p. 2 ll. 18-20, p. 6 ll. 15-17, p. 7 ll. 22-25 (finding single sentences regarding load). The Examiner has considered this evidence, pursuant to MPEP 2145 (citing *Soni*, 54 F.3d at 750, 34 USPQ2d at 1687 (error not to consider evidence presented in the specification)); however, it is afforded "little weight" as this is an attorney argument. See *In re Lindner* 59 C.C.P.A. 920, 457 F.2d 506, 508, 173 U.S.P.Q. (BNA) 356, 358 (CCPA 1972) (discussing evidence); MPEP 2145. This is no improvement to technology itself. Examiner submits that nothing more than a "reservation" of "purchased content." *See* Spec. at p. 1 ll. 10-15. As a real world analog, this is making a reservation of some good/service (e.g. making a reservation at a restaurant) in order to ensure that the good/service does not reach maximum capacity (e.g. the restaurant has enough tables for its customers).

I (B). Attorney Argument(s) Latency

Appellant continues to submit that "[u]nder this [conventional] approach, the distribution of content can become **very burdensome on the system**, especially at the release date and time as many client devices may begin downloading…thus creating communication **latency issues** within the system. Br. at 6 (parentheticals removed; emphasis added). This is an attorney argument. *See* MPEP 2145(I).

Appellant continue to submit that the "claim approach **improves** upon drawbacks…by transmitting change data…." (Br. at 6.) This is an attorney argument. *See* MPEP 2145(I).

II. References Teach Claimed Features

Appellant appears to have only address arguments under 102, not 103. Br .at 16 ("Thus, the rejection of these claims under 35 U.S.C. §102(a)(1) must be reversed."). Arguments not made are waived.

II (A). Rejection under 102(a)(1)

Examiner submitted that Downs was sufficient in terms of art as "the purpose of the instructions" is intended use/functional language. Appellant's arguments do not address Examiner's following rejection under §102.

Claim 1 is directed towards a "content distribution system, comprising: an information processing apparatus; and a server system having processing circuitry…the processing circuitry configured to (Applicant's PGPUB at 0062)…."

Claim 14 recites: "A content distribution system, comprising: a processor; and a memory…cause the processor to…."

Claim 15 recites: "A non-transitory storage medium…causes the content distribution server to provide execution comprising…."

Per claims 1, 14, and 15, the purpose of the instructions, in this case, to cause a machine to…is intended use/functional language and does not have patentable weight as the claimed machine-readable non-transitory storage medium merely stores instructions which is inherent to all memory (see MPEP 2103 I C, 2114 IV, Microsoft Press Computer Dictionary 5th edition, page 333, "A device where information can be stored and retrieved. In the most general sense, memory can refer to external storage such as disk drives or tape drives; in common usage, it refers only to a computer's main memory, the fast semiconductor storage (RAM) directly connected to the processor. See also core, EEPROM, EPROM, flash memory, PROM, RAM, ROM. Compare bubble memory, mass storage."). Therefore, as the prior art of Downs teaches a computer with a processor it is sufficient in terms of art (Fig. 1D Item 111).

Claims 3, 6-13, and 18-19 further describe the intended use/functional language, and therefore do not have patentable weight.

II (B). Rejection under 103(c)

The instant Brief does not address Examiner's rejections under §103. (Br. at 14-22.) Arguments not made are waived. Nonetheless, Examiner is respond accordingly without conceding to the fact Appellant has waived arguments under §103.

II (B) (1). Appellant's Contentions per Claims 1 and 14-16

II (B) (1) (a) The Content Hosting Site, Electronic Store, and Clearing House

Downs outlines a plurality of devices: Content Provider, Content Hosting Site(s), Electronic Digital Content Store(s), Clearing House(s), and End User Device(s). Downs at Fig. 6. The Clearinghouse may be part of the Digital Content Store. Downs at col. 11 ll. 15-29. Further, the Content Providers may act has a Hosting site for their own content. Downs at col. 69 ll. 17-28. As such, the Content Provider and the Content Hosting site may be one device. Further still, the Content Store may host the Content. Downs at col. 69 ll. 17-28. Therefore, based on the citations, the Content Hosting Site, the Content Store, and the Clearing House may be all one device.

II (B) (1) (b) Teachings of Downs and Mapping

Appellant is of the opinion that the combined prior art does not teach the element of "transmit, to the information processing apparatus, change data that comprising a modifying program configured to modify the second content to the first content after transmission of the second content." Examiner respectfully disagrees.

Downs teaches a Content Hosting site (server system having processing circuitry that includes, at least, a processor and a memory) that stores content (second content) in at least Fig. 6 Item 113; col. 23 ll. 42-56. The Content Hosting site (server system) of Downs transmits the stored content to the End User Device (information processing apparatus). (Downs at Fig. 6 Item 608; col. 24 ll. 47-62.) The content in Content SC(s) 630 is encrypted content (but is unable to be executed by the information processing apparatus) using symmetric encryption. (Downs at col. 24 ll. 47-63.)

Down additionally teaches transmitting a Symmetric Key 623 (change data) from the Clearing House (server system) to the End User Device (information processing apparatus). (Downs at Fig. 6 Items 632 inside 630; col. 39 ll. 14-15.) The key decrypts the encrypted content (change data that comprises a modifying program configured to modify the second content to the first content). (Downs at col.2 ll. 60-67; see also Downs at col. 7 ll. 30-35.)

Appellant concludes with a discussion related to Chen and Essa, but Appellants arguments continue to expound on "modifying program." (Br. at 16-19.) No different arguments are raised.

II (B) (2). Downs teaches Modifying Program per Claim 3

Claim 3 differs only from claim 1 with respect to the languages of "regular executable code" and "dummy executable code." The Examiner will address facts related to Downs per the language of "regular executable code" and "dummy executable code. Downs teaches "regular executable code" and "dummy executable code" because the **unusable** encrypted digital content is turned into **useable** digital content as stated above. (Down at col. 2 ll. 60-67.) Put another way, "dummy" content is content that is unable to be used whereas "regular" content is content that can be used.

II (B) (3). Downs teaches Modifying Program per Claim 23

Downs teaches a modifying program since it turns unusable content to useable content via encryption. (Downs at col.2 ll. 60-67; see also Downs at col. 7 ll. 30-35.)

III. Ineligible Subject Matter

III (A). Appellant's Arguments—Purported Improved Technology

Under Step 2A Pong One, Appellant submits that claims are not directed towards an abstract idea as claims are directed towards "specific improvements." (Br.at 24.) Similarly, Appellant submits that "[s]uch features…can…improve the overall ability for the content distribution system to deliver content to a variety of terminal device." (Br. at 25.) Under the same vein, Appellant submits "these features improve the systems' overall ability to manage load of the system thereby improving communication

latency." (Br. at 25.) Again, commenting on the load, Appellant submits "the claimed approach advantageously disperse the load of the content server and is thus an improvement to content distribution technology as the overall communication latency of the system is improved." Br. at 26 (emphasis omitted) (citing p. 16 l. 18, p. 17 l. 20 of Appellant's specification but not quoting).

Under Step 2A Pong Two, Appellant concludes with discussing the "executable program," *see* Br. at 27. Appellant submits that the additional element of change data allows the system to "disperse[] the load of the content server and improves overall latency of the system." (Br. at 28.)

For Steps 2A Pong One and Pong Two, these are attorney arguments as stated above. See MPEP 2145(I) ("The arguments of counsel cannot take the place of evidence in the record."). With the amount of citation that the Appellant does provide, the Examiner calls into question the weight. See *In re Lindner*, *supra*; MPEP 2145. As previously noted, this is not a technological improvement. Rather the real world analogy is solving a human problem related to waiting in line. At times, restaurants reach their maximum capacity. In order to manage an overflow of customers, they simply ask that a reservation be made for a future time period. This is recited and found in instant claim 1 ("prior to a sale start date and start time").

Under Step 2B, the examiner did not sustain the rejection on conventional, well known, or routine as Appellant propounds. (Br. at 28.)

III (B). No Improvement to Technology

For Steps 2A Pong One and Pong Two, the Examiner has review the record as a whole. MPEP 2106.07 (holding that "examiners should review the record as a whole"). Moreover, these problems with "load" are not technological as can be found through the prosecution history. Specifically, the Examiner applied Essa to the claims. *See* Notice of References Cited (05/30/2018) at Item (B). Essa discloses within the Background that there is an "ever-increasing demand to purchase digital electronic title **prior to public release**…." Essa at 0007. This is no technological problem. This is a human problem

(i.e. waiting in line for a good/service) given "increasing sale." Essa at 0003. Appellant's Specification supports this conclusion as well. Appellant's PGPUB at 0088 ("[A] **reservation** content is acquired in advance…to prevent access from concentrating on the sale start date and time.") (emphasis added). As noted previously, the reservation of content is analogous to reserving a dinner table for a future time period. This is not a technological solution.

III (C). Claims do not Capture Purported Improvement

For Steps 2A Pong One and Pong Two, Appellant previously submitted in the Brief the following: "Under this [conventional] approach, the distribution of content can become **very burdensome on the system**, especially at the release date and time as many client devices **may begin downloading**…thus creating communication **latency issues** within the system. Br. at 6 (parentheticals removed; emphasis added). Therefore, according to Appellant, this purported improvement to the system can only occur based on **downloading**. Because the instant claims fail to make any mention of an operation of "downloading" this purported improvement is not captured by the instant claims. *See* PGPUB at 0030 ("[The] convenience of download sale [sic] can be improved and a load on a side that distributes a content can be dispersed.").

IV. Rejections under §112

IV (A). Rejections under §112(a)

IV (A) (1). Answering Regarding Claims 1, 14, 15, and 16

Claims 1, 14, 15, and 16 recite: "transmit…change data **that includes a modifying program configured to modify**…." Appellant points to page 29 lines 17-30 and page 30 line 3 to support that "the 'change data' can correspond to 'modifying program 604b.'" Appellant appears to focus on the language of "is changed" and "is changed" and "is replaced" given the bolding. Appellant implies this is sufficient to support the "change data" can be the "modifying program." Examiner respectfully disagrees. The paragraph provided by Appellant discloses "updated program 602g", "reservation application program

(602f etc.)", "normal application program". Given this many-to-many type of mapping of programs, the Specification fails to support that the change data includes a modifying program.

The PGPUB discloses at Claim 2 (originally filed) and paragraph 0008 that the "change data **is data of** a modifying program." Appellant contends that the change data **can** correspond to modifying program. It is the other way around given Claim 2 (originally filed) and para. 0008. It is the modifying program that includes change data given the language of "is data of". Put another way, according to the Spec., the modifying program has change data inside of it.

IV (A) (2). Answering Regarding Claim 1

For claim 1, Appellant contends that "processing circuitry" is supported given that "one of ordinary skill would clearly understand that any combination of a CPU, RAM….would make up a working computer[.]" (Rm. at 31.) The instant claims do not recite that "a memory is storing instructions that when executed by a processor causes the processor to perform the operations of" or something to that effect. Rather, it is the "processing circuity [that is] configured to," not the processor. Given that it is the processing circuitry that is being configured, not the processor operatively coupled to memory, the Written Description cannot support this claim language.

IV (A) (3). Answering Regarding Claim 15

For claim 15, Appellant submits that "[s]uch features are clearly describe through the specification…." Claim 15 does not spell out a single device performing the operations of "transmit" and "transmit." It refers to some other device not found in the Spec.

IV (A) (4). Answering Regarding Claim 23

For claim 23, Appellant does not address this rejection. Argument is waived. Br. at 32 (ending §112(a) arguments).

IV (B). Rejections under §112(d)

This rejection has been withdrawn.

IV (C). Rejections under §112(b)

IV (C) (1). Answering Regarding Means Plus Function

Appellant contends that "these features do not at all invoked a §112(f) interpretation" given that the information processing apparatus is a "structural limitation[] in-and-of-[itself]." (Br. at 33-34.) Examiner disagrees. "[A]pparatus" is a nonce word, and it is coupled with a series of functions. Therefore, the scope of the claims is not commensurate with what Appellant regards as their invention. *See* MPEP 2172(II).

Next, Appellant proposes that "assuming for the sake of argument that these features are 'means-plus-function' language, the claimed features provided adequate structural support in the specification." (Br. at 34.) However, Appellant has not cited where the functions can be found given that the corresponding structure includes both the computer **and the algorithm** that performed the recited functions. *See* MPEP 2181(II)(B) ("Accordingly, a rejection under 35 U.S.C 112(b) or pre-AIA 35 U.S.C 112, second paragraph is appropriate[.]").

IV (C) (2). Answering Regarding Hybrid Claims Paragraphs

IV (C) (2) (a) User Actions

Claims 1, 7, 8, 9, 11, 14, 15, 16, and 23 relate to user actions, and therefore, the claim recites both a product and a method for using said product. *In re Katz Interactive Call Processing Patent Litigation*, 97 USPQ2d 1737 (Fed. Cir. 2011). In *Katz*, the claim language was directed towards "user actions, not system capabilities." *Id.* at 1749. Specifically, in *Katz*, the court held that the language of "wherein…callers digitally enter data" and "where…callers provide…data" implicated 112(b). *Id.* at 1749.

The aforementioned claims outline the same. For example, claim 7 recites "according to an operation of a user." Therefore, the instant claims would "create confusion as to **when** direct infringement occurs based they are directed both to systems and to actions performed by 'individual callers.'" *Id.* at 1749 (emphasis added).

IV (C) (2) (b) Functionality Divorced

Claims 1, 9, 14, 15, 16, and 23 are related to actions not performed by the server system, and therefore, the claim recites both a product and a method for using said product. The claims are directed towards the server system. However, instant claim 1, for example, recites operations of "settling" which are not performed by the server system. Examiner submits that the instant claims do not "reflect[] the capability of [the server system] in connection with the claimed functionality." See *UltimatePointer, L.L.C. v. Nintendo Co.*, 816 F.3d 816, 827.

IV (C) (3). Answering Unclear Scope

Appellant submits, for claims 15 and 16, that the claims are "still presented clearly and are not at all vague or indefinite." (Br. at 37.) MPEP 2173.05(m) holds that: "Examiner should reject claims as prolix only when they contain such **long recitations or unimportant details** that the scope of the claimed invention is rendered indefinite thereby." *Id*. (emphasis added).

For claims 12 and 18, Appellant submits that "these dependent claims **further define the timing** for which various elements are carried out….[and thus] define **the timing** in which certain elements occur." Br. at 37 (Examiner's emphasis). Examiner thanks Appellant for this explanation based on timing. Appellant submits that the instant claim is further limited based on when "elements are carried out," *see* Br. at 37. For system claims, infringement occurs when the system is created. For method claims, infringement occurs when all the operations are performed. Since the system claims are further limited based on a time period **after creation of the system**, it is unclear when direct infringement would occur. See *UltimatePointer, L.L.C. v. Nintendo Co., supra.*

Appellant submits, for claim 19, that "when reading the specification, one of ordinary skill would conclude [that] the 'normal content' includes 'resource and executable code.'" (Br. at 37.) Claim 19 recites: "…wherein the first content including the normal content having a resource and executable code." It is unclear what "having" is referring back towards. The claim is amendable to more than one

construction and therefore it is indefinite. *Ex parte Kenichi Miyazaki*, 89 USPQ2d 1207, 1211 (BPAI 2008) (precedential).

IV (C) (4). Answering Relative Term Claims 1, 14, 15, 16, 18, and 19

Appellant submits that "when reading the specification[, one skilled in the art] would understand that certain content would correspond to 'normal' or 'regular' executable content (e.g., a program that can fully execute), while 'dummy' executable content may correspond to non-executable content." (Br. at 38.) This is a finding of fact. Appellant points to p. 15 ll. 22 to p. 16 l. 7 ("Therefore, in this embodiment [...] by the game apparatus 20."). Examiner has reviewed the record and can find neither a lexicographic definition nor any suggestive definition. This purported finding of "fully execute" and "non-executable" is an attorney argument. *See* MPEP 2145(I). Moreover, one cannot import readings from specification into elements of the claim. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

PGPUB at 0010, outlines that "the second content includes a dummy executable code **with which** a content cannot be executed." The Examiner has taken the Specification "as is." Similarly, for "normal," the PGPUB at 0031 discloses: "[A] first content **that is normal** and can be executed by an information processing apparatus." Given a plain reading of the Spec., it is the content that is normal. Claim 3 (originally filed) of the Spec. discloses that "the first content includes a regular executable code **with which** a content can be executed." The Examiner has taken the Specification "as is."

IV (C) (5). Answering Antecedent Basis Claim 11

Appellant submits that "claim 11 defines that notification of certain execution is prohibited and thus the features of claim 11 do not at all present any antecedent basis issue." (Br. at 39.) Given the plurality of constructions, the claims are indefinite. See *Ex parte Kenichi Miyazaki*, 89 USPQ2d 1207, 1211 (BPAI 2008) (precedential). The language of "execute" and/or "execution" appears in claim 11 and claim 10, upon which claim 11 depends upon. Specifically claim 10 recites an "execute menu." Claim 11

recites the operation of "execute". Additionally, claim 11 recites the "content execute menu by the user." It is unclear what "that execution of the second content is restricted" is referring back towards. It may refer back towards the "execution [menu] of the second content." But it may refer to the operation of "execute." Additionally, the language is another type of execution thing unto itself. Therefore, the claims are indefinite.

(3) Conclusion

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Requirement to pay appeal forwarding fee. In order to avoid dismissal of the instant appeal in any application or ex parte reexamination proceeding, 37 CFR 41.45 requires payment of an appeal forwarding fee within the time permitted by 37 CFR 41.45(a), unless appellant had timely paid the fee for filing a brief required by 37 CFR 41.20(b) in effect on March 18, 2013.