

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: HOLA-005-US5

In re Application of:	)	Confirmation No. 4259
	)	
Derry Shribman <i>et al.</i>	)	Art Unit: 2459
	)	
Appln. No.: 15/957,950	)	Examiner: Nguyen Minh Chau
	)	
Filed: April 20, 2018	)	Washington, D.C.
	)	
For: SYSTEM PROVIDING FASTER AND MORE EFFICIENT DATA COMMUNICATION	)	August 23, 2018
	)	

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 August
8, 2016 ("Action"):

Remarks/Arguments begin on page 2 of this paper.

REMARKS / ARGUMENTS

The examiner's action dated August 8, 2018 ("Action") has been received and its contents carefully noted.

Office Action, pages 2-4

Claims 1-28 are rejected under 35 U.S.C. 101 as not directed to statutory subject matter.

a. Over generalization of the abstract idea

The Action is based on over generalization of the abstract idea and oversimplification of the recited claim functions and is untethered from the actual language of the claims. Alice framework, cautions that *"describing the claims at such a high level of abstraction and untethered from the language of the claims all but ensures that the exceptions to §101 swallow the rule."* Enfish, LLC v. Microsoft Corp., 822 F.3d 1327, 1337 (Fed. Cir. 2016).

It is noted that in the cited case of Int. Vent. V. Erie Indemnity the court determined that *"the claimed invention does not recite any particular unique delivery of information through this mobile interface."* (Slip op. at 24). In contrast, the claimed invention clearly defines a unique information delivery structure that involves not only content delivery, but also exchange of various identifiers of networked devices.

b. Generic elements.

The rejection is based on '*generic computer*' and '*generic computer components*'. First, even if the claimed invention uses *"generic computer, network, and Internet components, none of which is inventive by itself,"* the *"inventive concept can be found in the non-conventional and non-generic arrangement of*

known, conventional pieces." Bascom, 827 F.3d 1350, thus even if claim 1 may be implemented in software and potentially generic computer components (e.g., processor) does not doom the invention to abstraction. So characterized, claim 1 is sufficiently concrete and non-abstract.

It is noted that in the cited case of *Int. Vent. V. Erie Indemnity* the court determined that *"the claimed invention does not recite any particular unique delivery of information through this mobile interface."* Slip op. at 24. In contrast, the claimed invention clearly defines a unique information delivery structure that involves not only content delivery, but also exchange of various identifiers of networked devices.

c. The claims improve another technology or technical field.

In the rejection of claim 1 under §103, the Action admits that the claimed invention provides *"... an improvement for an information/communication exchange via a network"*. **Hence, the Action itself admits to various improvements in various technologies and fields.**

Here, independent claim 1 addresses a problem rooted in the technology itself, i.e., the need to improve content fetching by mapping content locations. (see also *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014) (patentable subject matter where claim addresses problem rooted in computer technology).

Further, in a similar technology, it is respectfully submitted that in a decision of Appeal 2017-010768 dated May 4, 2018 (from application 14/288,506), claims were similarly found to be patent eligible being *"directed to a technical improvement in the communication between computers"*. Similarly, in a decision of Appeal 2017-007566 dated May 17, 2018 (from application 14/268,145), claims were similarly found to be

patent eligible since they *'facilitates the cooperation of "multiple different kind of computers."'*, and using intermediate computers.

In another similar case, claims as a whole are directed to a computer solution of accelerating transaction execution using one data structure (i.e., a multidimensional data cube) to perform certain functions/results and another, different data structure (i.e., a relational database) to achieve other functions/results. Considering the claims in light the Specification, the disclosure bolsters that claims as a whole are directed to improving an existing, technological process of enterprise software implemented on a computer system (Appeal 2017-002623).

d. No support for "well understood, routine, conventional and known ...".

The Federal Circuit drew a distinction between what is well-understood, routine, conventional, and what is simply known in the prior art, cautioning that the mere fact that something is disclosed in a piece of prior art does not mean it was a well-understood, routine, conventional activity or element. See *Berkheimer v. HP Inc.*, 881 F.3d 1369 (Fed. Cir. 2018). Further, as set forth in MPEP § 2106.05(d)(I), an examiner should conclude that an element (or combination of elements) represents well-understood, routine, conventional activity **only when the examiner can readily conclude that the element(s) is widely prevalent or in common use in the relevant industry**. See MPEP § 2106.05. As the Federal Circuit explained: *"[w]hether a particular technology is well-understood, routine, and conventional goes beyond what was simply known in the prior art. The mere fact that something is disclosed in a piece of*

prior art, for example, does not mean it was well-understood, routine, and conventional." Berkheimer, 881 F.3d at 1369.

Office Action, pages 4-15

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 Kageyama *et al.* (US 2003/0097408 - "Kageyama").

Regarding Claim 1

a. The last limitation step of "*sending the received first content ... to the first client device*" is equated in the Action to the Yu reference described receiving the requested content by the peer node 403 from the web server. However, the claimed steps are performed by the first server that is distinct from the web server that is the second server.

b. The last limitation step recites "*sending the received first content ... to the first client device*" - Hence referring to the former step of receiving the content by the first server. Yu is silent regarding the equated web server receiving any content in general, and sending any received content in particular.

c. The Action does not explain WHY the Yu and Kageyama 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 Kageyama invention is focused on terminals communicating ONLY via server.

d. The rationale for combining with the Yu and Kageyama 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).

e. 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 Kageyama 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.

f. 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.

g. The Action relies upon the Kageyama reference for the steps of sending of the first content identifier and receiving in response the first content. However, the Kageyama in general, and the cited paragraphs in particular, does NOT disclose any content delivery of the content itself but only metadata relating to the content.

Regarding Claims 6 and 13

Claim 6 (and 13) recites selection of client devices by the first server. In contrast, 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 Claims 9-12

While the Yu reference may teach in the cited paragraphs 0023 and 0038 that the peer device notify the server upon going online and upon exiting the network, the Yu reference is general, and the cited paragraphs in particular, are silent regarding any messaging in-between the entering and exiting events, silent about list maintenance messages initiated by the server, and further silent regarding any status messages, such as 'keep alive' between the server and the peers.

Regarding Claims 16-19

The rejection of the added limitations of claims 16-19 is based on newly introduced passages in the Kageyama reference, however no rationale is provided for modifying the Yu reference with these limitations. Further, it is noted that these claims depend from claim 13 and further defines the 'selecting', where the rejection is based on the Yu reference for this feature. Furthermore, it is noted that the rejection is based on the Kageyama 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 19

While the Yu reference may mention by passing using TCP, it is silent regarding any TCP connection as recited in the claim.

Regarding Claims 22-23

While the cited paragraphs 0066-0067 disclose various metadata information relating to the content itself, these paragraphs are silent regarding any server information in general, and application version in particular, as recited in the claims.

Further, the rejection of the added limitations of claims 22-23 is based on newly introduced passages in the Kageyama reference, however no rationale is provided for modifying the Yu reference with these limitations. Furthermore, it is noted that the rejection is based on the Kageyama 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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