

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: HOLA-005-US8

In re Application of:	)	Confirmation No. 5327
	)	
Derry Shribman <i>et al.</i>	)	Art Unit: 2459
	)	
Appln. No.: 16/278,105	)	Examiner: Nguyen Minh Chau
	)	
Filed: February 17, 2019	)	Washington, D.C.
	)	
For: SYSTEM PROVIDING FASTER AND MORE EFFICIENT DATA COMMUNICATION	)	August 6, 2019
	)	

RESPONSE / AMENDMENT:

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Randolph Building, Mail Stop Amendments
401 Dulany Street
Alexandria, VA 22314

Sir:

In response to the Non-Final Office Action of
June 12, 2019 ("Action"):

Remarks/Arguments begin on page 2 of this paper.

REMARKS / ARGUMENTS

The examiner's action dated June 12, 2019 ("Action") has been received and its contents carefully noted. An eTD was filed to overcome the Double Patenting rejection.

Office Action, pages 6-16

Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yu *et al.* (US 2006/0212584 - "Yu") and in view of Barth *et al.* (US 2001/0054020 - "Barth").

Combining Yu and Barth references

a. The Action does not explain WHY the Yu and Barth references are analogous and can be combined. If the Examiner contends that they are analogous art being in the same field, **a clear definition stating that field is requested, as required in the rules.** In one example, while the Yu invention is directed to using **peer-to-peer** direct communication, the Barth invention is focused on fetching information from additional **servers**.

b. The rationale for combining with the Yu and Barth references is stated as *"... in order to provide an improvement for an information/communication exchange via a network"*. It is respectfully submitted that this rationale amounts to nothing more than a conclusory statement. It is not clear what improvement is provided and WHY. It is settled that the Office should provide a "satisfactory explanation" for the motivation for a finding that includes an express and **"rational" connection with the evidence presented**. Further, the rationale provides no link to the present application, as required in MPEP 2143 that clearly states that *"Any rationale employed must provide a link between the factual findings and the legal*

conclusion of obviousness." (Emphasis added), and "... *there must be "some articulated reasoning with some rational underpinning" to support the Examiner's findings and conclusion of obviousness*". See *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 401, 418 (2007).

c. The rationale is improper since the Yu reference already teaches an improvement of reducing server load and servicing of multiple clients (for example, see paragraphs 0004, 0016, 0025), hence additional improvement is not required, and the Action provides no explanation of why one of ordinary skill in the art would have modified accordingly the Yu reference. It is noted that In *Square, Inc. v. Cooper*, IPR2014-00158, Paper No. 8, at 30 (15 May 2014), an obviousness challenge was dismissed where the primary reference already had the capabilities that the secondary reference provided with its added disclosures. Moreover, it would not be appropriate to base this rejection on a combination of these references because the devices in Yu and Barth are each self-contained and independently operate effectively to improve "*an information/communication exchange via a network*", and it is settled in *Kinetic Concepts v. Smith and Nephew*, 688 F.3d 1342, at 1369 (CAFC, 2012) that:

Because each device independently operates effectively, a person having ordinary skill in the art, who was merely seeking to create a better device to drain fluids from a wound, would have no reason to combine the features of both devices into a single device.

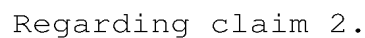
d. The Yu reference in general, and the cited passages in particular, is focused on reducing a load of a server by accessing client peer devices **rather than the server storing the required content**, where the system is managed by an additional server (indexing server 404). Modifying the Yu

reference so that the content is provided via the indexing server 404 resumes the basic problem of server loading, and thus the Yu reference effectively teaches away from the suggested modification.

e. The Action relies upon the Barth reference for the steps of sending of the first content identifier and receiving in response the first content. However, the Barth in general, and the cited paragraphs in particular, does NOT disclose any content delivery of the content itself but only information regarding the location of the content.

Regarding Claim 1

a. A non-limiting pictorial view of claim 1, in comparison to the cited Figure 4 of the Yu reference is shown in the Figure below. The comparison further illustrates the substantial differences. The Yu reference is directed to peer-to-peer communication and thus does not teach any content receiving from the first server, or from any server that is not the actual web server.



Claim 2 recites that the method: "... further comprising, by the first server, sending the received first content, or the part thereof, to the first client device.". The Action is based on steps 310 and 312 in Figure 3 of the Barth reference.

a. As explained in paragraph 0031 of the Barth reference, the data 'presented to the user' as part of step 312 is not the content requested or addressed by the user, but rather relating to a manipulation of the request as part of steps 306 and 308, thus the claim limitation is NOT taught.

b. The rejection is based on the Barth reference, however no rationale is provided for modifying the Yu reference with these limitations. Further, it is noted that this claim depends from claim 1 and further defines the 'selecting', where the rejection is based on the Yu reference for this feature. Furthermore, it is noted that the rejection of claim 1 is based on the Barth reference with regard to different limitations discussed in claims 1, and the rationale provided for combination in claim 1 is not relevant to the applied limitations of these claims.

I - Regarding claim 6

a. Claim 6 recites selection of the second client device by the first server. In contrast, BOTH the Yu and Barth references are silent regarding any selecting by any server in general, and sending only the selected peers in particular. In fact, the Yu reference teaches away from any selecting by any server. Further, the indexing server 404, as described in the cited paragraphs, sends the WHOLE list of peers to the requesting client, and **the selecting is made in the requesting client device** (see step 514 in Figure 5). The Yu reference is silent regarding any selecting by any server in general, and sending only the selected peers in particular.

b. The rejection is based on the Barth reference, however no rationale is provided for modifying the Yu reference with these limitations. Further, it is noted that this claim depends from claim 1 and further defines the 'selecting', where the rejection is based on the Yu reference for this feature. Furthermore, it is noted that the rejection of claim 1 is based on the Barth reference with regard to different limitations discussed in claims 1, and the rationale provided for

combination in claim 1 is not relevant to the applied limitations of these claims.

II- Regarding claim 6.

Claim 6 recites that the method: "... sending, by the first server, **the selected IP addresses** in response to the selecting." (Emphasis added). The Action is based on steps 308 and 310 in Figure 3 of the Barth reference.

a. As explained in paragraph 0031 of the Barth reference, the data 'presented to the user' as part of steps 310 and 312 is not the content requested or addressed by the user, but rather relating to a manipulation of the request as part of steps 306 and 308, thus the claim limitation is NOT taught. The Barth reference in general, and the cited Figure in particular, are silent regarding any sending of any IP address in general, and regarding the sending of the selected IP address as recited in the claim in particular.

b. The rejection is based on the Barth reference, however no rationale is provided for modifying the Yu reference with these limitations. Further, it is noted that this claim depends from claim 1 and further defines the 'selecting', where the rejection is based on the Yu reference for this feature. Furthermore, it is noted that the rejection of claim 1 is based on the Barth reference with regard to different limitations discussed in claims 1, and the rationale provided for combination in claim 1 is not relevant to the applied limitations of these claims.

Regarding Claim 8

Claim 8 recites that the method: "... further comprising responsive to the receiving of the first message from the first client device, adding the first client device to the plurality of client devices by including the IP address of the first device to the list.". The rejection is based on paragraphs 0057 and 0176 of the Barth reference.

a. It is unclear how paragraph 0057 is not relevant to the recited limitation. A clear explanation is requested. Regarding paragraph 0176, this paragraph ONLY discloses storing cookies in the requesting peer device, and does not disclose any storing in any server, or any storing of any IP address, and further regarding any adding any IP address of any client device as recited in the claim.

b. The rejection is based on the Barth reference, however no rationale is provided for modifying the Yu reference with these limitations. Further, it is noted that this claim depends from claim 1 and further defines the 'selecting', where the rejection is based on the Yu reference for this feature. Furthermore, it is noted that the rejection of claim 1 is based on the Barth reference with regard to different limitations discussed in claims 1, and the rationale provided for combination in claim 1 is not relevant to the applied limitations of these claims.

Regarding Claim 9

Claim 9 recites that the method: "... further comprising by the first server: sending to each of the client devices in the plurality of client devices, a 'keep alive' message; and waiting for a response to the 'keep alive' message from each of

the client devices in the plurality of client devices.". The rejection is based on paragraph 0095 of the Barth reference.

a. While the cited paragraph 0095 mentions by passing using 'keep-alive', it is silent regarding any sending of such message or waiting for any such message as recited in the claim.

b. The rejection is based on the Barth reference, however no rationale is provided for modifying the Yu reference with these limitations. Further, it is noted that this claim depends from claim 1 and further defines the 'selecting', where the rejection is based on the Yu reference for this feature. Furthermore, it is noted that the rejection of claim 1 is based on the Barth reference with regard to different limitations discussed in claims 1, and the rationale provided for combination in claim 1 is not relevant to the applied limitations of these claims.

Regarding Claim 10

Claim 10 recites that the method: "... *further comprising by the first server: receiving a message from the third client device; and responsive to the receiving of the message from the third client device, adding the third client device to the plurality of client devices by including the IP address of the third device to the list.*". The rejection is based on paragraphs 0057, 0176, and 0095-0098 of the Barth reference.

a. It is unclear how the cited paragraphs 0057 0057, 0176, and 0095-0098 are relevant to the recited limitations, since none of them teach any list, any adding to the list, any IP address inclusion in a list, and in particular any "adding the third

client device to the plurality of client devices by including the IP address of the third device to the list." as recited in the claim. A clear explanation is requested.

b. The rejection is based on the Barth reference, however no rationale is provided for modifying the Yu reference with these limitations. Further, it is noted that this claim depends from claim 1 and further defines the 'selecting', where the rejection is based on the Yu reference for this feature. Furthermore, it is noted that the rejection of claim 1 is based on the Barth reference with regard to different limitations discussed in claims 1, and the rationale provided for combination in claim 1 is not relevant to the applied limitations of these claims.

Regarding Claim 11

Claim 11 recites that the method: *"... further comprising responsive to not receiving, by the first server, a response to the 'keep alive' message from a third client device in the plurality of client devices, removing the third client device from the plurality of client devices by removing the IP address of the third device from the list."* The rejection is based on paragraphs 0095-0098, 0221, and 0232 of the Barth reference.

a. While the cited paragraph 0095 mentions by passing using 'keep-alive', the cited paragraphs are regarding any actions in response to such message in general, and updating any list in particular, as recited in the claim.

b. The rejection is based on the Barth reference, however no rationale is provided for modifying the Yu reference with these limitations. Further, it is noted that this claim depends from

claim 1 and further defines the 'selecting', where the rejection is based on the Yu reference for this feature. Furthermore, it is noted that the rejection of claim 1 is based on the Barth reference with regard to different limitations discussed in claims 1, and the rationale provided for combination in claim 1 is not relevant to the applied limitations of these claims.

Regarding Claim 13

Claim 13 recites selection of the second client device by the first server. In contrast, BOTH the Yu and Barth references are silent regarding any selecting by any server in general, and sending only the selected peers in particular. In fact, the Yu reference teaches away from any selecting by any server. Further, the indexing server 404, as described in the cited paragraphs, sends the WHOLE list of peers to the requesting client, and **the selecting is made in the requesting client device** (see step 514 in Figure 5). The Yu reference is silent regarding any selecting by any server in general, and sending only the selected peers in particular.

Regarding Claim 15

Claim 15 recites that the method: "... *further comprising: receiving, a second message by the first server from a third client device that is identified over the Internet using a third IP address; and adding, by the first server in response to the receiving of the second message, the third client device to the first plurality of client devices by adding the third IP address to the first list.*". The rejection is based on paragraphs 0057, 0176, and 0095-0098 of the Barth reference.

a. It is unclear how the cited paragraphs 0057 0057, 0176, and 0095-0098 are relevant to the recited limitations, since none of them teach any list, any adding to the list, any IP address inclusion in a list, and in particular any *"adding the third client device to the plurality of client devices by including the IP address of the third device to the list."* as recited in the claim. A clear explanation is requested.

b. The rejection is based on the Barth reference, however no rationale is provided for modifying the Yu reference with these limitations. Further, it is noted that this claim depends from claim 1 and further defines the 'selecting', where the rejection is based on the Yu reference for this feature. Furthermore, it is noted that the rejection of claim 1 is based on the Barth reference with regard to different limitations discussed in claims 1, and the rationale provided for combination in claim 1 is not relevant to the applied limitations of these claims.

Regarding Claim 16

Claim 16 recites that the method: *"... wherein the selecting of the second client device is according to, or based on, the criterion."* The rejection is based on paragraphs 0057 and 0176 of the Barth reference.

It is unclear how paragraph 0057 is not relevant to the recited limitation, as it is not related to any 'selecting' action. A clear explanation is requested. Regarding paragraph 0176, this paragraph ONLY discloses storing cookies in the requesting peer device, and does not disclose any selecting in general, and further regarding any criterion based selecting in particular, as recited in the claim.

Regarding Claim 17

Claim 17 recites that: "... the criterion is based on, or comprises, a numerical closeness to the web server IP address.". The rejection is based on paragraphs 0057, 0083, and 0176 of the Barth reference.

a. It is unclear how the cited paragraphs 0057, 0083, and 0176 are relevant to the recited limitations, as it is not related to any 'selecting' action in general, and to any 'numerical closeness' in particular, as recited in the claim.

b. The rejection is based on the Barth reference, however no rationale is provided for modifying the Yu reference with these specific limitations. Further, it is noted that this claim depends from claim 1 and further defines the 'selecting', where the rejection is based on the Yu reference for this feature. Furthermore, it is noted that the rejection of claim 1 is based on the Barth reference with regard to different limitations discussed in claims 1, and the rationale provided for combination in claim 1 is not relevant to the applied limitations of these claims.

Regarding Claim 18

Claim 18 recites that: "... the criterion is based on, or comprises, a geographical location of the selected client device.". The rejection is based on paragraph 0083 of the Barth reference.

a. The cited paragraph 0083 ONLY states that the server may be in a 'different physical location', while the claim recites locations of the peer clients. Second, the fact that a device

is in a 'different physical location' cannot be equated to *"the criterion is based on, or comprises, a geographical location of the selected client device"* as recited in the claim.

b. The rejection is based on the Barth reference, however no rationale is provided for modifying the Yu reference with these specific limitations. Further, it is noted that this claim depends from claim 1 and further defines the 'selecting', where the rejection is based on the Yu reference for this feature. Furthermore, it is noted that the rejection of claim 1 is based on the Barth reference with regard to different limitations discussed in claims 1, and the rationale provided for combination in claim 1 is not relevant to the applied limitations of these claims.

Regarding Claim 20

Claim 20 recites that: *"... further comprising establishing, by the first server, a Transmission Control Protocol (TCP) connection with the first or second client device."* The rejection is based on paragraph 0024 of the Yu reference.

While the cited paragraph 0024 of the Yu reference mentions by-passing using TCP, it is silent regarding 'TCP connection' which is technically different from just using the TCP protocol, as explained in the specification.

Regarding Claim 22

Claim 22 recites that: *"... wherein the method further comprising sending, by the first server to the first or second client device, a message that comprises the first version number of the software application."* The rejection is based on paragraphs 0069-0072 and 0091 of the Barth reference.

a. It is unclear how the cited paragraphs 0069-0072 and 0091 are relevant to the recited limitations, as it is not related to any software version in general, and sending such version in particular. A clear explanation is required.

b. The rejection is based on the Barth reference, however no rationale is provided for modifying the Yu reference with these specific limitations. Further, it is noted that this claim depends from claim 1 and further defines the 'selecting', where the rejection is based on the Yu reference for this feature. Furthermore, it is noted that the rejection of claim 1 is based on the Barth reference with regard to different limitations discussed in claims 1, and the rationale provided for combination in claim 1 is not relevant to the applied limitations of these claims.

The absence of a reply to a specific rejection, issue, or comment, does not signify agreement with that rejection, issue, or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims that have not been expressed.

Nothing in this reply should be understood as conceding any issue with regard to any claim, except as specifically stated in this reply, and the amendment of any claims does not necessarily signify concession of unpatentability to the claim before its amendment.

In view of the foregoing, it is requested that all of the rejections be reconsidered and withdrawn and that the claims be considered allowable.

If the above arguments should not now place the application in the condition for allowance, the examiner is invited to call undersigned counsel to resolve any remaining issues.

Respectfully submitted,

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