Remarks

The Patent Owner Interval Licensing LLC respectfully requests reconsideration of the rejections raised in the Office Action in view of the foregoing amendments and the following remarks.

As an initial matter the Patent Owner respectfully notes a typographical error in the Order Granting the Request for *Inter Partes* Reexamination ("the Order"). At page 2 of the Order, the patent at issue is indicated as No. 6,7<u>78</u>,314. The correct Patent No. is 6,7<u>88</u>,314.

I.   CLAIM STATUS

Claims 1-15 were pending in this *inter partes* reexamination proceeding. The Patent Owner requests that the Examiner cancel claims 5-6 and enter new claims 16-31, as shown in the preceding listing of claims. Upon entry of the amendments, the status of the claims is as follows:

Claims 1-4.   Pending (Original)

Claims 5-6.   Canceled

Claims 7-15.   Pending (Original)

Claims 16-31. Pending (New)

II.   SUPPORT FOR NEW CLAIMS

Support for new claims 16, 18, 20, 22 and 24 is found in the '314 patent specification at, *e.g.*, col. 2 lines 21-28, col. 6 lines 47-54, and col. 13 lines 19-22. Support for new claims 17, 19, 21, 23 and 25 is found in the '314 patent specification at, *e.g.*, col. 2 lines 21-28, col. 3 lines 34-39, col. 6 lines 47-54, and col. 13 lines 19-25. Support for new claims 26-31 is found in the '314 patent specification at, *e.g.*, col. 22 lines 47-48 and 57-58, col. 23 lines 19-23, and col. 27 lines 27-59. No new matter has been introduced by the new claims. All of the new claims depend from the original claims of the '314 patent. Accordingly, the new claims do "not enlarge the scope of a claim of the patent." *See, e.g.*, MPEP § 2666.01.

III.   REJECTIONS OVER KJORSVIK & SALM

In the Office Action, the Examiner rejected claims 1, 3, 5, 7, 9-10, 12-13 and 15 under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,748,190 to Kjorsvik (hereinafter "Kjorsvik"), and claims 2, 4, 6, 8, 11 and 14 under 35 U.S.C. § 103(a) as obvious over Kjorsvik in view of W. Salm "Buying a Real Computer Monitor", Popular Electronics (Oct. 1984) pp. 102-103, 132 and 134 (hereinafter "Salm"). The rejections of claims 5 and 6 have been rendered moot by the cancellation of these claims. The Patent Owner traverses the remaining rejections of claims 1-4 and 7-15, and maintains that all of the pending claims 1-4 and 7-31 are patentable over the cited art, for at least two reasons, each of which is addressed in one of the following Sections A and B. Each reason, standing alone, is sufficient to overcome the obviousness rejections and independently render the claims of the '314 patent patentable over the cited art.

A.   Kjorsvik and Salm Fail to Teach or Suggest the Claimed "Without the Content Data Being Aggregated at a Common Physical Location Remote from the Content Display System"

The Patent Owner agrees with the Examiner's determination that Kjorsvik's system aggregates content data (screensaver presentations) at a common physical location (a system database) remote from the user computers that display the presentations. However, the Patent Owner disagrees that it would have been obvious at the time the invention was made to modify Kjorsvik's system to eliminate this remote aggregation, as the Examiner has suggested. As explained below, Kjorsvik's invention is an "administration module" that centrally manages aggregated presentations in the remote system database for a network of user computers. The Examiner's proposal to eliminate aggregation of the presentations would eviscerate the centralized presentation management that is the heart of Kjorsvik's invention, and would prevent the administration module from operating in the manner intended. Because it is well-established law that modifications which render a reference inoperable cannot legally support an obviousness rejection, this rejection is improper and should be withdrawn.

1.   *Kjorsvik Teaches a Centralized Presentation Management System that Requires Aggregation of Presentations at a Common Physical Location (A System Database) Remote from User Computers*

Kjorsvik's presentation system is purposefully designed to provide centralized, network-level management of screensaver presentations for display on multiple personal computers (PCs) 12, 14, 16 within a network 10. An "administration module" 26 effects the centralized presentation management by obtaining screensaver presentations (also called scripts), aggregating presentations on a remote system database 24 (located on network server 18), assigning particular

presentations to individual users and groups of users, and scheduling sequences of presentations for display at the individual user computers. Kjorsvik at col. 2 lines 27-66; Figures 1-2.

The administration module's central management role, and its extensive reliance on the remote system database in which the presentations are aggregated, is apparent from a review of Figures 3-13 and col. 3 line 19 through col. 4 line 67 of Kjorsvik. The following exemplary passages from Kjorsvik emphasize that the aggregation of presentations in the remote system database is essential to the basic operation of the administration module:

> "The administration module 26 has the basic responsibility of composing, adding to, or deleting information from the database 24 on server 18." Kjorsvik at col. 2, lines 54-57.

> "The administration module 26 and database 24 on server 18 are responsible for generating the various slide presentations, selecting particular slide presentations for the individual PCs in the network and scheduling those presentations in a particular sequence." Kjorsvik at col. 2, lines 62-66.

> "Still another function of the administration module 26 is the assignment of specific presentations to the individual PCs. This capability allows the administration module 26 to match or select particular presentations to particular users, depending upon the needs or requirements of those users." Kjorsvik at col. 4, lines 1-5.

> "A related function of the administration module 26 concerns the particular schedule which is established for the appearance of the individual presentations at each of the network PCs. For instance, each user in the system (each network PC) will have its own unique schedule of presentations, including a particular sequence of different presentations and a specific time of nonuse required before a presentation begins. This scheduling of presentations is established through the administration module and stored in system database 24." Kjorsvik at col. 4, lines 9-18.

> "It should be noted, as indicated above with respect to some of the functions, that all changes, compositions, scheduling, etc. which are made by the administration module are ultimately stored in the system database 24." Kjorsvik at col. 4, lines 46-49.

The central management role of the administration module is also apparent from the Figures of Kjorsvik. In particular, Figures 3, 5 and 10 present three different examples of how the administration module is able to carry out its centralized presentation management functions for multiple user computers in the network *only in conjunction with* the system database's remote aggregation of the screensaver presentations and other data. Each of Figures 3, 5 and 10 of Kjorsvik is reproduced below, with explanatory text added in italics to illustrate specific functions of the administration module and its reliance on the remote system database.

Figure 3 illustrates a "main screen or overall flow chart for viewing the information associated with the various functions" of the administration module, as described at, e.g., col. 4 lines 25-51:

FIG.3
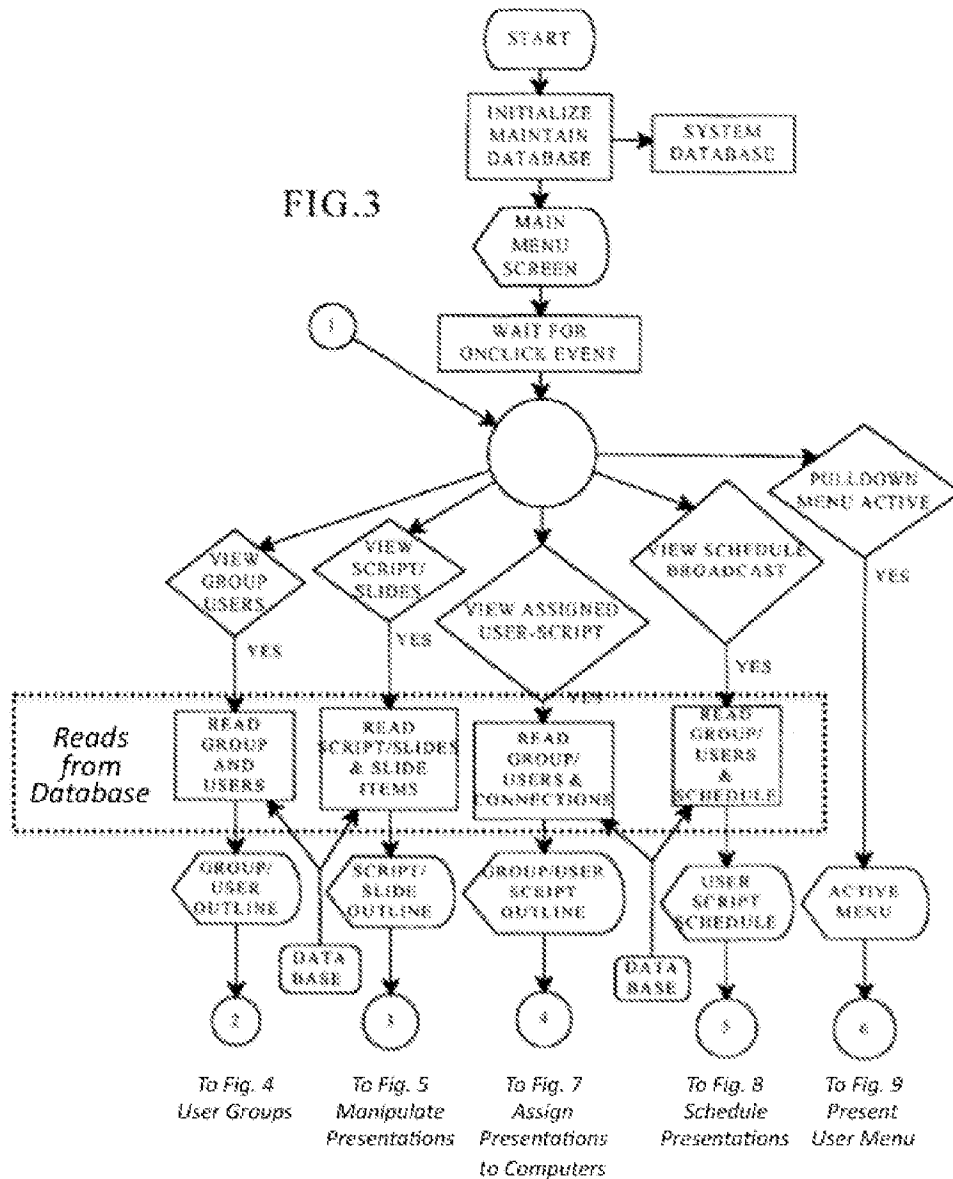
As shown inside the dotted box, the administration module must read presentations and user data from the remote system database in order to perform centralized management functions such as managing user groups, viewing and manipulating stored presentations and slides, assigning presentations to specific users and groups of users, and scheduling presentations for specific users and groups of users. Without the aggregation of presentations in the remote system database, the administration module would not be able to perform these centralized management functions for multiple users in the network.

Figure 5 depicts the administration module manipulating (e.g., composing, deleting, or editing) presentations in the remote system database. For example, the administration module may compose a presentation (script), and then store the presentation in the remote system database at the step inside the dotted box. *See* Kjorsvik at col. 3 lines 30-44 and col. 4 lines 32-37.
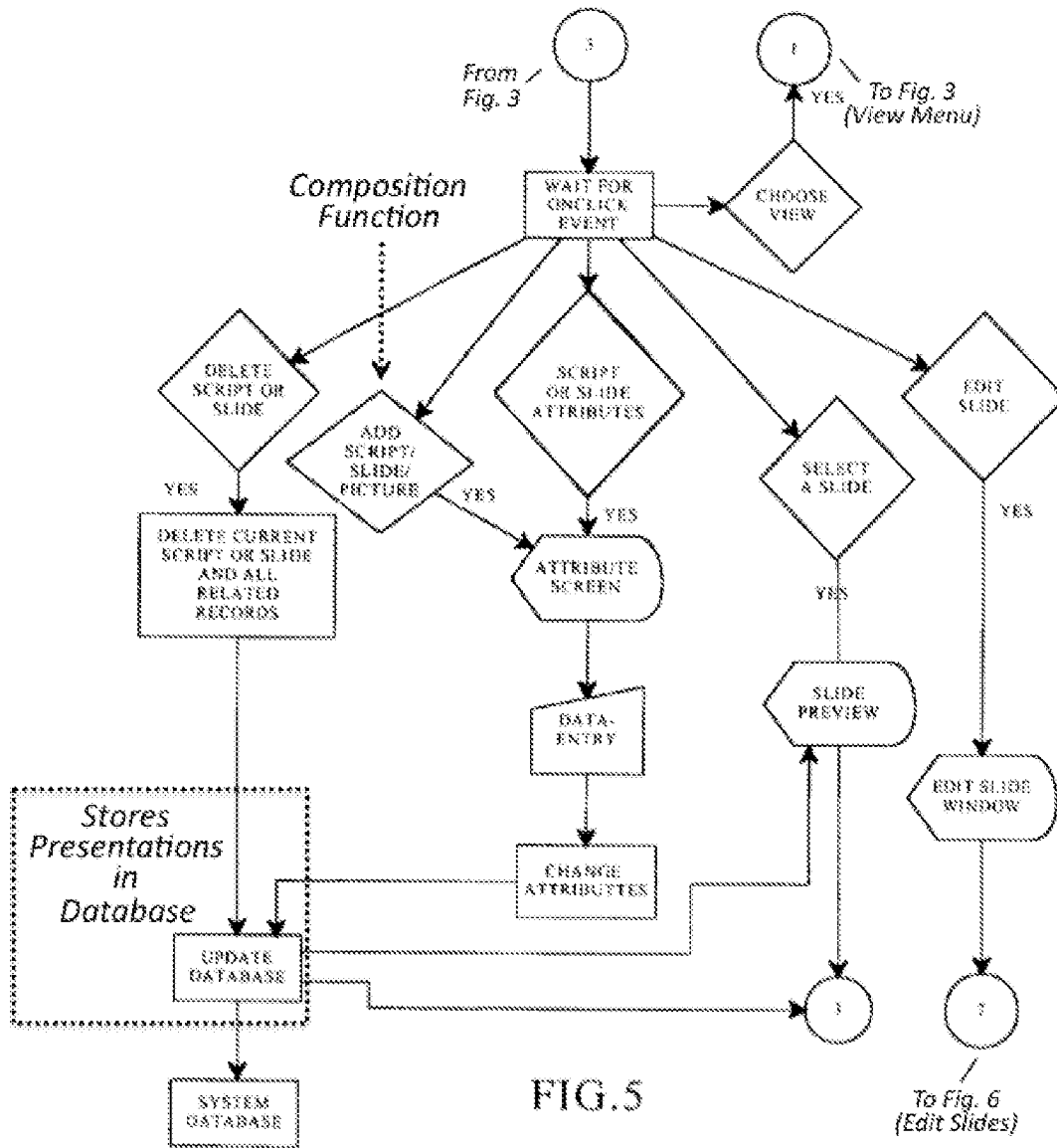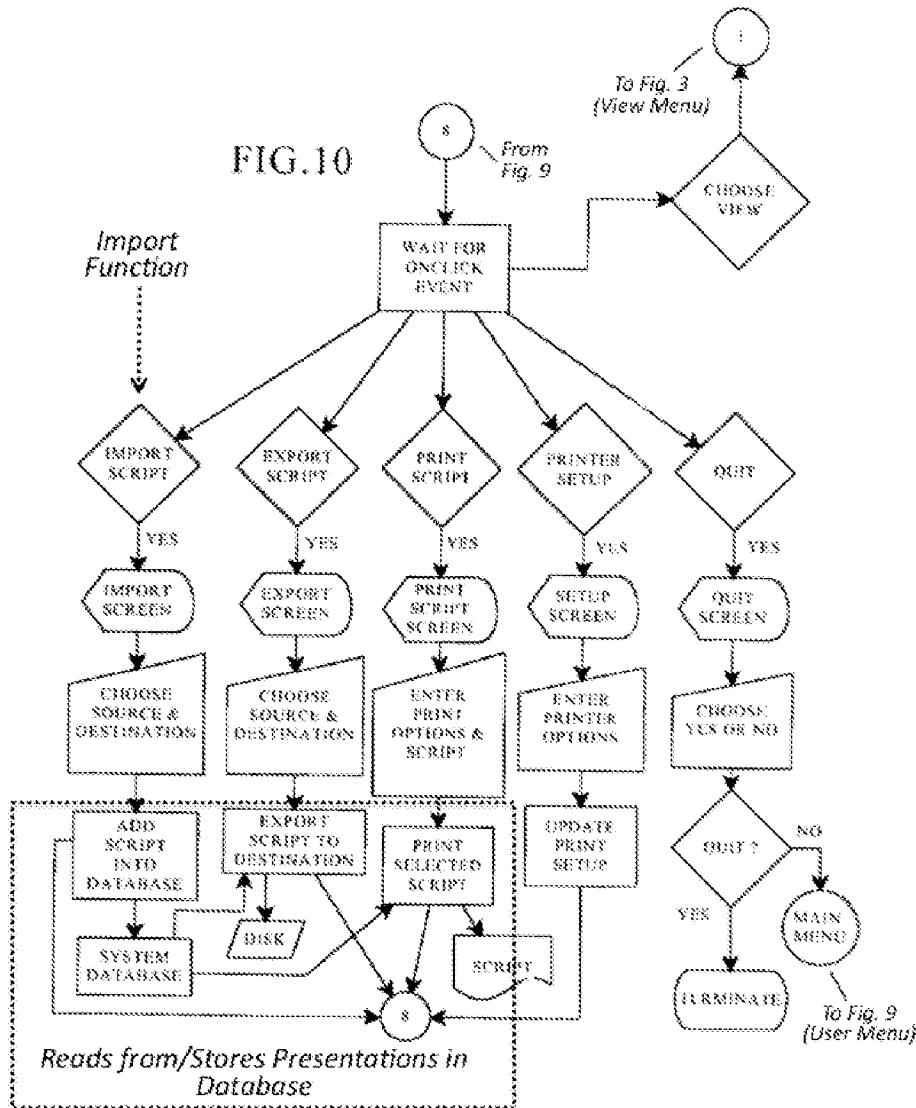

FIG.5

Figure 10 depicts the administration module importing, exporting and printing presentations stored in the remote system database. For example, the administration module may import a presentation (script), and then store the presentation in the remote system database at the steps inside the dotted box. Or, for example, the administration module may print a presentation by reading it from the remote system database and then printing it, as shown in the steps inside the dotted box. *See* Kjorsvik at col. 4 lines 19-24 and 57-60.

The ability to aggregate the composed presentations (as shown in Fig. 5) and the imported presentations (as shown in Fig. 10) in the remote system database is critical to the ability of the administration module to perform its other centralized management functions, such as assigning a particular presentation stored in the remote system database to multiple user computers, or scheduling a particular presentation for a group of user computers. *See, e.g.,* Kjorsvik at col. 4 lines 1-18 and 41-48 and Figures 7-8 (not reproduced here).

Furthermore, as a comparison of Figures 5 and 10 illustrates, the administration module may obtain presentations in two different ways: by "composing" (creating) the presentations; or by importing the presentations from external systems or other outside sources. *Compare* Kjorsvik at col. 3 lines 30-67 and Figure 5 (composing) *with* col. 4 lines 19-24 and Figure 10 (importing). The ability of the administration module to import externally-generated presentations eliminates the need for the administration module to compose every presentation within the system. Kjorsvik at col. 4 lines 19-24. Regardless of how the administration module obtains the presentations, however, the presentations must be aggregated on the remote system database in order for the administration module to carry out its centralized management of these presentations for multiple user computers in the network.

2. It Would Not Have Been Obvious to Modify Kjorsvik to Eliminate Aggregation of Presentations on the Remote System Database

Each of the independent claims 1, 3, 7, 10 and 13 of the '314 patent is directed to content providers providing content data to a content display system independently and *"without the content data being aggregated at a common physical location remote from the content display system* prior to being provided to the content display system." '314 patent claims 1, 3, 7, 10 and 13, (emphasis added).

The Examiner acknowledges that Kjorsvik fails to teach or suggest this claim limitation, because Kjorsvik teaches that presentations are aggregated in a common physical location (the system database located on a network server) that is remote (on the network server) from the user PCs on which the presentations are displayed. However, the Examiner argues that Kjorsvik's teaching that presentations can be obtained from external systems eliminates the need to aggregate the presentations at the remote system database prior to being provided to the user PCs, because the presentations would be coming directly from the external network server. Office Action at pages 6-7, 11-12, 16-17, 21-22, 26-27, 31-32.

The Examiner's reasoning apparently assumes that Kjorsvik stores presentations on the remote system database only because the presentations are composed by the administration module. Relying on this assumption, the Examiner concludes that, if the composition function of the administration module were eliminated and all of the presentations were imported from external sources, then remote aggregation could be dispensed with because there would be no need to store presentations on the remote system database.

The Patent Owner respectfully submits that the Examiner's underlying assumption about Kjorsvik's reasons for remotely aggregating presentations is not correct. As described *supra*, storing presentations on the remote system database is *necessary* for the administration module to perform its centralized presentation management functions for multiple users within the network,

including obtaining and editing presentations, assignment of specific presentations to individual users and groups of users, and scheduling of presentations and sequences of presentations for display at the individual PCs of the users. Thus, even assuming *pro arguendo* that the composition function in Kjorsvik might be eliminated, the administration module would still need to aggregate the imported presentations in the remote system database in order to perform its centralized presentation management functions. If the imported presentations were stored locally on each user PC as the Examiner suggests, then Kjorsvik's administration module would be unable to centrally manage presentations for multiple users, and would thus be unsuitable for its intended purpose.

It is well-established law that if a proposed modification would render the prior art invention unsatisfactory for its intended purpose, then the prior art cannot support a *prima facie* case of obviousness. *McGinley v. Franklin Sports Inc.*, 262 F.3d 1339, 1354 60 USPQ2d 1001 (Fed. Cir. 2001). *See also In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125 (Fed. Cir. 1984) (inoperable modification teaches away from invention); *In re Schulpen*, 390 F.2d 1009, 1013, 157 USPQ 52 (CCPA 1968) (inoperable modification teaches away from invention); *In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349 (CCPA 1959) (reversing obviousness rejection requiring "a substantial reconstruction and redesign" and "a change in the basic principles" of the prior art). *See also* MPEP § 2143.01.

Here, the Examiner proposes that Kjorsvik's system be modified so that each individual user PC in the network would be able to select and import presentations "directly from an external network server." If this modification were implemented, the presentations would be stored locally on the user PCs, and there would be no presentations aggregated in the remote system database. The Examiner's proposed modification would thus render the Kjorsvik system unsatisfactory for its intended purpose, because the administration module would be unable to perform most (if not all) of the centralized presentation management functions for which it is designed, such as assigning presentations, scheduling presentations, exporting presentations to an external system, printing presentations, editing presentations, running a messenger module or picture editor, etc.

For example, without access to an aggregated set of presentations, the administration module would be unable to assign specific presentations to the network users. As explained at col. 4, lines 1-5 of Kjorsvik's disclosure, "this [assignment] capability allows the administration module 26 to match or select particular presentations to particular users, depending upon the needs or requirements of those users." Likewise, without access to an aggregated set of presentations, the administration module would be unable to generate "the particular schedule which is established for the appearance of the individual presentations at each of the network PCs." Kjorsvik at col. 4, lines 10-12. As explained in the same paragraph, "[f]or instance, each user in the system (each network PC) will have its own unique schedule of presentations, including a particular sequence of

different presentations and a specific time of nonuse required before a presentation begins. <u>This scheduling of presentations is established through the administration module and stored in system database 24.</u>" Kjorsvik at col. 4, lines 12-18 (emphasis added).

The implications of modifying Kjorsvik in the manner proposed by the Examiner are far more significant than suggested by the Examiner's argument. The Examiner's proposed modification to eliminate remote storage of presentations in Kjorsvik's system database would vitiate the functionality of the administration module, because the administration module would no longer have access to an aggregated set of presentations to manage. Thus, the Examiner's proposed modification would essentially negate Kjorsvik's entire disclosure of centralized network-level presentation management.

Moreover, there is no guidance in Kjorsvik (or anywhere else) for the person of ordinary skill to extensively modify Kjorsvik in the manner suggested, which results in the administration module and system database being eliminated, the centralized presentation management functions being removed, and a completely different system architecture being required. It is well-established law that obviousness cannot be proven using hindsight, that is, it "is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). *See also In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991) ("It is impermissible … simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps."). This law has not been obviated by the Supreme Court's *KSR* decision. As explained in the post-*KSR* case of *Takeda Chemical Indus. v. Alphapharm Pty.*, 492 F.3d 1350, 1357 (Fed. Cir. 2007), it "remains necessary to identify some reason that would have led a [skilled artisan] to modify a known [system] in a particular manner to establish prima facie obviousness of a new claimed [system]."

No such reason for modification is found here. The Examiner's stated rationale for radically altering the architecture of Kjorsvik's presentation management system is "for the advantage of eliminating the need to compose the presentation within the system." However, there is no reason to modify Kjorsvik in order to achieve this advantage. Kjorsvik's administration module *already provides* this advantage by importing presentations into the remote system database. Further, *the Examiner's proposed modification not only fails to add the stated advantage, it would actually remove all of the existing advantages* of Kjorsvik's centralized management system and gut Kjorsvik's invention. Accordingly, the Examiner has not provided a reason that would have led the person of ordinary skill to modify Kjorsvik in the manner suggested.

In particular, the ability to import presentations from an external source into the remote system database is already an established feature of Kjorsvik's system. Kjorsvik explicitly discloses

that the administration module may obtain the presentations in two different ways: by "composing" (creating) the presentations; or by importing the presentations from external systems or other outside sources. *Compare* Kjorsvik at col. 3 lines 30-67 and Figure 5 (composing) *with* col. 4 lines 19-24 and Figure 10 (importing). The ability of the administration module to import externally-generated presentations eliminates the need for the administration module to compose every presentation within the system. Kjorsvik at col. 4, lines 19-24. Accordingly, the statement on which the Examiner relies does not suggest making any changes to the existing system architecture, let alone a change to the system database, because it merely describes an *already existing function* in Kjorsvik's system.

While it stands to reason that importing a particular presentation has the "advantage" of eliminating the need to compose that particular presentation, this statement in Kjorsvik amounts to a simple observation of the difference between importation and composition. It is a non sequitur for the Examiner to argue that this statement has something to do with eliminating aggregation of presentations on Kjorsvik's remote system database. The Examiner's logic jumps from the statement linking the import and composition functions to a conclusion that the system database and the administration module should be completely removed from the system, and the import function should be moved from the administration module and system database to the individual user PCs. No such change is suggested by the disclosure of the import function. Changing the _source_ of the presentations (i.e., whether the administration module creates or imports the presentations) does not change the _function_ of the remote system database, which is to aggregate presentations so that the administration module can perform its presentation management functions.

Accordingly, for at least the stated reasons, each of the independent claims 1, 3, 7, 10, and 13 and dependent claims 9, 12, and 15 are patentable over Kjorsvik, and the Patent Owner respectfully requests the Examiner to reconsider and withdraw the obviousness rejections over Kjorsvik.

Salm is relied upon for allegedly teaching subject matter recited in dependent claims 2, 4, 6, 8, 11, and 14. However, Salm does not compensate for the deficiencies of Kjorsvik. Consequently, the subject matter of independent claims 1, 3, 7, 10, and 13 and their dependent claims would not have been obvious from any combination of Kjorsvik and Salm for at least the same reasons that the independent claims are allowable. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejections over Kjorsvik and Salm.

B.   Kjorsvik and Salm Fail to Teach or Suggest the Claimed Display "In an Unobtrusive Manner That Does Not Distract a User of the Display Device ... From a Primary Interaction"

> **1.   *The Broadest Reasonable Interpretation of the Claimed Display "In an Unobtrusive Manner..." Excludes Screensavers***

Each of the independent claims 1, 3, 7, 10 and 13 of the '314 patent is directed to providing information (e.g., an image or images generated from a set of content data) to a user in non-distracting ways that do not interfere with the user's primary interaction with a device such as a computer. As recited in each of the independent claims, the information is selectively displayed *"in an unobtrusive manner...."* '314 patent claims 1, 3, 7, 10 and 13 (emphasis added).

The proper interpretation of this claim term "in an unobtrusive manner..." has significant relevance in light of the prior art cited in this reexamination proceeding. In particular, the Patent Owner and the Third Party Requester (hereinafter "the Requester") disagree with respect to how broadly this claim term may reasonably be interpreted. The Patent Owner maintains that the claim term must be interpreted in light of the overall claim language and the specification, which mandates: (1) *inclusion of the "unobtrusive" ("wallpaper") embodiment* in which information is displayed to a user while the user is actively engaged in a primary interaction with the display device or apparatus; and (2) *exclusion of the "screensaver" embodiment* in which information is displayed while the display device or apparatus is idle. The Requester urges an unreasonably broad interpretation that ignores the overall claim language and the specification.

As the Federal Circuit and the Supreme Court instruct, claim terms must be interpreted as part of the overall patent specification of which they are a part, and cannot be read in a vacuum. Accordingly, during prosecution, the Office properly determines the meaning of claim terms by reviewing them in the context of the claims, and "in light of the specification as it would be interpreted by one of ordinary skill in the art." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316-17 (Fed. Cir. 2005) (*en banc*). *Cf. Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 389 (1996) ("[A claim] term can be defined only in a way that comports with the instrument as a whole.").

The broadest reasonable interpretation for the claim term "in an unobtrusive manner..." that is supported by the overall claim language and the specification is that it reads on the "unobtrusive" ("wallpaper") embodiment described in the specification, *i.e.*, where the display of the images generated from the set of content data occurs *while a user is engaged in a primary interaction* with the display device or apparatus. Thus, the claimed images are displayed *in addition to* the display of images resulting from the user's primary interaction, *e.g.*, as a background "wallpaper" behind a word processing application, or in an unused area of the display.

This interpretation is required by the context in which the claim term is used, *i.e.*, by the surrounding words of the claim. Here, the claim term "in an unobtrusive manner" is recited in each independent claim as part of a longer claim limitation, namely that the image(s) are displayed "in an unobtrusive manner that *does not distract a user* of the display device or an apparatus associated with the display device *from a primary interaction* with the display device or apparatus." '314 patent claims 1, 3, 7, 10 and 13 (emphasis added). This context is highly instructive, because it requires that *there must be some activity* (the primary interaction) *from which the user might be (but is not) distracted* by the display of the images. *See Phillips*, 415 F.3d at 1314 ("To begin with, the context in which a term is used in the asserted claim can be highly instructive").

The specification also mandates this interpretation because *each time* the term "in an unobtrusive manner..." is used, it describes an embodiment in which the information is displayed in an unobtrusive manner *while the user is engaged in a primary interaction* with the display device or apparatus. Moreover, the specification repeatedly contrasts the "unobtrusive" ("wallpaper") embodiment (where the user is engaged, e.g., active, in a primary interaction) with a second unclaimed "screensaver" embodiment (where the user is not engaged, e.g., inactive). The difference between these two embodiments is disclosed in the '314 patent, e.g., at col. 2 lines 18-28:

"screensaver" embodiment — For example, the information can be presented to the person while the apparatus (e.g., computer) is operating, but during inactive periods (i.e., when a user is not engaged in an intensive interaction with the apparatus). Or, the information can be presented to the person during active periods (i.e., when a user is engaged in an intensive interaction with the apparatus), but in an unobtrusive manner that does not distract the user from the primary interaction with the apparatus (e.g., the information is presented in areas of a display screen that are not used by displayed information associated with the primary interaction with the apparatus). — "unobtrusive" embodiment

at col. 3 lines 28-40:

"screensaver" embodiment — According to a further aspect of the invention, the selective display of the image or images begins automatically after detection of an idle period of predetermined duration (the "screen saver embodiment"). This aspect can be implemented, for example, using the screen saver API (application program interface) that is part of many operating systems. According to another further aspect of the invention, the selective display of an image or images occurs while the user is engaged in a primary interaction with the apparatus, which primary interaction can result in the display of an image or images in addition to the image or images generated from the set of content data (the "wallpaper embodiment"). — "unobtrusive" embodiment

at col. 6 lines 43-54:

"screensaver" embodiment —

> In one embodiment of the invention, the information is presented by the attention manager while a primary interaction is ongoing, but during inactive periods (i.e., when the user is not engaged in an intensive interaction with the apparatus). In another embodiment of the invention, the information is presented by the attention manager during active periods (i.e., when the user is engaged in an intensive interaction with the apparatus), but in an unobtrusive manner that does not distract the user from the primary interaction (e.g., the information is presented in areas of a display screen that are not used by displayed information associated with the primary interaction).

"unobtrusive" embodiment

and at col. 13 lines 12-25:

"screensaver" embodiment —

> The method 100 (FIG. 1) described above is an embodiment of the invention in which the attention manager presents information to a person (which can be the user or another person) in the vicinity of the display device during inactive periods when a user is not engaged in an intensive interaction with the computer (as indicated by the step 102 which checks for the occurrence of an "idle period" before beginning operation of the attention manager). As indicated above, in other embodiments of the invention, the attention manager presents information to the person during active periods, but in an unobtrusive manner. In such embodiments, video content data could be presented, for example, as "wallpaper" on the display screen of a video display monitor.

"unobtrusive" embodiment

The specification thus makes it plain that the term "in an unobtrusive manner..." is associated with the "unobtrusive" ("wallpaper") embodiment and is not associated with the "screensaver" embodiment. Accordingly, the broadest reasonable interpretation of this term that is consistent with the specification is that the display of the images generated from the set of content data occurs *while a user is engaged in a primary interaction* with the display device or apparatus, and *does not encompass the display of screensavers. In re Suitco Surface, Inc.,* 603 F.3d 1255, 1259 (Fed. Cir. 2010) ("During reexamination, as with original examination, the PTO must give claims their broadest reasonable construction *consistent with the specification.*" (emphasis added) (citations omitted)). *See also* MPEP § 2111.

The Requester urges an extremely broad interpretation of the "in an unobtrusive manner..." term that would encompass the "screensaver" embodiment. However, the Requester's overly broad interpretation is *not reasonable* because it *conflicts* with the overall claim language

and with the specification's express teachings that the "unobtrusive" embodiment and the "screensaver" embodiment are two *separate* embodiments.

The surrounding claim language and the specification cannot be ignored as Requester urges. "The broadest-construction rubric ... does not give the PTO an unfettered license to interpret claims to embrace anything remotely related to the claimed invention. Rather, *claims should always be read in light of the specification and teachings in the underlying patent.*" *Suitco Surface*, 603 F.3d at 1260 (reversing PTO's interpretation of "finishing material" as overly broad and unreasonable in view of the specification) (emphasis added). *See also In re Marosi*, 710 F.2d 799, 802 (Fed. Cir. 1983) (reversing PTO's overly broad construction of "free from alkali metal" because "claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their 'broadest reasonable interpretation.'") (citation omitted), *cited in* MPEP § 2111.01.[1]

In addition, the Requester's suggested interpretation would render other claim terms functionally meaningless. If the term "in an unobtrusive manner..." is interpreted as broadly as Requester desires, *i.e.*, to cover any manner of display, it would effectively eliminate all of the meaning provided by the claim limitation. In other words, because the specification makes it clear that screensavers are not part of the unobtrusive embodiment, **Requester's interpretation would effectively strike all of the words** "in an unobtrusive manner that does not distract a user of the display device or an apparatus associated with the display device from a primary interaction with the display device or apparatus" *from the claims*, because Requester's display would not be unobtrusive, and there would be no primary interaction from which a user could be distracted.

Such an interpretation is legally improper. The Federal Circuit has repeatedly warned against interpreting claim terms in such a way that contradicts the claim language or renders other terms in the claims superfluous. *See Cat Tech LLC v. Tubemaster, Inc.*, 528 F.3d 871, 885 (Fed. Cir. 2008) (interpretation cannot render other limitations "functionally meaningless"); *Phillips*, 415 F.3d at 1314 (must interpret claim in context of surrounding claim language); *Wright Medical Tech., Inc. v. Osteonics Corp.*, 122 F.3d 1440, 1444 (Fed. Cir. 1997) (interpretation should not render claim language mere "surplusage"); *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1562 (Fed. Cir. 1991) ("All the limitations of a claim must be considered meaningful"). *See also Ex Parte Givens*, in Appeal No. 2009-003414 at 3 (Bd. Pat. App. & Int. August 6, 2009) ("Any interpretation that fails to give

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[1]   *See also Ex Parte Team Worldwide Corp.*, Appeal No. 2010-002223 at 9-10 (Bd. Pat. App. & Int. July 22, 2010) (reversing Examiner's interpretation of the "pump body" claim term as unreasonable because it was inconsistent with specification); *Ex Parte Technofirst S.A.*, Appeal No. 2009-010931 at 10-11 (Bd. Pat. App. & Int. March 5, 2010) (reversing Examiner's interpretation of the "complex polynomial function" claim term as unreasonable because it was inconsistent with the specification).

weight to "sub-band," "spectral," "subtractive," and "routine" deprives the words in this claim term of their normal meaning.").

The Requester also argues in its Request that the prosecution history should trump the specification when interpreting the claims in this proceeding. *See, e.g.,* Request for *Inter Partes* Reexamination at pp. 14-20. In particular, the Requester points to a particular response filed in Application No. 08/620,641 (the grand-parent application of the '314 patent), in which the prosecuting attorney argued that the claims of that application should be interpreted to cover both the "unobtrusive" and "screensaver" embodiments.[2]

Requester's argument is fatally flawed, however, because *the prosecuting attorney's broadening argument conflicts with the specification's teachings that the "in an unobtrusive manner ..." term is only associated with the "unobtrusive" ("wallpaper") embodiment*. It is well-established jurisprudence that when the prosecution history conflicts with the specification, the specification controls. *See Telcordia Technologies Inc. v. Cisco Sys. Inc.,* 612 F.3d 1365, 1375 (Fed. Cir. 2010) ("These prosecution history comments cannot trump the plain language of the claims and the direct teaching of the specification."); *Honeywell Int'l, Inc. v. ITT Industrials, Inc.,* 452 F.3d 1312, 1319 (Fed. Cir. 2006) ("[A]n expression by a patentee during prosecution that he intends his claims to cover more than what his specification discloses is entitled to little weight."); *Boss Control, Inc. v. Bombardier Inc.,* 410 F.3d 1372, 1378 (Fed. Cir. 2005) ("Neither the dictionary definition nor the prosecution history, however, overcomes the particular meaning . . . clearly set forth in the specification."). *See also Biogen v. Berlex Labs., Inc.,* 318 F.3d 1132, 1140 (Fed. Cir. 2003) ("Representations during prosecution cannot enlarge the content of the specification").

Moreover, the "broadest reasonable interpretation" of the claims is made in light of the specification and the ordinary meaning of the claim terms, and *is not guided by the prosecution history*. *Phillips,* 415 F.3d at 1316. *See also Ex Parte Team Worldwide,* Appeal No. 2010-002223 at 10 (Bd. Pat. App. & Int. July 22, 2010) (italics in original; underline added):

> In reaching our conclusion that the claims are not anticipated by Chaffee, we note that <u>we do not agree with Appellant that the meaning of the term "pump body" must be construed in light of the prosecution history</u> of the '469 patent and certain statements made therein by the Examiner (Appeal Br. 8-11). During proceedings before the PTO, claim are given their broadest reasonable interpretation in light of the *specification* and the *ordinary meaning* of the claim terms as they would be understood by a skilled worker.

Even if the prosecution history were consulted, the Federal Circuit has repeatedly instructed that the purpose of consulting the prosecution history is to determine "whether the inventor *limited* the invention in the course of prosecution, making the claim scope *narrower than it would otherwise*

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[2] The prosecuting attorney's statement appears in a response filed July 9, 1998 in the grand-parent application, U.S. Pat. Application No. 08/620,641, at pp. 13-14.

be." *Phillips*, 415 F.3d at 1317 (emphasis added); *Chimie v. PPG Industries, Inc.*, 402 F.3d 1371, 1384 (Fed. Cir. 2005); *Southwall Technologies, Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1576 (Fed. Cir. 1995); *ZMI Corp. v. Cardiac Resuscitator Corp.*, 844 F.2d 1576, 1580 (Fed. Cir. 1988); *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 452 (Fed. Cir. 1985). Here, the Requester attempts to turn this well-established instruction on its head by arguing that *broadening* arguments made by the prosecuting attorney during prosecution should control. There is no legal support for Requester's arguments.

New dependent claims 16-25 present two specific examples of how the claimed images are displayed *in addition to* the display of images resulting from the user's primary interaction, *i.e.*, "in an unobtrusive manner...". For example, claims 16-25 require the claimed images to be displayed *"during an active period* of the primary interaction with the display device or apparatus", *e.g.*, as a background "wallpaper" behind a word processing application. Claims 17, 19, 21, 23 and 25 also require the claimed images to be "displayed in an area of the display device *that is not used by the primary interaction,"* *e.g.*, in an unused area of the display during an active period. Thus, dependent claims 16-25 further clarify that the claims cannot encompass the display of screensavers.

In conclusion, the term "in an unobtrusive manner..." is properly interpreted consistently with the specification as encompassing only the "unobtrusive" ("wallpaper") embodiment, and not the display of screensavers.

2.   *Kjorsvik and Salm Fail to Teach or Suggest the Claimed Display "In an Unobtrusive Manner..."*

The Examiner rejected all of the claims as obvious over Kjorsvik, either alone or in combination with Salm. In particular, the Examiner has asserted for each claim that Kjorsvik's screensaver maps to the claimed display of images "in an unobtrusive manner that does not distract a user of the display device or an apparatus associated with the display device from a primary interaction with the display device or apparatus." Office Action at pages 5, 10, 15, 20, 25 and 30.

Patent Owner respectfully disagrees. As explained in the preceding section, this claim term requires the display of the images *while a user is engaged in a primary interaction* with the display device or apparatus, and *does not encompass the display of screensavers*.

Kjorsvik does not disclose such a display. Instead, Kjorsvik discloses a screensaver that is activated during idle periods. In particular, Kjorsvik teaches presentations (e.g., slideshows) that *replace* a "conventional" screensaver when the user's personal computer (PC) is *not in use, i.e., inactive. See* Kjorsvik at, e.g., col. 2 lines 13-18 (emphasis added):

> The presentations are initiated for each PC in the network following a selected amount of time during which each PC has been in an "on" state but has not been in use. *These presentations in effect replace the conventional screen saver,* but in addition, provide information in visual form which is intended to be beneficial to the user of the PC.

col. 3 lines 1-9 (emphasis added):

> The appearance of the successive slides on the PC screen is monitored by the messenger module to ensure that the individual slides in the presentation are presented in sequential order, even in the event that there is *a break in the immediate presentation, such as caused by the user operating the PC.* At any point in the presentation, the user may begin use of the PC, such as for work-in-progress, by simply pushing any key on the PC keyboard except for a designated key which is for manual control of the presentation.

col. 5 lines 4-8 (emphases added):

> *When a network PC has not been in use for the specific period of time* established for that particular PC, *the messenger module, in coordination with the database, will automatically begin the assigned presentation* on the PC's screen.

and col. 5 lines 14-17 (emphasis added):

> Each slide is shown for a preselected period of time, and then, *if the PC is still not being used, the next slide in the presentation sequence is shown,* again under the control of the messenger module.

Thus, as can be seen by the excerpted passages, Kjorsvik discloses a screensaver that displays presentations on a personal computer (PC) while the PC is "not being used." If the user does "begin use of the PC", then the screensaver stops displaying the presentations. Such disclosure fails to teach or suggest the claimed *"in an unobtrusive manner* that does not distract a user of the display device or an apparatus associated with the display device from a primary interaction with the display device or apparatus," which, as discussed *supra,* requires that the display of the images generated from the set of content data occurs *while a user is engaged in a primary interaction* with the display device or apparatus.

Salm merely discloses that a television may be used as a computer monitor. This disclosure fails to supplement the deficiencies of Kjorsvik.

Accordingly, for at least the stated reasons, each of the independent claims 1, 3, 7, 10 and 13 is patentable over Kjorsvik, either alone or in combination with Salm. Claims 2, 4, 8-9, 11-12, and 14-31 depend, either directly or indirectly, from one of the independent claims, and are thus in condition for allowance for at least the same reasons that the independent claims are allowable.

IV.   COMMENTS REGARDING RAKAVY

In the Office Action, the Examiner declined to reject the claims over U.S. Patent No. 5,913,040 to Rakavy et al. (hereinafter "Rakavy"). In particular, the Examiner stated that Rakavy fails to disclose the claim limitation "*without* the content data being aggregated at a common physical location *remote* from the content display system prior to being provided to the content display system." Office Action at pages 36-37 (emphasis added). The Examiner relied on the advertisement database 230 as the basis for concluding that Rakavy discloses remote aggregation.

Patent Owner agrees that Rakavy fails to disclose this limitation, because Rakavy aggregates advertisements at a common physical location that is remote from the content display system. In addition to the aggregation in the advertisement database 230 cited by the Examiner, Patent Owner notes that remote aggregation of advertisements occurs in the database 730 located on the advertising system server 600 (a common physical location remote from user computers).

Rakavy discloses a system that controls the bandwidth utilized by advertisement downloads, which comprises a local computer 500 and an advertising system server 600 connected via a network 700. *See, e.g.,* Rakavy at Figure 1 (reproduced herein with italic text added):
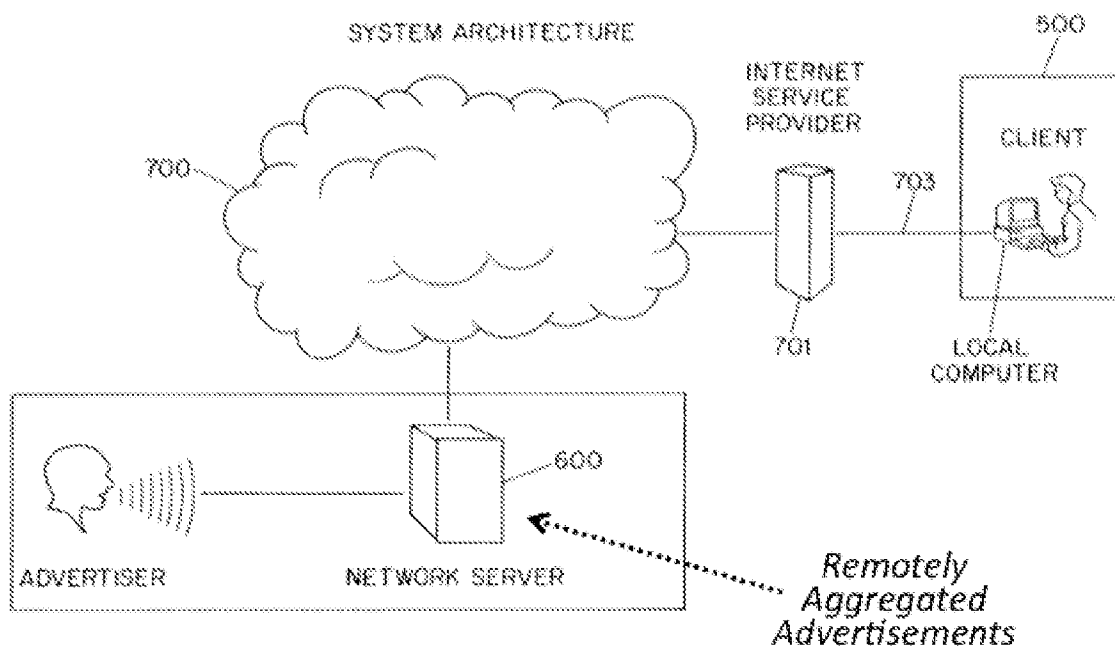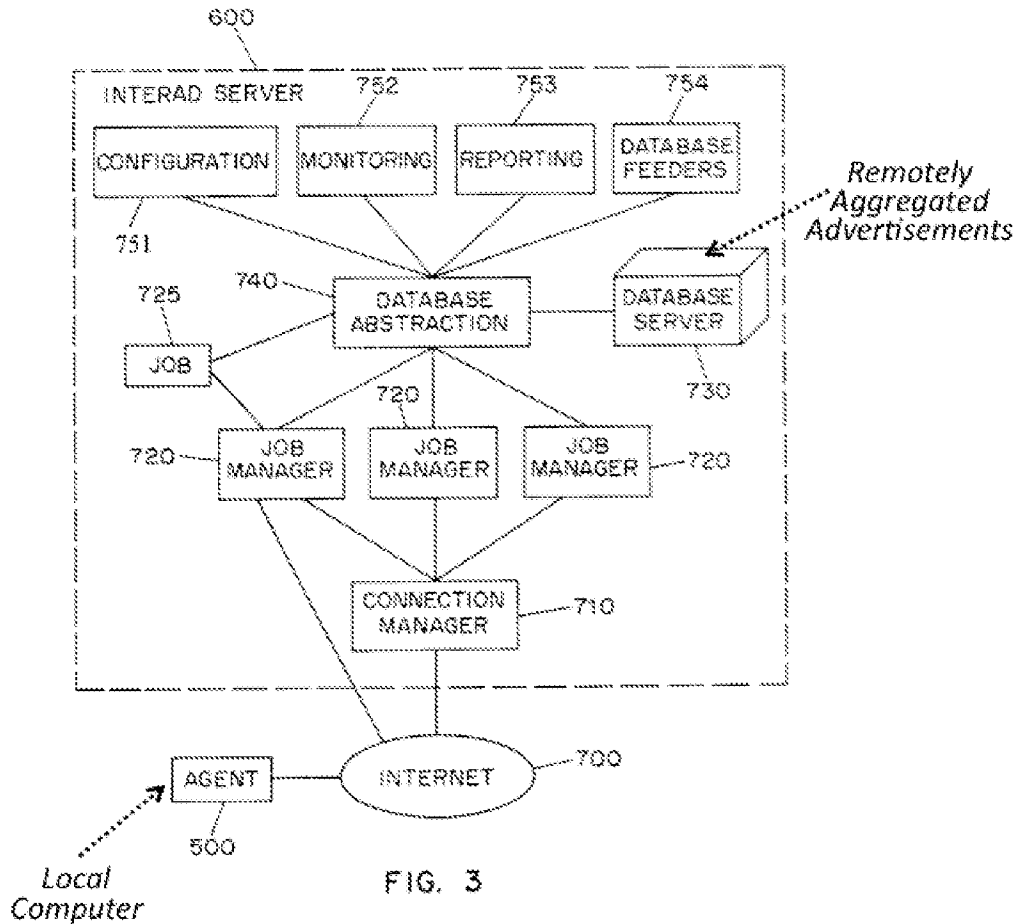

FIG. 1

The advertising system server 600 comprises a database 730 for storing advertisements, which are downloaded to the local computer 500. *See, e.g.,* Rakavy at Figure 3 (reproduced herein with italic text added):

FIG. 3

col. 5 lines 31-36 (emphasis added):

> The system preferably includes at least one Advertising System Server 600. The *main roles of the Advertising System Server 600 are to store Advertisements 50, transfer the Advertisements 50 to the Local Computer 500,* and collect user feedback.

and col. 6 lines 9-30 (emphasis added):

> The Local Computer 500 initially connects to the Connection Manager 710 which is responsible for allocating an available Job Manager 720 and returning its address to the agent.... The Job Manager 720 creates a Network Job 725 for each user it communicates with. *Each Network Job 725 communicates with the Local Computer 500 to select and download Advertisements 50;* collect feedback from the Local Computer 500; check the user's participation and any awards from contests, etc.; and upgrades and installs the Local Computer 500 software versions....

The local computer 500 of Rakavy utilizes advertisement feeder 250 and internet ad feeder 270 to download advertisements from the database 730 of the remote advertising system server 600 to the interad database 230. Although the interad database 230 may be located locally as shown in Fig. 4, or may be located on a LAN server as described at col. 9 lines 1-7, its location is not important to the overall system architecture because it does not change the need to download the advertisements aggregated in the remote server 600. *See, e.g.,* Rakavy at Figure 4, col. 7 lines 32-42, and col. 12 lines 6-40. Figure 4 (reproduced herein with italic text added) depicts the structure of the local computer 500:
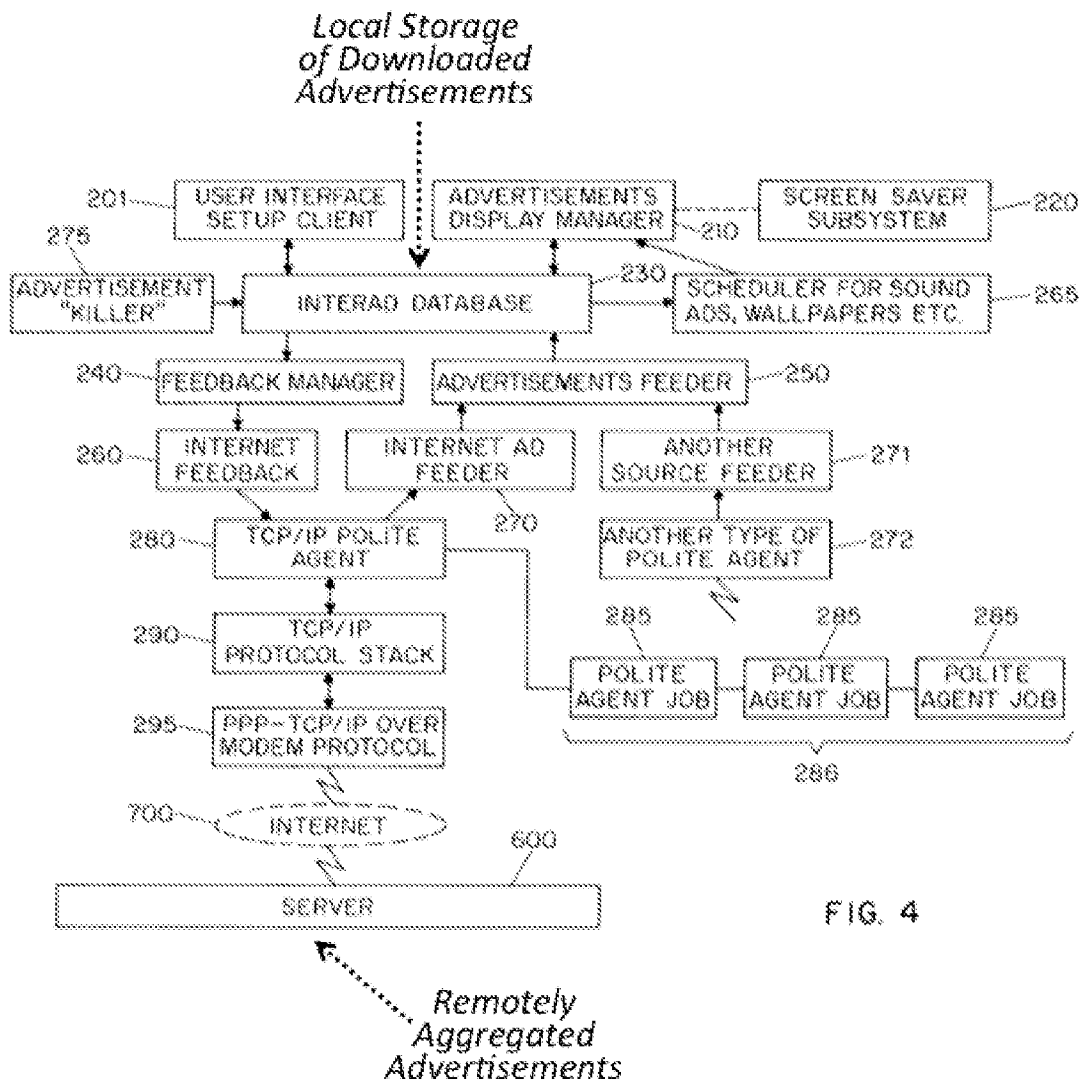

FIG. 4

Regardless of where the interad database 230 is located, the advertisement feeder 250 (shown in Figure 4) will still need to download advertisements from the remote advertising system server 600 as described at col. 12 lines 16-40 (emphasis added) and Figure 9 (not shown):

> ... To download a new Advertisement 50, *the Advertisement Feeder 250 first creates a Polite Agent Job 285 to request the Advertising System Server 600 to select the next advertisement for downloading (step 251).* The Advertising System Server 600 selects the next Advertisement 50 to be transferred based on the individual user's preferences and configuration and pricing parameters attached to each Advertisement 50.... Once the resources have been downloaded, the Advertisement Feeder 250 adds the Advertisement 50 to the User Preference and Advertisement Database 230 (step 253).

The Patent Owner therefore agrees with the Examiner that Rakavy discloses remote aggregation of advertisements at a common physical location (the advertising system server 600, and in some embodiments also the advertisement database 230 on a server). Because the '314 patent claims require the **absence** of remote aggregation, Rakavy thus fails to teach or suggest the claim limitation "***without*** the content data being aggregated at a common physical location remote from the content display system prior to being provided to the content display system," and the Examiner properly declined to adopt the proposed rejections over Rakavy.

V.   <u>CONCLUSION</u>

For the reasons stated in the foregoing arguments, all of the pending claims 1-4 and 7-31 are patentable over the cited art, and confirmation of their patentability is earnestly requested.

Any issues raised by the Third Party Requester or the Examiner that are not addressed herein are believed to be moot. Accordingly, the Patent Owner should not be deemed to have acquiesced in any factual or legal conclusion in connection with any such issues by failing to address the same herein.

Credit card payment has been submitted concurrently with the filing of this transmittal for payment of the fees for added claims pursuant to 37 C.F.R. § 1.20(c)(4). The Director is hereby authorized to charge any additional appropriate fees that may be required for the above-identified reexamination proceeding, and to credit any overpayment, to Deposit Account No. **05-0460**.

Dated: July 26, 2011   Respectfully submitted:

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