Doc Code: AP.PRE.REQ

USED IN LIEU OF PTO/SB/33 (07-09)

PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) 42327-501001US	
	Application Number 10/606,729	Filed June 26, 2003
	First Named Inventor Philip Donian et al.	
	Art Unit 3622	Examiner Y. Retta

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant /inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [x] attorney or agent of record. Registration number 52,315.
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

/mdvl/
Signature

Michael D. Van Loy
Typed or printed name

(858) 314-1559
Telephone number

April 4, 2017
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [ ] *Total of 1 forms are submitted.

Hulu, LLC - Ex. 1006, Page 000646

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: Philip M. Donian, *et al.*
Application No.: 10/606,729 Confirmation No.: 5831
Filed: June 26, 2003 Art Unit: 3622
For: METHOD AND APPARATUS FOR THE FREE LICENSING OF DIGITAL MEDIA CONTENT Examiner: Yehdega Retta

PRE-APPEAL BRIEF REQUEST FOR REVIEW

This Brief in Support of the Pre-Appeal Request for Review and Notice of Appeal filed concurrently herewith pertains to the rejections presented in the Final Office Action mailed October 12, 2016 ("the current Office Action"). Claims 212, 214-223, and 225-273 are pending in the application, with all claims rejected under 35 U.S.C. §112, first paragraph as allegedly failing to comply with the written description requirement, under 35 U.S.C. §101 as allegedly being directed to patent ineligible subject matter, and under 35 U.S.C. 103(a) as allegedly being unpatentably obvious over US2001/0042249 by Knepper *et al.* ("Knepper") in view of US7,761,327 to Hannah *et al.* and US2002/019150 by Wang. Applicants respectfully request withdrawal of these rejections – all represent clear error on the part of the Examiner. The undersigned discussed these issues with the Examiner during an Interview on November 8, 2016 ("the Interview"), and although she agreed to consult with her colleagues and to follow up with the undersigned, she has not provided further feedback.

A. Regarding the rejections under 35 U.S.C. §112, first paragraph: one of ordinary skill in the art would readily understand that the specification teaches the objected-to claim features.

The rejections of the independent claims under 35 U.S.C. §112, first paragraph are based on the Examiner's incorrect assertion that the original specification fails to provide the necessary written description support for the claim feature relating to "at least one of the alternatively sequenced insertion points being different from the one or more initially sequenced insertion points," which was added by amendment in the Response filed August 1, 2016 ("the previous Response"). As a first point, the allegedly unsupported features were first added to the claims in the paper filed October 28, 2015, albeit in slightly different form, to address a rejection under 35 U.S.C. §112, first paragraph raised in the Final Office Action mailed May 1, 2014. The Examiner withdrew the rejection in the Non-Final Office Action mailed February 1, 2016, but now has repeated it for reasons the Applicant does not understand.

Furthermore, the Examiner has clearly failed to apply the proper standard for a rejection under 35 U.S.C. §112, first paragraph. As stated in MPEP §2163.02: the objective standard for determining compliance with the written description requirement is, "does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed."[1] To satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed. If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met.[2] Furthermore,

[1] See, *e.g. In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Under *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).
[2] See, *e.g.*, *Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d at 1116; and *Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972) (stating "the description need not be *in ipsis verbis* [i.e., "in the same words"] to be sufficient").

as stated in MPEP §2163.07, "mere rephrasing of a passage does not constitute new matter," and "a rewording of a passage where the same meaning remains intact is permissible."[3]

In contrast to these requirements for making a proper rejection for alleged lack of written description support, the Office Action merely states that "Examiner could not find a support for the … claimed language." As discussed during the Interview, the Examiner appears to have merely searched the specification for explicit textual support without properly determining what a skilled artisan would have understood the inventors to have been in possession of at the time of filing. Had the Examiner performed the proper analysis, she would have readily noted that the claim feature at issue in this rejection is well-supported at least by ¶0149-¶0150, and also at ¶0154-¶0156, referring to FIG. 4A.

In ¶0149, the instant specification describes a situation in which "the user of sequence 402 jumps right into segment 434 as segment 430 is just starting" in which case "the player/viewer will begin segment 434 at its point of entry, followed at its end by ad block 412." In this case, the digital advertising content plays at "one of the one or more initial insertion points." In contrast, in ¶0150, "the user has watched 80% of segment 432, and then jumps into the middle of segment 434," which results in "ad block 410 play[ing] immediately, and when it is finished, content play resum[ing] at the point selected in segment 434." In the scenario described in ¶0150, ad block 410 is played at a point immediately preceding "the middle of segment 434," which is an "alternate insertion point" that is clearly "different than the one or more initially sequenced insertion points relative to the digital media content within the user-perceptible content stream," which would, in this example, be those insertion points originally scheduled to occur between the segments.

At ¶0154-¶0156, the instant specification provides further support for the claim feature at issue, this time in reference to an example (illustrated as sequence 404 in FIG. 4A) of a "track allowance method for ad placement." ¶0154 states that in "regular play without skipping around or other navigation, sequence 404 begins by playing tracks 440, 442, 444, 446, and 448 in series, followed by ad block 414, and then tracks 450, 452, 454, and 456" and that ad block 416 comes after track 456, "followed by tracks 458, 460, and 462." In ¶0156, "[i]f the user decides to play track 446 and then track 456, the program does not insert ad block 416 immediately after track 456. Instead, play goes directly into track 458, because the allowance is 5 tracks. If the user plays through most of track 458, then jumps to the beginning of track 442 and plays it, there is still allowance for one more track after that, since only four tracks (446, 456, 458, and 442) have played so far." In other words, ad blocks 414 and 416 are initially sequenced after tracks 448 and 456, respectively, but in response to user "skipping around or other navigation," ad block insertions wind up at different positions relative to those tracks to comply with pre-defined placement rules (which in this example are track count rules).

One of ordinary skill in the art would clearly understand that the movement of an ad block insertion location originally scheduled to follow track 448 and precede track 450 but instead being played at a different location that was not an initially scheduled insertion point provides clear support sufficient to satisfy the requirements of 35 U.S.C. §112, first paragraph. For at least these reasons, these rejections should be withdrawn.

B. The rejections under 35 U.S.C. §103(a) also represent clear error – the features of the current subject matter are not all described or suggested by the cited references

[3] See, *e.g. In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973).

As discussed with the Examiner during the Interview, the statement of the rejections under 35 USC §103 reflects clear error, at least because a) it ignores explicit limitations of the claims and b) the cited references clearly do not describe or suggest all of the features of the independent claims.

As a first point, the Examiner has explicitly acknowledged on the record (see the Final Office Action mailed May 1, 2014 at page 15) that Knepper does not teach "at least one of the advertisement files is presented in a different position relative to the media files." The specific wording of this limitation has been slightly modified relative to what was pending at the time of this Final Office Action to make it abundantly clear what is being claimed. Despite Applicant's repeated attempts to clarify the claimed subject matter, the Examiner continues to muddle the issue, specifically with her statement of the reasons for rejection on page 8 of the current Office Action, where she alleges that "[s]ame as applicant's disclosure, the advertisement and the media of Knepper which were sequenced to be played in a predefined order, when the user skips or forwards to a different music (e.g. to a third media in the sequence after playing the first media in the sequence), the ad appended to the media (third media) would also be played as a second in the sequence (the media and ad combination) instead of the ad appended to the second media in the sequence (playlist)." The rationale for this incorrect assertion relies on a re-statement of how a Knepper presentation clip page is constructed (citing ¶0062 as it relates to FIG. 7) and an alleged equality with descriptions in the instant specification. However, as discussed further below, the Knepper description directly contradicts the claimed subject matter, particularly the claim features in which an alternate insertion point (that differs from any initial insertion point) relative to digital media is used in response to user input that causes the adaptively modifying as claimed. Furthermore, the cited ¶0062 and FIG. 7 of Knepper clearly relate to initial set-up of the entertainment files and advertising files and make no reference whatsoever to "skipping." The Examiner appears to have constructed this part of the statement of rejection without proper basis in any of the prior art.

Further to the above, and as explained in great detail in the previous Response, Knepper allows a user to navigate between the "pages" of a magazine, for example as described at ¶0052. A page includes an entertainment file and a position at which an advertisement file is to be presented. Assuming *arguendo* that user navigation in the Knepper approach can change the order in which pages are presented, which in turn may result in the entertainment files and the associated advertising file locations for a given page to be presented in a different overall order, the locations at which advertising files are presented is nonetheless always fixed with respect to the associated entertainment file for a given page, at least because the navigation in Knepper occurs page by page, and because each page defines a fixed and unchangeable relationship between the entertainment file and a location for an advertising file. For example, if a user could navigate from a first page of a Knepper magazine to a fourth page, any initially defined advertising file location on the first page and the fourth page would remain the same relative to the entertainment files on those first and fourth pages both before and after the navigation. Advertising files in Knepper are always positioned at one of the advertising file locations originally defined for the pages in the magazine.

Claim 243 (and also claims 267 and 268, which differ in scope but include similar language) explicitly requires "the modified user-perceptible content stream comprising an alternate insertion position of the advertising block relative to the media section, the alternate insertion position differing from the initially defined insertion position and not having digital advertising content scheduled to be

presented in it in the user-perceptible content stream prior to the adaptively re-sequencing" (emphasis added). Claim 212 (and also claims 238 and 271, which differ in scope but include similar language) states a related limitation worded slightly differently, and is likewise clearly not compatible with any reasonable interpretation of Knepper. Specifically, the modified user-perceptible content stream of claim 243 includes an alternate insertion position of a specific advertising block relative to a specific media section, where the alternate insertion position differs from the initially defined insertion position and does not have digital advertising content scheduled to be presented in it in the user-perceptible content stream prior to the adaptively re-sequencing. Knepper neither describes nor suggests such an approach – as noted above, a given advertising location on a page is explicitly fixed relative to the entertainment file location on that page. While a page may be viewed in a different order relative to other pages in the magazine, the relationship between the advertising file location on a page and the entertainment file on that page stays constant throughout any type of user navigation, and digital advertising content is always presented in one of these positions on a page. There is no allowance in Knepper for presenting an advertising file in a location relative to an entertainment file that is not also present in the original sequence. Furthermore, FIG. 4 of Knepper expressly states that "no user intervention" is permitted with regards to the page structure itself. These teachings of Knepper, which were discussed in detail in the previous Response and at several other points during the lengthy prosecution of this matter, directly contradict the example of the claimed subject matter (see, e.g., description above relating to the written description rejections).

The current Office Action fails to even explicitly allege that the features of claims 212 (and 238 and 271) and 243 (and 267 and 268) discussed above are described or suggested in the prior art. For example, the statement of rejection appearing at pages 7 to 9 of the Office Action makes no reference to such features but rather recycles text that has appeared in previous rejections of claims that did not have these features recited as they are currently presented. Additionally, the statement of rejection beginning on page 7 of the current office action does not acknowledge any difference in the claim language between claims 212 and 243, which is another indication of clear error. Furthermore, in the Response to Arguments section (see end of page 16 and top of page 17), the Examiner expressly attempts to rebut Applicant's arguments for non-obviousness by alleging that these elements need not be considered because "applicant's specification does not provide support for such claim language." Beyond being an admission that the features are not addressed in the statement of the rejections under 35 U.S.C. §103(a), this statement is also, on its face, a clear violation of the principles of compact prosecution.[4] The Examiner has committed clear error by failing to consider the Applicant's argument with regard to an explicit claim feature with the excuse of an errant (as discussed above in relation to the rejections under 35 U.S.C. §112, first paragraph) allegation of lack of written description support.

Finally, the Examiner's citation of *In re Keller* (see page 17 of the current Office Action) is nonsensical. The holding in that case certainly does not preclude a rebuttal of an obviousness rejection by explaining how the primary reference does not teach features alleged by the Examiner, particularly when the cited secondary references are neither asserted to nor reasonably interpretable as remedying

[4] See MPEP §2103, which states that "each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement."

the identified deficiencies in the primary reference. For avoidance of doubt, Knepper does not describe or suggest the above-noted features, and none of the other cited references, whether considered alone or in any combination, are sufficient to establish proper grounds for a rejection under 35 U.S.C. §103(a).

For at least the above-stated reasons, reversal of these rejections is respectfully requested.

C. The rejections under 35 U.S.C. §101 also reflects clear error, as the proper analysis does not appear to be applied, and because the claims recite "significantly more" even assuming *arguendo* that they are directed to an abstract idea.

As noted previously, and in great detail, in this matter by the Applicant, the position taken by the Examiner in regards to patent eligibility of the claimed subject matter amounts to clear error, and a failure to properly consider the explicit guidance of the Court of Appeals for the Federal Circuit, the Patent and Trademark Appeals Board, and the series of Examiner guidance memorandums published by the USPTO itself (most recently in November 2016). During the Interview, the Examiner indicated that she had no knowledge of the USPTO Examiner Guidance of November 2, 2016 ("the Guidance").

That Memorandum explicitly bars reliance on a non-precedential decision in formulating a rejection under 35 U.S.C. §101. In this matter, the Examiner has relied upon two such decisions (*Smartgene* and *Cyberfone*) while merely listing a number of other decisions with no provided analysis.

The Examiner's allegation on page 15 of the Office Action that no "problem particular to computer networks and/or the Internet or 'solution to a problem in the software arts'" similar to the claims at issue in *Enfish* is unfounded. The current subject matter clearly addresses a problem relating to control of insertion of advertising in digital media in manner that allows monetization of such media while also permitting a user to navigate or make other modifications to the playback of such media. The finding of an abstract idea at Step 2A of the *Alice/Mayo* analysis is therefore clearly in error.

Furthermore, the Examiner has completely ignored the arguments presented in the prior response with regards to *Bascom*. While the statement of the rejection under 35 U.S.C. §101 cursorily mentions the requirement to consider whether the elements of the claims amount to an ordered combination that provides "significantly more" than the alleged abstract idea, this statement appears to be nothing but lip service. The Examiner merely conclusorily states that "the computer components add nothing that is not already present when the steps are considered separately." This statement reflects both a misstatement of the proper analysis required (see the Guidance at page 3) and a failure to provide any information as to the reasoning applied in reaching the conclusion stated.

The rejections under 35 U.S.C. §101 should be withdrawn at least for these reasons.

D. Conclusion.

The required fee for a Notice of Appeal has been previously paid in this matter. The Commissioner is authorized to charge any additional fees that may be due, or credit any overpayment of same, to Deposit Account No. 50-0311, Reference No. 43237-501001US. Because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper.

Dated: April 4, 2017

Respectfully submitted,

/mdvl/

Michael D. Van Loy, Reg. No.: 52,315

Doc Code: MES.GIB
Document Description: Certification of Micro Entity Status (Gross Income Basis)

PTO/SB/15A (07-14)

CERTIFICATION OF MICRO ENTITY STATUS
(GROSS INCOME BASIS)

Application Number or Control Number (if applicable):	Patent Number (if applicable):
10/606,729	
First Named Inventor:	**Title of Invention:**
Philip Donian	Method and apparatus for the Free Licensing of Digital Media Content

The applicant hereby certifies the following—

(1) **SMALL ENTITY REQUIREMENT –** The applicant qualifies as a small entity as defined in 37 CFR 1.27.

(2) **APPLICATION FILING LIMIT –** Neither the applicant nor the inventor nor a joint inventor has been named as the inventor or a joint inventor on more than four previously filed U.S. patent applications, excluding provisional applications and international applications under the Patent Cooperation Treaty (PCT) for which the basic national fee under 37 CFR 1.492(a) was not paid, and also excluding patent applications for which the applicant has assigned all ownership rights, or is obligated to assign all ownership rights, as a result of the applicant's previous employment.

(3) **GROSS INCOME LIMIT ON APPLICANTS AND INVENTORS –** Neither the applicant nor the inventor nor a joint inventor, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986 (26 U.S.C. 61(a)), exceeding the "Maximum Qualifying Gross Income" reported on the USPTO Web site at http://www.uspto.gov/patents/law/micro_entity.jsp which is equal to three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census.

(4) **GROSS INCOME LIMIT ON PARTIES WITH AN "OWNERSHIP INTEREST" –** Neither the applicant nor the inventor nor a joint inventor has assigned, granted, or conveyed, nor is under an obligation by contract or law to assign, grant, or convey, a license or other ownership interest in the application concerned to an entity that, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986, exceeding the "Maximum Qualifying Gross Income" reported on the USPTO Web site at http://www.uspto.gov/patents/law/micro_entity.jsp which is equal to three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census.

SIGNATURE by an authorized party set forth in 37 CFR 1.33(b)

Signature	/mdvl/				
Name	Michael D. Van Loy				
Date	April 4, 2017	Telephone	(858) 314-1559	Registration No.	52,315

☐ There is more than one inventor and I am one of the inventors who are jointly identified as the applicant. The required additional certification form(s) signed by the other joint inventor(s) are included with this form.

Electronic Patent Application Fee Transmittal

Application Number:	10606729
Filing Date:	26-Jun-2003
Title of Invention:	Method and apparatus for the free licensing of digital media content
First Named Inventor/Applicant Name:	Philip M. Donian
Filer:	Michael David VanLoy/Karen LePari
Attorney Docket Number:	42327-501001US

Filed as Micro Entity

Filing Fees for Utility under 35 USC 111(a)

Description	Fee Code	Quantity	Amount	Sub-Total in USD($)
Basic Filing:				
Pages:				
Claims:				
Miscellaneous-Filing:				
Petition:				
Patent-Appeals-and-Interference:				
Post-Allowance-and-Post-Issuance:				
Extension-of-Time:				

Description	Fee Code	Quantity	Amount	Sub-Total in USD($)
Extension - 3 months with $0 paid	3253	1	350	350
Miscellaneous:				
		Total in USD ($)		**350**

Electronic Acknowledgement Receipt	
EFS ID:	28833462
Application Number:	10606729
International Application Number:	
Confirmation Number:	5831
Title of Invention:	Method and apparatus for the free licensing of digital media content
First Named Inventor/Applicant Name:	Philip M. Donian
Customer Number:	64046
Filer:	Michael David VanLoy/Karen LePari
Filer Authorized By:	Michael David VanLoy
Attorney Docket Number:	42327-501001US
Receipt Date:	04-APR-2017
Filing Date:	26-JUN-2003
Time Stamp:	19:51:48
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	yes
Payment Type	DA
Payment was successfully received in RAM	$350
RAM confirmation Number	040517INTEFSW00005682500311
Deposit Account	500311
Authorized User	Michael VanLoy
The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows: 37 CFR 1.16 (National application filing, search, and examination fees) 37 CFR 1.17 (Patent application and reexamination processing fees)	

37 CFR 1.19 (Document supply fees)

37 CFR 1.20 (Post Issuance fees)

37 CFR 1.21 (Miscellaneous fees and charges)

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Notice of Appeal Filed	42327-501001US_NoticeOfAppeal_04APR2017.pdf	62333 f12e42f1c2deef1599da262725db94678a96aae8	no	1
Warnings:					
Information:					
2	Pre-Brief Conference request	42327-501001US_Pre-Apeal_Brief_Request_04APR2017.pdf	61461 fa2ea468b17782e977d4910f5000d1d1c7095ef7	no	1
Warnings:					
Information:					
3	Pre-Brief Conference request	42327-501001US_Pre-Appeal_Brief_04APR2017.pdf	136118 1a6b0945c46cde38c9b76737a876cec7667eb79e	no	5
Warnings:					
Information:					
4	Certification of Micro Entity (Gross Income Basis)	42327-501001US_CertificationOfMicroEntityStatus_04APR2017.pdf	99278 308f977ca90cbe61d6a4fe9bbb7dc635d5040ce8	no	1
Warnings:					
Information:					
5	Fee Worksheet (SB06)	fee-info.pdf	30239 b3230068df71d4563ead022c56763fa861d153b5	no	2
Warnings:					
Information:					
		Total Files Size (in bytes):	389429		

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

USED IN LIEU OF PTO/SB/31 (02-14)

NOTICE OF APPEAL FROM THE EXAMINER TO THE PATENT TRIAL AND APPEAL BOARD	Docket Number (Optional) 42327-501001US

In re Application of
Philip Donian et al.

Application Number	Filed
10/606,729	June 26, 2003

For Method and apparatus for the free licensing of digital media content

Art Unit	Examiner
3622	Y. Retta

Applicant hereby **appeals** to the Patent Trial and Appeal Board from the last decision of the examiner.

The fee for this Notice of Appeal is (37 CFR 41.20(b)(1)) $ 800.00

[X] Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is: ***no fee due – already paid July 2,** $ **200.00***

[ ] A check in the amount of the fee is enclosed.

[ ] Payment by credit card. Form PTO-2038 is attached.

[x] The Director is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-0311 .

[X] A petition for an extension of time under 37 CFR 1.136(a) (PTO/SB/22) is enclosed.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

I am the

[ ] applicant/inventor.

[ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

[x] attorney or agent of record.
Registration number 52,315 .

[ ] attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34. _____

/mdvl/
Signature

Michael D. Van Loy
Typed or printed name

(858) 314-1559
Telephone number

April 4, 2017
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

[ ] *Total of 1 forms are submitted.

Hulu, LLC - Ex. 1006, Page 000658

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,729	06/26/2003	Philip M. Donian	42327-501001US	5831

64046 7590 12/11/2017

Mintz Levin/San Diego Office
One Financial Center
Boston, MA 02111

EXAMINER	
RETTA, YEHDEGA	

ART UNIT	PAPER NUMBER
3688	

NOTIFICATION DATE	DELIVERY MODE
12/11/2017	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPDocketingBOS@mintz.com
IPFileroombos@mintz.com

Notice of Abandonment	Application No.	Applicant(s)
	10/606,729	Donian et al.
	Examiner	Art Unit
	YEHDEGA RETTA	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☑ Applicant's failure to timely file a proper reply to the Office letter mailed on 12 October 2016.
   (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
   (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 to the final rejection. (A proper reply under 37 CFR 1.113 to a final rejection consists only of:(1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) if this is utility or plant application, a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. Note that RCEs are not permitted in design applications.)
   (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
   (d) ☑ No reply has been received.

2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
   (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
   (b) ☐ The submitted fee of $ _____ is insufficient. A balance of $ _____ is due.
   The issue fee required by 37CFR 1.18 is $ _____ . The publication fee, if required by 37 CFR 1.18(d), is $ _____ .
   (c) ☐ The issue fee and publication fee, if applicable, has not been received.

3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
   (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
   (b) ☐ No corrected drawings have been received.

4. ☐ The letter of express abandonment which is signed by the attorney or agent of record or other party authorized under 37 CFR 1.33 (b). See 37 CFR 1.138(b).

5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34) upon the filing of a continuing application.

6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.

7. ☐ The reason(s) below:

_____

/YEHDEGA RETTA/
Primary Examiner, Art Unit 3688

Petitions to revive under 37 CFR 1.137, or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

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Application	Document	Mailroom Date	Attorney Docket No.
10606729	ABN	12/11/2017	42327-501001US

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In re Application of	:	
Donian, Philip M. et al.	:	**SUA SPONTE EXERCISE**
Application No.: 10/606,729	:	**OF**
Filed: June 26, 2003	:	**SUPERVISORY REVIEW**
Docket No. 42327-501001US	:	
For: Method and Apparatus for the Free	:	
Licensing of Digital Media Content	:	

A sua sponte review of the above-noted application file has been conducted. As a result, it has been determined that certain errors on the part of the Office have occurred. In particular, it has been determined that the holding of abandonment on December 11, 2017 was premature. The purpose of this communication is to correct this error and clarify the record.

A review of the file history reveals that a Final Office action was mailed on October 12, 2016. Subsequently, a Notice of Appeal was timely filed by the Applicant on April 4, 2017 along with a Pre-Brief Conference Request, and fees for a three-month extension of time. There were no communication or response in regards to the Pre-Brief Conference request by the office. Unfortunately, a Notice of Abandonment was prematurely mailed on December 11, 2017.

In view of the fact that the Applicant filed a timely Pre-Brief Conference request and there has not been any response to such request, the holding of abandonment on December 11, 2017 was improper and premature. Accordingly, the holding of abandonment mailed on December 11, 2017 is hereby **VACATED**.

A response to the Pre-Brief Conference request from the examiner will be forthcoming.

Any questions regarding this decision should be directed to Kambiz Abdi, Supervisory Patent Examiner, at (571) 272-6702.

Tariq Hafiz, Director
Technology Center 3600
(571) 272-5350

MB: 01/17/18

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,729	06/26/2003	Philip M. Donian	42327-501001US	5831

64046 7590 04/02/2018

Mintz Levin/San Diego Office
One Financial Center
Boston, MASSACHUSETTS 02111
UNITED STATES OF AMERICA

EXAMINER
RETTA, YEHDEGA

ART UNIT	PAPER NUMBER
3688	

NOTIFICATION DATE	DELIVERY MODE
04/02/2018	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Notice of Panel Decision from Pre-Appeal Brief Review

Application No.	Applicant(s)		
10/606,729	Donian et al.		
Examiner	**Art Unit**	**AIA Status**	
YEHDEGA RETTA	3622	No	

This is in response to the Pre-Appeal Brief Request for Review filed 19 March 2018 .

1. ☐ **Improper Request** - The Request is improper and a conference will not be held for the following reason(s):

☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
☐ The request does not include reasons why a review is appropriate.
☐ A proposed amendment is included with the Pre-Appeal Brief request.
☐ Other: _____ .

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☑ **Proceed to Board of Patent Appeals and Interferences** - A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

☑ The panel has determined the status of the claim(s) is as follows:
Claim(s) allowed: _____ .
Claim(s) objected to: _____ .
Claim(s) rejected: 212, 214-223 and 225-273 .
Claim(s) withdrawn from consideration: _____ .

3. ☐ **Allowable application** - A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. ☐ **Reopen Prosecution** - A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) YEHDEGA RETTA .	(3) Kambiz Abdi .
(2) Alexander Kalinowski .	(4) _____ .

/YEHDEGA RETTA/ Primary Examiner, Art Unit 3688	/ALEXANDER G KALINOWSKI/ Supervisory Patent Examiner, Art Unit 3691	/KAMBIZ ABDI/ Supervisory Patent Examiner, Art Unit 3688

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Application	Document	Mailroom Date	Attorney Docket No.
10606729	AP.PRE.DEC	04/02/2018	42327-501001US

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PATENT APPLICATION INFORMATION RETRIEVAL SYSTEM

Attorney's Docket No.: 42327-501001US
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Philip M. Donian, *et al.*

Application No.: 10/606,729 | Confirmation No.: 5831

Filed: June 26, 2003 | Art Unit: 3688

For: METHOD AND APPARATUS FOR THE FREE LICENSING OF DIGITAL MEDIA CONTENT | Examiner: Yehdega Retta

APPEAL BRIEF

FILED VIA EFS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir or Madam:

In response to the Final Office Action mailed October 12, 2016 (hereinafter "Office Action") and the Pre-Appeal Panel Decision (hereinafter "Panel Decision") mailed on April 2, 2018, Appellant respectfully submits the following remarks for consideration. A first Pre-Appeal Brief Request for Review and a first Notice of Appeal was timely filed on July 2, 2014 along with the appropriate fees. Prosecution of this application was re-opened in response to the Examiner's Answer to the Appeal Brief mailed on August 28, 2015. A second Pre-Appeal Brief Request for Review and a second Notice of Appeal was timely filed on April 4, 2017 relying on the fees paid along with the first Notice of Appeal on July 2, 2014. The Office did not properly address the second Pre-Appeal Brief Request for Review via a Pre-Appeal Conference. Instead, the Office incorrectly issued a notice of abandonment on December 11, 2017 despite never having considered the second Pre-Appeal Brief Request for Review. The notice of abandonment was withdrawn via a *Sua Sponte* Exercise of Supervisory Review on January 29, 2018 and the Panel Decision was finally issued on April 2, 2018. This Appeal Brief is timely filed along with a three-month extension of time and the associated fee.

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1. Knepper does not describe or suggest "at least one of the one or more alternatively sequenced insertion points being different than the one or more initially sequenced insertion points relative to the digital media content of" independent Claim 212 or the corresponding features of Claims 238, 243, 267, 268, and 271 21
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Hulu, LLC - Ex. 1006, Page 000667

I. REAL PARTY IN INTEREST

Piranha Media Distribution, Inc. is the real party in interest as the owner of the above-identified application by virtue of an assignment from the inventors.

Hulu, LLC - Ex. 1006, Page 000668

II. RELATED APPEALS AND INTERFERENCES

There are currently no other appeals or interferences, of which Appellant, Appellant's legal representative, or Assignee are aware, that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

Hulu, LLC - Ex. 1006, Page 000669

III. STATUS OF CLAIMS

In the Office Action, the Office rejected claims 212, 214-223 and 225-273 under 35 U.S.C. §112, first paragraph as allegedly failing to comply with the written description requirement; claims 212, 214-223 and 225-273 under 35 U.S.C. §101 as allegedly being drawn to non-statutory subject matter; and claims 212, 214-223, 225-232, 234-249, 251-255 and 257-273 under 35 U.S.C. §103(a) as allegedly being unpatentably obvious over Knepper et al., Patent Application Publication No. 2001/0042249 ("Knepper") in view of Hannah et al., U.S. Patent No. 7,761,327 ("Hannah") and further in view of Wang, Patent Application Publication No. 2002/0191950 ("Wang").

Appellant appeals the final rejections of independent Claims 212, 238, 243, 267, 268, and 271. All of the remaining, pending dependent claims depend at least indirectly from one of Claims 212, 238, 243, 267, 268, and 271, and are therefore patentable subject to the outcome of this appeal.

IV. SUMMARY OF CLAIMED SUBJECT MATTER

In accordance with 37 C.F.R. § 41.37(c)(1)(iii), Appellant provides a brief summary of each independent claim involved in the appeal. Each summary refers to the specification in the record by page and line number and to the drawings by reference number. Appellant notes that this summary is provided only to assist the Board in identifying portions of the specification related to the particular claims. In the interest of brevity, each claim summary does not necessarily include all references to all relevant portions of the specifications and drawings. Accordingly, omission of any reference to the specification or to the drawings should not be construed in any way as an intent to relinquish claim scope or term, or as an implication or statement regarding conformance with 35 U.S.C. §112. Appellant respectfully submits that the claims should not be construed as being limited to the embodiments described or referenced in any claim summary, and that other embodiments, as well as the Doctrine of Equivalents, may apply in determining claim scope.

A. Independent Claim 212.

Claim 212 is a method claim including receiving, on a client system, data comprising digital media content and digital advertising content (*see e.g.*, specification pg. 9, lines 28-30; pg. 10, lines 1-2, and 29-31; pg. 11, lines 1-4; pg. 20, lines 30-31; pg. 21, lines 1-21; pg. 25, lines 27-30; pg. 26, lines 1-2, and 26-30; FIGs. 1, 2, 4A, 4B, 11C). The method further includes sequencing the digital media content and the digital advertising content (*see e.g.*, specification pg. 25, lines 27-30; pg. 26, lines 1-2, and 26-30; pg. 27, lines 1-2, and 11-21; FIG. 4A, 4B), the sequencing comprising ordering at least some of the digital media content and at least some of the digital advertising content into a user-perceptible content stream, (*see e.g.*, specification pg. 20, lines 30-31; pg. 21, lines 1-21; pg. 27, lines 11-21; pg. 32, lines 21-29; FIG. 4A, 4B) the user-perceptible content stream comprising one or more initially sequenced insertion points at which the digital advertising content is scheduled to be presented relative to the digital media content (*see e.g.*, specification pg. 21, lines 1-21; pg. 28, lines 1-31; pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; FIG. 4A, 4B.). The method further includes adaptively modifying, using pre-defined rules and in response to a user input detected by the client system, (*see e.g.*, specification pg. 29, lines 17-22; pg. 33, lines 13-21; pg. 39, lines 9-14; pg. 40, lines 1-6; pg. 42, lines 22-31, pg. 43, lines 1-30, pg. 44, lines 1-31, pg. 45, lines 1-31, pg. 46, lines 1-30, pg. 47, lines 1-16; pg. 49, lines

1-6, and 19-27; pg. 50, lines 10-15) a presentation position of the digital advertising content from at least one of the one or more initially sequenced insertion points to one or more alternatively sequenced insertion points, at least one of the one or more alternatively sequenced insertion points being different than the one or more initially sequenced insertion points relative to the digital media content within the user-perceptible content stream (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The method further includes causing presentation of the user-perceptible content stream at the client system after the adaptively modifying (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The method further includes keeping a setting in a first memory to indicate a current state of play, the setting including a value to indicate whether presentation of a required part of the digital advertising content is in progress during presentation of the user-perceptible content stream (*see e.g.*, specification, pg. 32, lines 1-31; pg. 33, lines 1 – 31; pg. 34, lines 1-20; pg. 40, lines 1-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 53, lines 7-27; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The method further includes disallowing a navigation choice that alters a course of playback of the user-perceptible content stream while presentation of the required part of the digital advertising content is in progress (*see e.g.*, specification, pg. 34, lines 1-20; pg. 48, lines 20-30; pg. 49, lines 1-6; FIGs. 4A, 5A, 7A, 7B). The method further includes storing, in a second memory, presentation data comprising an indication of the digital advertising content that has been presented (*see e.g.*, specification, pg. 11, lines 1-4; pg. 16, lines 4 – 12; pg. 34, lines 1-20; pg. 40, lines 1-31, pg. 41, lines 1-31; pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D), wherein the receiving, the sequencing, the adaptively modifying, the causing, the keeping, the disallowing, and the storing are performed by one or more programmable processors (*see e.g.*, specification, pg. 17, lines 20-26; pg. 32, lines 12-15; FIG. 2).

B. Independent Claim 238.

Claim 238 is a method including transmitting, by at least one remote system to a client system, data comprising digital media content and digital advertising content (*see e.g.*, specification pg. 9, lines 28-30; pg. 10, lines 1-2, and 29-31; pg. 11, lines 1-4; pg. 20, lines 30-31; pg. 21, lines 1-21; pg. 25, lines 27-30; pg. 26, lines 1-2, and 26-30; FIGs. 1, 2, 4A, 4B, 11C). The method further includes sequencing the digital media content and the digital advertising content (*see e.g.*, specification pg. 25, lines 27-30; pg. 26, lines 1-2, and 26-30; pg. 27, lines 1-2, and 11-21; FIG. 4A, 4B), the sequencing comprising ordering at least some of the digital media content and at least some of the digital advertising content into a user-perceptible content stream, (*see e.g.*, specification pg. 20, lines 30-31; pg. 21, lines 1-21; pg. 27, lines 11-21; pg. 32, lines 21-29; FIG. 4A, 4B) the user-perceptible content stream comprising one or more initially sequenced insertion points at which the digital advertising content is scheduled to be presented relative to the digital media content (*see e.g.*, specification pg. 21, lines 1-21; pg. 28, lines 1-31; pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; FIG. 4A, 4B). The method further includes adaptively modifying, using pre-defined rules and in response to a user input detected by the client system, (*see e.g.*, specification pg. 29, lines 17-22; pg. 33, lines 13-21; pg. 39, lines 9-14; pg. 40, lines 1-6; pg. 42, lines 22-31, pg. 43, lines 1-30, pg. 44, lines 1-31, pg. 45, lines 1-31, pg. 46, lines 1-30, pg. 47, lines 1-16; pg. 49, lines 1-6, and 19-27; pg. 50, lines 10-15; FIG. 4A, 4B) a presentation position of the digital advertising content from at least one of the one or more initially sequenced insertion points to one or more alternatively sequenced insertion points, at least one of the one or more alternatively sequenced insertion points being different than the one or more initially sequenced insertion points relative to the digital media content within the user-perceptible content stream (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The method further includes causing presentation of the user-perceptible content stream at the client system after the adaptively modifying (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The method further includes keeping a setting in a first memory to indicate a current state of play, the setting including a value to indicate whether

presentation of a required part of the digital advertising content is in progress during presentation of the user-perceptible content stream (*see e.g.*, specification, pg. 32, lines 1-31; pg. 33, lines 1 – 31; pg. 34, lines 1-20; pg. 40, lines 1-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 53, lines 7-27; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The method further includes disallowing a navigation choice that alters a course of playback of the user-perceptible content stream while presentation of the required part of the digital advertising content is in progress (*see e.g.*, specification, pg. 34, lines 1-20; pg. 48, lines 20-30; pg. 49, lines 1-6; FIGs. 4A, 5A, 7A, 7B). The method further includes storing, in a second memory, presentation data comprising an indication of the digital advertising content that has been presented (*see e.g.*, specification, pg. 11, lines 1-4; pg. 16, lines 4 – 12; pg. 34, lines 1-20; pg. 40, lines 1-31, pg. 41, lines 1-31; pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D), wherein the receiving, the sequencing, the adaptively modifying, the causing, the keeping, the disallowing, and the storing are performed by one or more programmable processors (*see e.g.*, specification, pg. 17, lines 20-26; pg. 32, lines 12-15; FIG. 2).

C. Independent Claim 243.

Claim 243 is directed to a method including receiving, on a client system, data comprising digital media content and digital advertising content (*see e.g.*, specification pg. 9, lines 28-30; pg. 10, lines 1-2, and 29-31; pg. 11, lines 1-4; pg. 20, lines 30-31; pg. 21, lines 1-21; pg. 25, lines 27-30; pg. 26, lines 1-2, and 26-30; FIGs. 1, 2, 4A, 4B, 11C). The method further includes sequencing the digital media content (*see e.g.*, specification pg. 25, lines 27-30; pg. 26, lines 1-2, and 26-30; pg. 27, lines 1-2, and 11-21; FIG. 4A, 4B), the sequencing comprising ordering the digital media content into a user-perceptible content stream comprising a media section that comprises at least some of the digital media content, the user perceptible content stream further comprising an advertising block within which at least some of the digital advertising content is scheduled to be presented (*see e.g.*, specification pg. 25, lines 27-30; pg. 26, lines 1-2, and 26-30; pg. 27, lines 1-2, and 11-21; FIG. 4A, 4B), the advertising block being arranged within the user-perceptible content stream at an initially defined insertion position relative to the media section (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54,

lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The method further includes adaptively re-sequencing the user-perceptible content stream into a modified user-perceptible content stream to reflect a user input detected at the client machine (*see e.g.*, specification pg. 29, lines 17-22; pg. 33, lines 13-21; pg. 39, lines 9-14; pg. 40, lines 1-6; pg. 42, lines 22-31, pg. 43, lines 1-30, pg. 44, lines 1-31, pg. 45, lines 1-31, pg. 46, lines 1-30, pg. 47, lines 1-16; pg. 49, lines 1-6, and 19-27; pg. 50, lines 10-15; FIG. 4A, 4B), the modified user-perceptible content stream comprising an alternate insertion position of the advertising block relative to the media section, the alternate insertion position differing from the initially defined insertion position and not having digital advertising content scheduled to be presented in it in the user-perceptible content stream prior to the adaptively re-sequencing (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D), the adaptively re-sequencing comprising determining the alternate insertion position using one or more pre-defined placement rules associated with the digital media content (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The method further includes causing presentation of the modified user-perceptible content stream at the client system (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The method further includes keeping a setting in a first memory to indicate a current state of play, the setting including a value to indicate whether presentation of a required part of the digital advertising content is in progress during presentation of the modified user-perceptible content stream (*see e.g.*, specification, pg. 32, lines 1-31; pg. 33, lines 1 – 31; pg. 34, lines 1-20; pg. 40, lines 1-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 53, lines 7-27; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The method further includes disallowing a navigation choice that alters a course of playback of the modified user-perceptible content stream while presentation of the required part of the digital advertising content is in

progress (*see e.g.*, specification, pg. 34, lines 1-20; pg. 48, lines 20-30; pg. 49, lines 1-6; FIGs. 4A, 5A, 7A, 7B). The method further includes storing, in a second memory, presentation data comprising an indication of the digital advertising content that has been presented (*see e.g.*, specification, pg. 11, lines 1-4; pg. 16, lines 4 – 12; pg. 34, lines 1-20; pg. 40, lines 1-31, pg. 41, lines 1-31; pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D), wherein the receiving, the sequencing, the adaptively re-sequencing, the causing, the keeping, the disallowing, and the storing are performed by one or more programmable processors (*see e.g.*, specification, pg. 17, lines 20-26; pg. 32, lines 12-15; FIG. 2).

D. Independent Claim 267.

Claim 267 is directed to a method including transmitting, by at least one remote system to a client system, data comprising digital media content and digital advertising content (*see e.g.*, specification pg. 9, lines 28-30; pg. 10, lines 1-2, and 29-31; pg. 11, lines 1-4; pg. 20, lines 30-31; pg. 21, lines 1-21; pg. 25, lines 27-30; pg. 26, lines 1-2, and 26-30; FIGs. 1, 2, 4A, 4B, 11C). The method further includes sequencing the digital media content (*see e.g.*, specification pg. 25, lines 27-30; pg. 26, lines 1-2, and 26-30; pg. 27, lines 1-2, and 11-21; FIG. 4A, 4B), the sequencing comprising ordering the digital media content into a user-perceptible content stream comprising a media section that comprises at least some of the digital media content, the user perceptible content stream further comprising an advertising block within which at least some of the digital advertising content is scheduled to be presented (*see e.g.*, specification pg. 25, lines 27-30; pg. 26, lines 1-2, and 26-30; pg. 27, lines 1-2, and 11-21; FIG. 4A, 4B), the advertising block being arranged within the user-perceptible content stream at an initially defined insertion position relative to the media section (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The method further includes adaptively re-sequencing the user-perceptible content stream into a modified user-perceptible content stream to reflect a user input detected at the client machine (*see e.g.*, specification pg. 29, lines 17-22; pg. 33, lines 13-21; pg. 39, lines 9-14; pg. 40, lines 1-6; pg. 42, lines 22-31, pg. 43, lines 1-30, pg. 44, lines 1-31, pg. 45, lines 1-31, pg. 46, lines 1-30, pg. 47, lines 1-16; pg. 49, lines 1-6, and 19-27; pg. 50, lines 10-15; FIG. 4A, 4B), the modified user-perceptible content stream

comprising an alternate insertion position of the advertising block relative to the media section, the alternate insertion position differing from the initially defined insertion position and not having digital advertising content scheduled to be presented in it in the user-perceptible content stream prior to the adaptively re-sequencing (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D), the adaptively re-sequencing comprising determining the alternate insertion position using one or more pre-defined placement rules associated with the digital media content (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The method further includes causing presentation of the modified user-perceptible content stream at the client system (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The method further includes keeping a setting in a first memory to indicate a current state of play, the setting including a value to indicate whether presentation of a required part of the digital advertising content is in progress during presentation of the modified user-perceptible content stream (*see e.g.*, specification, pg. 32, lines 1-31; pg. 33, lines 1 – 31; pg. 34, lines 1-20; pg. 40, lines 1-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 53, lines 7-27; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The method further includes disallowing a navigation choice that alters a course of playback of the modified user-perceptible content stream while presentation of the required part of the digital advertising content is in progress (*see e.g.*, specification, pg. 34, lines 1-20; pg. 48, lines 20-30; pg. 49, lines 1-6; FIGs. 4A, 5A, 7A, 7B). The method further includes storing, in a second memory, presentation data comprising an indication of the digital advertising content that has been presented (*see e.g.*, specification, pg. 11, lines 1-4; pg. 16, lines 4 – 12; pg. 34, lines 1-20; pg. 40, lines 1-31, pg. 41, lines 1-31; pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D), wherein the transmitting, the sequencing, the adaptively re-sequencing, the causing, the keeping, the

disallowing, and the storing are performed by one or more programmable processors (*see e.g.*, specification, pg. 17, lines 20-26; pg. 32, lines 12-15; FIG. 2).

E. Independent Claim 268.

Claim 268 is directed to a system. The system including means for causing data comprising digital media content and digital advertising content to be available on a client system (*see e.g.*, specification pg. 9, lines 28-30; pg. 10, lines 1-2, and 29-31; pg. 11, lines 1-4; pg. 20, lines 30-31; pg. 21, lines 1-21; pg. 25, lines 27-30; pg. 26, lines 1-2, and 26-30; FIGs. 1, 2, 4A, 4B, 11C). The system further includes means for sequencing the digital media content (*see e.g.*, specification pg. 25, lines 27-30; pg. 26, lines 1-2, and 26-30; pg. 27, lines 1-2, and 11-21; FIG. 4A, 4B), the sequencing comprising ordering the digital media content into a user-perceptible content stream comprising a media section that comprises at least some of the digital media content, the user perceptible content stream further comprising an advertising block within which at least some of the digital advertising content is scheduled to be presented (*see e.g.*, specification pg. 25, lines 27-30; pg. 26, lines 1-2, and 26-30; pg. 27, lines 1-2, and 11-21; FIG. 4A, 4B), the advertising block being arranged within the user-perceptible content stream at an initially defined insertion position relative to the media section (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The system further includes means for adaptively re-sequencing the user-perceptible content stream into a modified user-perceptible content stream to reflect a user input detected at the client machine (*see e.g.*, specification pg. 29, lines 17-22; pg. 33, lines 13-21; pg. 39, lines 9-14; pg. 40, lines 1-6; pg. 42, lines 22-31, pg. 43, lines 1-30, pg. 44, lines 1-31, pg. 45, lines 1-31, pg. 46, lines 1-30, pg. 47, lines 1-16; pg. 49, lines 1-6, and 19-27; pg. 50, lines 10-15; FIG. 4A, 4B), the modified user-perceptible content stream comprising an alternate insertion position of the advertising block relative to the media section, the alternate insertion position differing from the initially defined insertion position and not having digital advertising content scheduled to be presented in it in the user-perceptible content stream prior to the adaptively re-sequencing (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41,

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lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D), the adaptively re-sequencing comprising determining the alternate insertion position using one or more pre-defined placement rules associated with the digital media content (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The system further includes means for causing presentation of the modified user-perceptible content stream at the client system (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The system further includes means for keeping a setting in a first memory to indicate a current state of play, the setting including a value to indicate whether presentation of a required part of the digital advertising content is in progress during presentation of the modified user-perceptible content stream (*see e.g.*, specification, pg. 32, lines 1-31; pg. 33, lines 1 – 31; pg. 34, lines 1-20; pg. 40, lines 1-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 53, lines 7-27; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The system further includes means for disallowing a navigation choice that alters a course of playback of the modified user-perceptible content stream while presentation of the required part of the digital advertising content is in progress (*see e.g.*, specification, pg. 34, lines 1-20; pg. 48, lines 20-30; pg. 49, lines 1-6; FIGs. 4A, 5A, 7A, 7B). The system further includes means for storing, in a second memory, presentation data comprising an indication of the digital advertising content that has been presented (*see e.g.*, specification, pg. 11, lines 1-4; pg. 16, lines 4 – 12; pg. 34, lines 1-20; pg. 40, lines 1-31, pg. 41, lines 1-31; pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D).

F. Independent Claim 271.

Claim 271 is directed to a system. The system including means for causing data comprising digital media content and digital advertising content to be available on a client system (*see e.g.*, specification pg. 9, lines 28-30; pg. 10, lines 1-2, and 29-31; pg. 11, lines 1-4; pg. 20, lines 30-31; pg. 21, lines 1-21; pg. 25, lines 27-30; pg. 26, lines 1-2, and 26-30; FIGs. 1, 2, 4A, 4B, 11C). The

system further includes means for sequencing the digital media content and the digital advertising content (*see e.g.*, specification pg. 25, lines 27-30; pg. 26, lines 1-2, and 26-30; pg. 27, lines 1-2, and 11-21; FIG. 4A, 4B), the sequencing comprising ordering at least some of the digital media content and at least some of the digital advertising content into a user-perceptible content stream, (*see e.g.*, specification pg. 20, lines 30-31; pg. 21, lines 1-21; pg. 27, lines 11-21; pg. 32, lines 21-29; FIG. 4A, 4B) the user-perceptible content stream comprising one or more initially sequenced insertion points at which the digital advertising content is scheduled to be presented relative to the digital media content (*see e.g.*, specification pg. 21, lines 1-21; pg. 28, lines 1-31; pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; FIG. 4A, 4B). The system further includes means for adaptively modifying, using pre-defined rules and in response to a user input detected by the client system, (*see e.g.*, specification pg. 29, lines 17-22; pg. 33, lines 13-21; pg. 39, lines 9-14; pg. 40, lines 1-6; pg. 42, lines 22-31, pg. 43, lines 1-30, pg. 44, lines 1-31, pg. 45, lines 1-31, pg. 46, lines 1-30, pg. 47, lines 1-16; pg. 49, lines 1-6, and 19-27; pg. 50, lines 10-15) a presentation position of the digital advertising content from at least one of the one or more initially sequenced insertion points to one or more alternatively sequenced insertion points, at least one of the one or more alternatively sequenced insertion points being different than the one or more initially sequenced insertion points relative to the digital media content within the user-perceptible content stream (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The system further includes means for causing presentation of the user-perceptible content stream at the client system after the adaptively modifying (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The system further includes means for keeping a setting in a first memory to indicate a current state of play, the setting including a value to indicate whether presentation of a required part of the digital advertising content is in progress during presentation of the user-perceptible content stream (*see e.g.*, specification, pg. 32, lines 1-31; pg. 33, lines 1 – 31; pg. 34, lines 1-20; pg. 40, lines 1-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 53, lines 7-27; pg. 54, lines 4-14; FIGs. 4A,

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6A, 6B, 7A, 7B, 8C, 8D). The system further includes means for disallowing a navigation choice that alters a course of playback of the user-perceptible content stream while presentation of the required part of the digital advertising content is in progress (*see e.g.*, specification, pg. 34, lines 1-20; pg. 48, lines 20-30; pg. 49, lines 1-6; FIGs. 4A, 5A, 7A, 7B). The system further includes means for storing, in a second memory, presentation data comprising an indication of the digital advertising content that has been presented (*see e.g.*, specification, pg. 11, lines 1-4; pg. 16, lines 4 – 12; pg. 34, lines 1-20; pg. 40, lines 1-31, pg. 41, lines 1-31; pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D).

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V. ARGUMENT

Appellant respectfully submits that the claim feature relating to "at least one of the alternatively sequenced insertion points being different from the one or more initially sequenced insertion points," is fully supported by the original specification and figures. References cited below are to the published application for convenience. Applicant submits that the references find support in the originally filed application, and can provide references thereto if the Board so desires. One of ordinary skill in the art would clearly understand that the inventor was in possession of the claimed invention at the time of filing at least through the portions of the specification and figures described herein. As such, Appellant respectfully requests the reversal of the rejections of the claims under 35 U.S.C. §112.

Appellant respectfully submits that the applied references, either alone or in combination, fail to describe or suggest at least "**adaptively modifying** using pre-defined rules and **in response to a user input detected by the client system**, **a presentation position of the digital advertising content** from at least one of the one or more initially sequenced insertion points to one or more alternatively sequenced insertion points, at least one of the one or more **alternatively sequenced insertion points being different than the one or more initially sequenced insertion points relative to the digital media content** within the user-perceptible content stream." As such, Appellant respectfully requests the reversal of the rejections of the claims under 35 U.S.C. §103(a).

Applicant submits the recent USPTO memorandum dated April 2, 2018, from Robert W. Bahr ("April 2018 Memo"), the April 2018 *Core Wireless* Federal Circuit case, *Ex parte Relyea*, as well as the remarks below, demonstrate that Claim 212 does not recite an abstract idea (step 2A), and, even if Claim 212 does recite an abstract idea (which Applicant does not acknowledge), Claim 212 amounts to significantly more than the abstract idea itself (step 2B). As such, Appellant respectfully requests the reversal of the rejections of the claims under 35 U.S.C. §101.

The Applicant's representative discussed these issues with the Examiner during an Interview on November 8, 2016 ("the Interview"), and although she agreed to consult with her colleagues and to follow up with the undersigned, she has not provided further feedback.

A. The pending claims satisfy the written description requirement under 35 U.S.C. §112, first paragraph because one of ordinary skill in the art would readily understand that the specification teaches the objected-to claim features.

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Claims 212, 214-223 and 225-273 stand rejected under 35 U.S.C. §112, first paragraph, because the Office alleges that the claims lack written description. *Office Action*, p. 4. The rejections of the independent claims under 35 U.S.C. §112, first paragraph are based on the Examiner's incorrect assertion that the original specification fails to provide the necessary written description support for the claim feature relating to "at least one of the alternatively sequenced insertion points being different from the one or more initially sequenced insertion points," which was added by amendment in the Response filed August 1, 2016 ("the previous Response"). As a first point, the allegedly unsupported features were first added to the claims in the paper filed October 28, 2015, albeit in slightly different form, to address a rejection under 35 U.S.C. §112, first paragraph raised in the Final Office Action mailed May 1, 2014. The Examiner withdrew the rejection in the Non-Final Office Action mailed February 1, 2016, but now has repeated it for reasons the Applicant does not understand.

Furthermore, the Examiner has clearly failed to apply the proper standard for a rejection under 35 U.S.C. §112, first paragraph. As stated in MPEP §2163.02: the objective standard for determining compliance with the written description requirement is, "does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed."[1] To satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed. If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met.[2] Furthermore, as stated in MPEP §2163.07, "mere rephrasing of a passage does not constitute new matter," and "a rewording of a passage where the same meaning remains intact is permissible."[3]

Further, to make a *prima facie* case, **the Examiner has the initial burden of presenting evidence or reasoning** to explain why persons skilled in the art would not recognize in the

[1] See, *e.g. In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Under *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).
[2] See, *e.g.*, *Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d at 1116; and *Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972) (stating "the description need not be *in ipsis verbis* [i.e., "in the same words"] to be sufficient").
[3] See, *e.g. In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973).

disclosure a description of the invention defined by the claim, and to explain why the claim is not fully supported by the disclosure (emphasis added). *MPEP* 2163.04. Instead of providing evidence or reasoning, the Examiner has simply alleged "Examiner could not find a [*sic*] support for the following claim language." *Office Action*, p. 5. Accordingly, the Examiner has not satisfied her burden of proof for establishing a *prima facie* case that one of ordinary skill in the art would not have been able to recognize that the inventors invented the subject matter recited in Claim 212. As such, the rejection under U.S.C. §112, first paragraph that Claim 212 allegedly fails to satisfy the written description requirement is improper and should be withdrawn.

As discussed during the Interview, the Examiner appears to have merely searched the specification for explicit textual support without properly determining what a skilled artisan would have understood the inventors to have been in possession of at the time of filing. Had the Examiner performed the proper analysis, she would have readily noted that the claim feature at issue in this rejection is well-supported at least by ¶0149-¶0150, and also at ¶0154-¶0156, referring to FIG. 4A.

In ¶0149, the instant specification describes a situation in which "the user of sequence 402 jumps right into segment 434 as segment 430 is just starting" in which case "the player/viewer will begin segment 434 at its point of entry, followed at its end by ad block 412." In this case, the digital advertising content plays at "one of the one or more initial insertion points." In contrast, in ¶0150, "the user has watched 80% of segment 432, and then jumps into the middle of segment 434," which results in "ad block 410 play[ing] immediately, and when it is finished, content play resum[ing] at the point selected in segment 434." In the scenario described in ¶0150, ad block 410 is played at a point immediately preceding "the middle of segment 434," which is an "alternate insertion point" that is clearly "different than the one or more initially sequenced insertion points relative to the digital media content within the user-perceptible content stream," which would, in this example, be those insertion points originally scheduled to occur between the segments.

At ¶0154-¶0156, the instant specification provides further support for the claim feature at issue, this time in reference to an example (illustrated as sequence 404 in FIG. 4A) of a "track allowance method for ad placement." ¶0154 states that in "regular play without skipping around or other navigation, sequence 404 begins by playing tracks 440, 442, 444, 446, and 448 in series, followed by ad block 414, and then tracks 450, 452, 454, and 456" and that ad block 416 comes after track 456, "followed by tracks 458, 460, and 462." In ¶0156, "[i]f the user decides to play track 446 and then track 456, the program does not insert ad block 416 immediately after track

456. Instead, play goes directly into track 458, because the allowance is 5 tracks. If the user plays through most of track 458, then jumps to the beginning of track 442 and plays it, there is still allowance for one more track after that, since only four tracks (446, 456, 458, and 442) have played so far." In other words, ad blocks 414 and 416 are initially sequenced after tracks 448 and 456, respectively, but in response to the user "skipping around or other navigation," ad block insertions wind up at different positions relative to those tracks to comply with pre-defined placement rules (which in this example are track count rules).

One of ordinary skill in the art would clearly understand that the movement of an ad block insertion location originally scheduled to follow track 448 and precede track 450 but instead being played at a different location that was not an initially scheduled insertion point provides clear support sufficient to satisfy the requirements of 35 U.S.C. §112, first paragraph. Claims 212, 238, 243, 267, 268, and 271 therefore satisfy the written description requirement. Claims 214-223, 225-237, 239-242, 244-266, 269-270, and 272-273 stand rejected for their dependency on a rejected basis, and are not separately rejected. As such, Claims 214-223, 225-237, 239-242, 244-266, 269-270 also comply with the written description requirement. For at least these reasons, these rejections should be withdrawn.

B. The pending claims are not obvious under 35 U.S.C. §103(a) because the applied references fail to teach or suggest each and every feature of the claims.

Claims 212, 214-223 and 225-273 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentably obvious over Knepper in view of Hannah and further in view of Wang. *Office Action*, p. 7. Appellant respectfully disagrees, and respectfully requests the reversal of the rejections of Claims 212, 214-223 and 225-273 for at least the reasons discussed herein.

The burden of establishing a proper *prima facie* basis upon which to reject claimed subject matter as unpatentably obvious lies with the Office. MPEP § 2143. In order to establish a proper *prima facie* basis, the Office must present a clear and explicit rationale supporting the assertion that all of the claimed elements were known in the prior art, and that one skilled in the art would have combined the claimed elements by known methods, with no change in their respective functions, to produce a combination yielding nothing more than predictable results. *Id.*; *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 416 and 419 (quoting with approval *In re Kahn,* 441 F.3d 977, 988 (C.A. Fed. 2006)). In judging the patentability of the claims against the prior

art, all words in a claim must be considered. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970); MPEP § 2143.03.

Furthermore, "[t]o support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP §706.02(j) (quoting *Ex Parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)).

Appellant respectfully submits that the Examiner has failed to establish a proper *prima facie* case of obviousness under 35 U.S.C. §103(a).

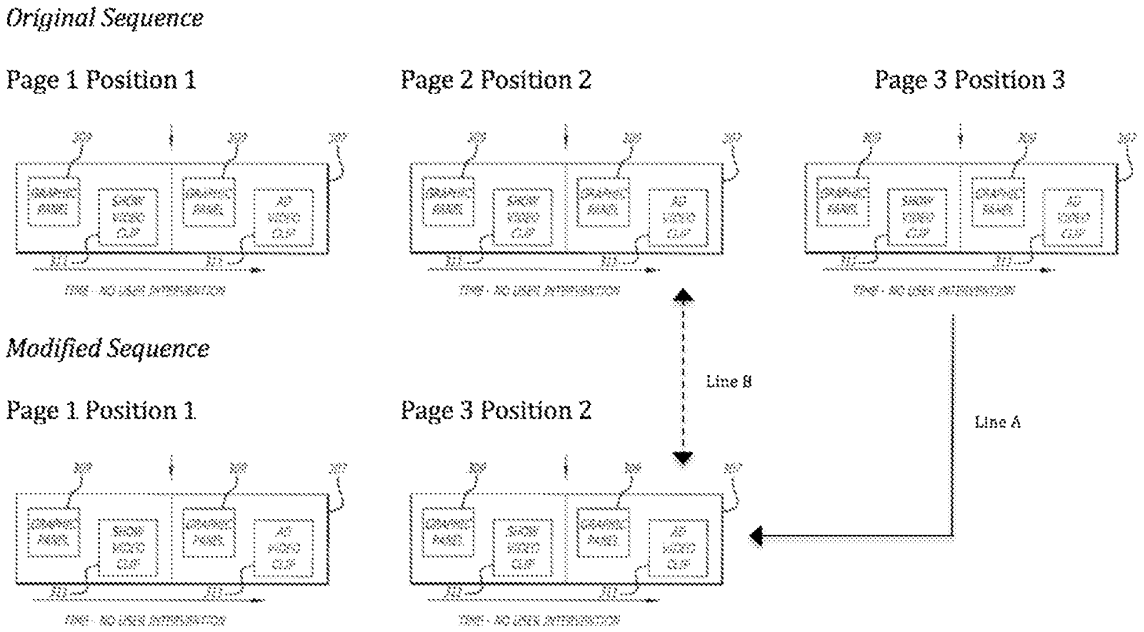
1. **Knepper does not describe or suggest "at least one of the one or more alternatively sequenced insertion points being different than the one or more initially sequenced insertion points relative to the digital media content of" independent Claim 212 or the corresponding features of Claims 238, 243, 267, 268, and 271.**

As discussed with the Examiner during the Interview, the statement of the rejections under 35 USC §103 reflects clear error, at least because a) it ignores explicit limitations of the claims and b) the cited references clearly do not describe or suggest all of the features of the independent claims.

As a first point, the Examiner has explicitly acknowledged on the record (see the Final Office Action mailed May 1, 2014 at page 15) that Knepper does not teach "at least one of the advertisement files is presented in a different position relative to the media files." The specific wording of this limitation has been slightly modified relative to what was pending at the time of this Final Office Action to make it abundantly clear what is being claimed. Despite Applicant's repeated attempts to clarify the claimed subject matter, the Examiner continues to muddle the issue, specifically with her statement of the reasons for rejection on page 8 of the current Office Action, where she alleges that "[s]ame as applicant's disclosure, the advertisement and the media of Knepper which were sequenced to be played in a predefined order, when the user skips or forwards to a different music (e.g. to a third media in the sequence after playing the first media in the sequence), the ad appended to the media (third media) would also be played as a second in the sequence (the media and ad combination) instead of the ad appended to the second media in the sequence (playlist)." The rationale for this incorrect assertion relies on a re-statement of how a

Knepper presentation clip page is constructed (citing ¶0062 as it relates to FIG. 7) and an alleged equality with descriptions in the instant specification. *Office Action*, p. 8. However, as discussed further below, the Knepper description directly contradicts the claimed subject matter, particularly the claim features in which an alternate insertion point (that differs from any initial insertion point) relative to digital media is used in response to user input that causes the adaptively modifying as claimed. Furthermore, the cited ¶0062 and FIG. 7 of Knepper clearly relate to initial set-up of the entertainment files and advertising files and make no reference whatsoever to "skipping." The Examiner appears to have constructed this part of the statement of rejection without proper basis in any of the prior art.

Even assuming, *arguendo*, that a user could navigate between Knepper pages and that would somehow change the order at which specific advertisement content is presented, the advertising insertion points as described in Knepper would still be at the exact same positions as enumerated upon in the following diagram example adapted from FIG. 4 of Knepper:



In the example diagram above, if a Knepper Page 3 moves from Position 3 in the *Original Sequence* to Position 2 in the *Modified Sequence* (as shown by Line A above) then, while the content of Ad Video Clip 311 at Position 2 may change, the advertisement insertion point of the resultant presentation at Page 3 Position 2 (formerly Page 2 Position 2) would be at the exact same

position in sequence (as shown by Line B, Ad Video Clip 311 above). The Examiner ***argues*** that moving the position of the pages (e.g., from Page 3, Position 3 to Page 3, Position 2, as shown above) changes the Content of the Ad Video Clip 311 at Position 2. *See Office Action*, p. 8. However, Claim 212 recites **adaptively modifying** a position for digital ad content by moving the position from "one or more **initially sequenced insertion points to one or more alternatively sequenced insertion points"** that are different from the initially sequenced insertion points "relative to the digital media content within the user-perceptible content stream." As clearly shown above and as described in Knepper, the insertion points of the Ad Video Clips **do not change**.

Moreover, the approaches described in Knepper generally relate to improvements that address challenges inherent in delivery and playback of video and/or audio media files on a client-side computer (see, e.g. ¶0007 of Knepper). Using the approach of Knepper, media files (which can include both entertainment media files and advertisement media files) and an instruction set are downloaded from a server to a client, and pre-cached at the client side. Knepper explains that the "server 207 thus has control over the user's advertisement set." *Id.* at ¶0029. Knepper also explains that an application "assembles the entertainment and advertisement media files and begins playback of the various media files… **in the order specified by the instruction set**" (emphasis added). *Id.* at ¶0037. The entertainment and advertisement media files are thus assembled to form a clip. The formed clip has the appearance of being a single media file. *Id.* at ¶0038.

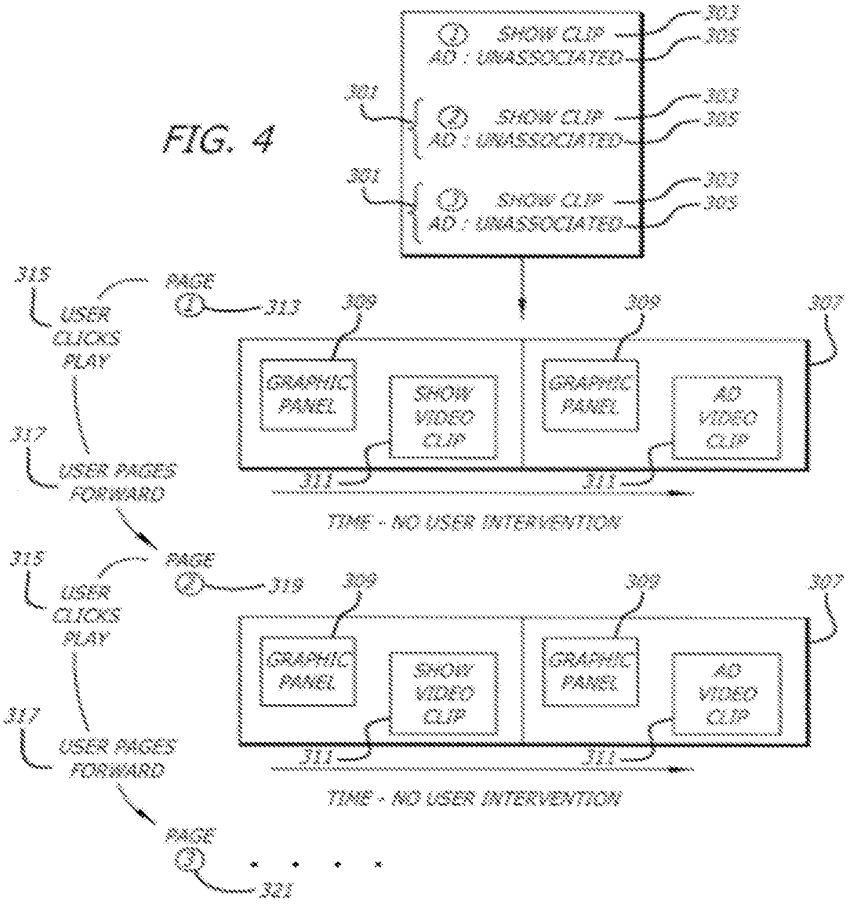
In direct contrast to the descriptions in Knepper, the "**adaptively modifying**" of "a presentation position of the digital advertising content" element of claim 212 involves using pre-defined rules and occurs **in response to a user input** detected by the client system. The presentation position of the digital advertising content is adaptively modified "from at least one of the one or more **initially sequenced insertion points to one or more alternatively sequenced insertion points**" and "at least one of the one or more **alternatively sequenced insertion points** [is] **different than the one or more initially sequenced insertion points relative to the digital media content within the user-perceptible content stream**." In other words, after creating a user-perceptible content stream a user input causes a modification to the user-perceptible content stream such that digital advertising content in the user-perceptible content stream after the adaptively modifying is arranged at different/alternate insertion positions relative to the digital media content. Such an adaptive modification would not be possible in the Knepper instruction set, **determined by the server**, that indicates the order of entertainment and advertisement media

files.

Knepper makes clear that the insertion positions for advertising are defined by pages. For example, Knepper at ¶0052 describes a digital magazine having ads at fixed positions in relation to the content. A user can traverse the magazine, for example by "paging forward", but will always be presented with advertisements at fixed pre-determined locations relative to the specific content assigned to a given page. Even assuming *arguendo* that user navigation in the Knepper approach can change the order in which pages are presented, which in turn may result in the entertainment files and the associated advertising file locations for a given page to be presented in a different overall order, the locations at which advertising files are presented is nonetheless always fixed with respect to the associated entertainment file for a given page, at least because the navigation in Knepper occurs page by page and each page defines a fixed and unchangeable relationship between the entertainment file and a location for an advertising file. *See Knepper*, FIG. 4 show video clip 311 and ad video clip 311. For example, if a user could navigate from a first page of a Knepper magazine to a third page, any initially defined advertising file location on the first page and the third page would remain the same relative to the entertainment files on those first and third pages both before and after the navigation, as shown in the above example on p. 22 adapted from FIG. 4 of Knepper.

With Knepper, and with particular reference to paragraphs ¶¶0052, 0059, 0063, and 0084, entertainment files can have associated advertisement files (i.e., the same advertisement is always played with the same entertainment file) or they can have unassociated advertisement files (i.e., an advertisement file is always played with the entertainment file – but it can be one of several advertisement files). What is not changeable in Knepper, however, are the actual insertion locations at which advertising is presented relative to the content on any given page. Thus, a user of the approach described in Knepper may choose to navigate between pages 307 as discussed above. However, as shown in Knepper's FIG. 4 (reproduced below for reference) on any given page 307, there is a fixed "show video clip" 311 and an "ad video clip" 311.

FIG. 4



In other words, the approach of Knepper requires defining of fixed, specific locations into which ad video clips are inserted before or after specific show video clips. This requirement is made explicit in ¶0041: "[t]he server also sends a text file containing a set of instructions indicating which advertisement media files from among the pre-cached advertisement media files to insert into the entertainment media file at run time, how many advertisement media files to insert, and **where to insert them**." (Emphasis added). Knepper further explains that once "all of the files listed in the instruction set are downloaded, the client begins to display the content" and the "**instruction set indicates the order in which the media files are to be played**" (emphasis added). *Id.* at ¶¶0011, 0065.

In contrast, the subject matter of the instant claims causes an alternate insertion position/one or more alternatively sequenced insertion points for digital advertising content in the adaptively re-sequenced/adaptively modified user-perceptible content stream to be different than

those in the user-perceptible content stream before the adaptively re-sequencing/adaptively modifying such that an insertion position for digital advertising content relative to a media section of the digital media content changes from the user-perceptible content stream to the modified user-perceptible content stream/the user-perceptible content stream post adaptively modifying. This changing of the insertion position/insertion points of digital advertising content occurs explicitly as a result of user interaction, which is directly and unequivocally contrary to the approach described in Knepper (*see, e.g.*, Knepper Fig 4, which repeatedly states "**no user intervention**" (emphasis added) with the combination of content and advertising).

Claim 243 (and also claims 267 and 268, which differ in scope but include similar language) explicitly requires "the modified user-perceptible content stream comprising an alternate insertion position of the advertising block relative to the media section, the alternate insertion position differing from the initially defined insertion position and not having digital advertising content scheduled to be presented in it in the user-perceptible content stream prior to the adaptively re-sequencing" (emphasis added). Claim 212 (and also claims 238 and 271, which differ in scope but include similar language) states a related limitation worded slightly differently, and is likewise clearly not compatible with any reasonable interpretation of Knepper. Specifically, the modified user-perceptible content stream of claim 243 includes an alternate insertion position of a specific advertising block relative to a specific media section, where the alternate insertion position differs from the initially defined insertion position and does not have digital advertising content scheduled to be presented in it in the user-perceptible content stream prior to the adaptively re-sequencing.

Knepper neither describes nor suggests such an approach – as noted above, a given advertising location on a page is explicitly fixed relative to the entertainment file location on that page. There is no allowance in Knepper for presenting an advertising file in a location relative to an entertainment file that is not also present in the original sequence. Furthermore, FIG. 4 of Knepper expressly states that "**no user intervention**" (emphasis added) is permitted with regards to the page structure itself. These teachings of Knepper, which were discussed in detail in the previous Response and at several other points during the lengthy prosecution of this matter, directly contradict the example of the claimed subject matter (see, e.g., description above relating to the written description rejections).

The current Office Action fails to even explicitly allege that the features of claims 212 (and

238 and 271) and 243 (and 267 and 268) discussed above are described or suggested in the prior art. For example, the statement of rejection appearing at pages 7 to 9 of the Office Action makes no reference to such features but rather recycles text that has appeared in previous rejections of claims that did not have these features recited as they are currently presented. Additionally, the statement of rejection beginning on page 7 of the current office action does not acknowledge any difference in the claim language between claims 212 and 243, which is another indication of clear error. Furthermore, in the Response to Arguments section (see end of page 16 and top of page 17), the Examiner expressly attempts to rebut Applicant's arguments for non-obviousness by alleging that these elements need not be considered because "applicant's specification does not provide support for such claim language." Beyond being an admission that the features are not addressed in the statement of the rejections under 35 U.S.C. §103(a), this statement is also, on its face, a clear violation of the principles of compact prosecution.[4] The Examiner has committed clear error by failing to consider the Applicant's argument with regard to an explicit claim feature with the excuse of an errant (as discussed above in relation to the rejections under 35 U.S.C. §112, first paragraph) allegation of lack of written description support.

Finally, the Examiner's citation of *In re Keller* (see page 17 of the current Office Action) is nonsensical. The holding in that case certainly does not preclude a rebuttal of an obviousness rejection by explaining how the primary reference does not teach features alleged by the Examiner, particularly when the cited secondary references are neither asserted to nor reasonably interpretable as remedying the identified deficiencies in the primary reference. For avoidance of doubt, Knepper does not describe or suggest the above-noted features, nor do any of the other cited references. For example, Wang and Hannah are cited merely as allegedly rendering unpatentably obvious the features relating to prevention of skipping of advertising. Neither reference addresses the clear deficiency in Knepper with regard to the currently pending claims. Accordingly, Knepper, Wang, and Hannah, whether considered alone or in any combination, are insufficient to establish proper grounds for a rejection under 35 U.S.C. §103(a).

Claim 238 is directed to subject matter of different scope than Claim 212, but includes similar limitations to those discussed above. Claims 243, 267, 268, and 271 likewise recite features

[4] See MPEP §2103, which states that "each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement."

similar to at least some of the patentable features discussed in connection with Claim 212 above and also define patent-eligible subject matter.

For at least these reasons, withdrawal of the pending rejections of Claims 212, 238, 243, 267, 268, and 271 under 35 U.S.C. §103(a) is respectfully requested.

2. Dependent Claims 214-223, 225-237, 239-242, 244-266, 269-270, and 272-273 are allowable over the applied references at least by virtue of their dependency from one of independent Claims 212, 238, 243, 267, 268, or 271.

Dependent Claims 214-223, 225-237, 239-242, 244-266, 269-270, and 272-273 each depend either directly or indirectly on one of independent Claims 212, 238, 243, 267, 268, and 271. Thus, the dependent claims incorporate by reference all the features of their respective independent claims pursuant to 35 U.S.C. § 112, ¶ 4. In view of the features as recited in the independent claims, and in view of the additional features as recited in the dependent claims, Appellant respectfully submits that the dependent claims define patentable subject matter over the applied references for at least the reasons discussed above, and for their respective additional novel features. Thus, Appellant respectfully submits that dependent Claims 214-223, 225-237, 239-242, 244-266, 269-270, and 272-273 are allowable.

Accordingly, for at least these reasons, reversal of the pending rejection of Claims 214-223, 225-237, 239-242, 244-266, 269-270, and 272-273 under 35 U.S.C. §103 is respectfully requested.

C. The pending claims are directed to patent eligible subject matter because they are not directed to an abstract idea, and even if they were, the pending claims provide significantly more than the abstract idea itself.

Claims 212, 214-223 and 225-273 are rejected under 35 U.S.C. §101, because the Office alleges that the claims are drawn to subject matter that is not eligible for patenting. *Office Action*, p. 2. Appellant respectfully disagrees and traverses this rejection for at least the following reasons.

Subject Matter Eligibility Standard

In *Alice v. CLS Bank*, the Supreme Court outlined a two-step analytical framework for analyzing subject matter eligibility under Section 101.[5] Step 1 requires a determination of whether the claim is directed to a process, machine, or composition of matter. In response to step 1 being decided in the affirmative, step 2A (part 1 of the *Mayo* test) requires a determination of whether the claims are directed to a law of nature, a natural phenomenon, or an abstract idea (judicial exceptions). In response to step 2A being decided in the affirmative, step 2B (part 2 of the *Mayo* test) requires a determination of whether the claim recites additional elements that amount to significantly more than the judicial exception.[6]

Subsequent Federal Circuit decisions and USPTO guidance have provided additional guidance on the subject matter eligibility requirement. For example, in *Enfish v. Microsoft*, the Federal Circuit held that a claim directed to a self-referential table was patent-eligible because it was directed to a specific, asserted improvement in computer capabilities.[7] In *BASCOM v. AT&T*, the Federal Circuit held that a claim containing known, conventional pieces was patent-eligible because it provided a non-conventional and non-generic arrangement of those pieces.[8] Further, in *McRO v. Bandai*, the Federal Circuit held that a claim requiring specific rules to render 3-D animations in a specific way was patent-eligible because the use of the rules did not preempt others from rendering 3-D animations using generic rules.[9]

Appellant respectfully submits that, in view of *Core Wireless*, *Ex parte Relyea*, and the April 2018 USPTO Memo, the claims do not recite an abstract idea (step 2A), and, even if the claims do recite an abstract idea (which Appellant does not acknowledge), the claims amount to significantly more than an abstract idea itself (step 2B). Moreover, Appellant respectfully submits that the Examiner has failed to establish a proper *prima facie* case that the claims are not directed to patent-eligible subject matter under 35 U.S.C. §101.

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[5] *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2355 (2014).
[6] *See id.*; MPEP § 2106.
[7] *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335-36 (Fed. Cir. 2016).
[8] *BASCOM Global Internet Servs. v. AT&T Mobility LLC*, 827 F.3d 1341, 1350 (Fed. Cir. 2016).
[9] *McRO, Inc. v. Bandai Namco Games Am.*, 837 F.3d 1299, 1315 (Fed. Cir. 2016).

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1. **Step 2A: the pending claims do not recite an abstract idea because they are inextricably tied to computer technology and distinct from the types of concepts found by the courts to be abstract.**

As an initial matter, the Examiner has not considered the most recent USPTO April 2018 Memo. In the April 2018 Memo, Mr. Bahr explains that two precedential Federal Circuit decisions, *Finjan*[10] and *Core Wireless*[11], found the software-related inventions patent eligible under 35 U.S.C. § 101 because the inventions ***were not directed to an abstract idea***. *Finjan*, *Core Wireless*, as well as *Enfish* and *McRO*, confirm that software-based innovations are not abstract if they make non-abstract improvements to computer technology. **As such, they are patent eligible under the first step of the Alice test (also referred to as step 2A in the USPTO's subject matter eligibility guidance, MPEP § 2106.04).**

In the Office Action, the Examiner cites *SmartGene* and *Cyberfone* as supporting the assertion that Claim 212 is similar to other ideas found to be abstract by various courts. *Office Action*, p. 3. Applicant first notes that both *SmartGene* and *Cyberfone* are non-precedential decisions by the Federal Circuit. In the November 2016 Memo to Examiners, the USPTO gave explicit guidance regarding use of both *SmartGene* and *Cyberfone* as non-precedential decisions:

> **Non-precedential decisions:** Finally, given the large and ever-increasing number of precedential decisions, **examiners should avoid relying upon or citing non-precedential decisions (e.g., SmartGene, Cyberfone) unless the facts of the application under examination uniquely match the facts at issue in the non-precedential decision**. The updated chart of court decisions available on the US PTO' s SME Webpage indicates whether a decision is precedential or nonprecedential. (Emphasis added) *November 2016 Memo*, p. 4; *see also* MPEP § 2106.07(a).

Accordingly, *SmartGene*, for example, should only be cited in applications that claim methods in which "every step" is one that a physician would make mentally upon observing a patient or reviewing medical data. Similarly, Cyberfone should only be cited in applications that claim methods in which "every step" is one that a computer would make when obtaining a single transmission from a telephone. Neither is the case in amended Claim 212.

Although the Examiner cites the above court decisions, the cited court decisions are not

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[10] *Finjan Inc. v. Blue Coat Systems, Inc.*, 879 F.3d 1299 (Fed. Cir. 2018).

[11] *Core Wireless Licensing S.A.R.L., v. LG Electronics, Inc.*, 880 F.3d 1356 (Fed. Cir. 2018).

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analogous to amended Claim 212. For example, in *SmartGene*, the claims were directed to a method for guiding the selection of a therapeutic treatment regimen for a patient with a known disease or medical condition. *SmartGene*, Slip Opinion, p. 2. The court stated that the claims defined a process of "using a computer to perform a series of mental steps that people, aware of each step, can and regularly do perform in their heads" *Id.* at p. 7-8. In *Cyberfone*, the claim at issue was directed to a method comprising "obtaining data transaction information …; forming a plurality of different exploded data transactions for the single transmission…; and sending said different exploded data transactions over a channel to said different destinations." *Slip Op.*, p. 7.

As noted above, Claim 212 is not directed to observing a patient or reviewing medical data and therefore should not be analogized to *SmartGene*. Likewise, Claim 212 is not directed to forming a plurality of different exploded data transactions from a single transaction and should not be analogized to *Cyberfone*. In contrast to the claims of *SmartGene* and *Cyberfone*, and as highlighted by the Specification of the present application, the subject matter of Claim 212 uses an initial sequencing and user input to "adaptively regroup and re-sequence the insertion of ad blocks extemporaneously (i.e. "on the fly"), in response to the consumer's arbitrary direction of the playback within the requested content, by means of playback controls." *See Specification*, ¶0117. As such, Claim 212 is not directed to "the abstract idea of 'preventing of commercial skipping by using a well-known device'" as alleged by the Examiner. *Office Action*, p. 3. Indeed, Claim 212 recites an improved computer-implemented way to adaptively re-sequence ad block positions in response to user input which is clearly different than the alleged abstract idea of "preventing of commercial skipping by using a well-known device."

This improvement is similar to those the courts recognized in *Core Wireless*, *Enfish*, and *McRO* in which the claims provided technological benefits and were not found to be directed to an abstract idea.

In *Core Wireless*, the claimed invention involves a graphical user interface (GUI) for mobile devices that displays an application summary of each application on the main menu while those applications are in an unlaunched state. The claims to computing devices were held patent eligible because the court concluded that they are directed to an improved user interface for electronic devices, not to the abstract idea of an index. In particular, **the claims contain precise language delimiting the type of data to be displayed and how to display it, thus improving upon conventional user interfaces** to increase the efficiency of using mobile devices. Finding the

claims eligible, the court compared the improved user interface in the patent claims to the improved systems claimed in *Enfish, Thales, Visual Memory,* and *Finjan.*

In Claim 212, like in *Core Wireless*, the claimed subject matter is directed to non-abstract improvements to computer technology because it **contains precise language delimiting the type of data to be sequenced and how to sequence and adaptively modify the sequence, thus improving upon conventional delivery, presentation, and user interaction of/with media content and advertising content**. For example, Claim 212 specifies the type of data (e.g., data comprising digital media content and digital advertising content), how to sequence it (e.g., determining an initial sequence of the digital media content and digital advertising content and adaptively modifying and/or re-sequencing the initial sequence), and even includes what is done with the information after the modifying and/or re-sequencing (e.g., presenting the content stream, keeping a setting, disallowing a navigation choice based on the digital advertising content, and storing presentation data). Accordingly, just as held in *Core Wireless*, amended Claim 212 is also not directed to an abstract idea.

In *Enfish*, the Federal Circuit noted that in determining whether a claim is *directed to* an abstract idea for purposes of the first step, it is not sufficient to simply ask whether the claim *involves* a patent-ineligible concept. The claims must be "considered in light of the specification, based on whether 'their character as a whole is directed to excluded subject matter.'" *Enfish*, pp. 9-11.

Unlike the claims in *SmartGene* and *Cyberfone*, the claims in *Enfish* were directed to an improvement in the function of a computer. The *Enfish* court gave specific guidance that "benefits over conventional databases, such as **increased flexibility, faster search times, and smaller memory requirements**," may be determinative that the claims are directed to improvements in existing computer technology and not an abstract idea. *May 2016 Guidance*, p. 2. Claim 212 is likewise directed to improvements in the function of computers, specifically to increase flexibility in the way digital advertisements may be delivered. For example, the subject matter of Claim 212 gives the "ability to adaptively regroup and re-sequence the insertion of ad blocks extemporaneously (i.e. "on the fly"), in response to the consumer's arbitrary direction of the playback within the requested content." *Specification*, ¶0117. Because these processes are inextricably related to a computing system, the claimed subject matter cannot be abstract nor directed to a judicial exception (Step 2A). Furthermore, the capability to adaptively regroup and

re-sequence insertion of ad blocks on the fly can provide important benefits over conventional distribution systems by improving security, optimizing bandwidth, performance, and user interaction, etc. *See id.* at ¶0054, FIG. 3A, ¶0110-0111, ¶0117, ¶0186, and ¶202-204.

Moreover, the Office has overgeneralized the claims, which is prohibited by recent USPTO guidance. For example, the November 2016 Memo, citing *McRO*, provides that:

> **Examiners should consider the claim as a whole under Step 2A** of the USPTO's SME guidance, and should not overgeneralize the claim or simplify it into its "gist" or core principles, when identifying a concept as a judicial exception. [] **An "improvement in computer-related technology" is not limited to improvements in the operation of a computer or a computer network *per se*, but may also be claimed as a set of "rules" (basically mathematical relationships) that improve computer-related technology by allowing computer performance of a function not previously performable by a computer**. *November 2016 Memo*, p. 2. (emphasis added).

The Office, however, has generalized the claims down to "preventing of commercial skipping." *See Office Action*, p. 3. The Examiner in particular fails to explain why limitations of "sequencing," "adaptively modifying," "causing presentation," "keeping a setting" and "disallowing" do not alter the scope of what the claims as a whole are directed to. The Office thus looked at the claims generally and did not account for the specific requirements of the claims which recite a novel and inventive method of adaptively re-sequencing ad insertion points which have nothing to do with "preventing of commercial skipping," e.g., in point of fact, even if the ads are adaptively re-sequenced after a user navigation, they could still possibly be skippable in some fashion (i.e. fast forward/skip) if not for the additional "disallowing" limitation of Claim 212. Indeed, the specific limitations of Claim 212 enable user navigation with advertising supported media which traditionally was not possible. *See Specification*, ¶0008, ¶0048, ¶0057.

Accordingly, the Office's rejection fails to meet the Office's burden to establish a *prima facie* case that the subject matter of Claim 212 is directed to an abstract idea that can be performed mentally.

2. Step 2B: the pending claims add significantly more to an abstract idea

Even assuming, *arguendo*, that Claim 212 is directed to an abstract idea under Step 2A, Claim 212 recites significantly more than the alleged abstract idea of preventing of commercial skipping.

For example, in the recent Federal Circuit decision of *Bascom Global Internet Services, Inc., v. AT&T Mobility LLC*, No. 2015-1763 (Fed. Cir.) (June 27, 2016), the Federal Circuit opined that Claim 1 of the application recited patent-eligible subject matter. Claim 1 of Bascom's patent recited:

> 1. A content filtering system for filtering content retrieved from an Internet computer network by individual controlled access network accounts, said filtering system comprising:
>
> a local client computer generating network access requests for said individual controlled access network accounts; at least one filtering scheme;
>
> a plurality of sets of logical filtering elements; and
>
> a remote ISP server coupled to said client computer and said Internet computer network, said ISP server associating each said network account to at least one filtering scheme and at least one set of filtering elements, said ISP server further receiving said network access requests from said client computer and executing said associated filtering scheme utilizing said associated set of logical filtering elements.

The Federal Circuit criticized the District Court's piecemeal analysis of the features of Claim 1, and stated that the inventive concept inquiry "requires more than recognizing that each claim element, by itself, was known in the art," as "an inventive concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces." *Bascom*, Slip Opinion, p. 15. The Federal Circuit also noted that the District Court analysis looked "similar to an obviousness analysis under 35 U.S.C. § 103, except lacking an explanation of a reason to combine the limitations." *Id.* at p. 4. The *Bascom* court clearly recognizes that "software-based inventions that improve the performance of the computer itself" are patent eligible even when the inventions are otherwise directed toward abstract ideas. *Id.* at p. 18.

The *Bascom* decision described how an analysis under 35 U.S.C. §101 should not be the same as an analysis under 35 U.S.C. §103. *Id.* at pp. 4, 15. Here, it should be noted that Claim 212 is not known, much less well-known (by virtue of being novel under 35 U.S.C. 102) and is also not obvious (by virtue of being allowable under 35 U.S.C. 103, as discussed above). Therefore, as in *Bascom*, the claim elements of Claim 212 cannot properly be rejected by the mere assertion that they are drawn to well-known, routine, and conventional practices as alleged on p. 4 of the Office Action.

Additionally, the most recent USPTO memorandum dated April 19, 2018, from Robert W. Bahr ("April 19, 2018 Memo") explains that the precedential Federal Circuit decision of *Berkheimer*[12] held that whether "something is well-understood, routine, and conventional to a skilled artisan at the time of the patent is a **factual determination**" (emphasis added). *April 19, 2018 Memo*, p. 2. The April 19, 2018 Memo explains that in "a step 2B analysis, an additional element (or combination of elements) is not well-understood, routine or conventional **unless the examiner finds, and expressly supports a rejection in writing with, one or more of the following**:" 1) a citation to an express statement in the specification or to a statement made by an applicant during prosecution; 2) citation to one or more of the court decisions discussed in MPEP § 2106.05(d)(II); 3) a citation to a publication; or 4) statement that the examiner is taking official notice. (Emphasis added). *See id.* at p. 3-4. These citations must demonstrate the well-understood, routine, conventional nature of the additional element(s). *Id.*

In the Office Action, the Examiner has not provided **any of the above support** for the assertion that the elements of Claim 212 are well-understood, routine or conventional and has therefore failed to meet the Office's burden under Step 2B and MPEP § 2106. *See Office Action*, p. 4

While the rejections under 35 U.S.C. §101 should be withdrawn simply due to this deficiency, the following additional arguments are presented in hopes of furthering prosecution in this matter. For example, claims 212 and 238 include ordered combinations of elements (implemented by operation of one or more processors) that include

- receiving data that includes digital media content and digital advertising content on a client system (claim 212) or transmitting such data to a client system from at least one remote system (claim 238);
- sequencing the digital media content and the digital advertising content, which includes ordering at least some of the digital media content and at least some of the digital advertising content into a user-perceptible content stream that includes one or more initially sequenced insertion points at which the digital advertising content is scheduled to be presented relative to the digital media content;

[12] *Berkheimer v. HP Inc.,* 881F.3d1360 (Fed. Cir. 2018).

- adaptively modifying a presentation position of the digital advertising content from at least one of the one or more initially sequenced insertion points to one or more alternatively sequenced insertion points using pre-defined rules and in response to a user input detected by the client system, such that at least one of the one or more alternatively sequenced insertion points is different than the one or more initially sequenced insertion points relative to the digital media content within the user-perceptible content stream;
- causing presentation of the user-perceptible content stream at the client system after the adaptively modifying;
- keeping a setting (which includes a value to indicate whether presentation of a required part of the digital advertising content is in progress during presentation of the user-perceptible content stream) in a first memory to indicate a current state of play;
- disallowing a navigation choice that alters a course of playback of the user-perceptible content stream while presentation of the required part of the digital advertising content is in progress; and
- storing presentation data comprising an indication of the digital advertising content that has been presented in a second memory.

Claim 271 includes similar limitations in a system (means-plus-function) claim.

While directed to subject matter of differing scope, new claims 243, 267, and 268 include an ordered combination of elements (implemented by operation of one or more processors) that include

- receiving data that includes digital media content and digital advertising content on a client system (claim 243) or transmitting such data to a client system from at least one remote system (claim 267);
- sequencing the digital media content, which includes ordering the digital media content into a user-perceptible content stream that includes a) a media section that includes at least some of the digital media content and b) an advertising block within which at least some of the digital advertising content is scheduled to be presented and which is arranged within the user-perceptible content stream at an initially defined insertion position relative to the media section;

- adaptively re-sequencing the user-perceptible content stream into a modified user-perceptible content stream to reflect a user input detected at the client machine, such that the modified user-perceptible content stream includes an alternate insertion position (which differs from the initially defined insertion position and does not have digital advertising content scheduled to be presented in it in the user-perceptible content stream prior to the adaptively re-sequencing), and where the adaptively re-sequencing includes determining the alternate insertion position using one or more pre-defined placement rules associated with the digital media content;
- causing presentation of the modified user-perceptible content stream at the client system;
- keeping a setting (which includes a value to indicate whether presentation of a required part of the digital advertising content is in progress during presentation of the modified user-perceptible content stream) in a first memory to indicate a current state of play;
- disallowing a navigation choice that alters a course of playback of the modified user-perceptible content stream while presentation of the required part of the digital advertising content is in progress; and
- storing presentation data comprising an indication of the digital advertising content that has been presented in a second memory.

Claim 268 includes similar limitations in a system (means-plus-function) claim.

The above stated ordered combinations of elements cannot be reasonably construed as well-known, conventional, or routine. These features, whether taken alone or in combination, do not resemble claim limitations that the courts have previously found to be well-understood, routine, or conventional. Furthermore, the statement of rejection makes no such assertion. In fact, and on the contrary, the noted claim limitations more closely resemble the combination of elements present in the claims at issue in *DDR Holdings* or in *Bascom v. AT&T*. For example, no court has found that implementing sequencing and adaptively modifying (claims 212, 238, and 271) or sequencing and re-sequencing (claims 243, 267, and 268) of digital media content using software-implemented features that act in response to a user input to cause presentation of a modified user-perceptible content stream with digital advertising positioned differently relative to digital media content compared to an initial position or set of positions relative to the digital media content, or anything similar to it, should be considered to be routine, well known, or conventional.

Furthermore, in *Bascom*, the Federal Circuit has explicitly acknowledged that the mere

ability of a claimed invention to be used in enhancing the execution of a commercial transaction is not dispositive of it being directed to a patent ineligible concept: "the invention in DDR's patent was engineered in the context of retaining potential customers, the invention was not claiming a business method per se, but was instead claiming a technical way to satisfy an existing problem for website hosts and viewers" (emphasis added). Such a distinction is **directly relevant** to the instantly claimed subject matter, which involves a technical way to solve the existing (at the time of the current invention) problem of providing internet-supplied media content with advertising in a manner that allows for arbitrary user-controlled navigation/re-ordering of the content to combat piracy of content while still generating revenue from the advertising.

Furthermore, the subject matter of Claim 212 is closely analogous to the patent eligible subject matter in the recent PTAB Appeal decision in *Ex parte Relyea*, Appeal No. 2017-001443 (April 18, 2018). In *Ex parte Relyea*, the claims at issue were directed to **Internet-based directed-advertising** under circumstances involving broadcast TV and simultaneous chat room participation. *Ex parte Relyea*, p. 2-4.

Claim 1 of the patent at issue recited a method that provides broadcast programming, hosts a chat group, defines a micro-group, **creates a profile** for the micro-group, monitors behavior of the group, **modifies the profile**, **retrieves advertising content** associated with chat group, and **provides advertising content to user devices**. *See id.*

While the Board did not find error in the Examiner's determination that the claims were directed to the abstract idea of "targeting of advertisements to a micro-group of users based on profile data and chat group content," the Board concluded that the claims "**improve[d] the technical field of broadcasting television programs by dynamically integrating targeted advertising content into the television programs that are broadcast to users of the chat group**," (emphasis added) and thus provided "**a detailed level of targeted advertising [that] was not technologically achievable for television broadcasting in the past**" (emphasis added). *Id.* at p. 9-10. The Board further ruled that the claims included limitations "not widely prevalent in the field" that "leverage[d] [the] **real-time behavior of users** in the chat groups **to integrate targeted advertising content into broadcast programming**"; and still further that the claims were "confined to the particular **useful application of integrating targeted advertising content**." *Id.* at p. 10. Thus, the Board reversed the Examiner's §101 rejection under Step 2B.

As noted above, Claim 212 is directed to an approach that improves the **technical field of distributing media content by dynamically integrating targeted advertising content into the digital media content that are presented to users**. Just as claim 1 of *Ex parte Relyea* leverages real-time behavior of users to integrate targeted advertising, the subject matter of Claim 212 leverages user input to deliver "**targeted advertisements** may be interspliced **into an original broadcast presentation in real-time**, thereby providing broadcast programming with promotional material tailored to the preferences, demographics, or other relevant criteria of individual users, in addition to and/or in place of those ads specifically associated with the broadcast media" (emphasis added). *Specification*, ¶0143. The ability to "adaptively regroup and re-sequence the insertion of ad blocks extemporaneously (i.e. "on the fly"), in response to the consumer's arbitrary direction of the playback within the requested content" **was not technologically achievable for media presentation in the past**. The specialized adaptive modification of Claim 212 is also confined to the particular **useful application of integrating targeted advertising content**. Accordingly, just like in *Ex parte Relyea*, the Board should reverse the Examiner's rejection under §101.

Ultimately, Applicant respectfully submits that amended Claim 212 does not recite an abstract idea (step 2A), and, even if amended Claim 212 does recite an abstract idea (which Applicant does not acknowledge), amended Claim 212 amounts to significantly more than the abstract idea itself (step 2B). Therefore, amended Claim 212 is directed to patent-eligible subject matter.

Accordingly, Applicant requests the withdrawal of the rejections of Claim 212 under 35 U.S.C. §101. Independent Claims 238, 243, 267, 268, and 271 likewise recite features similar to at least some of the patent eligible features discussed in connection with Claim 212 above and also define patent-eligible subject matter.

3. Dependent Claims 214-223, 225-237, 239-242, 244-266, 269-270, and 272-273 are allowable over the applied references at least by virtue of their dependency from one of independent Claims 212, 238, 243, 267, 268, or 271.

Dependent Claims 214-223, 225-237, 239-242, 244-266, 269-270, and 272-273 each depend either directly or indirectly on one of independent Claims 212, 238, 243, 267, 268, and 271. Thus, the dependent claims incorporate by reference all the features of their respective

independent claims pursuant to 35 U.S.C. § 112, ¶ 4. In view of the features as recited in the independent claims, and in view of the additional features as recited in the dependent claims, Appellant respectfully submits that the dependent claims define patentable subject matter over the applied references for at least the reasons discussed above, and for their respective additional novel features. Thus, Appellant respectfully submits that dependent Claims 214-223, 225-237, 239-242, 244-266, 269-270, and 272-273 are also patent eligible.

Accordingly, for at least these reasons, reversal of the pending rejection of Claims 214-223, 225-237, 239-242, 244-266, 269-270, and 272-273 under 35 U.S.C. §101 is respectfully requested.

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D. Conclusion

On the basis of the foregoing, Appellant respectfully requests that the Board reverse all of the outstanding rejections of the pending claims, Claims 212, 214-223 and 225-273. It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper.

Enclosed herewith please find the requisite fees for a three-month extension of time. No additional fees are believed to be due. However, the Commissioner is hereby authorized to charge any additional claim fees and any additional fees that may be due, or credit any overpayment of same, to Deposit Account No. 50-0311, Reference No. 42327-501001US. If there are any questions regarding this response, the undersigned may be contacted at the telephone number provided below.

Respectfully submitted,

Dated: July 19, 2018

/mdvl/

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VI. CLAIMS APPENDIX

1–211. (Canceled).

212. (Previously Presented) A method comprising:

receiving, on a client system, data comprising digital media content and digital advertising content;

sequencing the digital media content and the digital advertising content, the sequencing comprising ordering at least some of the digital media content and at least some of the digital advertising content into a user-perceptible content stream, the user-perceptible content stream comprising one or more initially sequenced insertion points at which the digital advertising content is scheduled to be presented relative to the digital media content;

adaptively modifying, using pre-defined rules and in response to a user input detected by the client system, a presentation position of the digital advertising content from at least one of the one or more initially sequenced insertion points to one or more alternatively sequenced insertion points, at least one of the one or more alternatively sequenced insertion points being different than the one or more initially sequenced insertion points relative to the digital media content within the user-perceptible content stream;

causing presentation of the user-perceptible content stream at the client system after the adaptively modifying;

keeping a setting in a first memory to indicate a current state of play, the setting including a value to indicate whether presentation of a required part of the digital advertising content is in progress during presentation of the user-perceptible content stream;

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disallowing a navigation choice that alters a course of playback of the user-perceptible content stream while presentation of the required part of the digital advertising content is in progress; and

storing, in a second memory, presentation data comprising an indication of the digital advertising content that has been presented;

wherein the receiving, the sequencing, the adaptively modifying, the causing, the keeping, the disallowing, and the storing are performed by one or more programmable processors.

213. (Canceled)

214. (Previously Presented) A method as in claim 212, wherein the causing presentation of the user-perceptible content stream on the client system comprises causing display of the user-perceptible content stream by way of a graphical user interface.

215. (Previously Presented) A method as in claim 212, wherein the receiving of the user- input and the adaptively modifying occur during the causing of the presentation of the user-perceptible content stream on the client system.

216. (Previously Presented) A method as in claim 212, wherein the receiving of the user- input and the adaptively modifying occur prior to the causing of the presentation of the user-perceptible content stream on the client system.

217. (Previously Presented) A method as in claim 212, wherein the receiving of the user- input and the adaptively modifying of the presentation position occur subsequent to the causing of the presentation of the user-perceptible content stream on the client system.

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218. (Previously Presented) A method as in claim 212, wherein the sequencing and the adaptively modifying are performed by the client system, which comprises a programmable processor of the one or more programmable processors.

219. (Previously Presented) A method as in claim 212, wherein the pre-defined rules specify the one or more initially sequenced insertion points.

220. (Previously Presented) A method as in claim 212, wherein the pre-defined rules specify the one or more alternatively sequenced insertion points.

221. (Previously Presented) A method as in claim 212, wherein the sequencing and the adaptively modifying are performed by at least one remote system differing from the client system, the at least one remote system comprising a processor of the one or more programmable processors.

222. (Previously Presented) A method as in claim 212, wherein the sequencing is performed by the client system, which comprises a first processor of the one or more programmable processors, and the adaptively modifying is performed by at least one remote system, which comprises a second processor of the one or more programmable processors.

223. (Previously Presented) A method as in claim 212, wherein the adaptively modifying is performed by the client system, which comprises a first processor of the one or more programmable processors, and the sequencing is performed by at least one remote system, which comprises a second processor of the one or more programmable processors.

224. (Canceled)

225. (Previously Presented) A method as in claim 212, wherein the digital media content comprises at least one media file.

226. (Previously Presented) A method as in claim 212, wherein the digital advertising content comprises at least one advertisement file.

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227. (Previously Presented) A method as in claim 226, further comprising: generating a sequence by sub-dividing a media file into two or more segments, and wherein at least a part of the at least one of the advertising file is presented between two of the segments.

228. (Previously Presented) A method as in claim 225, wherein the user input results in a change of a sequence of two or more media files by subtracting an existing media file, or by re-arranging the sequence of media files or results in a change of sequence by adding a new media file.

229. (Previously Presented) A method as in claim 212, wherein the user input comprises one or more navigational choices for the content stream.

230. (Previously Presented) A method as in claim 229, wherein the one or more navigational choices are selected from a group consisting of: play, stop, pause/continue, reverse, rewind, fast-forward, slow-motion, track advance, frame-by-frame advance, go direct to point or page in sequence, advance chapter, page turn, change track, change media selection, shuttle knob, and one or more sound controls.

231. (Previously Presented) A method as in claim 212, wherein the data is received by the client system from at least one remote system.

232. (Previously Presented) A method as in claim 212, wherein the receiving of the data comprises accessing a local data source.

233. (Previously Presented) A method as in claim 212, further comprising: rotating new advertising content into the user-perceptible content stream in response to the user input.

234. (Previously Presented) A method as in claim 212, further comprising: sending, by a remote system to the client system, additional advertising content during presentation of at least the part of the user-perceptible content stream.

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235. (Previously Presented) A method as in claim 212, wherein the pre-defined rules position the advertising content so as to uphold an average content play time.

236. (Previously Presented) A method as in claim 212, wherein the sequencing comprises positioning, according to the pre-defined rules, the digital advertising content based on an amount of media content played during presentation of the content stream.

237. (Previously Presented) A method as in claim 212, wherein the adaptively modifying uses two or more of the pre-defined rules for determining the corresponding presentation position of at least a part of the digital advertising content.

238. (Previously Presented) A method comprising:

transmitting, by at least one remote system to a client system, data comprising digital media content and digital advertising content;

sequencing the digital media content and the digital advertising content, the sequencing comprising ordering at least some of the digital media content and at least some of the digital advertising content into a user-perceptible content stream, the user-perceptible content stream comprising one or more initially sequenced insertion points at which the digital advertising content is scheduled to be presented relative to the digital media content;

adaptively modifying using pre-defined rules and in response to a user input detected by the client system, a presentation position of the digital advertising content from at least one of the one or more initially sequenced insertion points to one or more alternatively sequenced insertion points, at least one of the one or more alternatively sequenced insertion points being different than the one or more initially sequenced insertion points relative to the digital media content within the user-perceptible content stream;

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causing presentation of the user-perceptible content stream at the client system after the adaptively modifying;

keeping a setting in a first memory to indicate a current state of play, the setting including a value to indicate whether presentation of a required part of the digital advertising content is in progress during presentation of the user-perceptible content stream;

disallowing a navigation choice that alters a course of playback of the user-perceptible content stream while presentation of the required part of the digital advertising content is in progress; and

storing, in a second memory, presentation data comprising an indication of the digital advertising content that has been presented;

wherein the transmitting, the sequencing, the adaptively modifying, the causing, the keeping, the disallowing, and the storing are performed by one or more programmable processors.

239. (Previously Presented) A method as in claim 212, wherein the first memory and the second memory are part of the client system.

240. (Previously Presented) A method as in claim 212, wherein the first memory is part of the client system and the second memory is part of at least one remote system.

241. (Previously Presented) A method as in claim 212, wherein the first memory is part of at least one remote system and the second memory is part of the client system.

242. (Previously Presented) A method as in claim 212, wherein the first memory and the second memory are part of at least one remote system.

243. (Previously Presented) A method comprising:

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receiving, on a client system, data comprising digital media content and digital advertising content;

sequencing the digital media content, the sequencing comprising ordering the digital media content into a user-perceptible content stream comprising a media section that comprises at least some of the digital media content, the user perceptible content stream further comprising an advertising block within which at least some of the digital advertising content is scheduled to be presented, the advertising block being arranged within the user-perceptible content stream at an initially defined insertion position relative to the media section;

adaptively re-sequencing the user-perceptible content stream into a modified user-perceptible content stream to reflect a user input detected at the client machine, the modified user-perceptible content stream comprising an alternate insertion position of the advertising block relative to the media section, the alternate insertion position differing from the initially defined insertion position and not having digital advertising content scheduled to be presented in it in the user-perceptible content stream prior to the adaptively re-sequencing, the adaptively re-sequencing comprising determining the alternate insertion position using one or more pre-defined placement rules associated with the digital media content;

causing presentation of the modified user-perceptible content stream at the client system;

keeping a setting in a first memory to indicate a current state of play, the setting including a value to indicate whether presentation of a required part of the digital advertising content is in progress during presentation of the modified user-perceptible content stream;

disallowing a navigation choice that alters a course of playback of the modified user-perceptible content stream while presentation of the required part of the digital advertising content is in progress; and

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storing, in a second memory, presentation data comprising an indication of the digital advertising content that has been presented;

wherein the receiving, the sequencing, the adaptively re-sequencing, the causing, the keeping, the disallowing, and the storing are performed by one or more programmable processors.

244. (Previously Presented) A method as in claim 243, further comprising detecting the user input at the client system.

245. (Previously Presented) A method as in claim 244, wherein the detecting comprises a user interacting with playback controls of player and/or viewer software.

246. (Previously Presented) A method as in claim 243, wherein the user input comprises an arbitrary direction of playback within the user-perceptible content stream.

247. (Previously Presented) A method as in claim 246, wherein the arbitrary direction of playback comprises skipping the media section and/or one or more other media sections that comprise at least some of the digital media content.

248. (Previously Presented) A method as in claim 243, wherein the user input comprises a reordering of the media section and/or one or more other media sections that comprise at least some of the digital media content within the user-perceptible content stream.

249. (Previously Presented) A method as in claim 243, wherein the user input comprises the repositioning of the media section relative to one or more media sections within the user-perceptible content stream.

250. (Previously Presented) A method as in claim 243, wherein the one or more pre-defined placement rules comprise track-count based and/or elapsed time-based logic, and wherein the adaptively re-sequencing comprises determining when to re-schedule the advertising

block into the modified user-perceptible content stream, the determining comprising applying the track-count based and/or elapsed time-based logic.

251. (Previously Presented) A method as in claim 243, wherein the first memory and the second memory are part of the client system.

252. (Previously Presented) A method as in claim 243, wherein the first memory is part of the client system and the second memory is part of at least one remote system.

253. (Previously Presented) A method as in claim 243, wherein the first memory is part of at least one remote system and the second memory is part of the client system.

254. (Previously Presented) A method as in claim 243, wherein the first memory and the second memory are part of at least one remote system.

255. (Previously Presented) A method as in claim 243, wherein the adaptively re-sequencing comprises use of a plurality of the one or more pre-defined placement rules for determining the alternate insertion position for the advertising block.

256. (Previously Presented) A method as in claim 243, further comprising: rotating new advertising content into the user-perceptible content stream in response to the user input.

257. (Previously Presented) A method as in claim 243, wherein the causing presentation of the modified user-perceptible content stream on the client system comprises causing display of the modified user-perceptible content stream by way of a graphical user interface.

258. (Previously Presented) A method as in claim 243, further comprising: causing a first presentation of the user-perceptible content stream on the client system, and wherein the receiving of the user input and the adaptively re-sequencing occur during the first presentation of the user-perceptible content stream on the client system.

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259. (Previously Presented) A method as in claim 243, further comprising: causing a first presentation of the user-perceptible content stream on the client system, and wherein the receiving of the user input and the adaptively re-sequencing occur prior to the first presentation of the user-perceptible content stream on the client system.

260. (Previously Presented) A method as in claim 243 further comprising: causing a first presentation of the user-perceptible content stream on the client system, and wherein the receiving of the user input and the adaptively re-sequencing occur subsequent to the first presentation of the user-perceptible content stream on the client system.

261. (Previously Presented) A method as in claim 243, wherein the pre-defined placement rules specify the initially defined insertion position.

262. (Previously Presented) A method as in claim 243, wherein the pre-defined placement rules specify the alternate insertion position.

263. (Previously Presented) A method as in claim 243, wherein the sequencing and the adaptively re-sequencing are performed by the client system, which comprises a programmable processor of the one or more programmable processors.

264. (Previously Presented) A method as in claim 243, wherein the sequencing and the adaptively modifying are performed by at least one remote system differing from the client system, the at least one remote system comprising a first processor of the one or more programmable processors.

265. (Previously Presented) A method as in claim 243, wherein the sequencing is performed by the client system, which comprises a first processor of the one or more programmable processors, and the adaptively re-sequencing is performed by at least one remote system, which comprises a second processor of the one or more programmable processors.

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266. (Previously Presented) A method as in claim 243, wherein the adaptively re-sequencing is performed by the client system, which comprises a first processor of the one or more programmable processors, and the sequencing is performed by at least one remote system, which comprises a second processor of the one or more programmable processors.

267. (Previously Presented) A method comprising:

transmitting, by at least one remote system to a client system, data comprising digital media content and digital advertising content;

sequencing the digital media content, the sequencing comprising ordering the digital media content into a user-perceptible content stream comprising a media section that comprises at least some of the digital media content, the user perceptible content stream further comprising an advertising block within which at least some of the digital advertising content is scheduled to be presented, the advertising block being arranged within the user-perceptible content stream at an initially defined insertion position relative to the media section;

adaptively re-sequencing the user-perceptible content stream into a modified user-perceptible content stream to reflect a user input detected at the client machine, the modified user-perceptible content stream comprising an alternate insertion position of the advertising block relative to the media section, the alternate insertion position differing from the initially defined insertion position and not having digital advertising content scheduled to be presented in it in the user-perceptible content stream prior to the adaptively re-sequencing, the adaptively re-sequencing comprising determining the alternate insertion position using one or more pre-defined placement rules associated with the digital media content;

causing presentation of the modified user-perceptible content stream at the client system;

keeping a setting in a first memory to indicate a current state of play, the setting including a value to indicate whether presentation of a required part of the digital advertising content is in progress during presentation of the modified user-perceptible content stream;

disallowing a navigation choice that alters a course of playback of the user-perceptible content stream while presentation of the required part of the digital advertising content is in progress; and

storing, in a second memory, presentation data comprising an indication of the digital advertising content that has been presented;

wherein the transmitting, the sequencing, the adaptively re-sequencing, the causing, the keeping, the disallowing, and the storing are performed by one or more programmable processors.

268. A system comprising:

means for causing data comprising digital media content and digital advertising content to be available on a client system;

means for sequencing the digital media content, the sequencing comprising ordering the digital media content into a user-perceptible content stream comprising a media section that comprises at least some of the digital media content, the user perceptible content stream further comprising an advertising block within which at least some of the digital advertising content is scheduled to be presented, the advertising block being arranged within the user-perceptible content stream at an initially defined insertion position relative to the media section;

means for adaptively re-sequencing the user-perceptible content stream into a modified user-perceptible content stream to reflect a user input detected at the client machine, the modified user-perceptible content stream comprising an alternate insertion position of the

advertising block relative to the media section, the alternate insertion position differing from the initially defined insertion position and not having digital advertising content scheduled to be presented in it in the user-perceptible content stream prior to the adaptively re-sequencing, the adaptively re-sequencing comprising determining the alternate insertion position using one or more pre-defined placement rules associated with the digital media content;

means for causing presentation of the modified user-perceptible content stream at the client system;

means for keeping a setting in a first memory to indicate a current state of play, the setting including a value to indicate whether presentation of a required part of the digital advertising content is in progress during presentation of the modified user-perceptible content stream;

means for disallowing a navigation choice that alters a course of playback of the modified user-perceptible content stream while presentation of the required part of the digital advertising content is in progress; and

means for storing, in a second memory, presentation data comprising an indication of the digital advertising content that has been presented.

269. (Previously Presented) A system as in claim 268, wherein the means for causing the data comprising the digital media content and the digital advertising content to be available on the client system comprise means for receiving the data on the client system.

270. (Previously Presented) A system as in claim 268, wherein the means for causing the data comprising the digital media content and the digital advertising content to be available on the client system comprise means for transmitting the data to the client system from at least one remote system.

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271. (Previously Presented) A system comprising:

means for causing data comprising digital media content and digital advertising content to be available on a client system;

means for sequencing the digital media content and the digital advertising content, the sequencing comprising ordering at least some of the digital media content and at least some of the digital advertising content into a user-perceptible content stream, the user-perceptible content stream comprising one or more initially sequenced insertion points at which the digital advertising content is scheduled to be presented relative to the digital media content;

means for adaptively modifying, using pre-defined rules and in response to a user input detected by the client system, a presentation position of the digital advertising content from at least one of the one or more initially sequenced insertion points to one or more alternatively sequenced insertion points, at least one of the one or more alternatively sequenced insertion points being different than the one or more initially sequenced insertion points relative to the digital media content within the user-perceptible content stream;

means for causing presentation of the user-perceptible content stream at the client system after the adaptively modifying;

means for keeping a setting in a first memory to indicate a current state of play, the setting including a value to indicate whether presentation of a required part of the digital advertising content is in progress during presentation of the user-perceptible content stream;

means for disallowing a navigation choice that alters a course of playback of the user-perceptible content stream while presentation of the required part of the digital advertising content is in progress; and

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means for storing, in a second memory, presentation data comprising an indication of the digital advertising content that has been presented.

272. (Previously Presented) A system as in claim 271, wherein the means for causing the data comprising the digital media content and the digital advertising content to be available on the client system comprise means for receiving the data on the client system.

273. (Previously Presented) A system as in claim 271, wherein the means for causing the data comprising the digital media content and the digital advertising content to be available on the client system comprise means for transmitting the data to the client system from at least one remote system.

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PTO/SB/15A (07-14)

CERTIFICATION OF MICRO ENTITY STATUS
(GROSS INCOME BASIS)

Application Number or Control Number (if applicable):	Patent Number (if applicable):
10/606,729	
First Named Inventor:	**Title of Invention:**
Philip Donian	Method and apparatus for the free licensing of digital media content

The applicant hereby certifies the following—

(1) **SMALL ENTITY REQUIREMENT –** The applicant qualifies as a small entity as defined in 37 CFR 1.27.

(2) **APPLICATION FILING LIMIT –** Neither the applicant nor the inventor nor a joint inventor has been named as the inventor or a joint inventor on more than four previously filed U.S. patent applications, excluding provisional applications and international applications under the Patent Cooperation Treaty (PCT) for which the basic national fee under 37 CFR 1.492(a) was not paid, and also excluding patent applications for which the applicant has assigned all ownership rights, or is obligated to assign all ownership rights, as a result of the applicant's previous employment.

(3) **GROSS INCOME LIMIT ON APPLICANTS AND INVENTORS –** Neither the applicant nor the inventor nor a joint inventor, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986 (26 U.S.C. 61(a)), exceeding the "Maximum Qualifying Gross Income" reported on the USPTO Web site at http://www.uspto.gov/patents/law/micro_entity.jsp which is equal to three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census.

(4) **GROSS INCOME LIMIT ON PARTIES WITH AN "OWNERSHIP INTEREST" –** Neither the applicant nor the inventor nor a joint inventor has assigned, granted, or conveyed, nor is under an obligation by contract or law to assign, grant, or convey, a license or other ownership interest in the application concerned to an entity that, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986, exceeding the "Maximum Qualifying Gross Income" reported on the USPTO Web site at http://www.uspto.gov/patents/law/micro_entity.jsp which is equal to three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census.

SIGNATURE by an authorized party set forth in 37 CFR 1.33(b)

Signature	/Paul Brockland/				
Name	Paul S. Brockland on behalf of Michael D. Van Loy				
Date	July 19, 2018	Telephone	(858) 314-1500	Registration No.	61,130

☐ There is more than one inventor and I am one of the inventors who are jointly identified as the applicant. The required additional certification form(s) signed by the other joint inventor(s) are included with this form.

79603961v.1

Electronic Patent Application Fee Transmittal

Application Number:	10606729
Filing Date:	26-Jun-2003
Title of Invention:	Method and apparatus for the free licensing of digital media content
First Named Inventor/Applicant Name:	Philip M. Donian
Filer:	Michael David VanLoy/Maria Provencio
Attorney Docket Number:	42327-501001US

Filed as Micro Entity

Filing Fees for Utility under 35 USC 111(a)

Description	Fee Code	Quantity	Amount	Sub-Total in USD($)
Basic Filing:				
Pages:				
Claims:				
Miscellaneous-Filing:				
Petition:				
Patent-Appeals-and-Interference:				
Post-Allowance-and-Post-Issuance:				
Extension-of-Time:				

Description	Fee Code	Quantity	Amount	Sub-Total in USD($)
Extension - 3 months with $0 paid	3253	1	350	350
Miscellaneous:				
		Total in USD ($)		**350**

Electronic Acknowledgement Receipt	
EFS ID:	33232031
Application Number:	10606729
International Application Number:	
Confirmation Number:	5831
Title of Invention:	Method and apparatus for the free licensing of digital media content
First Named Inventor/Applicant Name:	Philip M. Donian
Customer Number:	64046
Filer:	Michael David VanLoy/Maria Provencio
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The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows:	

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Appeal Brief Filed	42327-501001US_Appeal_Brief.pdf	637409 ea7b0d69f7357853a8db1b3d2737cc1f6e72dc09	no	56
Warnings:					
Information:					
2	Certification of Micro Entity (Gross Income Basis)	42327-501001US_Cert_Micro_Entity.pdf	108825 3f822952016670793e1fb9971d222014857a384a	no	1
Warnings:					
Information:					
3	Fee Worksheet (SB06)	fee-info.pdf	30191 39991d1cc03c7cec9ec2a7786cb6bc8925c05b0f	no	2
Warnings:					
Information:					
		Total Files Size (in bytes):	776425		

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

<u>New Applications Under 35 U.S.C. 111</u>
If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.
<u>National Stage of an International Application under 35 U.S.C. 371</u>
If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.
<u>New International Application Filed with the USPTO as a Receiving Office</u>
If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

Attorney's Docket No.: 42327-501001US
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Philip M. Donian, *et al.*

Application No.: 10/606,729 | Confirmation No.: 5831

Filed: June 26, 2003 | Art Unit: 3688

For: METHOD AND APPARATUS FOR THE FREE LICENSING OF DIGITAL MEDIA CONTENT | Examiner: Yehdega Retta

CORRECTED APPEAL BRIEF

FILED VIA EFS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir or Madam:

In response to the Final Office Action mailed October 12, 2016 (hereinafter "Office Action") and the Pre-Appeal Panel Decision (hereinafter "Panel Decision") mailed on April 2, 2018, Appellant respectfully submits the following remarks for consideration. A first Pre-Appeal Brief Request for Review and a first Notice of Appeal was timely filed on July 2, 2014 along with the appropriate fees. Prosecution of this application was re-opened in response to the Examiner's Answer to the Appeal Brief mailed on August 28, 2015. A second Pre-Appeal Brief Request for Review and a second Notice of Appeal was timely filed on April 4, 2017 relying on the fees paid along with the first Notice of Appeal on July 2, 2014. The Office did not properly address the second Pre-Appeal Brief Request for Review via a Pre-Appeal Conference. Instead, the Office incorrectly issued a notice of abandonment on December 11, 2017 despite never having considered the second Pre-Appeal Brief Request for Review. The notice of abandonment was withdrawn via a *Sua Sponte* Exercise of Supervisory Review on January 29, 2018 and the Panel Decision was finally issued on April 2, 2018. This Appeal Brief is timely filed along with a three-month extension of time and the associated fee.

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F. Independent Claim 271. 14
V. Argument 17
A. The pending claims satisfy the written description requirement under 35 U.S.C. §112, first paragraph because one of ordinary skill in the art would readily understand that the specification teaches the objected-to claim features. 17
B. The pending claims are not obvious under 35 U.S.C. §103(a) because the applied references fail to teach or suggest each and every feature of the claims. 20
1. Knepper does not describe or suggest "at least one of the one or more alternatively sequenced insertion points being different than the one or more initially sequenced insertion points relative to the digital media content of" independent Claim 212 or the corresponding features of Claims 238, 243, 267, 268, and 271 21
2. Dependent Claims 214-223, 225-237, 239-242, 244-266, 269-270, and 272-273 are allowable over the applied references at least by virtue of their dependency from one of independent Claims 212, 238, 243, 267, 268, or 271. 28
C. The pending claims are directed to patent eligible subject matter because they are not directed to an abstract idea, and even if they were, the pending claims provide significantly more than the abstract idea itself. 28
1. Step 2A: the pending claims do not recite an abstract idea because they are inextricably tied to computer technology and distinct from the types of concepts found by the courts to be abstract 30
2. Step 2B: the pending claims add significantly more to an abstract idea 33
3. Dependent Claims 214-223, 225-237, 239-242, 244-266, 269-270, and 272-273 are allowable over the applied references at least by virtue of their dependency from one of independent Claims 212, 238, 243, 267, 268, or 271. 39
D. Conclusion 6
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I. REAL PARTY IN INTEREST

Piranha Media Distribution, Inc. is the real party in interest as the owner of the above-identified application by virtue of an assignment from the inventors.

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II. RELATED APPEALS AND INTERFERENCES

There are currently no other appeals or interferences, of which Appellant, Appellant's legal representative, or Assignee are aware, that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

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III. STATUS OF CLAIMS

In the Office Action, the Office rejected claims 212, 214-223 and 225-273 under 35 U.S.C. §112, first paragraph as allegedly failing to comply with the written description requirement; claims 212, 214-223 and 225-273 under 35 U.S.C. §101 as allegedly being drawn to non-statutory subject matter; and claims 212, 214-223, 225-232, 234-249, 251-255 and 257-273 under 35 U.S.C. §103(a) as allegedly being unpatentably obvious over Knepper et al., Patent Application Publication No. 2001/0042249 ("Knepper") in view of Hannah et al., U.S. Patent No. 7,761,327 ("Hannah") and further in view of Wang, Patent Application Publication No. 2002/0191950 ("Wang").

Appellant appeals the final rejections of independent Claims 212, 238, 243, 267, 268, and 271. All of the remaining, pending dependent claims depend at least indirectly from one of Claims 212, 238, 243, 267, 268, and 271, and are therefore patentable subject to the outcome of this appeal.

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IV. SUMMARY OF CLAIMED SUBJECT MATTER

In accordance with 37 C.F.R. § 41.37(c)(1)(iii), Appellant provides a brief summary of each independent claim involved in the appeal. Each summary refers to the specification in the record by page and line number and to the drawings by reference number. Appellant notes that this summary is provided only to assist the Board in identifying portions of the specification related to the particular claims. In the interest of brevity, each claim summary does not necessarily include all references to all relevant portions of the specifications and drawings. Accordingly, omission of any reference to the specification or to the drawings should not be construed in any way as an intent to relinquish claim scope or term, or as an implication or statement regarding conformance with 35 U.S.C. §112. Appellant respectfully submits that the claims should not be construed as being limited to the embodiments described or referenced in any claim summary, and that other embodiments, as well as the Doctrine of Equivalents, may apply in determining claim scope.

A. Independent Claim 212.

Claim 212 is a method claim including receiving, on a client system, data comprising digital media content and digital advertising content (*see e.g.*, specification pg. 9, lines 28-30; pg. 10, lines 1-2, and 29-31; pg. 11, lines 1-4; pg. 20, lines 30-31; pg. 21, lines 1-21; pg. 25, lines 27-30; pg. 26, lines 1-2, and 26-30; FIGs. 1, 2, 4A, 4B, 11C). The method further includes sequencing the digital media content and the digital advertising content (*see e.g.*, specification pg. 25, lines 27-30; pg. 26, lines 1-2, and 26-30; pg. 27, lines 1-2, and 11-21; FIG. 4A, 4B), the sequencing comprising ordering at least some of the digital media content and at least some of the digital advertising content into a user-perceptible content stream, (*see e.g.*, specification pg. 20, lines 30-31; pg. 21, lines 1-21; pg. 27, lines 11-21; pg. 32, lines 21-29; FIG. 4A, 4B) the user-perceptible content stream comprising one or more initially sequenced insertion points at which the digital advertising content is scheduled to be presented relative to the digital media content (*see e.g.*, specification pg. 21, lines 1-21; pg. 28, lines 1-31; pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; FIG. 4A, 4B.). The method further includes adaptively modifying, using pre-defined rules and in response to a user input detected by the client system, (*see e.g.*, specification pg. 29, lines 17-22; pg. 33, lines 13-21; pg. 39, lines 9-14; pg. 40, lines 1-6; pg. 42, lines 22-31, pg. 43, lines 1-30, pg. 44, lines 1-31, pg. 45, lines 1-31, pg. 46, lines 1-30, pg. 47, lines 1-16; pg. 49, lines

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1-6, and 19-27; pg. 50, lines 10-15) a presentation position of the digital advertising content from at least one of the one or more initially sequenced insertion points to one or more alternatively sequenced insertion points, at least one of the one or more alternatively sequenced insertion points being different than the one or more initially sequenced insertion points relative to the digital media content within the user-perceptible content stream (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The method further includes causing presentation of the user-perceptible content stream at the client system after the adaptively modifying (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The method further includes keeping a setting in a first memory to indicate a current state of play, the setting including a value to indicate whether presentation of a required part of the digital advertising content is in progress during presentation of the user-perceptible content stream (*see e.g.*, specification, pg. 32, lines 1-31; pg. 33, lines 1 – 31; pg. 34, lines 1-20; pg. 40, lines 1-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 53, lines 7-27; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The method further includes disallowing a navigation choice that alters a course of playback of the user-perceptible content stream while presentation of the required part of the digital advertising content is in progress (*see e.g.*, specification, pg. 34, lines 1-20; pg. 48, lines 20-30; pg. 49, lines 1-6; FIGs. 4A, 5A, 7A, 7B). The method further includes storing, in a second memory, presentation data comprising an indication of the digital advertising content that has been presented (*see e.g.*, specification, pg. 11, lines 1-4; pg. 16, lines 4 – 12; pg. 34, lines 1-20; pg. 40, lines 1-31, pg. 41, lines 1-31; pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D), wherein the receiving, the sequencing, the adaptively modifying, the causing, the keeping, the disallowing, and the storing are performed by one or more programmable processors (*see e.g.*, specification, pg. 17, lines 20-26; pg. 32, lines 12-15; FIG. 2).

B. Independent Claim 238.

Claim 238 is a method including transmitting, by at least one remote system to a client system, data comprising digital media content and digital advertising content (*see e.g.*, specification pg. 9, lines 28-30; pg. 10, lines 1-2, and 29-31; pg. 11, lines 1-4; pg. 20, lines 30-31; pg. 21, lines 1-21; pg. 25, lines 27-30; pg. 26, lines 1-2, and 26-30; FIGs. 1, 2, 4A, 4B, 11C). The method further includes sequencing the digital media content and the digital advertising content (*see e.g.*, specification pg. 25, lines 27-30; pg. 26, lines 1-2, and 26-30; pg. 27, lines 1-2, and 11-21; FIG. 4A, 4B), the sequencing comprising ordering at least some of the digital media content and at least some of the digital advertising content into a user-perceptible content stream, (*see e.g.*, specification pg. 20, lines 30-31; pg. 21, lines 1-21; pg. 27, lines 11-21; pg. 32, lines 21-29; FIG. 4A, 4B) the user-perceptible content stream comprising one or more initially sequenced insertion points at which the digital advertising content is scheduled to be presented relative to the digital media content (*see e.g.*, specification pg. 21, lines 1-21; pg. 28, lines 1-31; pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; FIG. 4A, 4B). The method further includes adaptively modifying, using pre-defined rules and in response to a user input detected by the client system, (*see e.g.*, specification pg. 29, lines 17-22; pg. 33, lines 13-21; pg. 39, lines 9-14; pg. 40, lines 1-6; pg. 42, lines 22-31, pg. 43, lines 1-30, pg. 44, lines 1-31, pg. 45, lines 1-31, pg. 46, lines 1-30, pg. 47, lines 1-16; pg. 49, lines 1-6, and 19-27; pg. 50, lines 10-15; FIG. 4A, 4B) a presentation position of the digital advertising content from at least one of the one or more initially sequenced insertion points to one or more alternatively sequenced insertion points, at least one of the one or more alternatively sequenced insertion points being different than the one or more initially sequenced insertion points relative to the digital media content within the user-perceptible content stream (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The method further includes causing presentation of the user-perceptible content stream at the client system after the adaptively modifying (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The method further includes keeping a setting in a first memory to indicate a current state of play, the setting including a value to indicate whether

presentation of a required part of the digital advertising content is in progress during presentation of the user-perceptible content stream (*see e.g.*, specification, pg. 32, lines 1-31; pg. 33, lines 1 – 31; pg. 34, lines 1-20; pg. 40, lines 1-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 53, lines 7-27; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The method further includes disallowing a navigation choice that alters a course of playback of the user-perceptible content stream while presentation of the required part of the digital advertising content is in progress (*see e.g.*, specification, pg. 34, lines 1-20; pg. 48, lines 20-30; pg. 49, lines 1-6; FIGs. 4A, 5A, 7A, 7B). The method further includes storing, in a second memory, presentation data comprising an indication of the digital advertising content that has been presented (*see e.g.*, specification, pg. 11, lines 1-4; pg. 16, lines 4 – 12; pg. 34, lines 1-20; pg. 40, lines 1-31, pg. 41, lines 1-31; pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D), wherein the receiving, the sequencing, the adaptively modifying, the causing, the keeping, the disallowing, and the storing are performed by one or more programmable processors (*see e.g.*, specification, pg. 17, lines 20-26; pg. 32, lines 12-15; FIG. 2).

C. Independent Claim 243.

Claim 243 is directed to a method including receiving, on a client system, data comprising digital media content and digital advertising content (*see e.g.*, specification pg. 9, lines 28-30; pg. 10, lines 1-2, and 29-31; pg. 11, lines 1-4; pg. 20, lines 30-31; pg. 21, lines 1-21; pg. 25, lines 27-30; pg. 26, lines 1-2, and 26-30; FIGs. 1, 2, 4A, 4B, 11C). The method further includes sequencing the digital media content (*see e.g.*, specification pg. 25, lines 27-30; pg. 26, lines 1-2, and 26-30; pg. 27, lines 1-2, and 11-21; FIG. 4A, 4B), the sequencing comprising ordering the digital media content into a user-perceptible content stream comprising a media section that comprises at least some of the digital media content, the user perceptible content stream further comprising an advertising block within which at least some of the digital advertising content is scheduled to be presented (*see e.g.*, specification pg. 25, lines 27-30; pg. 26, lines 1-2, and 26-30; pg. 27, lines 1-2, and 11-21; FIG. 4A, 4B), the advertising block being arranged within the user-perceptible content stream at an initially defined insertion position relative to the media section (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54,

lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The method further includes adaptively re-sequencing the user-perceptible content stream into a modified user-perceptible content stream to reflect a user input detected at the client machine (*see e.g.*, specification pg. 29, lines 17-22; pg. 33, lines 13-21; pg. 39, lines 9-14; pg. 40, lines 1-6; pg. 42, lines 22-31, pg. 43, lines 1-30, pg. 44, lines 1-31, pg. 45, lines 1-31, pg. 46, lines 1-30, pg. 47, lines 1-16; pg. 49, lines 1-6, and 19-27; pg. 50, lines 10-15; FIG. 4A, 4B), the modified user-perceptible content stream comprising an alternate insertion position of the advertising block relative to the media section, the alternate insertion position differing from the initially defined insertion position and not having digital advertising content scheduled to be presented in it in the user-perceptible content stream prior to the adaptively re-sequencing (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D), the adaptively re-sequencing comprising determining the alternate insertion position using one or more pre-defined placement rules associated with the digital media content (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The method further includes causing presentation of the modified user-perceptible content stream at the client system (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The method further includes keeping a setting in a first memory to indicate a current state of play, the setting including a value to indicate whether presentation of a required part of the digital advertising content is in progress during presentation of the modified user-perceptible content stream (*see e.g.*, specification, pg. 32, lines 1-31; pg. 33, lines 1 – 31; pg. 34, lines 1-20; pg. 40, lines 1-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 53, lines 7-27; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The method further includes disallowing a navigation choice that alters a course of playback of the modified user-perceptible content stream while presentation of the required part of the digital advertising content is in

progress (*see e.g.*, specification, pg. 34, lines 1-20; pg. 48, lines 20-30; pg. 49, lines 1-6; FIGs. 4A, 5A, 7A, 7B). The method further includes storing, in a second memory, presentation data comprising an indication of the digital advertising content that has been presented (*see e.g.*, specification, pg. 11, lines 1-4; pg. 16, lines 4 – 12; pg. 34, lines 1-20; pg. 40, lines 1-31, pg. 41, lines 1-31; pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D), wherein the receiving, the sequencing, the adaptively re-sequencing, the causing, the keeping, the disallowing, and the storing are performed by one or more programmable processors (*see e.g.*, specification, pg. 17, lines 20-26; pg. 32, lines 12-15; FIG. 2).

D. Independent Claim 267.

Claim 267 is directed to a method including transmitting, by at least one remote system to a client system, data comprising digital media content and digital advertising content (*see e.g.*, specification pg. 9, lines 28-30; pg. 10, lines 1-2, and 29-31; pg. 11, lines 1-4; pg. 20, lines 30-31; pg. 21, lines 1-21; pg. 25, lines 27-30; pg. 26, lines 1-2, and 26-30; FIGs. 1, 2, 4A, 4B, 11C). The method further includes sequencing the digital media content (*see e.g.*, specification pg. 25, lines 27-30; pg. 26, lines 1-2, and 26-30; pg. 27, lines 1-2, and 11-21; FIG. 4A, 4B), the sequencing comprising ordering the digital media content into a user-perceptible content stream comprising a media section that comprises at least some of the digital media content, the user perceptible content stream further comprising an advertising block within which at least some of the digital advertising content is scheduled to be presented (*see e.g.*, specification pg. 25, lines 27-30; pg. 26, lines 1-2, and 26-30; pg. 27, lines 1-2, and 11-21; FIG. 4A, 4B), the advertising block being arranged within the user-perceptible content stream at an initially defined insertion position relative to the media section (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The method further includes adaptively re-sequencing the user-perceptible content stream into a modified user-perceptible content stream to reflect a user input detected at the client machine (*see e.g.*, specification pg. 29, lines 17-22; pg. 33, lines 13-21; pg. 39, lines 9-14; pg. 40, lines 1-6; pg. 42, lines 22-31, pg. 43, lines 1-30, pg. 44, lines 1-31, pg. 45, lines 1-31, pg. 46, lines 1-30, pg. 47, lines 1-16; pg. 49, lines 1-6, and 19-27; pg. 50, lines 10-15; FIG. 4A, 4B), the modified user-perceptible content stream

comprising an alternate insertion position of the advertising block relative to the media section, the alternate insertion position differing from the initially defined insertion position and not having digital advertising content scheduled to be presented in it in the user-perceptible content stream prior to the adaptively re-sequencing (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D), the adaptively re-sequencing comprising determining the alternate insertion position using one or more pre-defined placement rules associated with the digital media content (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The method further includes causing presentation of the modified user-perceptible content stream at the client system (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The method further includes keeping a setting in a first memory to indicate a current state of play, the setting including a value to indicate whether presentation of a required part of the digital advertising content is in progress during presentation of the modified user-perceptible content stream (*see e.g.*, specification, pg. 32, lines 1-31; pg. 33, lines 1 – 31; pg. 34, lines 1-20; pg. 40, lines 1-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 53, lines 7-27; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The method further includes disallowing a navigation choice that alters a course of playback of the modified user-perceptible content stream while presentation of the required part of the digital advertising content is in progress (*see e.g.*, specification, pg. 34, lines 1-20; pg. 48, lines 20-30; pg. 49, lines 1-6; FIGs. 4A, 5A, 7A, 7B). The method further includes storing, in a second memory, presentation data comprising an indication of the digital advertising content that has been presented (*see e.g.*, specification, pg. 11, lines 1-4; pg. 16, lines 4 – 12; pg. 34, lines 1-20; pg. 40, lines 1-31, pg. 41, lines 1-31; pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D), wherein the transmitting, the sequencing, the adaptively re-sequencing, the causing, the keeping, the

disallowing, and the storing are performed by one or more programmable processors (*see e.g.*, specification, pg. 17, lines 20-26; pg. 32, lines 12-15; FIG. 2).

E. Independent Claim 268.

Claim 268 is directed to a system. The system including means for causing data comprising digital media content and digital advertising content to be available on a client system (*see e.g.*, specification pg. 9, lines 28-30; pg. 10, lines 1-2, and 29-31; pg. 11, lines 1-4; pg. 20, lines 30-31; pg. 21, lines 1-21; pg. 25, lines 27-30; pg. 26, lines 1-2, and 26-30; FIGs. 1, 2, 4A, 4B, 11C). The system further includes means for sequencing the digital media content (*see e.g.*, specification pg. 25, lines 27-30; pg. 26, lines 1-2, and 26-30; pg. 27, lines 1-2, and 11-21; FIG. 4A, 4B), the sequencing comprising ordering the digital media content into a user-perceptible content stream comprising a media section that comprises at least some of the digital media content, the user perceptible content stream further comprising an advertising block within which at least some of the digital advertising content is scheduled to be presented (*see e.g.*, specification pg. 25, lines 27-30; pg. 26, lines 1-2, and 26-30; pg. 27, lines 1-2, and 11-21; FIG. 4A, 4B), the advertising block being arranged within the user-perceptible content stream at an initially defined insertion position relative to the media section (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The system further includes means for adaptively re-sequencing the user-perceptible content stream into a modified user-perceptible content stream to reflect a user input detected at the client machine (*see e.g.*, specification pg. 29, lines 17-22; pg. 33, lines 13-21; pg. 39, lines 9-14; pg. 40, lines 1-6; pg. 42, lines 22-31, pg. 43, lines 1-30, pg. 44, lines 1-31, pg. 45, lines 1-31, pg. 46, lines 1-30, pg. 47, lines 1-16; pg. 49, lines 1-6, and 19-27; pg. 50, lines 10-15; FIG. 4A, 4B), the modified user-perceptible content stream comprising an alternate insertion position of the advertising block relative to the media section, the alternate insertion position differing from the initially defined insertion position and not having digital advertising content scheduled to be presented in it in the user-perceptible content stream prior to the adaptively re-sequencing (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41,

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lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D), the adaptively re-sequencing comprising determining the alternate insertion position using one or more pre-defined placement rules associated with the digital media content (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The system further includes means for causing presentation of the modified user-perceptible content stream at the client system (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The system further includes means for keeping a setting in a first memory to indicate a current state of play, the setting including a value to indicate whether presentation of a required part of the digital advertising content is in progress during presentation of the modified user-perceptible content stream (*see e.g.*, specification, pg. 32, lines 1-31; pg. 33, lines 1 – 31; pg. 34, lines 1-20; pg. 40, lines 1-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 53, lines 7-27; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The system further includes means for disallowing a navigation choice that alters a course of playback of the modified user-perceptible content stream while presentation of the required part of the digital advertising content is in progress (*see e.g.*, specification, pg. 34, lines 1-20; pg. 48, lines 20-30; pg. 49, lines 1-6; FIGs. 4A, 5A, 7A, 7B). The system further includes means for storing, in a second memory, presentation data comprising an indication of the digital advertising content that has been presented (*see e.g.*, specification, pg. 11, lines 1-4; pg. 16, lines 4 – 12; pg. 34, lines 1-20; pg. 40, lines 1-31, pg. 41, lines 1-31; pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D).

F. Independent Claim 271.

Claim 271 is directed to a system. The system including means for causing data comprising digital media content and digital advertising content to be available on a client system (*see e.g.*, specification pg. 9, lines 28-30; pg. 10, lines 1-2, and 29-31; pg. 11, lines 1-4; pg. 20, lines 30-31; pg. 21, lines 1-21; pg. 25, lines 27-30; pg. 26, lines 1-2, and 26-30; FIGs. 1, 2, 4A, 4B, 11C). The

system further includes means for sequencing the digital media content and the digital advertising content (*see e.g.*, specification pg. 25, lines 27-30; pg. 26, lines 1-2, and 26-30; pg. 27, lines 1-2, and 11-21; FIG. 4A, 4B), the sequencing comprising ordering at least some of the digital media content and at least some of the digital advertising content into a user-perceptible content stream, (*see e.g.*, specification pg. 20, lines 30-31; pg. 21, lines 1-21; pg. 27, lines 11-21; pg. 32, lines 21-29; FIG. 4A, 4B) the user-perceptible content stream comprising one or more initially sequenced insertion points at which the digital advertising content is scheduled to be presented relative to the digital media content (*see e.g.*, specification pg. 21, lines 1-21; pg. 28, lines 1-31; pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; FIG. 4A, 4B). The system further includes means for adaptively modifying, using pre-defined rules and in response to a user input detected by the client system, (*see e.g.*, specification pg. 29, lines 17-22; pg. 33, lines 13-21; pg. 39, lines 9-14; pg. 40, lines 1-6; pg. 42, lines 22-31, pg. 43, lines 1-30, pg. 44, lines 1-31, pg. 45, lines 1-31, pg. 46, lines 1-30, pg. 47, lines 1-16; pg. 49, lines 1-6, and 19-27; pg. 50, lines 10-15) a presentation position of the digital advertising content from at least one of the one or more initially sequenced insertion points to one or more alternatively sequenced insertion points, at least one of the one or more alternatively sequenced insertion points being different than the one or more initially sequenced insertion points relative to the digital media content within the user-perceptible content stream (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The system further includes means for causing presentation of the user-perceptible content stream at the client system after the adaptively modifying (*see e.g.*, specification pg. 10, lines 29-31, pg. 11, lines 1-4; pg. 21, lines 12-21; pg. 28, lines 1 -31, pg. 29, lines 1-31, pg. 30, lines 1-30, pg. 31, lines 1-19; pg. 33, lines 13 – 31; pg. 34, lines 1-5; pg. 40, lines 28-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D). The system further includes means for keeping a setting in a first memory to indicate a current state of play, the setting including a value to indicate whether presentation of a required part of the digital advertising content is in progress during presentation of the user-perceptible content stream (*see e.g.*, specification, pg. 32, lines 1-31; pg. 33, lines 1 – 31; pg. 34, lines 1-20; pg. 40, lines 1-31, pg. 41, lines 1-12; pg. 44, lines 3-14; pg. 47, lines 7-16, pg. 50, lines 10-15; pg. 53, lines 7-27; pg. 54, lines 4-14; FIGs. 4A,

6A, 6B, 7A, 7B, 8C, 8D). The system further includes means for disallowing a navigation choice that alters a course of playback of the user-perceptible content stream while presentation of the required part of the digital advertising content is in progress (*see e.g.*, specification, pg. 34, lines 1-20; pg. 48, lines 20-30; pg. 49, lines 1-6; FIGs. 4A, 5A, 7A, 7B). The system further includes means for storing, in a second memory, presentation data comprising an indication of the digital advertising content that has been presented (*see e.g.*, specification, pg. 11, lines 1-4; pg. 16, lines 4 – 12; pg. 34, lines 1-20; pg. 40, lines 1-31, pg. 41, lines 1-31; pg. 50, lines 10-15; pg. 54, lines 4-14; FIGs. 4A, 6A, 6B, 7A, 7B, 8C, 8D).

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V. ARGUMENT

Appellant respectfully submits that the claim feature relating to "at least one of the alternatively sequenced insertion points being different from the one or more initially sequenced insertion points," is fully supported by the original specification and figures. References cited below are to the published application for convenience. Applicant submits that the references find support in the originally filed application, and can provide references thereto if the Board so desires. One of ordinary skill in the art would clearly understand that the inventor was in possession of the claimed invention at the time of filing at least through the portions of the specification and figures described herein. As such, Appellant respectfully requests the reversal of the rejections of the claims under 35 U.S.C. §112.

Appellant respectfully submits that the applied references, either alone or in combination, fail to describe or suggest at least "**adaptively modifying** using pre-defined rules and **in response to a user input detected by the client system, a presentation position of the digital advertising content** from at least one of the one or more initially sequenced insertion points to one or more alternatively sequenced insertion points, at least one of the one or more **alternatively sequenced insertion points being different than the one or more initially sequenced insertion points relative to the digital media content** within the user-perceptible content stream." As such, Appellant respectfully requests the reversal of the rejections of the claims under 35 U.S.C. §103(a).

Applicant submits the recent USPTO memorandum dated April 2, 2018, from Robert W. Bahr ("April 2018 Memo"), the April 2018 *Core Wireless* Federal Circuit case, *Ex parte Relyea*, as well as the remarks below, demonstrate that Claim 212 does not recite an abstract idea (step 2A), and, even if Claim 212 does recite an abstract idea (which Applicant does not acknowledge), Claim 212 amounts to significantly more than the abstract idea itself (step 2B). As such, Appellant respectfully requests the reversal of the rejections of the claims under 35 U.S.C. §101.

The Applicant's representative discussed these issues with the Examiner during an Interview on November 8, 2016 ("the Interview"), and although she agreed to consult with her colleagues and to follow up with the undersigned, she has not provided further feedback.

A. The pending claims satisfy the written description requirement under 35 U.S.C. §112, first paragraph because one of ordinary skill in the art would readily understand that the specification teaches the objected-to claim features.

Claims 212, 214-223 and 225-273 stand rejected under 35 U.S.C. §112, first paragraph, because the Office alleges that the claims lack written description. *Office Action*, p. 4. The rejections of the independent claims under 35 U.S.C. §112, first paragraph are based on the Examiner's incorrect assertion that the original specification fails to provide the necessary written description support for the claim feature relating to "at least one of the alternatively sequenced insertion points being different from the one or more initially sequenced insertion points," which was added by amendment in the Response filed August 1, 2016 ("the previous Response"). As a first point, the allegedly unsupported features were first added to the claims in the paper filed October 28, 2015, albeit in slightly different form, to address a rejection under 35 U.S.C. §112, first paragraph raised in the Final Office Action mailed May 1, 2014. The Examiner withdrew the rejection in the Non-Final Office Action mailed February 1, 2016, but now has repeated it for reasons the Applicant does not understand.

Furthermore, the Examiner has clearly failed to apply the proper standard for a rejection under 35 U.S.C. §112, first paragraph. As stated in MPEP §2163.02: the objective standard for determining compliance with the written description requirement is, "does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed."[1] To satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed. If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met.[2] Furthermore, as stated in MPEP §2163.07, "mere rephrasing of a passage does not constitute new matter," and "a rewording of a passage where the same meaning remains intact is permissible."[3]

Further, to make a *prima facie* case, **the Examiner has the initial burden of presenting evidence or reasoning** to explain why persons skilled in the art would not recognize in the

[1] See, *e.g. In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Under *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).
[2] See, *e.g.*, *Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d at 1116; and *Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972) (stating "the description need not be *in ipsis verbis* [i.e., "in the same words"] to be sufficient").
[3] See, *e.g. In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973).

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disclosure a description of the invention defined by the claim, and to explain why the claim is not fully supported by the disclosure (emphasis added). *MPEP* 2163.04. Instead of providing evidence or reasoning, the Examiner has simply alleged "Examiner could not find a [*sic*] support for the following claim language." *Office Action*, p. 5. Accordingly, the Examiner has not satisfied her burden of proof for establishing a *prima facie* case that one of ordinary skill in the art would not have been able to recognize that the inventors invented the subject matter recited in Claim 212. As such, the rejection under U.S.C. §112, first paragraph that Claim 212 allegedly fails to satisfy the written description requirement is improper and should be withdrawn.

As discussed during the Interview, the Examiner appears to have merely searched the specification for explicit textual support without properly determining what a skilled artisan would have understood the inventors to have been in possession of at the time of filing. Had the Examiner performed the proper analysis, she would have readily noted that the claim feature at issue in this rejection is well-supported at least by ¶0149-¶0150, and also at ¶0154-¶0156, referring to FIG. 4A.

In ¶0149, the instant specification describes a situation in which "the user of sequence 402 jumps right into segment 434 as segment 430 is just starting" in which case "the player/viewer will begin segment 434 at its point of entry, followed at its end by ad block 412." In this case, the digital advertising content plays at "one of the one or more initial insertion points." In contrast, in ¶0150, "the user has watched 80% of segment 432, and then jumps into the middle of segment 434," which results in "ad block 410 play[ing] immediately, and when it is finished, content play resum[ing] at the point selected in segment 434." In the scenario described in ¶0150, ad block 410 is played at a point immediately preceding "the middle of segment 434," which is an "alternate insertion point" that is clearly "different than the one or more initially sequenced insertion points relative to the digital media content within the user-perceptible content stream," which would, in this example, be those insertion points originally scheduled to occur between the segments.

At ¶0154-¶0156, the instant specification provides further support for the claim feature at issue, this time in reference to an example (illustrated as sequence 404 in FIG. 4A) of a "track allowance method for ad placement." ¶0154 states that in "regular play without skipping around or other navigation, sequence 404 begins by playing tracks 440, 442, 444, 446, and 448 in series, followed by ad block 414, and then tracks 450, 452, 454, and 456" and that ad block 416 comes after track 456, "followed by tracks 458, 460, and 462." In ¶0156, "[i]f the user decides to play track 446 and then track 456, the program does not insert ad block 416 immediately after track

456. Instead, play goes directly into track 458, because the allowance is 5 tracks. If the user plays through most of track 458, then jumps to the beginning of track 442 and plays it, there is still allowance for one more track after that, since only four tracks (446, 456, 458, and 442) have played so far." In other words, ad blocks 414 and 416 are initially sequenced after tracks 448 and 456, respectively, but in response to the user "skipping around or other navigation," ad block insertions wind up at different positions relative to those tracks to comply with pre-defined placement rules (which in this example are track count rules).

One of ordinary skill in the art would clearly understand that the movement of an ad block insertion location originally scheduled to follow track 448 and precede track 450 but instead being played at a different location that was not an initially scheduled insertion point provides clear support sufficient to satisfy the requirements of 35 U.S.C. §112, first paragraph. Claims 212, 238, 243, 267, 268, and 271 therefore satisfy the written description requirement. Claims 214-223, 225-237, 239-242, 244-266, 269-270, and 272-273 stand rejected for their dependency on a rejected basis, and are not separately rejected. As such, Claims 214-223, 225-237, 239-242, 244-266, 269-270 also comply with the written description requirement. For at least these reasons, these rejections should be withdrawn.

B. The pending claims are not obvious under 35 U.S.C. §103(a) because the applied references fail to teach or suggest each and every feature of the claims.

Claims 212, 214-223 and 225-273 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentably obvious over Knepper in view of Hannah and further in view of Wang. *Office Action*, p. 7. Appellant respectfully disagrees, and respectfully requests the reversal of the rejections of Claims 212, 214-223 and 225-273 for at least the reasons discussed herein.

The burden of establishing a proper *prima facie* basis upon which to reject claimed subject matter as unpatentably obvious lies with the Office. MPEP § 2143. In order to establish a proper *prima facie* basis, the Office must present a clear and explicit rationale supporting the assertion that all of the claimed elements were known in the prior art, and that one skilled in the art would have combined the claimed elements by known methods, with no change in their respective functions, to produce a combination yielding nothing more than predictable results. *Id.*; *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 416 and 419 (quoting with approval *In re Kahn,* 441 F.3d 977, 988 (C.A. Fed. 2006)). In judging the patentability of the claims against the prior

art, all words in a claim must be considered. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970); MPEP § 2143.03.

Furthermore, "[t]o support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP §706.02(j) (quoting *Ex Parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)).

Appellant respectfully submits that the Examiner has failed to establish a proper *prima facie* case of obviousness under 35 U.S.C. §103(a).

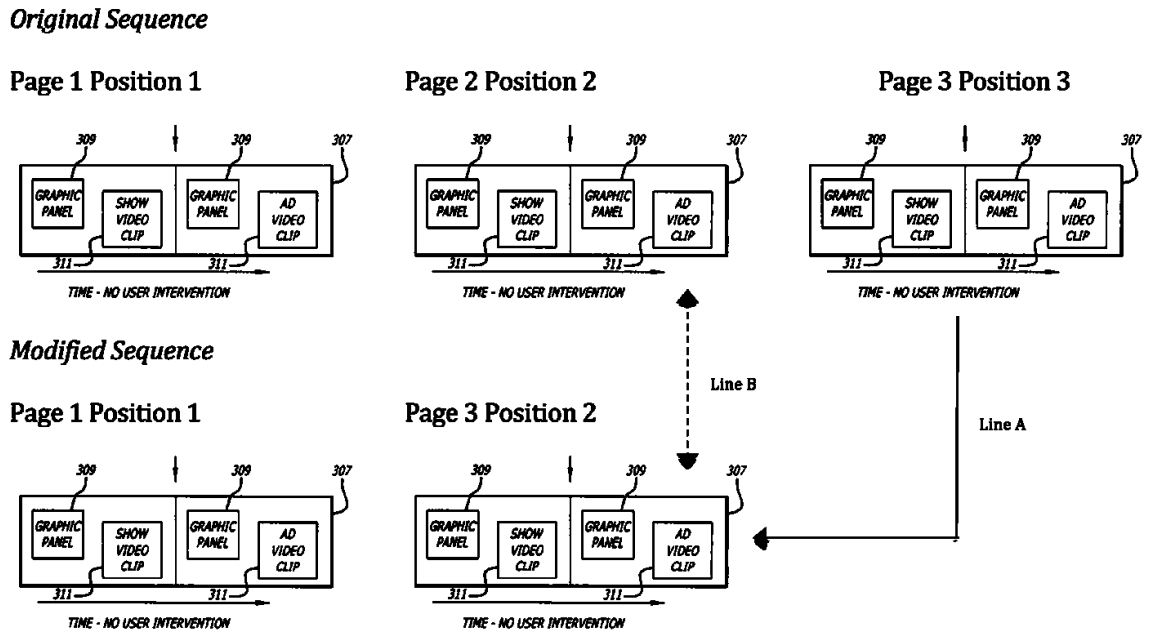
1. **Knepper does not describe or suggest "at least one of the one or more alternatively sequenced insertion points being different than the one or more initially sequenced insertion points relative to the digital media content of" independent Claim 212 or the corresponding features of Claims 238, 243, 267, 268, and 271.**

As discussed with the Examiner during the Interview, the statement of the rejections under 35 USC §103 reflects clear error, at least because a) it ignores explicit limitations of the claims and b) the cited references clearly do not describe or suggest all of the features of the independent claims.

As a first point, the Examiner has explicitly acknowledged on the record (see the Final Office Action mailed May 1, 2014 at page 15) that Knepper does not teach "at least one of the advertisement files is presented in a different position relative to the media files." The specific wording of this limitation has been slightly modified relative to what was pending at the time of this Final Office Action to make it abundantly clear what is being claimed. Despite Applicant's repeated attempts to clarify the claimed subject matter, the Examiner continues to muddle the issue, specifically with her statement of the reasons for rejection on page 8 of the current Office Action, where she alleges that "[s]ame as applicant's disclosure, the advertisement and the media of Knepper which were sequenced to be played in a predefined order, when the user skips or forwards to a different music (e.g. to a third media in the sequence after playing the first media in the sequence), the ad appended to the media (third media) would also be played as a second in the sequence (the media and ad combination) instead of the ad appended to the second media in the sequence (playlist)." The rationale for this incorrect assertion relies on a re-statement of how a

Knepper presentation clip page is constructed (citing ¶0062 as it relates to FIG. 7) and an alleged equality with descriptions in the instant specification. *Office Action*, p. 8. However, as discussed further below, the Knepper description directly contradicts the claimed subject matter, particularly the claim features in which an alternate insertion point (that differs from any initial insertion point) relative to digital media is used in response to user input that causes the adaptively modifying as claimed. Furthermore, the cited ¶0062 and FIG. 7 of Knepper clearly relate to initial set-up of the entertainment files and advertising files and make no reference whatsoever to "skipping." The Examiner appears to have constructed this part of the statement of rejection without proper basis in any of the prior art.

Even assuming, *arguendo*, that a user could navigate between Knepper pages and that would somehow change the order at which specific advertisement content is presented, the advertising insertion points as described in Knepper would still be at the exact same positions as enumerated upon in the following diagram example adapted from FIG. 4 of Knepper:



In the example diagram above, if a Knepper Page 3 moves from Position 3 in the *Original Sequence* to Position 2 in the *Modified Sequence* (as shown by Line A above) then, while the content of Ad Video Clip 311 at Position 2 may change, the advertisement insertion point of the resultant presentation at Page 3 Position 2 (formerly Page 2 Position 2) would be at the exact same

position in sequence (as shown by Line B, Ad Video Clip 311 above). The Examiner ***argues*** that moving the position of the pages (e.g., from Page 3, Position 3 to Page 3, Position 2, as shown above) changes the Content of the Ad Video Clip 311 at Position 2. *See Office Action*, p. 8. However, Claim 212 recites **adaptively modifying** a position for digital ad content by moving the position from "one or more **initially sequenced insertion points to one or more alternatively sequenced insertion points"** that are different from the initially sequenced insertion points "relative to the digital media content within the user-perceptible content stream." As clearly shown above and as described in Knepper, the insertion points of the Ad Video Clips **do not change**.

Moreover, the approaches described in Knepper generally relate to improvements that address challenges inherent in delivery and playback of video and/or audio media files on a client-side computer (see, e.g. ¶0007 of Knepper). Using the approach of Knepper, media files (which can include both entertainment media files and advertisement media files) and an instruction set are downloaded from a server to a client, and pre-cached at the client side. Knepper explains that the "server 207 thus has control over the user's advertisement set." *Id.* at ¶0029. Knepper also explains that an application "assembles the entertainment and advertisement media files and begins playback of the various media files… **in the order specified by the instruction set**" (emphasis added). *Id.* at ¶0037. The entertainment and advertisement media files are thus assembled to form a clip. The formed clip has the appearance of being a single media file. *Id.* at ¶0038.

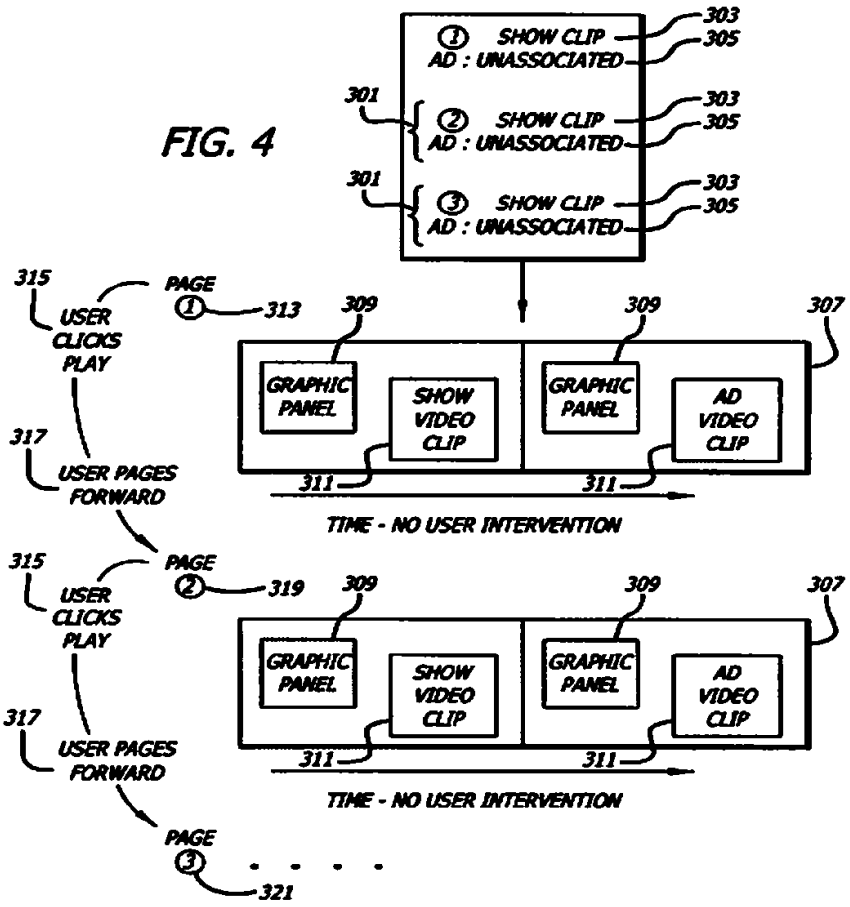
In direct contrast to the descriptions in Knepper, the "**adaptively modifying**" of "a presentation position of the digital advertising content" element of claim 212 involves using pre-defined rules and occurs **in response to a user input** detected by the client system. The presentation position of the digital advertising content is adaptively modified "from at least one of the one or more **initially sequenced insertion points to one or more alternatively sequenced insertion points**" and "at least one of the one or more **alternatively sequenced insertion points** [is] **different than the one or more initially sequenced insertion points relative to the digital media content within the user-perceptible content stream**." In other words, after creating a user-perceptible content stream a user input causes a modification to the user-perceptible content stream such that digital advertising content in the user-perceptible content stream after the adaptively modifying is arranged at different/alternate insertion positions relative to the digital media content. Such an adaptive modification would not be possible in the Knepper instruction set, **determined by the server**, that indicates the order of entertainment and advertisement media

files.

Knepper makes clear that the insertion positions for advertising are defined by pages. For example, Knepper at ¶0052 describes a digital magazine having ads at fixed positions in relation to the content. A user can traverse the magazine, for example by "paging forward", but will always be presented with advertisements at fixed pre-determined locations relative to the specific content assigned to a given page. Even assuming *arguendo* that user navigation in the Knepper approach can change the order in which pages are presented, which in turn may result in the entertainment files and the associated advertising file locations for a given page to be presented in a different overall order, the locations at which advertising files are presented is nonetheless always fixed with respect to the associated entertainment file for a given page, at least because the navigation in Knepper occurs page by page and each page defines a fixed and unchangeable relationship between the entertainment file and a location for an advertising file. *See Knepper*, FIG. 4 show video clip 311 and ad video clip 311. For example, if a user could navigate from a first page of a Knepper magazine to a third page, any initially defined advertising file location on the first page and the third page would remain the same relative to the entertainment files on those first and third pages both before and after the navigation, as shown in the above example on p. 22 adapted from FIG. 4 of Knepper.

With Knepper, and with particular reference to paragraphs ¶¶0052, 0059, 0063, and 0084, entertainment files can have associated advertisement files (i.e., the same advertisement is always played with the same entertainment file) or they can have unassociated advertisement files (i.e., an advertisement file is always played with the entertainment file – but it can be one of several advertisement files). What is not changeable in Knepper, however, are the actual insertion locations at which advertising is presented relative to the content on any given page. Thus, a user of the approach described in Knepper may choose to navigate between pages 307 as discussed above. However, as shown in Knepper's FIG. 4 (reproduced below for reference) on any given page 307, there is a fixed "show video clip" 311 and an "ad video clip" 311.

FIG. 4



In other words, the approach of Knepper requires defining of fixed, specific locations into which ad video clips are inserted before or after specific show video clips. This requirement is made explicit in ¶0041: "[t]he server also sends a text file containing a set of instructions indicating which advertisement media files from among the pre-cached advertisement media files to insert into the entertainment media file at run time, how many advertisement media files to insert, and **where to insert them**." (Emphasis added). Knepper further explains that once "all of the files listed in the instruction set are downloaded, the client begins to display the content" and the "**instruction set indicates the order in which the media files are to be played**" (emphasis added). *Id.* at ¶¶0011, 0065.

In contrast, the subject matter of the instant claims causes an alternate insertion position/one or more alternatively sequenced insertion points for digital advertising content in the adaptively re-sequenced/adaptively modified user-perceptible content stream to be different than

those in the user-perceptible content stream before the adaptively re-sequencing/adaptively modifying such that an insertion position for digital advertising content relative to a media section of the digital media content changes from the user-perceptible content stream to the modified user-perceptible content stream/the user-perceptible content stream post adaptively modifying. This changing of the insertion position/insertion points of digital advertising content occurs explicitly as a result of user interaction, which is directly and unequivocally contrary to the approach described in Knepper (*see, e.g.*, Knepper Fig 4, which repeatedly states "**no user intervention**" (emphasis added) with the combination of content and advertising).

Claim 243 (and also claims 267 and 268, which differ in scope but include similar language) explicitly requires "the modified user-perceptible content stream comprising an alternate insertion position of the advertising block relative to the media section, the alternate insertion position differing from the initially defined insertion position and not having digital advertising content scheduled to be presented in it in the user-perceptible content stream prior to the adaptively re-sequencing" (emphasis added). Claim 212 (and also claims 238 and 271, which differ in scope but include similar language) states a related limitation worded slightly differently, and is likewise clearly not compatible with any reasonable interpretation of Knepper. Specifically, the modified user-perceptible content stream of claim 243 includes an alternate insertion position of a specific advertising block relative to a specific media section, where the alternate insertion position differs from the initially defined insertion position and does not have digital advertising content scheduled to be presented in it in the user-perceptible content stream prior to the adaptively re-sequencing.

Knepper neither describes nor suggests such an approach – as noted above, a given advertising location on a page is explicitly fixed relative to the entertainment file location on that page. There is no allowance in Knepper for presenting an advertising file in a location relative to an entertainment file that is not also present in the original sequence. Furthermore, FIG. 4 of Knepper expressly states that "**no user intervention**" (emphasis added) is permitted with regards to the page structure itself. These teachings of Knepper, which were discussed in detail in the previous Response and at several other points during the lengthy prosecution of this matter, directly contradict the example of the claimed subject matter (see, e.g., description above relating to the written description rejections).

The current Office Action fails to even explicitly allege that the features of claims 212 (and

238 and 271) and 243 (and 267 and 268) discussed above are described or suggested in the prior art. For example, the statement of rejection appearing at pages 7 to 9 of the Office Action makes no reference to such features but rather recycles text that has appeared in previous rejections of claims that did not have these features recited as they are currently presented. Additionally, the statement of rejection beginning on page 7 of the current office action does not acknowledge any difference in the claim language between claims 212 and 243, which is another indication of clear error. Furthermore, in the Response to Arguments section (see end of page 16 and top of page 17), the Examiner expressly attempts to rebut Applicant's arguments for non-obviousness by alleging that these elements need not be considered because "applicant's specification does not provide support for such claim language." Beyond being an admission that the features are not addressed in the statement of the rejections under 35 U.S.C. §103(a), this statement is also, on its face, a clear violation of the principles of compact prosecution.[4] The Examiner has committed clear error by failing to consider the Applicant's argument with regard to an explicit claim feature with the excuse of an errant (as discussed above in relation to the rejections under 35 U.S.C. §112, first paragraph) allegation of lack of written description support.

Finally, the Examiner's citation of *In re Keller* (see page 17 of the current Office Action) is nonsensical. The holding in that case certainly does not preclude a rebuttal of an obviousness rejection by explaining how the primary reference does not teach features alleged by the Examiner, particularly when the cited secondary references are neither asserted to nor reasonably interpretable as remedying the identified deficiencies in the primary reference. For avoidance of doubt, Knepper does not describe or suggest the above-noted features, nor do any of the other cited references. For example, Wang and Hannah are cited merely as allegedly rendering unpatentably obvious the features relating to prevention of skipping of advertising. Neither reference addresses the clear deficiency in Knepper with regard to the currently pending claims. Accordingly, Knepper, Wang, and Hannah, whether considered alone or in any combination, are insufficient to establish proper grounds for a rejection under 35 U.S.C. §103(a).

Claim 238 is directed to subject matter of different scope than Claim 212, but includes similar limitations to those discussed above. Claims 243, 267, 268, and 271 likewise recite features

[4] See MPEP §2103, which states that "each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement."

similar to at least some of the patentable features discussed in connection with Claim 212 above and also define patent-eligible subject matter.

For at least these reasons, withdrawal of the pending rejections of Claims 212, 238, 243, 267, 268, and 271 under 35 U.S.C. §103(a) is respectfully requested.

2. Dependent Claims 214-223, 225-237, 239-242, 244-266, 269-270, and 272-273 are allowable over the applied references at least by virtue of their dependency from one of independent Claims 212, 238, 243, 267, 268, or 271.

Dependent Claims 214-223, 225-237, 239-242, 244-266, 269-270, and 272-273 each depend either directly or indirectly on one of independent Claims 212, 238, 243, 267, 268, and 271. Thus, the dependent claims incorporate by reference all the features of their respective independent claims pursuant to 35 U.S.C. § 112, ¶ 4. In view of the features as recited in the independent claims, and in view of the additional features as recited in the dependent claims, Appellant respectfully submits that the dependent claims define patentable subject matter over the applied references for at least the reasons discussed above, and for their respective additional novel features. Thus, Appellant respectfully submits that dependent Claims 214-223, 225-237, 239-242, 244-266, 269-270, and 272-273 are allowable.

Accordingly, for at least these reasons, reversal of the pending rejection of Claims 214-223, 225-237, 239-242, 244-266, 269-270, and 272-273 under 35 U.S.C. §103 is respectfully requested.

C. The pending claims are directed to patent eligible subject matter because they are not directed to an abstract idea, and even if they were, the pending claims provide significantly more than the abstract idea itself.

Claims 212, 214-223 and 225-273 are rejected under 35 U.S.C. §101, because the Office alleges that the claims are drawn to subject matter that is not eligible for patenting. *Office Action*, p. 2. Appellant respectfully disagrees and traverses this rejection for at least the following reasons.

Subject Matter Eligibility Standard

In *Alice v. CLS Bank*, the Supreme Court outlined a two-step analytical framework for analyzing subject matter eligibility under Section 101.[5] Step 1 requires a determination of whether the claim is directed to a process, machine, or composition of matter. In response to step 1 being decided in the affirmative, step 2A (part 1 of the *Mayo* test) requires a determination of whether the claims are directed to a law of nature, a natural phenomenon, or an abstract idea (judicial exceptions). In response to step 2A being decided in the affirmative, step 2B (part 2 of the *Mayo* test) requires a determination of whether the claim recites additional elements that amount to significantly more than the judicial exception.[6]

Subsequent Federal Circuit decisions and USPTO guidance have provided additional guidance on the subject matter eligibility requirement. For example, in *Enfish v. Microsoft*, the Federal Circuit held that a claim directed to a self-referential table was patent-eligible because it was directed to a specific, asserted improvement in computer capabilities.[7] In *BASCOM v. AT&T*, the Federal Circuit held that a claim containing known, conventional pieces was patent-eligible because it provided a non-conventional and non-generic arrangement of those pieces.[8] Further, in *McRO v. Bandai*, the Federal Circuit held that a claim requiring specific rules to render 3-D animations in a specific way was patent-eligible because the use of the rules did not preempt others from rendering 3-D animations using generic rules.[9]

Appellant respectfully submits that, in view of *Core Wireless*, *Ex parte Relyea*, and the April 2018 USPTO Memo, the claims do not recite an abstract idea (step 2A), and, even if the claims do recite an abstract idea (which Appellant does not acknowledge), the claims amount to significantly more than an abstract idea itself (step 2B). Moreover, Appellant respectfully submits that the Examiner has failed to establish a proper *prima facie* case that the claims are not directed to patent-eligible subject matter under 35 U.S.C. §101.

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[5] *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2355 (2014).
[6] *See id.*; MPEP § 2106.
[7] *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335-36 (Fed. Cir. 2016).
[8] *BASCOM Global Internet Servs. v. AT&T Mobility LLC*, 827 F.3d 1341, 1350 (Fed. Cir. 2016).
[9] *McRO, Inc. v. Bandai Namco Games Am.*, 837 F.3d 1299, 1315 (Fed. Cir. 2016).

1. **Step 2A: the pending claims do not recite an abstract idea because they are inextricably tied to computer technology and distinct from the types of concepts found by the courts to be abstract.**

As an initial matter, the Examiner has not considered the most recent USPTO April 2018 Memo. In the April 2018 Memo, Mr. Bahr explains that two precedential Federal Circuit decisions, *Finjan*[10] and *Core Wireless*[11], found the software-related inventions patent eligible under 35 U.S.C. § 101 because the inventions ***were not directed to an abstract idea***. *Finjan*, *Core Wireless*, as well as *Enfish* and *McRO*, confirm that software-based innovations are not abstract if they make non-abstract improvements to computer technology. **As such, they are patent eligible under the first step of the Alice test (also referred to as step 2A in the USPTO's subject matter eligibility guidance, MPEP § 2106.04).**

In the Office Action, the Examiner cites *SmartGene* and *Cyberfone* as supporting the assertion that Claim 212 is similar to other ideas found to be abstract by various courts. *Office Action*, p. 3. Applicant first notes that both *SmartGene* and *Cyberfone* are non-precedential decisions by the Federal Circuit. In the November 2016 Memo to Examiners, the USPTO gave explicit guidance regarding use of both *SmartGene* and *Cyberfone* as non-precedential decisions:

> **Non-precedential decisions:** Finally, given the large and ever-increasing number of precedential decisions, **examiners should avoid relying upon or citing non-precedential decisions (e.g., SmartGene, Cyberfone) unless the facts of the application under examination uniquely match the facts at issue in the non-precedential decision**. The updated chart of court decisions available on the US PTO' s SME Webpage indicates whether a decision is precedential or nonprecedential. (Emphasis added) *November 2016 Memo*, p. 4; *see also* MPEP § 2106.07(a).

Accordingly, *SmartGene*, for example, should only be cited in applications that claim methods in which "every step" is one that a physician would make mentally upon observing a patient or reviewing medical data. Similarly, Cyberfone should only be cited in applications that claim methods in which "every step" is one that a computer would make when obtaining a single transmission from a telephone. Neither is the case in amended Claim 212.

Although the Examiner cites the above court decisions, the cited court decisions are not

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[10] *Finjan Inc. v. Blue Coat Systems, Inc.,* 879 F.3d 1299 (Fed. Cir. 2018).

[11] *Core Wireless Licensing S.A.R.L., v. LG Electronics, Inc.,* 880 F.3d 1356 (Fed. Cir. 2018).

analogous to amended Claim 212. For example, in *SmartGene*, the claims were directed to a method for guiding the selection of a therapeutic treatment regimen for a patient with a known disease or medical condition. *SmartGene*, Slip Opinion, p. 2. The court stated that the claims defined a process of "using a computer to perform a series of mental steps that people, aware of each step, can and regularly do perform in their heads" *Id.* at p. 7-8. In *Cyberfone*, the claim at issue was directed to a method comprising "obtaining data transaction information …; forming a plurality of different exploded data transactions for the single transmission…; and sending said different exploded data transactions over a channel to said different destinations." *Slip Op.*, p. 7.

As noted above, Claim 212 is not directed to observing a patient or reviewing medical data and therefore should not be analogized to *SmartGene*. Likewise, Claim 212 is not directed to forming a plurality of different exploded data transactions from a single transaction and should not be analogized to *Cyberfone*. In contrast to the claims of *SmartGene* and *Cyberfone*, and as highlighted by the Specification of the present application, the subject matter of Claim 212 uses an initial sequencing and user input to "adaptively regroup and re-sequence the insertion of ad blocks extemporaneously (i.e. "on the fly"), in response to the consumer's arbitrary direction of the playback within the requested content, by means of playback controls." *See Specification*, ¶0117. As such, Claim 212 is not directed to "the abstract idea of 'preventing of commercial skipping by using a well-known device'" as alleged by the Examiner. *Office Action*, p. 3. Indeed, Claim 212 recites an improved computer-implemented way to adaptively re-sequence ad block positions in response to user input which is clearly different than the alleged abstract idea of "preventing of commercial skipping by using a well-known device."

This improvement is similar to those the courts recognized in *Core Wireless*, *Enfish*, and *McRO* in which the claims provided technological benefits and were not found to be directed to an abstract idea.

In *Core Wireless*, the claimed invention involves a graphical user interface (GUI) for mobile devices that displays an application summary of each application on the main menu while those applications are in an unlaunched state. The claims to computing devices were held patent eligible because the court concluded that they are directed to an improved user interface for electronic devices, not to the abstract idea of an index. In particular, **the claims contain precise language delimiting the type of data to be displayed and how to display it, thus improving upon conventional user interfaces** to increase the efficiency of using mobile devices. Finding the

claims eligible, the court compared the improved user interface in the patent claims to the improved systems claimed in *Enfish, Thales, Visual Memory,* and *Finjan.*

In Claim 212, like in *Core Wireless*, the claimed subject matter is directed to non-abstract improvements to computer technology because it **contains precise language delimiting the type of data to be sequenced and how to sequence and adaptively modify the sequence, thus improving upon conventional delivery, presentation, and user interaction of/with media content and advertising content**. For example, Claim 212 specifies the type of data (e.g., data comprising digital media content and digital advertising content), how to sequence it (e.g., determining an initial sequence of the digital media content and digital advertising content and adaptively modifying and/or re-sequencing the initial sequence), and even includes what is done with the information after the modifying and/or re-sequencing (e.g., presenting the content stream, keeping a setting, disallowing a navigation choice based on the digital advertising content, and storing presentation data). Accordingly, just as held in *Core Wireless*, amended Claim 212 is also not directed to an abstract idea.

In *Enfish*, the Federal Circuit noted that in determining whether a claim is *directed to* an abstract idea for purposes of the first step, it is not sufficient to simply ask whether the claim *involves* a patent-ineligible concept. The claims must be "considered in light of the specification, based on whether 'their character as a whole is directed to excluded subject matter.'" *Enfish*, pp. 9-11.

Unlike the claims in *SmartGene* and *Cyberfone*, the claims in *Enfish* were directed to an improvement in the function of a computer. The *Enfish* court gave specific guidance that "benefits over conventional databases, such as **increased flexibility, faster search times, and smaller memory requirements**," may be determinative that the claims are directed to improvements in existing computer technology and not an abstract idea. *May 2016 Guidance*, p. 2. Claim 212 is likewise directed to improvements in the function of computers, specifically to increase flexibility in the way digital advertisements may be delivered. For example, the subject matter of Claim 212 gives the "ability to adaptively regroup and re-sequence the insertion of ad blocks extemporaneously (i.e. "on the fly"), in response to the consumer's arbitrary direction of the playback within the requested content." *Specification*, ¶0117. Because these processes are inextricably related to a computing system, the claimed subject matter cannot be abstract nor directed to a judicial exception (Step 2A). Furthermore, the capability to adaptively regroup and

re-sequence insertion of ad blocks on the fly can provide important benefits over conventional distribution systems by improving security, optimizing bandwidth, performance, and user interaction, etc. *See id.* at ¶0054, FIG. 3A, ¶0110-0111, ¶0117, ¶0186, and ¶202-204.

Moreover, the Office has overgeneralized the claims, which is prohibited by recent USPTO guidance. For example, the November 2016 Memo, citing *McRO*, provides that:

> **Examiners should consider the claim as a whole under Step 2A** of the USPTO's SME guidance, and should not overgeneralize the claim or simplify it into its "gist" or core principles, when identifying a concept as a judicial exception. [] **An "improvement in computer-related technology" is not limited to improvements in the operation of a computer or a computer network *per se*, but may also be claimed as a set of "rules" (basically mathematical relationships) that improve computer-related technology by allowing computer performance of a function not previously performable by a computer**. *November 2016 Memo*, p. 2. (emphasis added).

The Office, however, has generalized the claims down to "preventing of commercial skipping." *See Office Action*, p. 3. The Examiner in particular fails to explain why limitations of "sequencing," "adaptively modifying," "causing presentation," "keeping a setting" and "disallowing" do not alter the scope of what the claims as a whole are directed to. The Office thus looked at the claims generally and did not account for the specific requirements of the claims which recite a novel and inventive method of adaptively re-sequencing ad insertion points which have nothing to do with "preventing of commercial skipping," e.g., in point of fact, even if the ads are adaptively re-sequenced after a user navigation, they could still possibly be skippable in some fashion (i.e. fast forward/skip) if not for the additional "disallowing" limitation of Claim 212. Indeed, the specific limitations of Claim 212 enable user navigation with advertising supported media which traditionally was not possible. *See Specification*, ¶0008, ¶0048, ¶0057.

Accordingly, the Office's rejection fails to meet the Office's burden to establish a *prima facie* case that the subject matter of Claim 212 is directed to an abstract idea that can be performed mentally.

2. Step 2B: the pending claims add significantly more to an abstract idea

Even assuming, *arguendo*, that Claim 212 is directed to an abstract idea under Step 2A, Claim 212 recites significantly more than the alleged abstract idea of preventing of commercial skipping.

For example, in the recent Federal Circuit decision of *Bascom Global Internet Services, Inc., v. AT&T Mobility LLC*, No. 2015-1763 (Fed. Cir.) (June 27, 2016), the Federal Circuit opined that Claim 1 of the application recited patent-eligible subject matter. Claim 1 of Bascom's patent recited:

> 1. A content filtering system for filtering content retrieved from an Internet computer network by individual controlled access network accounts, said filtering system comprising:
>
> a local client computer generating network access requests for said individual controlled access network accounts; at least one filtering scheme;
>
> a plurality of sets of logical filtering elements; and
>
> a remote ISP server coupled to said client computer and said Internet computer network, said ISP server associating each said network account to at least one filtering scheme and at least one set of filtering elements, said ISP server further receiving said network access requests from said client computer and executing said associated filtering scheme utilizing said associated set of logical filtering elements.

The Federal Circuit criticized the District Court's piecemeal analysis of the features of Claim 1, and stated that the inventive concept inquiry "requires more than recognizing that each claim element, by itself, was known in the art," as "an inventive concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces." *Bascom*, Slip Opinion, p. 15. The Federal Circuit also noted that the District Court analysis looked "similar to an obviousness analysis under 35 U.S.C. § 103, except lacking an explanation of a reason to combine the limitations." *Id.* at p. 4. The *Bascom* court clearly recognizes that "software-based inventions that improve the performance of the computer itself" are patent eligible even when the inventions are otherwise directed toward abstract ideas. *Id.* at p. 18.

The *Bascom* decision described how an analysis under 35 U.S.C. §101 should not be the same as an analysis under 35 U.S.C. §103. *Id.* at pp. 4, 15. Here, it should be noted that Claim 212 is not known, much less well-known (by virtue of being novel under 35 U.S.C. 102) and is also not obvious (by virtue of being allowable under 35 U.S.C. 103, as discussed above). Therefore, as in *Bascom*, the claim elements of Claim 212 cannot properly be rejected by the mere assertion that they are drawn to well-known, routine, and conventional practices as alleged on p. 4 of the Office Action.

Additionally, the most recent USPTO memorandum dated April 19, 2018, from Robert W. Bahr ("April 19, 2018 Memo") explains that the precedential Federal Circuit decision of *Berkheimer*[12] held that whether "something is well-understood, routine, and conventional to a skilled artisan at the time of the patent is a **factual determination**" (emphasis added). *April 19, 2018 Memo*, p. 2. The April 19, 2018 Memo explains that in "a step 2B analysis, an additional element (or combination of elements) is not well-understood, routine or conventional **unless the examiner finds, and expressly supports a rejection in writing with, one or more of the following**:" 1) a citation to an express statement in the specification or to a statement made by an applicant during prosecution; 2) citation to one or more of the court decisions discussed in MPEP § 2106.05(d)(II); 3) a citation to a publication; or 4) statement that the examiner is taking official notice. (Emphasis added). *See id.* at p. 3-4. These citations must demonstrate the well-understood, routine, conventional nature of the additional element(s). *Id.*

In the Office Action, the Examiner has not provided **any of the above support** for the assertion that the elements of Claim 212 are well-understood, routine or conventional and has therefore failed to meet the Office's burden under Step 2B and MPEP § 2106. *See Office Action*, p. 4

While the rejections under 35 U.S.C. §101 should be withdrawn simply due to this deficiency, the following additional arguments are presented in hopes of furthering prosecution in this matter. For example, claims 212 and 238 include ordered combinations of elements (implemented by operation of one or more processors) that include

- receiving data that includes digital media content and digital advertising content on a client system (claim 212) or transmitting such data to a client system from at least one remote system (claim 238);
- sequencing the digital media content and the digital advertising content, which includes ordering at least some of the digital media content and at least some of the digital advertising content into a user-perceptible content stream that includes one or more initially sequenced insertion points at which the digital advertising content is scheduled to be presented relative to the digital media content;

[12] *Berkheimer v. HP Inc.*, 881F.3d1360 (Fed. Cir. 2018).

- adaptively modifying a presentation position of the digital advertising content from at least one of the one or more initially sequenced insertion points to one or more alternatively sequenced insertion points using pre-defined rules and in response to a user input detected by the client system, such that at least one of the one or more alternatively sequenced insertion points is different than the one or more initially sequenced insertion points relative to the digital media content within the user-perceptible content stream;
- causing presentation of the user-perceptible content stream at the client system after the adaptively modifying;
- keeping a setting (which includes a value to indicate whether presentation of a required part of the digital advertising content is in progress during presentation of the user-perceptible content stream) in a first memory to indicate a current state of play;
- disallowing a navigation choice that alters a course of playback of the user-perceptible content stream while presentation of the required part of the digital advertising content is in progress; and
- storing presentation data comprising an indication of the digital advertising content that has been presented in a second memory.

Claim 271 includes similar limitations in a system (means-plus-function) claim.

While directed to subject matter of differing scope, new claims 243, 267, and 268 include an ordered combination of elements (implemented by operation of one or more processors) that include

- receiving data that includes digital media content and digital advertising content on a client system (claim 243) or transmitting such data to a client system from at least one remote system (claim 267);
- sequencing the digital media content, which includes ordering the digital media content into a user-perceptible content stream that includes a) a media section that includes at least some of the digital media content and b) an advertising block within which at least some of the digital advertising content is scheduled to be presented and which is arranged within the user-perceptible content stream at an initially defined insertion position relative to the media section;

- adaptively re-sequencing the user-perceptible content stream into a modified user-perceptible content stream to reflect a user input detected at the client machine, such that the modified user-perceptible content stream includes an alternate insertion position (which differs from the initially defined insertion position and does not have digital advertising content scheduled to be presented in it in the user-perceptible content stream prior to the adaptively re-sequencing), and where the adaptively re-sequencing includes determining the alternate insertion position using one or more pre-defined placement rules associated with the digital media content;
- causing presentation of the modified user-perceptible content stream at the client system;
- keeping a setting (which includes a value to indicate whether presentation of a required part of the digital advertising content is in progress during presentation of the modified user-perceptible content stream) in a first memory to indicate a current state of play;
- disallowing a navigation choice that alters a course of playback of the modified user-perceptible content stream while presentation of the required part of the digital advertising content is in progress; and
- storing presentation data comprising an indication of the digital advertising content that has been presented in a second memory.

Claim 268 includes similar limitations in a system (means-plus-function) claim.

The above stated ordered combinations of elements cannot be reasonably construed as well-known, conventional, or routine. These features, whether taken alone or in combination, do not resemble claim limitations that the courts have previously found to be well-understood, routine, or conventional. Furthermore, the statement of rejection makes no such assertion. In fact, and on the contrary, the noted claim limitations more closely resemble the combination of elements present in the claims at issue in *DDR Holdings* or in *Bascom v. AT&T*. For example, no court has found that implementing sequencing and adaptively modifying (claims 212, 238, and 271) or sequencing and re-sequencing (claims 243, 267, and 268) of digital media content using software-implemented features that act in response to a user input to cause presentation of a modified user-perceptible content stream with digital advertising positioned differently relative to digital media content compared to an initial position or set of positions relative to the digital media content, or anything similar to it, should be considered to be routine, well known, or conventional.

Furthermore, in *Bascom*, the Federal Circuit has explicitly acknowledged that the mere

ability of a claimed invention to be used in enhancing the execution of a commercial transaction is not dispositive of it being directed to a patent ineligible concept: "the invention in DDR's patent was engineered in the context of retaining potential customers, the invention was not claiming a business method per se, but was instead claiming a technical way to satisfy an existing problem for website hosts and viewers" (emphasis added). Such a distinction is **directly relevant** to the instantly claimed subject matter, which involves a technical way to solve the existing (at the time of the current invention) problem of providing internet-supplied media content with advertising in a manner that allows for arbitrary user-controlled navigation/re-ordering of the content to combat piracy of content while still generating revenue from the advertising.

Furthermore, the subject matter of Claim 212 is closely analogous to the patent eligible subject matter in the recent PTAB Appeal decision in *Ex parte Relyea*, Appeal No. 2017-001443 (April 18, 2018). In *Ex parte Relyea*, the claims at issue were directed to **Internet-based directed-advertising** under circumstances involving broadcast TV and simultaneous chat room participation. *Ex parte Relyea*, p. 2-4.

Claim 1 of the patent at issue recited a method that provides broadcast programming, hosts a chat group, defines a micro-group, **creates a profile** for the micro-group, monitors behavior of the group, **modifies the profile**, **retrieves advertising content** associated with chat group, and **provides advertising content to user devices**. *See id.*

While the Board did not find error in the Examiner's determination that the claims were directed to the abstract idea of "targeting of advertisements to a micro-group of users based on profile data and chat group content," the Board concluded that the claims "**improve[d] the technical field of broadcasting television programs by dynamically integrating targeted advertising content into the television programs that are broadcast to users of the chat group**," (emphasis added) and thus provided "**a detailed level of targeted advertising [that] was not technologically achievable for television broadcasting in the past**" (emphasis added). *Id.* at p. 9-10. The Board further ruled that the claims included limitations "not widely prevalent in the field" that "leverage[d] [the] **real-time behavior of users** in the chat groups **to integrate targeted advertising content into broadcast programming**"; and still further that the claims were "confined to the particular **useful application of integrating targeted advertising content**." *Id.* at p. 10. Thus, the Board reversed the Examiner's §101 rejection under Step 2B.

As noted above, Claim 212 is directed to an approach that improves the **technical field of distributing media content by dynamically integrating targeted advertising content into the digital media content that are presented to users**. Just as claim 1 of *Ex parte Relyea* leverages real-time behavior of users to integrate targeted advertising, the subject matter of Claim 212 leverages user input to deliver "**targeted advertisements** may be interspliced **into an original broadcast presentation in real-time**, thereby providing broadcast programming with promotional material tailored to the preferences, demographics, or other relevant criteria of individual users, in addition to and/or in place of those ads specifically associated with the broadcast media" (emphasis added). *Specification*, ¶0143. The ability to "adaptively regroup and re-sequence the insertion of ad blocks extemporaneously (i.e. "on the fly"), in response to the consumer's arbitrary direction of the playback within the requested content" **was not technologically achievable for media presentation in the past**. The specialized adaptive modification of Claim 212 is also confined to the particular **useful application of integrating targeted advertising content**. Accordingly, just like in *Ex parte Relyea*, the Board should reverse the Examiner's rejection under §101.

Ultimately, Applicant respectfully submits that amended Claim 212 does not recite an abstract idea (step 2A), and, even if amended Claim 212 does recite an abstract idea (which Applicant does not acknowledge), amended Claim 212 amounts to significantly more than the abstract idea itself (step 2B). Therefore, amended Claim 212 is directed to patent-eligible subject matter.

Accordingly, Applicant requests the withdrawal of the rejections of Claim 212 under 35 U.S.C. §101. Independent Claims 238, 243, 267, 268, and 271 likewise recite features similar to at least some of the patent eligible features discussed in connection with Claim 212 above and also define patent-eligible subject matter.

3. Dependent Claims 214-223, 225-237, 239-242, 244-266, 269-270, and 272-273 are allowable over the applied references at least by virtue of their dependency from one of independent Claims 212, 238, 243, 267, 268, or 271.

Dependent Claims 214-223, 225-237, 239-242, 244-266, 269-270, and 272-273 each depend either directly or indirectly on one of independent Claims 212, 238, 243, 267, 268, and 271. Thus, the dependent claims incorporate by reference all the features of their respective

independent claims pursuant to 35 U.S.C. § 112, ¶ 4. In view of the features as recited in the independent claims, and in view of the additional features as recited in the dependent claims, Appellant respectfully submits that the dependent claims define patentable subject matter over the applied references for at least the reasons discussed above, and for their respective additional novel features. Thus, Appellant respectfully submits that dependent Claims 214-223, 225-237, 239-242, 244-266, 269-270, and 272-273 are also patent eligible.

Accordingly, for at least these reasons, reversal of the pending rejection of Claims 214-223, 225-237, 239-242, 244-266, 269-270, and 272-273 under 35 U.S.C. §101 is respectfully requested.

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D. Conclusion

On the basis of the foregoing, Appellant respectfully requests that the Board reverse all of the outstanding rejections of the pending claims, Claims 212, 214-223 and 225-273. It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper.

Enclosed herewith please find the requisite fees for a three-month extension of time. No additional fees are believed to be due. However, the Commissioner is hereby authorized to charge any additional claim fees and any additional fees that may be due, or credit any overpayment of same, to Deposit Account No. 50-0311, Reference No. 42327-501001US. If there are any questions regarding this response, the undersigned may be contacted at the telephone number provided below.

Respectfully submitted,

Dated: July 26, 2018

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VI. CLAIMS APPENDIX

1–211. (Canceled).

212. (Previously Presented) A method comprising:

receiving, on a client system, data comprising digital media content and digital advertising content;

sequencing the digital media content and the digital advertising content, the sequencing comprising ordering at least some of the digital media content and at least some of the digital advertising content into a user-perceptible content stream, the user-perceptible content stream comprising one or more initially sequenced insertion points at which the digital advertising content is scheduled to be presented relative to the digital media content;

adaptively modifying, using pre-defined rules and in response to a user input detected by the client system, a presentation position of the digital advertising content from at least one of the one or more initially sequenced insertion points to one or more alternatively sequenced insertion points, at least one of the one or more alternatively sequenced insertion points being different than the one or more initially sequenced insertion points relative to the digital media content within the user-perceptible content stream;

causing presentation of the user-perceptible content stream at the client system after the adaptively modifying;

keeping a setting in a first memory to indicate a current state of play, the setting including a value to indicate whether presentation of a required part of the digital advertising content is in progress during presentation of the user-perceptible content stream;

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disallowing a navigation choice that alters a course of playback of the user-perceptible content stream while presentation of the required part of the digital advertising content is in progress; and

storing, in a second memory, presentation data comprising an indication of the digital advertising content that has been presented;

wherein the receiving, the sequencing, the adaptively modifying, the causing, the keeping, the disallowing, and the storing are performed by one or more programmable processors.

213. (Canceled)

214. (Previously Presented) A method as in claim 212, wherein the causing presentation of the user-perceptible content stream on the client system comprises causing display of the user-perceptible content stream by way of a graphical user interface.

215. (Previously Presented) A method as in claim 212, wherein the receiving of the user- input and the adaptively modifying occur during the causing of the presentation of the user-perceptible content stream on the client system.

216. (Previously Presented) A method as in claim 212, wherein the receiving of the user- input and the adaptively modifying occur prior to the causing of the presentation of the user-perceptible content stream on the client system.

217. (Previously Presented) A method as in claim 212, wherein the receiving of the user- input and the adaptively modifying of the presentation position occur subsequent to the causing of the presentation of the user-perceptible content stream on the client system.

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218. (Previously Presented) A method as in claim 212, wherein the sequencing and the adaptively modifying are performed by the client system, which comprises a programmable processor of the one or more programmable processors.

219. (Previously Presented) A method as in claim 212, wherein the pre-defined rules specify the one or more initially sequenced insertion points.

220. (Previously Presented) A method as in claim 212, wherein the pre-defined rules specify the one or more alternatively sequenced insertion points.

221. (Previously Presented) A method as in claim 212, wherein the sequencing and the adaptively modifying are performed by at least one remote system differing from the client system, the at least one remote system comprising a processor of the one or more programmable processors.

222. (Previously Presented) A method as in claim 212, wherein the sequencing is performed by the client system, which comprises a first processor of the one or more programmable processors, and the adaptively modifying is performed by at least one remote system, which comprises a second processor of the one or more programmable processors.

223. (Previously Presented) A method as in claim 212, wherein the adaptively modifying is performed by the client system, which comprises a first processor of the one or more programmable processors, and the sequencing is performed by at least one remote system, which comprises a second processor of the one or more programmable processors.

224. (Canceled)

225. (Previously Presented) A method as in claim 212, wherein the digital media content comprises at least one media file.

226. (Previously Presented) A method as in claim 212, wherein the digital advertising content comprises at least one advertisement file.

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227. (Previously Presented) A method as in claim 226, further comprising: generating a sequence by sub-dividing a media file into two or more segments, and wherein at least a part of the at least one of the advertising file is presented between two of the segments.

228. (Previously Presented) A method as in claim 225, wherein the user input results in a change of a sequence of two or more media files by subtracting an existing media file, or by re-arranging the sequence of media files or results in a change of sequence by adding a new media file.

229. (Previously Presented) A method as in claim 212, wherein the user input comprises one or more navigational choices for the content stream.

230. (Previously Presented) A method as in claim 229, wherein the one or more navigational choices are selected from a group consisting of: play, stop, pause/continue, reverse, rewind, fast-forward, slow-motion, track advance, frame-by-frame advance, go direct to point or page in sequence, advance chapter, page turn, change track, change media selection, shuttle knob, and one or more sound controls.

231. (Previously Presented) A method as in claim 212, wherein the data is received by the client system from at least one remote system.

232. (Previously Presented) A method as in claim 212, wherein the receiving of the data comprises accessing a local data source.

233. (Previously Presented) A method as in claim 212, further comprising: rotating new advertising content into the user-perceptible content stream in response to the user input.

234. (Previously Presented) A method as in claim 212, further comprising: sending, by a remote system to the client system, additional advertising content during presentation of at least the part of the user-perceptible content stream.

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235. (Previously Presented) A method as in claim 212, wherein the pre-defined rules position the advertising content so as to uphold an average content play time.

236. (Previously Presented) A method as in claim 212, wherein the sequencing comprises positioning, according to the pre-defined rules, the digital advertising content based on an amount of media content played during presentation of the content stream.

237. (Previously Presented) A method as in claim 212, wherein the adaptively modifying uses two or more of the pre-defined rules for determining the corresponding presentation position of at least a part of the digital advertising content.

238. (Previously Presented) A method comprising:

transmitting, by at least one remote system to a client system, data comprising digital media content and digital advertising content;

sequencing the digital media content and the digital advertising content, the sequencing comprising ordering at least some of the digital media content and at least some of the digital advertising content into a user-perceptible content stream, the user-perceptible content stream comprising one or more initially sequenced insertion points at which the digital advertising content is scheduled to be presented relative to the digital media content;

adaptively modifying using pre-defined rules and in response to a user input detected by the client system, a presentation position of the digital advertising content from at least one of the one or more initially sequenced insertion points to one or more alternatively sequenced insertion points, at least one of the one or more alternatively sequenced insertion points being different than the one or more initially sequenced insertion points relative to the digital media content within the user-perceptible content stream;

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causing presentation of the user-perceptible content stream at the client system after the adaptively modifying;

keeping a setting in a first memory to indicate a current state of play, the setting including a value to indicate whether presentation of a required part of the digital advertising content is in progress during presentation of the user-perceptible content stream;

disallowing a navigation choice that alters a course of playback of the user-perceptible content stream while presentation of the required part of the digital advertising content is in progress; and

storing, in a second memory, presentation data comprising an indication of the digital advertising content that has been presented;

wherein the transmitting, the sequencing, the adaptively modifying, the causing, the keeping, the disallowing, and the storing are performed by one or more programmable processors.

239. (Previously Presented) A method as in claim 212, wherein the first memory and the second memory are part of the client system.

240. (Previously Presented) A method as in claim 212, wherein the first memory is part of the client system and the second memory is part of at least one remote system.

241. (Previously Presented) A method as in claim 212, wherein the first memory is part of at least one remote system and the second memory is part of the client system.

242. (Previously Presented) A method as in claim 212, wherein the first memory and the second memory are part of at least one remote system.

243. (Previously Presented) A method comprising:

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receiving, on a client system, data comprising digital media content and digital advertising content;

sequencing the digital media content, the sequencing comprising ordering the digital media content into a user-perceptible content stream comprising a media section that comprises at least some of the digital media content, the user perceptible content stream further comprising an advertising block within which at least some of the digital advertising content is scheduled to be presented, the advertising block being arranged within the user-perceptible content stream at an initially defined insertion position relative to the media section;

adaptively re-sequencing the user-perceptible content stream into a modified user-perceptible content stream to reflect a user input detected at the client machine, the modified user-perceptible content stream comprising an alternate insertion position of the advertising block relative to the media section, the alternate insertion position differing from the initially defined insertion position and not having digital advertising content scheduled to be presented in it in the user-perceptible content stream prior to the adaptively re-sequencing, the adaptively re-sequencing comprising determining the alternate insertion position using one or more pre-defined placement rules associated with the digital media content;

causing presentation of the modified user-perceptible content stream at the client system;

keeping a setting in a first memory to indicate a current state of play, the setting including a value to indicate whether presentation of a required part of the digital advertising content is in progress during presentation of the modified user-perceptible content stream;

disallowing a navigation choice that alters a course of playback of the modified user-perceptible content stream while presentation of the required part of the digital advertising content is in progress; and

storing, in a second memory, presentation data comprising an indication of the digital advertising content that has been presented;

wherein the receiving, the sequencing, the adaptively re-sequencing, the causing, the keeping, the disallowing, and the storing are performed by one or more programmable processors.

244. (Previously Presented) A method as in claim 243, further comprising detecting the user input at the client system.

245. (Previously Presented) A method as in claim 244, wherein the detecting comprises a user interacting with playback controls of player and/or viewer software.

246. (Previously Presented) A method as in claim 243, wherein the user input comprises an arbitrary direction of playback within the user-perceptible content stream.

247. (Previously Presented) A method as in claim 246, wherein the arbitrary direction of playback comprises skipping the media section and/or one or more other media sections that comprise at least some of the digital media content.

248. (Previously Presented) A method as in claim 243, wherein the user input comprises a reordering of the media section and/or one or more other media sections that comprise at least some of the digital media content within the user-perceptible content stream.

249. (Previously Presented) A method as in claim 243, wherein the user input comprises the repositioning of the media section relative to one or more media sections within the user-perceptible content stream.

250. (Previously Presented) A method as in claim 243, wherein the one or more pre-defined placement rules comprise track-count based and/or elapsed time-based logic, and wherein the adaptively re-sequencing comprises determining when to re-schedule the advertising

block into the modified user-perceptible content stream, the determining comprising applying the track-count based and/or elapsed time-based logic.

251. (Previously Presented) A method as in claim 243, wherein the first memory and the second memory are part of the client system.

252. (Previously Presented) A method as in claim 243, wherein the first memory is part of the client system and the second memory is part of at least one remote system.

253. (Previously Presented) A method as in claim 243, wherein the first memory is part of at least one remote system and the second memory is part of the client system.

254. (Previously Presented) A method as in claim 243, wherein the first memory and the second memory are part of at least one remote system.

255. (Previously Presented) A method as in claim 243, wherein the adaptively re-sequencing comprises use of a plurality of the one or more pre-defined placement rules for determining the alternate insertion position for the advertising block.

256. (Previously Presented) A method as in claim 243, further comprising: rotating new advertising content into the user-perceptible content stream in response to the user input.

257. (Previously Presented) A method as in claim 243, wherein the causing presentation of the modified user-perceptible content stream on the client system comprises causing display of the modified user-perceptible content stream by way of a graphical user interface.

258. (Previously Presented) A method as in claim 243, further comprising: causing a first presentation of the user-perceptible content stream on the client system, and wherein the receiving of the user input and the adaptively re-sequencing occur during the first presentation of the user-perceptible content stream on the client system.

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259. (Previously Presented) A method as in claim 243, further comprising: causing a first presentation of the user-perceptible content stream on the client system, and wherein the receiving of the user input and the adaptively re-sequencing occur prior to the first presentation of the user-perceptible content stream on the client system.

260. (Previously Presented) A method as in claim 243 further comprising: causing a first presentation of the user-perceptible content stream on the client system, and wherein the receiving of the user input and the adaptively re-sequencing occur subsequent to the first presentation of the user-perceptible content stream on the client system.

261. (Previously Presented) A method as in claim 243, wherein the pre-defined placement rules specify the initially defined insertion position.

262. (Previously Presented) A method as in claim 243, wherein the pre-defined placement rules specify the alternate insertion position.

263. (Previously Presented) A method as in claim 243, wherein the sequencing and the adaptively re-sequencing are performed by the client system, which comprises a programmable processor of the one or more programmable processors.

264. (Previously Presented) A method as in claim 243, wherein the sequencing and the adaptively modifying are performed by at least one remote system differing from the client system, the at least one remote system comprising a first processor of the one or more programmable processors.

265. (Previously Presented) A method as in claim 243, wherein the sequencing is performed by the client system, which comprises a first processor of the one or more programmable processors, and the adaptively re-sequencing is performed by at least one remote system, which comprises a second processor of the one or more programmable processors.

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266. (Previously Presented) A method as in claim 243, wherein the adaptively re-sequencing is performed by the client system, which comprises a first processor of the one or more programmable processors, and the sequencing is performed by at least one remote system, which comprises a second processor of the one or more programmable processors.

267. (Previously Presented) A method comprising:

transmitting, by at least one remote system to a client system, data comprising digital media content and digital advertising content;

sequencing the digital media content, the sequencing comprising ordering the digital media content into a user-perceptible content stream comprising a media section that comprises at least some of the digital media content, the user perceptible content stream further comprising an advertising block within which at least some of the digital advertising content is scheduled to be presented, the advertising block being arranged within the user-perceptible content stream at an initially defined insertion position relative to the media section;

adaptively re-sequencing the user-perceptible content stream into a modified user-perceptible content stream to reflect a user input detected at the client machine, the modified user-perceptible content stream comprising an alternate insertion position of the advertising block relative to the media section, the alternate insertion position differing from the initially defined insertion position and not having digital advertising content scheduled to be presented in it in the user-perceptible content stream prior to the adaptively re-sequencing, the adaptively re-sequencing comprising determining the alternate insertion position using one or more pre-defined placement rules associated with the digital media content;

causing presentation of the modified user-perceptible content stream at the client system;

keeping a setting in a first memory to indicate a current state of play, the setting including a value to indicate whether presentation of a required part of the digital advertising content is in progress during presentation of the modified user-perceptible content stream;

disallowing a navigation choice that alters a course of playback of the user-perceptible content stream while presentation of the required part of the digital advertising content is in progress; and

storing, in a second memory, presentation data comprising an indication of the digital advertising content that has been presented;

wherein the transmitting, the sequencing, the adaptively re-sequencing, the causing, the keeping, the disallowing, and the storing are performed by one or more programmable processors.

268. A system comprising:

means for causing data comprising digital media content and digital advertising content to be available on a client system;

means for sequencing the digital media content, the sequencing comprising ordering the digital media content into a user-perceptible content stream comprising a media section that comprises at least some of the digital media content, the user perceptible content stream further comprising an advertising block within which at least some of the digital advertising content is scheduled to be presented, the advertising block being arranged within the user-perceptible content stream at an initially defined insertion position relative to the media section;

means for adaptively re-sequencing the user-perceptible content stream into a modified user-perceptible content stream to reflect a user input detected at the client machine, the modified user-perceptible content stream comprising an alternate insertion position of the

advertising block relative to the media section, the alternate insertion position differing from the initially defined insertion position and not having digital advertising content scheduled to be presented in it in the user-perceptible content stream prior to the adaptively re-sequencing, the adaptively re-sequencing comprising determining the alternate insertion position using one or more pre-defined placement rules associated with the digital media content;

means for causing presentation of the modified user-perceptible content stream at the client system;

means for keeping a setting in a first memory to indicate a current state of play, the setting including a value to indicate whether presentation of a required part of the digital advertising content is in progress during presentation of the modified user-perceptible content stream;

means for disallowing a navigation choice that alters a course of playback of the modified user-perceptible content stream while presentation of the required part of the digital advertising content is in progress; and

means for storing, in a second memory, presentation data comprising an indication of the digital advertising content that has been presented.

269. (Previously Presented) A system as in claim 268, wherein the means for causing the data comprising the digital media content and the digital advertising content to be available on the client system comprise means for receiving the data on the client system.

270. (Previously Presented) A system as in claim 268, wherein the means for causing the data comprising the digital media content and the digital advertising content to be available on the client system comprise means for transmitting the data to the client system from at least one remote system.

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271. (Previously Presented) A system comprising:

means for causing data comprising digital media content and digital advertising content to be available on a client system;

means for sequencing the digital media content and the digital advertising content, the sequencing comprising ordering at least some of the digital media content and at least some of the digital advertising content into a user-perceptible content stream, the user-perceptible content stream comprising one or more initially sequenced insertion points at which the digital advertising content is scheduled to be presented relative to the digital media content;

means for adaptively modifying, using pre-defined rules and in response to a user input detected by the client system, a presentation position of the digital advertising content from at least one of the one or more initially sequenced insertion points to one or more alternatively sequenced insertion points, at least one of the one or more alternatively sequenced insertion points being different than the one or more initially sequenced insertion points relative to the digital media content within the user-perceptible content stream;

means for causing presentation of the user-perceptible content stream at the client system after the adaptively modifying;

means for keeping a setting in a first memory to indicate a current state of play, the setting including a value to indicate whether presentation of a required part of the digital advertising content is in progress during presentation of the user-perceptible content stream;

means for disallowing a navigation choice that alters a course of playback of the user-perceptible content stream while presentation of the required part of the digital advertising content is in progress; and

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means for storing, in a second memory, presentation data comprising an indication of the digital advertising content that has been presented.

272. (Previously Presented) A system as in claim 271, wherein the means for causing the data comprising the digital media content and the digital advertising content to be available on the client system comprise means for receiving the data on the client system.

273. (Previously Presented) A system as in claim 271, wherein the means for causing the data comprising the digital media content and the digital advertising content to be available on the client system comprise means for transmitting the data to the client system from at least one remote system.

Hulu, LLC - Ex. 1006, Page 000782

Electronic Acknowledgement Receipt

EFS ID:	33291947
Application Number:	10606729
International Application Number:	
Confirmation Number:	5831
Title of Invention:	Method and apparatus for the free licensing of digital media content
First Named Inventor/Applicant Name:	Philip M. Donian
Customer Number:	64046
Filer:	Paul S. Brockland/Walter Lau
Filer Authorized By:	Paul S. Brockland
Attorney Docket Number:	42327-501001US
Receipt Date:	26-JUL-2018
Filing Date:	26-JUN-2003
Time Stamp:	17:12:52
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Transmittal Letter	42327-501001US-Corrected_Appeal_Brief_Transmittal.pdf	123044 30390ee5d49e24754b5a03d2db988b02a640a6d1	no	1
Warnings:					

Information:					
2	Appeal Brief Filed	42327-501001US-Corrected_Appeal_Brief.pdf	1782047 431cc92268ea45274bf4770fc8f8907cb81761d8	no	56
Warnings:					
Information:					
			Total Files Size (in bytes):	1905091	

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Philip M. Donian, *et al.*

Application No.: 10/606,729 Confirmation No.: 5831

Filed: June 26, 2003 Art Unit: 3688

For: METHOD AND APPARATUS FOR THE FREE LICENSING OF DIGITAL MEDIA CONTENT Examiner: Yehdega Retta

CORRECTED APPEAL BRIEF TRANSMITTAL

FILED VIA EFS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir or Madam:

Per our conversation with Timothy Koh at the Patent Appeals Center on July 26, 2018, this Corrected Appeal Brief is submitted herewith to correct irregularities with the figures on page 22 and 25 to make the record clear.

No new matter has been added and no additional fees are believed to be due. However, the Commissioner is hereby authorized to charge any additional claim fees and any additional fees that may be due, or credit any overpayment of same, to Deposit Account No. 50-0311, Reference No. 42327-501001US. The undersigned may be contacted at the telephone number provided below.

Respectfully submitted,

Dated: July 26, 2018

Electronic signature: /Paul Brockland/
Paul S. Brockland, Esq. on behalf of Michael D. Van Loy, Esq.
Reg. No.: 61,130 & Reg. No.: 52,315 respectively
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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,729	06/26/2003	Philip M. Donian	42327-501001US	5831

64046 7590 10/18/2018

Mintz Levin/San Diego Office
One Financial Center
Boston, MA 02111

EXAMINER	
RETTA, YEHDEGA	

ART UNIT	PAPER NUMBER
3688	

NOTIFICATION DATE	DELIVERY MODE
10/18/2018	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Application Number: 10/606,729
Filing Date: 26 Jun 2003
Appellant(s): Donian et al.

Carl A. Kukkonen
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/26/18.

(1) Grounds of Rejection to be Reviewed on Appeal

Every ground of rejection set forth in the Office action dated 10/12/16 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."

(2) Response to Argument

Regarding the rejection under 112, according to the specification … if a user begin segment 434 at a point of entry, the player will begin the segment 434 at its point of entry, followed at its end by ad block 412 (see Fig. 4A),… the pre-defined sequencing is to play ad block 412 after media segment 434… if the user skips to a next media segment after playing a first media segment the first ad block (which follows the first media segment) is played before the user is allowed to skip to the next segment.

In any situation, the ad that follows the media segment is played after the media segment that precede it. Thus, the insertion point of the ads remain in the same sequence, i.e. next to the media segment. In the next example, the specification discloses that the sequencing of media segment and ad block is to play the ad after pre-defined set of media segments have been played. Even if a user skips from one segment to another, the ad location remains the same, which is after a pre-defined number of media segments (e.g. 5). Examiner could not find support for the claimed language (adaptively modifying, using pre-defined rules and in response to a user-generated input detected by the client system, *a presentation position of the digital advertising content from at least one of the one or more initial initially sequenced insertion points to one or more alternate alternatively sequenced insertion points, at least one of the one or more alternatively sequenced insertion points being located at one or more different than the one or*

more initially sequenced insertion points positions relative to the digital media content within the user-perceptible content stream).

In response to Appellant's argument regarding the 103 rejection, Knepper teaches advertisements and the media clips sequenced to be played in a predefined order. Knepper teaches when a user skips or forwards to a different media segment, the ad appended to the media would be played as a second in the sequence (the media/ad combination). Knepper teaches when a client-side user selects a particular entertainment file, the server sends entertainment file, a set of instructions indicating which media files… to insert into the entertainment file at run time, how many advertisement media files to insert (see [0041]) … an advertisement file is appended to a media file such that the entertainment and advertisement files are played to appear as a single clip ... <ADInsert> is a tag that is recognized by the client application as specific instructions regarding treatment of the advertising media files ... using this tags the server can direct the client to place an ad before, during or after a media file during playback of media files in the magazine page (see [0052] ... the client displays the entertainment media file before it plays the advertisement media file ... when the entertainment media file is finished playing, the advertisement media file immediately proceeds without the appearance of a page turn (see [0059]). Therefore, when the sequence of media segment changes (from a 1st in the sequence to a 3rd in the sequence, the ad position also changes adaptively with the media file. Knepper also teaches a user-perceptible content stream (media playlist or media files play together sequentially, similar to a television show with commercials inserted at various points (see fig. 1, 3, [0041]).

Appellant further argues that, in Knepper the same advertisement is always played with the same entertainment file or can be one of several advertisement files but what is not

changeable are the actual insertion locations at which advertising is presented relative to the content on any given page.

Appellant's specification discloses as follows:

[0147] Play sequence 402 is typical for a segmented title/track, by the definition of segmented media given above. ***With segmented media, the player/viewer holds a sense of particular ad blocks retaining their own sense of place in the sequence with the ads chosen to go along with a pre-determined portion of the content.*** If the consumer elects to skip around during the course of playing a segmented title, *the same block of ads plays with a particular portion of the content as the user skips back and forth through different parts of the title*, over a predetermined period of time and/or number of viewings. If the predetermined limit is exceeded, the player/viewer rotates in new ad blocks automatically.

[0148] Segmented titles are sequenced like television programs, in that ad breaks tend to occur at particular scheduled places in the content. The first time through viewing any particular *segmented content with ads, each block is shown before or after its associated content, and the player/viewer requires the ads to be run in their entirety.* After that, when ad blocks that have been seen already are encountered again through a user-directed repeat of a sequence in a single request session, the player/viewer may allow the user to navigate out of the ad, or possibly omit it altogether.

[0149] For example, ***if the user of [redacted] 402 jumps right into segment 434 as segment 430 is just starting, the player/viewer will begin segment 434 at its point of entry, followed at its end by ad block 412. Wherever possible, the ad block chosen for play at the end of a segment will be the one most appropriate to the actual part of the content that has played since the latest preceding ad block.***

[0150] In some cases, there may be a need to insert an ad block just before resuming play after a user-directed skip. ***For instance, if the user has watched 80% of segment 432, and then jumps into the middle of segment 434, ad block 410 plays immediately, and when it is finished, content play resumes at the point selected in segment 434.***

Knepper also show a first sequencing of media files and ad files (a playlist of media files with ad files). However, when a user does not follow the pre-set order of the playlist, by skipping media files in the sequence, the order of the playlist changes (e.g. instead of a media file being the 3rd in order, it would be a 2nd in the order), the position of the ad file also changes within the playlist.

Regarding claim 243, Appellant asserts that the claim requires " the modified user-perceptive content stream comprising an alternate insertion positon of the advertising block relative to the media section, the alternate insertion position differing from the initially defined insertion position and not having digital advertising content scheduled to be presented in it in the user-perceptible content stream prior to the adaptively re-sequencing". The claimed language, (adaptively modifying, using pre-defined rules and in response to a user input detected by the client system, a presentation position of the digital advertising content from at least one of the one or more initially sequenced insertion points to one or more alternatively sequenced insertion points, *at least one of the one or more alternatively sequenced insertion points being different than the one or more initially sequenced insertion points relative to the digital media content* within the user-perceptible content stream), have been addressed under the 112 rejection.

The claim recites *receiving a media content and advertising content*, … sequencing (ordering) the media content into a user-perceptive content stream, … comprising an ad block… with which an *advertising content is scheduled to be presented*, the advertising block being arranged at an initially defined insertion position relative to the media section. The claim further recites … adaptively re-sequencing… to reflect a user input detected …. *not having digital advertising content scheduled to be presented … prior to the re-sequencing* …

Knepper also teaches when a client-side user selects a particular entertainment file, the server sends entertainment file, a set of instructions indicating which media files… to insert into the entertainment file at run time, how many advertisement media files to insert (see [0041]

Appellant also asserts that Knepper expressly states that "no user intervention" (in Fig. 4) is permitted with regards to the page structure itself or with the combination of content and advertising). It is unclear how the language, "no user intervention", is correlated with the claimed limitation. In Knepper, user intervention is required to change the sequence of the

playlist, by skipping or forwarding. Knepper also teaches that for playback of the show to occur on the client three components are used, … entertainment rich media files, advertisement rich media files, an instruction set, or text file, that describes the assembly and playback order of the media files… (which does not require user intervention) (see [0024]-[0027]).

Regarding the rejection under 101, the claimed steps of sequencing and re-sequencing of media content and advertising content, are not similar to the claims in Enfish, Bascom, McRO or Core Wireless. The claims in the current application do not provide … improvement upon prior art information search and retrieval systems by employing a flexible, self referential table to store data (as in Enfish), installation of a filtering tool at a specific location, remote from the end-users, with customizable filtering features specific to each end user (as in BASCOM), … or a specific way to solve the problem of producing accurate and realistic lip synchronization and facial expressions in animated characters, which improves the animation process, as in McRo, etc.,.

The claims reciting generic components (client device and remote device) for performing the steps of receiving, sequencing, re-sequencing, presenting, storing, etc., merely describing the functions of the abstract idea itself, without particularity, which is not enough under step two.

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

Respectfully submitted,

/YEHDEGA RETTA/
Primary Examiner, Art Unit 3688

Conferees:

/KAMBIZ ABDI/
Supervisory Patent Examiner, Art Unit 3688

/ALEXANDER G KALINOWSKI/
Supervisory Patent Examiner, Art Unit 3691

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.

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From: PAIR_eOfficeAction@uspto.gov
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Application	Document	Mailroom Date	Attorney Docket No.
10606729	APEA	10/18/2018	42327-501001US

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Thank you for prompt attention to this notice,

UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION INFORMATION RETRIEVAL SYSTEM

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Philip M. Donian, *et al.*

Application No.: 10/606,729 | Confirmation No.: 5831

Filed: June 26, 2003 | Art Unit: 3688

For: METHOD AND APPARATUS FOR THE FREE LICENSING OF DIGITAL MEDIA CONTENT | Examiner: Yehdega Retta

FILED VIA EFS
Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Appellant files this Reply Brief pursuant to 37 C.F.R. § 41.41 in further support of the Appeal Brief filed on July 26, 2018 (hereafter the "Appeal Brief") and in response to the Examiner's Answer mailed on Oct. 18, 2018 (hereafter the "Answer").

As this Reply Brief is filed within two months of the mailing date of the Answer, it should be entered and considered in accordance with 37 C.F.R. § 41.41(a)(1). **Payment of the forwarding fee required under 37 C.F.R. § 41.45 is submitted concurrently herewith**. No additional fees are believed to be due.

The Commissioner is hereby authorized to charge any additional fees that may be due, or credit any overpayment of same, to Deposit Account No. **50-0311**, Reference No. Attorney's Docket No. **42327-501001US**.

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I. STATUS OF CLAIMS

In the Office Action, the Office rejected claims 212, 214-223 and 225-273 under 35 U.S.C. §112, first paragraph as allegedly failing to comply with the written description requirement.

The Office further rejected claims 212, 214-223 and 225-273 under 35 U.S.C. §101 as allegedly being drawn to non-statutory subject matter.

Claims 212, 214-223, 225-232, 234-249, 251-255 and 257-273 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentably obvious over Knepper et al., Patent Application Publication No. 2001/0042249 ("Knepper") in view of Hannah et al., U.S. Patent No. 7,761,327 ("Hannah") and further in view of Wang, Patent Application Publication No. 2002/0191950 ("Wang").

Appellant appeals the final rejections of independent claims 212, 238, 243, 267, 268, and 271. All of the remaining, pending dependent claims depend at least indirectly from one of claims 212, 238, 243, 267, 268, and 271, and are therefore patentable subject to the outcome of this appeal.

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II. ARGUMENT

§ 112 Rejection

The Answer relies on new rationale to support the § 112 grounds of rejection. Particularly, the Final Action of December 10, 2016 (hereafter the "Final Action") refers to pars. 0117, 0133 and 0236 of the Specification as a means to support the § 112 grounds of rejection. *Final Act. 5-6.* In the Answer, the Examiner now refers to FIG. 4A of the Specification without providing any direct citations to any paragraphs in the Specification. *Answer 3-4.* A review of the Specification and the figures seems to suggest that the new arguments in the Answer are mainly directed to the sequence of events illustrated at the top portion of FIG. 4A. These new arguments were not presented in the Final Action to support the § 112 grounds of rejection.

Appellant respectfully submits that new arguments, introduced at the appeal stage, and not necessitated by arguments presented in the Appeal Brief, constitute new grounds of rejection. These new arguments should not be considered by the United States Patent Trial and Appeal Board (PTAB) Panel because such new grounds would effectively require for the prosecution to be reopened. Respectfully, the Panel's consideration of any new grounds of rejection, asserted after prosecution has been closed, would deprive the Appellant from the opportunity to properly respond or amend the claims prior to initiating the costly appeal process, and would also incentivize piecemeal prosecution by the Examining Corps.

Furthermore, MPEP 1207.01 provides if "the examiner's answer contains a new ground of rejection, it *must* clearly designate the rejection as a new ground of rejection. 37 CFR 41.39 specifies that new grounds of rejection *must* be approved by the Director - i.e., Director of the USPTO … The answer *must* also include the signature of a Technology Center (TC) Director or designee to indicate that they approve the new ground of rejection" (emphasis added). The Answer fails to meet any of the indicated 1207.01 requirements. Therefore, the new § 112 arguments submitted in the Answer should not be considered.[1]

[1] The Applicant contends the Examiner's findings should be reversed on all grounds as provided in this Reply Brief and all the pending claims should be allowed. However, should the Panel not reach that conclusion, at least the Panel should remand the case to the Examiner to reopen prosecution under newly asserted § 112 grounds of rejection.

Notwithstanding the above defects, in both the Final Action and the Answer, the Examiner seems to selectively rely on portions of the Specification which, according to the Examiner, do not support the claim language, effectively ignoring other portions of the Specification that provide adequate support, as highlighted in the Appellant's prior replies and in the Appeal Brief. *See* App. Br. 18-20 (referring to paragraphs 149-150, 154-156 and FIG. 4A (sequence 404)).

As best understood by the Appellant, the Examiner's main § 112 arguments are:

> (1) an "ad that follows a media segment is played after the media segment." Therefore, "the insertion point of the ads remain in the same sequence, i.e., next to the media segment," and
>
> (2) the Examiner cannot find *ipsissimis verbis* support in the Specification.
>
> *Answer 3*.

The first argument is based on an incorrect construction of the claim language. The claim language in question recites:

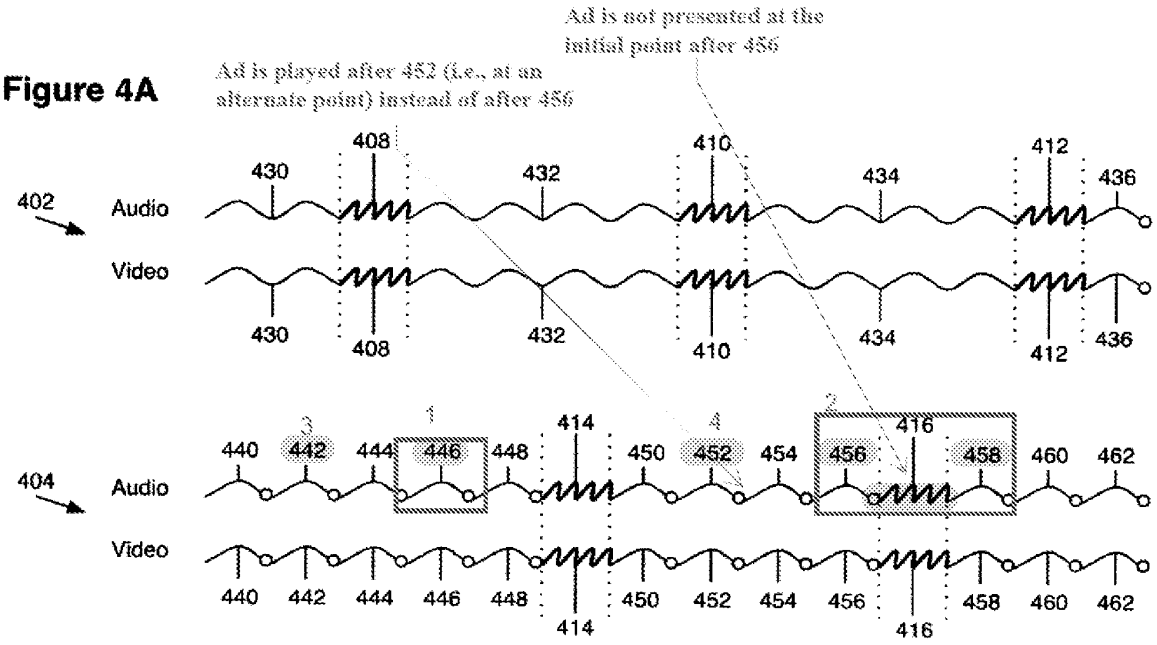
> "adaptively modifying … a *presentation position* of the digital advertising content from … initially sequenced *insertion points* to … alternatively sequenced insertion points." (emphasis added).

As best understood by the Appellant, the Examiner seems to be misconstruing the claim language as requiring the modification of the initial ad "*insertion points*" in the media stream, whereas the claim recites modifying "a *presentation position*" of the ad content regardless of the point the ad was scheduled to be inserted in the stream initially. In other words, in a media stream, an ad segment may be initially scheduled to be *inserted* following a media segment. However, the point of initial insertion in the stream is not the same as the recited "*presentation position*" of the ad content during play. As provided in further detail below, it is the "*presentation position*" of the ad in the stream that may be adaptively modified (e.g., due to user input), as claimed and as clearly supported in the Specification.

Referring to FIG. 4A and pars. 0154-0156, as highlighted in the Appellant's prior replies and in the Appeal Brief, **sequence 404** includes "tracks 440, 442, 444, 446, and 448 in series,

followed by ad block 414, and then tracks 450, 452, 454, and 456." As shown, ad block 416 comes after track 456, "followed by tracks 458, 460, and 462."[2]

Figure 4A



For example, in sequence 404, consider a case where the program is using a track allowance method for ad placement, with an initial allowance of 5 tracks per ad block. If the user decides to play track 446 and then track 456, the program does not insert ad block 416 immediately after track 456. Instead, play goes directly into track 458, because the allowance is 5 tracks. If the user plays through most of track 458, then jumps to the beginning of track 442 and plays it, there is still allowance for one more track after that, since only four tracks (446, 456, 458, and 442) have played so far. If the user then jumps to track 452, an ad block will play immediately after track 452 completes, or if the user attempts to leave track 452 after hearing most of it but before it completes, because it is the fifth track. This ad block will be assembled extemporaneously to go with the five tracks that were played, and there is no retained sense of recurring blocks falling at specific points when the user skips around between tracks in a play-list. Typically, ad blocks interspliced in this way require full play with each occurrence, and the player/viewer manages its adaptive ad selection to present new ads every time, to a certain extent.

[2] *See also* App. Br. 18-20 (referring to paragraphs 149-150, 154-156 and FIG. 4A (sequence 404)).

Referring more particularly to the annotated FIG. 4A and par. 0156, "[i]f the user decides to play track 446 [*step 1*] and then track 456 [*step 2*], the program does not insert ad block 416 immediately after track 456." In other words, ad block 416 is not *presented* at the "initially sequenced insertion point" after 456. "Instead, play goes directly into track 458" [*step 2 continues*]. Then "the user plays through most of track 458, then jumps to the beginning of track 442 [*step 3*] and plays it." As such, ad block 416 that was to be *presented* at an initial insertion point in the sequence (i.e., a point between media tracks 456 and 458) is skipped. Par. 0156 further discloses "[i]f the user then jumps to track 452 [*step 4*], an ad block will play immediately after track 452 completes."

In other words, an ad block will be *presented* at "an alternatively sequenced insertion point" after track 452 and before track 454, where initially no ad blocks were to be presented. The remaining claim language "at least one of … alternatively sequenced insertion points being different than the one or more initially sequenced insertion points" simply recites that the presentation point of an ad during play may be at a different point (i.e., an alternate insertion point in the stream) than initially arranged. This change in presentation time as explained above and in the referenced portions of the Appellant's application, may be due to user input (e.g., user interaction to skip forward or backward), as claimed.

MPEP §2163.02 provides that the objective standard for determining compliance with the written description requirement is whether the description clearly allows persons "of ordinary skill in the art to recognize that [the inventor] invented what is claimed."[3] To satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed. If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description

[3] See, *e.g. In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Under *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

requirement is met.[4]

For the reasons provided above, the Appellant respectfully submits that the Specification adequately supports the recited claim language in claim 212 directed to: "*adaptively modifying, using pre-defined rules and in response to a user input detected by the client system, a presentation position of the digital advertising content from at least one of the one or more initially sequenced insertion points to one or more alternatively sequenced insertion points, at least one of the one or more alternatively sequenced insertion points being different than the one or more initially sequenced insertion points relative to the digital media content within the user-perceptible content stream*."

"The examiner has the initial burden, after a thorough reading and evaluation of the content of the application, of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims. There is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed."[5]

The Examiner, instead of considering portions of the Specification that support the claim language (as suggested in the prior replies and during the Examiner Interview of January 8, 2016), continues to misconstrue the claim language and refers to portions of the Specification that the Examiner erroneously construes as not being related to the claimed features. The Examiner has unfortunately failed to thoroughly evaluate the entire content of the application. The Examiner's continued reference to select portions of the Specification cannot be used as evidence that other portions of the Specification are somehow insufficient to satisfy the written description requirement. Therefore, it is respectfully submitted that the Examiner has erred in rejecting the claims under § 112.

As to the second argument re Examiner not being able to find word-for-word support for

[4] See, *e.g.*, *Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d at 1116; and *Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972) (stating "the description need not be *ipsissimis verbis* [i.e., "in identical words"] to be sufficient").
[5] *In re Wertheim*, 541 F.2d 257 at 262.

the claim language, §112 requires for the specification to adequately support the subject matter claimed, rather than mirroring the claim language word-for-word.[6] Support can be provided "in a variety of ways" and "using such descriptive means as words, structures, figures, diagrams, and formulas" to "show that the applicant was in possession of the claimed invention."[7]

It is respectfully submitted that one of ordinary skill in the art, upon reviewing the illustration in FIG. 4A, in combination with the teachings of pars. 0150 and 0154-0156, would have clearly understood that the disputed claim language is adequately supported. This is because the noted portions of the Application particularly disclose that an ad block's *presentation position* in sequences 402 and 404, for example, may be modified to a new point in the sequence, depending on user input (i.e., user interaction).

By way of a specific example, the Specification clearly provides that, in sequence 404, ad block 416 originally scheduled to be *presented* at an *initially sequenced insertion point* (i.e., following track 456 and preceding track 458) may be *adaptively modified* to be *presented* at *an alternatively sequenced insertion point* (i.e., following track 452 and preceding track 454). A similar analysis may also be applied to sequence 402, where the *presentation position* of the advertising content may be *adaptively modified* as well (e.g., to an alternate point in the presentation timeline).

For the above reasons, the Application as filed *adequately* supports the rejected claim language under § 112. Accordingly, all pending § 112 grounds of rejection should be reversed.

§ 103 Rejection

The Answer primarily relies on *Knepper et al.*, Patent Application Publication No. 2001/0042249 (hereafter "Knepper") as teaching the claimed elements. *Answer 4-7.* On page 6 of the Answer, the Examiner argues claim language related to "*adaptively modifying, using pre-defined rules and in response to a user input detected by the client system, a presentation position*

[6] MPEP 2163, *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116 (emphasis added).
[7] *Lockwood v. American Airlines, Inc.,* 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). See, e.g., *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998) (emphasis added).

of the digital advertising content from at least one of the one or more initially sequenced insertion points to one or more alternatively sequenced insertion points, at least one of the one or more alternatively sequenced insertion points being different than the one or more initially sequenced insertion points relative to the digital media content within the user-perceptible content stream" is "addressed under the 112 rejection," without citing any references. Accordingly, the Examiner essentially admits that neither Knepper nor any of the other cited references teach or suggest all the claimed elements in the above "*adaptively modifying"* step.

A review of the Final Action and the Answer confirms that the Examiner has failed to refer to any portions in Knepper or any of the other cited references that teach all the elements recited in the above "*adaptively modifying*" step. The Examiner seems to at least partially base the § 103 grounds of rejection on her interpretation of the claim language not including all the explicitly recited elements in the "*adaptively modifying*" step. As noted in the Appeal Brief, page 27, MPEP §2103 provides "each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement." Accordingly, the Examiner has committed reversible error by failing to consider the explicitly recited claim features in at least the "*adaptively modifying*" step. That is, the Examiner has relied on an unfounded allegation of lack of written description under § 112 to avoid citing a proper reference for claim features not considered.

All words in a claim must be considered in judging the patentability of that claim against the prior art.[8] If the cited references fail to disclose each specific and explicit limitation of the claimed subject matter, the Office has failed to establish a valid prima facie case for obviousness under 35 U.S.C. §103.[9] The Examiner, neither in the Final Action nor in the Answer, has provided any cogent arguments or evidence that the disputed features under § 112 are disclosed or suggested in any of the cited references. Therefore, § 103 grounds of rejection are defective because the Examiner has failed to establish a rational basis for how any of the cited references teach every recited feature in the "*adaptively modifying"* step, either individually or in combination. At least for this reason alone, the § 103 grounds of rejection should be reversed.

[8] *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).
[9] See *e.g.* MPEP §706.02(j) citing *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

On pages 4 and 5 of the Answer, the Examiner attempts to rebut Appellant's arguments that "in Knepper the same advertisement is always played with the same entertainment file … but what is not changeable are the actual insertion locations" by referring to certain paragraphs in the Appellant's Specification, namely pars. 0147-0150. By this, the Examiner is apparently trying to import, into the claim, selectively cherry-picked language from the Specification to construe the claim beyond its plain meaning. It is improper for the Examiner to construe the claim language as matching the teachings of a cited reference based on an out-of-context interpretation of selected parts of the Specification.

The claim language specifically recites "*adaptively modifying, using pre-defined rules and in response to a user input detected by the client system, a presentation position of the digital advertising content from at least one of the one or more initially sequenced insertion points to one or more alternatively sequenced insertion points, at least one of the one or more alternatively sequenced insertion points being different than the one or more initially sequenced insertion points relative to the digital media content within the user-perceptible content stream.*" As provided in the § 112 discussion above, the Appellant clearly sets forth how the claim language for the "*adaptively modifying*" step is supported by FIG. 4A and pars. 0150 and 0154-0156. These portions of the Specification particularly disclose that an ad block's *presentation* in a media stream (e.g., in sequence 402 or 404) may be modified to a new point in the media stream, depending on user interaction.

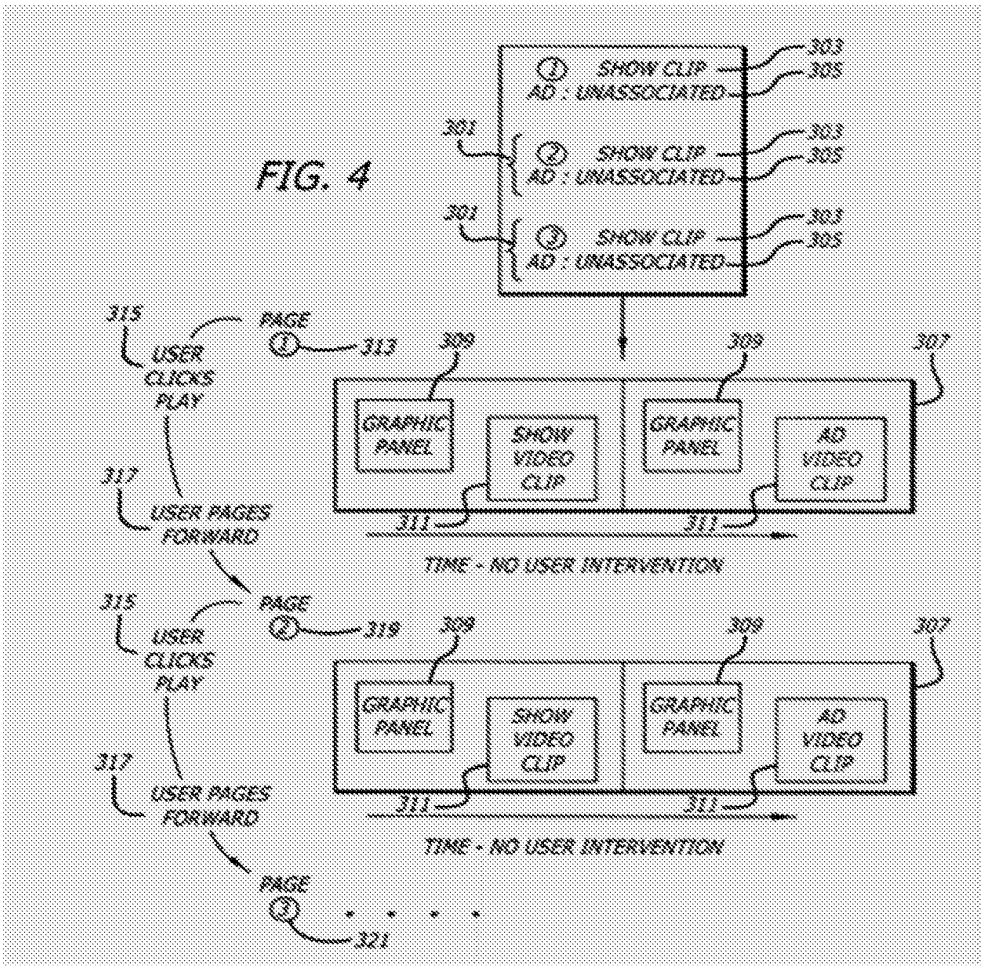
On page 5 of the Answer, the Examiner quotes from the Appellant's Specification, with added emphasis, as follows:

> "[0150] In some cases, there may be a need to insert an ad block just before resuming play after a user-directed skip. ***For instance, if the user has watched 80% of segment 432, and then jumps into the middle of segment 434, ad block 410 plays immediately, and when it is finished, content play resumes at the point selected in segment 434***."

The Examiner argues, "Knepper also shows [sic] a first sequencing of media files and ad files (a playlist of media files with ad files). However, when a user does not follow the pre-set order of the playlist, by sipping media files in the sequence, the order of the playlist changes." As

clearly articulated in the Appeal Brief, pages 21 through 26, Knepper specifically bars the user from interacting with a page 307 comprised of media content and advertising content, to which the Examiner refers to as "a playlist of media files with ad files." *Answer 5*. This teaching in Knepper is exactly opposite to the teaching of the claimed "*adaptively modifying*" step.

Referring to FIG. 4, reproduced below, Knepper emphasizes in all capital letters: "NO USER INTERVENTION."



Further, Knepper, par. 0038 provides:

"[0038] Thus, as shown in FIG. 4, an example of this invention involves show clips 301, each comprising an entertainment video media file 303 and an

> advertisement video media file 305. The playback of any show clip 301 occurs within an area on a computer screen denoted at "page" 307. Each page 307 comprises two sub-areas, namely, a graphic panel 309 that displays a static image and a clip panel 311 that displays a moving picture. In the example illustrated by FIG. 4, a user views a first page on his client-side computer screen and clicks a "play" button 313 displayed on the page. The assembled clip, comprising both the entertainment media files 303 and the advertisement media files 305, then plays within a page 307. While a fully assembled show clip preferably consists of separate media files such as an entertainment media file 303 and an advertisement media file 305, **it proceeds through playback within the single page 307 to have the appearance of a single, continuous clip to the user. In other words, the user cannot discern the individuality of entertainment media files 303 and advertisement media files 305 because they are played seamlessly in series**." (emphasis added).

"A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention."[10] The above portions of Knepper expressly teach away from the claimed "adaptively modifying … *in response to a user input* … a presentation position of the digital advertising content from at least one of the one or more initially sequenced insertion points to one or more alternatively sequenced insertion points" (emphasis added). Therefore, Knepper is an improper § 103 reference because one of ordinary skill in the art would not have been motivated to modify a reference that explicitly teaches away or disparages a claimed feature in view of the teachings of a secondary reference.[11]

In summary, the Examiner improperly insists on an erroneous construction of the claim language under § 112 in an attempt to ignore explicitly recited features in the claims. Based on the erroneous construction, the Examiner further incorrectly argues that the Office is not required to consider certain claim features (e.g., all the elements in the claimed *adaptively modifying* step) under § 103 obviousness analysis due to lack of support under § 112. However, as noted above, every element recited in the claims is adequately supported by in the Appellant's Specification. Because the Examiner cannot selectively ignore portions of the claim language when construing a claim and also because the primary reference, Knepper, teaches away from the claimed features, it is respectfully submitted that all pending § 103 grounds of rejection should be reversed.

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[10] *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).
[11] *In re Grasselli,* 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

§ 101 Rejection

The Answer relies on generic conclusory arguments without any true analysis to support the § 101 grounds of rejection. The Examiner simply alleges the claimed features are "not similar" to the claims in *Enfish, Bascom, McRo or Core Wireless* and thereafter lists the specific claim features in each cited decision without any analysis. *Answer 7*. Respectfully, if the test for patent-eligibility was the similarity of claim language to the specific claim terminology used in the above four cases, then only a very small minority of inventions would be deemed patent-eligible. This line of reasoning is untenable and cannot be considered by the Panel as an appropriate response to the Appellant's arguments presented in the Appeal Brief. *See App. Br. 29-40*.

In the Appeal Brief, Appellant specifically provided several reasons why the § 101 grounds for rejection have been improperly asserted by the Examiner. It was particularly pointed out that the two primary decisions relied upon in the Final Action (i.e., *SmartGene, Cyberfone*) were non-precedential and therefore inapplicable. *See November 2016 Memo*, p. 4; *see also* MPEP § 2106.07(a). Respectfully, the Examiner has not provided an appropriate reply to the Appellant's well-articulated reasons supporting patent-eligibility. Instead, the Examiner has simply concluded "[t]he claims reciting generic components … for performing the steps of receiving, sequencing, re-sequencing, presenting, storing, etc., merely describe [sic] the functions of the abstract idea itself, *without particularity*, which is not enough under step two." *Answer 7* (emphasis added).

It is unclear to the Appellant which part of the claim lacks "*particularity*" as alleged in the Answer. The claims are not result-centric, nor are the claims drafted in a manner that could be interpreted as pre-empting all applications of some abstract idea. Rather, the claims are drafted to recite how the claimed subject matter functions. For example, every step of claim 212 reproduced below particularly recites features that claim with particularity how each step is implemented:

> 212. (Previously Presented) A method comprising:
>
> receiving, on a client system, data comprising digital media content and digital advertising content;
>
> sequencing the digital media content and the digital advertising content, the sequencing comprising ordering at least some of the digital media content and

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at least some of the digital advertising content into a user-perceptible content stream, the user-perceptible content stream comprising one or more initially sequenced insertion points at which the digital advertising content is scheduled to be presented relative to the digital media content;

adaptively modifying, using pre-defined rules and in response to a user input detected by the client system, a presentation position of the digital advertising content from at least one of the one or more initially sequenced insertion points to one or more alternatively sequenced insertion points, at least one of the one or more alternatively sequenced insertion points being different than the one or more initially sequenced insertion points relative to the digital media content within the user-perceptible content stream;

causing presentation of the user-perceptible content stream at the client system after the adaptively modifying;

keeping a setting in a first memory to indicate a current state of play, the setting including a value to indicate whether presentation of a required part of the digital advertising content is in progress during presentation of the user-perceptible content stream;

disallowing a navigation choice that alters a course of playback of the user-perceptible content stream while presentation of the required part of the digital advertising content is in progress; and

storing, in a second memory, presentation data comprising an indication of the digital advertising content that has been presented,

wherein the receiving, the sequencing, the adaptively modifying, the causing, the keeping, the disallowing, and the storing are performed by one or more programmable processors.

To wit, instead of addressing each claimed feature as required under the *Berkheimer Memo,*[12] the Examiner continues to rely on the impermissible generalization and abstraction of the claim to its gist in order to establish a prima facie case. *Final Action* 3, Answer 7. The November 2016 Memo, citing *McRO*, provides:

Examiners should consider the claim as a whole under Step 2A of the USPTO's SME guidance, and should not overgeneralize the claim or simplify it into its "gist" or core principles, when identifying a concept as a judicial exception.

[12] See examination procedure published online by the USPTO on April 19, 2018, entitled "Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP, Inc.* 881 F.3d 1360 (Fed. Cir. 2018))."

> [] An "improvement in computer-related technology" is not limited to improvements in the operation of a computer or a computer network *per se*, but may also be claimed as a set of "rules" (basically mathematical relationships) that improve computer-related technology by allowing computer performance of a function not previously performable by a computer. *November 2016 Memo*, p. 2. (emphasis added).

Moreover, a recent decision by the Patent Trial and Appeal Board issued Oct. 15, 2018 (hereafter "the *PTAB Decision '084*") is attached herein. As provided in the highlighted portions, § 101 grounds of rejection, where the Office Action fails to follow the requirements of the *Berkheimer Memo,* are procedurally defective and constitute Examiner Error.

The *PTAB '084 Decision* holds that under the *Berkheimer Memo*, there is a "fact finding requirement for Examiners, as applicable to rejections under § 101. Specifically, Examiners must now provide specific types of evidence to support a finding that claim elements (or combinations of elements) are well-understood, routine, and conventional."[13] Furthermore, MPEP § 2106.07 (9th ed. Rev. 08.2017, Jan. 2018) makes clear that the initial burden of establishing a prima facie case of ineligibility under § 101 is on the Examiner to explain clearly and specifically why claims are ineligible, so that the applicant has sufficient notice and can respond effectively.[14]

Here, the Examiner's reasoning that the claimed subject matter is directed to an abstract idea, without providing a clear analysis under Step 2A or 2B, let alone any evidentiary support for the asserted conclusory statements, is insufficient to establish a prima facie case. Simply put, the Examiner's determinations that the claims do not amount to significantly more than the abstract idea are predicated on unsupported findings and do not follow the *Berkheimer Memo's* procedural requirements. For at least this reason, neither the Final Action nor the Answer has provided adequate evidentiary support to establish a prima facie case of ineligibility under § 101.

It is further submitted that the Final Action is defective in that the Examiner has relied on hindsight or Examiner's own opinion in the § 101 analysis to support why the claimed features are well-understood, routine, and conventional. These conclusory statements do not meet the

[13] *PTAB '084 Decision* (emphasis added).
[14] *Id.*

Berkheimer requirements. Because the proper procedure required under the *Berkheimer Memo* has not been followed, the § 101 grounds of rejection should be reversed.

Moreover, it is noteworthy that claim 212 specifically recites:

1. a *computing structure* (i.e., user-perceptible content stream, sequenced insertion points, setting in a first memory to indicate a current state of play, etc.)

2. implemented to *operate in a particular manner* (i.e., sequencing the digital media content and the digital advertising content … into a user-perceptible content stream, … adaptively modifying, using pre-defined rules … a presentation position of the digital advertising content from … initially sequenced insertion points to … alternatively sequenced insertion points, etc.)

3. in order to provide *specific improvements to computing functionality* (e.g., improve upon conventional delivery, presentation, and user interaction of media content and advertising content by way of adaptive modification of ad presentation points in a media stream, increase flexibility in the way digital advertisements may be delivered in a computing platform that delivers media streams, improve security, and optimize bandwidth, performance. *See Specification* FIG. 3A, pars. 0054, 0110-0111, 0117, 0186, and 202-204).

Referring to the recent *Ancora* decision by the Court of Appeals for the Federal Circuit, a claimed invention that meets the above three criteria is patent-eligible.[15] To determine whether claims are directed to an abstract idea, the court examines "the patent's 'claimed advance.'"[16] "In cases involving software innovations, this inquiry often turns on whether the claims focus on 'the specific asserted improvement in computer capabilities.'"[17] "Computers are improved not only through changes in hardware; '[s]oftware can make non-abstract improvements to computer technology.'"[18]

The pending claims are focused on specific (non-abstract) improvements in computing technology. For example, improvements of the claimed invention include more efficient content delivery and ad presentation, increased flexibility in the way digital advertisements may be presented over a computing platform that delivers media streams, improved security, optimized

[15] *Ancora Technologies, Inc. v. HTC America, Inc.* (Fed. Cir. Nov. 16, 2018) – Slip. 2018-1404.
[16] *Id*, 8 (quoting *Finjan, Inc. v. Blue Coat System, Inc.*, 879 F.3d 1299, 1303 (Fed. Cir. 2018).
[17] *Id.* (quoting *Enfish*, 822 F.3d 1327, 1335-36 (Fed. Cir. 2016)); *see BSG Tech LLC v. Buyseasons, Inc.*, 899 F.3d 1281, 1285–86 (Fed. Cir. 2018).
[18] *Id.* (quoting *Enfish*, 822 F.3d at 1335; *see Finjan*, 879 F.3d at 1304).

bandwidth, and improved performance. *See Specification* FIG. 3A, pars. 0054, 0110-0111, 0117, 0186, and 202-204. These improvements directly enhance the computing functionality itself, due to the functional and structural capabilities and features recited in the claimed inventive steps, not because the computer simply speeds up the execution of the claimed processes.

In *Ancora*, claims directed to use of software for improving computer security were held to be not abstract, because the claimed software invention improved secure access to a computer (i.e., prevented unauthorized use of a program) via a "*specific technique*" to "*solve a specific computer problem.*"[19] Similar to *Ancora*, in the pending claims, specific computer problems (i.e., undesirable skipping over required ad content, inconvenient interruption in media streaming, etc.) are solved by the recited advancements in computing techniques and the use of particular computing structures and processes (i.e., sequencing the digital media content and the digital advertising content into a user-perceptible content stream, adaptively modifying, using pre-defined rules, a presentation position of the digital advertising content from initially sequenced insertion points to alternatively sequenced insertion points, etc.).

In *Enfish, LLC v. Microsoft Corp*, claims at issue were not directed to an abstract idea because the particularly claimed computing structure (i.e., self-referential tables) improved the way that computers operated and handled data (i.e., the claimed self-referential tables allowed the more efficient launching and adaptation of databases).[20] Similar to *Enfish*, in the pending claims, *sequencing the digital media content and the digital advertising content into a user-perceptible content stream and adaptively modifying a presentation position of the digital advertising content from initially sequenced insertion points to alternatively sequenced insertion points* provide notable improvements in ad delivery and presentation, increase flexibility in the way digital advertisements may be delivered over a computing platform that delivers media streams, and improve security, bandwidth, and performance in the media streaming computer infrastructure itself.

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[19] *Id*, 10 (emphasis added); s*ee also Finjan*, 879 F.3d at 1304–05.
[20] *Enfish*, 1336; *see BSG*, 899 F.3d at 1288 (noting that the self-referential table in *Enfish* "enabled programmers to construct databases in new ways that required less modeling and configuring of various tables prior to launch"); *Finjan*, 879 F.3d at 1304–05 (describing *Enfish*).

In *Finjan, Inc. v. Blue Coat System, Inc.*, claims were directed to a "behavior-based virus scan" that enabled "more flexible and nuanced virus filtering" and the detection of potentially dangerous code.[21] The claims thus were directed to "a non-abstract improvement in computer functionality" having the benefit of achieving greater computer security.[22] Similar to *Finjan*, pending claims recite how use of specific computing structure and technique (i.e., *sequencing the digital media content and the digital advertising content into a user-perceptible content stream and adaptively modifying a presentation position of the digital advertising content from initially sequenced insertion points to alternatively sequenced insertion points*) provide specific non-abstract improvements to computer functionality as noted above.

In *Core Wireless Licensing S.A.R.L. v. LG Electronics, Inc.*, claims to a method for making websites easier to navigate were not directed to an abstract idea of indexing information.[23] The claims were found eligible because the claims "were directed to a specific type of index for a specific type of user."[24] Similar to *Core Wireless*, the pending claims here cannot be deemed abstract because particular computing structures (i.e., a user-perceptible content stream, sequenced insertion points, settings in a first memory to indicate a current state of play) are recited. These particular computing structures may be used to enable a specific use and functionality in a computing system to improve particular computing operations, as noted above.

In accordance with the above precedents, pending claims are not directed to an abstract idea because improving conventional advertisement delivery methods by way of adaptive modification of ad presentation points in a media stream increases flexibility in the way digital advertisements may be presented in a computing platform that delivers media streams. The claimed features amount to non-abstract improvements in computer functionality enabled by an inventive process and technique that departs from earlier approaches.

For the above reasons, all pending § 101 grounds of rejection should be reversed.

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[21] *Finjan*, 879 F.3d at 1304.
[22] *Id.* at 1305.
[23] *Core Wireless,* 880 F.3d 1356, 1362-1363 (Fed. Cir. 2018).
[24] *Ancora* 9-10.

CONCLUSION

For the above reasons, reversal of the pending rejection of claims 212, 214-223 and 225-273 is respectfully requested. If there are any questions regarding this Reply Brief, the undersigned may be contacted at the telephone number provided below.

Dated: December 18, 2018

Respectfully submitted,

/FJF/

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United States Court of Appeals for the Federal Circuit

ANCORA TECHNOLOGIES, INC.,
Plaintiff-Appellant

v.

HTC AMERICA, INC., HTC CORPORATION,
Defendants-Appellees

2018-1404

Appeal from the United States District Court for the Western District of Washington in No. 2:16-cv-01919-RAJ, Judge Richard A. Jones.

Decided: November 16, 2018

MARC LORELLI, Brooks Kushman PC, Southfield, MI, argued for plaintiff-appellant. Also represented by MARK A. CANTOR, JOHN S. LE ROY, JOHN P. RONDINI.

IRFAN A. LATEEF, Knobbe, Martens, Olson & Bear, LLP, Irvine, CA, argued for defendants-appellees. Also represented by BRIAN CHRISTOPHER CLAASSEN, DANIEL C. KIANG, JOSEPH R. RE.

Before DYK, WALLACH, and TARANTO, *Circuit Judges*.

TARANTO, *Circuit Judge*

Ancora Technologies, Inc.'s U.S. Patent 6,411,941 is entitled "Method of Restricting Software Operation Within a License Limitation." The patent describes and claims methods of limiting a computer's running of software not authorized for that computer to run. It issued in 2002, and the patentability of all claims was confirmed in a reexamination in 2010. The '941 patent was previously before this court in *Ancora Technologies, Inc. v. Apple, Inc.*, 744 F.3d 732 (Fed. Cir. 2014), which involved a 2011 infringement suit against Apple that raised issues of claim construction and indefiniteness in this court.

Ancora brought this action against HTC America and HTC Corporation in 2016, alleging infringement of the '941 patent. HTC moved to dismiss on the ground that the patent's claims are invalid because their subject matter is ineligible for patenting under 35 U.S.C § 101. The district court granted HTC's motion to dismiss, concluding that the claims are directed to, and ultimately claim no more than, an abstract idea.

We reverse. Under *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016), and related authorities, we conclude, the claims at issue here are not directed to ineligible subject matter. Rather, we hold, the claimed advance is a concrete assignment of specified functions among a computer's components to improve computer security, and this claimed improvement in computer functionality is eligible for patenting. As a result, the claims are not invalid under § 101.

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Describing aspects of the prior-art methods it seeks to improve, the '941 patent states that "[n]umerous methods have been devised for the identifying and restricting of an unauthorized software program's operation." '941 patent,

col. 1, lines 12–14. For example, software-based methods exist that require writing a license signature on the computer's hard drive, but a flaw in those methods is that such a signature can be changed by hackers without damaging other aspects of computer functionality. *Id.*, col. 1, lines 19–26. Hardware-based methods exist that require inserting a dongle into a computer port to authenticate the software authorization, but those methods are costly, inconvenient, and not suitable for software sold and downloaded over the internet. *Id.*, col. 1, lines 27–32.

The '941 patent describes an asserted improvement based on assigning certain functions to particular computer components and having them interact in specified ways. The proposed method "relies on the use of a key and of a record." *Id.*, col. 1, lines 40–41. A "key," which is "a unique identification code" for the *computer*, is embedded in the read-only memory (ROM) of the computer's Basic Input Output System (BIOS) module: the key "cannot be removed or modified." *Id.*, col. 1, lines 45–51. A "record" is a "license record" associated with a particular *application*: "each application program that is to be licensed to run on the specified computer[] is associated with a license record[] that consists of author name, program name[,] and number of licensed users (for network)." *Id.*, col. 1, lines 52–57.

The asserted innovation of the patent relates to where the license record is stored in the computer and the interaction of that memory with other memory to check for permission to run a program that is introduced into the computer. The inventive method uses a modifiable part of the BIOS memory—not other computer memory—to store the information that can be used, when a program is introduced into the computer, to determine whether the program is licensed to run on that computer. BIOS memory is typically used for storing programs that assist in the start-up of a computer, not verification structures comparable to the software-licensing structure embodied

by the claimed invention. Using BIOS memory, rather than other memory in the computer, improves computer security, the patent indicates, because successfully hacking BIOS memory (*i.e.*, altering it without rendering the computer inoperable) is much harder than hacking the memory used by the prior art to store license-verification information. *Id.*, col. 3, lines 4–17; *see Ancora*, 744 F.3d at 733–34 ("Thus, the inventors stated that their method makes use of the existing computer hardware (eliminating the expense and inconvenience of using additional hardware), while storing the verification information in a space that is harder and riskier for a hacker to tamper with than storage areas used by earlier methods.").

More specifically: The method calls for storage of a license record in a "verification structure" created in a portion of BIOS memory that, unlike the ROM of the BIOS, "may be erased or modified"—for example, an Electrically Erasable Programmable Read Only Memory (E^2PROM), which may be altered by "using E^2PROM manipulation commands." *Id.*, col. 1, line 65 through col. 2, line 5. The role of the verification structure is to "indicate that the specified program is licensed to run on the specified computer." *Id.*, col. 1, lines 60–62. "This is implemented by encrypting the license record (or portion thereof) using [the computer-specific] key (or portion thereof) . . . as an encryption key." *Id.* at lines 59–67. When a program has been loaded into the computer's volatile memory (*e.g.*, Random Access Memory), the computer, in order to verify authorization to run that program, "accesses the program under question, retrieves therefrom the license record, encrypts the record utilizing the specified unique key . . . and compares the so encrypted record" to the one stored in the verification structure in the (erasable, modifiable) BIOS. *Id.*, col. 2, lines 10–19. If the newly encrypted record does not match the one in the BIOS, the program is halted or other action is taken. *Id.* at lines 19–26.

In the district court, the parties focused their arguments on claim 1 of the '941 patent. We therefore discuss only that claim. It reads as follows:

> 1. A method of restricting software operation within a license for use with a computer including an erasable, non-volatile memory area of a BIOS of the computer, and a volatile memory area; the method comprising the steps of:
>
> selecting a program residing in the volatile memory,
>
> using an agent to set up a verification structure in the erasable, non-volatile memory of the BIOS, the verification structure accommodating data that includes at least one license record,
>
> verifying the program using at least the verification structure from the erasable non-volatile memory of the BIOS, and
>
> acting on the program according to the verification.

Id., col. 6, line 59 through col. 7, line 4.

B

On December 15, 2016, Ancora filed this action in the Western District of Washington, alleging that HTC has infringed and is infringing the '941 patent. In April 2017, HTC moved to dismiss under Rule 12(b)(6) of the Federal Rules of Civil Procedure. HTC argued that the subject matter of the claims of the patent is ineligible for patenting under 35 U.S.C. § 101.

In May 2017, HTC filed with the Patent Trial and Appeal Board a petition to institute a review of the '941 patent, on § 101 and other grounds, under the provision for review of Covered Business Method patents set forth in Section 18 of the Leahy-Smith America Invents Act,

Pub. L. No. 112-29, 125 Stat. 284, 329–31 (2011). Section 18(d)(1) excludes patents "for technological inventions" from such review. An implementing regulation calls for consideration of "whether the claimed subject matter as a whole recites a technological feature that is novel and unobvious over the prior art; and solves a technical problem using a technical solution." 37 C.F.R. § 42.301(b). On December 1, 2017, the Board rejected the request to institute a review, concluding that the '941 patent claims a technical solution to a technical problem and comes within the "technological inventions" exception for such reviews. *HTC Corp. v. Ancora Techs. Inc.*, CBM2017-00054, 2017 WL 6032605, at *3–5 (P.T.A.B. Dec. 1, 2017).

On December 14, 2017, the district court granted HTC's motion to dismiss. *Ancora Techs., Inc. v. HTC America, Inc.*, 287 F. Supp. 3d 1168, 1170 (W.D. Wash. 2017). The court followed the two-step analytic process set forth in *Alice Corp. v. CLS Bank International*, 573 U.S. 208, 134 S. Ct. 2347 (2014). At the first step, because "the claims at issue are directed toward computer-related technology," the court asked "whether the focus of the claims is on the specific asserted improvement in computer capabilities or, instead, on a process that qualifies as an 'abstract idea' for which computers are invoked merely as a tool." *Ancora Techs., Inc.*, 287 F. Supp. 3d at 1173 (quoting *Enfish*, 822 F.3d at 1335–36). The court stated that the patent claims are "not focused on how usage of the BIOS to store the verification structure leads to an improvement in computer security" and that "the erasable, non-volatile memory of the BIOS . . . is typically used to store data." *Id.* at 1174. The court concluded that the claims' "focus is on the abstract concept of selecting a program, verifying whether the program is licensed, and acting on the program according to the verification." *Id.* Proceeding then to step two of the *Alice* framework, the district court concluded that the claims contained no "inventive concept" that makes their subject matter

something significantly more than the abstract idea: in particular, "[s]pecifying that the BIOS be used to house the verification structure" calls for nothing more than "[s]toring data in the memory of a computer component that generally stores data." *Id.* at 1175.

The district court issued its final judgment on December 20, 2017. Ancora timely filed a notice of appeal on December 29, 2017. *See* 28 U.S.C. § 2107(a). We have jurisdiction to hear this appeal pursuant to 28 U.S.C. § 1295(a)(1).

II

We review the Rule 12(b)(6) dismissal de novo. *See OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362 (Fed. Cir. 2015) (following Ninth Circuit law). We recently explained:

> Eligibility under 35 U.S.C. § 101 is a question of law, based on underlying facts. Like other legal questions based on underlying facts, this question may be, and frequently has been, resolved on a Rule 12(b)(6) or (c) motion where the undisputed facts, considered under the standards required by that Rule, require a holding of ineligibility under the substantive standards of law.

SAP America, Inc. v. InvestPic, LLC, 898 F.3d 1161, 1166 (Fed. Cir. 2018) (internal citations omitted).

Section 101 defines patent-eligible subject matter as "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof." 35 U.S.C. § 101. Laws of nature, natural phenomena, and abstract ideas are not eligible matter. *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 70 (2012). A two-step analysis determines whether claim 1 of the '941 patent falls outside § 101. We ask (1) whether the claim, as a whole, is "directed to" patent-ineligible matter—here, an abstract idea—and (2)

if so, whether the elements of the claim, considered individually or as an ordered combination "'transform the nature of the claim' into a patent-eligible application." *Alice*, 573 U.S. at ___, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 78). We conclude that claim 1 is not directed to an abstract idea, and therefore we do not reach the second step.

We examine the patent's "'claimed advance' to determine whether the claims are directed to an abstract idea." *Finjan, Inc. v. Blue Coat System, Inc.*, 879 F.3d 1299, 1303 (Fed. Cir. 2018). "In cases involving software innovations, this inquiry often turns on whether the claims focus on 'the specific asserted improvement in computer capabilities . . . or, instead, on a process that qualifies as an "abstract idea" for which computers are invoked merely as a tool.'" *Id.* (quoting *Enfish*, 822 F.3d at 1335–36); *see BSG Tech LLC v. Buyseasons, Inc.*, 899 F.3d 1281, 1285–86 (Fed. Cir. 2018). Computers are improved not only through changes in hardware; "[s]oftware can make non-abstract improvements to computer technology . . . ." *Enfish*, 822 F.3d at 1335; *see Finjan*, 879 F.3d at 1304. We have several times held claims to pass muster under *Alice* step one when sufficiently focused on such improvements.

In *Enfish*, we held that the patent claims at issue were not directed to an abstract idea because the claimed self-referential tables improved the way that computers operated and handled data. The claimed self-referential tables allowed the more efficient launching and adaptation of databases. *Enfish*, 822 F.3d at 1333, 1336; *see BSG*, 899 F.3d at 1288 (noting that the self-referential table in *Enfish* "enabled programmers to construct databases in new ways that required less modeling and configuring of various tables prior to launch"); *Finjan*, 879 F.3d at 1304–05 (describing *Enfish*).

In *Visual Memory LLC v. NVIDIA Corp.*, we drew a similar conclusion about claims focused on a specific improvement in computer memory. 867 F.3d 1253, 1262 (Fed. Cir. 2017). The district court had determined that the claims were directed to the abstract concept of categorical data storage. *Id.* at 1257. We determined that the district court had erred because the patent was specifically "directed to an improved computer memory system, not to the abstract idea of categorical data storage," and therefore was not directed to an abstract idea. *Id.* at 1259. The claims were specific and limited to certain types of data to be stored. *Id.* "None of the claims recite[d] all types and all forms of categorical data storage." *Id.* As we summarized in *BSG*, the *Visual Memory* claims were directed to "an 'improved memory system' that configured operational characteristics of a computer's cache memory based on the type of processor connected to the memory system," allowing "the claimed invention to accommodate different types of processors without compromising performance." 899 F.3d at 1288. This was an improvement in computer functionality. *Visual Memory*, 867 F.3d at 1260.

In *Finjan*, we held that claims to a "behavior-based virus scan" were a specific improvement in computer functionality and hence not directed to an abstract idea. 879 F.3d at 1304. The claimed technique of scanning enabled "more flexible and nuanced virus filtering" and detection of potentially dangerous code. *Id.* The claims thus were directed to "a non-abstract improvement in computer functionality" having the benefit of achieving greater computer security. *Id.* at 1305.

In *Core Wireless Licensing S.A.R.L. v. LG Electronics, Inc.*, we held that claims to a method for making websites easier to navigate on a small-screen device were not directed to an abstract idea. 880 F.3d 1356, 1363 (Fed. Cir. 2018). The claimed method involved launching a summary window to allow small-screen users to quickly

access commonly used features of a website. *Id.* at 1359–60. Although the defendant argued that the patent was directed to the abstract idea of indexing information, we determined that the claims were directed to a specific type of index for a specific type of user and so not directed to an abstract idea. *Id.* at 1362–63.

Most recently, in *Data Engine Technologies LLC v. Google LLC*, this court held that claims to "a specific method for navigating through three-dimensional electronic spreadsheets" were "not directed to an abstract idea." 906 F.3d 999, 1007 (Fed. Cir. 2018). The method provided "a specific solution to then-existing technological problems in computers and prior art electronic spreadsheets." *Id.* at 1008. The navigation difficulties of prior-art spreadsheets were addressed "in a particular way—by providing a highly intuitive, user-friendly interface with familiar notebook tabs for navigating the three-dimensional worksheet environment." *Id.* We distinguished other cases in which we had held claims to be "simply directed to displaying a graphical user interface or collecting, manipulating, or organizing information"; the claims in *Data Engine*, we concluded, recite "a specific structure (i.e., notebook tabs) within a particular spreadsheet display that performs a specific function (i.e., navigating within a three-dimensional spreadsheet)." *Id.* at 1010–11.

In accordance with those precedents, we conclude that claim 1 of the '941 patent is not directed to an abstract idea. Improving security—here, against a computer's unauthorized use of a program—can be a non-abstract computer-functionality improvement if done by a specific technique that departs from earlier approaches to solve a specific computer problem. *See Finjan*, 879 F.3d at 1304–05. The claimed method here specifically identifies how that functionality improvement is effectuated in an assertedly unexpected way: a structure containing a license record is stored in a particular, modifiable, non-volatile

portion of the computer's BIOS, and the structure in that memory location is used for verification by interacting with the distinct computer memory that contains the program to be verified. In this way, the claim addresses a technological problem with computers: vulnerability of license-authorization software to hacking. '941 patent, col. 1, lines 12–35; *cf. HTC*, 2017 WL 6032605, at *3–5 (PTAB conclusion regarding "technological inventions"). It does so by relying on specific and unique characteristics of certain aspects of the BIOS that the patent asserts, and we lack any basis for disputing, were not previously used in the way now claimed, and the result is a beneficial reduction of the risk of hacking. '941 patent, col. 1, line 39, through col. 2, line 59; *id.*, col. 3, lines 4–17; *id.*, col. 6, lines 59–67. The prosecution history reinforces what the patent itself indicates about the change in previous verification techniques for computer security. *See* J.A. 283 (examiner stating reasons for allowance, summarizing patent's solution of "using an agent to set up a verification structure in the erasable, non-volatile memory of the BIOS"); *Ancora*, 744 F.3d at 735–36 (quoting applicants' arguments to examiner).

In short, claim 1 of the '941 patent is directed to a solution to a computer-functionality problem: an improvement in computer functionality that has "the specificity required to transform a claim from one claiming only a result to one claiming a way of achieving it." *SAP America, Inc.*, 898 F.3d at 1167. It therefore passes muster under *Alice* step one, as it is not directed to patent-ineligible subject matter. We need not and do not apply step two of the *Alice* analysis. *See Data Engine*, 906 F.3d at 1011; *Finjan*, 879 F.3d at 1306; *Visual Memory*, 867 F.3d at 1262.

We do note, in accord with our recognition of overlaps between some step one and step two considerations, *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016), that our conclusion that the specific

improvement in this case passes muster at step one is indirectly reinforced by some of our holdings under step two. For example, in *BASCOM Global Internet Services v. AT&T Mobility*, we held that claims to a method and system of filtering Internet content using an Internet Service Provider (ISP) server were a "technical improvement over the prior art ways of filtering such content." 827 F.3d 1341, 1350, 1352 (Fed. Cir. 2016). The prior art disclosed two forms of content-filtering systems: software was either (1) "placed on local computers, such that each local computer had its own tool for filtering [content]"; or (2) placed on "a local server" or remote ISP server. *Id.* at 1343–44. But both of those systems had disadvantages: the former allowed end-user modifications and was difficult to administer; the latter ignored material differences among end users. *Id.* The claimed invention addressed the disadvantages of the prior art through a filtering system located on an ISP server that used the server's ability to "to associate an individual user with a specific request" to create individually customizable filtering. *Id.* In holding the claimed invention eligible under *Alice* step two, we reasoned that although "[f]iltering content on the Internet was already a known concept, . . . the patent describes how its particular arrangement of elements is a technical improvement over the prior art ways of filtering such content." *Id.* at 1349–50. A similar characterization, we think, applies to the technical improvement claimed in this case and, in light of the line of cases we have discussed above, justifies the conclusion that claim 1 of the '941 patent is not directed to an abstract idea, but to a computer-functionality improvement.

The contrast with another step-two case, *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307 (Fed. Cir. 2016), is also instructive. There, the claimed invention required the installation of a virus-screening software on a telephone network. *Id.* at 1319. But because the claim at issue did not "recite[] any improvement to

conventional virus screening software, nor . . . solve any problem associated with situating such virus screening on the telephone network," we held that the patent did not identify a sufficient inventive concept under *Alice* to transform the claimed abstract idea into something patentable. *Id.* at 1320–21. Nor did the claimed method provide advantages with respect to computer function. *Id.* at 1320. In the present case, in contrast, the record described above shows that the claimed invention moves a software-verification structure to a BIOS location not previously used for this computer-security purpose and alters how the function is performed (in that the BIOS memory used for verification now interacts with distinct computer memory to perform a software-verification function), yielding a tangible technological benefit (by making the claimed system less susceptible to hacking). Thus, *Intellectual Ventures I v. Symantec*_is consistent with our conclusion.

HTC does not dispute that all claims pass muster if claim 1 does. Accordingly, we hold that HTC has not shown the '941 patent's claims to be invalid under 35 U.S.C. § 101. We do not have before us any question about invalidity under other provisions of Title 35.

III

For the foregoing reasons, we reverse the judgment of the district court and remand the case.

Costs to Ancora.

REVERSED AND REMANDED

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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MEMORANDUM

DATE: April 19, 2018

TO: Patent Examining Corps

FROM: Robert W. Bahr
Deputy Commissioner
for Patent Examination Policy

SUBJECT: Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP, Inc.*)

The USPTO recognizes that unless careful consideration is given to the particular contours of subject matter eligibility (35 U.S.C. § 101), it could "swallow all of patent law." *Alice Corp. v. CLS Bank International*, 573 U.S. ___, ___, 134 S. Ct. 2347, 2352 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 71, 132 S. Ct. 1289, 1293-1294 (2012)). This memorandum provides additional USPTO guidance that will further clarify how the USPTO is determining subject matter eligibility in accordance with prevailing jurisprudence. Specifically, this memorandum addresses the limited question of whether an additional element (or combination of additional elements) represents well-understood, routine, conventional activity. The USPTO is determined to continue its mission to provide clear and predictable patent rights in accordance with this rapidly evolving area of the law, and to that end, may issue further guidance in the future.

The U. S. Court of Appeals for the Federal Circuit (Federal Circuit) recently issued a precedential decision holding that the question of whether certain claim limitations represent well-understood, routine, conventional activity raised a disputed factual issue, which precluded summary judgment that all of the claims at issue were not patent eligible. *See Berkheimer v. HP Inc.*, 881 F.3d 1360 (Fed. Cir. 2018). Shortly thereafter, the Federal Circuit reaffirmed the *Berkheimer* standard in the context of a judgment on the pleadings and judgment as a matter of law.[1] While summary judgment, judgment on the pleadings, and judgment as a matter of law

[1] In *Aatrix Software, Inc. v. Green Shades Software, Inc.*, 882 F.3d 1121 (Fed. Cir. 2018), the Federal Circuit reversed a judgment on the pleadings of ineligibility, similarly finding that whether the claims in the challenged patent perform well-understood, routine, conventional activities is an issue of fact. In *Exergen Corp. v. Kaz USA, Inc.*, Nos. 2016-2315, 2016-2341, 2018 WL 1193529, at *1 (Fed. Cir. Mar. 8, 2018) (non-precedential), the Federal Circuit affirmed a district court's denial of a motion for judgment as a matter of law of patent ineligibility (thus

standards in civil litigation are generally inapplicable during the patent examination process, *Berkheimer* informs the inquiry into whether an additional element (or combination of additional elements) represents well-understood, routine, conventional activity.

I. Federal Circuit Decision in Berkheimer: In *Berkheimer*, the invention relates to digitally processing and archiving files in a digital asset management system. The patent specification explains that the system eliminates redundant storage of common text and graphical elements, which improves system operation efficiency and reduces storage costs. With respect to *Mayo/Alice* step 1 (step 2A in the USPTO's guidance), the Federal Circuit held that the claims are directed to the abstract ideas of parsing and comparing data (claims 1-3 and 9), parsing, comparing, and storing data (claim 4), and parsing, comparing, storing, and editing data (claims 5-7) based upon a comparison of these claims to claims held to be abstract in prior Federal Circuit decisions. *Berkheimer*, 881 F.3d at 1366-67. With respect to *Mayo/Alice* step 2 (step 2B in the USPTO's guidance), the Federal Circuit considered the elements of each claim both individually and as an ordered combination, recognizing that "whether a claim element or combination of elements is well-understood, routine and conventional to a skilled artisan in the relevant field is a question of fact." *Id.* at 1367-68. While observing that the specification discussed purported improvements (*e.g.*, reducing redundancy and enabling one-to-many editing as the purported improvements), the Federal Circuit held claims 1-3 and 9 ineligible because they do not include limitations that realize these purported improvements. *Id.* at 1369-70.

In contrast, the Federal Circuit held that claims 4-7 do contain limitations directed to purported improvements described in the specification (*e.g.*, claim 4 recites "storing a reconciled object structure in the archive without substantial redundancy," which the specification explains improves system operating efficiency and reduces storage costs), raising a genuine issue of material fact as to whether the purported improvements were more than well-understood, routine, conventional activity previously known in the industry. *Id.* at 1370. The Federal Circuit therefore reversed the district court's decision on summary judgment that claims 4-7 are patent ineligible, and remanded for further fact finding as to the eligibility of those claims. *Id.* at 1370-71.

Finally, 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. *Id.* at 1369.

II. Well-Understood, Routine, Conventional Activity: While the *Berkheimer* decision does not change the basic subject matter eligibility framework as set forth in MPEP § 2106, it does provide clarification as to the inquiry into whether an additional element (or combination of additional elements) represents well-understood, routine, conventional activity. Specifically, the Federal Circuit held that "[w]hether something is well-understood, routine, and conventional to a skilled artisan at the time of the patent is a factual determination." *Id.* at 1369.

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upholding the district court's conclusion that the claims were drawn to a patent eligible invention), concluding that the district court's fact finding that the claimed combination was not proven to be well-understood, routine, conventional was not clearly erroneous.

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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. This memorandum clarifies that such a conclusion must be based upon a factual determination that is supported as discussed in section III below. This memorandum further clarifies that the analysis as to whether an element (or combination of elements) is widely prevalent or in common use is the same as the analysis under 35 U.S.C. § 112(a) as to whether an element is so well-known that it need not be described in detail in the patent specification.[2]

The question of whether additional elements represent well-understood, routine, conventional activity is distinct from patentability over the prior art under 35 U.S.C. §§ 102 and 103. This is because a showing that additional elements are obvious under 35 U.S.C. § 103, or even that they lack novelty under 35 U.S.C. § 102, is not by itself sufficient to establish that the additional elements are well-understood, routine, conventional activities or elements to those in the relevant field. *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.

III. Impact on Examination Procedure: This memorandum revises the procedures set forth in MPEP § 2106.07(a) (Formulating a Rejection For Lack of Subject Matter Eligibility) and MPEP § 2106.07(b) (Evaluating Applicant's Response).

A. Formulating Rejections: In a step 2B analysis, an additional element (or combination of elements) is not well-understood, routine or conventional unless the examiner finds, and expressly supports a rejection in writing with, one or more of the following:

1. A citation to an express statement in the specification or to a statement made by an applicant during prosecution that demonstrates the well-understood, routine, conventional nature of the additional element(s). A specification demonstrates the well-understood, routine, conventional nature of additional elements when it describes the additional elements as well-understood or routine or conventional (or an equivalent term), as a commercially available product, or in a manner that indicates that the additional elements are sufficiently well-known that the specification does not need to describe the particulars of such additional elements to satisfy 35 U.S.C. § 112(a). A finding that an element is

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[2] *See Genetic Techs. Ltd. v. Merial LLC*, 818 F.3d 1369, 1377 (Fed. Cir. 2016) (supporting the position that amplification was well-understood, routine, conventional for purposes of subject matter eligibility by observing that the patentee expressly argued during prosecution of the application that amplification was a technique readily practiced by those skilled in the art to overcome the rejection of the claim under 35 U.S.C. 112, first paragraph); *see also Lindemann Maschinenfabrik GMBH v. Am. Hoist & Derrick Co.*, 730 F.2d 1452, 1463 (Fed. Cir. 1984) ("[T]he specification need not disclose what is well known in the art."); *In re Myers*, 410 F.2d 420, 424 (CCPA 1969) ("A specification is directed to those skilled in the art and need not teach or point out in detail that which is well-known in the art."); *Exergen Corp.*, 2018 WL 1193529, at *4 (holding that "[l]ike indefiniteness, enablement, or obviousness, whether a claim is directed to patent eligible subject matter is a question of law based on underlying facts," and noting that the Supreme Court has recognized that "the inquiry 'might sometimes overlap' with other fact-intensive inquiries like novelty under 35 U.S.C. § 102").

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well-understood, routine, or conventional cannot be based only on the fact that the specification is silent with respect to describing such element.

2. A citation to one or more of the court decisions discussed in MPEP § 2106.05(d)(II) as noting the well-understood, routine, conventional nature of the additional element(s).

3. A citation to a publication that demonstrates the well-understood, routine, conventional nature of the additional element(s). An appropriate publication could include a book, manual, review article, or other source that describes the state of the art and discusses what is well-known and in common use in the relevant industry. It does not include all items that might otherwise qualify as a "printed publication" as used in 35 U.S.C. § 102.[3] Whether something is disclosed in a document that is considered a "printed publication" under 35 U.S.C § 102 is a distinct inquiry from whether something is well-known, routine, conventional activity. A document may be a printed publication but still fail to establish that something it describes is well-understood, routine, conventional activity. *See Exergen Corp.*, 2018 WL 1193529, at *4 (the single copy of a thesis written in German and located in a German university library considered to be a "printed publication" in *Hall* "would not suffice to establish that something is 'well-understood, routine, and conventional activity previously engaged in by scientists who work in the field'"). The nature of the publication and the description of the additional elements in the publication would need to demonstrate that the additional elements are widely prevalent or in common use in the relevant field, comparable to the types of activity or elements that are so well-known that they do not need to be described in detail in a patent application to satisfy 35 U.S.C. § 112(a). For example, while U.S. patents and published applications are publications, merely finding the additional element in a single patent or published application would not be sufficient to demonstrate that the additional element is well-understood, routine, conventional, unless the patent or published application demonstrates that the additional element are widely prevalent or in common use in the relevant field.

4. A statement that the examiner is taking official notice of the well-understood, routine, conventional nature of the additional element(s). This option should be used **only** when the examiner is certain, based upon his or her personal knowledge, that the additional element(s) represents well-understood, routine, conventional activity engaged in by those in the relevant art, in that the additional elements are widely prevalent or in common use in the relevant field, comparable to the types of activity or elements that are so well-known that they do not need to be described in detail in a patent application to satisfy 35 U.S.C. § 112(a). Procedures for taking official notice and addressing an applicant's challenge to official notice are discussed in MPEP § 2144.03.

B. Evaluating Applicant's Response: If an applicant challenges the examiner's position that the additional element(s) is well-understood, routine, conventional activity, the examiner should reevaluate whether it is readily apparent that the additional elements are in actuality well-

[3] *See, e.g., In re Klopfenstein*, 380 F.3d 1345 (Fed. Cir. 2004) (publicly displayed slide presentation); *In re Hall*, 781 F.2d 897 (Fed. Cir. 1986) (doctoral thesis shelved in a library); *Mass. Inst. of Tech. v. AB Fortia*, 774 F.2d 1104, 1108-09 (Fed. Cir. 1985) (paper orally presented at a scientific meeting and distributed upon request); *In re Wyer*, 655 F.2d 221 (CCPA 1981) (patent application laid open to public inspection).

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understood, routine, conventional activities to those who work in the relevant field. If the examiner has taken official notice per paragraph (4) of section (III)(A) above that an element(s) is well-understood, routine, conventional activity, and the applicant challenges the examiner's position, specifically stating that such element(s) is not well-understood, routine, conventional activity, the examiner must then provide one of the items discussed in paragraphs (1) through (3) of section (III)(A) above, or an affidavit or declaration under 37 CFR 1.104(d)(2) setting forth specific factual statements and explanation to support his or her position. As discussed previously, to represent well-understood, routine, conventional activity, the additional elements must be widely prevalent or in common use in the relevant field, comparable to the types of activity or elements that are so well-known that they do not need to be described in detail in a patent application to satisfy 35 U.S.C. § 112(a).

The MPEP will be updated in due course to incorporate the changes put into effect by this memorandum.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ALISTAIR P. BARROS

Appeal 2017-004816
Application 12/788,084
Technology Center 3600

Before JEAN R. HOMERE, AMBER L. HAGY, and
KARA L. SZPONDOWSKI, *Administrative Patent Judges*.

HAGY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant[1] appeals under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–20, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

[1] Appellant identifies the real party in interest as SAP SE. (App. Br. 1.)

STATEMENT OF THE CASE

Introduction

Appellant's disclosure relates to "brokered service delivery." (Spec. ¶ 1.) By way of background, the Specification states that "[t]he brokering of goods and services is a time-honored technique of facilitating commerce." (*Id.* ¶ 2.) In particular, the Specification describes brokering as a broker taking on the responsibility from a manufacturer or provider of services to locate purchasers and to conduct and consummate sales, in exchange for receiving "a share of the purchase price or some other fee or payment." (*Id.*) The Specification further states that "these general concepts" have been adopted "[i]n the computer, network, and software realm(s) . . . for the delivery of goods and services, e.g., over the Internet." (*Id.* ¶ 3.) The Specification notes that "[i]n theory, the intersection of brokering and software services . . . is conceptually straight-forward." (*Id.* ¶ 5.) The Specification states, however, that "many services are conventionally difficult or impossible to deliver as part of a brokered service delivery scenario." (*Id.* ¶ 6.) Purportedly to address that difficulty, the Specification describes a system "for providing service delivery management for brokered service delivery" that includes "an explicit, dedicated platform for service delivery management which enables complex service delivery models to support the run-time brokerage of groups of long-running, multi-session services, some or all of which may be hosted by different, otherwise-incompatible service providers." (*Id.* ¶ 39.)

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Exemplary Claim

Claims 1, 4, 10, and 16 are independent. Claim 1, reproduced below, is exemplary of the claimed subject matter:

> 1. A computer system including instructions stored on a nontransitory computer-readable storage medium, the computer system comprising:
>
> a service regulator configured to cause at least one processor to transform a service interface of at least one service of at least one service provider into service states and transitions between the service states to create a coordination model, the service states corresponding to distinct forms to be exchange with a user as part of an execution of the at least one service, the transitions representing action requests and responses on the at least one service;
>
> a broker consumer gateway configured to cause the at least one processor to interface with a service consumer of a computing device consuming the at least one service of the at least one service provider based on the coordination model, each of the service states represented as at least one distinct form that is requested, filled-in, and submitted in association with the user via the service consumer of the computing device; and
>
> a service delivery manager configured to cause the at least one processor to mediate delivery of each of the service states modeled with the coordination model of the at least one service to the service consumer of the computing device via the broker consumer gateway including invoking the at least one distinct form for each of the service states during execution of the at least one service, the service delivery manager including:
>
> a consumer session manager configured to cause the at least one processor to create at least one consumer session in association with the user during which to execute at least a portion of the at least one service, including transitioning through one or more of the service states of the at least one service according to the coordination model, a consumer instance manager

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> configured to cause the at least one processor to create at least one instance of the at least one service within the at least one consumer session, the at least one instance being associated with the at least one service including representing each of the service states with the at least one distinct form that is requested, filled-in, and submitted in association with the user via the service consumer of the computing device, and
>
> a service coordinator configured to cause the at least one processor to coordinate and track each of the service states during delivery of the at least one service from the at least one service provider within the at least one consumer session and the at least one instance of the at least one service, the service coordinator configured to cause the at least one processor to track and advance a current state of each executing service to a next service state using the coordination model characterizing the at least one service in which each of the distinct forms are associated with corresponding ones of the service states of the at least one service and in which the transitions between each of the service states are executed based on the at least one distinct form exchanged with the service consumer during each service state.

REJECTIONS[2]

1. Claims 1, 4, 10, 14, 16, and 20 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting over claims 1, 5, 6, 10, and 18 of copending Application No. 12/788,087 ("the '087 Application") and further in view of D'Angelo, U.S. Patent No. 7,917,124 B2, issued Mar. 29, 2011 ("D'Angelo") and Kumaran, Pub. No. US 2009/0024514 A1, published Jan. 22, 2009 ("Kumaran"). (Final Act. 10-21.)

[2] Claims 1–20 were rejected also under 35 U.S.C. § 103 in the Final Action (Final Act. 23–62), but the Examiner withdraws these rejections in the Answer. (Ans. 16.)

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2. Claims 1–20 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter (abstract idea). (Final Act. 3–7, 21–23.)

ANALYSIS

A. Provisional Rejection for Obviousness-Type Double Patenting

The Examiner provisionally rejects claims 1, 4, 10, 14, 16, and 20 on the ground of nonstatutory obviousness-type double patenting over claims 1, 5, 6, 10, and 18 of the '087 Application and further in view of D'Angelo and Kumaran. (Final Act. 10–21.)

As Appellant points out (Reply Br. 12), the '087 Application has since been abandoned (as of March 11, 2016). Accordingly, the Examiner's provisional obviousness-type double patenting rejection over the '087 application in combination with D'Angelo and Kumaran is now moot.

B. § 101 Rejection

The Examiner rejects the claims as being directed to patent-ineligible subject matter under 35 U.S.C. § 101.[3] The Examiner determines the claims are directed to the abstract idea of "facilitating service delivery." (Ans. 15.) The Examiner further finds the claims do not amount to significantly more than the abstract idea because "Appellant has not shown that the computer technology utilized in the claims performs anything more than court-recognized examples of *well-understood, routine, and conventional*

[3] The Examiner rejects claims 2–20 on the "same rationale" as claim 1. (Final Act. 23.) Appellant generally argues the rejection of all claims collectively with regard to claim 1 (*see* App. Br. 9–17), while presenting additional arguments with regard to claims 4, 14, and 20 (*id.* at 17–19). We select claim 1 as representative pursuant to our authority under 37 C.F.R. § 41.37(c)(1)(iv).

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functions, including 'receiving, processing, storing and transmitting data.'" (*Id.* at 23 (emphasis added).)

Appellant argues the Examiner erred because, *inter alia*, the claimed solution "employs novel and inventive computer functions for delivering software services via a broker, which serves as a central point between specific software services running on remote, backend systems of the service provider(s) and consumer computing devices executing an instance of the software service(s) within a browser application." (App. Br. 10.) In particular, Appellant argues claim 1

> specif[ies] in very specific technical terms how the performance of the system itself is improved to yield a desired result - allowing multi-step, long-running software services to be deployed, configured, and executed via a broker through the use of the coordination model, e.g., sending forms to the consuming applications, receiving submitted forms containing actions for execution, and adapting and invoking the back-end service applications. The above-identified limitations of claim 1 are meaningful limitations that add more than generally linking the use of the abstract idea to a generic computer, because they solve a network-centric problem with a claimed solution that is necessarily rooted in computer technology, similar to the additional elements in *DDR Holdings*.

(App. Br. 16 (citing *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014).)

It is the Examiner's burden to show—with supporting facts—that the recited limitations are well-understood, routine, and conventional where, as here, the Examiner relies on such a basis for the ineligibility rejection. *See Berkheimer v. HP Inc.*, 881 F.3d 1360, 1369 (Fed. Cir. 2018) ("Whether something is well-understood, routine, and conventional to a skilled artisan at the time of the patent is a factual determination"). The prima facie case is

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a procedural tool of patent examination, allocating the respective burdens between the Examiner and an applicant. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). First, the Examiner bears the initial burden of presenting a prima facie case of unpatentability. *Id.* (*citing In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984)). If the Examiner meets that burden, the burden then shifts to the applicant to rebut the prima facie case with evidence or argument. *Oetiker*, 977 F.2d at 1445. Then, patentability is determined on the totality of the record by a preponderance of evidence with due consideration of persuasiveness of argument. *Id.*; *accord* MANUAL OF PATENT EXAMINING PROCEDURE (MPEP) § 2106.07 (9th ed. Rev. 08.2017, Jan. 2018) (noting that the initial burden of establishing a prima facie case of ineligibility under § 101 is on the Examiner to explain clearly and specifically why claims are ineligible, so that the applicant has sufficient notice and can respond effectively).

Under the new examination procedure published online by the USPTO on April 19, 2018, entitled "Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP, Inc.*)" (hereinafter "*Berkheimer* Memorandum"), there is a new fact finding requirement for Examiners, as applicable to rejections under § 101. Specifically, Examiners must now provide specific types of evidence to support a finding that claim elements (or combinations of elements) are well-understood, routine, and conventional.

Here, the Examiner's determinations that the claims are directed to an abstract idea and do not amount to significantly more than the abstract idea are predicated, at least in part, on unsupported findings that

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> Appellant's claims are devoid of any discernible change, transformation, or improvement to any process, technology, or computer, but instead are directed to creating a coordination model at least in part by using service states and transitions to identify brokered service delivery scenarios, accompanied by general-purpose or at least conventional computing elements that merely tie the idea to a particular operating environment, along with high-level descriptive claim language that describes *well-known, routine, and conventional activities in the art.*

(Ans. 24 (emphasis added).) The Examiner also finds, without citing evidentiary support, that "creating a coordination model, mediat[ing] delivery of service states, creat[ing] a consumer session, coordinat[ing] and track[ing] each service state merely involve well-understood, routine, and conventional activities in the art, and even when implemented by a computer, [and] involve nothing more than automating mental/manual and conventional activities in the art." (*Id.* at 27.)

We determine that the Examiner did not satisfy the initial burden of establishing a prima facie case of ineligibility under § 101 by providing the requisite factual support for limitations that are said to be well-understood, routine, and conventional; consequently, the burden never shifted to Appellant to rebut that case. We are, therefore, constrained on this record to reverse the Examiner's 35 U.S.C. § 101 rejection of claim 1 as well as claims 2–20 rejected on the same basis and argued collectively by Appellant.

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DECISION

The Examiner's obviousness-type double patenting rejection of claims 1, 4, 10, 14, 16, and 20 is determined to be moot.

The Examiner's 35 U.S.C. § 101 rejection of claims 1–20 is reversed.

REVERSED

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Electronic Patent Application Fee Transmittal

Application Number:	10606729
Filing Date:	26-Jun-2003
Title of Invention:	Method and apparatus for the free licensing of digital media content
First Named Inventor/Applicant Name:	Philip M. Donian
Filer:	Farshad Jason Far-hadian/Susan Telford
Attorney Docket Number:	42327-501001US

Filed as Large Entity

Filing Fees for Utility under 35 USC 111(a)

Description	Fee Code	Quantity	Amount	Sub-Total in USD($)
Basic Filing:				
Pages:				
Claims:				
Miscellaneous-Filing:				
Petition:				
Patent-Appeals-and-Interference:				
APPEAL FORWARDING FEE	1413	1	2240	2240
Post-Allowance-and-Post-Issuance:				

Description	Fee Code	Quantity	Amount	Sub-Total in USD($)
Extension-of-Time:				
Miscellaneous:				
			Total in USD ($)	**2240**

Electronic Acknowledgement Receipt	
EFS ID:	34628324
Application Number:	10606729
International Application Number:	
Confirmation Number:	5831
Title of Invention:	Method and apparatus for the free licensing of digital media content
First Named Inventor/Applicant Name:	Philip M. Donian
Customer Number:	64046
Filer:	Farshad Jason Far-hadian/Susan Telford
Filer Authorized By:	Farshad Jason Far-hadian
Attorney Docket Number:	42327-501001US
Receipt Date:	18-DEC-2018
Filing Date:	26-JUN-2003
Time Stamp:	18:07:23
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	yes
Payment Type	DA
Payment was successfully received in RAM	$2240
RAM confirmation Number	121918INTEFSW00019412500311
Deposit Account	500311
Authorized User	Susan Telford
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File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Reply Brief Filed	42327-501001US_ReplyBrief.pdf	17714049 89d81e5b395cf74d85122908c2a9238f99d98895	no	46
Warnings:					
Information:					
2	Fee Worksheet (SB06)	fee-info.pdf	30458 b9edd99e7d893441e0f3bf4a2c1d1f4db893ece4	no	2
Warnings:					
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Doc Code: MES.GIB
Document Description: Certification of Micro Entity Status (Gross Income Basis)

PTO/SB/15A (07-14)

CERTIFICATION OF MICRO ENTITY STATUS
(GROSS INCOME BASIS)

Application Number or Control Number (if applicable):	Patent Number (if applicable):
10/606,729	
First Named Inventor:	**Title of Invention:**
Philip Donian	Method and apparatus for the free licensing of digital media content

The applicant hereby certifies the following—

(1) **SMALL ENTITY REQUIREMENT –** The applicant qualifies as a small entity as defined in 37 CFR 1.27.

(2) **APPLICATION FILING LIMIT –** Neither the applicant nor the inventor nor a joint inventor has been named as the inventor or a joint inventor on more than four previously filed U.S. patent applications, excluding provisional applications and international applications under the Patent Cooperation Treaty (PCT) for which the basic national fee under 37 CFR 1.492(a) was not paid, and also excluding patent applications for which the applicant has assigned all ownership rights, or is obligated to assign all ownership rights, as a result of the applicant's previous employment.

(3) **GROSS INCOME LIMIT ON APPLICANTS AND INVENTORS –** Neither the applicant nor the inventor nor a joint inventor, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986 (26 U.S.C. 61(a)), exceeding the "Maximum Qualifying Gross Income" reported on the USPTO Web site at http://www.uspto.gov/patents/law/micro_entity.jsp which is equal to three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census.

(4) **GROSS INCOME LIMIT ON PARTIES WITH AN "OWNERSHIP INTEREST" –** Neither the applicant nor the inventor nor a joint inventor has assigned, granted, or conveyed, nor is under an obligation by contract or law to assign, grant, or convey, a license or other ownership interest in the application concerned to an entity that, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986, exceeding the "Maximum Qualifying Gross Income" reported on the USPTO Web site at http://www.uspto.gov/patents/law/micro_entity.jsp which is equal to three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census.

SIGNATURE by an authorized party set forth in 37 CFR 1.33(b)

Signature	/FJF/				
Name	F. Jason Far-hadian				
Date	2018/12/21	Telephone	858-314-2144	Registration No.	42,523

☐ There is more than one inventor and I am one of the inventors who are jointly identified as the applicant. The required additional certification form(s) signed by the other joint inventor(s) are included with this form.

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The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

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6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
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REQUEST FOR REFUND

Reference # *(Patent #, Application #, Trademark Serial #, Registration #, etc.)*	**Title of Invention or Mark Information**	
10606729	Method and apparatus for the free licensing of digital media content	
Attorney Docket # *(if applicable)*	**Payment Date** *(mm/dd/yyyy)*	**Refund Request Amount**
42327-501001US	12/18/2018	$ 1,680.00

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- [ ] Duplicate Payment
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- [x] Other Micro Entity

Rationale *(Supporting documentation may be submitted with this form)*

When filing a Reply Brief, the appeal forwarding fees required under 37 C.F.R. § 41.45 for the large entity fee ($2240) was paid instead of the Micro Entity Fees of $560. A refund for the amount paid in excess is respectfully requested. Micro entity certification has been already filed in this matter. A new Micro entity certification is also filed herewith.

Requester's Information

Company or Firm Name *(if applicable)*		
Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.		
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Address Line 2 *(if applicable)*	**Country**	**Zip/Postal Code**
	US	92130
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F. Jason Far-hadian		42,523
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EFS ID:	34676527
Application Number:	10606729
International Application Number:	
Confirmation Number:	5831
Title of Invention:	Method and apparatus for the free licensing of digital media content
First Named Inventor/Applicant Name:	Philip M. Donian
Customer Number:	64046
Filer:	Farshad Jason Far-hadian/Susan Telford
Filer Authorized By:	Farshad Jason Far-hadian
Attorney Docket Number:	42327-501001US
Receipt Date:	21-DEC-2018
Filing Date:	26-JUN-2003
Time Stamp:	15:39:07
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Certification of Micro Entity (Gross Income Basis)	042327-501001US_Cert_for_Micro_Entity_Status.pdf	136181 0f2f69b436f50481395ad7adab22600f894ae3da	no	2

Warnings:

Information:					
2	Refund Request	42327-501001US_Refund_Request_Form.pdf	274554 4bfd97bea977be02985b1954e2f57bb90ccf1393	no	1
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Information:					
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New International Application Filed with the USPTO as a Receiving Office

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,729	06/26/2003	Philip M. Donian	42327-501001US	5831

64046 7590 12/28/2018

Mintz Levin/San Diego Office
One Financial Center
Boston, MA 02111

EXAMINER	
RETTA, YEHDEGA	

ART UNIT	PAPER NUMBER
3688	

NOTIFICATION DATE	DELIVERY MODE
12/28/2018	ELECTRONIC

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Appeal No: 2019-001632
Application: 10/606,729
Appellant: Philip M. Donian et al.

Patent Trial and Appeal Board Docketing Notice

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EXAMINER
RETTA, YEHDEGA

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PHILIP M. DONIAN, LARRY E. HENNEMAN JR.,
and MICHAEL M. MALIONE

Appeal 2019-001632
Application 10/606,729
Technology Center 3600

Before ANTON W. FETTING, BRUCE T. WIEDER, and
AMEE A. SHAH, *Administrative Patent Judges*.

SHAH, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), the Appellant[1] appeals from the Examiner's decision to reject claims 212, 214–223, and 225–273, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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[1] We use the word "Appellant" to refer to "applicant" as defined in 37 C.F.R. § 1.42. The Appellant identifies the real party in interest as Piranha Media Distribution, Inc. Appeal Br. 3.

CLAIMED SUBJECT MATTER

The Appellant's "invention relates generally to the distribution of audio, video, and print media content, copyrighted or otherwise, via digital replication and delivery channels," and more specifically,

> to an apparatus and method for the wide digital distribution of media content in a way that allows the free use of media properties, on demand, with direct consumer exchange capabilities, while at the same time offering equitable return to the copyright holder, and providing for a strict level of control over the enforcement of license agreements on the part of the distributor.

Spec. 1, ll. 14–20.

Claims 212, 238, 243, 267, 268, and 271 are the independent claims on appeal. Claim 212, reproduced below, with bracketed notations and added paragraphing, is illustrative of the claimed subject matter.

212. A method comprising:

[(a)] receiving, on a client system, data comprising digital media content and digital advertising content;

[(b)] sequencing the digital media content and the digital advertising content,

the sequencing comprising ordering at least some of the digital media content and at least some of the digital advertising content into a user-perceptible content stream,

the user-perceptible content stream comprising one or more initially sequenced insertion points at which the digital advertising content is scheduled to be presented relative to the digital media content;

[(c)] adaptively modifying, using pre-defined rules and in response to a user input detected by the client system, a presentation position of the digital advertising content from at least one of the one or more initially sequenced insertion points to one or more alternatively sequenced insertion points,

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at least one of the one or more alternatively sequenced insertion points being different than the one or more initially sequenced insertion points relative to the digital media content within the user-perceptible content stream;

[(d)] causing presentation of the user-perceptible content stream at the client system after the adaptively modifying;

[(e)] keeping a setting in a first memory to indicate a current state of play,

the setting including a value to indicate whether presentation of a required part of the digital advertising content is in progress during presentation of the user-perceptible content stream;

[(f)] disallowing a navigation choice that alters a course of playback of the user-perceptible content stream while presentation of the required part of the digital advertising content is in progress; and

[(g)] storing, in a second memory, presentation data comprising an indication of the digital advertising content that has been presented;

wherein the receiving, the sequencing, the adaptively modifying, the causing, the keeping, the disallowing, and the storing are performed by one or more programmable processors.

REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Knepper et al. ("Knepper")	US 2001/0042249 A1	Nov. 15, 2001
Oh	US 2002/0161739 A1	Oct. 31, 2002
Wang	US 2002/0191950 A1	Dec. 19, 2002
Hannah et al. ("Hannah")	US 7,761,327 B1	July 20, 2010

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REJECTIONS

Claims 212, 214–223, and 225–273 stand rejected under 35 U.S.C. § 101 as being directed to a judicial exception without significantly more.

Claims 212, 214–223, and 225–273 stand rejected under 35 U.S.C. § 112 (pre-AIA), first paragraph, as failing to comply with the written description requirement.

Claims 212, 214–223, 225–232, 234–249, 251–255, and 257–273 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Knepper, Hannah, and Wang.

Claims 233 and 256 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Knepper, Hannah, Wang, and Official Notice.

Claim 250 stands rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Knepper, Hannah, Wang, and Oh.

OPINION

35 U.S.C. § 101 – Statutory Subject Matter[2]

The Appellant presents arguments for the independent claims together and relies on those arguments for the dependent claims. *See* Appeal Br. 39–40. We thus group all the claims together and select claim 212 as representative of the group, with the rejection of the remaining claims standing or falling therewith. *See* 37 C.F.R. § 41.37(c)(1)(iv).

[2] The rejections are addressed in the order presented by the Examiner in the Final Action.

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35 U.S.C. § 101 Framework

Section 101

An invention is patent-eligible if it claims a "new and useful process, machine, manufacture, or composition of matter." 35 U.S.C. § 101. However, the U.S. Supreme Court has long interpreted 35 U.S.C. § 101 to include implicit exceptions: "[l]aws of nature, natural phenomena, and abstract ideas" are not patentable. *E.g.*, *Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208, 216 (2014).

In determining whether a claim falls within an excluded category, we are guided by the Court's two-part framework, described in *Mayo* and *Alice*. *Id.* at 217–18 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 75–77 (2012)). In accordance with that framework, we first determine what concept the claim is "directed to." *See Alice*, 573 U.S. at 219 ("On their face, the claims before us are drawn to the concept of intermediated settlement, *i.e.,* the use of a third party to mitigate settlement risk."); *see also Bilski v. Kappos*, 561 U.S. 593, 611 (2010) ("Claims 1 and 4 in petitioners' application explain the basic concept of hedging, or protecting against risk.").

Concepts determined to be abstract ideas, and thus patent ineligible, include certain methods of organizing human activity, such as fundamental economic practices (*Alice*, 573 U.S. at 219–20; *Bilski*, 561 U.S. at 611); mathematical formulas (*Parker v. Flook*, 437 U.S. 584, 594–95 (1978)); and mental processes (*Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)). Concepts determined to be patent eligible include physical and chemical processes, such as "molding rubber products" (*Diamond v. Diehr*, 450 U.S. 175, 191 (1981)); "tanning, dyeing, making waterproof cloth, vulcanizing India

rubber, smelting ores" (*id.* at 182 n.7 (quoting *Corning v. Burden*, 56 U.S. 252, 267–68 (1853))); and manufacturing flour (*Benson*, 409 U.S. at 69 (citing *Cochrane v. Deener*, 94 U.S. 780, 785 (1876))).

In *Diehr*, the claim at issue recited a mathematical formula, but the Court held that "a claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula." *Diehr*, 450 U.S. at 187; *see also id.* at 191 ("We view respondents' claims as nothing more than a process for molding rubber products and not as an attempt to patent a mathematical formula."). Having said that, the Court also indicated that a claim "seeking patent protection for that formula in the abstract . . . is not accorded the protection of our patent laws, and this principle cannot be circumvented by attempting to limit the use of the formula to a particular technological environment." *Id.* (citation omitted) (citing *Benson* and *Flook*); *see, e.g.*, *id.* at 187 ("It is now commonplace that an *application* of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.").

If the claim is "directed to" an abstract idea, we turn to the second step of the *Alice* and *Mayo* framework, where "we must examine the elements of the claim to determine whether it contains an 'inventive concept' sufficient to 'transform' the claimed abstract idea into a patent-eligible application." *Alice*, 573 U.S. at 221 (quotation marks omitted). "A claim that recites an abstract idea must include 'additional features' to ensure 'that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].'" *Id.* (alterations in original) (quoting *Mayo*, 566 U.S. at 77). "[M]erely requir[ing] generic computer implementation[] fail[s] to transform that abstract idea into a patent-eligible invention." *Id.*

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USPTO Section 101 Guidance

In January 2019, after the Final Action and Answer were mailed and the Appeal Brief and Reply Brief entered, the U.S. Patent and Trademark Office (USPTO) published revised guidance on the application of § 101. 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50 (Jan. 7, 2019) ("Revised Guidance") (incorporated into the MANUAL OF PATENT EXAMINING PROCEDURE, Rev. 10.2019 ("MPEP") in June 2010). "The guidance sets out agency policy with respect to the USPTO's interpretation of the subject matter eligibility requirements of 35 U.S.C. § 101 in view of decisions by the Supreme Court and the Federal Circuit." Revised Guidance, 84 Fed. Reg. at 51. Although "[a]ll USPTO personnel are, as a matter of internal agency management, expected to follow the guidance," the guidance "does not create any right or benefit, substantive or procedural, enforceable by any party against the USPTO." *Id.* The Revised Guidance, by its terms, applies to all applications, and to all patents resulting from applications, filed before, on, or after January 7, 2019. *Id.* at 50.[3]

Under the Revised Guidance, we first look to whether the claim recites: (1) any judicial exceptions, including certain groupings of abstract ideas (i.e., mathematical concepts, certain methods of organizing human

[3] The Revised Guidance supersedes MPEP § 2106.04(II) and also supersedes all versions of the USPTO's "Eligibility Quick Reference Sheet Identifying Abstract Ideas." *See* Revised Guidance, 84 Fed. Reg. at 51 ("Eligibility-related guidance issued prior to the Ninth Edition, R-08.2017, of the MPEP (published Jan. 2018) should not be relied upon."). Thus, the Appellant's arguments related to prior guidance (*see, e.g.*, Appeal Br. 30–31 (presenting arguments related to the particular judicial decisions the Examiner cited)) will not be considered.

activity such as a fundamental economic practice, or mental processes) (*see* MPEP § 2106.04(a)) ("Step 2A, Prong One"); and (2) additional elements that integrate the judicial exception into a practical application (*see* MPEP § 2106.04(d)) ("Step 2A, Prong Two").[4] Revised Guidance, 84 Fed. Reg. at 52–55.

Only if a claim (1) recites a judicial exception and (2) does not integrate that exception into a practical application, do we then look, under Step 2B, to whether the additional elements, individually or in combination, provide an inventive concept. *Id.* Among the considerations in determining whether the additional elements, individually or in combination, amount to significantly more than the exception itself, we look to whether they add a specific limitation beyond the judicial exception that is not "well-understood, routine, conventional" in the field or simply append well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception. *Id.* at 56.

Step One of the Mayo/Alice Framework

Under the first step of the *Mayo/Alice* framework and Step 2A of USPTO guidance, the Examiner determines that independent claim 212 is "directed to re-sequencing or modifying (changing) the presentational

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[4] This evaluation is performed by (a) identifying whether there are any additional elements recited in the claim beyond the judicial exception, and (b) evaluating those additional elements individually and in combination to determine whether the claim as a whole integrates the exception into a practical application. *See* Revised Guidance - Section III(A)(2), 84 Fed. Reg. at 54–55, MPEP § 2106.04(d).

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position of advertisement in response to a user input" (Final Act. 2) and to "preventing of commercial skipping by using a well-known device" (*id.* at 3). The Examiner characterizes the claimed concept as reciting "steps that can be performed mentally, thus an abstract idea." *Id.* at 2. When viewed through the lens of the Revised Guidance Step 2A, Prong One, the Examiner's determinations indicate that the claim's limitations recite "[m]ental processes—concepts performed in the human mind (including an observation, evaluation, judgment, opinion)." 84 Fed. Reg. at 52; MPEP § 2106.04(a)(III).

The Examiner also determines that "the claim[] simply convey[s] the abstract idea itself applied on some generic computer system. The claim[] at issue amount[s] to nothing significantly more than an instruction to apply the abstract idea using some unspecified, generic computer." Final Act. 4. When viewed through the lens of the Revised Guidance Step 2A, Prong Two, the Examiner's determinations indicate that "a judicial exception has not been integrated into a practical application" because "[a]n additional element merely recites the words 'apply it' (or an equivalent) with the judicial exception, or merely includes instructions to implement an abstract idea on a computer, or merely uses a computer as a tool to perform an abstract idea." 84 Fed. Reg. at 55; MPEP § 2106.04(d)(I).

The Appellant disagrees that claim 212 is "directed to 'the abstract idea of 'preventing of commercial skipping by using a well-known device'' as alleged by the Examiner." Appeal Br. 31. Rather, the claim "recites an improved computer-implemented way to adaptively re-sequence ad block positions in response to user input." *Id.* When viewed through the lens of the Revised Guidance, Step 2A, the Appellant's arguments indicate that the

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Appellant contends that claim 212 does not recite a mental process under Prong One and "integrates a judicial exception into a practical application" under Prong Two because it includes an additional element or combination of elements that "reflects an improvement in the functioning of a computer, or an improvement to other technology or technical field." 84 Fed. Reg. at 54–55; MPEP § 2104(d)(1).

Under the first step of the *Mayo/Alice* framework and Step 2A USPTO guidance, we first determine to what claim 212 is directed, i.e., whether claim 1 recites an abstract idea and if so, whether claim 1 is directed to that abstract idea. The Federal Circuit has explained that "the 'directed to' inquiry applies a stage-one filter to claims, considered in light of the specification, based on whether 'their character as a whole is directed to excluded subject matter.'" *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015)). It asks whether the focus of the claim is on a specific improvement in relevant technology or on a process that itself qualifies as an "abstract idea" for which computers are invoked merely as a tool. *See id.* at 1335–36. Here, it is clear from the Specification, including the claim language, that claim 212 focuses on an abstract idea, and not on any improvement to technology and/or a technical field.

Reciting a Judicial Exception

The Specification provides for a "**METHOD AND APPARATUS FOR THE FREE LICENSING OF DIGITAL MEDIA CONTENT**." Spec., Title. In the "Field of the Invention" section, the Specification states the "invention relates generally to the distribution of audio, video, and print

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media content, copyrighted or otherwise, via digital replication and delivery channels," and more specifically,

> to an apparatus and method for the wide digital distribution of media content in a way that allows the free use of media properties, on demand, with direct consumer exchange capabilities, while at the same time offering equitable return to the copyright holder, and providing for a strict level of control over the enforcement of license agreements on the part of the distributor.

Spec. 1, ll. 14–20. In the "Description of Background Art" section, the Specification discusses "[t]he problem of widespread consumer-directed copying and redistribution of licensed material." *Id.* at 1, ll. 23–24. "New technologies to restrict consumer copying and unencumbered use of content have met with opposition and a determination on the part of some consumers to defeat them." *Id.* at 1, ll. 30–31. "Given the nature of modern networked digital devices, the consumers' power to redistribute media files illicitly is formidable." *Id.* at 2, ll. 5–6. "[C]onventional methods and apparatus have inherent drawbacks that make it difficult for them to maintain their limitations to consumer access in the presence of modern digital technology and a consumer culture driven to defeat them in open defiance of the rights of copyright holders." *Id.* at 2, ll. 8–11. Distribution of copyrighted material can be accomplished either for free via broadcast television and radio by "mixing licensed content with advertisements and other paid announcements in a pre-configured time sequence, then transmitting this sequence asymmetrically over the airwaves to a large number of consumer receivers capable of showing the content in real-time as it is [sic] comes in" (*id.* at 2, ll. 14–19) or for a subscription fee via cable and satellite television and radio and Video On Demand ("VOD") with "[p]re-configured analog or

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digital media content, with or without commercial advertisement, . . . conveyed asymmetrically to the consuming population via coaxial cable" using encryption methods to prevent theft (*id.* at 2, l. 27–3, l. 9; *see also id.* at 3, ll. 11–26). "To the inventor's knowledge, there is currently no conventional digital media distribution method in practice that incorporates the free consumer-directed access and exchange of content with the distributor-directed control of media sequencing after all such exchanges." *Id.* at 9, ll. 3–5. Thus, the invention aims

> to provide a revenue generating market for the free consumer redistribution of media content, sponsored through paid advertising that a consumer may be required to experience during the course of media playback, provided by means of a system and/or method that offers the benefits of content restriction and controlled playback, working in conjunction with customized, addressable advertising on an individual consumer basis, with monitoring of content use and ad penetration to track audience viewership.

Id. at 9, ll. 8–13. Specifically, the "software functions primarily as a media presentation 'player/viewer', capable of running audio, video, and print media content" that "allows for a 'general license', whereby a consumer can obtain free use of a media property, with strict controls enforced during media playback," the controls "amount[ing] to the intermittent insertion of paid commercial advertisements and other promotional material into the time sequence of the media content during its course of presentation, along with the temporary disabling of certain user controls to ensure that this material is presented in its entirety." *Id.* at 9, l. 21–10, l. 1. Thus, "[t]he consumer gains free use of content in exchange for exposure to these paid advertisements." *Id.* at 10, ll. 1–2.

Consistent with this disclosure, claim 212 recites a method. We consider claim 212 as a whole[5] giving it the broadest reasonable construction[6] as one of ordinary skill in the art would have interpreted it in light of the Specification[7] at the time of filing. The method of claim 212 comprises the steps of: (a) receiving data "comprising digital media content and digital advertising content"; (b) "sequencing the digital media content and the digital advertising content" by "ordering at least some of the digital media content and at least some of the digital advertising content into a user-perceptible content stream" having "one or more initially sequenced insertion points"; (c) "adaptively modifying, using pre-defined rules and in response to a user input detected by the client system, a presentation position of the digital advertising content from at least one of the one or more initially sequenced insertion points to one or more alternatively sequenced insertion points"; (d) displaying, i.e., "causing presentation" of information "of the user-perceptible content stream at the client system after the adaptively modifying"; (e) "keeping a setting in a first memory to indicate a current state of play, the setting including a value to indicate whether

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[5] "In determining the eligibility of respondents' claimed process for patent protection under § 101, their claims must be considered as a whole." *Diehr*, 450 U.S. at 188.

[6] Revised Guidance, 84 Fed. Reg. at 52 n.14 ("If a claim, under its *broadest reasonable interpretation* . . . .") (emphasis added).

[7] "First, it is always important to look at the actual language of the claims. . . . Second, in considering the roles played by individual limitations, it is important to read the claims 'in light of the specification.'" *Smart Sys. Innovations, LLC v. Chicago Transit Authority*, 873 F.3d 1364, 1378 (Fed. Cir. 2017) (J. Linn, dissenting in part and concurring in part) (citing *Enfish*, 822 F.3d at 1335, among others).

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presentation of a required part of the digital advertising content is in progress during presentation of the user-perceptible content stream"; (f) "disallowing a navigation choice that alters a course of playback of the user-perceptible content stream while presentation of the required part of the digital advertising content is in progress"; and (g) "storing, in a second memory, presentation data comprising an indication of the digital advertising content that has been presented." Appeal Br. 42–43 (Claims App.). The steps of claim 212 "are performed by one or more programmable processors" (*id.* at 43), i.e., conventional computer components (*see* Spec. 17, ll. 20–26, Fig. 2 (describing and depicting a computer system with "conventional architecture")).

Receiving data is an extra-solution activity. *See In re Bilski*, 545 F.3d 943, 963 (Fed. Cir. 2008) (en banc), *aff'd sub nom Bilski v. Kappos*, 561 U.S. 593 (2010) (characterizing data gathering steps as insignificant extra-solution activity). Sequencing content by ordering content into a stream at insertion points is a way of organizing content, which is a mental process. *See Versata Dev. Grp., Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1333–34 (Fed. Cir. 2015) (using hierarchies "is a building block, a basic conceptual framework for organizing information"). Similarly, adaptively modifying, using rules and user input, a position of the content from one insertion point to another is a way of organizing content based on an analysis of criteria, a mental process. *See Electric Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016) (citing cases) ("we have treated analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes"). Causing presentation of the stream, i.e., displaying data, is an extra-solution activity.

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See id.; *Bilski*, 561 U.S. at 610–11 ("*Flook* stands for the proposition that the prohibition against patenting abstract ideas 'cannot be circumvented by attempting to limit the use of the formula to a particular technological environment' or adding 'insignificant post-solution activity.'"). Keeping a setting in a memory and storing presentation data are ways of storing data, which is a mental process. *See Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat. Ass'n*, 776 F.3d 1343, 1347 (Fed. Cir. 2014) ("The concept of data collection, recognition, and storage is undisputedly well-known. Indeed, humans have always performed these functions."). The limitation of disallowing a choice is recited functionally without details on how, technologically or by what algorithm, a disallowance is achieved, and as such is a way of controlling access to resources or data, which is a mental process. *See Ericsson Inc. v. TCL Commc'n Tech. Holdings Ltd.*, 955 F.3d 1317, 1327 (Fed. Cir. 2020) (holding that controlling access to resources is a process that "can be performed in the human mind, or by a human using a pen and paper" that long predates the claimed invention and "is pervasive in human activity").

When considered collectively and under the broadest reasonable interpretation, the limitations of claim 212 recite a method for sequencing digital media and advertising content to prevent commercial skipping by receiving, organizing, re-organizing, displaying, and storing data and controlling access based on the stored data.[8] This is an abstract idea

[8] We note that "[a]n abstract idea can generally be described at different levels of abstraction." *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240 (Fed. Cir. 2016). The Board's "slight revision of its abstract idea analysis does not impact the patentability analysis." *Id.* at 1241.

comprising "[m]ental processes—concepts performed in the human mind (including an observation, evaluation, judgment, opinion)" and a "[c]ertain method[] of organizing human activity— . . . commercial or legal interactions (including agreements in the form of contracts; legal obligations; advertising, marketing or sales activities or behaviors; business relations)." Revised Guidance, 84 Fed. Reg. at 52; MPEP § 2106.04(a)(2)(II)(B). As such, we disagree with the Appellant's assertion that the Examiner generalizes the claim. *See* Appeal Br. 33; Reply Br. 14.

Our reviewing court has held similar concepts to be abstract. For example, the Federal Circuit has held abstract the concepts of "organizing, displaying, and manipulating data of particular documents" in *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1340–41 (Fed. Cir. 2017) ("*Capital One Fin.*"), collecting, analyzing, and displaying the results in *Electric Power*, 830 F.3d at 1354, tailoring advertising in *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1370 (Fed. Cir. 2015) ("*Capital One Bank*"), "displaying an advertisement in exchange for access to copyrighted media" in *Ultramercial, Inc. v. Hulu LLC*, 772 F.3d 709, 714–15 (Fed. Cir. 2014), collecting, organizing, grouping, and storing data in *In re Jobin*, 811 F. App'x 633, 637 (Fed. Cir. 2020), and "receiving or collecting data queries, analyzing the data query, retrieving and processing the information constituting a response to the initial data query, and generating a visual or audio response to the initial data query" in *W. View Research, LLC v. Audi AG*, 685 F. App'x 923, 926 (Fed. Cir. 2017).

Having concluded that claim 212 recites a judicial exception under the Revised Guidance, Step 2A, Prong One, we next consider whether the claim

recites additional elements that integrate the judicial exception into a practical application.

Integration into a Practical Application

We look to whether the claim "appl[ies], rel[ies] on, or use[s] the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception," i.e., "integrates a judicial exception into a practical application." Revised Guidance, 84 Fed. Reg. at 54; MPEP § 2106.04(d). Here, the only additional elements recited in claim 212 beyond the abstract idea are the "client system," "first memory," "second memory," and "programmable processors" — elements that, as the Examiner observes (*see* Final Act. 3; Ans. 8), are described in the Specification as generic computer and off-the shelf components (*see, e.g.*, Spec. 14, ll. 2–23, 15, l. 13–18, l. 26; Figs. 1, 2).

We find no indication in the Specification, nor does the Appellant direct us to any indication, that the operations recited in claim 212 require any specialized computer hardware or other inventive computer components, i.e., a particular machine, invoke any asserted inventive programming, or that the claimed invention is implemented using other than generic computer components to perform generic computer functions. *See DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014) ("[A]fter *Alice*, there can remain no doubt: recitation of generic computer limitations does not make an otherwise ineligible claim patent-eligible."). We also find no indication in the Specification that the claimed invention as recited in claim 212 effects a transformation or reduction of a particular article to a different state or thing.

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The Appellant contends that "[c]laim 212 recites an improved computer-implemented way to adaptively re-sequence ad block positions in response to user input which is clearly different than the alleged abstract idea of 'preventing of commercial skipping by using a well-known device.'" Appeal Br. 31. The Appellant argues that the claim is "directed to improvements in the function of computers, specifically to increase flexibility in the way digital advertisements may be delivered." *Id.* at 32. The Appellant contends that "[t]his improvement is similar to those the courts recognized in *Core Wireless* [*Licensing, S.A.R.L. v. LG Electronics, Inc.*, 880 F.3d 1356 (Fed. Cir. 2018)], *Enfish*, and *McRO*[*, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299 (Fed. Cir. 2016)]." *Id.* at 31; *see also id.* at 32–33; Reply Br. 17–19.

In *Core Wireless*, the court found that the claims recited a specific improvement in computer technology – "an improved user interface for electronic devices, particularly those with small screens." 880 F.3d at 1363. In *Enfish*, the court held that the focus of the claims was to "a specific improvement to the way computers operate, embodied in the self-referential table." 822 F.3d at 1336. Specifically, "the claims [were] not simply directed to *any* form of storing tabular data, but instead [were] specifically directed to a *self-referential* table for a computer database." *Id.* at 1337. The Specification provided that "the self-referential table function[ed] differently than conventional database structures" (*id.*) and improved "the way a computer stores and retrieves data in memory" (*id.* at 1339). In *McRO*, the claims were directed to computer animation and used rules to automate a subjective task of humans to create a sequence of synchronized, animated characters. *See McRO*, 837 F.3d at 1314–15. Unlike *Flook*, *Bilski*,

and *Alice*, it was not the use of the computer, but the incorporation of the rules that improved an existing technological process. *Id.* at 1314. In finding the claims patent-eligible, *McRO* noted that the "abstract idea exception has been applied to prevent patenting of claims that abstractly cover results where 'it matters not by what process or machinery the result is accomplished.' [*O'Reilly v. Morse*, 56 U.S. (15 How.) 62, 113 (1853)]; *see also Mayo*, [566 U.S. at 85]." *Id.*

However, the improvements to which the Appellant refers are not technological improvements to computer technology, but rather improvements to the process, i.e., the abstract idea itself. The Appellant does not provide reasoning or evidence, and we do not see from the claim, how the computer itself is improved by adaptively re-sequencing ad block positions or by providing flexibility in the way advertisements are delivered. At best, this is an improvement in the organization and analysis of data, i.e., the abstract idea.

The Appellant argues that the claim "is directed to non-abstract improvements to computer technology because it **contains precise language delimiting the type of data to be sequenced and how to sequence and adaptively modify the sequence, thus improving upon conventional delivery, presentation, and user interaction of/with media content and advertising content**" (Appeal Br. 32) and because "the capability to adaptively regroup and re-sequence insertion of ad blocks on the fly can provide important benefits over conventional distribution systems by improving security, optimizing bandwidth, performance, and user interaction, etc. *See* [Spec.] at ¶0054, FIG. 3A, ¶0110-0111, ¶0117, ¶0186,

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and ¶202-204" (*id.* at 32–33; Reply Br. 16–17).[9] However, the Appellant does not explain, and we do not see from the claim, how the specific type of data to be sequenced and the modification of the sequence of data to be presented provide a technological improvement to the claimed client system and/or processors. At best, the type of data and sequence modification provide more relevant information and ensure advertisements are presented. This is not an improvement to technology. *See Capital One Bank*, 792 F.3d at 1369–71 (determining that tailoring advertisements has been long prevalent, is not a problem unique to the Internet, and is not an improvement). The claim does not recite a specific technological way of delivering, presenting, and interacting that improves the technology of the client system, a user interface as in *Core Wireless*, a database as in *Enfish*, or an existing technological process as in *McRO*.

Further, the Specification does not discuss how the claimed limitations "improve[] security, optimize[] bandwidth, and improve[] performance" of a computer. *See* Appeal Br. 33; Reply Br. 16–17. Rather, portions of the Specification cited by the Appellant (*see id.*) merely state that "one particular method of the invention provides for unlimited redistribution and free use under general license, enforced by the player/viewer software," that "is a new use of digital rights management practices, and . . . provides improved security by diminishing incentive on the part of the consumer to breach the system, since the desired content is already available free-of-

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[9] We note that the Specification as filed on February 14, 2014, does not contain paragraph numbers. We correlate the cited portions to the Specification as filed to the best of our ability.

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charge from within it" (Spec. 10, ll. 12–16), and "there is much less incentive on the part of the consumer to engage in piracy and other attempts to circumvent the digital rights security put in place according to the invention" (*id.* at 25, ll. 23–25). Any improvement to "security" is in preventing copyright infringement, which is not a problem rooted in technology, and the Specification does not discuss how, technologically, the security is improved. Although the Specification discusses encryption "to enforce security" (*id.* at 32, l. 30–33, l. 3), the claim recites no such limitation, and the Specification indicates that generic, conventional encryption techniques are used (*id.*). Regarding bandwidth, the Specification provides that "[t]his embodiment employs ordinary and new practices to optimize bandwidth utilization throughout its media delivery system, which is the apparatus providing media service 568 to player/viewer 560" (Spec. 36, ll. 28–30), without discussing how, technologically or by what algorithm, the new practices (as opposed to the ordinary ones) achieve an optimized bandwidth.

The Appellant also argues

> the subject matter of Claim 212 gives the "ability to adaptively regroup and re-sequence the insertion of ad blocks extemporaneously (i.e. 'on the fly'), in response to the consumer's arbitrary direction of the playback within the requested content." Specification, ¶0117. Because these processes are inextricably related to a computing system, the claimed subject matter cannot be abstract nor directed to a judicial exception (Step 2A).

Appeal Br. 32. That the claim is "inextricably related to a computing system" (Appeal Br. 32) at best limits the invention to a computer environment and does not make the claim less abstract. *See Affinity Labs of*

Tex., LLC v. DIRECTV, LLC, 838 F.3d 1253, 1259 (Fed. Cir. 2016) ("The Supreme Court and [the Federal Circuit] have repeatedly made clear that merely limiting the field of use of the abstract idea to a particular existing technological environment does not render the claims any less abstract."). Any improvement to re-sequencing ads lies in the process itself, an improvement in the abstract idea itself, not to any technological improvement. Having the "ability to adaptively regroup and re-sequence the insertion of ad blocks extemporaneously" (Appeal Br. 32) is "not an improvement in networking or computer functionality" as it does not "enable[] a computer . . . to do things it could not do before." *Finjan, Inc. v. Blue Coat Sys., Inc.*, 879 F.3d 1299, 1305 (Fed. Cir. 2018). Rather, the claim's focus is "not a physical-realm improvement but an improvement in a wholly abstract idea," that is not eligible for patenting. *SAP Am. Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1168 (Fed. Cir. 2018); *see also Bridge & Post, Inc. v. Verizon Commc'ns, Inc.*, 778 F. App'x 882, 893 (Fed. Cir. 2019) ("The ability to run a more efficient advertising campaign, even if novel, and even if aided by conventional computers, is an advance 'entirely in the realm of abstract ideas,' which we have repeatedly held to be ineligible.") (citation omitted).

The Appellant further argues that the limitations of claims 212 "more closely resemble the combination of elements present in the claims at issue in *DDR Holdings* or in *Bascom v. AT&T*." Appeal Br. 37[10] (citing *BASCOM*

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[10] We acknowledge that the Appellant presented this argument under Step 2 of the *Mayo*/*Alice* (Step 2B of Revised Guidance) and may be properly evaluated there. Solely for purposes of maintaining consistent treatment

Glob. Internet Servs., Inc. v. AT&T Mobility LLC, 827 F.3d 1341 (Fed. Cir. 2016)). Specifically, the Appellant argues that "in *Bascom*, the Federal Circuit has explicitly acknowledged that the mere ability of a claimed invention to be used in enhancing the execution of a commercial transaction" and that similar to *DDR Holdings*, claim 212 "involves a technical way to solve the existing (at the time of the current invention) problem of providing internet-supplied media content with advertising in a manner that allows for arbitrary user-controlled navigation/re-ordering of the content to combat piracy of content while still generating revenue from the advertising." Appeal Br. 37–38.

However, the Appellant does not provide adequate reasoning or evidence, and we do not see from the claim, how the limitations claim a technological solution to a computer-based problem, i.e., a solution "necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks." *DDR Holdings*, 773 F.3d at 1257. To the extent the Appellant argues that "providing internet-supplied media content with advertising in a manner that allows for arbitrary user-controlled navigation/re-ordering of the content" is a problem, the Appellant does not provide adequate reasoning or support that this was an existing technology problem or that the claim addresses this problem. Similarly, the Appellant's argument that "[t]he ability to 'adaptively regroup and re-sequence the insertion of ad blocks extemporaneously (i.e. 'on the fly'), in response to the consumer's arbitrary direction of the playback

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within the Office, we evaluate these arguments under Step 1 of *Alice/Mayo* (Step 2A of Revised Guidance). *See* Revised Guidance, 84 Fed. Reg. at 55.

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within the requested content' was not **technologically achievable for media presentation in the past**" (Appeal Br. 39; *see also* Reply Br. 16) is unsupported attorney argument. The Specification does not discuss why or that this was technologically unachievable, and claim 212 does not recite how, technologically, the adaptive modification of presentation placement is performed such that it would be a technical or technological improvement.

As discussed above, that the content is internet-supplied simply limits the invention to a technological field, but does not make it any less abstract. To the extent the Appellant argues that the claim addresses the problem of combatting piracy of content, this problem existed prior to the Internet, as the Appellant acknowledges. *See, e.g.*, Spec. 1, ll. 23–31 (discussing existing problems with unauthorized copying and distribution of licensed material); *see also Uniloc USA, Inc. v. Amazon.com, Inc.*, 243 F. Supp. 3d 797, 804 (E.D. Tex. 2017) ("licensing is a fundamental economic practice and because licenses are abstract exchanges of intangible contractual obligations"), *aff'd*, 733 F. App'x 1026 (Fed. Cir. 2018).

Further, the purported solution comprises a generic computer system and processors operating in their ordinary and conventional capacities. *See supra*; *see also Alice*, 573 U.S. at 224–26. As discussed above, the Appellant does not, and cannot, claim that they invented any of the claimed client system or processors, their basic functions, or that those components, claimed generally, were unknown in the art as of time of the invention. *See Affinity Labs*, 838 F.3d at 1270. The "focus" of the claim is not "on the specific asserted improvement in computer capabilities" (*Enfish*, 822 F.3d at 1336), but rather on using the computer device as a tool to implement the abstract idea in the particular field of digital content and advertising.

Regarding the Appellant's argument that the claim is similar to those of *BASCOM* (*see* Appeal Br. 37–38), the Appellant does not show how the claim here is similar to *BASCOM*'s "particular arrangement of elements [that] is a technical improvement over prior art ways of filtering such content" (827 F.3d at 1350). The patent at issue in *BASCOM* "claim[ed] a technology-based solution (not an abstract-idea-based solution implemented with generic technical components in a conventional way) to filter content on the Internet that overcomes existing problems with other Internet filtering systems." *Id.* at 1351. The court determined that "[b]y taking a prior art filter solution (one-size-fits-all filter at the ISP server) and making it more dynamic and efficient (providing individualized filtering at the ISP server), the claimed invention represents a 'software-based invention[ ] that improve[s] the performance of the computer system itself.'" *Id.* Here, there is no such improvement. Although the claim recites the structural element of a client computer with memory and processors, there is no claimed technological improvement to these structures or arrangement of these structures. Any improvement in the invention lies in the abstract idea itself, i.e., sequencing digital media and advertising content.

We also disagree that "Claim 212 is directed to an approach that improves the **technical field of distributing media content by dynamically integrating targeted advertising content into the digital media content that are presented to users**." Appeal Br. 39. Claim 212 provides no details as to how the content is distributed such that there would be a technical improvement to the field of distributing media content. Rather, the claim here organizes the content based on some generic analysis,

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disallows a choice by some unrecited method, and presents the content using a conventional system with processors.

The Appellant further argues that claim 212 is similar to the claims held patent-eligible in *Finjan* and *Ancora Techs., Inc. v. HTC Am., Inc.*, 908 F.3d 1343 (Fed. Cir. 2018). Reply Br. 16–18.[11] However, in both of those cases, as the Appellant acknowledges (*id.*), the court found that the claims recited a specific improvement in computer technology — by "employ[ing] a new kind of file that enables a computer security system to do things it could not do before" in *Finjan* (879 F.3d at 1305), and "by a specific technique that departs from earlier approaches to solve a specific computer problem," the "functionality improvement . . . effectuated in an assertedly unexpected way" of moving a software-verification structure to a location not previously used for this purpose, thereby altering how the security verification function is performed in *Ancora* (908 F.3d at 1348–50). Here, as discussed above, there is nothing that the claimed system and processor could not have done before, technologically, nor is there a technologically unconventional solution to solve a problem rooted in computers; rather, claim 212 merely uses a computer as a tool to sequence digital media and advertising content into a stream and modify the position of content (Reply Br. 16–18).

Thus, we are not persuaded of error in the Examiner's determination that claim 212 is directed to an abstract idea.

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[11] The *Finjan* decision was issued prior to the filing of the Appeal Brief, but was not raised until the Reply Brief and good cause has not been shown as to why it was not. However, to expedite prosecution, we will consider it.

Step Two of the Mayo/Alice Framework

Under the second step in the *Alice* framework and USTPO guidance Step 2B, we "[e]valuat[e] additional elements to determine whether they amount to an inventive concept [which] requires considering them both individually and in combination to ensure that they amount to significantly more than the judicial exception itself." MPEP § 2106.05(I). Here, the Examiner finds that "[t]aking the claim elements individually, the functions performed by the computer at each step of the process are purely conventional." Final Act. 3 (citing Office guidance and judicial decisions). The Examiner further finds that "[e]ven when considered as an ordered combination, the computer components add nothing that is not already present when the steps are considered separately" because "the claim[] simply convey[s] the abstract idea itself applied on some generic computer system." *Id.* at 4. Thus, the Examiner concludes that claim 212 "amount[s] to nothing significantly more than an instruction to apply the abstract idea using some unspecified, generic computer." *Id.* We find supported the Examiner's determination that claim 212's additional elements beyond the abstract idea, taken individually or as an ordered combination, do not amount to significantly more than the judicial exception.

The Appellant contends that "[c]laim 212 recites significantly more than the alleged abstract idea of preventing of commercial skipping." Appeal Br. 33. Specifically, the Appellant argues that "as in *Bascom*, the claim elements of Claim 212 cannot properly be rejected by the mere assertion that they are drawn to well-known, routine, and conventional practices as alleged on p. 4 of the Office Action." *Id.* at 34. The Appellant cites to the USPTO Memorandum on Changes in Examination Procedure

Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP, Inc.*) (April 19, 2018) ("*Berkheimer* Memo") and contends that "the Examiner has not provided **any of the above support** for the assertion that the elements of Claim 212 are well-understood, routine or conventional and has therefore failed to meet the Office's burden under Step 2B and MPEP § 2106." *Id.* at 35 (referring to paraphrased portions of the *Berkheimer* Memo 3–4 and citing Final Act. 4); *see also* Reply Br. 15–16. The Appellant argues that the "ordered combinations of elements (implemented by operation of one or more processors) that include" receiving data, sequencing content, adaptively modifying a position of the content, causing presentation of the content, keeping a setting, disallowing a navigation choice, and storing data "cannot be reasonably construed as well-known, conventional, or routine," that the "rejection makes no such assertion," and that "[t]hese features, whether taken alone or in combination, do not resemble claim limitations that the courts have previously found to be well-understood, routine, or conventional." Appeal Br. 35–37. We disagree.

As discussed above, under Step 2B we look to whether the additional elements beyond the abstract idea, individually or in combination, provide an inventive concept. 84 Fed. Reg. at 55. *Alice* is clear, as described above, that under step two of the *Mayo/Alice* framework, the elements of each claim are considered both individually and "as an ordered combination" to determine whether the additional elements, i.e., the elements other than the abstract idea itself, "transform the nature of the claim" into a patent-eligible application. *Alice*, 573 U.S. at 217; *see also Mayo*, 566 U.S. at 72–73 (requiring that "a process that focuses upon the use of a natural law also

contain other elements or a combination of elements, sometimes referred to as an 'inventive concept,' sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the natural law itself"). In other words, the inventive concept under step two of the *Mayo/Alice* framework cannot be the abstract idea itself: "It is clear from *Mayo* that the 'inventive concept' cannot be the abstract idea itself, and *Berkheimer* . . . leave[s] untouched the numerous cases from this court which have held claims ineligible because the only alleged 'inventive concept' is the abstract idea." *Berkheimer v. HP, Inc.*, 890 F.3d 1369, 1374 (Fed. Cir. 2018) (Moore, J., concurring) (*Berkheimer II*); *see also BSG Tech LLC v. BuySeasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018) ("It has been clear since *Alice* that a claimed invention's use of the ineligible concept to which it is directed cannot supply the inventive concept that renders the invention 'significantly more' than that ineligible concept.") (citation omitted).

To the extent the Appellant argues that claim 212 recites elements that amount to significantly more than the abstract idea because the claim "recite[s] a novel and inventive method" (Appeal Br. 33), an abstract idea does not transform into an inventive concept just because the prior art does not disclose or suggest it. *See Mayo*, 566 U.S. at 78. "Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry." *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 591 (2013). Indeed, "[t]he 'novelty' of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter." *Diehr*, 450 U.S. at 188–89; *see also Mayo*, 566 U.S. at 91 (rejecting "the Government's invitation to substitute

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§§ 102, 103, and 112 inquiries for the better established inquiry under § 101").

Here, the only additional elements beyond the abstract idea are the client and remote devices, i.e., computers with memory and processors programmed to perform all of the limitations of claim 212. *See* Final Act. 4; Ans. 7; *supra*. We note the claim simply recites the functional results to be achieved by the devices. The claim "provides only a result-oriented solution[] with insufficient detail for how a computer accomplishes it. Our law demands more." *Capital One Fin.*, 850 F.3d at 1342. The claimed functions of receiving, sequencing, adaptively modifying, causing presentation, keeping a setting, disallowing a choice, and storing data are part of the abstract idea itself; they are not additional elements to be considered when determining whether claim 212 includes additional elements or a combination of elements that is sufficient to amount to significantly more than the judicial exception.

As discussed above, the only claim elements beyond the abstract idea are the client system with memory and processor programmed to perform the steps, recited generally, that the Specification indisputably shows were conventional at the time of filing. *See supra*; Spec. 14, ll. 2–23, 15, l. 13–18, l. 26; Figs. 1, 2. The Appellant does not provide any supported reasoning or explanation that the functions of receiving data, sequencing and adaptively modifying, i.e., organizing content, presenting content, keeping a setting, disallowing a choice, i.e., preventing access to data, and storing data are not well-understood, routine, and conventional. And, in compliance with the *Berkheimer* Memo, the Examiner provides support for the claimed functions being "purely conventional" and "well-understood, routine, and

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conventional . . . when they are claimed in a merely generic manner" by providing "citation[s] to one or more of the court decisions discussed in MPEP § 2106.05(d)(II) as noting the well-understood, routine, conventional nature of the additional element(s)." Final Act. 3; *Berkheimer* Memo 4.

The Appellant cannot reasonably maintain that there is a genuine issue of material fact regarding whether operation of the claimed device or processor is well-understood, routine, or conventional, where, as here, there is nothing in the Specification to indicate that the operations recited in claim 212 require any specialized hardware or inventive computer components, or that the claimed invention is implemented using other than generic hardware or computer components to perform the generic computer functions as discussed above. Indeed, the Federal Circuit, in accordance with *Alice*, has "repeatedly recognized the absence of a genuine dispute as to eligibility" where claims have been defended as involving an inventive concept based "merely on the idea of using existing computers or the Internet to carry out conventional processes, with no alteration of computer functionality." *Berkheimer II*, 890 F.3d at 1373 (Moore, J., concurring) (citations omitted).

Here, as discussed above, the elements other than the abstract idea are recited at a high level of generality and are used in their ordinary and conventional capacities to receive, organize, display, store, and generate, store, receive, analyze, and prevent access to data. *See Capital One Fin.*, 850 F.3d at 1341 (holding that collecting, organizing, identifying, mapping, organizing, defining, and detecting was abstract); *Capital One Bank*, 792 F.3d at 1369–71 (holding that "the entry of data into a computer database, the breakdown and organization of that entered data according to some

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criteria, . . . and the transmission of information derived from that entered data to a computer user, all through the use of conventional computer components, such as a database and processors, operating in a conventional manner" did not transform a patent-ineligible process into something more); *Elec. Power*, 830 F.3d at 1355 (gathering, sending, monitoring, analyzing, selecting, and presenting information does not transform the abstract process into a patent-eligible invention); *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1095 (Fed. Cir. 2016) (generating a rule related to accessing information, applying the rule, and storing and announcing the result did not transform the abstract idea into a patent-eligible invention); *Inventor Holdings, LLC v. Bed Bath & Beyond, Inc.*, 876 F.3d 1372, 1378 (Fed. Cir. 2017) (holding that sequence of data retrieval, analysis, modification, generation, display, and transmission was abstract).

The Appellant's argument that the combination of elements are similar to those of *DDR Holdings* and *BASCOM* (Appeal Br. 37–38) are unpersuasive of error for the reasons discussed above with respect to Step 1 of the *Mayo*/*Alice* framework.[12] Thus, we are not persuaded of error in the Examiner's determination that the limitations of claim 212 do not transform the claim into significantly more than the abstract idea.

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[12] We note the Appellant's argument regarding *Ex parte Relyea*, Appeal No. 2017-001443 (April 18, 2018). Appeal Br. 38. First, we note that the Specification and claim limitations in *Relyea* are different than those at issue here. *See id.* Second, we are not bound by a decision of another panel in a non-precedential Board opinion. We similarly do not consider the Appellant's comparisons to "*PTAB '084 Decision*." Reply Br. 15.

Therefore, we are not persuaded of error in the Examiner's determination that the limitations of claim 212 do not transform the claim into significantly more than the abstract idea.

We sustain the Examiner's rejection under 35 U.S.C. § 101 of independent claim 212 and of claims 214–223, and 225–273, the rejection of which stands with claim 212.

35 U.S.C. § 112(a) – Written Description

The Examiner rejects claims 212, 214–223, and 225–273 as failing to comply with the written description requirement of 35 U.S.C. § 112, first paragraph, because the Specification does not describe, in a way to reasonably convey to one of ordinary skill in the art at the time the application was filed, that the Appellant had possession of the claimed invention, i.e., that the Specification as filed had written description support for

> adaptively modifying, . . . a presentation position of the digital advertising content from at least one of the one or more initially sequenced insertion points to one or more alternatively sequenced insertion points, *at least one of the one or more alternatively sequenced insertion points being different than the one or more initially sequenced insertion points relative to the digital media content* within the user-perceptible content stream.

Final Act. 5. The Examiner finds that although the Specification discusses "that the intersplicer has the ability to adaptively regroup and re-sequence the insertion of ad blocks extemporaneously (i.e. 'on the fly'), in response to the consumer's arbitrary direction of the playback within the requested content, by means of playback controls" and "that the method has the power to require and enforce the presentation of paid advertisements inserted at

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regular intervals within the requested media content . . . , the advertisement sequencing that may occur in combination over a playback sequence of requested audio or video media content," the Specification does not discuss at least one of the alternatively sequenced insertion point being different than the initially sequenced insertion points relative to the content. *Id.* Specifically, the Examiner finds that "the insertion point of the ads remain in the same sequence, i.e. next to the media segment" and that "[e]ven if a user skips from one segment to another, the ad location remains the same, which is after a pre-defined number of media segments." Ans. 3.

The Appellant contends that "the claim feature at issue in this rejection is well-supported at least by ¶0149-¶0150, and also at ¶0154-¶0156, referring to FIG. 4A." Appeal Br. 19 (citing Spec. 28, l. 27–29, l. 4, 28, l. 23–29, l. 16). Specifically, the Appellant contends that

> In the scenario described in ¶0150, ad block 410 is played at a point immediately preceding "the middle of segment 434," which is an "alternate insertion point" that is clearly "different than the one or more initially sequenced insertion points relative to the digital media content within the user-perceptible content stream," which would, in this example, be those insertion points originally scheduled to occur between the segments.

Id. The Appellant also contends that the Specification provides additional support in that

> ad blocks 414 and 416 are initially sequenced after tracks 448 and 456, respectively, but in response to the user "skipping around or other navigation," ad block insertions wind up at different positions relative to those tracks to comply with pre-defined placement rules (which in this example are track count rules).

Id. at 20. The Appellant argues that

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> the Examiner seems to be misconstruing the claim language as requiring the modification of the initial ad "*insertion points*" in the media stream, whereas the claim recites modifying "a *presentation position*" of the ad content regardless of the point the ad was scheduled to be inserted in the stream initially. In other words, in a media stream, an ad segment may be initially scheduled to be *inserted* following a media segment. However, the point of initial insertion in the stream is not the same as the recited "*presentation position*" of the ad content during play. . . . [I]t is the "*presentation position*" of the ad in the stream that may be adaptively modified (e.g., due to user input), as claimed and as clearly supported in the Specification.

Reply Br. 4.[13]

We agree with the Appellant that the Examiner appears to equate the claimed presentation position with the sequenced insertion point. The claims require modifying the presentation position from one initial insertion point to a different insertion point. *See, e.g.*, Appeal Br. 42 (Claims App., claim 212). That the sequence of the content, i.e., an ad next to media content, remains the same does not indicate that the position of the ad in the presentation content stream is unchanged, for example, not playing an ad block after a track 456 when a previous track is skipped, but inserting the ad

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[13] The Appellant's contention that the Examiner's Answer contains new grounds of rejection is not considered. *See* Reply Br. 4. If the Appellant sought to contest the failure of the Examiner to designate the rejections as containing new grounds, the proper recourse was to request review of the Examiner's Answer "by way of a petition to the Director under § 1.181 of this title within two months from the entry of the examiner's answer and before the filing of any reply brief." 37 C.F.R. § 41.40(a) (2019). The Appellant has not filed such a petition. Rather, the Appellant maintained the appeal by filing a reply brief addressing the alleged new grounds. *Id.* § 41.39(b)(2).

after the played track 458. *See* Reply Br. 5–6. And, we agree with the Appellant that the cited portions of the Specification adequately support the claim language "because the noted portions of the [Specification] particularly disclose that an ad block's presentation position in sequences 402 and 404, for example, may be modified to a new point in the sequence, depending on user input (i.e., user interaction)." *Id.* at 8.

Therefore, based on the record before us, we do not sustain the written description rejection of claims 212, 214–223, and 225–273.

35 U.S.C. § 103 - Obviousness

The Appellant contends that the Examiner's rejection of independent claims 212, 238, 243, 267, 268, and 271 is in error because "Knepper does not describe or suggest 'at least one of the one or more alternatively sequenced insertion points being different than the one or more initially sequenced insertion points relative to the digital media content of' independent Claim 212 or the corresponding features of Claims 238, 243, 267, 268, and 271." Appeal Br. 21 (bolding omitted). After careful review of the record before us, we agree.

The Examiner relies on Knepper for teaching this limitation finding, in relevant part, that Knepper teaches "receiving, a user input representing one or more navigational choices associated with a presentation of the content stream (*play forwarding, skipping*), modifying (re-sequencing), [and] using a pre-defined rules presentation position of an advertisement from initial sequenced position to alternative sequenced insertion point (position)." Final Act. 7 (citing Knepper ¶¶ 34–42, 59). The Examiner further finds

> Same as applicant's disclosure, the advertisement and the media of Knepper which were sequenced to be played in a predefined order, when the user skips or forwards to a different music (e.g. to a third media in the sequence after playing the first media in the sequence), the ad appended to the media (third media) would also be played as a second in the sequence (the media and ad combination) instead of the ad appended to the second media in the sequence (play list) (see applicant's specification [0144]-[0149]).

Id. at 8 (italics omitted); *see also id.* at 16 ("similar to Applicant's disclosure, Knepper teaches the ads plays with the content as the user skips back and forth"). The Examiner finds that Knepper teaches by using tags that are "specific instructions regarding treatment of the advertising media files," "the server can direct the client to place an ad before, during or after a media file during playback of media files in the magazine page." Ans. 4 (citing Knepper ¶ 52). "[W]hen the sequence of media segment changes (from a 1st in the sequence to a 3rd in the sequence, the ad position also changes adaptively with the media file." *Id.* The Examiner finds

> Knepper also show a first sequencing of media files and ad files (a playlist of media files with ad files). However, when a user does not follow the pre-set order of the playlist, by skipping media files in the sequence, the order of the play list changes (e.g. instead of a media file being the 3nd [sic] in order, it would be a 2nd in the order), the position of the ad file also changes within the playlist.

Id. at 5.

Knepper discloses a "system and method for transferring entertainment media files and advertisement media files." Knepper Abstract. Three components of "entertainment rich media files, advertisement rich media files, and an instruction set, or text file, that

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describes the assembly and playback order of the media files" are used. *Id.* ¶ 25. The entertainment media files from storage, that are pre-cached on the client side and ready for playback, may be downloaded from a server to a client at any time. *Id.* ¶ 27; *see also id.* ¶ 35. "The instruction set may be an HTML file or a text file that includes tags or other specific instructions to the client," "is a listing of the order of the entertainment and advertisement media files that will make up the show that was requested by the user," "is created on the server side, in some instances at the time of the user's request, and may be specific to each user." *Id.* ¶ 34. Playback may begin before all files are cached. *Id.* ¶ 35. "After all of the necessary media files are resident at the client side . . . , the client application assembles the entertainment and advertisement media files and begins playback of the various media files (and static images received by the client application) in the order specified by the instruction set . . . ." *Id.* ¶ 37. The instruction set can be modified to insert random ads and create a play list. *Id.* ¶ 37; Fig. 3 (block 294). The media files appear as a single file played in a continuous show clip. *Id.* ¶¶ 37, 38. The instruction set is analyzed by the client-side application; then, a show is built by pulling media files from storage as listed on the instruction set, and if "not already resident at the client side, then the appropriate advertisement media files 409 are retrieved from a server side advertisement file storage 105." *Id.* ¶ 40. "The sequence of multiple media files, including combinations of entertainment files and advertisement files, is retrieved from storage in response to a single request or action from the client side, whether the request is direct or derived from a user subscription." *Id.*

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Knepper further discloses that "[i]n one embodiment, the media files play together sequentially, similar to a television show with commercials inserted at various points," whereby the entertainment media files are blended with the advertisement media files, and "[t]he entertainment media files include indications within the files, or possibly in an external file, pointing to where, if at all, the entertainment media files may have advertisement media files inserted therein." *Id.* ¶ 41. "When a client-side user selects a particular entertainment file . . . , the server sends the entertainment file to the user, or the portion of the entertainment file that had not been previously pre-cached at the client side." *Id.* "The server also sends a text file containing a set of instructions indicating which advertisement media files from among the pre-cached advertisement media files to insert into the entertainment media file at run time, how many advertisement media files to insert, and where to insert them." *Id.* The instruction file does not need to specify "exactly which advertisement media files to insert," but can "allow the client application to make its own random or pseudo-random selection, subject to any positive and negative associations, for playing back with the entertainment media file." *Id.*

Knepper uses "[t]wo new tags, not standard to HTML programming," specifically <ADInsert> and <ADOverlay> tags, to "give the server complete control over the content and placement of the ads within a show, even though this is eventually carried out on the client side." *Id.* ¶ 52. "Using these tags, the server can direct the client to place an ad before, during, or after a media file during playback of media files in the magazine page." *Id.* "The placement of the <ADinsert> tags within the ClipTag section dictates the sequence of advertisement and entertainment media

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files." *Id.* ¶ 55. In one example, "all of the content designated inside of the <ADInsert> tags is downloaded and then all of the content designated inside of the <ClipTag> tags is downloaded." After receipt of the all of the content, "the client begins to display the content in the application," so that the art and the advertisement media file are displayed by the client before the static image and the entertainment media file "because of the placement of these files within the instruction set as defined." *Id.* ¶ 55. In another example, "the client displays the entertainment media file and associated graphic panel content before it plays the advertisement media file with its associated graphic panel content." *Id.* ¶ 59. "According to this instruction set, once the user directs the client application to begin playing the show, the client begins to play the entertainment media files in the first panel within the magazine." *Id.* "When the entertainment media file is finished playing, the advertisement media file immediately proceeds, without the appearance of a page turn." *Id.*

We agree with the Appellant that Knepper does not describe "the claim features in which an alternate insertion point (that differs from any initial insertion point) relative to digital media is used in response to user input that causes the adaptively modifying as claimed." Appeal Br. 22. Knepper teaches two examples where (1) the art and advertising files can precede the static entertainment file or (2) the entertainment file precedes the advertisement file. However, we do not see, and the Examiner does not direct attention to, where Knepper teaches "when a user does not follow the pre-set order of the playlist, by skipping media files in the sequence, the order of the play list changes (e.g. instead of a media file being the 3nd [sic] in order, it would be a 2nd in the order), the position of the ad file also

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changes within the playlist." Ans. 5. Rather, we agree with the Appellant that "[e]ven assuming, *arguendo*, that a user could navigate between Knepper pages and that would somehow change the order at which specific advertisement content is presented, the advertising insertion points as described in Knepper would still be at the exact same positions," whereas the claims require adaptively modifying or re-sequencing with an alternate insertion point different from the initial insertion point. Appeal Br. 22–23.

We further agree with the Appellant that Knepper does not teach adaptively modifying or re-sequencing the presentation position in response to user input, because Knepper's server determines the order of the media, sends that order to the client-side device, and even if the user skips pages, the order as provided by the instruction set, remains the same. *See id.* at 23–24. Although Knepper provides that the instruction set can be modified to insert random ads and create a play list (*see* Knepper ¶ 37; Fig. 3 (block 294)), we do not see, and the Examiner does not explain, where Knepper teaches that the order of the presentation, as contained in the instruction set, changes in response to user input.

Thus, based on the record before us, we do not sustain the obviousness rejection of claims independent claims 212, 238, 243, 267, 268, and 271. We also do not sustain the rejection of dependent claims 214–223, 225–232, 234–237, 239–242, 244–249, 251–255, 257–266, 269, 270, 272, and 273 under the same ground of rejection. The rejections of dependent claims 233, 250, and 256 as further obvious over Official Notice or Oh are also not sustained, as they fail to include additional findings and/or reasoning that cures the deficiency in the rejections of the independent claims, from which they depend.

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CONCLUSION

The Examiner's decision to reject claims 212, 214–223, and 225–273 is sustained.

In summary:

Claims Rejected	35 U.S.C. §	References/ Basis	Affirmed	Reversed
212, 214–223, 225–273	101	Eligibility	212, 214–223, 225–273	
212, 214–223, 225–273	112, first	Written Description		212, 214–223, 225–273
212, 214–223, 225–232, 234–249, 251–255, 257–273	103(a)	Knepper, Hannah, Wang		212, 214–223, 225–232, 234–249, 251–255, 257–273
233, 256	103(a)	Knepper, Hannah, Wang, Official Notice		233, 256
250	103(a)	Knepper, Hannah, Wang, Oh		250
Overall Outcome			212, 214–223, 225–273	

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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To: IPDocketingBOS@mintz.com,IPFileroombos@mintz.com,mintzdocketing@cpaglobal.com
From: PAIR_eOfficeAction@uspto.gov
Cc: PAIR_eOfficeAction@uspto.gov
Subject: Private PAIR Correspondence Notification for Customer Number 64046

Aug 12, 2020 03:41:57 AM

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Application	Document	Mailroom Date	Attorney Docket No.
10606729	APDA	08/12/2020	42327-501001US

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PATENT APPLICATION INFORMATION RETRIEVAL SYSTEM

Doc code: RCEX
Doc description: Request for Continued Examination (RCE)

PTO/SB/30EFS (02-18)
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REQUEST FOR CONTINUED EXAMINATION(RCE)TRANSMITTAL
(Submitted Only via EFS-Web)

Application Number	10606729	Filing Date	2003-06-26	Docket Number (if applicable)	042327-501001US	Art Unit	3688
First Named Inventor	Philip M. Donian			Examiner Name	Yehdega Retta		

This is a Request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application.
Request for Continued Examination (RCE) practice under 37 CFR 1.114 does not apply to any utility or plant application filed prior to June 8, 1995, or to any design application. The Instruction Sheet for this form is located at WWW.USPTO.GOV

SUBMISSION REQUIRED UNDER 37 CFR 1.114

Note: If the RCE is proper, any previously filed unentered amendments and amendments enclosed with the RCE will be entered in the order in which they were filed unless applicant instructs otherwise. If applicant does not wish to have any previously filed unentered amendment(s) entered, applicant must request non-entry of such amendment(s).

☐ Previously submitted. If a final Office action is outstanding, any amendments filed after the final Office action may be considered as a submission even if this box is not checked.

☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on _____

☐ Other _____

☒ Enclosed

☒ Amendment/Reply

☐ Information Disclosure Statement (IDS)

☐ Affidavit(s)/ Declaration(s)

☐ Other _____

MISCELLANEOUS

☐ Suspension of action on the above-identified application is requested under 37 CFR 1.103(c) for a period of months _____
(Period of suspension shall not exceed 3 months; Fee under 37 CFR 1.17(i) required)

☐ Other _____

FEES

The RCE fee under 37 CFR 1.17(e) is required by 37 CFR 1.114 when the RCE is filed.

☒ The Director is hereby authorized to charge any underpayment of fees, or credit any overpayments, to Deposit Account No 50-0311

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

☒ Patent Practitioner Signature

☐ Applicant Signature

PTO/SB/30EFS (02-18)
Approved for use through 11/30/2020. OMB 0651-0031
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Signature of Registered U.S. Patent Practitioner			
Signature	/FJF/	Date (YYYY-MM-DD)	2020-10-13
Name	F. Jason Far-hadian	Registration Number	75822

This collection of information is required by 37 CFR 1.114. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450.

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1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Doc Code: TRACK1.REQ
Document Description: TrackOne Request

PTO/AIA/424 (04-14)

CERTIFICATION AND REQUEST FOR PRIORITIZED EXAMINATION UNDER 37 CFR 1.102(e) (Page 1 of 1)

First Named Inventor:	Philip M. Donian	Nonprovisional Application Number (if known):	10/606,729
Title of Invention:	METHOD AND APPARATUS FOR THE FREE LICENSING OF DIGITAL MEDIA CONTENT		

APPLICANT HEREBY CERTIFIES THE FOLLOWING AND REQUESTS PRIORITIZED EXAMINATION FOR THE ABOVE-IDENTIFIED APPLICATION.

1. The processing fee set forth in 37 CFR 1.17(i)(1) and the prioritized examination fee set forth in 37 CFR 1.17(c) have been filed with the request. The publication fee requirement is met because that fee, set forth in 37 CFR 1.18(d), is currently $0. The basic filing fee, search fee, and examination fee are filed with the request or have been already been paid. I understand that any required excess claims fees or application size fee must be paid for the application.

2. I understand that the application may not contain, or be amended to contain, more than four independent claims, more than thirty total claims, or any multiple dependent claims, and that any request for an extension of time will cause an outstanding Track I request to be dismissed.

3. The applicable box is checked below:

I. ☐ Original Application (Track One) - Prioritized Examination under § 1.102(e)(1)

i. (a) The application is an original nonprovisional utility application filed under 35 U.S.C. 111(a). This certification and request is being filed with the utility application via EFS-Web.

---OR---

(b) The application is an original nonprovisional plant application filed under 35 U.S.C. 111(a). This certification and request is being filed with the plant application in paper.

ii. An executed inventor's oath or declaration under 37 CFR 1.63 or 37 CFR 1.64 for each inventor, **or** the application data sheet meeting the conditions specified in 37 CFR 1.53(f)(3)(i) is filed with the application.

II. ☑ Request for Continued Examination - Prioritized Examination under § 1.102(e)(2)

i. A request for continued examination has been filed with, or prior to, this form.
ii. If the application is a utility application, this certification and request is being filed via EFS-Web.
iii. The application is an original nonprovisional utility application filed under 35 U.S.C. 111(a), or is a national stage entry under 35 U.S.C. 371.
iv. This certification and request is being filed prior to the mailing of a first Office action responsive to the request for continued examination.
v. No prior request for continued examination has been granted prioritized examination status under 37 CFR 1.102(e)(2).

Signature /FJF/	Date 2020/10/13
Name (Print/Typed) F. Jason Far-hadian, Esq.	Practitioner Registration Number 42,523

Note: *This form must be signed in accordance with 37 CFR 1.33. See 37 CFR 1.4(d) for signature requirements and certifications. Submit multiple forms if more than one signature is required.**

☐ *Total of _____ forms are submitted.

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The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Electronic Patent Application Fee Transmittal

Application Number:	10606729
Filing Date:	26-Jun-2003
Title of Invention:	Method and apparatus for the free licensing of digital media content
First Named Inventor/Applicant Name:	Philip M. Donian
Filer:	Farshad Jason Far-hadian/Emily Rogers
Attorney Docket Number:	42327-501001US

Filed as Micro Entity

Filing Fees for Utility under 35 USC 111(a)

Description	Fee Code	Quantity	Amount	Sub-Total in USD($)
Basic Filing:				
REQUEST FOR PRIORITIZED EXAMINATION	3817	1	1050	1050
Pages:				
Claims:				
Miscellaneous-Filing:				
Petition:				
Patent-Appeals-and-Interference:				
Post-Allowance-and-Post-Issuance:				

Description	Fee Code	Quantity	Amount	Sub-Total in USD($)
Extension-of-Time:				
Miscellaneous:				
RCE- 2ND AND SUBSEQUENT REQUEST	3820	1	500	500
		Total in USD ($)		**1550**

Electronic Acknowledgement Receipt	
EFS ID:	40833819
Application Number:	10606729
International Application Number:	
Confirmation Number:	5831
Title of Invention:	Method and apparatus for the free licensing of digital media content
First Named Inventor/Applicant Name:	Philip M. Donian
Customer Number:	64046
Filer:	Farshad Jason Far-hadian/Emily Rogers
Filer Authorized By:	Farshad Jason Far-hadian
Attorney Docket Number:	42327-501001US
Receipt Date:	13-OCT-2020
Filing Date:	26-JUN-2003
Time Stamp:	18:23:46
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	yes
Payment Type	DA
Payment was successfully received in RAM	$1550
RAM confirmation Number	E20200CI24133527
Deposit Account	500311
Authorized User	Emily Rogers
The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows: 37 CFR 1.21 (Miscellaneous fees and charges)	

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1		Amendment.pdf	253452 4b3d95d62d9f96b8887dfa5312e6e008c2c1a6c6	yes	25

	Multipart Description/PDF files in .zip description		
	Document Description	**Start**	**End**
	Applicant Arguments/Remarks Made in an Amendment	11	25
	Claims	2	10
	Amendment/Argument after Patent Board Decision	1	1

Warnings:

Information:

2	Request for Continued Examination (RCE)	RCE.pdf	50028 4435560b5f9506d966e86c14e7e8aac7a1fe2a10	no	3

Warnings:

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Information:

3	TrackOne Request	Track_One_Request.pdf	79566 6e46fb39d2f216bb48bbd735ca9f3caeecd7a44d	no	2

Warnings:

Information:

4	Fee Worksheet (SB06)	fee-info.pdf	32247 abb6bff6b32ac07c284d70ee2b2a7759670fc8c8	no	2

Warnings:

Information:

Total Files Size (in bytes):	415293

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New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

II. REMARKS

With this amendment, claims 212, 214-218, 221-223, 231, 234, 238, 240-243, and 267 have been amended. New Claim 274 has been added. Claims 232, 239, 244-266, and 268-273 have been canceled. Support for the amended features of claims 212, 238, 243, and 267 can be found at least paragraphs 0057 and 0117.

After entering the above amendments, claims 212, 214-223, 225-231, 233-238, 240-243, 267, and 274 will be pending. Reconsideration and allowance of the current Application are requested in light of the above-marked amendments and the following remarks.

Claims 212, 214-223, 225-231, 233-238, 240-243, and 267 stand rejected under 35 U.S.C. §101, because the Office alleges that the claims are drawn to unpatentable subject matter. This rejection is respectfully traversed.

Subject Matter Eligibility Standard

In *Alice v. CLS Bank*, the Supreme Court outlined a two-step analytical framework for analyzing subject matter eligibility under Section 101.[1] Step 1 requires a determination of whether the claim is directed to a process, machine, or composition of matter. In response to step 1 being decided in the affirmative, step 2A (part 1 of the *Mayo* test) requires a determination of whether the claims are directed to a law of nature, a natural phenomenon, or an abstract idea (judicial exceptions). In response to step 2A being decided in the affirmative, step 2B (part 2 of the *Mayo* test) requires a determination of whether the claim recites additional elements that amount to significantly more than the judicial exception.[2]

Subsequent Federal Circuit decisions and USPTO guidance have provided additional guidance on the subject matter eligibility requirement. For example, in *Enfish v. Microsoft*, the Federal Circuit held that a claim directed to a self-referential table was patent-eligible because it

[1] *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2355 (2014).
[2] *See id.*; 2014 USPTO Interim Guidance on Patent Subject Matter Eligibility (reflected in 79 Fed. Reg. 74,618 et seq. (December 16, 2014)).

was directed to a specific, asserted improvement in computer capabilities.[3] In *BASCOM v. AT&T*, the Federal Circuit held that a claim containing known, conventional pieces was patent-eligible because it provided a non-conventional and non-generic arrangement of those pieces.[4] Further, in *McRO v. Bandai*, the Federal Circuit held that a claim requiring specific rules to render 3-D animations in a specific way was patent-eligible because the use of the rules did not preempt others from rendering 3-D animations using generic rules.[5]

In the 2019 PEG, the USPTO specified that the analysis under step 2A involves a two-prong approach. Prong One: evaluate whether a claim recites a judicial exception including identifying specific limitation(s) that are believed to recite an abstract idea and determining whether the identified limitation(s) **fall within an enumerated abstract idea grouping**. The enumerated abstract groupings include: a) mathematical concepts, b) certain methods of organizing human activity, and c) mental processes. Under Prong Two: evaluate whether the claim integrates the judicial exception into a practical application. *2019 PEG*, p. 52-53. As applied to the instant application, claim 212 is directed toward new and useful processes, machines, and/or improvements thereof. *See* 35 U.S.C §101. Thus, claim 212 complies with step 1 of the *Alice/Mayo* test.

Step 2A – Prong 1: the pending claims do not recite an abstract idea because they are inextricably tied to computer technology and distinct from the types of concepts found by the courts to be abstract.

The MPEP requires the Examiner to identify abstract ideas by comparing the claimed subject matter to concepts already found to be abstract in the body of case law precedent.[6] The abstract idea inquiry in the two-part *Mayo*[7] framework requires a proper construction of the claimed subject matter. The USPTO released 2019 revised patent subject matter eligibility guidance in January 2019 (2019 PEG) and a patent eligibility guidance update in October 2019 (2019 PEG Update). In the guidance, the USPTO specified that the analysis under step 2A

[3] *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335-36 (Fed. Cir. 2016).
[4] *BASCOM Global Internet Servs. v. AT&T Mobility LLC*, 827 F.3d 1341, 1350 (Fed. Cir. 2016).
[5] *McRO, Inc. v. Bandai Namco Games Am.*, 837 F.3d 1299, 1315 (Fed. Cir. 2016).
[6] MPEP 2106.04(a)
[7] *Mayo v. Prometheus*, 132 S. Ct. 1289 (2012)

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involves a two-prong approach. Prong One: evaluate whether a claim recites a judicial exception including identifying specific limitation(s) that are believed to recite an abstract idea and determining whether the identified limitation(s) fall within an enumerated abstract idea grouping. The enumerated abstract groupings include: a) mathematical concepts, b) certain methods of organizing human activity, and c) mental processes. Under Prong Two: evaluate whether the claim integrates the judicial exception into a practical application. 2019 revised patent subject matter eligibility guidance (2019 PEG), p. 52-53.

As further explained below, the amended claims are not directed towards "mental processes" and "certain methods of organizing human activity" groupings, as alleged by the Office. *Decision on Appeal*, p. 15-16.

A correct characterization of the claimed subject matter is integral to the comparison of the claimed subject matter to concepts found to be abstract by the courts. To that end, the courts have repeatedly admonished against oversimplification and overgeneralization of the claimed subject matter. As the *Alice*[8] decision points out, "at some level, all inventions … embody, use, reflect, rest upon or apply laws of nature, natural phenomena, or abstract ideas." Additionally, USPTO Guidance prohibits overgeneralization.[9]

Here, the Office failed to recognize the technology-based solution set forth in claim 212 for addressing the technical problems of "adaptively regroup and re-sequence the insertion of ad blocks extemporaneously (i.e. "on the fly"), in response to the consumer's arbitrary direction of the playback within the requested content, by means of playback controls." *See Specification*, ¶0117. In contrast to the Office's allegations of the claims reciting steps performable in the human mind, the claimed subject matter is intricately tied to computer processing by disabling user interface commands at a digital media player system during a play period and using an intersplicer to order data blocks of the digital media content and the digital advertising content. The intersplicer directly improves the functionality and processing of the digital media player system, which results in increased control over the insertion of digital advertising data blocks into the digital media content. This particular process allows **computer performance of a function not previously performable by a computer** (e.g., disabling user interface commands at a digital

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8 *Alice Corp. Pty. Ltd. v. CLS Bank Intern.*, 134 S. Ct. 2347

9 USPTO November 2016 memorandum for *Recent Subject Matter Eligibility Decisions* ("*November 2016 Memo*")

media player system during a play period), as evidenced by the claimed subject matter being new and inventive under 35 U.S.C. §102 and §103.

In the Decision on Appeal, the Office contends that the improvement recited by the claims is not tied to computer functionality. The Office reprints portions of the Background in the Specification to suggest that the claim language does not recite an improvement tied to computer functionality, while completely ignoring the remaining portions of the Specification with technical disclosures ties to computing and computing functionality. See *Decision on Appeal*, p. 11-12. It is well known that the Background section is provided for the purpose of generally discussing the problems associated with older technology, as here. Focusing on the disclosure in the Background section as a means to suggest the claimed subject matter is an abstract idea and has no technical character is respectfully disingenuous and misguided, considering the specific technical details disclosed in the remaining portions of the Specification that tie the inventive methods to specific technical details and integrate them into a practical application as provided below.

The Office should identify an **"**improvement in computer-related technology**"** that **"**allow[s] computer performance of a function not previously performable by a computer**"** in conducting an abstract idea analysis.[10] Here, the amended claims improve computer performance not previously performable by using an intersplicer that "adaptively select[s] and re-sequence[s] the ads to be shown in response to the user's navigational actions throughout the content" and "disabl[es] certain user playback controls while the ads are running." *See Specification*, ¶0057, 0117. The ability to "adaptively regroup and re-sequence the insertion of ad blocks extemporaneously (i.e. "on the fly"), in response to the consumer's arbitrary direction of the playback within the requested content" was not technologically achievable for media presentation in the past. Claim 212 captures this inventive conceptive by reciting: "[an] intersplicer configured to control one or more insertion points of the digital advertising content into the digital media content" and "disabling user interface commands comprising at least one of a user volume control or a user navigation control." Thus, claim 212 of the current Application includes an inventive concept of disabling user interface commands at a digital media player system during a play period and using an intersplicer to order data blocks of the digital media content and the digital advertising content.

[10] *November 2016 Memo*, p. 2.

Mental Processes

The Board alleges that the steps of claim 212 fall within the mental process grouping, contending the technology cannot be patentable subject matter because the technology mimics a mental process. *Decision on Appeal,* p. 15-16.

A proper abstract idea inquiry cannot be based on an oversimplification and overgeneralization of the claimed subject matter, which the courts have repeatedly admonished against. As the *Alice*[11] decision points out, "at some level, all inventions … embody, use, reflect, rest upon or apply laws of nature, natural phenomena, or abstract ideas." The Federal Circuit, in its *McRO*[12] decision, cautioned against oversimplifying the claims "by looking at the claims generally and failing to account for the specific requirements of the claims."

Here, the subject matter recited in the amended claims directly improves a digital media player system. The improved digital media player system database uses an intersplicer. The intersplicer sequences data blocks of the digital media content and the digital advertising content processing of streaming content. Based on the type of data blocks streaming, the digital media player system may disable user interface commands during a play period. Claim 212 recites steps intricately linked to improved digital media player system. For example, claim 212 recites "[an] intersplicer configured to control one or more insertion points of the digital advertising content into the digital media content" and "disabling user interface commands comprising at least one of a user volume control or a user navigation control." Additionally, the intersplicer enables the digital media player system to "adaptively regroup and re-sequence the insertion of ad blocks extemporaneously (i.e. "on the fly"), in response to the consumer's arbitrary direction of the playback within the requested content," which was not technologically achievable for media presentation in the past. *See Specification*, p. 0057, 0117.

Claim 212, as amended, recites claim elements that cannot be categorized as mental processes. On page 15 of the Decision on Appeal, the Office alleges "the limitation of disallowing a choice is recited functionally without detail on how, technologically or by what algorithm, a disallowance is achieved, and as such is a way of controlling access to resources or data" and thus can be performed in the human mind. The Applicant has further amended the claims to show that

[11] *Alice Corp. Pty. Ltd. v. CLS Bank Intern.*, 134 S. Ct. 2347
[12] *McRO, Inc. v. Bandai Namco Games America Inc.*, (Fed. Cir. 2016).

the "disallowing a choice" claim element is a far cry from any mental process. This claim element has been amended to recite, "responsive to detecting the first value in the first memory, disabling user interface commands comprising at least one of a user volume control or a user navigation control that alters a corresponding volume or a course of presentation of the user-perceptible content stream." As amended, this claim element cannot be a mental process. It is unclear how a mental process could cause a digital media player system to control access to the user interface commands, let alone "disable user interface commands" in response to detecting the first value in the first memory. As such, the elements of claim 212 are not directed to mental processes.

Furthermore, on page 14 of the Decision on Appeal, the Office alleges "the receiving data" claim element is extra-solution activity. The Applicant has further amended the claims to show that the "receiving data" claim element does not purely involve extra-solution activity. This claim element has been amended to recite, "receiving, by the digital media player system, data comprising digital media content and digital advertising content, the *digital media player system having a user interface and an intersplicer, the user interface configured to allow a user control of a course of presentation of the digital media content received, and the intersplicer configured to control one or more insertion points of the digital advertising content into the digital media content*." This claim element outlines the role of the intersplicer to control insertion points of digital advertising content, which involves the sequencing of data blocks at the digital media player system. Accordingly, the amended claim element cannot be extrasolution activity because the ordering of data blocks changes the content presented at the digital media player system. As such, the limitations of claim 212 are not directed to a mental process.

The 2019 PEG Update provides further clarification as to whether claims fall within the enumerated groupings by providing examples of claims that *do not* recite a mental process. For instance, the 2019 PEG describes a claim[13] to detect suspicious activity by using network monitors and analyzing network packets. *Similar to this exemplary claim, claim 212 uses digital media player systems (e.g.., back-end server computers, databases, decision engines) having intersplicers to analyze data blocks (e.g., transaction data) to determine when to disable user interface commands (e.g., detect suspicious activity).* Moreover, claim 212 here recites several specific steps with a high level of sophistication, such as disabling user interface commands

[13] *SRI Int'l, Inc. v. Cisco Systems, Inc.*, 930 F.3d 1295, 1304 (Fed. Cir. 2019)

comprising at least one of a user volume control or a user navigation control that alters a corresponding volume or a course of presentation responsive to detecting the first value in the first memory. Thus, claim 212 is not a mental process for at least using intersplicers to sequence data blocks and disabling user interface commands at a digital media player system during a play period in response to detecting the first value in the first memory.

As such, claim 212 is clearly not an abstract idea, including a method directed to mental processes. For at least these reasons, the rejection of pending claim 212 under 35 U.S.C. §101 should be withdrawn.

Certain Methods of Organizing Human Activity

The Decision on Appeal contends that claim 212 falls within the "Certain Methods of Organizing Human Activity." *Decision on Appeal*, p. 16.

The 2019 PEG Update states that the Certain Methods of Organizing Human Activity "grouping is limited to activity that falls within the enumerated sub-groupings of fundamental economic principles or practices, commercial or legal interactions, managing personal behavior, and relationships or interactions between people, **and is not to be expanded beyond these enumerated sub-groupings**." [14] (Emphasis added) *2019 PEG Update*, p. 4-5.

According to the 2019 PEG, "**fundamental economic principles or practices" include hedging, insurance, and mitigating risk and "describe subject matter relating to the economy and commerce**."[15] Additionally, MPEP 2106.04(a)(2)(I) provides examples of "fundamental economic principles or practices." Even if amended claim 212 was stripped of its technical features, amended claim 212 would still be directed to "a computer-implemented method for controlling digital media presentations using an improved digital media player system" which is not an enumerated fundamental economic principle or practice and is not included in the examples of MPEP 2106.04.

Further, claim 212 as amended is not directed to matters that *purely* relate to controlling commercial transactions or economic activity. While certain aspects of the claim may be related to advertising activity, the focus of the claimed subject matter is to improve a conventional digital media player to control media playback in a practical manner, such that the presentation of certain

[14] USPTO Training "Subject Matter Eligibility: Well-Understood, Routine, Conventional Activity, April 2018 (https://www.uspto.gov/patent/laws-and-regulations/examination-policy/subject-matter-eligibility).
[15] *2019 PEG Update*, p. 5.

segments of digital media data cannot be circumvented by a human operator or end user. The recited control over presentation of the digital media and how certain segments of the digital media may or may not be circumvented by a human operator is achieved by way of the claimed technical improvements to conventional computer-implemented digital media player systems that have been incapable of practically solving the noted circumvention problem. As such, claim 212 is distinguishable from claims that purely recite commercial transactions.

For at least these reasons, the rejection of pending claim 212 under 35 U.S.C. §101 should be withdrawn.

Step 2A – Prong 2: the pending claims are patent eligible at least because the claims are integrated into a practical application.

Even assuming, *arguendo*, that claim 212 is directed to an abstract idea under prong 1, which Applicant disputes, claim 212 still integrates the alleged abstract idea into a practical application under prong 2.

The 2019 PEG Update states "the evaluation of Prong Two requires the use of the considerations (e.g., **improving technology**, effecting a particular treatment or prophylaxis, implementing with a particular machine, etc.) identified by the Supreme Court and the Federal Circuit, to ensure that the claim as a whole "integrates [the] judicial exception into a practical application [that] will apply, rely on, or use the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception." 2019 *PEG Update*, p. 11.

Here, claim 212 is clearly integrated into a practical application because claim 212 is directed to a technical improvement of the digital media player system (e.g., disabling user interface commands at a digital media player system during a play period and using an intersplicer to order data blocks of the digital media content and the digital advertising content). Claim 212 embodies a practical application by using the intersplicer that "adaptively select[s] and re-sequence[s] the ads to be shown in response to the user's navigational actions throughout the content" and "disabl[es] certain user playback controls while the ads are running." *See Specification*, ¶0057, 0117. Using the intersplicer features, the claimed system controls the real-world experience for an end user by sequencing the data blocks of the digital media content and

the digital advertising content. For example, the intersplicer can determine when advertisement data blocks are inserted into the sequence of data blocks of the media content. Accordingly, the intersplicer may determine when the navigational controls of the digital media content player system are disabled. *See Specification*, 0052. Disabling such navigational controls prevents the consumer from skipping through the promotional material or lowering the sound volume beneath a predetermined threshold level. *Specification*, 0057. Therefore, claim 212 is clearly integrated into a practical application for at least improving functionality of the conventional digital media player systems.

Furthermore, the intersplicer described in claim 212 improves computing resource management (e.g., the sequencing of data blocks of the digital media content and the digital advertising content processing of streaming content). In comparison to conventional methods that steam content with ads, the intersplicer enables the digital media player system to "adaptively regroup and re-sequence the insertion of ad blocks extemporaneously (i.e. "on the fly"), in response to the consumer's arbitrary direction of the playback within the requested content," which was not technologically achievable for media presentation in the past. *See Specification*, p. 0057, 0117. Therefore, Claim 212, when practically applied, solves the particular technical problem of sequencing of data blocks of the digital media content and the digital advertising content processing in real-time.

The 2019 PEG Update explains the Supreme Court and the Federal Circuit identified **improving technology** as a consideration to ensure that the claims as a whole "integrate [the] judicial exception into a practical application [that] will apply, rely on, or use the judicial exception in a manner that imposes a meaningful limit on the judicial exception." The 2019 PEG Update provides examples indicative of whether a judicial exception has been integrated into a practical application. One listed example recites: "an additional element reflects an improvement in the functioning of a computer *or an improvement to other technology or technical field*."[16] Here, the technical solution of claim 212 is necessarily rooted in computer technology by using an intersplicer that "adaptively select[s] and re-sequence[s] the ads to be shown in response to the user's navigational actions throughout the content" and "disabl[es] certain user playback controls while the ads are running." *See Specification*, ¶0057, 0117. The intersplicer sequences data blocks

[16] 2019 PEG Update, p. 12.

of the digital media content and the digital advertising content processing of streaming content. Based on the type of data blocks streaming, the digital media player system may disable user interface commands during a play period in response to detecting a first value in a first memory.

Additionally, claim 212 requires a physical device, such as a digital media player system capable of disabling user interface commands in response to detecting a first value in a first memory during a play period. Claim 212 also requires a physical device, such as a digital media player having an intersplicer capable of sequencing data blocks and control one or more insertion points of the digital advertising content into the digital media content. *See Ex parte Schmid* (PTAB reversing §101 rejection because the claims required a physical device); *Ex parte Balestrieri* (PTAB reversing §101 rejection because the method claim could not be performed by a human).

As such, claim 212 is clearly not an abstract idea for at least integrating the alleged abstract idea into a practical application. For at least these reasons, the rejection of pending claim 212 under 35 U.S.C. §101 should be withdrawn.

Step 2B: the pending claims are patent eligible at least because the claims recite significantly more than the alleged abstract idea.

Even assuming, *arguendo*, that amended Claim 212 is directed to an abstract idea under part 2A of the Interim Guidance, amended Claim 212 recites significantly more than the alleged abstract idea of "method to prevent commercial skipping." *Decision on Appeal*, p. 15.

Under Step 2B, claim 212 is significantly more than an abstract idea at least because the claimed implementation entails an unconventional solution to a technical problem, as discussed below.

In light of the 2019 PEG Update, a "Step 2B" rejection based on a failure to claim an invention that is directed to patent-eligible subject matter (i.e., the claim is directed to a judicial exception without providing an inventive concept/significantly more at Step 2B of the eligibility analysis) should explain the following:

First, the rejection should identify the judicial exception (i.e., abstract idea enumerated in Section I of the 2019 PEG, laws of nature, or a natural phenomenon) by referring to *what is recited* (i.e., set forth or described) in the claim and *explaining why* it is considered to be an exception

(Step 2A Prong One). There is no requirement for the examiner to provide further support, such as publications or an affidavit or declaration under 37 CFR 1.104(d)(2), for the conclusion that a claim recites a judicial exception.

Second, the rejection should *identify* any additional elements recited in the claim beyond the judicial exception and *evaluate* the integration of the judicial exception into a practical application *by explaining* that 1) there are no additional elements in the claim; or 2) the claim as a whole, looking at the additional elements individually and in combination, does not integrate the judicial exception into a practical application using the considerations set forth in the 2019 PEG (Step 2A Prong Two).

Finally, the examiner should *explain why* the additional elements, taken individually and in combination, do not result in the claim, as a whole, amounting to significantly more than the exception (Step 2B). For instance, when the examiner has concluded that certain claim elements recite well-understood, routine, conventional activity in the relevant field, the examiner must expressly support such a rejection in writing with one of the four options specified in Section III.A. of the *Berkheimer* Memorandum.

An inventive concept can be found in the non-conventional and non-generic arrangement of known conventional pieces. In the *Bascom* decision, the Federal Circuit found patent-eligible subject matter even though the claims were directed towards the abstract idea of organizing human activity.[17] The Federal Circuit criticized the District Court's piecemeal step 2B analysis and stated that the inventive concept inquiry "requires more than recognizing that each claim element, by itself, was known in the art," as "an inventive concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces."[18] The Federal Circuit also noted that the District Court analysis looked "similar to an obviousness analysis under 35 U.S.C. § 103, except lacking an explanation of a reason to combine the limitations." *Id.* at p. 4. The *Bascom* court clearly recognizes that "software-based inventions that improve the performance of the computer itself" are patent eligible even when the inventions are otherwise directed toward abstract ideas. *Id.* at p. 18.

[17] *Bascom Global Internet Services Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016)
[18] *Id.* at 15.

Here, similar to *Bascom*, claim 212 of the current Application recites an inventive concept that can be found in the non-conventional and non-generic arrangement of the recited features. At least, one inventive concept of claim 212 includes "adaptively selecting and re-sequencing the ads to be shown in response to the user's navigational actions throughout the content" and "disabling certain user playback controls while the ads are running." *See Specification*, ¶0057, 0117. This inventive concept is not intuitive because a digital media player system has traditionally been unable to adaptively select and re-sequence the ads to be shown in response to the user's navigational actions throughout the content. *Specification*, 0057, 0117. This non-intuitive inventive concept transforms the claim language into non-conventional and non-generic claim elements. Claim 212 captures this inventive concept by reciting: "[an] intersplicer configured to control one or more insertion points of the digital advertising content into the digital media content" and "disabling user interface commands comprising at least one of a user volume control or a user navigation control." Thus, claim 212 of the current Application includes an inventive concept that can be found at least in the non-conventional and non-generic arrangement of known, conventional pieces.

The Federal Circuit held in *Amdocs* that the claims at issue were significantly more than abstract because they "entail[] an unconventional solution (enhancing data in a distributed fashion) to a technological problem (massive record flows which previously required massive databases)."[19] Claim 212 describes the unconventional solution (e.g., disabling user interface commands at a digital media player system during a play period and using an intersplicer to order data blocks of the digital media content and the digital advertising content) of using the claimed technique to solve a technical problem of sequencing of data blocks of the digital media content and the digital advertising content processing in real-time. Therefore, in view of the rationale in *Amdocs*, claim 212 should be deemed significantly more than an abstract idea.

Moreover, the claimed elements in claim 212 are **not** well-understood, routine, and conventional. The Federal Circuit in *BASCOM* found each element of the claim individually in the prior art. However, they held that the ordered combination of the claim elements rendered the claims subject matter eligible. Here, the claimed elements, either individually or in an ordered combination, **are not found in the prior art** and hence, for at least this reason, claim 212 cannot

[19] *Amdocs (Israel) Ltd. V. Openet Telecom*, 841 F.3d 1288, 1300-01 (Fed. Cir. 2016).

be said to contain only elements that are well-understood, routine, and conventional. *See*, *BASCOM* [20].

Ultimately, Applicant respectfully submits that claim 212 does not recite an abstract idea (step 2A), and, even if claim 212 does recite an abstract idea (which Applicant disputes), claim 212 is integrated into a practical application and/or amounts to significantly more than the abstract idea itself (step 2B). Therefore, claim 212 is directed to patent-eligible subject matter.

Accordingly, Applicant requests the withdrawal of the rejections of claim 212 under 35 U.S.C. §101. Independent claims 238, 243, and 267 recite features similar to at least some of the patentable features discussed in connection with claim 212 above and also define patent-eligible subject matter.

Accordingly, for at least these reasons, Appellant respectfully requests the reversal of the rejections of the pending claims under 35 U.S.C. § 101.

Dependent Claims 214-223, 225-231, 233-237, and 240-242 are allowable over the applied references at least by virtue of their dependency from one of independent Claims 212, 238, 243, and 267.

Dependent Claims 214-223, 225-231, 233-237, and 240-242 each depend either directly or indirectly on one of independent Claims 212, 238, 243, and 267. Thus, the dependent claims incorporate by reference all the features of their respective independent claims pursuant to 35 U.S.C. § 112, ¶ 4. In view of the features as recited in the independent claims, and in view of the additional features as recited in the dependent claims, Appellant respectfully submits that the dependent claims define patentable subject matter over the applied references for at least the reasons discussed above, and for their respective additional novel features. Thus, Appellant respectfully submits that dependent Claims 214-223, 225-231, 233-237, and 240-242 are also patent eligible.

Accordingly, for at least these reasons, reversal of the pending rejection of Claims 212, 214-223, 225-231, 233-238, 240-243, and 267 under 35 U.S.C. §101 is respectfully requested.

[20] *Bascom Global Internet Services Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016)

New Claim

New claim 274 is allowable for at least the reasons discussed above with respect to Claim 267.

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Conclusion

On the basis of the foregoing, Appellant respectfully requests that the Board reverse all of the outstanding rejections of the pending claims, Claims 212, 214-223, 225-231, 233-238, 240-243, and 267. It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper.

Enclosed herewith please find the requisite **micro entity** fees for continued examination and prioritized examination. No additional fees are believed to be due. However, the Commissioner is hereby authorized to charge any additional claim fees and any additional fees that may be due, or credit any overpayment of same, to Deposit Account No. 50-0311, Reference No. 42327-501001US. If there are any questions regarding this response, the undersigned may be contacted at the telephone number provided below.

Respectfully submitted,

Dated: October 13, 2020

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I. CLAIMS

1–211. (Canceled).

212. (**Currently Amended**) A computer-implemented method for controlling digital media presentations using an improved digital media player system, the method comprising:

receiving, ~~on a client~~by the digital media player system, data comprising digital media content and digital advertising content, the digital media player system having a user interface and an intersplicer, the user interface configured to allow a user control of a course of presentation of the digital media content received, and the intersplicer configured to control one or more insertion points of the digital advertising content into the digital media content;

sequencing the digital media content and the digital advertising content, using the intersplicer, the sequencing comprising ordering ~~at least some of~~ one or more data blocks in the digital media content and ~~at least some of~~ one or more data blocks in the digital advertising content into a user-perceptible content stream, the user-perceptible content stream comprising one or more initially sequenced insertion points at which the digital advertising content is scheduled to be presented relative to the digital media content;

adaptively modifying, using one or more pre-defined rules and in response to a user input detected by the ~~client~~ digital media player system, a presentation position of the digital advertising content from at least one of the one or more initially sequenced insertion points to one or more alternatively sequenced insertion points, at least one of the one or more alternatively sequenced insertion points being different than the one or more initially sequenced insertion points relative to the digital media content within the user-perceptible content stream;

causing presentation of the user-perceptible content stream at the ~~client~~ digital media player system during a play period associated with one or more states of play ~~after the adaptively modifying~~;

keeping a setting, in a first memory of the digital player system, to indicate a ~~current~~ first state of play, the setting including a first value to indicate ~~whether~~ presentation of a required part of the digital advertising content is in progress during presentation of the user-perceptible content stream;

~~disallowing~~ responsive to detecting the first value in the first memory, disabling user interface commands comprising at least one of a user volume control or a user navigation ~~choice~~

control that alters a course of ~~playback~~ presentation of the user-perceptible content stream while presentation of the required part of the digital advertising content is in progress; and

storing, in a second memory of the digital player system, presentation data comprising an indication of the digital advertising content that has been presented[[;]]

~~wherein the receiving, the sequencing, the adaptively modifying, the causing, the keeping, the disallowing, and the storing are performed by one or more programmable processors~~.

213. (Canceled)

214. (**Currently Amended**) A method as in claim 212, wherein the causing presentation of the user-perceptible content stream on the ~~client~~ digital media player system comprises causing display of the user-perceptible content stream by way of a graphical user interface.

215. (**Currently Amended**) A method as in claim 212, wherein the receiving of the user- input and the adaptively modifying occur during the causing of the presentation of the user-perceptible content stream on the ~~client~~ digital media player system.

216. (**Currently Amended**) A method as in claim 212, wherein the receiving of the user- input and the adaptively modifying occur prior to the causing of the presentation of the user-perceptible content stream on the ~~client~~ digital media player system.

217. (**Currently Amended**) A method as in claim 212, wherein the receiving of the user- input and the adaptively modifying of the presentation position occur subsequent to the causing of the presentation of the user-perceptible content stream on the ~~client~~ digital media player system.

218. (**Currently Amended**) A method as in claim 212, wherein the sequencing and the adaptively modifying are performed by the ~~client~~ digital media player system, which comprises a programmable processor ~~of the one or more programmable processors~~.

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219. (Previously Presented) A method as in claim 212, wherein the pre-defined rules specify the one or more initially sequenced insertion points.

220. (Previously Presented) A method as in claim 212, wherein the pre-defined rules specify the one or more alternatively sequenced insertion points.

221. (**Currently Amended**) A method as in claim 212, wherein the sequencing and the adaptively modifying are performed by at least one remote system differing from the ~~client~~ digital media player system, the at least one remote system comprising a processor ~~of the one or more programmable processors~~.

222. (**Currently Amended**) A method as in claim 212, wherein the sequencing is performed by the ~~client~~ digital media player system, which comprises a first processor ~~of the one or more programmable processors~~, and the adaptively modifying is performed by at least one remote system, which comprises a second processor ~~of the one or more programmable processors~~.

223. (**Currently Amended**) A method as in claim 212, wherein the adaptively modifying is performed by the ~~client~~ digital media player system, which comprises a first processor ~~of the one or more programmable processors~~, and the sequencing is performed by at least one remote system, which comprises a second processor ~~of the one or more programmable processors~~.

224. (Canceled)

225. (Previously Presented) A method as in claim 212, wherein the digital media content comprises at least one media file.

226. (Previously Presented) A method as in claim 212, wherein the digital advertising content comprises at least one advertisement file.

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227. (Previously Presented) A method as in claim 226, further comprising: generating a sequence by sub-dividing a media file into two or more segments, and wherein at least a part of the at least one of the advertising file is presented between two of the segments.

228. (Previously Presented) A method as in claim 225, wherein the user input results in a change of a sequence of two or more media files by subtracting an existing media file, or by re-arranging the sequence of media files or results in a change of sequence by adding a new media file.

229. (Previously Presented) A method as in claim 212, wherein the user input comprises one or more navigational choices for the content stream.

230. (Previously Presented) A method as in claim 229, wherein the one or more navigational choices are selected from a group consisting of: play, stop, pause/continue, reverse, rewind, fast-forward, slow-motion, track advance, frame-by-frame advance, go direct to point or page in sequence, advance chapter, page turn, change track, change media selection, shuttle knob, and one or more sound controls.

231. (**Currently Amended**) A method as in claim 212, wherein the data is received by the ~~client~~ digital media player system from at least one remote system.

232. (**Canceled**)

233. (Previously Presented) A method as in claim 212, further comprising: rotating new advertising content into the user-perceptible content stream in response to the user input.

234. (**Currently Amended**) A method as in claim 212, further comprising: sending, by a remote system to the ~~client~~ digital media player system, additional advertising content during presentation of at least the part of the user-perceptible content stream.

235. (Previously Presented) A method as in claim 212, wherein the pre-defined rules position the advertising content so as to uphold an average content play time.

236. (Previously Presented) A method as in claim 212, wherein the sequencing comprises positioning, according to the pre-defined rules, the digital advertising content based on an amount of media content played during presentation of the content stream.

237. (Previously Presented) A method as in claim 212, wherein the adaptively modifying uses two or more of the pre-defined rules for determining the corresponding presentation position of at least a part of the digital advertising content.

238. (**Currently Amended**) A computer-implemented method for controlling digital media presentations using an improved digital media player system, the method comprising:

transmitting, by at least one remote system to a ~~client~~ digital media player system, data comprising digital media content and digital advertising content, the digital media player system having a user interface and an intersplicer, the user interface configured to allow a user control a course of presentation of the digital media content received, and the intersplicer configured to control one or more insertion points of the digital advertising content into the digital media content;

sequencing the digital media content and the digital advertising content, using the intersplicer, the sequencing comprising ordering ~~at least some of~~ one or more data blocks in the digital media content and ~~at least some of~~ one or more data blocks in the digital advertising content into a user-perceptible content stream, the user-perceptible content stream comprising one or more initially sequenced insertion points at which the digital advertising content is scheduled to be presented relative to the digital media content;

adaptively modifying one or more using pre-defined rules and in response to a user input detected by the ~~client~~ digital media player system, a presentation position of the digital advertising content from at least one of the one or more initially sequenced insertion points to one or more alternatively sequenced insertion points~~, at least one of the one or more alternatively sequenced insertion points being different than the one or more initially sequenced insertion points relative to the digital media content within the user-perceptible content stream~~;

causing presentation of the user-perceptible content stream at the ~~client~~ digital media player system during a play period associated with one or more states of play ~~after the adaptively modifying~~;

keeping a setting, in a first memory of the digital player system, to indicate a ~~current~~ first state of play, the setting including a first value to indicate ~~whether~~ presentation of a required part of the digital advertising content is in progress during presentation of the user-perceptible content stream;

~~disallowing~~ responsive to detecting the first value in the first memory, disabling user interface commands comprising a user navigation ~~choice~~ control that alters a corresponding volume or a course of ~~playback~~ presentation of the user-perceptible content stream ~~while presentation of the required part of the digital advertising content is in progress~~; and

storing, in a second memory of the digital player system, presentation data comprising an indication of the digital advertising content that has been presented[[;]]

~~wherein the receiving, the sequencing, the adaptively modifying, the causing, the keeping, the disallowing, and the storing are performed by one or more programmable processors~~.

239. (**Canceled**)

240. (**Currently Amended**) A method as in claim 238~~212~~, wherein the first memory is part of the ~~client~~ digital media player system and the second memory is part of at least one remote system.

241. (**Currently Amended**) A method as in claim 238~~212~~, wherein the first memory is part of at least one remote system and the second memory is part of the ~~client~~ digital media player system.

242. (**Currently Amended**) A method as in claim 238~~212~~, wherein the first memory and the second memory are part of at least one remote system.

243. (**Currently Amended**) A computer-implemented method for controlling digital media presentations using an improved digital media player system, the method comprising:

receiving, on a ~~client~~ digital media player system, data comprising digital media content and digital advertising content, the digital media player system having a user interface and an

intersplicer, the user interface configured to allow a user control of a course of presentation of the digital media content received, and the intersplicer configured to control one or more insertion points of the digital advertising content into the digital media content;

sequencing the digital media content, using the intersplicer, the sequencing comprising ordering one or more data blocks in the digital media content into a user-perceptible content stream comprising a media section that comprises at least some of the digital media content, the user perceptible content stream further comprising an advertising block within which at least some of the digital advertising content is scheduled to be presented, the advertising block being arranged within the user-perceptible content stream at an initially defined insertion position relative to the media section;

adaptively re-sequencing the user-perceptible content stream into a modified user-perceptible content stream to reflect a user input detected at the ~~client~~ digital media player system~~machine~~, the modified user-perceptible content stream comprising an alternate insertion position of the advertising block relative to the media section, ~~the alternate insertion position differing from the initially defined insertion position and not having digital advertising content scheduled to be presented in it in the user-perceptible content stream prior to the adaptively re-sequencing,~~ the adaptively re-sequencing comprising determining the alternate insertion position using one or more pre-defined placement rules associated with the digital media content;

causing presentation of the modified user-perceptible content stream at the ~~client~~ digital media player system during a play period associated with one or more states of play;

keeping a setting, in a first memory of the digital player system, to indicate a ~~current~~ first state of play, the setting including a first value to indicate ~~whether~~ presentation of a required part of the digital advertising content is in progress during presentation of the modified user-perceptible content stream;

~~disallowing~~ responsive to detecting the first value in the first memory, disabling user interface commands comprising at least one of a user volume control or a user navigation ~~choice~~ control that alters a corresponding volume or a course of ~~playback~~ presentation of the modified user-perceptible content stream ~~while presentation of the required part of the digital advertising content is in progress~~; and

storing, in a second memory of the digital player system, presentation data comprising an indication of the digital advertising content that has been presented[[;]]

~~wherein the receiving, the sequencing, the adaptively modifying, the causing, the keeping, the disallowing, and the storing are performed by one or more programmable processors~~.

244–266. (**Canceled**).

267. (**Currently Amended**) A computer-implemented method for controlling digital media presentations using an improved digital media player system, the method comprising:

transmitting, by at least one remote system to a ~~client~~ digital media player system, data comprising digital media content and digital advertising content, the digital media player system having a user interface and an intersplicer, the user interface configured to allow a user control of a course of presentation of the digital media content received, and the intersplicer configured to control one or more insertion points of the digital advertising content into the digital media content;

sequencing the digital media content, using the intersplicer, the sequencing comprising ordering one or more data blocks in the digital media content into a user-perceptible content stream comprising a media section that comprises at least some of the digital media content, the user perceptible content stream further comprising an advertising block within which at least some of the digital advertising content is scheduled to be presented, the advertising block being arranged within the user-perceptible content stream at an initially defined insertion position relative to the media section;

adaptively re-sequencing the user-perceptible content stream into a modified user-perceptible content stream to reflect a user input detected at the ~~client~~ digital media player system~~machine~~, the modified user-perceptible content stream comprising an alternate insertion position of the advertising block relative to the media section, ~~the alternate insertion position differing from the initially defined insertion position and not having digital advertising content scheduled to be presented in it in the user-perceptible content stream prior to the adaptively re-sequencing,~~ the adaptively re-sequencing comprising determining the alternate insertion position using one or more pre-defined placement rules associated with the digital media content;

causing presentation of the modified user-perceptible content stream at the ~~client~~ digital media player system during a play period associated with one or more states of play;

keeping a setting, in a first memory of the digital player system, to indicate a ~~current~~ first state of play, the setting including a first value to indicate ~~whether~~ presentation of a required part of the digital advertising content is in progress during presentation of the modified user-perceptible content stream;

~~disallowing~~ responsive to detecting the first value in the first memory, disabling user interface commands comprising at least one of a user volume control or a user navigation ~~choice~~ control that alters a course of ~~playback~~ presentation of the user-perceptible content stream ~~while presentation of the required part of the digital advertising content is in progress~~; and

storing, in a second memory of the digital player system, presentation data comprising an indication of the digital advertising content that has been presented[[;]]

~~wherein the transmitting, the sequencing, the adaptively re-sequencing, the causing, the keeping, the disallowing, and the storing are performed by one or more programmable processors~~.

268–273. (**Canceled**).

274. (**New**) The method as in claim 267, wherein presentation data comprising an indication of the digital advertising content that has been presented is stored in a second memory of the digital player system.

Attorney's Docket No.: 42327-501001US
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Philip M. Donian, *et al.*

Application No.: 10/606,729 | Confirmation No.: 5831

Filed: June 26, 2003 | Art Unit: 3688

For: METHOD AND APPARATUS FOR THE FREE LICENSING OF DIGITAL MEDIA CONTENT | Examiner: Yehdega Retta

AMENDMENT

FILED VIA EFS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir or Madam:

Applicant respectfully submits the following amendments and remarks for consideration with the accompanying request for Continued Examination under 37 C.F.R. §1.114.

The Applicant is a micro entity and respectfully requests prioritized examination of this application under Track One subject to the attached petition under 37 CFR 1.102(e)(2).

The consideration of the amended claims and the remarks provided below are respectfully requested, as they place the application in condition for allowance or better form for appeal.

Doc Code: MES.GIB
Document Description: Certification of Micro Entity Status (Gross Income Basis)

PTO/SB/15A (07-14)

CERTIFICATION OF MICRO ENTITY STATUS
(GROSS INCOME BASIS)

Application Number or Control Number (if applicable):	Patent Number (if applicable):
10/606,729	
First Named Inventor:	**Title of Invention:**
Philip M. Donian	METHOD AND APPARATUS FOR THE FREE LICENSING OF DIGITAL MEDIA CONTENT

The applicant hereby certifies the following—

(1) **SMALL ENTITY REQUIREMENT –** The applicant qualifies as a small entity as defined in 37 CFR 1.27.

(2) **APPLICATION FILING LIMIT –** Neither the applicant nor the inventor nor a joint inventor has been named as the inventor or a joint inventor on more than four previously filed U.S. patent applications, excluding provisional applications and international applications under the Patent Cooperation Treaty (PCT) for which the basic national fee under 37 CFR 1.492(a) was not paid, and also excluding patent applications for which the applicant has assigned all ownership rights, or is obligated to assign all ownership rights, as a result of the applicant's previous employment.

(3) **GROSS INCOME LIMIT ON APPLICANTS AND INVENTORS –** Neither the applicant nor the inventor nor a joint inventor, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986 (26 U.S.C. 61(a)), exceeding the "Maximum Qualifying Gross Income" reported on the USPTO Web site at http://www.uspto.gov/patents/law/micro_entity.jsp which is equal to three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census.

(4) **GROSS INCOME LIMIT ON PARTIES WITH AN "OWNERSHIP INTEREST" –** Neither the applicant nor the inventor nor a joint inventor has assigned, granted, or conveyed, nor is under an obligation by contract or law to assign, grant, or convey, a license or other ownership interest in the application concerned to an entity that, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986, exceeding the "Maximum Qualifying Gross Income" reported on the USPTO Web site at http://www.uspto.gov/patents/law/micro_entity.jsp which is equal to three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census.

SIGNATURE by an authorized party set forth in 37 CFR 1.33(b)

Signature	/FJF/				
Name	F. Jason Far-hadian				
Date	2020/10/13	Telephone	858.314.2144	Registration No.	42,523

☐ There is more than one inventor and I am one of the inventors who are jointly identified as the applicant. The required additional certification form(s) signed by the other joint inventor(s) are included with this form.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Electronic Acknowledgement Receipt

EFS ID:	40835815
Application Number:	10606729
International Application Number:	
Confirmation Number:	5831
Title of Invention:	Method and apparatus for the free licensing of digital media content
First Named Inventor/Applicant Name:	Philip M. Donian
Customer Number:	64046
Filer:	Farshad Jason Far-hadian
Filer Authorized By:	
Attorney Docket Number:	42327-501001US
Receipt Date:	13-OCT-2020
Filing Date:	26-JUN-2003
Time Stamp:	21:48:43
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Certification of Micro Entity (Gross Income Basis)	042327-501001US_sb0015a_MicroStatus.pdf	120346 98b9b57ecb7b5910baaa449b45f9384d8b574ac4	no	2

Warnings:

Information:	
Total Files Size (in bytes):	120346

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New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

Doc Code: MES.GIB
Document Description: Certification of Micro Entity Status (Gross Income Basis)

PTO/SB/15A (07-14)

CERTIFICATION OF MICRO ENTITY STATUS
(GROSS INCOME BASIS)

Application Number or Control Number (if applicable):	Patent Number (if applicable):
10/606,729	
First Named Inventor:	**Title of Invention:**
Philip M. Donian	METHOD AND APPARATUS FOR THE FREE LICENSING OF DIGITAL MEDIA CONTENT

The applicant hereby certifies the following—

(1) **SMALL ENTITY REQUIREMENT –** The applicant qualifies as a small entity as defined in 37 CFR 1.27.

(2) **APPLICATION FILING LIMIT –** Neither the applicant nor the inventor nor a joint inventor has been named as the inventor or a joint inventor on more than four previously filed U.S. patent applications, excluding provisional applications and international applications under the Patent Cooperation Treaty (PCT) for which the basic national fee under 37 CFR 1.492(a) was not paid, and also excluding patent applications for which the applicant has assigned all ownership rights, or is obligated to assign all ownership rights, as a result of the applicant's previous employment.

(3) **GROSS INCOME LIMIT ON APPLICANTS AND INVENTORS –** Neither the applicant nor the inventor nor a joint inventor, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986 (26 U.S.C. 61(a)), exceeding the "Maximum Qualifying Gross Income" reported on the USPTO Web site at http://www.uspto.gov/patents/law/micro_entity.jsp which is equal to three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census.

(4) **GROSS INCOME LIMIT ON PARTIES WITH AN "OWNERSHIP INTEREST" –** Neither the applicant nor the inventor nor a joint inventor has assigned, granted, or conveyed, nor is under an obligation by contract or law to assign, grant, or convey, a license or other ownership interest in the application concerned to an entity that, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986, exceeding the "Maximum Qualifying Gross Income" reported on the USPTO Web site at http://www.uspto.gov/patents/law/micro_entity.jsp which is equal to three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census.

SIGNATURE by an authorized party set forth in 37 CFR 1.33(b)

Signature	/FJF/				
Name	F. Jason Far-hadian				
Date	2020/10/13	Telephone	858.314.2144	Registration No.	42,523

☐ There is more than one inventor and I am one of the inventors who are jointly identified as the applicant. The required additional certification form(s) signed by the other joint inventor(s) are included with this form.

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
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6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
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Electronic Acknowledgement Receipt

EFS ID:	40835861
Application Number:	10606729
International Application Number:	
Confirmation Number:	5831
Title of Invention:	Method and apparatus for the free licensing of digital media content
First Named Inventor/Applicant Name:	Philip M. Donian
Customer Number:	64046
Filer:	Farshad Jason Far-hadian/Jeremy Johnston
Filer Authorized By:	Farshad Jason Far-hadian
Attorney Docket Number:	42327-501001US
Receipt Date:	13-OCT-2020
Filing Date:	26-JUN-2003
Time Stamp:	22:00:20
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Certification of Micro Entity (Gross Income Basis)	042327-501001US-sb0015a.pdf	123074 eff74469ac1eefbb50f475869828a1aae8f10147	no	2

Warnings:

Information:	
Total Files Size (in bytes):	123074

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

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New International Application Filed with the USPTO as a Receiving Office

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PTO/SB/06 (09-11)
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PATENT APPLICATION FEE DETERMINATION RECORD Substitute for Form PTO-875	Application or Docket Number 10/606,729	Filing Date 06/26/2003	☐ To be Mailed

ENTITY: ☑ LARGE ☐ SMALL ☐ MICRO

APPLICATION AS FILED - PART I

	(Column 1)	(Column 2)			
FOR	NUMBER FILED	NUMBER EXTRA		RATE ($)	FEE ($)
☐ BASIC FEE (37 CFR 1.16(a), (b), or (c))	N/A	N/A		N/A	
☐ SEARCH FEE (37 CFR 1.16(k), (i), or (m))	N/A	N/A		N/A	
☐ EXAMINATION FEE (37 CFR 1.16(o), (p), or (q))	N/A	N/A		N/A	
TOTAL CLAIMS (37 CFR 1.16(i))	minus 20 =	*		x $18 =	
INDEPENDENT CLAIMS (37 CFR 1.16(h))	minus 3 =	*		x $84 =	
☐ APPLICATION SIZE FEE (37 CFR 1.16(s))	If the specification and drawings exceed 100 sheets of paper, the application size fee due is $310 ($155 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).				
☐ MULTIPLE DEPENDENT CLAIM PRESENT (37 CFR 1.16(j))					
* If the difference in column 1 is less than zero, enter "0" in column 2.				TOTAL	

APPLICATION AS AMENDED - PART II

		(Column 1)		(Column 2)	(Column 3)			
AMENDMENT	10/13/2020	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA		RATE ($)	ADDITIONAL FEE ($)
	Total (37 CFR 1.16(i))	* 30	Minus	** 137	= 0		x $100 =	0
	Independent (37 CFR 1.16(h))	* 4	Minus	*** 5	= 0		x $480 =	0
	☐ Application Size Fee (37 CFR 1.16(s))							
	☐ FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))							
							TOTAL ADD'L FEE	0

		(Column 1)		(Column 2)	(Column 3)			
AMENDMENT		CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA		RATE ($)	ADDITIONAL FEE ($)
	Total (37 CFR 1.16(i))	*	Minus	**	=		x $0 =	
	Independent (37 CFR 1.16(h))	*	Minus	***	=		x $0 =	
	☐ Application Size Fee (37 CFR 1.16(s))							
	☐ FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))							
							TOTAL ADD'L FEE	

* If the entry in column 1 is less than the entry in column 2, write "0" in column 3.	LIE
** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20".	/NICOLE C LAWRENCE/
*** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3".	
The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.	

This collection of information is required by 37 CFR 1.16. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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Sale Accounting Date:10/20/2020

Sale Item Reference Number	Effective Date
10606729	10/13/2020

Document Number	Fee Code	Fee Code Description	Amount Paid	Payment Method
I20200JB27241965	3830	PROCESSING FEE, EXCEPT PROV. APPLS.	$35.00	Deposit Account

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,729	06/26/2003	Philip M. Donian	42327-501001US	5831

64046 7590 10/21/2020

Mintz Levin/San Diego Office
One Financial Center
Boston, MA 02111

EXAMINER	
RETTA, YEHDEGA	

ART UNIT	PAPER NUMBER
3688	

NOTIFICATION DATE	DELIVERY MODE
10/21/2020	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Decision Granting Request for Prioritized Examination (Track I)	**Application No.** 10/606,729	**Applicant(s)** Donian et al.	
	Examiner BRIAN W BROWN	**Art Unit** OPET	**AIA (FITF) Status** No

1. THE REQUEST FILED 13 October 2020 IS **GRANTED** .

The above-identified application has met the requirements for prioritized examination

A. ☐ for an original nonprovisional application (Track I).

B. ☑ for an application undergoing continued examination (RCE).

2. **The above-identified application will undergo prioritized examination**. The application will be accorded special status throughout its entire course of prosecution until one of the following occurs:

A. filing a **petition for extension of time** to extend the time period for filing a reply;

B. filing an **amendment to amend the application to contain more than four independent claims, more than thirty total claims** , or a multiple dependent claim;

C. filing a **request for continued examination** ;

D. filing a notice of appeal;

E. filing a request for suspension of action;

F. mailing of a notice of allowance;

G. mailing of a final Office action;

H. completion of examination as defined in 37 CFR 41.102; or

I. abandonment of the application.

Telephone inquiries with regard to this decision should be directed to BRIAN BROWN at (571)272-5338. In his/her absence, calls may be directed to Petition Help Desk at (571) 272-3282.

/BRIAN W BROWN/ Petitions Examiner, OPET	

UNITED STATES PATENT AND TRADEMARK OFFICE

USPTO Automated Interview Request (AIR)

Oct 22 2020

This paper requesting to schedule and/or conduct an interview is appropriate because:

This submission is requested to be accepted as an authorization for this interview to communicate via the internet. Recognizing that Internet communications are not secure, I hereby authorize the USPTO to communicate with the undersigned concerning scheduling of the interview via video conference, instant messaging, or electronic mail, and to conduct the interview in accordance with office practice including video conferencing.

Name(s):
F. Jason Far-hadian

S-signature:
/FJF/

Registration Number:
42523

U.S. Application Number:
10606729

Confirmation Number:
5831

E-mail Address:
fjfar-hadian@mintz.com

Phone Number:
+1 858.314.2144

Proposed Time of Interview:
10-29-2020 11:00 AM ET

Prefered Interview Type:
Video Conference

I am the applicant or applicant's representative for this application.

Topic for Discussion:
Allowance - please confirm or propose a time by email. Thank you.

uspto UNITED STATES PATENT AND TRADEMARK OFFICE

To: IPDocketingBOS@mintz.com,IPFileroombos@mintz.com,mintzdocketing@cpaglobal.com
From: PAIR_eOfficeAction@uspto.gov
Cc: PAIR_eOfficeAction@uspto.gov
Subject: Private PAIR Correspondence Notification for Customer Number 64046

Oct 22, 2020 03:46:13 AM

Dear PAIR Customer:

Mintz Levin/San Diego Office
One Financial Center
Boston, MA 02111
UNITED STATES

The following USPTO patent application(s) associated with your Customer Number, 64046 , have new outgoing correspondence. This correspondence is now available for viewing in Private PAIR.

The official date of notification of the outgoing correspondence will be indicated on the form PTOL-90 accompanying the correspondence.

Disclaimer:
The list of documents shown below is provided as a courtesy and is not part of the official file wrapper. The content of the images shown in PAIR is the official record.

Application	Document	Mailroom Date	Attorney Docket No.
10606729	TRACK1.GRANT	10/21/2020	42327-501001US

To view your correspondence online or update your email addresses, please visit us anytime at https://sportal.uspto.gov/secure/myportal/privatepair.

If you have any questions, please email the Electronic Business Center (EBC) at EBC@uspto.gov with 'e-Office Action' on the subject line or call 1-866-217-9197 during the following hours:

Monday - Friday 6:00 a.m. to 12:00 a.m.

Thank you for prompt attention to this notice,

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PATENT APPLICATION INFORMATION RETRIEVAL SYSTEM

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,729	06/26/2003	Philip M. Donian	42327-501001US	5831

64046 7590 11/10/2020

Mintz Levin/San Diego Office
One Financial Center
Boston, MA 02111

EXAMINER	
RETTA, YEHDEGA	

ART UNIT	PAPER NUMBER
3688	

NOTIFICATION DATE	DELIVERY MODE
11/10/2020	ELECTRONIC

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Applicant-Initiated Interview Summary	**Application No.** 10/606,729	**Applicant(s)** Donian et al.	
	Examiner YEHDEGA RETTA	**Art Unit** 3688	**AIA (FITF) Status** No

All participants (applicant, applicants representative, PTO personnel):

(1) YEHDEGA RETTA. (3) _____.

(2) JASON FAR-HADIAN. (4) _____.

Date of Interview: 29 October 2020.

Type: ☑ Telephonic ☐ Video Conference
☐ Personal [copy given to: ☐ applicant ☐ applicant's representative]

Exhibit shown or demonstration conducted: ☐ Yes ☐ No.
If Yes, brief description: _____.

Issues Discussed ☑101 ☐112 ☐102 ☐103 ☐Others
(For each of the checked box(es) above, please describe below the issue and detailed description of the discussion)

Claim(s) discussed: 1.

Identification of prior art discussed: _____.

Substance of Interview
(For each issue discussed, provide a detailed description and indicate if agreement was reached. Some topics may include: identification or clarification of a reference or a portion thereof, claim interpretation, proposed amendments, arguments of any applied references etc...)

The amended claim was discussed. Applicant representative explained the claimed invention and how the amended claim would overcome the 101 rejection. Examiner did not agree and explain that the clam is directed to arranging and rearranging and placing of advertisement between media when played withing a media player. Thus, the claimed invention would not overcome the 101 rejection. However, no agreement was reached..

Applicant recordation instructions: The formal written reply to the last Office action must include the substance of the interview. (See MPEP section 713.04). If a reply to the last Office action has already been filed, applicant is given a non-extendable period of the longer of one month or thirty days from this interview date, or the mailing date of this interview summary form, whichever is later, to file a statement of the substance of the interview.

Examiner recordation instructions: Examiners must summarize the substance of any interview of record. A complete and proper recordation of the substance of an interview should include the items listed in MPEP 713.04 for complete and proper recordation including the identification of the general thrust of each argument or issue discussed, a general indication of any other pertinent matters discussed regarding patentability and the general results or outcome of the interview, to include an indication as to whether or not agreement was reached on the issues raised.

☐ Attachment

/YEHDEGA RETTA/ Primary Examiner, Art Unit 3688	

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record
A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) 1.133 Interviews
Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.
All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiners responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicants correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:
- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:
1) A brief description of the nature of any exhibit shown or any demonstration conducted,-
2) an identification of the claims discussed,
3) an identification of the specific prior art discussed,
4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
5) a brief identification of the general thrust of the principal arguments presented to the examiner,
   (The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
6) a general indication of any other pertinent matters discussed, and
7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicants record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiners version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, Interview Record OK on the paper recording the substance of the interview along with the date and the examiners initials.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,729	06/26/2003	Philip M. Donian	42327-501001US	5831

64046 7590 11/13/2020

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EXAMINER	
RETTA, YEHDEGA	

ART UNIT	PAPER NUMBER
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IPFileroombos@mintz.com
mintzdocketing@cpaglobal.com

Office Action Summary	Application No. 10/606,729	Applicant(s) Donian et al.	
	Examiner YEHDEGA RETTA	Art Unit 3688	AIA (FITF) Status No

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☑ Responsive to communication(s) filed on 10/13/20.

☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.

2a)☐ This action is **FINAL.** 2b) ☑ This action is non-final.

3)☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

4)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims*

5) ☑ Claim(s) 212,214-223,225-231,233-238,240-243,267 and 274 is/are pending in the application.

5a) Of the above claim(s) _____ is/are withdrawn from consideration.

6) ☐ Claim(s) _____ is/are allowed.

7) ☑ Claim(s) 212,214-223,225-231,233-238,240-243,267 and 274 is/are rejected.

8) ☐ Claim(s) _____ is/are objected to.

9) ☐ Claim(s) _____ are subject to restriction and/or election requirement

* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to **PPHfeedback@uspto.gov.**

Application Papers

10)☐ The specification is objected to by the Examiner.

11)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

Certified copies:

a)☐ All b)☐ Some** c)☐ None of the:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

** See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☑ Notice of References Cited (PTO-892)

2) ☐ Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b) Paper No(s)/Mail Date _____.

3) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date _____.

4) ☐ Other: _____.

DETAILED ACTION

Notice of Pre-AIA or AIA Status

The present application is being examined under the pre-AIA first to invent provisions.

Claim Rejections – 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 212, 214-223 and 225-231, 233-238, 240-243, 267 and 274 are rejected under 35 U.S.C. 101 because the claimed invention is directed to an abstract idea without significantly more. The claimed invention is directed to sequencing, re-sequencing or modifying (changing) the presentational position of advertisement in a media player. The claims recite receiving media content, sequencing media content, modifying presentation position, causing presentation, keeping a setting, disabling user interface and storing presentation data. The limitation of receiving, creating (recommending), covers a mental process. That is, other than reciting a computer (digital media player), nothing in the claim element precludes the step from practically being performed in the mind. For example, but for the "by a media player" limitation, "sequencing", modifying, keeping setting, in the context of this claim encompasses the user manually arranging or re-ranging a list of media content and under its broadest reasonable interpretation, covers performance of the limitation in the mind but for the recitation of generic computer components. If a claim limitation, under its broadest reasonable interpretation, covers performance of the limitation in the mind but for the recitation of generic computer components, then it falls within the "Mental Processes" grouping of abstract ideas. Accordingly, the claim recites an abstract idea.

This judicial exception is not integrated into a practical application. The claim recites additional element of a digital media player. The media player is claimed and described in the specification at a high level of generality, which at best amounts to mere instruction to implement an abstract idea on a generic computer, or merely uses a generic computer as a tool to perform the abstract idea (see Applicant's specification [0040]-[0048], [0083]-[0089]). The steps of receiving, sequencing (re-sequencing modifying or changing) presentation, keeping a setting, disabling and storing are considered generic computer (media player) functions and the combination of the additional elements simply limits the use of the abstract idea to one particular environment or field of use (e.g., computers). The additional elements represent either a generic computer or steps that are normally performed by a generic computer including the steps of allowing the user to control presentation and insertion of advertising content. Accordingly, those steps are well-understood, routine and conventional because those steps are computer operations found in any computer system. Specifically there is no improvement to the functioning of the computer. Accordingly, this additional element does not integrate the abstract idea into a practical application because it does not impose any meaningful limits on practicing the abstract idea. The claim is directed to an abstract idea. See Delivering user-selected media content to portable devices (Affinity Labs v. Amazon.com), Providing an additional set of information without disrupting the ongoing provision of an initial set of information (Interval Licensing) Ferguson (structuring a sales force or marketing company).

As indicated in the specification and as claimed, the claim is directed to implementing a commercial solution (inserting advertisement in a sequence of media content) of generating revenue for free distribution of media content (sponsored through paid advertising). The additional elements, the media player and the intersplicer (or a splicer for combining the media

file and the ad files by giving a signals to the media player) and transmits the streaming media to a media player) is intended to be carried out in a technical environment but failed to contain meaningful limitations beyond generally linking to the use of an abstract idea to a particular technical environment. For the splicing of media and advertisement, see Zhang et al. (US 6,611,624 B1), Safadi (US 6,487,721 B1), Eldering (US 6,615,039 B1).

As also indicated by the Board, "when considered collectively and under the broadest reasonable interpretation, the limitations of claim 212 recite a method for sequencing digital media and advertising content to prevent commercial skipping by receiving, organizing, re-organizing, displaying, and storing data and controlling access based on the stored data.8 This is an abstract idea comprising "[mental processes—concepts performed in the human mind (including an observation, evaluation, judgment, opinion)" and a "[certain method[] of organizing human activity— . . . commercial or legal interactions (including agreements in the form of contracts; legal obligations; advertising, marketing or sales activities or behaviors; business relations)."

Claim Rejections - 35 USC § 112

The following is a quotation of 35 U.S.C. 112(b):
(b) CONCLUSION.—The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

The following is a quotation of 35 U.S.C. 112 (pre-AIA), second paragraph:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 212, 214-223 and 225-231, 233-238, 240-243, 267 and 274 are rejected under 35 U.S.C. 112(b) or 35 U.S.C. 112 (pre-AIA), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint

inventor (or for applications subject to pre-AIA 35 U.S.C. 112, the applicant), regards as the invention.

The term "user-perceptible content stream" in claims 212, 238, 243, 267 is a relative term which renders the claim indefinite. The term "user-perceptible" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Regarding the sequencing and also the intersplicer, Applicant's specification discloses as follows:

[0054] Rather than strictly granting or denying access to secured content, one particular method of the invention provides for unlimited redistribution and free use under general license, enforced by the player/viewer software. This is a new use of digital rights management practices, and it provides improved security by diminishing incentive on the part of the consumer to breach the system, since the desired content is already available free-of-charge from within it.

[0055] *The player/viewer software has the means to assemble a new, customized sequence of requested content, interspliced with promotional material every time it runs, selecting appropriate ads on demand from a greater repository.* Ads are selected on the basis of requested content and other specific information that the system maintains about consumers and their media/ad play histories, and new ads may be chosen even when reusing the same content.

[0056] Where demographic, geographic, or other relevant user and/or system information is available, the player/viewer software can apply targeted marketing in the ad selection process. Targeted marketing takes the form of addressable advertising, which not only identifies a select advertising candidate list, but additionally verifies that individual ads were received and consumed by the intended recipient. This custom-selection of advertisements, addressable to unique users, conducted by software running on the consumer's device, is a novel use of new and existing technologies.

[0057] *In the course of playing or viewing media content, the application software automatically edits the selected advertisements into the presentation stream.* The novel "intersplicer" module providing this functionality enforces the conveyance of required ads in their entirety at least once, by disabling certain user playback controls while the ads are running. *This module also has the power to adaptively select and re -sequence the ads to be shown in response to the user's navigational actions throughout the content, and keeps a history of all the content and advertising material that is presented.*

Thus, the step of sequencing (or ordering) the digital media content and the digital advertising content into a user-perceptible content stream,... including initially sequenced insertion points (where the advertising content is scheduled to be presented...) is indefinite.

Examiner interpretation of this term is that the media content and the advertising content are sequenced (for presentation). Clarification is required.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YEHDEGA RETTA whose telephone number is (571)272-6723. The examiner can normally be reached on Monday-Thursday 8am-6pm.

Examiner interviews are available via telephone, in-person, and video conferencing using a USPTO supplied web-based collaboration tool. To schedule an interview, applicant is encouraged to use the USPTO Automated Interview Request (AIR) at http://www.uspto.gov/interviewpractice.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see https://ppair-my.uspto.gov/pair/PrivatePair. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to

the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/YEHDEGA RETTA/
Primary Examiner, Art Unit 3688

Notice of References Cited	Application/Control No. 10/606,729	Applicant(s)/Patent Under Reexamination Donian et al.	
	Examiner YEHDEGA RETTA	Art Unit 3688	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	CPC Classification	US Classification
*	A	US-6615039-B1	09-2003	Eldering; Charles A.	H04N7/165	348/E7.063
*	B	US-6611624-B1	08-2003	Zhang; Ji	H04N21/23406	370/498
*	C	US-6487721-B1	11-2002	Safadi; Reem	H04N21/234354	725/36
	D					
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FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	CPC Classification
	N					
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	P					
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	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

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✓	Rejected	-	Cancelled	N	Non-Elected	A	Appeal
=	Allowed	÷	Restricted	I	Interference	O	Objected

CLAIMS

☐ Claims renumbered in the same order as presented by applicant ☐ CPA ☐ T.D. ☐ R.1.47

CLAIM		DATE								
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CLAIM		DATE								
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	146	✓	-							

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CPC - Searched*		
Symbol	Date	Examiner

CPC Combination Sets - Searched*		
Symbol	Date	Examiner

US Classification - Searched*			
Class	Subclass	Date	Examiner

* See search history printout included with this form or the SEARCH NOTES box below to determine the scope of the search.

Search Notes		
Search Notes	Date	Examiner
see EAST search	11/06/2020	YR
see Proquest search	11/06/2020	YR

Interference Search			
US Class/CPC Symbol	US Subclass/CPC Group	Date	Examiner

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Dialog

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Search Strategy from Dialog

November 06 2020 08:57

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Search Strategy

Databases: ABI/INFORM® Professional Advanced, Abstracts in New Technology & Engineering, AdisInsight: Drugs, AdisInsight: Trials, Adis Pharmacoeconomics & Outcomes News, AGRICOLA, AGRIS, Allied & Complementary Medicine™, Analytical Abstracts, APA PsycInfo®, Aqualine, Aquatic Science & Fisheries Abstracts (ASFA), Australian Education Index, BIOSIS® Toxicology, BIOSIS Previews®, British Library Inside Conferences, British Nursing Index, Business & Industry, CAB ABSTRACTS, Chemical Business Newsbase, Chemical Engineering & Biotechnology Abstracts, Chemical Safety Newsbase, Civil Engineering Abstracts, Current Contents® Search, Derwent Drug File, Derwent Drug Registry, DH-DATA: Health Administration, Medical Toxicology & Environmental Health, DIOGENES® FDA Regulatory Updates, Drug Information Fulltext, Earthquake Engineering Abstracts, EconLit, Ei Compendex®, Ei EnCompassLIT, Embase®, EMCare®, ERIC, ESPICOM Pharmaceutical & Medical Device News, FDAnews, FLUIDEX (Fluid Engineering Abstracts), Foodline®: MARKET, Foodline®: PRODUCT, Foodline®: SCIENCE, FSTA®, Gale Group Computer Database™, Gale Group Health Periodicals Database, Gale Group New Product Announcements / Plus®, Gale Group Newsletter Database™, Gale Group PharmaBiomed Business Journals, Gale Group PROMT®, Gale Group Trade & Industry Database™, GEOBASE, GeoRef, Global Health, HSELINE: Health and Safety, ICONDA - International Construction Database, IMS Company Profiles, IMS New Product Focus, IMS Pharma Trademarks, IMS R&D Focus, IMS R&D Focus Drug News, Inspec®, International Pharmaceutical Abstracts, Jane's Defense & Aerospace News, King's Fund, KOSMET: Cosmetic Science, Lancet Titles, Material Safety Datasheets -OHS™, Mechanical & Transportation Engineering Abstracts, MEDLINE®, Meteorological & Geoastrophysical Abstracts, Morressier Life Science Conference Abstracts and Posters, New England Journal of Medicine, Northern Light Life Sciences Conference Abstracts, NTIS: National Technical Information Service, Oceanic Abstracts, PAIS International, Paperbase, PAPERCHEM, ProQuest Advanced Tech & Aerospace Professional, ProQuest Biological & Health Science Professional, ProQuest Dissertations and Theses Professional, ProQuest Environmental Science Professional, ProQuest Materials Research Professional, ProQuest Newsstand Professional, ProQuest Technology Research Professional, Prous Science Daily Essentials, Prous Science Drug Data Report, Prous Science Drugs Of The Future™, Registry of Toxic Effects of Chemical Substances (RTECS®), SciSearch®: a Cited Reference Science Database, Social SciSearch®, ToxFile®, Transport Research International Documentation, TULSA™ (Petroleum Abstracts), UBM Computer Full Text, Weldasearch®, Zoological Record

Set#	Searched for	Results
S1	(splic* near/9 (media or multimedia or multi-media or music or audio or video) and adverti* near9 (play* or display* or arrang*) near/9 insert*)	0°
S2	(splic* near/9 (media or multimedia or multi-media or music or audio or video) and adverti* near/9 (play* or display* or arrang*) near/9 insert*)	29°
S3	(media or music or audio or multimedia or multi-media) near/9 intersplic* near/9 (ad or adverti*)	3°
S4	(media or music or audio or multimedia or multi-media) near/9 insert$8 near/9 (ad or adverti*) near/9 player	147°
S5	(media or music or audio or multimedia or multi-media) near/9 insert$8 near/9 (ad or adverti*) near/9 player and (sequenc* or arrang* or order*)	44°

° Duplicates are removed from the search and from the result count.

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EAST Search History

EAST Search History (Prior Art)

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
L1	1,810	splic$5 same (media multimedia multi-media music audio video) same (commercial marketing adverti$8)	US-PGPUB; USPAT	OR	ON	2020/11/06 09:05
L2	1,349	splic$5 same (media multimedia multi-media music audio video) same (commercial marketing adverti$8) same (insert$5 present$5 transmit$5 provid$5 join$5)	US-PGPUB; USPAT	OR	ON	2020/11/06 09:06
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L4	2	splic$5 same (media multimedia multi-media music audio video) same (commercial marketing adverti$8) same (insert$5 present$5 transmit$5 provid$5 join$5) and player and (arrang$5 sequenc$5) same insertion adj (point cue)	US-PGPUB; USPAT	OR	ON	2020/11/06 09:08
L5	0	splic$5 same (media multimedia multi-media music audio video) same (commercial marketing adverti$8) same (insert$5 present$5 transmit$5 provid$5 join$5) and player and (arrang$5 sequenc$5) adj (point cue)	US-PGPUB; USPAT	OR	ON	2020/11/06 09:08
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L7	552	splic$5 same (media multimedia multi-media music audio video) same (commercial marketing adverti$8) same (insert$5 present$5 transmit$5 provid$5 join$5) and player and (point cue)	US-PGPUB; USPAT	OR	ON	2020/11/06 09:10
L8	1,037	splic$5 same (media multimedia multi-media music audio video) same (commercial marketing adverti$8) same (insert$5 present$5 transmit$5 provid$5 join$5) and play$5 and (point cue)	US-PGPUB; USPAT	OR	ON	2020/11/06 09:10

L9	532	splic$5 same (media multimedia multi-media music audio video) same (commercial marketing adverti$8) same (insert$5 present$5 transmit$5 provid$5 join$5) same (point cue)	US-PGPUB; USPAT	OR	ON	2020/11/06 09:11
L10	922	splic$5 same (media multimedia multi-media music audio video) same (commercial marketing adverti$8) same (insert$5 present$5 transmit$5 provid$5 join$5) and (insert$5 splic$5) same (point cue)	US-PGPUB; USPAT	OR	ON	2020/11/06 09:11
L11	368	splic$5 same (media multimedia multi-media music audio video) same (commercial marketing adverti$8) same (insert$5 present$5 transmit$5 provid$5 join$5) and (insert$5 splic$5) same (point cue) same (adverti$5 market$5 promotion$4)	US-PGPUB; USPAT	OR	ON	2020/11/06 09:12
L12	748	splic$5 same (media multimedia multi-media music audio video) same (commercial marketing adverti$8) same (insert$5 present$5 transmit$5 provid$5 join$5) and (insert$5 splic$5) near9 (point cue)	US-PGPUB; USPAT	OR	ON	2020/11/06 09:14
L13	462	splic$5 same (media multimedia multi-media music audio video) same (commercial marketing adverti$8) same (insert$5 present$5 transmit$5 provid$5 join$5) same (insert$5 splic$5) near9 (point cue)	US-PGPUB; USPAT	OR	ON	2020/11/06 09:20
L14	776	splic$5 same (media multimedia multi-media music audio video) same (commercial marketing adverti$8) same (insert$5 present$5 transmit$5 provid$5 join$5) and (insert$5 splic$5) near9 (point cue marker)	US-PGPUB; USPAT	OR	ON	2020/11/06 09:26
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L16	55	14 and @pd<"20050101"	US-PGPUB; USPAT	OR	ON	2020/11/06 09:27
S55	1	"20040003398"	US-PGPUB; USPAT	OR	ON	2009/05/05 09:21
S56	5	"6950804"	US-PGPUB; USPAT	OR	ON	2009/05/05 09:24
S57	1	(media or music or audio or multimedia or multi-media) same intersplic$5 same (ad or adverti$7)	US-PGPUB; USPAT	OR	ON	2009/05/05 09:31

S59	2	intersplic$5 same (ad or adverti$7)	US-PGPUB; USPAT	OR	ON	2009/05/05 09:31
S60	2	intersplic$5 same (media or music or audio or ad or adverti$7)	US-PGPUB; USPAT	OR	ON	2009/05/05 09:32
S66	104	(media or music or audio or multimedia or multi-media) near5 insert$5 near5 (ad or adverti$7) same (player or preload$5 or pre-load$5 or download$4)	US-PGPUB; USPAT	OR	ON	2009/05/05 16:05
S67	99	S66 and (profile or demographic$5 or content) same (ad or adverti$8)	US-PGPUB; USPAT	OR	ON	2009/05/05 16:06
S68	100	S66 and (profile or demographic$5 or content or target$5) same (ad or adverti$8)	US-PGPUB; USPAT	OR	ON	2009/05/05 16:07
S69	27	S68 and (playlist or (play adj list) or play-list)	US-PGPUB; USPAT	OR	ON	2009/05/05 16:54
S70	16	S68 and (playlist or (play adj list) or play-list) and tag	US-PGPUB; USPAT	OR	ON	2009/05/05 16:56
S71	74	S68 and playback	US-PGPUB; USPAT	OR	ON	2009/05/05 17:02
S72	74	S68 and playback and (format or audio or video)	US-PGPUB; USPAT	OR	ON	2009/05/05 17:10
S73	5	S68 and (playlist or (play adj list) or play-list) and tag and zero	US-PGPUB; USPAT	OR	ON	2009/05/05 17:30
S74	7	S68 and (playlist or (play adj list) or play-list) and tag and (ad same no)	US-PGPUB; USPAT	OR	ON	2009/05/05 17:31
S75	9	S68 and (playlist or (play adj list) or play-list) and tag and (ad same (without or out))	US-PGPUB; USPAT	OR	ON	2009/05/05 17:33
S76	58	S68 and playback and (type same (advert$5 or media) same (format or audio or video))	US-PGPUB; USPAT	OR	ON	2009/05/05 17:41
S77	5	"6950804"	US-PGPUB; USPAT	OR	ON	2009/05/05 17:52
S78	1	"20020077901"	US-PGPUB; USPAT	OR	ON	2009/05/05 17:55
S79	237	"6269361"	US-PGPUB; USPAT	OR	ON	2009/05/05 17:59
S80	1	("6269361").PN.	USPAT; USOCR	OR	OFF	2009/05/05 18:00
S81	104	(media or music or audio or multimedia or multi-media) near5 insert$5 near5 (ad or adverti$7) same (player or preload$5 or pre-load$5 or download$4)	US-PGPUB; USPAT	OR	ON	2009/05/06 15:29

S82	100	S81 and (profile or demographic$5 or content or target$5) same (ad or adverti$8)	US-PGPUB; USPAT	OR	ON	2009/05/06 15:29
S83	58	S82 and playback and (type same (advert$5 or media) same (format or audio or video))	US-PGPUB; USPAT	OR	ON	2009/05/06 15:29
S84	23	S83 and interactive	US-PGPUB; USPAT	OR	ON	2009/05/06 15:31
S85	1	"20040003398" and interactive	US-PGPUB; USPAT	OR	ON	2009/05/06 15:31
S86	1	S85 and peer-to-peer	US-PGPUB; USPAT	OR	ON	2009/05/06 15:45
S87	5	"6950804"	US-PGPUB; USPAT	OR	ON	2009/05/06 15:48
S88	1	"20040003398"	US-PGPUB; USPAT	OR	ON	2010/01/27 08:03
S89	1	S88 and (media adj file) same (ad adj file)	US-PGPUB; USPAT	OR	ON	2010/01/27 08:11
S90	1	S88 and (media same file)	US-PGPUB; USPAT	OR	ON	2010/01/27 08:13
S91	1	S88 and (media same ad same file)	US-PGPUB; USPAT	OR	ON	2010/01/27 08:14
S92	1	S88 and (ad same break)	US-PGPUB; USPAT	OR	ON	2010/01/27 08:29
S93	1	"20040003398"	US-PGPUB; USPAT	OR	ON	2010/01/27 12:54
S94	0	S93 and (ad same break same instruction)	US-PGPUB; USPAT	OR	ON	2010/01/27 12:54
S95	1	"20010042249" and instruction	US-PGPUB; USPAT	OR	ON	2010/01/27 12:55
S96	126	(media or music or audio or multimedia or multi-media) near5 insert$5 near5 (ad or adverti$7) same (player or preload$5 or pre-load$5 or download$4)	US-PGPUB; USPAT	OR	ON	2010/01/27 13:52
S97	120	S96 and (profile or demographic$5 or content or target$5) same (ad or adverti$8)	US-PGPUB; USPAT	OR	ON	2010/01/27 13:52
S98	63	S97 and playback and (type same (advert$5 or media) same (format or audio or video))	US-PGPUB; USPAT	OR	ON	2010/01/27 13:52
S99	64	S96 and playback and (type same (advert$5 or media) same (format or audio or video))	US-PGPUB; USPAT	OR	ON	2010/01/27 13:53
S100	43	S96 and (clip episode) same (ad adverti$6)	US-PGPUB; USPAT	OR	ON	2010/01/27 13:55

S101	12	S96 and (episode same (ad adverti$6))	US-PGPUB; USPAT	OR	ON	2010/01/27 13:56
S102	63	S96 and (number or amount) same (media song clip file) same (ad adverti$6)	US-PGPUB; USPAT	OR	ON	2010/01/27 14:07
S103	21	S96 and (number or amount) near5 (media song clip file) same (insert$4 play$4) near5 (ad adverti$6)	US-PGPUB; USPAT	OR	ON	2010/01/27 14:08
S104	995	(media or music or audio or multimedia or multi-media) same ((play$4 insert$5) near5 (ad or adverti$7)) same playing	US-PGPUB; USPAT	OR	ON	2010/01/27 15:35
S105	591	S104 and (instruction tag insert$6) same (ad adverti$8)	US-PGPUB; USPAT	OR	ON	2010/01/27 15:40
S106	444	S104 and (instruction tag insert$6) near5 (ad adverti$8)	US-PGPUB; USPAT	OR	ON	2010/01/27 15:40
S109	366	(media or music or audio or multimedia or multi-media) near8 (insert$5 near5 (ad or adverti$7)) same play$5	US-PGPUB; USPAT	OR	ON	2010/01/27 15:42
S110	366	S109 and (instruction tag insert$6) near5 (ad adverti$8)	US-PGPUB; USPAT	OR	ON	2010/01/27 15:42
S111	154	S110 and clip	US-PGPUB; USPAT	OR	ON	2010/01/27 16:30
S112	56	S110 and (clip same (program episode))	US-PGPUB; USPAT	OR	ON	2010/01/27 16:32
S113	4	S110 and (clip same episode)	US-PGPUB; USPAT	OR	ON	2010/01/27 16:33
S114	118	S110 and (clip segment) same (program episode)	US-PGPUB; USPAT	OR	ON	2010/01/27 16:35
S115	3	S110 and (number adj3 (clip segment)) same (program episode) same (ad adverti$8)	US-PGPUB; USPAT	OR	ON	2010/01/27 16:36
S116	252	S110 and (number same (ad adverti$8))	US-PGPUB; USPAT	OR	ON	2010/01/27 16:46
S117	198	S110 and (number near10 (ad adverti$8))	US-PGPUB; USPAT	OR	ON	2010/01/27 16:46
S118	177	number same (media or music or audio or multimedia or multi-media) near8 (insert$5 near5 (ad or adverti$7))	US-PGPUB; USPAT	OR	ON	2010/01/27 17:01
S119	47	number near5 (media or music or audio or multimedia or multi-media) near8 ((insert$5 play) near5 (ad or adverti$7))	US-PGPUB; USPAT	OR	ON	2010/01/27 17:03
S120	132	time near5 (media or music or audio or multimedia or multi-media) near8 ((insert$5 play) near5 (ad or adverti$7))	US-PGPUB; USPAT	OR	ON	2010/01/27 17:09

S121	266	S110 and (time near10 (ad adverti$8))	US-PGPUB; USPAT	OR	ON	2010/01/27 18:10
S122	70	S121 and @pd<"20050101"	US-PGPUB; USPAT	OR	ON	2010/01/27 18:11
S123	372	(media or music or audio or multimedia or multi-media) near8 (insert$5 near5 (ad or adverti$7)) same play$5	US-PGPUB; USPAT	OR	ON	2010/01/28 08:19
S124	372	S123 and (instruction tag insert$6) near5 (ad adverti$8)	US-PGPUB; USPAT	OR	ON	2010/01/28 08:19
S125	209	S124 and sequence	US-PGPUB; USPAT	OR	ON	2010/01/28 08:19
S126	109	S124 and (sequence same play$4)	US-PGPUB; USPAT	OR	ON	2010/01/28 08:20
S127	372	(media or music or audio or multimedia or multi-media) near8 (insert$5 near5 (ad or adverti$7)) same play$5	US-PGPUB; USPAT	OR	ON	2010/01/28 09:53
S128	372	S127 and (instruction tag insert$6) near5 (ad adverti$8)	US-PGPUB; USPAT	OR	ON	2010/01/28 09:53
S129	109	S128 and (sequence same play$4)	US-PGPUB; USPAT	OR	ON	2010/01/28 09:53
S130	101	S129 and (time period) same (second minute)	US-PGPUB; USPAT	OR	ON	2010/01/28 10:06
S131	85	"6434747"	US-PGPUB; USPAT	OR	ON	2010/01/28 10:15
S132	122	"6698020"	US-PGPUB; USPAT	OR	ON	2010/01/28 10:15
S133	190	S131 S132	US-PGPUB; USPAT	OR	ON	2010/01/28 10:15
S134	91	S133 and (ad adverti$8) same media	US-PGPUB; USPAT	OR	ON	2010/01/28 10:17
S135	278	"5778187"	US-PGPUB; USPAT	OR	ON	2010/09/30 09:53
S136	113	S135 and @pd<"20050101"	US-PGPUB; USPAT	OR	ON	2010/09/30 09:54
S137	61	S136 and (ad advertis$8 commercial promotion$4)	US-PGPUB; USPAT	OR	ON	2010/09/30 09:55
S138	1	"20040003398" and (rules same (ad adverti$9))	US-PGPUB; USPAT	OR	ON	2010/09/30 10:08
S139	1	"20040003398" and (rules same (ad adverti$9))	US-PGPUB; USPAT	OR	ON	2010/10/01 08:36
S140	0	(mediaplayer media-player (media adj player)) same intersplic$4 same segment$5	US-PGPUB; USPAT	OR	ON	2010/10/01 09:33

S141	0	(mediaplayer media-player (media adj player)) same intersplic$4 same segement$5	US-PGPUB; USPAT	OR	ON	2010/10/01 09:33
S142	1	(mediaplayer media-player (media adj player)) and intersplic$4 same segment$5	US-PGPUB; USPAT	OR	ON	2010/10/01 09:34
S143	1	"20010042249"	US-PGPUB; USPAT	OR	ON	2010/10/01 09:34
S144	167	"6698020"	US-PGPUB; USPAT	OR	ON	2010/10/01 09:53
S146	160	(audio video music multimedia multi-media) same (ad advertis$9) same (segment$4 block insert$5) same (sequenc$5 order$4) same (mediaplayer media-player (media adj player) playback play-back (play$4 adj back))	US-PGPUB; USPAT	OR	ON	2010/10/01 10:09
S147	156	"5892536"	US-PGPUB; USPAT	OR	ON	2010/10/01 10:26
S148	133	S147 and (ad adverti$9 promotion$5 commercial)	US-PGPUB; USPAT	OR	ON	2010/10/01 11:16
S149	46	S147 and (ad adverti$9 promotion$5 commercial) same (segment block) and sequenc$5	US-PGPUB; USPAT	OR	ON	2010/10/01 11:18
S150	1	"20040003398" and order$5 same sequenc$5	US-PGPUB; USPAT	OR	ON	2013/07/17 15:23
S151	1	"20040003398" and order$5 same sequenc$5	US-PGPUB; USPAT	OR	ON	2013/07/17 16:32
S152	1	"20040003398" and (order$5 sequenc$5)	US-PGPUB; USPAT	OR	ON	2013/07/17 16:32
S153	1	"20040003398" and (order$5 sequenc$5) same (ad advertis$5)	US-PGPUB; USPAT	OR	ON	2013/07/17 16:33
S154	147	"6338044"	US-PGPUB; USPAT	OR	ON	2013/07/17 16:43
S155	1	"20040003398" and (order$5 sequenc$5)	US-PGPUB; USPAT	OR	ON	2013/07/17 16:46
S156	1	"20040003398" and (order$5 sequenc$5 playlist)	US-PGPUB; USPAT	OR	ON	2013/07/18 10:01
S157	1	"20040003398" and (order$5 sequenc$5 playlist)	US-PGPUB; USPAT	OR	ON	2013/08/11 14:41
S158	1	"20040003398" and media adj file	US-PGPUB; USPAT	OR	ON	2013/08/11 16:07
S159	1	"20040003398" and media adj file and subset	US-PGPUB; USPAT	OR	ON	2013/08/11 16:08
S160	1	"20040003398" and (select$5 choos$4) near5 media adj file and subset	US-PGPUB; USPAT	OR	ON	2013/08/11 16:11

S161	1	"20040003398" and (select$5 choos$4) near5 media adj file and subset and title	US-PGPUB; USPAT	OR	ON	2013/08/11 16:12
S162	1	"20040003398" and (select$5 choos$4) near5 (media track music title)	US-PGPUB; USPAT	OR	ON	2013/08/11 16:13
S163	1	"20010042249" and (select$5 choos$4) near5 (media track music title sequence)	US-PGPUB; USPAT	OR	ON	2013/08/11 16:15
S164	1	"20010042249" and (select$5 choos$4 request$5) near5 (media track music title sequence)	US-PGPUB; USPAT	OR	ON	2013/08/11 16:17
S165	292	(playlist play-list sequence) same (audio music) same insert$5 same (ad adverti$9)	US-PGPUB; USPAT	OR	ON	2013/08/11 17:05
S166	160	(playlist play-list sequence) same (audio music) same insert$5 near9 (ad adverti$9)	US-PGPUB; USPAT	OR	ON	2013/08/11 17:05
S167	131	(playlist play-list sequence) same (audio music) same insert$5 near9 (ad adverti$9) and (player playing)	US-PGPUB; USPAT	OR	ON	2013/08/11 17:09
S168	8	(playlist play-list sequence) same select$5 near5 (audio music) same insert$5 near9 (ad adverti$9) and (player playing)	US-PGPUB; USPAT	OR	ON	2013/08/11 17:10
S169	0	(playlist play-list sequence) same select$5 near5 (audio music) same rule near5 (number frequenc$5) near9 (ad adverti$9)	US-PGPUB; USPAT	OR	ON	2013/08/12 11:24
S170	1	(playlist play-list sequence) same select$5 near5 (audio music) same rule near5 (number frequenc$5) same (ad adverti$9)	US-PGPUB; USPAT	OR	ON	2013/08/12 11:25
S171	3	(playlist play-list sequence) same select$5 near5 (audio music) same rule same (number frequenc$5) same (ad adverti$9)	US-PGPUB; USPAT	OR	ON	2013/08/12 11:26
S172	37	(playlist play-list sequence) same select$5 same (audio music) same rule same (number frequenc$5) same (ad adverti$9)	US-PGPUB; USPAT	OR	ON	2013/08/12 11:28
S173	0	"20040003398" and playlist near5 setting same volume	US-PGPUB; USPAT	OR	ON	2013/08/12 11:59
S174	1	"20040003398" and setting same volume	US-PGPUB; USPAT	OR	ON	2013/08/12 11:59
S175	1	"20040003398" and setting and threshold	US-PGPUB; USPAT	OR	ON	2013/08/12 12:00

S176	1	("6588015").PN.	US-PGPUB; USPAT; USOCR	OR	OFF	2013/08/12 12:05
S177	1	S176 and volume	US-PGPUB; USPAT	OR	ON	2013/08/12 12:09
S178	6	(playlist play-list) same (commercial ad advertis$6) same control$5 near5 volume	US-PGPUB; USPAT	OR	ON	2013/08/12 12:10
S180	4	(playlist play-list) same (commercial ad advertis$6) same sett$5 near5 volume	US-PGPUB; USPAT	OR	ON	2013/08/12 12:11
S181	18	(playlist play-list sequenc$5 order$5) same (media multimedia multi-media music audio) same (commercial ad advertis$6) same sett$5 near5 volume	US-PGPUB; USPAT	OR	ON	2013/08/12 12:13
S182	22	(playlist play-list sequenc$5 order$5) same (media multimedia multi-media music audio) same (commercial ad advertis$6) same player near9 volume	US-PGPUB; USPAT	OR	ON	2013/08/12 12:15
S183	41	(playlist play-list sequenc$5 order$5) same (media multimedia multi-media music audio) same (commercial ad advertis$6) same setting same volume	US-PGPUB; USPAT	OR	ON	2013/08/12 12:19
S185	424	(media multimedia multi-media music audio) same (commercial ad advertis$6) same (control$5 setting) same volume same play$5	US-PGPUB; USPAT	OR	ON	2013/08/12 12:20
S186	180	(media multimedia multi-media music audio) same (commercial ad advertis$6) same (control$5 setting) same volume near9 play$5	US-PGPUB; USPAT	OR	ON	2013/08/12 12:20
S187	6	(media multimedia multi-media music audio) same (commercial ad advertis$6) same volume near9 play$5 same disabl$4	US-PGPUB; USPAT	OR	ON	2013/08/12 12:26
S188	6	(media multimedia multi-media music audio) same (commercial ad advertis$6) same volume near9 play$5 same disabl$4	US-PGPUB; USPAT	OR	ON	2013/08/12 13:00
S189	1	"20040003398"	US-PGPUB; USPAT	OR	ON	2013/08/12 13:25
S190	1	S189 and volume	US-PGPUB; USPAT	OR	ON	2013/08/12 13:27
S191	434	player same (increas$5 adjust$5) near4 volume same (setting preference)	US-PGPUB; USPAT	OR	ON	2013/08/12 13:31
S192	0	player same (increas$5 adjust$5) near4 volume near5 (setting preference) same (ad advertis$5 commercial)	US-PGPUB; USPAT	OR	ON	2013/08/12 13:32

S193	193	player same (increas$5 adjust$5) near4 volume near9 (setting preference)	US-PGPUB; USPAT	OR	ON	2013/08/12 13:32
S194	0	"20040003398" and modif$5 near5 remove same file	US-PGPUB; USPAT	OR	ON	2013/08/12 14:10
S195	0	"20040003398" and modif$5 near5 remov$4 same file	US-PGPUB; USPAT	OR	ON	2013/08/12 14:10
S196	1	"20040003398" and modif$5 same (sequence order$5)	US-PGPUB; USPAT	OR	ON	2013/08/12 14:11
S197	1	"20040003398" and remove$5	US-PGPUB; USPAT	OR	ON	2013/08/12 14:11
S198	1	"20040003398" and remov$5	US-PGPUB; USPAT	OR	ON	2013/08/12 14:11
S199	3	"7720686"	US-PGPUB; USPAT	OR	ON	2013/08/12 14:18
S200	1	"20040003398" and concurrently	US-PGPUB; USPAT	OR	ON	2013/08/12 14:33
S201	1	"20040003398" and (sequence order$5)	US-PGPUB; USPAT	OR	ON	2013/08/12 18:19
S202	1	"20010042249" and (revers$5 forward$5)	US-PGPUB; USPAT	OR	ON	2013/08/12 18:43
S203	1	"20040003398"	US-PGPUB; USPAT	OR	ON	2013/10/02 13:53
S204	1	"20040003398"	US-PGPUB; USPAT	OR	ON	2014/04/15 09:40
S205	1	"20040054591"	US-PGPUB; USPAT	OR	ON	2014/04/15 10:51
S206	1	"20040054591" and image	US-PGPUB; USPAT	OR	ON	2014/04/15 10:52
S207	1	"20040003398"	US-PGPUB; USPAT	OR	ON	2014/04/15 11:17
S210	1	"20040003398"	US-PGPUB; USPAT	OR	ON	2014/04/15 15:25
S211	0	S208 and rules	US-PGPUB; USPAT	OR	ON	2014/04/15 15:26
S212	1	S210 and rules	US-PGPUB; USPAT	OR	ON	2014/04/15 15:26
S213	1	S210 and sequence near9 list	US-PGPUB; USPAT	OR	ON	2014/04/15 15:42
S214	1	S210 and sequence near9 list same (viewer$9 player client)	US-PGPUB; USPAT	OR	ON	2014/04/15 15:42
S215	1	S210 and sequence near9 list same (player$9 client)	US-PGPUB; USPAT	OR	ON	2014/04/15 15:55
S216	1	S210 and (player$9 client)	US-PGPUB; USPAT	OR	ON	2014/04/15 15:56

S217	1	S210 and (player$9 client) same (adverti$9 ad)	US-PGPUB; USPAT	OR	ON	2014/04/15 15:56
S218	1	"20010042249" and (forward backward)	US-PGPUB; USPAT	OR	ON	2014/04/16 11:39
S219	1	"20010042249" and (forward backward skip$4)	US-PGPUB; USPAT	OR	ON	2014/04/16 11:39
S220	1	"20010042249" and (forward backward skip$4 revers$5)	US-PGPUB; USPAT	OR	ON	2014/04/16 12:17
S221	1	"20010042249" and (forward backward skip$4 revers$5)	US-PGPUB; USPAT	OR	ON	2014/04/16 12:17
S222	75	"6950804"	US-PGPUB; USPAT	OR	ON	2014/04/16 16:32
S223	6,778	(playlist music audio multimedia media) same (skip$5 forward$5) same (ad adverti$8 marketing commercial)	US-PGPUB; USPAT	OR	ON	2014/04/16 16:39
S224	748	(playlist music audio multimedia media) same (skip$5 forward$5) same (ad adverti$8 marketing commercial) same (play$5 near5 (ad adverti$9))	US-PGPUB; USPAT	OR	ON	2014/04/16 16:39
S225	284	(playlist music audio multimedia media) near6 (skip$5 forward$5) same (ad adverti$8 marketing commercial) same (play$5 near5 (ad adverti$9))	US-PGPUB; USPAT	OR	ON	2014/04/16 16:40
S226	39	S225 and @pd<"20070101"	US-PGPUB; USPAT	OR	ON	2014/04/16 16:41
S227	1	"20030149975" and skip$6	US-PGPUB; USPAT	OR	ON	2014/04/16 17:22
S228	284	(playlist music audio multimedia media) near6 (skip$5 forward$5) same (ad adverti$8 marketing commercial) same (play$5 near5 (ad adverti$9))	US-PGPUB; USPAT	OR	ON	2014/04/16 17:59
S229	39	S228 and @pd<"20070101"	US-PGPUB; USPAT	OR	ON	2014/04/16 17:59
S230	172	(playlist music audio multimedia media) near6 skip$5 same (ad adverti$8 marketing commercial) same (play$5 near5 (ad adverti$9))	US-PGPUB; USPAT	OR	ON	2014/04/17 09:04
S231	31	playlist same (music audio multimedia media) near6 tag same (ad adverti$8 marketing commercial) same play$5	US-PGPUB; USPAT	OR	ON	2014/04/17 10:11
S232	1,560	playlist same (music audio multimedia media) same (ad adverti$8 marketing commercial) same play$5	US-PGPUB; USPAT	OR	ON	2014/04/17 10:13
S233	396	playlist same (music audio multimedia media) same (ad adverti$8 marketing	US-PGPUB; USPAT	OR	ON	2014/04/17 10:14

		commercial) same play$5 same (clip segment marker)				
S234	181	playlist same (music audio multimedia media) same (ad adverti$8 marketing commercial) near9 (clip segment marker) same play$6	US-PGPUB; USPAT	OR	ON	2014/04/17 10:19
S235	181	playlist same (music audio multimedia media) same (ad adverti$8 marketing commercial) near9 (clip segment marker) same play$6	US-PGPUB; USPAT	OR	ON	2014/04/17 11:02
S236	181	playlist same (music audio multimedia media) same (ad adverti$8 marketing commercial) near9 (clip segment marker) same play$6	US-PGPUB; USPAT	OR	ON	2014/04/17 11:36
S237	396	playlist same (music audio multimedia media) same (ad adverti$8 marketing commercial) same (clip segment marker) same play$6	US-PGPUB; USPAT	OR	ON	2014/04/17 11:44
S238	24	S237 and @pd<"20060101"	US-PGPUB; USPAT	OR	ON	2014/04/17 11:44
S239	106	S237 and @pd<"20090101"	US-PGPUB; USPAT	OR	ON	2014/04/17 11:45
S240	168	S237 and @pd<"20110101"	US-PGPUB; USPAT	OR	ON	2014/04/17 11:45
S241	23	S237 and @ad<"20030101"	US-PGPUB; USPAT	OR	ON	2014/04/17 11:48
S242	108	S237 and @ad<"20070101"	US-PGPUB; USPAT	OR	ON	2014/04/17 11:49
S243	39	playlist same (music audio multimedia media) same (ad adverti$8 marketing commercial) same (clip segment marker) same play$6 and marker	US-PGPUB; USPAT	OR	ON	2014/04/17 11:50
S244	81	S242 and (skip$5 forward$4)	US-PGPUB; USPAT	OR	ON	2014/04/17 11:52
S247	102	(playlist (play adj list) play-list) same (ad adverti$8) near5 (clip segment marker tag spot) same (playback (playing adj back))	US-PGPUB; USPAT	OR	ON	2014/04/17 12:37
S248	113	(playlist (play adj list) play-list) same (ad adverti$8 marketing commercial) near5 (clip segment marker tag spot) same (playback (playing adj back))	US-PGPUB; USPAT	OR	ON	2014/04/17 12:37
S249	1	"20080126193"	US-PGPUB; USPAT	OR	ON	2014/04/21 16:48
S250	1	"20040003398"	US-PGPUB; USPAT	OR	ON	2014/04/21 16:49

S251	90	((adverti$9 ad) near5 rule) same (media music multimedia multi-media) same (playlist player)	US-PGPUB; USPAT	OR	ON	2014/04/21 16:55
S252	291	((adverti$9 ad) same rule) same (media music multimedia multi-media) same (playlist player)	US-PGPUB; USPAT	OR	ON	2014/04/21 17:40
S253	102	((adverti$9 ad) same rule) same (media music multimedia multi-media) same (playlist player) same number	US-PGPUB; USPAT	OR	ON	2014/04/21 17:40
S254	293	((adverti$9 ad) same rule) same (media music multimedia multi-media) same (playlist player)	US-PGPUB; USPAT	OR	ON	2014/04/22 09:51
S255	297	((adverti$9 ad) same rule) same (media music multimedia multi-media songs) same (playlist player)	US-PGPUB; USPAT	OR	ON	2014/04/22 09:51
S256	32	S255 and @pd<"20050101"	US-PGPUB; USPAT	OR	ON	2014/04/22 09:52
S257	57	S255 and @pd<"20070101"	US-PGPUB; USPAT	OR	ON	2014/04/22 09:53
S258	297	((adverti$9 ad) same rule) same (media music multimedia multi-media songs) same (playlist player)	US-PGPUB; USPAT	OR	ON	2014/04/22 11:44
S259	57	S258 and @pd<"20070101"	US-PGPUB; USPAT	OR	ON	2014/04/22 11:44
S260	297	((adverti$9 ad) same rule) same (media music multimedia multi-media songs) same (playlist player)	US-PGPUB; USPAT	OR	ON	2014/04/22 13:04
S261	57	S260 and @pd<"20070101"	US-PGPUB; USPAT	OR	ON	2014/04/22 13:04
S262	1,756	(adverti$9 ad) same (media music multimedia multi-media songs) same (playlist same player mediaplayer media-player realplayer real-player mp3)	US-PGPUB; USPAT	OR	ON	2014/04/22 13:32
S263	26	S262 and (number near5 (music song)) near5 play$5 same (adverti$8 ad)	US-PGPUB; USPAT	OR	ON	2014/04/22 13:33
S265	153	(number near5 (song music)) same play$5 same adverti$9	US-PGPUB; USPAT	OR	ON	2014/04/22 13:40
S266	153	(number near5 (song music)) same play$5 same adverti$9	US-PGPUB; USPAT	OR	ON	2014/04/22 15:55
S267	1	"20010042249" and (skip$5 or forward$5)	US-PGPUB; USPAT	OR	ON	2014/04/23 11:31
S268	1	(music song multimedia multi-media) same segement$5 same (ad advertis$8)	US-PGPUB; USPAT	OR	ON	2014/04/25 11:50

S269	3	(music audio song multimedia multi-media) same segement$5 same (ad advertis$8)	US-PGPUB; USPAT	OR	ON	2014/04/25 11:51
S270	5	(music audio song multimedia multi-media) same segement$5 and (ad advertis$8)	US-PGPUB; USPAT	OR	ON	2014/04/25 11:52
S271	2,075	(add$5 same (music audio songs) near5 playlist)	US-PGPUB; USPAT	OR	ON	2014/04/25 13:03
S272	884	(add$5 near4 (music audio songs) near5 playlist)	US-PGPUB; USPAT	OR	ON	2014/04/25 13:04
S273	25	(add$5 near4 (music audio songs) near5 playlist) same (comercial ad adverti$9)	US-PGPUB; USPAT	OR	ON	2014/04/25 13:04
S274	0	(select$5 near new near4 (music audio songs) near5 playlist) same (comercial ad adverti$9)	US-PGPUB; USPAT	OR	ON	2014/04/25 13:05
S275	0	select$5 near9 (music audio songs) near5 to near5 playlist same (comercial ad adverti$9)	US-PGPUB; USPAT	OR	ON	2014/04/25 13:07
S276	77	select$5 near9 (music audio songs) near9 playlist same (comercial ad adverti$9)	US-PGPUB; USPAT	OR	ON	2014/04/25 13:08
S277	14	select$5 near9 (music audio songs) near9 playlist same (comercial ad adverti$9) same modif$7	US-PGPUB; USPAT	OR	ON	2014/04/25 13:10
S278	39	(music audio songs) near9 playlist same (comercial ad adverti$9) same modif$7	US-PGPUB; USPAT	OR	ON	2014/04/25 13:16
S279	134	(music audio songs) near9 playlist same (comercial ad adverti$9) same add$5	US-PGPUB; USPAT	OR	ON	2014/04/25 13:41
S280	37	new near9 (music audio songs) near9 playlist same (comercial ad adverti$9)	US-PGPUB; USPAT	OR	ON	2014/04/25 13:45
S281	281	(generat$5 creat$5) near9 new near9 (music audio songs) near9 playlist	US-PGPUB; USPAT	OR	ON	2014/04/25 13:46
S282	71	S281 and @pd<"20070101"	US-PGPUB; USPAT	OR	ON	2014/04/25 13:46
S283	54	append$5 same (ad advertis$9) same number near4 (songs music audio video multimedia media multi-media)	US-PGPUB; USPAT	OR	ON	2014/04/25 17:30
S284	287	inser$7 near6 (ad advertis$9) same number near4 (songs music audio video multimedia media multi-media)	US-PGPUB; USPAT	OR	ON	2014/04/25 17:37
S285	0	inser$7 near6 (ad advertis$9) same number near4 of near5 (songs music audio video multimedia media multi-media)	US-PGPUB; USPAT	OR	ON	2014/04/25 17:37

S286	226	inser$7 near6 (ad advertis$9) same number near3 (songs music audio video multimedia media multi-media)	US-PGPUB; USPAT	OR	ON	2014/04/25 17:37
S287	56	inser$7 near6 (ad advertis$9) same number near3 (songs music audio video multimedia media multi-media) same play$9	US-PGPUB; USPAT	OR	ON	2014/04/25 17:38
S288	3	S287 and less near5 (ad advertis$9) near5 play$5	US-PGPUB; USPAT	OR	ON	2014/04/25 17:43
S289	1	"20040003398" and rotat$6	US-PGPUB; USPAT	OR	ON	2014/04/28 10:53
S290	0	"20010042249" and rotat$6	US-PGPUB; USPAT	OR	ON	2014/04/28 10:55
S291	0	"20020120564" and rotat$5	US-PGPUB; USPAT	OR	ON	2014/04/28 12:06
S293	39	advertis$9 near8 rotat$5 near5 segment	US-PGPUB; USPAT	OR	ON	2014/04/28 12:09
S294	5	advertis$9 near8 rotat$5 near5 songs	US-PGPUB; USPAT	OR	ON	2014/04/28 12:11
S295	2	advertis$9 near8 rotat$5 near5 music	US-PGPUB; USPAT	OR	ON	2014/04/28 12:13
S296	22	advertis$9 near8 rotat$5 same music	US-PGPUB; USPAT	OR	ON	2014/04/28 12:13
S297	22,681	705/14.1-14.73.ccls.	US-PGPUB; USPAT	OR	ON	2014/05/03 17:03
S298	21,535	g06q30/0201-0239.cpc.	US-PGPUB; USPAT	OR	ON	2014/05/03 17:05
S299	37,028	g06q30/0201-0277.cpc.	US-PGPUB; USPAT	OR	ON	2014/05/03 17:06
S300	288	inser$7 near6 (ad advertis$9) same number near4 (songs music audio video multimedia media multi-media)	US-PGPUB; USPAT	OR	ON	2014/05/03 17:07
S301	333	(media or music or audio or multimedia or multi-media) near5 insert$5 near5 (ad or adverti$7) same (player or preload$5 or pre-load$5 or download$4)	US-PGPUB; USPAT	OR	ON	2014/05/03 17:07
S302	333	(media or music or audio or multimedia or multi-media) near5 insert$5 near5 (ad or adverti$7) same (player or preload$5 or pre-load$5 or download$4)	US-PGPUB; USPAT	OR	ON	2014/05/03 17:08
S303	323	S302 and (profile or demographic$5 or content or target$5) same (ad or adverti$8)	US-PGPUB; USPAT	OR	ON	2014/05/03 17:08
S304	97	S302 and (clip episode) same (ad adverti$6)	US-PGPUB; USPAT	OR	ON	2014/05/03 17:10

S305	28	S297 and S304	US-PGPUB; USPAT	OR	ON	2014/05/03 17:10
S306	29	S299 and S304	US-PGPUB; USPAT	OR	ON	2014/05/03 17:10
S307	116	S297 and S301	US-PGPUB; USPAT	OR	ON	2014/05/03 17:10
S308	116	S297 and S303	US-PGPUB; USPAT	OR	ON	2014/05/03 17:11
S309	146	S299 and S303	US-PGPUB; USPAT	OR	ON	2014/05/03 17:11
S310	1	"20040059712"	US-PGPUB; USPAT	OR	ON	2014/08/26 09:38
S311	3,330	(search query) near (query engine result) same (bid$5 auction) same (advertis$6 ad)	US-PGPUB; USPAT	OR	ON	2014/08/26 09:56
S312	3,141	(search query) near (engine result) same (bid$5 auction) same (advertis$6 ad)	US-PGPUB; USPAT	OR	ON	2014/08/26 09:57
S313	1,051	(search query) near (engine result) same (bid$5 same auction) same (advertis$6 ad)	US-PGPUB; USPAT	OR	ON	2014/08/26 09:57
S314	303	((search query) near engine) same result same (bid$5 same auction) same advertis$6	US-PGPUB; USPAT	OR	ON	2014/08/26 09:58
S315	303	((search query) near engine) same result same (bid$5 same auction) same advertis$6	US-PGPUB; USPAT	OR	ON	2014/08/26 15:50
S316	9	((search query) near engine) same result same (automatic$5 dynamic$5 notification notif$5) near9 (bid$5 same auction) same advertis$6	US-PGPUB; USPAT	OR	ON	2014/08/26 15:55
S318	132	(send$5 transmit$6 notif$9) same (search query) same advertis$6 near3 (agent computer system) same bid$6	US-PGPUB; USPAT	OR	ON	2014/08/26 16:05
S319	760	"1" and seqenc$6	US-PGPUB; USPAT	OR	ON	2015/08/12 10:18
S320	1	"20040003398"	US-PGPUB; USPAT	OR	ON	2015/08/12 10:18
S321	0	S320 and seqenc$6	US-PGPUB; USPAT	OR	ON	2015/08/12 10:18
S322	1	S320 and sequenc$6	US-PGPUB; USPAT	OR	ON	2015/08/12 10:20
S323	1	S320 and sequenc$6 same (advert$5 commercial)	US-PGPUB; USPAT	OR	ON	2015/08/12 10:21

S324	37	"7565429" and (skip$5 forward$5)	US-PGPUB; USPAT	OR	ON	2015/08/12 16:54
S325	1	"20010042249" and (skip$5 forward$5)	US-PGPUB; USPAT	OR	ON	2015/08/12 16:54
S326	1	"20060206479"	US-PGPUB; USPAT	OR	ON	2015/08/13 08:47
S327	1	"20040003398"	US-PGPUB; USPAT	OR	ON	2015/08/13 10:50
S328	1	S327 and average	US-PGPUB; USPAT	OR	ON	2015/08/13 10:50
S329	1	"20040003398"	US-PGPUB; USPAT	OR	ON	2015/08/13 12:59
S330	1	"20040003398" and file	US-PGPUB; USPAT	OR	ON	2015/08/13 13:17
S331	1	"20040003398"	US-PGPUB; USPAT	OR	ON	2015/08/18 11:38
S332	1	S331 and adverti$6	US-PGPUB; USPAT	OR	ON	2015/08/18 11:38
S333	1	S331 and adverti$8	US-PGPUB; USPAT	OR	ON	2015/08/18 11:40
S334	1	S331 and adverti$8 near4 file	US-PGPUB; USPAT	OR	ON	2015/08/18 11:43
S335	1	S331 and adverti$8 near4 (content file)	US-PGPUB; USPAT	OR	ON	2015/08/18 11:44
S336	1	S331 and skip$5 same adverti$8 near4 (content file)	US-PGPUB; USPAT	OR	ON	2015/08/18 11:54
S337	1	S331 and skip$5 same adverti$8 near4 (content file) and sequen$9	US-PGPUB; USPAT	OR	ON	2015/08/18 11:55
S338	1	"20040003398"	US-PGPUB; USPAT	OR	ON	2016/01/20 12:15
S339	0	S338 and (modif$5 chang$5) near5 sequenc$6	US-PGPUB; USPAT	OR	ON	2016/01/20 12:27
S340	1	S338 and skip$5	US-PGPUB; USPAT	OR	ON	2016/01/20 12:37
S341	1	"20040003398"	US-PGPUB; USPAT	OR	ON	2016/01/20 14:51
S342	0	S341 and (modif$5 chang$5) near5 sequenc$6	US-PGPUB; USPAT	OR	ON	2016/01/20 14:51
S343	1	S341 and sequenc$6	US-PGPUB; USPAT	OR	ON	2016/01/20 14:51
S344	1	("6588015").PN.	US-PGPUB; USPAT; USOCR	OR	OFF	2016/01/20 16:32

S345	95	("6588015").URPN.	USPAT	OR	ON	2016/01/20 16:44
S346	95	("6588015").URPN.	USPAT	OR	ON	2016/01/20 17:21
S347	64	S346 and (skip$5 sequence)	USPAT	OR	ON	2016/01/20 17:22
S348	32	S346 and skip$5	USPAT	OR	ON	2016/01/20 17:22
S349	18	S346 and skip$5 same adverti$7	USPAT	OR	ON	2016/01/20 17:23
S350	1	(disabl$5 disallow$5) near5 (skip$5 bypass$5) near4 (commercial advertis$6marketing) same (video music multimedia multi-media media) same play$5	US-PGPUB; USPAT	OR	ON	2016/01/21 09:19
S351	77	(disabl$5 disallow$5) near4 (skip$5 bypass$5 by-pass$5) same (commercial marketing advertis$6) same play$5	US-PGPUB; USPAT	OR	ON	2016/01/21 09:20
S352	182	(disabl$5 disallow$5) same (skip$5 bypass$5 by-pass$5) same (commercial marketing advertis$6) same play$5	US-PGPUB; USPAT	OR	ON	2016/01/21 09:24
S353	112	(disabl$5 disallow$5) same (skip$5 bypass$5 by-pass$5) same (commercial marketing advertis$6) same play$5 and (music songs)	US-PGPUB; USPAT	OR	ON	2016/01/21 09:24
S354	1	"7539711" AND (skip$5 bypass$5)	US-PGPUB; USPAT	OR	ON	2016/01/21 13:00
S355	1	"7539711" AND (skip$5 bypass$5 fast-forward (fast adj forward)) and (commercial advertis$5)	US-PGPUB; USPAT	OR	ON	2016/01/21 13:03
S356	8	"6988277" AND (skip$5 bypass$5 fast-forward (fast adj forward)) and (commercial advertis$5)	US-PGPUB; USPAT	OR	ON	2016/01/21 13:06
S357	2	"8418195" AND (skip$5 bypass$5 fast-forward (fast adj forward)) and (commercial advertis$5)	US-PGPUB; USPAT	OR	ON	2016/01/21 13:08
S358	15	"6912571" AND (skip$5 bypass$5 fast-forward (fast adj forward)) and (commercial advertis$5)	US-PGPUB; USPAT	OR	ON	2016/01/21 13:10
S359	15	"6912571" AND (skip$5 bypass$5 fast-forward (fast adj forward)) and (commercial advertis$5)	US-PGPUB; USPAT	OR	ON	2016/01/21 13:15
S360	368	"6698020" AND (skip$5 bypass$5 fast-forward (fast adj forward)) and (commercial advertis$5)	US-PGPUB; USPAT	OR	ON	2016/01/21 13:17

S361	173	"6698020" AND (skip$5 bypass$5 fast-forward (fast adj forward)) same(commercial advertis$5) and (audio music)	US-PGPUB; USPAT	OR	ON	2016/01/21 13:18
S362	2	track$5 near5 (adverti$6 commercial) near5 play$5 near9 amount same (skip$6 fast-forward$5) same (song music track album)	US-PGPUB; USPAT	OR	ON	2016/01/21 16:28
S363	2	track$5 near5 (adverti$6 commercial) near5 play$5 same amount same (skip$6 fast-forward$5) same (song music track album)	US-PGPUB; USPAT	OR	ON	2016/01/21 16:29
S364	5	track$5 near5 (adverti$6 commercial) near5 play$5 same amount same (skip$6 fast-forward$5) and (song music track album)	US-PGPUB; USPAT	OR	ON	2016/01/21 16:29
S365	0	monitor$5 near5 (adverti$6 commercial) near5 play$5 same amount same (skip$6 fast-forward$5) and (song music track album)	US-PGPUB; USPAT	OR	ON	2016/01/21 16:31
S366	3	monitor$5 near5 (adverti$6 commercial) near5 play$5 same (full amount percentage end) same (skip$6 fast-forward$5) and (song music track album)	US-PGPUB; USPAT	OR	ON	2016/01/21 16:31
S367	108	"5987210"	US-PGPUB; USPAT	OR	ON	2016/01/21 16:32
S368	0	S367 and skip$%	US-PGPUB; USPAT	OR	ON	2016/01/21 16:33
S369	74	S367 and skip$5	US-PGPUB; USPAT	OR	ON	2016/01/21 16:33
S370	1	("5987210").PN.	US-PGPUB; USPAT; USOCR	OR	OFF	2016/01/21 16:34
S371	62	S367 and skip$5 same (commercial adverti$8 marketing)	US-PGPUB; USPAT	OR	ON	2016/01/21 16:41
S372	4	(allow$5 permit$5) near5 (forward fast-forward) same (commercial adverti$8 marketing) same (amount percent$5) same played	US-PGPUB; USPAT	OR	ON	2016/01/21 16:55
S373	80	(forward fast-forward) same (commercial adverti$8 marketing) same (amount percent$5) same played	US-PGPUB; USPAT	OR	ON	2016/01/21 16:56
S374	89	(avoid$5 disabl$5 dis-abl$5 disallow$5 dis-allow$5) same (commercial adverti$8 marketing) same (amount percent$5) same played	US-PGPUB; USPAT	OR	ON	2016/01/21 17:00

S375	2,508	(insert$5 embed$5) near5 (commercial adverti$8 marketing) same (music audio multimedia multi-media media) same play$6	US-PGPUB; USPAT	OR	ON	2016/01/21 17:05
S376	939	(insert$5 embed$5) near5 (commercial adverti$8 marketing) same (music audio multimedia multi-media media) same play$6 same (playback play-back (play adj back))	US-PGPUB; USPAT	OR	ON	2016/01/21 17:06
S377	246	S376 and (play listen) near4 (commercial adverti$6)	US-PGPUB; USPAT	OR	ON	2016/01/21 17:06
S378	154	S376 and (play$5 listen$5) near4 (commercial adverti$6) same skip$5	US-PGPUB; USPAT	OR	ON	2016/01/21 17:07
S379	524	(play$5 listen$5) near4 end$6 near5 (commercial adverti$6) and (playlist playback play-back player) and (music audio)	US-PGPUB; USPAT	OR	ON	2016/01/21 17:18
S380	364	(play$5 listen$5) near4 end$6 near5 (commercial adverti$6) and (playlist playback play-back player) same (music audio)	US-PGPUB; USPAT	OR	ON	2016/01/21 17:19
S381	259	(play$5 listen$5) near4 end$6 near5 (commercial adverti$6) and (playlist playback play-back player) near5 (music audio)	US-PGPUB; USPAT	OR	ON	2016/01/21 17:19
S382	24	(play$5 listen$5) near4 end$6 near5 (commercial adverti$6) and (playlist playback play-back player) near5 (music audio) same insert$5 same (commercial advert$7)	US-PGPUB; USPAT	OR	ON	2016/01/21 17:20
S383	99	(play$5 listen$5) near4 end$6 near5 (commercial adverti$6) and (playlist playback play-back player) near5 (music audio) same (commercial advert$7)	US-PGPUB; USPAT	OR	ON	2016/01/21 17:21
S391	0	advertis$8 same play$5 near4 while	US-PGPUB; USPAT	OR	ON	2016/01/21 18:02
S392	3	advertis$8 same play$5 near4 in adj progress	US-PGPUB; USPAT	OR	ON	2016/01/21 18:03
S393	592	(determin$5 monitor$5 track$5) same end near4 (commercial advertis$8) same play$5	US-PGPUB; USPAT	OR	ON	2016/01/21 18:06
S394	476	(determin$5 monitor$5 track$5) same end near4 (commercial advertis$8) same play$5 and (playlist (play adj list) play-list playback play-back sequence)	US-PGPUB; USPAT	OR	ON	2016/01/21 18:07
S395	294	(determin$5 monitor$5 track$5) same end near4 (commercial advertis$8) same	US-PGPUB; USPAT	OR	ON	2016/01/21 18:07

		play$5 same (playlist (play adj list) play-list playback play-back sequence)				
S396	42	S395 and @pd<"20050101"	US-PGPUB; USPAT	OR	ON	2016/01/21 18:08
S397	1	"20040003398"	US-PGPUB; USPAT	OR	ON	2016/04/06 12:48
S398	1	"20040003398"	US-PGPUB; USPAT	OR	ON	2016/09/19 09:50
S399	1	"20040003398" and sequenc$6 same play$6	US-PGPUB; USPAT	OR	ON	2016/09/19 10:51
S400	1	"20040003398" and re -sequenc$6 same play$6	US-PGPUB; USPAT	OR	ON	2016/09/19 13:42
S401	1	"20040003398" and re-sequenc$6 same play$6	US-PGPUB; USPAT	OR	ON	2016/09/19 13:43
S402	195	playlist same (reordering re-ordering re-sequenc$5)	US-PGPUB; USPAT	OR	ON	2016/09/20 09:12
S403	26	display$5 near9 playlist same (reordering re-ordering re-sequenc$5)	US-PGPUB; USPAT	OR	ON	2016/09/20 09:14
S404	20	display$5 near9 playlist same (music audio media multimedia multi-media) same (reordering re-ordering re-sequenc$5)	US-PGPUB; USPAT	OR	ON	2016/09/20 09:15
S405	168	display$5 near9 playlist same (music audio media multimedia multi-media) and (reordering re-ordering re-sequenc$5)	US-PGPUB; USPAT	OR	ON	2016/09/20 09:17
S406	1,995	display$5 near9 playlist same (music audio media multimedia multi-media) and (skip$5 forward$5 shuffl$4 reshuffl$5 re-shuffl$4)	US-PGPUB; USPAT	OR	ON	2016/09/20 09:19
S407	385	display$5 near9 playlist same (music audio media multimedia multi-media) same (skip$5 forward$5 shuffl$4 reshuffl$5 re-shuffl$4)	US-PGPUB; USPAT	OR	ON	2016/09/20 09:20
S408	3	display$5 near9 playlist same (music audio media multimedia multi-media) same (skip$5 forward$5) same (shuffl$4 reshuffl$5 re-shuffl$4)	US-PGPUB; USPAT	OR	ON	2016/09/20 09:20
S409	74	display$5 near9 playlist same (music audio media multimedia multi-media) and (skip$5 forward$5) same (shuffl$4 reshuffl$5 re-shuffl$4)	US-PGPUB; USPAT	OR	ON	2016/09/20 09:20
S410	1	"20040003398" and rules	US-PGPUB; USPAT	OR	ON	2016/09/20 09:24
S411	0	"20040003398" and (truck same count)	US-PGPUB; USPAT	OR	ON	2016/09/20 09:24

S412	1	"20040003398" and (track same count)	US-PGPUB; USPAT	OR	ON	2016/09/20 09:24
S413	50	("2001/0042249").URPN.	USPAT	OR	ON	2016/09/20 09:55
S414	75	(playlist play-list (play adj list)) same (music audio multimedia multi-media (multi adj media)) same (count$5 track$5) near5 number same play$5 and advertis$6	USPAT	OR	ON	2016/09/20 10:34
S415	260	(playlist play-list (play adj list)) same (music audio multimedia multi-media (multi adj media)) same (count$5 track$5) near5 number same play$5 and advertis$6	US-PGPUB; USPAT	OR	ON	2016/09/20 10:34
S416	16	S415 and @pd<"20030101"	US-PGPUB; USPAT	OR	ON	2016/09/20 10:35
S417	18	S415 and @pd<"20050101"	US-PGPUB; USPAT	OR	ON	2016/09/20 10:35
S418	1,356	(music audio multimedia multi-media (multi adj media)) same (count$5 track$5) near5 number same play$5 and advertis$6	US-PGPUB; USPAT	OR	ON	2016/09/20 10:40
S419	132	S418 and @pd<"20050101"	US-PGPUB; USPAT	OR	ON	2016/09/20 10:40
S420	687	(music audio multimedia multi-media (multi adj media)) same (count$5 tracking) near5 number same play$5 and advertis$6	US-PGPUB; USPAT	OR	ON	2016/09/20 11:09
S421	30	S420 and @pd<"20050101"	US-PGPUB; USPAT	OR	ON	2016/09/20 11:09
S422	844	(music audio multimedia multi-media (multi adj media)) and (count$5 tracking) near5 number near5 times same play$5 and advertis$6	US-PGPUB; USPAT	OR	ON	2016/09/20 12:36
S423	48	S422 and @pd<"20050101"	US-PGPUB; USPAT	OR	ON	2016/09/20 12:37
S424	89	(music audio multimedia multi-media (multi adj media)) and (count$5 tracking) near5 number near5 (insert$6 break play$6) near5 (ad advertis$6)	US-PGPUB; USPAT	OR	ON	2016/09/20 12:45
S425	248	(music audio multimedia multi-media (multi adj media)) same number near5 (insert$6 break play$6) near5 (ad advertis$6)	US-PGPUB; USPAT	OR	ON	2016/09/20 12:50
S426	39	S425 and @pd<"20050101"	US-PGPUB; USPAT	OR	ON	2016/09/20 12:50

S427	86	(music audio multimedia multi-media (multi adj media)) near5 number same insert$6 near5 (ad advertis$6)	US-PGPUB; USPAT	OR	ON	2016/09/20 12:53
S428	532	(music audio multimedia multi-media (multi adj media)) same (time period number) same play$6 same insert$6 near5 (ad advertis$6)	US-PGPUB; USPAT	OR	ON	2016/09/20 12:57
S429	48	S428 and @pd<"20050101"	US-PGPUB; USPAT	OR	ON	2016/09/20 12:57
S430	1,226	(music audio multimedia multi-media (multi adj media)) same play$6 same insert$6 near5 (ad advertis$6)	US-PGPUB; USPAT	OR	ON	2016/09/20 13:12
S431	48	S429 and @pd<"20050101"	US-PGPUB; USPAT	OR	ON	2016/09/20 13:12
S432	122	S430 and @pd<"20050101"	US-PGPUB; USPAT	OR	ON	2016/09/20 13:13
S433	2,589	playlist same advertis$8	US-PGPUB; USPAT	OR	ON	2016/09/20 14:15
S434	122	S433 and @pd<"20050101"	US-PGPUB; USPAT	OR	ON	2016/09/20 14:15
S435	1,227	swix and (music audio)	US-PGPUB; USPAT	OR	ON	2016/09/20 14:43
S436	539	swix and (music audio) same (adverti$7 commercial)	US-PGPUB; USPAT	OR	ON	2016/09/20 14:43
S437	114	swix and (music audio) same (adverti$7 commercial) same insert$5	US-PGPUB; USPAT	OR	ON	2016/09/20 14:44
S438	581	"6718551"	US-PGPUB; USPAT	OR	ON	2016/09/20 14:46
S439	1	("6718551").PN.	US-PGPUB; USPAT; USOCR	OR	OFF	2016/09/20 14:46
S440	564	(music audio) same track same (count number period) same (insert$5 play$5) same (ad advertis$5 commercial)	US-PGPUB; USPAT	OR	ON	2016/09/20 14:55
S441	74	S440 and @pd<"20050101"	US-PGPUB; USPAT	OR	ON	2016/09/20 14:55
S442	678	(music audio) same (track-count (track near3 count$5))	US-PGPUB; USPAT	OR	ON	2016/09/20 15:19
S443	171	S442 and @pd<"20050101"	US-PGPUB; USPAT	OR	ON	2016/09/20 15:19
S444	165	(music audio) near5 counting same play$5	US-PGPUB; USPAT	OR	ON	2016/09/20 15:22
S445	4	"7761327"	US-PGPUB; USPAT	OR	ON	2016/09/20 15:29

S446	1	"20010042249" and append$6	US-PGPUB; USPAT	OR	ON	2016/09/20 17:06
S447	1	"20040003398"	US-PGPUB; USPAT	OR	ON	2016/10/03 10:11
S448	1	"20040003398"	US-PGPUB; USPAT	OR	ON	2016/10/03 11:05
S449	1	S448 and server	US-PGPUB; USPAT	OR	ON	2016/10/03 11:05
S450	0	S448 and server same (rule sequenc$5)	US-PGPUB; USPAT	OR	ON	2016/10/03 11:05
S451	1	S448 and (rule sequenc$5)	US-PGPUB; USPAT	OR	ON	2016/10/03 11:06
S452	0	S448 and (rule sequenc$5) same (client remote)	US-PGPUB; USPAT	OR	ON	2016/10/03 11:36
S453	1	S448 and (rule sequenc$5 modif$5) same (client remote)	US-PGPUB; USPAT	OR	ON	2016/10/03 11:39
S454	1	S448 and (client remote)	US-PGPUB; USPAT	OR	ON	2016/10/03 11:39
S455	1	S448 and (client remot$5 local$4) same (sequen$6 position)	US-PGPUB; USPAT	OR	ON	2016/10/03 12:09
S456	1	"20040003398"	US-PGPUB; USPAT	OR	ON	2016/10/03 14:04
S457	1	S456 and (client remot$5 local$4 consumer server host computer) same (sequen$6 position)	US-PGPUB; USPAT	OR	ON	2016/10/03 14:04
S458	1	S456 and re-sequenc$5	US-PGPUB; USPAT	OR	ON	2016/10/03 14:57
S459	0	S456 and pre-defined	US-PGPUB; USPAT	OR	ON	2016/10/03 15:05
S460	1	S456 and rules	US-PGPUB; USPAT	OR	ON	2016/10/03 15:05
S461	1	S456 and rule same sequenc$6 and re-sequenc$6	US-PGPUB; USPAT	OR	ON	2016/10/03 15:06
S462	1	"20040003398"	US-PGPUB; USPAT	OR	ON	2016/10/04 09:36
S463	1	S462 and rule	US-PGPUB; USPAT	OR	ON	2016/10/04 09:46
S464	0	S462 and rule and re-seqenc$5	US-PGPUB; USPAT	OR	ON	2016/10/04 09:50
S465	1	S462 and rule and re-sequenc$5	US-PGPUB; USPAT	OR	ON	2016/10/04 09:51
S466	1	"20040003398"	US-PGPUB; USPAT	OR	ON	2016/10/04 11:16

S467	0	S466 and (user-perceptible perceptible)	US-PGPUB; USPAT	OR	ON	2016/10/04 11:16
S468	1	"20040003398"	US-PGPUB; USPAT	OR	ON	2016/10/04 12:28
S469	1	"20040003398" and "434"	US-PGPUB; USPAT	OR	ON	2016/11/08 13:27
S470	1	"20040003398" and adaptiv$4	US-PGPUB; USPAT	OR	ON	2018/10/02 11:17
S471	1	"20040003398" and adaptiv$4	US-PGPUB; USPAT	OR	ON	2018/10/02 15:49
S472	1	"20040003398"	US-PGPUB; USPAT	OR	ON	2018/10/09 10:11
S473	1	"20040003398" and sequenc$5	US-PGPUB; USPAT	OR	ON	2018/10/09 18:27
S474	0	"20010042249" and intervention	US-PGPUB; USPAT	OR	ON	2018/10/09 19:57
S475	0	"20010042249" and intervention	US-PGPUB; USPAT	OR	ON	2018/10/09 19:57
S476	1	"20040003398"	US-PGPUB; USPAT	OR	ON	2020/11/05 13:59
S477	16	"2004003879"	US-PGPUB; USPAT; EPO; DERWENT	OR	ON	2020/11/05 14:08
S478	2	((media adj player) media-player real-player (real adj player)) same intersplicer	US-PGPUB; USPAT; EPO; DERWENT	OR	ON	2020/11/05 14:10
S479	2	intersplicer	US-PGPUB; USPAT; EPO; DERWENT	OR	ON	2020/11/05 14:10
S480	24	intersplicing	US-PGPUB; USPAT; EPO; DERWENT	OR	ON	2020/11/05 14:12
S481	2,986	splic$5 same (media multimedia multi-media music audio video) and adverti$9	US-PGPUB; USPAT; EPO; DERWENT	OR	ON	2020/11/05 14:14
S482	613	splic$5 same (media multimedia multi-media music audio video) same adverti$9 same (play$5 display$5 arrang$6)	US-PGPUB; USPAT; EPO; DERWENT	OR	ON	2020/11/05 14:15
S483	332	splic$5 same (media multimedia multi-media music audio video) same	US-PGPUB; USPAT;	OR	ON	2020/11/05 14:15

		adverti$9 same (play$5 display$5 arrang$6) same insert$6	EPO; DERWENT			
S484	43	splic$5 same (media multimedia multi-media music audio video) same adverti$9 same (play$5 display$5 arrang$6) same insert$6 same player	US-PGPUB; USPAT; EPO; DERWENT	OR	ON	2020/11/05 14:16
S485	323	splic$5 same (media multimedia multi-media music audio video) same adverti$9 same (play$5 display$5 arrang$6) same insert$6	US-PGPUB; USPAT	OR	ON	2020/11/05 14:17
S486	575	splic$5 same (media multimedia multi-media music audio video) same adverti$9 same (play$5 display$5 arrang$6)	US-PGPUB; USPAT	OR	ON	2020/11/05 14:24
S487	252	S486 not S485	US-PGPUB; USPAT	OR	ON	2020/11/05 14:25
S488	362	splic$5 same (media multimedia multi-media music audio video) same player	US-PGPUB; USPAT	OR	ON	2020/11/05 14:28
S489	313	S488 not S485	US-PGPUB; USPAT	OR	ON	2020/11/05 14:28
S490	103	S489 and (commercial marketing adverti$7) same (insert$5 splicing)	US-PGPUB; USPAT	OR	ON	2020/11/05 14:30
S491	1,210	splicer same (media multimedia multi-media music audio video)	US-PGPUB; USPAT	OR	ON	2020/11/05 14:33
S492	374	splicer same (media multimedia multi-media music audio video) same (commercial marketing adverti$8)	US-PGPUB; USPAT	OR	ON	2020/11/05 14:33
S493	47	splicer same (media multimedia multi-media music audio video) same (commercial marketing adverti$8) same sequenc$5	US-PGPUB; USPAT	OR	ON	2020/11/05 14:34
S494	1	"20040003398" and (splic$5 intersplicer)	US-PGPUB; USPAT	OR	ON	2020/11/05 17:52
S495	1	"20040003398" and (splic$5 intersplicer) same sequenc$6	US-PGPUB; USPAT	OR	ON	2020/11/05 17:55
S496	1	"20040003398" and (splic$5 intersplicer) same sequenc$6 and application	US-PGPUB; USPAT	OR	ON	2020/11/05 17:56
S497	1	"20040003398" and sequenc$6	US-PGPUB; USPAT	OR	ON	2020/11/05 17:59

11/6/2020 9:47:01 AM
C:\Users\yretta\Documents\EAST\Workspaces\10606729.wsp

To: IPDocketingBOS@mintz.com,IPFileroombos@mintz.com,mintzdocketing@cpaglobal.com
From: PAIR_eOfficeAction@uspto.gov
Cc: PAIR_eOfficeAction@uspto.gov
Subject: Private PAIR Correspondence Notification for Customer Number 64046

Nov 10, 2020 03:57:33 AM

Dear PAIR Customer:

Mintz Levin/San Diego Office
One Financial Center
Boston, MA 02111
UNITED STATES

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Application	Document	Mailroom Date	Attorney Docket No.
10606729	EXIN	11/10/2020	42327-501001US
	INTV.SUM.APP	11/10/2020	42327-501001US

To view your correspondence online or update your email addresses, please visit us anytime at https://sportal.uspto.gov/secure/myportal/privatepair.

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PATENT APPLICATION INFORMATION RETRIEVAL SYSTEM

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USPTO Automated Interview Request (AIR)

Nov 13 2020

This paper requesting to schedule and/or conduct an interview is appropriate because:

This submission is requested to be accepted as an authorization for this interview to communicate via the internet. Recognizing that Internet communications are not secure, I hereby authorize the USPTO to communicate with the undersigned concerning scheduling of the interview via video conference, instant messaging, or electronic mail, and to conduct the interview in accordance with office practice including video conferencing.

Name(s):
F. Jason Far-hadian

S-signature:
/FJF/

Registration Number:
42523

U.S. Application Number:
10606729

Confirmation Number:
5831

E-mail Address:
fjfar-hadian@mintz.com

Phone Number:
+1 858.314.2144

Proposed Time of Interview:
12-3-2020 2:30 PM ET

Prefered Interview Type:
Video Conference

I am the applicant or applicant's representative for this application.

Topic for Discussion:
Discuss pending rejections with SPE Stamber & possible amendments towards allowance - PLEASE CONFIRM OR PROPOSE NEW DATE AND TIME BY REPLY EMAIL. Thank you.

uspto UNITED STATES PATENT AND TRADEMARK OFFICE

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Subject: Private PAIR Correspondence Notification for Customer Number 64046

Nov 13, 2020 03:51:58 AM

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Application	Document	Mailroom Date	Attorney Docket No.
10606729	CTNF	11/13/2020	42327-501001US
	892	11/13/2020	42327-501001US

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,729	06/26/2003	Philip M. Donian	42327-501001US	5831

64046 7590 01/27/2021

Mintz Levin/San Diego Office
One Financial Center
Boston, MA 02111

EXAMINER	
RETTA, YEHDEGA	

ART UNIT	PAPER NUMBER
3688	

NOTIFICATION DATE	DELIVERY MODE
01/27/2021	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPDocketingBOS@mintz.com
IPFileroombos@mintz.com
mintzdocketing@cpaglobal.com

Applicant-Initiated Interview Summary	**Application No.** 10/606,729	**Applicant(s)** Donian et al.		
	Examiner YEHDEGA RETTA	**Art Unit** 3688	**AIA (First Inventor to File) Status** No	**Page** 1 of 1

All Participants (applicant, applicants representative, PTO personnel)	**Title**	**Type**
YEHDEGA RETTA	Primary Examiner	Telephonic
KAMBIZ ABDI	SPE	
JASON FAR-HADIAN	Attorney	

Date of Interview: 21 January 2021

Issues Discussed:

35 U.S.C. 101

Applicant discussed the claimed invention and provided a proposed amendment. The claim was evaluated in view of the 101 issue. Examiner indicated, as claimed, the claimed language would not overcome the 101 rejection but no agreement was reached

/YEHDEGA RETTA/ Primary Examiner, Art Unit 3688	

Applicant is reminded that a complete written statement as to the substance of the interview must be made of record in the application file. It is the applicants responsibility to provide the written statement, unless the interview was initiated by the Examiner and the Examiner has indicated that a written summary will be provided. See MPEP 713.04
Please further see:
MPEP 713.04
Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews, paragraph (b)
37 CFR § 1.2 Business to be transacted in writing

Applicant recordation instructions: The formal written reply to the last Office action must include the substance of the interview. (See MPEP section 713.04). If a reply to the last Office action has already been filed, applicant is given a non-extendable period of the longer of one month or thirty days from this interview date, or the mailing date of this interview summary form, whichever is later, to file a statement of the substance of the interview.

Examiner recordation instructions: Examiners must summarize the substance of any interview of record. A complete and proper recordation of the substance of an interview should include the items listed in MPEP 713.04 for complete and proper recordation including the identification of the general thrust of each argument or issue discussed, a general indication of any other pertinent matters discussed regarding patentability and the general results or outcome of the interview, to include an indication as to whether or not agreement was reached on the issues raised.

To: IPDocketingBOS@mintz.com,IPFileroombos@mintz.com,mintzdocketing@cpaglobal.com
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Cc: PAIR_eOfficeAction@uspto.gov
Subject: Private PAIR Correspondence Notification for Customer Number 64046

Jan 27, 2021 04:25:52 AM

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Application	Document	Mailroom Date	Attorney Docket No.
10606729	EXIN	01/27/2021	42327-501001US

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Thank you for prompt attention to this notice,

UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION INFORMATION RETRIEVAL SYSTEM

Attorney's Docket No.: 42327-501001US
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Philip M. Donian, *et al.*

Application No.: 10/606,729 Confirmation No.: 5831

Filed: June 26, 2003 Art Unit: 3688

For: METHOD AND APPARATUS FOR THE FREE LICENSING OF DIGITAL MEDIA CONTENT Examiner: Yehdega Retta

AMENDMENT IN REPLY TO NON-FINAL OFFICE ACTION

FILED VIA EFS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madam:

This reply is responsive to the Non-Final Office Action mailed on November 13, 2020 in the above-reference matter (hereinafter "the Office Action").

The Applicant is a micro entity and has been granted prioritized examination of this application under Track One pursuant to 37 CFR 1.102(e)(2).

The consideration of the amended claims and the remarks provided below are respectfully requested, as they place the application in condition for allowance or better form for appeal.

Electronic Acknowledgement Receipt	
EFS ID:	41939683
Application Number:	10606729
International Application Number:	
Confirmation Number:	5831
Title of Invention:	Method and apparatus for the free licensing of digital media content
First Named Inventor/Applicant Name:	Philip M. Donian
Customer Number:	64046
Filer:	Mark D. Hammond/Jeremy Johnston
Filer Authorized By:	Mark D. Hammond
Attorney Docket Number:	42327-501001US
Receipt Date:	16-FEB-2021
Filing Date:	26-JUN-2003
Time Stamp:	23:56:08
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1		042327-501001US-Response-v2.pdf	433198 49eb3ee550b3d31df1e4e3523536ade0a422838a	yes	49

	Multipart Description/PDF files in .zip description		
	Document Description	**Start**	**End**
	Applicant Arguments/Remarks Made in an Amendment	16	49
	Claims	4	15
	Applicant summary of interview with examiner	2	3
	Amendment/Req. Reconsideration-After Non-Final Reject	1	1
Warnings:			
Information:			
	Total Files Size (in bytes):	433198	

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

II. REMARKS

After entering the above amendments, claims 212, 214, 221, 225-230, 233, 237-238, 240-243, 267, and 274-279 will be pending. Reconsideration and allowance of the current Application are requested in light of the above-marked amendments and the following remarks.

Summary of Rejections. The Office has rejected claims 212, 214-223, 225-231, 233-238, 240-243, 267, and 274 under 35 U.S.C. §101, because the Office alleges that the claims are drawn to unpatentable subject matter; claims 212, 214-223, 225-231, 233-238, 240-243, 267 and 274 under 35 U.S.C. §112, second paragraph as allegedly failing to clearly and distinctly recite what the inventor considers to be the invention.

Summary of Amendments. With this amendment, claims 212, 214, 221, 225-230, 233, 237-238, 240-243, 267, and 274 are amended, claims 215-220, 222-224, 231, and 234-236 are canceled, and new claims 275-279 are added. The amendments and new claims are fully supported by the original specification and the claims previously pending in the application. No new matter is added with this amendment.

Request for Interview. The amendments/arguments presented herein are believed to be sufficient to overcome the pending rejections. However, if the contents of this paper are not deemed sufficient to further prosecution in this matter, or if any issues arise that can be most efficiently handled by telephone, the Examiner is respectfully requested to contact the undersigned by either phone or e-mail to schedule an interview at a mutually convenient time.

Hulu, LLC - Ex. 1006, Page 001004

Procedural History

USPTO is "to foster innovation, competitiveness and economic growth, domestically and abroad, by providing high quality and timely examination of patent and trademark applications." https://www.commerce.gov/bureaus-and-offices/uspto. A review of the prosecution history of the present application reveals that the examination of this Application does not comport with the USPTO's self-proclaimed mission.

First, the Office has failed to timely examine this Application. Following its filing on **June 23, 2003**, the Office took over five years to substantively review the Application. Not until October 3, 2008 was the first office action issued on the merits. From there, the Application was further ignored and was not subject to timely examination.

For example, following the filing of a request for continued examination on **March 14, 2011**, the examination of the Application was improperly delayed for over two years until a non-final rejection issued on **August 20, 2013**. This resulted in a two-year gap in prosecution of the Application by the Office between 2011 and 2013.

It is noteworthy that the Application has now been pending for over **18 years**, despite the Applicant's consistent and timely efforts to advance prosecution.

As to the quality of the examination, it should be also noted that the Application was rejected consistently for several years by the same cited reference as being anticipated under § 102, despite numerous claim amendments and arguments, which clearly established the § 102 reference did not teach all the recited elements. The Applicants position was later confirmed by the United States Patent Trial and Appeal Board.

Furthermore, the Application has been subject to piecemeal prosecution, improperly dragging out the examination time and increasing Applicant's costs. For example, additional grounds of rejection under §101 were not initially presented, but were introduced for the very first time in an Examiner's answer on August 28, 2015 over 12 years after the filing of the Application.

Most troublesome is the fact that the Application was prematurely and improperly **abandoned** by the examiner on December 11, 2017. This abandonment was vacated by the Director, noting that the Abandonment was improper and premature.

Rejections under 35 U.S.C. §112(b), Second Paragraph

Claims 212, 214-223, 225-231, 233-238, 240-243, 267 and 274 stand rejected under 35 U.S.C. §112(b) because the Office alleges that the claims fail to clearly delineate the subject matter that the Inventor(s) intend to claim.

The office alleges the term "user-perceptible" content stream in claims 212, 238, 243, and 267 is a relative term which renders the claim indefinite. The Applicant disagrees with this contention, but to advance prosecution has amended the claims.

Withdrawal of the pending rejection under 35 U.S.C. §112(a) is respectfully requested.

Rejections under 35 U.S.C §101

Claims 212, 214-223, 225-231, 233-238, 240-243, and 267 and 274 stand rejected under 35 U.S.C. §101, because the Office alleges that the claims are drawn to unpatentable subject matter. These rejections are respectfully traversed.

For at least these reasons, withdrawal of the pending rejection under 35 U.S.C. §101 is respectfully requested.

1. The Office Action Fails to Establish a Prima Facie Case:

The Office Action alleges the claimed process is directed to "mental process" and is therefore an abstract idea. *Office Action 2*. The Office Action further seems to allege there are no claim elements that amount to significantly more than the judicial exception and that the abstract idea is not integrated into a "practical application." *Id. 3.*

Hulu, LLC - Ex. 1006, Page 001006

Applicant respectfully submits that the Office Action fails to establish a prima facie case. Aside from the above conclusory statements, the Office Action does not provide any additional analysis that, in a meaningful manner, considers the detailed claim elements. The Office Action seems to generally categorize the claimed subject matter as abstract, but fails to provide any analysis as to why the claimed combination of elements is directed to a mental process, nor is there any support why the claimed subject matter has no practical application. The Office Action unreasonably and improperly characterizes the claimed subject matter as "a mental process" without due consideration of the claim language and recent USPTO Guidance. Respectfully, a cursory analysis such as that interposed in the Office Action does not comply with MPEP guidelines requiring that the claimed subject matter be compared to concepts already found to be abstract in the body of case law precedent.[1]

A proper characterization of the claimed subject matter is integral to the comparison of the claimed subject matter to concepts found to be abstract by the courts. To that end, the courts have repeatedly admonished against oversimplification and overgeneralization of the claimed subject matter. As the *Alice*[2] decision points out, "at some level, all inventions … embody, use, reflect, rest upon or apply laws of nature, natural phenomena, or abstract ideas." Additionally, USPTO Guidance prohibits overgeneralization.[3]

Here, instead of providing a rational underpinning or reasoning, the Office Action simply repeats the claim language and makes the above conclusory statements. The Office Action neither cites to any case law that is relevant, nor does it provide any detailed analysis of how the well-drafted technical features are abstract. Unfortunately, the Office Action essentially ignores all the particularly recited elements and relationships and simply concludes that the claimed subject matter is directed to an abstract idea. This lack of analysis is untenable and fails to establish a prima facie case under § 101.

---

1 MPEP 2106.04(a)
2 *Alice Corp. Pty. Ltd. v. CLS Bank Intern.*, 134 S. Ct. 2347
3 USPTO November 2016 memorandum for *Recent Subject Matter Eligibility Decisions* ("*November 2016 Memo*")

The Office Action also fails to recognize the technology-based solution set forth in claim 212 for addressing the technical problems of "adaptively regroup and re-sequence the insertion of ad blocks extemporaneously (i.e. "on the fly"), in response to the consumer's arbitrary direction of the playback within the requested content, by means of playback controls." (*Specification*, 0117) This innovative feature solves the problem associated with a user bypassing sponsored content using the playback controls, while allowing the user some level of freedom to fast forward or reverse or rearrange playback without completely circumventing the sponsored media.

The device of claim 212 captures this inventive concept by reciting: "the one or more alternatively sequenced insertion points being adaptively selectable by the intersplicer according to selection criteria defined by the one or more adaptive preference rules taking into account the new play position and at least one of a length of time associated with playing the digital media content, a number of digital media data blocks of the digital media content to be played, and a point in time the digital media content is to be played." The Office Action seems to allege the claimed method is performable in the human mind. The claimed subject matter is, however, tied to a computer-implemented process that cannot be possibly performed in human mind, or using a pencil and paper.

Respectfully, an assertion that the claimed media player device and the functionalities recited in detail in the pending claims can be performed using pen and paper is not sensible. The examiner's reasoning seems to be that as long as she can write down the claimed subject matter on paper using a pen, then the idea is abstract. This is not a reasonable position because it would render all inventions patent-ineligible. Examiner's position is also not supported by any judicial decisions nor is it contemplated in any portion of the MPEP or Office guidance. The judicial cases that refer to mental process and pen and paper are exclusively related to claims directed to mathematical algorithms used in performing financial transactions.

In contrast, there is nothing in the pending claims that is related to financial transactions or mathematical concepts. The examiner is respectfully requested to provide a fair and detailed analysis of the asserted grounds of rejection by citing to judicial cases that support her position or

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otherwise withdraw the § 101 grounds of rejection.

In contrast to the Office's allegations of the claims reciting steps performable in the human mind, the claimed subject matter is intricately tied to computer processing by disabling user interface commands at a digital media player system during a play period and using an intersplicer to order data blocks of the digital media content and the digital advertising content. The intersplicer directly improves the functionality and processing of the digital media player system, which results in increased control over the insertion of digital advertising data blocks into the digital media content. This particular process allows computer performance of a function not previously performable by a computer (e.g., disabling user interface commands at a digital media player system during a play period), as evidenced by the claimed subject matter being new and inventive under 35 U.S.C. §102 and §103.

The Office Action contends:

more. The claimed invention is directed to sequencing, re-sequencing or modifying (changing) the presentational position of advertisement in a media player. The claims recite receiving media content, sequencing media content, modifying presentation position, causing presentation, keeping a setting, disabling user interface and storing presentation data. The limitation of receiving, creating (recommending), covers a mental process. That is, other than reciting a

This contention is incorrect. There is nothing in the Office Action that includes any analysis how or why the claimed subject matter is directed to an Abstract Idea. Furthermore, the Office Action does not include any analysis regarding the technical improvements to a computer (e.g., disabling user interface commands at a digital media player system during a play period) recited in the claims. The examiner has simply copied and pasted language from the claims followed by some boilerplate language that lacks any analysis. The grounds of rejection are basically a conclusory statement. There is no analysis why the claimed subject matter is abstract, other than the examiner concluding it is. Conclusory examiner remarks do not establish a prima facie case and do not shift the burden to the Applicant.

The Office Action also contends:

reasonable interpretation, the limitations of claim 212 recite a method for sequencing digital media and advertising content to prevent commercial skipping by receiving, organizing, re-organizing, displaying, and storing data and controlling access based on the stored data.8 This is an abstract idea comprising "[mental processes—concepts performed in the human mind (including an observation, evaluation, judgment, opinion)" and a "[certain method[] of organizing human activity— . . . commercial or legal interactions (including agreements in the form of contracts; legal obligations; advertising, marketing or sales activities or behaviors; business relations)."

At the outset, it is noted that the pending claims do not recited commercial or legal interactions. For this reason alone, the § 101 grounds of rejection is flawed as it unfairly and improperly construes the claim language to fall in a context that is clearly a fallacy and untrue. The Examiner is requested to point to portions of the claim that explicitly recite a commercial or legal transaction or otherwise withdraw the § 101 grounds of rejection.

Further, the contention that this is a certain method of organizing human activity is also incorrect. The Office Action alleges the method is "for sequencing digital media and advertising content to prevent commercial skipping." But listing a potential market for the subject matter does not constitute a certain method of organizing human activity. There is nothing in the Office Action that includes any analysis how or why the claimed subject matter, including the recited details about the improvements to the computer and the claimed graphical user interface, are directed to a method of organizing human activity. The examiner has simply picked portions of the claim language, copied and pasted that language from the claims followed by more boilerplate language that lacks any analysis. Again, the grounds of rejection are basically a conclusory statement that in examiner's opinion some selected portion of the claimed subject matter falls within "Methods of Organizing Human Activity", but the examiner has failed to provide any analysis why that is the case.

The examiner has conveniently skipped over portions of the claims that recite

improvements to the computer, such as "[an] intersplicer configured to control one or more insertion points of the digital advertising content into the digital media content" and "disabling user interface commands comprising at least one of a user volume control or a user navigation control." Unfortunately, again, there is no analysis whatsoever why the claimed subject matter is not eligible under § 101, other than the examiner's conclusory remarks and copy and paste of boilerplate language that selectively repeats portions of the claim related to computer processors which only make up part of the claim. The examiner repeatedly choses to ignore detailed claim language that recites the inventive nature of the claimed subject matter and simply concludes that the entire claim is directed to an abstract idea. Conclusory examiner remarks do not establish a prima facie case and do not shift the burden to the Applicant.

Because the Office Action is deficient in properly setting forth grounds of rejection as required under the Office Guidance as well as under the provisions of the Berkheimer and Alice decisions (as provide in further detail below), the examiner has failed to establish a prima facie case -- the burden cannot be shifted to the Applicant to disprove a negative assertion with no basis in law or Office guidance. It is therefore respectfully requested that the § 101 grounds of rejection be withdrawn.

The Office Action contends:

> environment or field of use (e.g., computers). The additional elements represent either a generic computer or steps that are normally performed by a generic computer including the steps of allowing the user to control presentation and insertion of advertising content. Accordingly, those steps are well-understood, routine and conventional because those steps are computer operations found in any computer system. Specifically there is no improvement to the functioning of the

The Examiner misunderstands the technical solution of the claim. The Examiner states that "the additional elements represent either a generic computer or steps that are normally performed by a generic computer including the *steps of allowing the user to control presentation and insertion of advertising content* (emphasis added)." The technical solution of the claims is a far cry from "allowing the user to control presentation."

Here, using the adaptively modifying features, the claimed device *controls* the real-world experience for an end user by adaptively selecting alternative sequenced insertion points for presenting the data blocks of the digital media content and the digital advertising content. For example, the intersplicer can "according to selection criteria defined by the one or more adaptive preference rules taking into account the new play position and at least one of a length of time associated with playing the digital media content, a number of digital media data blocks of the digital media content to be played, and a point in time the digital media content is to be played." Accordingly, the intersplicer may determine when the navigational controls of the digital media content player system are disabled. *See Specification*, 0052. Disabling such navigational controls prevents the consumer from skipping through the promotional material or lowering the sound volume beneath a predetermined threshold level. *Specification*, 0057. Therefore, claim 212 embodies a specific combination of features that controls the presentation of advertising content rather than allowing a user to control presentation. As such, the Office Action erred in concluding that claim 212 is directed to a generic computer including the steps of allowing the user to control presentation and insertion of advertising content.

The Office Action contends:

> additional element of a digital media player. The media player is claimed and described in the specification at a high level of generality, which at best amounts to mere instruction to implement an abstract idea on a generic computer, or merely uses a generic computer as a tool to perform the abstract idea (see Applicant's specification [0040]-[0048], [0083]-[0089]). The steps of receiving, sequencing (re-sequencing modifying or changing) presentation, keeping a setting, disabling and storing are considered generic computer (media player) functions and the combination of the additional elements simply limits the use of the abstract idea to one particular environment or field of use (e.g., computers). The additional elements represent either a generic

In response to the Office Action's argument that claim 212 is abstract for merely using a

computer as a tool and for failing to improve technology (*See Office Action*, 3), a recent decision by the Federal Circuit provides critical insight. In *EcoServices, LLC v. Certified Aviation Serv., LLC*,[4] the Federal Circuit ruled in favor of the patentee, holding that the claim in dispute was not directed to an abstract idea. The Court determined that the claimed subject matter was directed to a specific system that improves jet engine washing because it was for *a specific solution* for accomplishing jet engine washing rather than merely claiming a desired result of automated jet engine washing.[5]

The Court considered whether the "claims simply use a computer as a tool to automate conventional activity" in the context of *Alice* step one, and compared the claims to *McRO*, which employed a computer "to perform a distinct process to automate a task previously performed by humans" to reach the conclusion that the disputed claim language was directed to *a specific combination* of a type of washing unit, information detector, and control unit, configured in a certain way to create technical improvements to systems for washing jet engines.[6]

Similar to *EcoServices*, the pending claims are directed to a specific combination of features configured to improve the functionality of conventional digital media player systems. The specific combination of features includes intersplicers, a digital media player system, a user interface, user navigation control, and the sequencing of digital media content and digital advertising content. The combination of elements can be found in, for example, Claim 212. Claim 212 embodies a specific combination of features by using the intersplicer that "adaptively select[s] and re-sequence[s] the ads to be shown in response to the user's navigational actions throughout the content" and "disabl[es] certain user playback controls while the ads are running." *See Specification*, ¶0057, 0117. The device of claim 212 captures this unique combination of elements by reciting: "the one or more alternatively sequenced insertion points being adaptively selectable by the intersplicer according to selection criteria defined by the one or more adaptive preference rules taking into account the new play position and at least one of a length of time associated with playing the digital media content, a number of digital media data blocks of the digital media

[4] *EcoServices*, No. 19-1602 (Fed. Cir. 2020)
[5] *Id.* at 15-19.
[6] *Id.* at 16-17.

content to be played, and a point in time the digital media content is to be played," and "responsive to detecting the first value in the first memory, the user interface input is disabled to prevent commands comprising at least one of a user volume control or a user navigation control from altering a course of presentation."

Using the adaptively modifying features, the claimed device controls the real-world experience for an end user by adaptively selecting alternative sequenced insertion points for presenting the data blocks of the digital media content and the digital advertising content. For example, the intersplicer can "adaptively select according to selection criteria defined by the one or more adaptive preference rules taking into account the new play position and at least one of a length of time associated with playing the digital media content, a number of digital media data blocks of the digital media content to be played, and a point in time the digital media content is to be played." Accordingly, the intersplicer may determine when the navigational controls of the digital media content player system are disabled. *See Specification*, 0052. Disabling such navigational controls prevents the consumer from skipping through the promotional material or lowering the sound volume beneath a predetermined threshold level. *Specification*, 0057. Therefore, claim 212 embodies a specific combination of features for at least improving functionality of the conventional digital media player devices. As such, the Office Action erred in concluding that claim 212 is directed to an abstract idea.

The pending Office Action alleges "the focus of the claims is not on such an improvement in computers as tools, but on certain independently abstract ideas that use computers as tools." (*Office Action,* 3). The Court in *EcoServices* warned against assuming a claimed system is necessarily directed to an abstract idea for merely achieving automation of a task previously performed by humans. That is, the Court concluded that using a computer as a tool to automate prior art or conventional systems can fall within the purview of § 101 to define patent-eligible subject matter when, as here, the new technology results in improvements to the older technology. The specific combination of features such as intersplicers, a digital media player system, a user interface, user navigation control, and the sequencing of digital media content and digital advertising content is sufficiently specific to integrate the claimed subject matter into a practical application. Accordingly, the Office Action erred in concluding that claim 212 is directed to an

abstract idea by merely alleging the computer is used as a tool.

The Office Action has not responded to above-noted Applicant arguments and therefore both are deficient and constitute examiner error. Also for this reason, the examiner is requested to withdraw the § 101 grounds of rejection or otherwise properly consider the Applicant's arguments and respond without relying on conclusory remarks and statements or copying and pasting from the claims and simply concluding that the pending claims are directed to an abstract idea or routine and conventional subject matter, while ignoring the detailed claim recitations.

The § 101 grounds of rejection seem to be supported by the examiner's own knowledge as the Office Action provides no evidence why the combination of claimed elements is abstract. Respectfully, in view of the fact that there are no art-based rejections that teach or suggest the claimed combination, an assertion that the claimed features lack inventive concept is unreasonable and without merit. Pursuant to MPEP §2144.03, if the examiner is relying on his personal knowledge to establish a prima facie case for rejecting the claims under § 101, it is respectfully requested for the examiner to provide supportive evidence in the form of a signed affidavit or citing a relevant reference.[7] Otherwise, the § 101 grounds of rejection should be withdrawn.

Particularly, in view of the fact that there are no art-based rejections that teach or suggest the claimed combination, Office's assertion that the claimed features are abstract and do not provide significantly more than an abstract idea is respectfully traversed. Unless the Office can provide evidentiary support that each and every one of the above explicitly recited elements, relationships and combinations are routine and conventional, the purported analysis is defective and § 101 grounds of rejection should be withdrawn.

Accordingly, the Office Action fails to establish the prima facie case for non-patentable subject matter.

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[7] "The rationale supporting … a rejection may be based on common knowledge in the art or "well-known" prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner." Also see USPTO memorandum dated April 19, 2018, from Robert W. Bahr ("April 19, 2018 Memo").

2. The Claimed Subject Matter Is Integrated Into a Practical Application

Referring to Director Iancu's Jan. 7, 2019 Patent Eligibility Guidance (PEG), a claimed subject matter is patent-eligible, if the recited functions and relationships, in combination with all the other recited elements, have a ***practical application***, even if the claimed subject matter *involves* or *utilizes* a mental process.

It is irrefutable that the claimed processes have a practical application in the technological field of digital media player systems. The claimed processes enable the functionality of disabling user interface commands at a digital media player system during a play period and using an intersplicer to adaptively order data blocks of the digital media content and the digital advertising content. Claim 212 embodies a practical application by using the intersplicer that "adaptively select[s] and re-sequence[s] the ads to be shown in response to the user's navigational actions throughout the content" and "disabl[es] certain user playback controls while the ads are running." *See Specification*, ¶0057, 0117. Using the intersplicer features, the claimed system controls the real-world experience for an end user by sequencing the data blocks of the digital media content and the digital advertising content.

For example, the intersplicer can determine when advertisement data blocks are inserted into the sequence of data blocks of the media content. Accordingly, the intersplicer may determine when the navigational controls of the digital media content player system are disabled. *See Specification*, 0052. Disabling such navigational controls prevents the consumer from skipping through the promotional material or lowering the sound volume beneath a predetermined threshold level. *Specification*, 0057.

The fact that the particular practical applications recited in the claims are related to commercial skipping of advertisements should not summarily subject the claims to what amounts to be a discriminatory application of the § 101 based on a blanket allegation that the claims are abstract. Further, other than conclusory statements by the examiner, there is no factual or legal analysis (e.g., case law) cited in the Office Action to support a conclusion that the claims are abstract.

Any of the following claim aspects may be relied on to show that a claimed process has a practical application:

(1) the claimed process helps improve a technological field,[8]

(2) the claimed process is applied with, or by use of, a particular machine,[9]

(3) the claimed process effects a transformation or reduction of a particular article to a different state or thing,[10]

(4) the claimed process adds specific limitations, other than what is well-understood, routine, conventional activity in the field,[11] or

(5) the claimed process is applied or used in a meaningful way to a particular technological environment without monopolization (i.e., preemption) of the entire field.[12]

Pursuant to MPEP 2106.05(a), claim 212 recites a computer-implemented process that has a practical application in disabling user interface commands at a digital media player system during a play period and using an intersplicer to order data blocks of the digital media content and the digital advertising content. Furthermore, the intersplicer described in claim 212 improves computing resource management (e.g., a user interface output for causing presentation such that a part of the digital advertising content is adaptively played at the one or more alternatively sequenced insertion points instead of the one or more initially sequenced insertion points). In comparison to conventional methods, the intersplicer enables the digital media player system to "adaptively regroup and re-sequence the insertion of ad blocks extemporaneously (i.e. "on the fly"), in response to the consumer's arbitrary direction of the playback within the requested content," which was not technologically achievable for media presentation in the past. *See Specification*, p. 0057, 0117.

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[8] MPEP 2106.05(a).
[9] MPEP 2106.05(b).
[10] MPEP 2106.05(c).
[11] MPEP 2106.05(d).
[12] MPEP 2106.05(e).

Accordingly, the particularly recited arranged combination of elements and functions in claim 212 is directed to a method that improves digital media player system technologies (i.e., *improves a technological field*) by "adaptively select[ing] and re-sequence[ing] the ads to be shown in response to the user's navigational actions throughout the content" and "disabling certain user playback controls while the ads are running." *See Specification*, ¶0057, 0117.

Pursuant to MPEP 2106.05(b), the claimed process is applied with, or by use of, a particular machine, which requires the specifically claimed functional and structural implementations. The Applicant's Specification clearly provides, and the claims definitively recite, an improvement to a technological implementation rooted in computing technology, by using an intersplicer sequencing data blocks of the digital media content and the digital advertising content. Based on the type of data blocks, the digital media player system may disable user interface commands during a play period in response to detecting a first value in a first memory.

Pursuant to MPEP 2106.05(d), as clear from the lack of any art-based rejections, the claimed process also adds specific limitations, other than what is well-understood, routine, or conventional activity in the recited technological field. The claimed features and functionalities "adaptively selecting and re-sequencing the ads to be shown in response to the user's navigational actions throughout the content" and "disabling certain user playback controls while the ads are running." *See Specification*, ¶0057, 0117. This inventive concept is not intuitive because a digital media player system has traditionally been unable to adaptively select and re-sequence the ads to be shown in response to the user's navigational actions throughout the content, let alone allowing a user to navigate ad supported content in the first place. *Specification*, 0057, 0117.

Finally, pursuant to MPEP 2106.05(e), the claimed process is applied or used in a meaningful way to a particular technological device and environment (e.g., a digital media player device that adaptively selects and plays digital advertising content at the alternatively sequenced insertion points) without monopolization of the entire field. The particularly recited processes and functionality lead to the practical results of optimizing and simplifying the related technical field, and do not pre-empt the entire computerized digital media presentation or advertising landscape.

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Moreover, the current subject matter, as recited in claim 212 correlates with **Example 39** of the 2019 PEG. In Example 39 of the 2019 PEG, the claims were directed to a method for training a neural network for facial detection. The exemplary claim in Example 39 recited a method comprising:

> collecting a set of digital facial images from a database;
>
> applying one or more transformations to each digital facial image including mirroring, rotating, smoothing, or contrast reduction to create a modified set of digital facial images;
>
> creating a first training set comprising the collected set of digital facial images, the modified set of digital facial images, and a set of digital non-facial images;
>
> training the neural network in a first stage using the first training set;
>
> creating a second training set for second stage of training comprising the first training set in digital non-facial images that are incorrectly detected as facial images after the first stage of training; and
>
> training the neural network in the second stage using the second train set.

In its analysis of the claim, the USPTO determined that the claimant was not directed to a judicial exception enumerated in the 2019 PEG.[13] The USPTO noted, that "the claim does not recite any of the judicial exceptions enumerated in the 2019 PEG. For instance, the claim does not recite any mathematical relationships, formulas, or calculations. While some of the limitations may be based on mathematical concepts, mathematical concepts are not recited in the claims. Further, the claim does not recite a mental process because the steps are not practically performed in the human mind. Finally, the claimant does not recite any method of organizing human activity such as a fundamental economic concept or managing interactions between people.

[13] 2019 PEG at p. 9.

Thus, the claim is eligible because it does not recite a judicial exception. For example, claim 212 does not recite a method of organizing human activity at least because like the claim in Example 39, claim 212 does not recite a fundamental economic concept or a mental process."[14]

The claimed subject matter further recites a high degree of complexity that may only be addressed through use of computing systems and networks, but cannot be performed manually or by simple automation of a manual computation. As such, claim 212 does not recite "a mental process."

Accordingly, claim 212 does not recite any of the judicial exceptions enumerated in the 2019 PEG. For example, the claim does not recite any mathematical relationships, formulas, or calculations. Much like Example 39 of the 2019 guidance, claim 212, does not include any of the judicial exceptions recited under prong one of step 2A.

Even if claim 212 recited a judicial exception under prong one of step 2A, under prong two of the 2019 guidance, claim 212 is integrated into a practical application. The 2019 PEG states "a claim that integrates a judicial exception into a practical application will apply, rely on, or use the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception." *2019 PEG* at p 53.

The claimed subject matter is not designed to monopolize the alleged judicial exception. On the contrary, the claimed subject matter provides a high degree of complexity that may only be addressed through use of computing networks, but cannot be performed manually or by simple automation of a manual computation. The claim as a whole is directed to a particular improvement.

Other independent claims recite features that are substantially the same or similar to claim 212 including processes that have a practical application and outcome and improve a technological field. That is, the claims are directed to a combination of arranged features that recite technical

[14] *Id* at p. 15

implementations and solutions for improving a technology. As such, the claimed inventive concepts directed to a particular computing technology are patent-eligible, as distinguishable from abstract concepts in business, accounting, inventory management or pure financial transactions that, only under specific factual settings, have been deemed patent-ineligible by some courts or panels.

Subject Matter Eligibility Standard

In *Alice v. CLS Bank*, the Supreme Court outlined a two-step analytical framework for analyzing subject matter eligibility under Section 101.[15] Step 1 requires a determination of whether the claim is directed to a process, machine, or composition of matter. In response to step 1 being decided in the affirmative, step 2A (part 1 of the *Mayo* test) requires a determination of whether the claims are directed to a law of nature, a natural phenomenon, or an abstract idea (judicial exceptions). In response to step 2A being decided in the affirmative, step 2B (part 2 of the *Mayo* test) requires a determination of whether the claim recites additional elements that amount to significantly more than the judicial exception.[16]

Subsequent Federal Circuit decisions and USPTO guidance have provided additional guidance on the subject matter eligibility requirement. For example, in *Enfish v. Microsoft*, the Federal Circuit held that a claim directed to a self-referential table was patent-eligible because it was directed to a specific, asserted improvement in computer capabilities.[17] In *BASCOM v. AT&T*, the Federal Circuit held that a claim containing known, conventional pieces was patent-eligible because it provided a non-conventional and non-generic arrangement of those pieces.[18] Further, in *McRO v. Bandai*, the Federal Circuit held that a claim requiring specific rules to render 3-D animations in a specific way was patent-eligible because the use of the rules did not preempt others from rendering 3-D animations using generic rules.[19]

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[15] *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2355 (2014).
[16] *See id.*; 2014 USPTO Interim Guidance on Patent Subject Matter Eligibility (reflected in 79 Fed. Reg. 74,618 et seq. (December 16, 2014)).
[17] *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335-36 (Fed. Cir. 2016).
[18] *BASCOM Global Internet Servs. v. AT&T Mobility LLC*, 827 F.3d 1341, 1350 (Fed. Cir. 2016).
[19] *McRO, Inc. v. Bandai Namco Games Am.*, 837 F.3d 1299, 1315 (Fed. Cir. 2016).

In the 2019 PEG, the USPTO specified that the analysis under step 2A involves a two-prong approach. Prong One: evaluate whether a claim recites a judicial exception including identifying specific limitation(s) that are believed to recite an abstract idea and determining whether the identified limitation(s) fall within an enumerated abstract idea grouping. The enumerated abstract groupings include: a) mathematical concepts, b) certain methods of organizing human activity, and c) mental processes. Under Prong Two: evaluate whether the claim integrates the judicial exception into a practical application. *2019 PEG*, p. 52-53. As applied to the instant application, claim 212 is directed toward new and useful processes, machines, and/or improvements thereof. *See* 35 U.S.C §101. Thus, claim 212 complies with step 1 of the *Alice/Mayo* test.

Step 2A – Prong 1: the pending claims do not recite an abstract idea because they are inextricably tied to computer technology and distinct from the types of concepts found by the courts to be abstract.

The MPEP requires the Examiner to identify abstract ideas by comparing the claimed subject matter to concepts already found to be abstract in the body of case law precedent.[20] The abstract idea inquiry in the two-part *Mayo*[21] framework requires a proper construction of the claimed subject matter. The USPTO released 2019 revised patent subject matter eligibility guidance in January 2019 (2019 PEG) and a patent eligibility guidance update in October 2019 (2019 PEG Update). In the guidance, the USPTO specified that the analysis under step 2A involves a two-prong approach.

Prong One: evaluate whether a claim recites a judicial exception including identifying specific limitation(s) that are believed to recite an abstract idea and determining whether the identified limitation(s) fall within an enumerated abstract idea grouping. The enumerated abstract groupings include: a) mathematical concepts, b) certain methods of organizing human activity,

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[20] MPEP 2106.04(a)

[21] *Mayo v. Prometheus*, 132 S. Ct. 1289 (2012)

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and c) mental processes. Under Prong Two: evaluate whether the claim integrates the judicial exception into a practical application. 2019 revised patent subject matter eligibility guidance (2019 PEG), p. 52-53.

As further explained below, the amended claims are not directed towards "mental processes" and "certain methods of organizing human activity" groupings, as alleged by the Office. *Decision on Appeal*, p. 15-16.

A correct characterization of the claimed subject matter is integral to the comparison of the claimed subject matter to concepts found to be abstract by the courts. To that end, the courts have repeatedly admonished against oversimplification and overgeneralization of the claimed subject matter. As the *Alice*[22] decision points out, "at some level, all inventions … embody, use, reflect, rest upon or apply laws of nature, natural phenomena, or abstract ideas." Additionally, USPTO Guidance prohibits overgeneralization.[23]

Here, the Office failed to recognize the technology-based solution set forth in claim 212 for addressing the technical problems of "adaptively regroup and re-sequence the insertion of ad blocks extemporaneously (i.e. "on the fly"), in response to the consumer's arbitrary direction of the playback within the requested content, by means of playback controls." *See Specification*, ¶0117. In contrast to the Office's allegations of the claims reciting steps performable in the human mind, the claimed subject matter is intricately tied to computer processing by disabling user interface commands at a digital media player system during a play period and using an intersplicer to order data blocks of the digital media content and the digital advertising content. The intersplicer directly improves the functionality and processing of the digital media player system, which results in increased control over the insertion of digital advertising data blocks into the digital media content. This particular process allows computer performance of a function not previously performable by a computer (e.g., disabling user interface commands at a digital media player system during a play period), as evidenced by the claimed subject matter being new and

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22 *Alice Corp. Pty. Ltd. v. CLS Bank Intern.*, 134 S. Ct. 2347

23 USPTO November 2016 memorandum for *Recent Subject Matter Eligibility Decisions* ("*November 2016 Memo*")

inventive under 35 U.S.C. §102 and §103.

In the Decision on Appeal, the Office contends that the improvement recited by the claims is not tied to computer functionality. The Office reprints portions of the Background in the Specification to suggest that the claim language does not recite an improvement tied to computer functionality, while completely ignoring the remaining portions of the Specification with technical disclosures ties to computing and computing functionality. See *Decision on Appeal*, p. 11-12. It is well known that the Background section is provided for the purpose of generally discussing the problems associated with older technology, as here. Focusing on the disclosure in the Background section as a means to suggest the claimed subject matter is an abstract idea and has no technical character is respectfully disingenuous and misguided, considering the specific technical details disclosed in the remaining portions of the Specification that tie the inventive methods to specific technical details and integrate them into a practical application as provided below.

The Office should identify an **"**improvement in computer-related technology**"** that **"**allow[s] computer performance of a function not previously performable by a computer**"** in conducting an abstract idea analysis.[24] Here, the amended claims improve computer performance not previously performable by using an intersplicer that "adaptively select[s] and re-sequence[s] the ads to be shown in response to the user's navigational actions throughout the content" and "disabl[es] certain user playback controls while the ads are running." *See Specification*, ¶0057, 0117. The ability to "adaptively regroup and re-sequence the insertion of ad blocks extemporaneously (i.e. "on the fly"), in response to the consumer's arbitrary direction of the playback within the requested content" was not technologically achievable for media presentation in the past. The device of claim 212 captures this inventive conceptive by reciting: "the one or more alternatively sequenced insertion points being adaptively selectable by the intersplicer according to selection criteria defined by the one or more adaptive preference rules taking into account the new play position and at least one of a length of time associated with playing the digital media content, a number of digital media data blocks of the digital media content to be played, and a point in time the digital media content is to be played." Thus, the device claim 212 of the current

[24] *November 2016 Memo*, p. 2.

Application includes an inventive concept of a disabled user interface input to prevent commands comprising at least one of a user volume control or a user navigation control from altering a course of presentation and one or more processors to adaptively modify a presentation position of the digital advertising content from an initially sequenced insertion points to one or more alternatively sequenced insertion points.

Mental Processes

The Office Action alleges that the steps of claim 212 fall within the mental process grouping, contending the technology cannot be patentable subject matter because the technology mimics a mental process.

A proper abstract idea inquiry cannot be based on an oversimplification and overgeneralization of the claimed subject matter, which the courts have repeatedly admonished against. As the *Alice*[25] decision points out, "at some level, all inventions … embody, use, reflect, rest upon or apply laws of nature, natural phenomena, or abstract ideas." The Federal Circuit, in its *McRO*[26] decision, cautioned against oversimplifying the claims "by looking at the claims generally and failing to account for the specific requirements of the claims."

Here, the subject matter recited in the amended claims directly improves a digital media player device. The improved digital media player device has one or more processors to adaptively modify a presentation position of the digital advertising content from an initially sequenced insertion points to one or more alternatively sequenced insertion points. Based on the type of data blocks, the digital media player system may disable user interface commands during a play period.

Claim 212 recites steps intricately linked to an improved digital media player device. For example, claim 212 recites "[an] intersplicer configured to control one or more insertion points of the digital advertising content into the digital media content" and "disabling user interface

[25] *Alice Corp. Pty. Ltd. v. CLS Bank Intern.*, 134 S. Ct. 2347
[26] *McRO, Inc. v. Bandai Namco Games America Inc.*, (Fed. Cir. 2016).

commands comprising at least one of a user volume control or a user navigation control." Additionally, one or more processors may adaptively modify a presentation position of the digital advertising content from an initially sequenced insertion points that "adaptively regroup[s] and re-sequence[s] the insertion of ad blocks extemporaneously (i.e. "on the fly"), in response to the consumer's arbitrary direction of the playback within the requested content," which was not technologically achievable for media presentation in the past. *See Specification*, p. 0057, 0117.

Claim 212, as amended, recites claim elements that cannot be categorized as mental processes. On page 15 of the Decision on Appeal, the Office alleges "the limitation of disallowing a choice is recited functionally without detail on how, technologically or by what algorithm, a disallowance is achieved, and as such is a way of controlling access to resources or data" and thus can be performed in the human mind. The Applicant has further amended the claims to show that the "disallowing a choice" claim element is a far cry from any mental process. This claim element has been amended to recite, "a user interface output for causing presentation of the content stream during a play period associated with one or more states of play such that a part of the digital advertising content is adaptively played at the one or more alternatively sequenced insertion points, instead of the one or more initially sequenced insertion points." As amended, this claim element cannot be a mental process. It is unclear how a mental process could cause a digital media player system to control access to the user interface commands, let alone create "[a] user interface input is disabled to prevent commands" in response to detecting the first value in the first memory. As such, the elements of claim 212 are not directed to mental processes.

Furthermore, on page 14 of the Decision on Appeal, the Office alleges "the receiving data" claim element is extra-solution activity. The Applicant has further amended the claims to show that the "receiving data" claim element does not purely involve extra-solution activity. This claim element has been amended to recite, "a user interface input for allowing a user to control a course of presentation of the digital media content received" and "an intersplicer for controlling one or more insertion points of the digital advertising content into the digital media content thereby sequencing the digital media content and the digital advertising content." This claim element outlines the role of the intersplicer to control insertion points of digital advertising content, which involves the sequencing of data blocks at the digital media player system.

Accordingly, the amended claim element cannot be extra solution activity because the ordering of data blocks changes the content presented at the digital media player system. As such, the limitations of claim 212 are not directed to a mental process.

The 2019 PEG Update provides further clarification as to whether claims fall within the enumerated groupings by providing examples of claims that *do not* recite a mental process. For instance, the 2019 PEG describes a claim[27] to detect suspicious activity by using network monitors and analyzing network packets. *Similar to this exemplary claim, claim 212 uses digital media player systems (e.g.., back-end server computers, databases, decision engines) having intersplicers to analyze data blocks (e.g., transaction data) to determine when to disable user interface commands (e.g., detect suspicious activity).* Moreover, claim 212 here recites several specific steps with a high level of sophistication, such as disabling user interface commands comprising at least one of a user volume control or a user navigation control that alters a corresponding volume or a course of presentation responsive to detecting the first value in the first memory. Thus, claim 212 is not a mental process for at least using intersplicers to sequence data blocks and disabling user interface commands at a digital media player system during a play period in response to detecting the first value in the first memory.

As such, claim 212 is clearly not an abstract idea, including a method directed to mental processes. For at least these reasons, the rejection of pending claim 212 under 35 U.S.C. §101 should be withdrawn.

Certain Methods of Organizing Human Activity

The Decision on Appeal contends that claim 212 falls within the "Certain Methods of Organizing Human Activity." *Decision on Appeal*, p. 16.

The 2019 PEG Update states that the Certain Methods of Organizing Human Activity "grouping is limited to activity that falls within the enumerated sub-groupings of fundamental economic principles or practices, commercial or legal interactions, managing personal behavior,

[27] *SRI Int'l, Inc. v. Cisco Systems, Inc.*, 930 F.3d 1295, 1304 (Fed. Cir. 2019)

and relationships or interactions between people, and is not to be expanded beyond these enumerated sub-groupings." [28] (Emphasis added) *2019 PEG Update*, p. 4-5.

According to the 2019 PEG, "fundamental economic principles or practices" include hedging, insurance, and mitigating risk and "describe subject matter relating to the economy and commerce."[29] Additionally, MPEP 2106.04(a)(2)(I) provides examples of "fundamental economic principles or practices." Even if amended claim 212 was stripped of its technical features, amended claim 212 would still be directed to "A digital media player device for controlling digital media presentations" which is not an enumerated fundamental economic principle or practice and is not included in the examples of MPEP 2106.04.

Further, claim 212 as amended is not directed to matters that *purely* relate to controlling commercial transactions or economic activity. While certain aspects of the claim may be related to advertising activity, the focus of the claimed subject matter is to improve a conventional digital media player to control media playback in a practical manner, such that the presentation of certain segments of digital media data cannot be circumvented by a human operator or end user. The recited control over presentation of the digital media and how certain segments of the digital media may or may not be circumvented by a human operator is achieved by way of the claimed technical improvements to conventional computer-implemented digital media player systems that have been incapable of practically solving the noted circumvention problem. As such, claim 212 is distinguishable from claims that purely recite commercial transactions.

For at least these reasons, the rejection of pending claim 212 under 35 U.S.C. §101 should be withdrawn.

Step 2A – Prong 2: the pending claims are patent eligible at least because the claims are integrated into a practical application.

[28] USPTO Training "Subject Matter Eligibility: Well-Understood, Routine, Conventional Activity, April 2018 (https://www.uspto.gov/patent/laws-and-regulations/examination-policy/subject-matter-eligibility).
[29] *2019 PEG Update*, p. 5.

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Even assuming, *arguendo*, that claim 212 is directed to an abstract idea under prong 1, which Applicant disputes, claim 212 still integrates the alleged abstract idea into a practical application under prong 2.

The 2019 PEG Update states "the evaluation of Prong Two requires the use of the considerations (e.g., **improving technology**, effecting a particular treatment or prophylaxis, implementing with a particular machine, etc.) identified by the Supreme Court and the Federal Circuit, to ensure that the claim as a whole "integrates [the] judicial exception into a practical application [that] will apply, rely on, or use the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception." 2019 *PEG Update*, p. 11.

Here, claim 212 is clearly integrated into a practical application because claim 212 is directed to a technical improvement of the digital media player system (e.g., disabling user interface commands at a digital media player system during a play period and using an intersplicer to order data blocks of the digital media content and the digital advertising content). Claim 212 embodies a practical application by using the intersplicer that "adaptively select[s] and re-sequence[s] the ads to be shown in response to the user's navigational actions throughout the content" and "disabl[es] certain user playback controls while the ads are running." *See Specification*, ¶0057, 0117.

Using the intersplicer features, the claimed system controls the real-world experience for an end user by sequencing the data blocks of the digital media content and the digital advertising content. For example, the intersplicer can determine when advertisement data blocks are inserted into the sequence of data blocks of the media content. Accordingly, the intersplicer may determine when the navigational controls of the digital media content player system are disabled. *See Specification*, 0052. Disabling such navigational controls prevents the consumer from skipping through the promotional material or lowering the sound volume beneath a predetermined threshold level. *Specification*, 0057. Therefore, claim 212 is clearly integrated into a practical application for at least improving functionality of the conventional digital media player systems.

Furthermore, the intersplicer described in claim 212 improves computing resource management (e.g., a user interface output for causing presentation such that a part of the digital advertising content is adaptively played at the one or more alternatively sequenced insertion points instead of the one or more initially sequenced insertion points). In comparison to conventional methods, the intersplicer enables the digital media player system to "adaptively regroup and re-sequence the insertion of ad blocks extemporaneously (i.e. "on the fly"), in response to the consumer's arbitrary direction of the playback within the requested content," which was not technologically achievable for media presentation in the past. *See Specification*, p. 0057, 0117. Therefore, Claim 212, when practically applied, solves the particular technical problem of preventing the consumer from skipping through the promotional material or lowering the sound volume beneath a predetermined threshold level while still allowing the end user control over the presentation of the digital media content.

The 2019 PEG Update explains the Supreme Court and the Federal Circuit identified improving technology as a consideration to ensure that the claims as a whole "integrate [the] judicial exception into a practical application [that] will apply, rely on, or use the judicial exception in a manner that imposes a meaningful limit on the judicial exception." The 2019 PEG Update provides examples indicative of whether a judicial exception has been integrated into a practical application. One listed example recites: "an additional element reflects an improvement in the functioning of a computer *or an improvement to other technology or technical field*."[30] Here, the technical solution of claim 212 is necessarily rooted in computer technology by using an intersplicer that "adaptively select[s] and re-sequence[s] the ads to be shown in response to the user's navigational actions throughout the content" and "disabl[es] certain user playback controls while the ads are running." *See Specification*, ¶0057, 0117. The intersplicer sequences data blocks of the digital media content and the digital advertising content. Based on the type of data blocks, the digital media player system may disable user interface commands during a play period in response to detecting a first value in a first memory.

As discussed during the examiner interview, the claimed subject matter is comparable to

[30] 2019 PEG Update, p. 12.

the claims in Federal Circuit decision in *Core Wireless Licensing S.A.R.L. v. LG Electronics, Inc.*,[31] in which the Federal Circuit held that graphical user interface claims are patent-eligible under 35 U.S.C. § 101 because when they "recite a specific improvement over prior systems, resulting in an improved user interface for electronic devices." (*Slip Op.* at 9). The Court determined that the claims are directed to "a particular manner of summarizing and presenting information in electronic devices" and that the claims do not "us[e] conventional user interface methods to display a generic index on a computer." (*Id.*).

Similar to the improved user interface in *Core Wireless*, claims 278 and 279 of the present Application recites a specific improvement over prior systems by using a graphical user interface that presents a time bar configured to control the intersplicer to alter the course of the presentation of the content stream in response to the user dragging the time bar on the graphical user interface. The particular manner of presenting the precise selectable menu goes far beyond conventional systems by generating "one of many important novelties of the invention is its ability to ensure the viewing of promotional ad material when the service level calls for it, whether through these controls or by some other approach. As these commands alter the course of play, they are also responsible for gathering user play history data, effectively keeping track of the user's navigation history throughout the material, as shown in the following figures." *Specification*, para. 0249. Accordingly, the Office Action erred in concluding claim 212 is directed to an abstract idea in light of recent Federal Circuit decisions.

Additionally, claim 212 requires a physical device, such as a digital media player system capable of disabling user interface commands in response to detecting a first value in a first memory during a play period. Claim 212 also requires a physical device, such as a digital media player having an intersplicer capable of sequencing and resequencing data blocks and control one or more insertion points of the digital advertising content into the digital media content at alternate insertions points. *See Ex parte Schmid* (PTAB reversing §101 rejection because the claims required a physical device); *Ex parte Balestrieri* (PTAB reversing §101 rejection because the method claim could not be performed by a human).

[31] *Core Wireless,* 880 F.3d 1356, 1362-1363 (Fed. Cir. 2018).

As such, claim 212 is clearly not an abstract idea for at least integrating the alleged abstract idea into a practical application. For at least these reasons, the rejection of pending claim 212 under 35 U.S.C. §101 should be withdrawn.

Step 2B: the pending claims are patent eligible at least because the claims recite significantly more than the alleged abstract idea.

Even assuming, *arguendo*, that amended Claim 212 is directed to an abstract idea under part 2A of the Interim Guidance, amended Claim 212 recites significantly more than the alleged abstract idea of "method to prevent commercial skipping." *Decision on Appeal*, p. 15.

Under Step 2B, claim 212 is significantly more than an abstract idea at least because the claimed implementation entails an unconventional solution to a technical problem, as discussed below.

In light of the 2019 PEG Update, a "Step 2B" rejection based on a failure to claim an invention that is directed to patent-eligible subject matter (i.e., the claim is directed to a judicial exception without providing an inventive concept/significantly more at Step 2B of the eligibility analysis) should explain the following:

First, the rejection should identify the judicial exception (i.e., abstract idea enumerated in Section I of the 2019 PEG, laws of nature, or a natural phenomenon) by referring to *what is recited* (i.e., set forth or described) in the claim and *explaining why* it is considered to be an exception (Step 2A Prong One). There is no requirement for the examiner to provide further support, such as publications or an affidavit or declaration under 37 CFR 1.104(d)(2), for the conclusion that a claim recites a judicial exception.

Second, the rejection should *identify* any additional elements recited in the claim beyond the judicial exception and *evaluate* the integration of the judicial exception into a practical application *by explaining* that 1) there are no additional elements in the claim; or 2) the claim as a whole, looking at the additional elements individually and in combination, does not integrate the

judicial exception into a practical application using the considerations set forth in the 2019 PEG (Step 2A Prong Two).

Finally, the examiner should *explain why* the additional elements, taken individually and in combination, do not result in the claim, as a whole, amounting to significantly more than the exception (Step 2B). For instance, when the examiner has concluded that certain claim elements recite well-understood, routine, conventional activity in the relevant field, the examiner must expressly support such a rejection in writing with one of the four options specified in Section III.A. of the *Berkheimer* Memorandum.

An inventive concept can be found in the non-conventional and non-generic arrangement of known conventional pieces. In the *Bascom* decision, the Federal Circuit found patent-eligible subject matter even though the claims were directed towards the abstract idea of organizing human activity.[32] The Federal Circuit criticized the District Court's piecemeal step 2B analysis and stated that the inventive concept inquiry "requires more than recognizing that each claim element, by itself, was known in the art," as "an inventive concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces."[33] The Federal Circuit also noted that the District Court analysis looked "similar to an obviousness analysis under 35 U.S.C. § 103, except lacking an explanation of a reason to combine the limitations." *Id.* at p. 4. The *Bascom* court clearly recognizes that "software-based inventions that improve the performance of the computer itself" are patent eligible even when the inventions are otherwise directed toward abstract ideas. *Id.* at p. 18.

Here, similar to *Bascom*, claim 212 of the current Application recites an inventive concept that can be found in the non-conventional and non-generic arrangement of the recited features. At least, one inventive concept of claim 212 includes "adaptively selecting and re-sequencing the ads to be shown in response to the user's navigational actions throughout the content" and "disabling certain user playback controls while the ads are running." *See Specification*, ¶0057, 0117. This

[32] *Bascom Global Internet Services Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016)
[33] *Id.* at 15.

inventive concept is not intuitive because a digital media player system has traditionally been unable to adaptively select and re-sequence the ads to be shown in response to the user's navigational actions throughout the content. *Specification*, 0057, 0117. This non-intuitive inventive concept transforms the claim language into non-conventional and non-generic claim elements.

Claim 212 captures this inventive concept by reciting: "the one or more alternatively sequenced insertion points being adaptively selectable by the intersplicer according to selection criteria defined by the one or more adaptive preference rules taking into account the new play position and at least one of a length of time associated with playing the digital media content, a number of digital media data blocks of the digital media content to be played, and a point in time the digital media content is to be played." Thus, claim 212 of the current Application includes an inventive concept that can be found at least in the non-conventional and non-generic arrangement of known, conventional pieces.

The Federal Circuit held in *Amdocs* that the claims at issue were significantly more than abstract because they "entail[] an unconventional solution (enhancing data in a distributed fashion) to a technological problem (massive record flows which previously required massive databases)."[34] Claim 212 describes the unconventional solution (e.g., a user interface output for causing presentation such that a part of the digital advertising content is adaptively played at the one or more alternatively sequenced insertion points instead of the one or more initially sequenced insertion points) of using the claimed technique to solve a technical problem of sequencing of data blocks of the digital media content and the digital advertising content processing in real-time. Therefore, in view of the rationale in *Amdocs*, claim 212 should be deemed significantly more than an abstract idea.

Moreover, the claimed elements in claim 212 are **not** well-understood, routine, and conventional. The Federal Circuit in *BASCOM* found each element of the claim individually in the prior art. However, they held that the ordered combination of the claim elements rendered the

[34] *Amdocs (Israel) Ltd. V. Openet Telecom*, 841 F.3d 1288, 1300-01 (Fed. Cir. 2016).

claims subject matter eligible. Here, the claimed elements, either individually or in an ordered combination, are not found in the prior art and hence, for at least this reason, claim 212 cannot be said to contain only elements that are well-understood, routine, and conventional. *See*, *BASCOM* [35].

Ultimately, Applicant respectfully submits that claim 212 does not recite an abstract idea (step 2A), and, even if claim 212 does recite an abstract idea (which Applicant disputes), claim 212 is integrated into a practical application and/or amounts to significantly more than the abstract idea itself (step 2B). Therefore, claim 212 is directed to patent-eligible subject matter.

Accordingly, Applicant requests the withdrawal of the rejections of claim 212 under 35 U.S.C. §101. Independent claims 238, 243, and 267 recite features similar to at least some of the patentable features discussed in connection with claim 212 above and also define patent-eligible subject matter.

Accordingly, for at least these reasons, Appellant respectfully requests the reversal of the rejections of the pending claims under 35 U.S.C. § 101.

Dependent Claims are allowable over the applied references at least by virtue of their dependency from one of independent Claims.

Dependent claims 214, 221, 225-230, 233, 237, 239-242, and 274 each depend either directly or indirectly on one of independent claims 212, 238, 243, and 267. New claims 275-279 are allowable for at least the reasons discussed above with respect to Claim 212.

Thus, the dependent claims incorporate by reference all the features of their respective independent claims pursuant to 35 U.S.C. § 112, ¶ 4. In view of the features as recited in the independent claims, and in view of the additional features as recited in the dependent claims, Appellant respectfully submits that the dependent claims define patentable subject matter over the

[35] *Bascom Global Internet Services Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016)

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applied references for at least the reasons discussed above, and for their respective additional novel features. Thus, Appellant respectfully submits that dependent claims 214, 221, 225-230, 233, 237, 239-242, and 274 are also patent eligible.

Accordingly, the pending claims define patent-eligible subject matter and the 35 U.S.C. §101 grounds of rejection should now be moot.

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CONCLUSION

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper.

Enclosed herewith please find the requisite **micro entity** fees for continued examination and prioritized examination. No additional fees are believed to be due. However, the Commissioner is hereby authorized to charge any additional claim fees and any additional fees that may be due, or credit any overpayment of same, to Deposit Account No. 50-0311, Reference No. 42327-501001US. If there are any questions regarding this response, the undersigned may be contacted at the telephone number provided below.

Respectfully submitted,

Dated: February 16, 2021

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I. CLAIMS

1–211 (Canceled)

212. (Currently Amended) A ~~computer-implemented method~~ digital media player device for controlling digital media presentations ~~using an improved digital media player system~~, the digital media player device ~~method~~ comprising:

one or more processors for receiving~~, by the digital media player system,~~ data comprising digital media content and digital advertising content;~~, the digital media player system having~~

a user interface input ~~and an intersplicer, the user interface configured to allow~~ for allowing a user to control [[of]] a course of presentation of the digital media content received;~~,~~ ~~and the~~

an intersplicer ~~configured to control~~ for controlling one or more insertion points of the digital advertising content into the digital media content[[;]] thereby sequencing the digital media content and the digital advertising content, ~~using the intersplicer,~~

the sequencing comprising ordering one or more data blocks of [[in]] the digital media content and one or more data blocks of [[in]] the digital advertising content into a ~~user-perceptible~~ content stream playable as audio or visual content perceivable by the user,

the ~~user-perceptible~~ content stream comprising one or more initially sequenced insertion points at which the digital advertising content is scheduled to be presented relative to the digital media content during play;

in response to user input updating a current play position in the content stream to a new play position in the content stream, the one or more processors using one or more adaptive preference rules to adaptively modify ~~adaptively modifying, using one or more~~

~~pre-defined rules and in response to a user input detected by the digital media player system,~~ a presentation position of the digital advertising content from at least one of the one or more initially sequenced insertion points to one or more alternatively sequenced insertion points in the digital media content,

at least one of the one or more alternatively sequenced insertion points being different than the one or more initially sequenced insertion points relative to the digital media content within the ~~user-perceptible~~ content stream;

the one or more alternatively sequenced insertion points being adaptively selectable by the intersplicer according to selection criteria defined by the one or more adaptive preference rules taking into account the new play position and at least one of a length of time associated with playing the digital media content and a number of digital media data blocks of the digital media content to be played,

such that at least one of the alternatively sequenced insertion points is positioned at a play position in the digital media content that satisfies a condition selected from:

the play position being a predetermined length of time after the new play position,

the play position being a predetermined number of digital media data blocks after the new play position; and

a user interface output for causing presentation of the ~~user-perceptible~~ content stream ~~at the digital media player system~~ during a play period associated with one or more states of play such that a part of the digital advertising content is adaptively played at the one or more alternatively sequenced insertion points, instead of at the one or more initially sequenced insertion points; and

~~keeping a setting, in a~~ at least a first memory ~~of the digital player system,~~ for storing a setting to indicate a first state of play, the setting including a first value to indicate presentation

of a required part of the digital advertising content is in progress during presentation of the ~~user-perceptible~~ content stream [[;]] such that responsive to detecting the first value in the first memory, ~~disabling~~ the user interface input is disabled to prevent commands comprising at least one of a user volume control or a user navigation control ~~that alters~~ from altering a course of presentation of the ~~user-perceptible~~ content stream while presentation of the required part of the digital advertising content is in progress~~; and~~

~~storing, in a second memory of the digital player system, presentation data comprising an indication of the digital advertising content that has been presented~~.

213. (Canceled)

214. (Currently Amended) ~~A method~~ The digital media player device as in claim 212, wherein the user interface input comprises a graphical user interface that includes a time bar to allow the user to control the course of presentation of the digital media content received to a specific point in the presentation past at least one of the one or more initially sequenced insertion points ~~causing presentation of the user-perceptible content stream on the digital media player system comprises causing display of the user-perceptible content stream by way of a graphical user interface~~.

215-220. (Canceled)

221. (Currently Amended) ~~A method~~ The digital media player device as in claim 212, wherein the sequencing ~~and the adaptively modifying are~~ is performed by at least one remote system differing from the digital media player device ~~system~~, the at least one remote system comprising a processor.

222-224 (Canceled)

225. (Currently Amended) ~~A method~~ The digital media player device as in claim 212, wherein the digital media content comprises at least one media file.

226. (Currently Amended) ~~A method~~ The digital media player device as in claim 212, wherein the digital advertising content comprises at least one advertisement file.

227. (Currently Amended) ~~A method~~ The digital media player device as in claim 226, ~~further comprising: generating~~ wherein a sequence is generated by sub-dividing a media file into two or more segments, and wherein at least a part of the at least one of the advertising file is presented between two of the segments.

228. (Currently Amended) ~~A method~~ The digital media player device as in claim 225, wherein the user input results in a change of a sequence of two or more media files by at least one of subtracting an existing media file~~, or by~~ and re-arranging the sequence of two or more media files ~~or results~~ in a change of sequence by adding a new media file.

229. (Currently Amended) ~~A method~~ The digital media player device as in claim 212, wherein the user input further comprises one or more navigational choices for the content stream.

230. (Currently Amended) ~~A method~~ The digital media player device as in claim 229, wherein the one or more navigational choices are selected from a group consisting of: play, stop, pause/continue, reverse, rewind, fast-forward, slow-motion, track advance, frame-by-frame advance, go direct to point or page in sequence, advance chapter, page turn, change track, change media selection, shuttle knob, and one or more sound controls.

231-232 (Canceled)

233. (Currently Amended) ~~A method~~ The digital media player device as in claim 212, further comprising: rotating, using an ad manager and an ad rotator, new advertising content into the ~~user-perceptible~~ content stream in response to the user input, the ad manager operative to receive ad files and select ad files for presentation from a database of ad files and the ad rotator configured to replace ad files with new ad files after the ad files have been presented.

234-236 (Canceled)

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237. (Currently Amended) ~~A method~~ The digital media player device as in claim 212, wherein the adaptively modifying uses two or more of the adaptive preference rules for determining the one or more alternatively sequenced insertion points ~~corresponding presentation position~~ of at least a part of the digital advertising content.

238. (Currently Amended) A computer-implemented system ~~method~~ for controlling digital media presentations ~~using an improved digital media player system~~, the system ~~method~~ comprising:

~~transmitting to a digital media player system, data comprising digital media content and digital advertising content, the digital media player system~~

one or more processors;

a user interface ~~and an intersplicer, the user interface configured to allow~~ for allowing a user to control a course of presentation of ~~the~~ digital media content; ~~received, and the~~

an intersplicer ~~configured to control~~ for controlling one or more insertion points of ~~the~~ digital advertising content into the digital media content[[;]] thereby sequencing the digital media content and [[the]] digital advertising content, ~~using the intersplicer,~~

the sequencing comprising ordering one or more data blocks of [[in]] the digital media content and one or more data blocks of [[in]] the digital advertising content into a ~~user-perceptible~~ content stream playable as audio or visual content perceivable by the user,

the ~~user-perceptible~~ content stream comprising one or more initially sequenced insertion points at which the digital advertising content is scheduled to be presented relative to the digital media content during play;

in response to user input updating a current play position in the content stream to a new play position in the content stream, the one or more processors using one or more adaptive preference rules to adaptively modify ~~detected by the digital media player system~~, a presentation position of the digital advertising content from at least one of the

one or more initially sequenced insertion points to one or more alternatively sequenced insertion points;

the one or more alternatively sequenced insertion points being adaptively selectable by the intersplicer according to selection criteria defined by the one or more adaptive preference rules taking into account the new play position and at least one of a length of time associated with playing the digital media content, a number of digital media data blocks of the digital media content to be played, and a point in time the digital media content is to be played, such that at least one of the alternatively sequenced insertion points is positioned at a play position in the digital media content that satisfies a condition selected from:

the play position being a predetermined length of time after the new play position,

the play position being a predetermined number of digital media data blocks after the new play position, and

the play position being at a predetermined time of the hour after the new play position;

a user interface output for causing presentation of the ~~user-perceptible~~ content stream ~~at the digital media player system~~ during a play period associated with one or more states of play such that a part of the digital advertising content is adaptively played at the one or more alternatively sequenced insertion points, instead of the one or more initially sequenced insertion points; and

~~keeping a setting, in a~~ at least a first memory ~~of the digital player system,~~ for storing a setting to indicate a first state of play, the setting including a first value to indicate presentation of a required part of the digital advertising content is in progress during presentation of the ~~user-perceptible~~ content stream[[;]] such that responsive to detecting the first value in the first memory, ~~disabling~~ the user interface is disabled to prevent commands comprising a user

navigation control ~~that alters~~ from altering ~~a corresponding volume or~~ a course of presentation of the ~~user-perceptible~~ content stream~~; and~~

~~storing, in a second memory of the digital player system, presentation data comprising an indication of the digital advertising content that has been presented~~.

239. (Canceled)

240. (Currently Amended) ~~A method~~ The system as in claim 238, wherein the at least first memory is part of the computer-implemented ~~digital media player~~ system ~~and the second memory is part of at least one remote system~~.

241. (Currently Amended) ~~A method~~ The system as in claim 238, wherein the at least first memory is part of at least one remote system ~~and the second memory is part of the digital media player system~~.

242. (Currently Amended) ~~A method~~ The system as in claim 238, wherein the at least first memory ~~and the second memory are~~ is part of at least one remote system.

243. (Currently Amended) A computer-implemented method for controlling digital media presentations using an improved digital media player system, the method comprising:

receiving, on a digital media player system, data comprising digital media content and digital advertising content, the digital media player system having a user interface and an intersplicer, the user interface configured to allow a user to control [[of]] a course of presentation of the digital media content received, and the intersplicer configured to control one or more initially sequenced insertion points of the digital advertising content into the digital media content;

sequencing the digital media content, using the intersplicer, the sequencing comprising ordering one or more data blocks of [[in]] the digital media content into a ~~user-perceptible~~ content stream playable as audio or visual content perceivable by the user, the content stream comprising a media section that comprises at least some of the digital media content, the ~~user-perceptible~~ content stream further comprising an advertising block within which at least some of

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the digital advertising content is scheduled to be presented, the advertising block being arranged within the ~~user-perceptible~~ content stream at an initially defined insertion position relative to the media section during play;

adaptively re-sequencing the ~~user-perceptible~~ content stream into a modified ~~user-perceptible~~ content stream to reflect a user input comprising updating a current play position to a new play position in the digital media content detected at the digital media player system, the modified ~~user-perceptible~~ content stream comprising an alternate insertion position of the advertising block relative to the media section, the adaptively re-sequencing comprising determining the alternate insertion position using one or more ~~pre-defined~~ adaptive preference placement rules associated with the digital media content;

the alternate insertion position being adaptively selectable by the intersplicer according to selection criteria defined by the one or more adaptive preference placement rules taking into account the new play position and at least one of a length of time associated with playing the digital media content, a number of digital media data blocks of the digital media content to be played, and a point in time the digital media content is to be played, such that the alternate insertion position is positioned at a play position in the digital media content that satisfies a condition selected from:

the play position being a predetermined length of time after the new play position,

the play position being a predetermined number of digital media data blocks after the new play position, and

the play position being at a predetermined time of the hour after the new play position;

causing presentation of the modified ~~user-perceptible~~ content stream at the digital media player system during a play period associated with one or more states of play;

causing adaptive presentation of a required part of the digital advertising content at the alternate insertion position, instead of at the one or more initially sequenced insertion points;

keeping a setting, in at least a first memory of the digital media player system, to indicate a first state of play, the setting including a first value to indicate presentation of the[[a]] required

part of the digital advertising content is in progress during presentation of the modified ~~user-perceptible~~ content stream; and

responsive to detecting the first value in the first memory, disabling user interface commands comprising ~~at least one of a user volume control or~~ a user navigation control that enables the user to alter ~~a corresponding volume or~~ a course of presentation of the modified ~~user-perceptible~~ content stream~~; and~~

~~storing, in a second memory of the digital player system, presentation data comprising an indication of the digital advertising content that has been presented~~.

244–266. (Canceled)

267. (Currently Amended) A computer-implemented method for controlling digital media presentations using an improved digital media player system, the method comprising:

transmitting, by at least one remote system to a digital media player system, data comprising digital media content and digital advertising content, the digital media player system having a user interface and an intersplicer, the user interface configured to allow a user to control [[of]] a course of presentation of the digital media content received, and the intersplicer ~~configured to control~~ for controlling one or more insertion points of the digital advertising content into the digital media content;

sequencing the digital media content, using the intersplicer, the sequencing comprising ordering one or more data blocks of [[in]] the digital media content into a ~~user-perceptible~~ content stream playable as audio or visual content perceivable by the user, the content stream comprising a media section that comprises at least some of the digital media content, the ~~user perceptible~~ content stream further comprising an advertising block within which at least some of the digital advertising content is scheduled to be presented during play, the advertising block being arranged within the ~~user-perceptible~~ content stream at an initially defined insertion position relative to the media section;

adaptively re-sequencing the ~~user-perceptible~~ content stream into a modified ~~user-perceptible~~ content stream to reflect a user input comprising updating a current play position to a new play position in the digital media content detected at the digital media player system, the modified ~~user-perceptible~~ content stream comprising an alternate insertion position of the

advertising block relative to the media section, the adaptively re-sequencing comprising determining the alternate insertion position using one or more ~~pre-defined~~ adaptive preference placement rules associated with the digital media content during play;

the alternate insertion position being adaptively selectable by the intersplicer according to selection criteria defined by the one or more adaptive preference placement rules taking into account the new play position and at least one of a length of time associated with playing the digital media content, a number of digital media data blocks of the digital media content to be played, and a point in time the digital media content is to be played

such that the alternate insertion position is positioned at a play position in the digital media content that satisfies a condition selected from:

the play position being a predetermined length of time after the new play position,

the play position being a predetermined number of digital media data blocks after the new play position, and

the play position being at a predetermined time of the hour after the new play position;

causing presentation of the modified ~~user-perceptible~~ content stream at the digital media player system during a play period associated with one or more states of play;

causing adaptive presentation of a required part of the digital advertising content at the alternate insertion point, instead of the initially defined insertion position;

keeping a setting, in at least a first memory of the digital media player system, to indicate a first state of play, the setting including a first value to indicate presentation of the[[a]] required part of the digital advertising content is in progress during presentation of the modified ~~user-perceptible~~ content stream; and

responsive to detecting the first value in the first memory, disabling user interface commands comprising ~~at least one of a user volume control or~~ a user navigation control that enables the user to alter ~~alters~~ a course of presentation of the ~~user-perceptible~~ content stream~~;~~ ~~and~~

~~storing, in a second memory of the digital player system, presentation data comprising an indication of the digital advertising content that has been presented~~.

268–273. (Canceled)

274. (Currently Amended) The method as in claim 267, wherein presentation data comprising an indication of the digital advertising content that has been presented is stored in a second memory of the digital media player system.

275. (New) The device as in claim 212, wherein the intersplicer generates control signals configured to instruct the one or more processors to interrupt the presentation of the digital media content with the presentation of the one or more data blocks at the one or more alternatively sequenced insertion points on the digital media player device.

276. (New) The device as in claim 212, the digital media player device further comprising a media file decryptor configured to receive and decrypt the digital media content during play, the media file decryptor configured to limit access to a non-volatile memory following the decryption of the digital media content.

277. (New) The device as in claim 212, wherein the digital media player device is configured to read a data structure of the one or more data blocks of the digital media content, the data structure including a first field containing data identifying a media file associated with the digital media content, a second field containing data indicative of an ad requirement associated with the digital media content, and a third field containing data representing an ad file associated with the digital advertising content to be displayed with the media file.

278. (New) The device as in claim 212, wherein the user interface input includes a time bar configured to control the intersplicer to alter a course of presentation of the content stream in response to the user dragging the time bar, the dragging of the time bar enabling at least one of fast-forward play, skipping forward, backward skipping to a fixed point, slow motion play, and frame advance play.

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279. (New) The device as in claim 212, wherein the user interface input includes a graphical user interface comprising a first tab indicative of a first media type and a second tab indicative of a second media type such that a user selection of the first tab causes the digital media player device to present a media file of the first media type in an active display window with a time bar, the time bar configured to control the intersplicer to alter a course of presentation of the content stream in response to the user dragging the time bar, and a user selection of the second tab causes the digital media player device to present another media file of the second media type in a background window.

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EXAMINER INTERVIEW SUMMARY

On January 21, 2021, an examiner interview was conducted with Examiner Retta and SPE Abdi. Applicant wishes to thank both for their time and gracious efforts in considering Applicant's position in this matter and reviewing the proposed amendments submitted.

During the interview, pending rejections under 35 U.S.C. § 101 were discussed. Applicant's representative explained the claimed improvements over older media player devices and playback technology and also covered inventive features and aspects that integrate the claimed subject matter into a practical application.

Particularly, it was noted that the proposed claim amendments were directed to an improved media player device and technology with graphical user interface components (e.g., a time bar) that would allow a user to interactively control the playback of content on the media player device. Because a user interface that improves user experience and functionality of the media player device is deemed to be patent eligible under *Core Wireless Licensing S.A.R.L. v. LG Elecs., Inc.,* 880 F.3d 1356, 1361, 125 USPQ2d 1436, 1440 (Fed. Cir. 2018)), it was noted that reciting such features in the claims would overcome the § 101 grounds of rejection.

Further, it was noted that the claimed media playback device includes practical functional features which provide for adaptive insertion of advertisement media into content being played by the media player device. It was explained that the adaptive insertion is an improvement to the older media player devices and technology that were limited to playing advertising media at pre-fixed portions. The older devices, disadvantageously, prevented a user from fast forwarding or rewinding past the designated pre-fixed portions, unless the user had watched the advertising content.

As it was further discussed in much detail during the telephonic interview, the claimed inventive and practical features of the recited media player obviate the need for a user to consume advertisement media at fixed intervals, an experience that can be extremely

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inconvenient and frustrating for the user. Instead, the improved media player provides for the timing of the playback of the advertisements relative to the content to be adaptively shifted to a different time, based on certain adaptable rules.

The examiner was asked but did not provide any constructive assistance to help advance prosecution with respect to possible claim amendments. Examiner suggested that the claimed subject matter was abstract regardless of the claimed detailed features and improvements because it could be done in the "human mind" and using "pen and paper." When it was inquired how the claimed technology could be performed with pen and paper, the examiner suggested because the general idea can be written down on a piece of paper.

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Doc Code: MES.GIB
Document Description: Certification of Micro Entity Status (Gross Income Basis)

PTO/SB/15A (07-14)

CERTIFICATION OF MICRO ENTITY STATUS
(GROSS INCOME BASIS)

Application Number or Control Number (if applicable):	Patent Number (if applicable):
10/606,729	
First Named Inventor:	**Title of Invention:**
Philip Donian	Method and apparatus for the free licensing of digital media content

The applicant hereby certifies the following—

(1) **SMALL ENTITY REQUIREMENT –** The applicant qualifies as a small entity as defined in 37 CFR 1.27.

(2) **APPLICATION FILING LIMIT –** Neither the applicant nor the inventor nor a joint inventor has been named as the inventor or a joint inventor on more than four previously filed U.S. patent applications, excluding provisional applications and international applications under the Patent Cooperation Treaty (PCT) for which the basic national fee under 37 CFR 1.492(a) was not paid, and also excluding patent applications for which the applicant has assigned all ownership rights, or is obligated to assign all ownership rights, as a result of the applicant's previous employment.

(3) **GROSS INCOME LIMIT ON APPLICANTS AND INVENTORS –** Neither the applicant nor the inventor nor a joint inventor, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986 (26 U.S.C. 61(a)), exceeding the "Maximum Qualifying Gross Income" reported on the USPTO Web site at http://www.uspto.gov/patents/law/micro_entity.jsp which is equal to three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census.

(4) **GROSS INCOME LIMIT ON PARTIES WITH AN "OWNERSHIP INTEREST" –** Neither the applicant nor the inventor nor a joint inventor has assigned, granted, or conveyed, nor is under an obligation by contract or law to assign, grant, or convey, a license or other ownership interest in the application concerned to an entity that, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income, as defined in section 61(a) of the Internal Revenue Code of 1986, exceeding the "Maximum Qualifying Gross Income" reported on the USPTO Web site at http://www.uspto.gov/patents/law/micro_entity.jsp which is equal to three times the median household income for that preceding calendar year, as most recently reported by the Bureau of the Census.

SIGNATURE by an authorized party set forth in 37 CFR 1.33(b)

Signature	/FJF/				
Name	F. Jason Far-hadian				
Date	2021/02/16	Telephone	858-314-2144	Registration No.	42,523

☐ There is more than one inventor and I am one of the inventors who are jointly identified as the applicant. The required additional certification form(s) signed by the other joint inventor(s) are included with this form.

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Electronic Acknowledgement Receipt

EFS ID:	41939740
Application Number:	10606729
International Application Number:	
Confirmation Number:	5831
Title of Invention:	Method and apparatus for the free licensing of digital media content
First Named Inventor/Applicant Name:	Philip M. Donian
Customer Number:	64046
Filer:	Farshad Jason Far-hadian/Jeremy Johnston
Filer Authorized By:	Farshad Jason Far-hadian
Attorney Docket Number:	42327-501001US
Receipt Date:	17-FEB-2021
Filing Date:	26-JUN-2003
Time Stamp:	00:04:40
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Certification of Micro Entity (Gross Income Basis)	042327-501001US_Cert_for_Micro_Entity_Status_sb0015a.pdf	123266 ad9ddde3cd02072dfd5b92d6880118bcdc69bd8c	no	2

Warnings:

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If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

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If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

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United States Patent and Trademark Office

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Document Code:WFEE

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Sale Accounting Date:02/17/2021

Sale Item Reference Number	Effective Date
10606729	02/17/2021

Document Number	Fee Code	Fee Code Description	Amount Paid	Payment Method
I20212GE01510672	3251	EXTENSION FOR RESPONSE WITHIN 1ST MONTH	$55.00	Deposit Account

PTO/SB/06 (09-11)
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PATENT APPLICATION FEE DETERMINATION RECORD Substitute for Form PTO-875	Application or Docket Number 10/606,729	Filing Date 06/26/2003	☐ To be Mailed

ENTITY: ☑ LARGE ☐ SMALL ☐ MICRO

APPLICATION AS FILED - PART I

	(Column 1)	(Column 2)			
FOR	NUMBER FILED	NUMBER EXTRA		RATE ($)	FEE ($)
☐ BASIC FEE (37 CFR 1.16(a), (b), or (c))	N/A	N/A		N/A	
☐ SEARCH FEE (37 CFR 1.16(k), (i), or (m))	N/A	N/A		N/A	
☐ EXAMINATION FEE (37 CFR 1.16(o), (p), or (q))	N/A	N/A		N/A	
TOTAL CLAIMS (37 CFR 1.16(i))	minus 20 =	*		x $18 =	
INDEPENDENT CLAIMS (37 CFR 1.16(h))	minus 3 =	*		x $84 =	
☐ APPLICATION SIZE FEE (37 CFR 1.16(s))	If the specification and drawings exceed 100 sheets of paper, the application size fee due is $310 ($155 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).				
☐ MULTIPLE DEPENDENT CLAIM PRESENT (37 CFR 1.16(j))					
* If the difference in column 1 is less than zero, enter "0" in column 2.				TOTAL	

APPLICATION AS AMENDED - PART II

		(Column 1)		(Column 2)	(Column 3)			
AMENDMENT	02/16/2021	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA		RATE ($)	ADDITIONAL FEE ($)
	Total (37 CFR 1.16(i))	* 23	Minus	** 137	= 0		x $100 =	0
	Independent (37 CFR 1.16(h))	* 4	Minus	*** 5	= 0		x $480 =	0
	☐ Application Size Fee (37 CFR 1.16(s))							
	☐ FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))							
							TOTAL ADD'L FEE	0

		(Column 1)		(Column 2)	(Column 3)			
AMENDMENT		CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA		RATE ($)	ADDITIONAL FEE ($)
	Total (37 CFR 1.16(i))	*	Minus	**	=		x $0 =	
	Independent (37 CFR 1.16(h))	*	Minus	***	=		x $0 =	
	☐ Application Size Fee (37 CFR 1.16(s))							
	☐ FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))							
							TOTAL ADD'L FEE	

* If the entry in column 1 is less than the entry in column 2, write "0" in column 3.	Non-Examiner
** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20".	/RICARDO ANTONIO CAMOU/
*** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3".	
The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.	

This collection of information is required by 37 CFR 1.16. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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NOTICE OF ALLOWANCE AND FEE(S) DUE

64046 7590 03/10/2021
Mintz Levin/San Diego Office
One Financial Center
Boston, MA 02111

EXAMINER
RETTA, YEHDEGA

ART UNIT	PAPER NUMBER
3688	

DATE MAILED: 03/10/2021

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,729	06/26/2003	Philip M. Donian	42327-501001US	5831

TITLE OF INVENTION: Method and apparatus for the free licensing of digital media content

APPLN. TYPE	ENTITY STATUS	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	MICRO	$300	$0.00	$0.00	$300	06/10/2021

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.

HOW TO REPLY TO THIS NOTICE:

I. Review the ENTITY STATUS shown above. If the ENTITY STATUS is shown as SMALL or MICRO, verify whether entitlement to that entity status still applies.

If the ENTITY STATUS is the same as shown above, pay the TOTAL FEE(S) DUE shown above.

If the ENTITY STATUS is changed from that shown above, on PART B - FEE(S) TRANSMITTAL, complete section number 5 titled "Change in Entity Status (from status indicated above)".

For purposes of this notice, small entity fees are 1/2 the amount of undiscounted fees, and micro entity fees are 1/2 the amount of small entity fees.

II. PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted. If an equivalent of Part B is filed, a request to reapply a previously paid issue fee must be clearly made, and delays in processing may occur due to the difficulty in recognizing the paper as an equivalent of Part B.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

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PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), by mail or fax, or via EFS-Web.

By mail, send to: Mail Stop ISSUE FEE
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CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

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(Typed or printed name)
(Signature)
(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,729	06/26/2003	Philip M. Donian	42327-501001US	5831

TITLE OF INVENTION: Method and apparatus for the free licensing of digital media content

APPLN. TYPE	ENTITY STATUS	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	MICRO	$300	$0.00	$0.00	$300	06/10/2021

EXAMINER	ART UNIT	CLASS-SUBCLASS
RETTA, YEHDEGA	3688	014-014000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

❑ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.

❑ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-09 or more recent) attached. **Use of a Customer Number is required.**

2. For printing on the patent front page, list
(1) The names of up to 3 registered patent attorneys or agents OR, alternatively,
(2) The name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

1 _____
2 _____
3 _____

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document must have been previously recorded, or filed for recordation, as set forth in 37 CFR 3.11 and 37 CFR 3.81(a). Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE (B) RESIDENCE: (CITY and STATE OR COUNTRY)

Please check the appropriate assignee category or categories (will not be printed on the patent) : ❑ Individual ❑ Corporation or other private group entity ❑ Government

4a. Fees submitted: ❑Issue Fee ❑Publication Fee (if required) ❑Advance Order - # of Copies _____

4b. Method of Payment: *(Please first reapply any previously paid fee shown above)*

❑ Electronic Payment via EFS-Web ❑ Enclosed check ❑ Non-electronic payment by credit card (Attach form PTO-2038)

❑ The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment to Deposit Account No. _____

5. **Change in Entity Status** (from status indicated above)

❑ Applicant certifying micro entity status. See 37 CFR 1.29

❑ Applicant asserting small entity status. See 37 CFR 1.27

❑ Applicant changing to regular undiscounted fee status.

NOTE: Absent a valid certification of Micro Entity Status (see forms PTO/SB/15A and 15B), issue fee payment in the micro entity amount will not be accepted at the risk of application abandonment.
NOTE: If the application was previously under micro entity status, checking this box will be taken to be a notification of loss of entitlement to micro entity status.
NOTE: Checking this box will be taken to be a notification of loss of entitlement to small or micro entity status, as applicable.

NOTE: This form must be signed in accordance with 37 CFR 1.31 and 1.33. See 37 CFR 1.4 for signature requirements and certifications.

Authorized Signature _____ Date _____

Typed or printed name _____ Registration No. _____

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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,729	06/26/2003	Philip M. Donian	42327-501001US	5831

64046 7590 03/10/2021

Mintz Levin/San Diego Office
One Financial Center
Boston, MA 02111

EXAMINER	
RETTA, YEHDEGA	
ART UNIT	PAPER NUMBER
3688	

DATE MAILED: 03/10/2021

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)
(Applications filed on or after May 29, 2000)

The Office has discontinued providing a Patent Term Adjustment (PTA) calculation with the Notice of Allowance.

Section 1(h)(2) of the AIA Technical Corrections Act amended 35 U.S.C. 154(b)(3)(B)(i) to eliminate the requirement that the Office provide a patent term adjustment determination with the notice of allowance. See Revisions to Patent Term Adjustment, 78 Fed. Reg. 19416, 19417 (Apr. 1, 2013). Therefore, the Office is no longer providing an initial patent term adjustment determination with the notice of allowance. The Office will continue to provide a patent term adjustment determination with the Issue Notification Letter that is mailed to applicant approximately three weeks prior to the issue date of the patent, and will include the patent term adjustment on the patent. Any request for reconsideration of the patent term adjustment determination (or reinstatement of patent term adjustment) should follow the process outlined in 37 CFR 1.705.

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

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OMB Clearance and PRA Burden Statement for PTOL-85 Part B

The Paperwork Reduction Act (PRA) of 1995 requires Federal agencies to obtain Office of Management and Budget approval before requesting most types of information from the public. When OMB approves an agency request to collect information from the public, OMB (i) provides a valid OMB Control Number and expiration date for the agency to display on the instrument that will be used to collect the information and (ii) requires the agency to inform the public about the OMB Control Number's legal significance in accordance with 5 CFR 1320.5(b).

The information collected by PTOL-85 Part B is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450. Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Notice of Allowability	**Application No.** 10/606,729	**Applicant(s)** Donian et al.	
	Examiner YEHDEGA RETTA	**Art Unit** 3688	**AIA (FITF) Status** No

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☑ This communication is responsive to 2/16/21.
   ☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.

2. ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

3. ☑ The allowed claim(s) is/are See Continuation Sheet . As a result of the allowed claim(s), you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see **http://www.uspto.gov/patents/init_events/pph/index.jsp** or send an inquiry to **PPHfeedback@uspto.gov.**

4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   Certified copies:

   a) ☐ All b) ☐ Some *c) ☐ None of the:

   1. ☐ Certified copies of the priority documents have been received.
   2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
   3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

   * Certified copies not received: _____ .

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
   ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____ .

   Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).

6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date _____.
3. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material _____.
4. ☐ Interview Summary (PTO-413), Paper No./Mail Date. _____.
5. ☐ Examiner's Amendment/Comment
6. ☑ Examiner's Statement of Reasons for Allowance
7. ☐ Other _____.

/YEHDEGA RETTA/
Primary Examiner, Art Unit 3688

Continuation of 3. The allowed claim(s) is/are: 212,214,221,225-230,233,237-238,240-243,267 and 274-279

Notice of Pre-AIA or AIA Status

The present application is being examined under the pre-AIA first to invent provisions.

Allowable Subject Matter

Claims 212, 214, 221, 225-230, 233, 237, 238, 240-243, 267 and 274-279 are allowed.

The following is an examiner's statement of reasons for allowance:

The prior art of record, Knepper et al. (US 2001/0042249A1), Hannah et al. (US 7,761,327 B1) and Wang (US 2002/0191950 A1) failed to teach the following limitation:

the content stream comprising one or more initially sequenced insertion points at which the digital advertising content is scheduled to be presented relative to the digital media content during play;

in response to user input updating a current play position in the content stream to a new play position in the content stream, the one or more processors using one or more adaptive preference rules to adaptively modify a presentation position of the digital advertising content from at least one of the one or more initially sequenced insertion points to one or more alternatively sequenced insertion points in the digital media content;

at least one of the one or more alternatively sequenced insertion points being different than the one or more initially sequenced insertion points relative to the digital media content within the content stream;

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YEHDEGA RETTA whose telephone number is (571)272-6723. The examiner can normally be reached on Monday-Thursday 8am-6pm.

Examiner interviews are available via telephone, in-person, and video conferencing using a USPTO supplied web-based collaboration tool. To schedule an interview, applicant is encouraged to use the USPTO Automated Interview Request (AIR) at http://www.uspto.gov/interviewpractice.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see https://ppair-my.uspto.gov/pair/PrivatePair. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/YEHDEGA RETTA/
Primary Examiner, Art Unit 3688

Search Notes	Application/Control No.	Applicant(s)/Patent Under Reexamination
	10/606,729	Donian et al.
	Examiner	Art Unit
	YEHDEGA RETTA	3688

CPC - Searched*		
Symbol	Date	Examiner

CPC Combination Sets - Searched*		
Symbol	Date	Examiner

US Classification - Searched*			
Class	Subclass	Date	Examiner

* See search history printout included with this form or the SEARCH NOTES box below to determine the scope of the search.

Search Notes		
Search Notes	Date	Examiner
see EAST search	11/06/2020	YR
see Proquest search	11/06/2020	YR
EAST search	02/25/2021	YR
STIC search	02/25/2021	YR

Interference Search			
US Class/CPC Symbol	US Subclass/CPC Group	Date	Examiner
H04N	21	02/26/2021	YR

/YEHDEGA RETTA/ Primary Examiner, Art Unit 3688	

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Index of Claims	Application/Control No.	Applicant(s)/Patent Under Reexamination
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	Examiner	Art Unit
	YEHDEGA RETTA	3688

✓	Rejected	-	Cancelled	N	Non-Elected	A	Appeal
=	Allowed	÷	Restricted	I	Interference	O	Objected

CLAIMS

☐ Claims renumbered in the same order as presented by applicant ☐ CPA ☐ T.D. ☐ R.1.47

CLAIM		DATE								
Final	Original	10/05/2010	11/06/2020	02/26/2021						
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	2	-	-	-						
	3	-	-	-						
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	6	-	-	-						
	7	-	-	-						
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	11	-	-	-						
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	38	-	-	-						
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	41	-	-	-						
	42	-	-	-						

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CLAIM		DATE								
Final	Original	10/05/2010	11/06/2020	02/26/2021						
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	94	-	-	-						

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CLAIM		DATE								
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	141	✓	-	-						
	142	✓	-	-						
	143	✓	-	-						
	144	✓	-	-						
	145	✓	-	-						
	146	✓	-	-						

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CLAIM		DATE								
Final	Original	10/05/2010	11/06/2020	02/26/2021						
	147	✓	-	-						
	148	✓	-	-						
	149	✓	-	-						
	150	✓	-	-						
	151	✓	-	-						
	152	✓	-	-						
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	217		✓	-						
	218		✓	-						
	219		✓	-						
	220		✓	-						
3	221		✓	=						
	222		✓	-						

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	Examiner	Art Unit
	YEHDEGA RETTA	3688

CLAIM		DATE								
Final	Original	10/05/2010	11/06/2020	02/26/2021						
	223		✓	-						
	224		-	-						
4	225		✓	=						
5	226		✓	=						
6	227		✓	=						
7	228		✓	=						
8	229		✓	=						
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	231		✓	-						
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	234		✓	-						
	235		✓	-						
	236		✓	-						
11	237		✓	=						
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	239		-	-						
18	240		✓	=						
19	241		✓	=						
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21	243		✓	=						
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	263		-	-						
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	265		-	-						
	266		-	-						
22	267		✓	=						
	268		-	-						
	269		-	-						
	270		-	-						
	271		-	-						
	272		-	-						
	273		-	-						
23	274		✓	=						

Index of Claims	Application/Control No.	Applicant(s)/Patent Under Reexamination
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CLAIM		DATE								
Final	Original	10/05/2010	11/06/2020	02/26/2021						
12	275			=						
13	276			=						
14	277			=						
15	278			=						
16	279			=						

Issue Classification	Application/Control No.	Applicant(s)/Patent Under Reexamination
	10/606,729	Donian et al.
	Examiner	**Art Unit**
	YEHDEGA RETTA	3688

CPC						
Symbol					**Type**	**Version**
H04N	/	21	/	44204	F	2013-01-01
H04N	/	21	/	4532	I	2013-01-01
H04N	/	21	/	4627	I	2013-01-01
G06F	/	21	/	10	I	2013-01-01
H04N	/	21	/	44016	I	2013-01-01
H04N	/	21	/	482	I	2013-01-01
H04N	/	21	/	25891	I	2013-01-01
H04N	/	21	/	2541	I	2013-01-01
H04N	/	21	/	4147	I	2013-01-01
H04N	/	21	/	458	I	2013-01-01
H04N	/	21	/	4788	I	2013-01-01
H04N	/	21	/	23424	I	2013-01-01
H04N	/	21	/	8193	I	2013-01-01
H04N	/	21	/	8173	I	2013-01-01
H04N	/	21	/	8456	I	2013-01-01
H04N	/	21	/	47202	I	2013-01-01
H04N	/	21	/	8355	I	2013-01-01
G06Q	/	30	/	02	I	2013-01-01
H04N	/	21	/	4314	I	2013-01-01
H04N	/	7	/	17318	I	2013-01-01
H04N	/	21	/	6582	I	2013-01-01
H04N	/	21	/	4312	I	2013-01-01
H04N	/	21	/	812	I	2013-01-01
H04N	/	21	/	4667	I	2013-01-01
H04N	/	21	/	454	I	2013-01-01
H04N	/	21	/	4825	I	2013-01-01

CPC Combination Sets							
Symbol					**Type**	**Set**	**Ranking**	**Version**
	/		/					

NONE		**Total Claims Allowed:**	
(Assistant Examiner)	(Date)	23	
/YEHDEGA RETTA/ Primary Examiner, Art Unit 3688	26 February 2021	O.G. Print Claim(s)	O.G. Print Figure
(Primary Examiner)	(Date)	1	4A

U.S. Patent and Trademark Office — Part of Paper No.: 20210226

Hulu, LLC - Ex. 1006, Page 001073

Issue Classification	Application/Control No.	Applicant(s)/Patent Under Reexamination
	10/606,729	Donian et al.
	Examiner	Art Unit
	YEHDEGA RETTA	3688

INTERNATIONAL CLASSIFICATION					
CLAIMED					
G06Q	/	30	/	00	

NON-CLAIMED					
	/		/		

US ORIGINAL CLASSIFICATION	
CLASS	SUBCLASS

CROSS REFERENCES(S)						
CLASS	SUBCLASS (ONE SUBCLASS PER BLOCK)					

NONE		Total Claims Allowed:	
(Assistant Examiner)	(Date)	23	
/YEHDEGA RETTA/ Primary Examiner, Art Unit 3688	26 February 2021	O.G. Print Claim(s)	O.G. Print Figure
(Primary Examiner)	(Date)	1	4A

U.S. Patent and Trademark Office — Part of Paper No.: 20210226

Hulu, LLC - Ex. 1006, Page 001074

Issue Classification	Application/Control No.	Applicant(s)/Patent Under Reexamination
	10/606,729	Donian et al.
	Examiner	Art Unit
	YEHDEGA RETTA	3688

☐ Claims renumbered in the same order as presented by applicant ☐ CPA ☐ T.D. ☐ R.1.47

CLAIMS

Final	Original	Final	Original	Final	Original	Final	Original	Final	Original	Final	Original	Final	Original	Final	Original
1	212	3	221	9	230		239		248		257		266	12	275
	213		222		231	18	240		249		258	22	267	13	276
2	214		223		232	19	241		250		259		268	14	277
	215		224	10	233	20	242		251		260		269	15	278
	216	4	225		234	21	243		252		261		270	16	279
	217	5	226		235		244		253		262		271		
	218	6	227		236		245		254		263		272		
	219	7	228	11	237		246		255		264		273		
	220	8	229	17	238		247		256		265	23	274		

NONE		Total Claims Allowed:	
(Assistant Examiner)	(Date)	23	
/YEHDEGA RETTA/ Primary Examiner, Art Unit 3688	26 February 2021	O.G. Print Claim(s)	O.G. Print Figure
(Primary Examiner)	(Date)	1	4A

U.S. Patent and Trademark Office Part of Paper No.: 20210226

Hulu, LLC - Ex. 1006, Page 001075

EAST Search History

EAST Search History (Prior Art)

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
S520	1	"20040003398"	US-PGPUB; USPAT	OR	ON	2021/02/22 09:11
S521	1	"20040003398" and sequenc$5	US-PGPUB; USPAT	OR	ON	2021/02/22 09:19
S522	1	"20040003398" and sequenc$5 same adverti$7	US-PGPUB; USPAT	OR	ON	2021/02/22 09:19
S523	9,129	(H04N21/44204 or H04N21/4532 or H04N21/4627 or G06F21/10 or H04N21/44016 or H04N21/482 or H04N21/25891 or H04N21/2541 or H04N21/4147 or H04N21/458 or H04N21/4788 or H04N21/23424 or H04N21/8193 or H04N21/8173 or H04N21/8456 or H04N21/47202 or H04N21/8355 or G06Q30/02 or H04N21/4314 or H04N7/17318).cpc. and (playlist play-list (media-player realplayer real-player))	US-PGPUB; USPAT	OR	ON	2021/02/22 10:04
S524	4,488	(H04N21/44204 or H04N21/4532 or H04N21/4627 or G06F21/10 or H04N21/44016 or H04N21/482 or H04N21/25891 or H04N21/2541 or H04N21/4147 or H04N21/458 or H04N21/4788 or H04N21/23424 or H04N21/8193 or H04N21/8173 or H04N21/8456 or H04N21/47202 or H04N21/8355 or G06Q30/02 or H04N21/4314 or H04N7/17318).cpc. and (playlist play-list (media-player realplayer real-player)) same (music media audio) and (adverti$8 marketing)	US-PGPUB; USPAT	OR	ON	2021/02/22 10:05
S525	1,712	(H04N21/44204 or H04N21/4532 or H04N21/4627 or G06F21/10 or H04N21/44016 or H04N21/482 or H04N21/25891 or H04N21/2541 or H04N21/4147 or H04N21/458 or H04N21/4788 or H04N21/23424 or H04N21/8193 or H04N21/8173 or H04N21/8456 or H04N21/47202 or H04N21/8355 or G06Q30/02 or H04N21/4314 or H04N7/17318).cpc. and (playlist play-list (media-player realplayer real-player)) same (music	US-PGPUB; USPAT	OR	ON	2021/02/22 10:05

		media audio) same (insert$5 play$5) same (adverti$8 marketing)				
S526	23	S525 and @pd<"20040101"	US-PGPUB; USPAT	OR	ON	2021/02/22 10:07
S527	137,246	(H04N21/44204 or H04N21/4532 or H04N21/4627 or G06F21/10 or H04N21/44016 or H04N21/482 or H04N21/25891 or H04N21/2541 or H04N21/4147 or H04N21/458 or H04N21/4788 or H04N21/23424 or H04N21/8193 or H04N21/8173 or H04N21/8456 or H04N21/47202 or H04N21/8355 or G06Q30/02 or H04N21/4314 or H04N7/17318).cpc.	US-PGPUB; USPAT	OR	ON	2021/02/22 10:09
S528	12,454	S527 and @pd<"20040101"	US-PGPUB; USPAT	OR	ON	2021/02/22 10:09
S529	23	S528 and (playlist play-list (media-player realplayer real-player)) same (music media audio) same (insert$5 play$5) same (adverti$8 marketing)	US-PGPUB; USPAT	OR	ON	2021/02/22 10:09
S530	125	S528 and (playlist play-list (media-player realplayer real-player) (media music audio) adj3 player) same (insert$5 play$5) same (adverti$8 marketing)	US-PGPUB; USPAT	OR	ON	2021/02/22 10:12
S531	5,112	(H04N21/44204 or H04N21/4532 or H04N21/4627 or G06F21/10 or H04N21/44016 or H04N21/482 or H04N21/25891 or H04N21/2541 or H04N21/4147 or H04N21/458 or H04N21/4788 or H04N21/23424 or H04N21/8193 or H04N21/8173 or H04N21/8456 or H04N21/47202 or H04N21/8355 or G06Q30/02 or H04N21/4314 or H04N7/17318).cpc. and (playlist play-list (media-player realplayer real-player) (media music audio) adj3 player) same (insert$5 play$5) same (adverti$8 marketing)	US-PGPUB; USPAT	OR	ON	2021/02/22 10:13
S532	125	S531 and @pd<"20040101"	US-PGPUB; USPAT	OR	ON	2021/02/22 10:13
S533	122	S532 and (sequenc$5 order$4 arrang$5)	US-PGPUB; USPAT	OR	ON	2021/02/22 10:14
S534	106	S532 and (sequenc$5 order$4 arrang$5) same (audio music list media playlist)	US-PGPUB; USPAT	OR	ON	2021/02/22 10:15

S535	1	S534 and (rearrang$5 re-arrang$5 re-sequenc$5 resequence) same (skip$5 forward$5)	US-PGPUB; USPAT	OR	ON	2021/02/22 10:16
S536	3,485	(playlist play-list (media-player realplayer real-player)) same (music media audio) same (insert$5 play$5) same (adverti$8 marketing)	US-PGPUB; USPAT	OR	ON	2021/02/22 10:46
S537	55	S536 and @pd<"20040101"	US-PGPUB; USPAT	OR	ON	2021/02/22 10:46
S538	299	S527 and (rearrang$5 re-arrang$5 re-sequenc$5 resequence) same (skip$5 forward$5)	US-PGPUB; USPAT	OR	ON	2021/02/22 10:46
S539	139	S527 and (rearrang$5 re-arrang$5 re-sequenc$5 resequence) same (skip$5 forward$5) same (playlist play-list list sequence)	US-PGPUB; USPAT	OR	ON	2021/02/22 10:47
S540	3	S527 and (rearrang$5 re-arrang$5 re-sequenc$5 resequence) same (skip$5 forward$5) same (playlist play-list list sequence) and splic$5	US-PGPUB; USPAT	OR	ON	2021/02/22 10:48
S541	8	((("DONIAN") near3 ("Philip")) OR (("HENNEMAN") near3 ("Larry")) OR (("MALIONE") near3 ("Michael"))).INV.	US-PGPUB; USPAT; USOCR; EPO; JPO; DERWENT	OR	ON	2021/02/22 10:57

EAST Search History (Interference)

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L1	3	(playlist media music audio) same insert$ near5 (advertis$5 marketing promotion$4) same sequenc$5 same (skip$5 (select$5 adj (out adj order)))	USPAT	OR	ON	2021/02/26 08:26
S542	17	(playlist play-list (media-player realplayer real-player)) same (music media audio) same (insert$5 play$5) same (adverti$8 marketing) same splic$5	USPAT	OR	ON	2021/02/22 10:51
S543	0	S542 and @pd<"20040101"	USPAT	OR	ON	2021/02/22 10:51

2/26/2021 8:29:45 AM
C:\Users\yretta\Documents\EAST\Workspaces\10606729-1.wsp

Bibliographic Data

Application No: 10/606,729

Foreign Priority claimed: ○ Yes ◉ No

35 USC 119 (a-d) conditions met: ☐ Yes ☑ No ☐ Met After Allowance

Verified and Acknowledged: Examiner's Signature | Initials

Title: Method and apparatus for the free licensing of digital media content

FILING or 371(c) DATE	CLASS	GROUP ART UNIT	ATTORNEY DOCKET NO.
06/26/2003	705	3688	42327-501001US
RULE			

APPLICANTS

INVENTORS

Philip M. Donian, San Francisco, CA,

Larry E. Henneman JR., Three Rivers, MI,

Michael M. Malione, Oakland, CA,

CONTINUING DATA

This application has PRO of 60393193 06/27/2002

This application has PRO of 60392232 06/27/2002

FOREIGN APPLICATIONS

IF REQUIRED, FOREIGN LICENSE GRANTED**

09/17/2003

**** MICRO ENTITY ****

STATE OR COUNTRY

ADDRESS

Mintz Levin/San Diego Office
One Financial Center
Boston, MA 02111
UNITED STATES

FILING FEE RECEIVED

$1,291

EAST Search History

EAST Search History (Prior Art)

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
L1	1	"20040003398"	US-PGPUB; USPAT	OR	ON	2021/02/22 09:11
L2	1	"20040003398" and sequenc$5	US-PGPUB; USPAT	OR	ON	2021/02/22 09:19
L3	1	"20040003398" and sequenc$5 same adverti$7	US-PGPUB; USPAT	OR	ON	2021/02/22 09:19
L4	9,129	(H04N21/44204 or H04N21/4532 or H04N21/4627 or G06F21/10 or H04N21/44016 or H04N21/482 or H04N21/25891 or H04N21/2541 or H04N21/4147 or H04N21/458 or H04N21/4788 or H04N21/23424 or H04N21/8193 or H04N21/8173 or H04N21/8456 or H04N21/47202 or H04N21/8355 or G06Q30/02 or H04N21/4314 or H04N7/17318).cpc. and (playlist play-list (media-player realplayer real-player))	US-PGPUB; USPAT	OR	ON	2021/02/22 10:04
L5	4,488	(H04N21/44204 or H04N21/4532 or H04N21/4627 or G06F21/10 or H04N21/44016 or H04N21/482 or H04N21/25891 or H04N21/2541 or H04N21/4147 or H04N21/458 or H04N21/4788 or H04N21/23424 or H04N21/8193 or H04N21/8173 or H04N21/8456 or H04N21/47202 or H04N21/8355 or G06Q30/02 or H04N21/4314 or H04N7/17318).cpc. and (playlist play-list (media-player realplayer real-player)) same (music media audio) and (adverti$8 marketing)	US-PGPUB; USPAT	OR	ON	2021/02/22 10:05
L6	1,712	(H04N21/44204 or H04N21/4532 or H04N21/4627 or G06F21/10 or H04N21/44016 or H04N21/482 or H04N21/25891 or H04N21/2541 or H04N21/4147 or H04N21/458 or H04N21/4788 or H04N21/23424 or H04N21/8193 or H04N21/8173 or H04N21/8456 or H04N21/47202 or H04N21/8355 or G06Q30/02 or H04N21/4314 or H04N7/17318).cpc. and (playlist play-list (media-player realplayer real-player)) same (music	US-PGPUB; USPAT	OR	ON	2021/02/22 10:05

		media audio) same (insert$5 play$5) same (adverti$8 marketing)				
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L8	137,246	(H04N21/44204 or H04N21/4532 or H04N21/4627 or G06F21/10 or H04N21/44016 or H04N21/482 or H04N21/25891 or H04N21/2541 or H04N21/4147 or H04N21/458 or H04N21/4788 or H04N21/23424 or H04N21/8193 or H04N21/8173 or H04N21/8456 or H04N21/47202 or H04N21/8355 or G06Q30/02 or H04N21/4314 or H04N7/17318).cpc.	US-PGPUB; USPAT	OR	ON	2021/02/22 10:09
L9	12,454	8 and @pd<"20040101"	US-PGPUB; USPAT	OR	ON	2021/02/22 10:09
L10	23	9 and (playlist play-list (media-player realplayer real-player)) same (music media audio) same (insert$5 play$5) same (adverti$8 marketing)	US-PGPUB; USPAT	OR	ON	2021/02/22 10:09
L11	125	9 and (playlist play-list (media-player realplayer real-player) (media music audio) adj3 player) same (insert$5 play$5) same (adverti$8 marketing)	US-PGPUB; USPAT	OR	ON	2021/02/22 10:12
L12	5,112	(H04N21/44204 or H04N21/4532 or H04N21/4627 or G06F21/10 or H04N21/44016 or H04N21/482 or H04N21/25891 or H04N21/2541 or H04N21/4147 or H04N21/458 or H04N21/4788 or H04N21/23424 or H04N21/8193 or H04N21/8173 or H04N21/8456 or H04N21/47202 or H04N21/8355 or G06Q30/02 or H04N21/4314 or H04N7/17318).cpc. and (playlist play-list (media-player realplayer real-player) (media music audio) adj3 player) same (insert$5 play$5) same (adverti$8 marketing)	US-PGPUB; USPAT	OR	ON	2021/02/22 10:13
L13	125	12 and @pd<"20040101"	US-PGPUB; USPAT	OR	ON	2021/02/22 10:13
L14	122	13 and (sequenc$5 order$4 arrang$5)	US-PGPUB; USPAT	OR	ON	2021/02/22 10:14
L15	106	13 and (sequenc$5 order$4 arrang$5) same (audio music list media playlist)	US-PGPUB; USPAT	OR	ON	2021/02/22 10:15
L16	1	15 and (rearrang$5 re-arrang$5 re-sequenc$5 resequence) same (skip$5 forward$5)	US-PGPUB; USPAT	OR	ON	2021/02/22 10:16

L17	3,485	(playlist play-list (media-player realplayer real-player)) same (music media audio) same (insert$5 play$5) same (adverti$8 marketing)	US-PGPUB; USPAT	OR	ON	2021/02/22 10:46
L18	55	17 and @pd<"20040101"	US-PGPUB; USPAT	OR	ON	2021/02/22 10:46
L19	299	8 and (rearrang$5 re-arrang$5 re-sequenc$5 resequence) same (skip$5 forward$5)	US-PGPUB; USPAT	OR	ON	2021/02/22 10:46
L20	139	8 and (rearrang$5 re-arrang$5 re-sequenc$5 resequence) same (skip$5 forward$5) same (playlist play-list list sequence)	US-PGPUB; USPAT	OR	ON	2021/02/22 10:47
L21	3	8 and (rearrang$5 re-arrang$5 re-sequenc$5 resequence) same (skip$5 forward$5) same (playlist play-list list sequence) and splic$5	US-PGPUB; USPAT	OR	ON	2021/02/22 10:48
L24	8	((("DONIAN") near3 ("Philip")) OR (("HENNEMAN") near3 ("Larry")) OR (("MALIONE") near3 ("Michael"))).INV.	US-PGPUB; USPAT; USOCR; EPO; JPO; DERWENT	OR	ON	2021/02/22 10:57

2/22/2021 10:59:25 AM
C:\Users\yretta\Documents\EAST\Workspaces\10606729-1.wsp

STIC Scientific & Technical Information Center

EIC 3600 Search Report

To: Yehdega Retta Location: PHP Art Unit: 3688 Case Serial Number: 10/606,729	
Access Search Log Number:	626474

Searcher:	Jermaine Wilson
Location:	EIC-3600 KNOX 4B
Phone:	571-270-5791
Email:	Jermaine.wilson@uspto.gov
Date Completed:	2/25/2021

This search report contains the following content:

- **Search Histories**
  Keyword/synonym strings and search strategies used by the EIC Searcher in completing the prior art search are included. The search history for each database or resource utilized appears at the top of each database/resource section, indicated by the database/resource section headings.

- **Search Results**
  Only on-topic results are included in the search report. On-topic results include all references found that are related to the art area being searched. These references may not necessarily be useful for a rejection or other office action, but are included for the Examiner's review. Off-topic, unrelated, or irrelevant search results ("false drops" or "false hits") were removed by the Searcher. Off-topic results include all references that are unrelated to the art area being searched.

If you have any questions about this search, or about how to interpret this search report, please do not hesitate to contact the Searcher using the contact information listed above.

If you need assistance retrieving the full text of any of the references contained in this report, please contact the Searcher listed above, or the EIC 3600 Reference Desk at 571-272-3488 (x23488) or STIC-EIC3600@uspto.gov.

Thank you for using the EIC, and we look forward to your next search!

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Per our conversation, I was unable to find any good references for *"re-arranges or re-sequences advertisement after changing play list on a media player"* **See attached search history below.**

ProQuest Dialog - Patent

Databases: Argentina Patents Fulltext, Australia Patents Fulltext, Austria Patents Fulltext, Belgium Patents Fulltext, Brazil Patents Fulltext, Canada Patents Fulltext, China Patents Fulltext, Denmark Patents Fulltext, Derwent Chemistry Resource, Derwent Patents Citation Index®, Derwent World Patents Index®, Eurasia Patents Fulltext, European Patents Fulltext, Finland Patents Fulltext, France Patents Fulltext, Germany Patents Fulltext, Global Patents Bibliographic, Great Britain Patents Fulltext, IFI CLAIMS® US Patents and Legal Status, IMS Patent Focus, India Patents Fulltext™, INPADOC / Family and Legal Status, Ireland Patents Fulltext, Italy Patents Fulltext, Japan Patents Fulltext, JAPIO - Patent Abstracts of Japan, Korea Patents Fulltext, LitAlert®, Luxembourg Patents Fulltext, Mexico Patents Fulltext, Monaco Patents Fulltext, Netherlands Patents Fulltext, Norway Patents Fulltext, Portugal Patents Fulltext, Russia Patents Fulltext, Spain Patents Fulltext, Sweden Patents Fulltext, Switzerland Patents Fulltext, United States Patents Fulltext, WIPO PCT Patents Fulltext

Set#	Searched for	Results
S1	(((mp3 or audio or music or media or multimedia or playback) pre/2 (player[*1] or device[*1] or appts or apparatus)) or ipod[*1])	6800601
S2	(re[*1]arrang[*3] or rearrang[*3] or re[*1]sequenc[*3] or resequenc[*3] or reorganiz[*3] or reord[*3] or regroup[*3] or reconfigur[*3] or shuffl[*3]) near/5 ((play[*1]list or (play pre/0 list) or song[*1]list or (song pre/0 list)) or ((play or song or music) pre/0 (preset[*1] or pre[*1]set[*1] or ("pre" pre/0 set[*1]))))	3424
S3	(re[*1]arrang[*3] or rearrang[*3] or re[*1]sequenc[*3] or resequenc[*3] or reorganiz[*3] or reord[*3] or regroup[*3] or reconfigur[*3] or shuffl[*3]) near/5 (advertisement or ad[*1] or advertis[*3] or advertiser or commercial[*1] or marketing or campaign[*1])	29838

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S4	s1 AND s2 AND s3	94°
S5	(s1 AND s2 AND s3) and (pd(19900101-20020626))	0°

ProQuest Dialog – Non-Patent Literature

Databases: ABI/INFORM® Professional Advanced, Abstracts in New Technology & Engineering, British Library Inside Conferences, Business & Industry, Civil Engineering Abstracts, Current Contents® Search, Earthquake Engineering Abstracts, Ei Compendex®, Gale Group Computer Database™, Gale Group New Product Announcements / Plus®, Gale Group Newsletter Database™, Gale Group PROMT®, Gale Group Trade & Industry Database™, Inspec®, Mechanical & Transportation Engineering Abstracts, NTIS: National Technical Information Service, ProQuest Advanced Tech & Aerospace Professional, ProQuest Dissertations and Theses Professional, ProQuest Materials Research Professional, ProQuest Newsstand Professional, ProQuest Technology Research Professional, UBM Computer Full Text

Set#	Searched for	Results
S1	(((mp3 or audio or music or media or multimedia or playback) pre/2 (player[*1] or device[*1] or appts or apparatus)) or ipod[*1])	1524049*
S2	(re[*1]arrang[*3] or rearrang[*3] or re[*1]sequenc[*3] or resequenc[*3] or reorganiz[*3] or reord[*3] or regroup[*3] or reconfigur[*3] or shuffl[*3]) near/5 ((play[*1]list or (play pre/0 list) or song[*1]list or (song pre/0 list)) or ((play or song or music) pre/0 (preset[*1] or pre[*1]set[*1] or ("pre" pre/0 set[*1]))))	1106°
S3	(re[*1]arrang[*3] or rearrang[*3] or re[*1]sequenc[*3] or resequenc[*3] or reorganiz[*3] or reord[*3] or regroup[*3] or reconfigur[*3] or shuffl[*3]) near/5 (advertisement or ad[*1] or advertis[*3] or advertiser or commercial[*1] or marketing or campaign[*1])	38668*
S4	s1 AND s2 AND s3	39°
S5	(s1 AND s2 AND s3) and (pd(19900101-20020626))	0°

Hulu, LLC - Ex. 1006, Page 001085

Ref #	Hits	Search Query	DBs	Default Operator	Plurals
L1	394,520	(((mp3 audio music media multimedia playback) adj2 (player$1 device$1 appts apparatus)) ipod$1)	FPRS; EPO; JPO; DERWENT; IBM_TDB	OR	ON
L2	83	(re$1arrang$3 rearrang$3 re$1sequenc$3 resequenc$3 reorganiz$3 reord$3 regroup$3 reconfigur$3 shuffl$3) near5 ((play$1list (play adj list) song$1list (song adj list)) ((play song music) adj (preset$1 pre$1set$1 (pre adj set$1))))	FPRS; EPO; JPO; DERWENT; IBM_TDB	OR	ON
L3	635	(re$1arrang$3 rearrang$3 re$1sequenc$3 resequenc$3 reorganiz$3 reord$3 regroup$3 reconfigur$3 shuffl$3) near5 (advertisement ad$1 advertis$3 advertiser commercial$1 marketing campaign$1)	FPRS; EPO; JPO; DERWENT; IBM_TDB	OR	ON
L4	0	l1 and l2 and l3	FPRS; EPO; JPO; DERWENT; IBM_TDB	OR	ON
L5	954,947	(((mp3 audio music media multimedia playback) adj2 (player$1 device$1 appts apparatus)) ipod$1)	US-PGPUB; USPAT; USOCR	OR	ON
L6	1,333	(re$1arrang$3 rearrang$3 re$1sequenc$3 resequenc$3 reorganiz$3 reord$3 regroup$3 reconfigur$3 shuffl$3) near5 ((play$1list (play adj list) song$1list (song adj list)) ((play song music) adj (preset$1 pre$1set$1 (pre adj set$1))))	US-PGPUB; USPAT; USOCR	OR	ON
L7	11,017	(re$1arrang$3 rearrang$3 re$1sequenc$3 resequenc$3 reorganiz$3 reord$3 regroup$3 reconfigur$3 shuffl$3) near5 (advertisement ad$1 advertis$3 advertiser commercial$1 marketing campaign$1)	US-PGPUB; USPAT; USOCR	OR	ON
L8	59	l5 and (l6 same3 l7)	US-PGPUB; USPAT; USOCR	OR	ON

Hulu, LLC - Ex. 1006, Page 001086

IP.com / InnovationQ - Patents

US Patents, US Designs, US Applications, Canadian Patents, Canadian Applications, Mexican Patents, Mexican Applications, European Patents, European Applications, French Patents, French Applications, German Patents, German Applications, Great Britain Patents, Great Britain Applications, Netherlands Patents, Netherlands Applications, Luxembourg Patents, Denmark Patents, Denmark Applications, Finnish Patents, Finnish Applications, Sweden Patents, Sweden Applications, Switzerland Patents, Switzerland Applications, Austrian Patents, Austrian Applications, Italian Patents, Italian Applications, Spanish Patents, Spanish Applications, Poland Patents, Poland Applications, Chinese Patents, Chinese Applications, Indian Patents, Indian Applications, Japanese Patents, Japanese Applications, Korean Patents, Korean Applications, Taiwanese Patents, Taiwanese Applications, Israel Applications, Australian Patent Documents, Brazil Patents, Brazil Applications, New Zealand Patents, Russian Patents, Russian Applications, WIPO Applications, and South Africa Patents.

Main Concept Text

==========

re-arranges or re-sequences advertisement after changing play list on a media player

Filters (1)

==========

Publication Date: From 1997-09-16 To 2002-06-26

1.

System and method of joining encoded video streams for continuous play

A system and method for transferring entertainment media files and advertisement media files. A set of advertisement files is pre-cached at the client side (101). A show, movie or other form of entertainment object is delivered to the user over the Internet (109). An instruction set is downloaded...

CURRENT ASSIGNEES: LOAD MEDIA NETWORKS INC

WO2001069929A1 | WIPO APPLICATIONS | 20-SEP-2001

2.

System and method of joining encoded video streams for continuous play

A system and method for transferring entertainment media files and advertisement media files. A set of advertisement files is pre-cached at the client side. A show, movie or other form of entertainment object may be requested by a user, and the set of files of which that entertainment object is...

CURRENT ASSIGNEES: LOAD MEDIA NETWORK INC

US20010042249 | US APPLICATIONS | 15-NOV-2001

3.

List building system

A system implementable using a programmable processor includes a plurality of pre-stored commands for building an inventory of audio, musical, works or audio/visual works, such as music videos. A plurality of works can be collected together in a list for purposes of establishing a play or a...

CURRENT ASSIGNEES: PREMIER INTL ASSOC LLC [+1]

US6243725 | US PATENTS | 05-JUN-2001

4.

Programmed juke box capable of calculating a continuous updated playlist

Hulu, LLC - Ex. 1006, Page 001087

A system for playing performances recorded on disc, tape and records includes video display terminals with touch panel control for audience selection of particular performances to be played. The terminals display not only lists of performances but also the graphics and text on the album covers or...
CURRENT ASSIGNEES: ALLISON AVERY VINCE
US5668788 | US PATENTS | 16-SEP-1997

5.

A web application for accessing media streams

A web page (10) has a player (16) for playing media objects, a sequencer (14) which displays a play list that defines an order in which media objects are played by the player (16), and a media access area (12) for containing a plurality of graphical icons. Each graphical icon representing a media...
CURRENT ASSIGNEES: MEDIA & TRANSACTIONS INC
WO2000028396A2 | WIPO APPLICATIONS | 18-MAY-2000

6.

Personalized disc jockey system

Automated insertion of personalized information content between segments of an audio program. The information may be based on user preferences and unique for the individual user. When a user is listening to a series of digital audio files being rendered by an audio player application according to a...
CURRENT ASSIGNEES: INTEL CORP
WO2002009088A2 | WIPO APPLICATIONS | 31-JAN-2002

7.

Online multimedia system and method

A system and method for delivering a targeted advertisement, compnsing means for performing the steps of classifying a consumer by assigning to the consumer a behavior classification based on a set of expressly defined set of preferences, an automatically derived set of preferences, and a prior...
CURRENT ASSIGNEES: ZEBUS GROUP INC
WO2001093161A1 | WIPO APPLICATIONS | 06-DEC-2001

8.

Data communication system

A computer program product is provided which includes in combination a media player control (12) and a web browser control (14) stored on a digital storage medium. The product further includes a display controller which defines a browsing zone and a media player zone on a display screen of a...
CURRENT ASSIGNEES: M WEB CONNECT PTY LTD
WO2001020471A1 | WIPO APPLICATIONS | 22-MAR-2001

9.

Method, system and computer program product for producing and distributing enhanced media downstreams

A multimedia production and distribution system collects or assembles a media production (such as, a news program, television programming, or radio broadcast) from a variety of sources, including television stations and other media hosting facilities. The media production is categorized and indexed...
CURRENT ASSIGNEES: PARKERVISION INC
US20020053078 | US APPLICATIONS | 02-MAY-2002

10.

Universal music player

A universal music player system includes a virtual player which has the appearance and functionality of a real media player. One or more media object displays display media objects which are owned by or accessible to a user. An animator visually emulates loading a media object from the virtual rack...
CURRENT ASSIGNEES: ROCK COM INC
WO2000054187A1 | WIPO APPLICATIONS | 14-SEP-2000

Hulu, LLC - Ex. 1006, Page 001088

To: IPDocketingBOS@mintz.com,IPFileroombos@mintz.com,mintzdocketing@cpaglobal.com
From: PAIR_eOfficeAction@uspto.gov
Cc: PAIR_eOfficeAction@uspto.gov
Subject: Private PAIR Correspondence Notification for Customer Number 64046

Mar 10, 2021 11:18:25 AM

Dear PAIR Customer:

Mintz Levin/San Diego Office
One Financial Center
Boston, MA 02111
UNITED STATES

The following USPTO patent application(s) associated with your Customer Number, 64046 , have new outgoing correspondence. This correspondence is now available for viewing in Private PAIR.

The official date of notification of the outgoing correspondence will be indicated on the form PTOL-90 accompanying the correspondence.

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Application	Document	Mailroom Date	Attorney Docket No.
10606729	NOA	03/10/2021	42327-501001US

To view your correspondence online or update your email addresses, please visit us anytime at https://sportal.uspto.gov/secure/myportal/privatepair.

If you have any questions, please email the Electronic Business Center (EBC) at EBC@uspto.gov with 'e-Office Action' on the subject line or call 1-866-217-9197 during the following hours:

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Thank you for prompt attention to this notice,

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Mintz Levin/San Diego Office
One Financial Center
Boston, MA 02111

Courtesy Reminder for
Application Serial No: 10/606,729

Attorney Docket No: 42327-501001US
Customer Number: 64046
Date of Electronic Notification: 03/10/2021

This is a courtesy reminder that new correspondence is available for this application. If you have not done so already, please review the correspondence. The official date of notification of the outgoing correspondence will be indicated on the form PTOL-90 accompanying the correspondence.

An email notification regarding the correspondence was sent to the following email address(es) associated with your customer number:

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IPFileroombos@mintz.com
mintzdocketing@cpaglobal.com

To view your correspondence online or update your email addresses, please visit us anytime at **https://ppair-my.uspto.gov/pair/PrivatePair.**
If you have any questions, please email the Electronic Business Center (EBC) at EBC@uspto.gov or call 1-866-217-9197.

PART B – FEE(S) TRANSMITTAL

Complete and send this form, together with the applicable fee(s), by mail or fax, or via EFS-Web.

By mail, send to: Mail Stop ISSUE FEE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By fax, send to: (571) 273-2885

INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
US
One Financial Center
Boston, MA 02111

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

Certificate of Mailing or Transmission

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being transmitted to the USPTO via EFS-Web or by facsimile to (571) 273-2885, on the date below.

(Typed or printed name)
(Signature)
(Date)

APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
10/606,729	2003-06-26	Philip M. DONIAN	042327-501001US	5831

TITLE OF INVENTION: METHOD AND APPARATUS FOR THE FREE LICENSING OF DIGITAL MEDIA CONTENT

APPLN. TYPE	ENTITY STATUS	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
UTILITY	MICRO	300	0	0	300	2021-06-10

EXAMINER	ART UNIT	CLASS-SUBCLASS
YEHDEGA RETTA	3688	-

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363)

☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.

☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-09 or more recent) attached. **Use of a Customer Number is required.**

2. For printing on the patent front page, list

(1) The names of up to 3 registered patent attorneys or agents OR, alternatively,

(2) The name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

1. Mintz, Levin, Cohn, Ferris,
2. Glovsky and Popeo, P.C.
3.

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document must have been previously recorded, or filed for recordation, as set forth in 37 CFR 3.11 and 37 CFR 3.81(a). Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE	(B) RESIDENCE: (CITY and STATE or COUNTRY)
Piranha Media Distribution, Inc.	San Francisco, CA

Please check the appropriate assignee category or categories (will not be printed on the patent): ☐ Individual ☑ Corporation or other private group entity ☐ Government

4a. Fees Submitted: ☑ Issue Fee ☐ Publication Fee (if required) ☐ Advance Order - # of Copies _____

4b. Method of Payment (*Please first reapply any previously paid fee shown above*):

☑ Electronic Payment via EFS-Web ☐ Enclosed check ☐ Non-electronic payment by credit card (Attach form PTO-2038)

☑ The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment to Deposit Account No. 50-0311

5. Change of Entity Status (from status indicated above)

☐ Applicant certifying micro entity status. See 37 CFR 1.29. NOTE: Absent a valid Certification of Micro Entity Status (see forms PTO/SB/15A and 15B), issue fee payment in the micro entity amount will not be accepted at the risk of application abandonment.

☐ Applicant asserting small entity status. See 37 CFR 1.27. NOTE: If the application was previously under micro entity status, checking this box will be taken as a notification of loss of entitlement to micro entity status.

☐ Applicant changing to regular undiscounted fee status. NOTE: Checking this box will be taken as a notification of loss of entitlement to small or micro entity status, as applicable.

NOTE: This form must be signed in accordance with 37 CFR 1.31 and 1.33. See 37 CFR 1.4 for signature requirements and certifications.

Authorized Signature /Mark Hammond/ Date March 19, 2021

Typed or printed name Mark D. Hammond Registration No. 75,822

Hulu, LLC - Ex. 1006, Page 001091

OMB Clearance and PRA Burden Statement for PTOL-85 Part B

The Paperwork Reduction Act (PRA) of 1995 requires Federal agencies to obtain Office of Management and Budget approval before requesting most types of information from the public. When OMB approves an agency request to collect information from the public, OMB (i) provides a valid OMB Control Number and expiration date for the agency to display on the instrument that will be used to collect the information and (ii) requires the agency to inform the public about the OMB Control Number's legal significance in accordance with 5 CFR 1320.5(b).

The information collected by PTOL-85 Part B is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450. Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

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The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Confirmation No.: 5831
Philip M. Donian	Examiner: Yehdega Retta
Application No.: 10/606,729	Technology Center/Art Unit: 3688
Filed: June 26, 2003	
For: Method and Apparatus for the Free Licensing of Digital Media Content	

COMMENTS ON STATEMENT OF REASONS FOR ALLOWANCE

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Commissioner:

Applicant has received the Examiner's Statement of Reasons for Allowance with the March 10, 2021 Notice of Allowance and Allowability regarding the above-identified application. Entry of the Statement into the record should not be construed as any agreement with or acquiescence in the reasoning stated by the Examiner. Each of the claims stands on its own merits and is patentable because of the combination it recites and not because of the presence or absence of any one particular element.

The Examiner's Statement was not prepared by Applicant and only contains the Examiner's possible positions in one or more reasons for allowability. Thus, any interpretation with respect to the Examiner's Statement of Reasons for Allowance should not be imputed to the Applicant.

Dated: March 19, 2021

Respectfully submitted,

/Mark Hammond/

Mark D. Hammond
Reg. No. 75,822
MINTZ LEVIN COHN FERRIS GLOVSKY
AND POPEO, P.C.
3580 Carmel Mountain Road, Suite 300
San Diego, CA 92130
(858) 314-1500
Attorneys for Applicant

109647999v.1

Electronic Patent Application Fee Transmittal

Application Number:	10606729
Filing Date:	26-Jun-2003
Title of Invention:	Method and apparatus for the free licensing of digital media content
First Named Inventor/Applicant Name:	Philip M. Donian
Filer:	Mark D. Hammond/Matthew Tupper
Attorney Docket Number:	42327-501001US

Filed as Micro Entity

Filing Fees for Utility under 35 USC 111(a)

Description	Fee Code	Quantity	Amount	Sub-Total in USD($)
Basic Filing:				
Pages:				
Claims:				
Miscellaneous-Filing:				
Petition:				
Patent-Appeals-and-Interference:				
Post-Allowance-and-Post-Issuance:				
UTILITY ISSUE FEE	3501	1	300	300

Description	Fee Code	Quantity	Amount	Sub-Total in USD($)
Extension-of-Time:				
Miscellaneous:				
			Total in USD ($)	**300**

Electronic Acknowledgement Receipt	
EFS ID:	42233537
Application Number:	10606729
International Application Number:	
Confirmation Number:	5831
Title of Invention:	Method and apparatus for the free licensing of digital media content
First Named Inventor/Applicant Name:	Philip M. Donian
Customer Number:	64046
Filer:	Mark D. Hammond/Matthew Tupper
Filer Authorized By:	Mark D. Hammond
Attorney Docket Number:	42327-501001US
Receipt Date:	19-MAR-2021
Filing Date:	26-JUN-2003
Time Stamp:	17:56:53
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	yes
Payment Type	DA
Payment was successfully received in RAM	$300
RAM confirmation Number	E20213IH57413668
Deposit Account	
Authorized User	
The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows:	

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Issue Fee Payment (PTO-85B)	042327-501001US_Issuefee.pdf	114167 870e029509684d15244c9ec042bbca47df2ced11	no	2
Warnings:					
Information:					
2	Post Allowance Communication - Incoming	042327-501001US_Comments.pdf	103457 a89d0696d49b442e84ba257fff6b6a6b03ebfe0d	no	1
Warnings:					
Information:					
3	Fee Worksheet (SB06)	fee-info.pdf	30020 0addf99db8a4740c9b673a2afe6878d8668a4688	no	2
Warnings:					
Information:					
		Total Files Size (in bytes):	247644		

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111
If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.
National Stage of an International Application under 35 U.S.C. 371
If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.
New International Application Filed with the USPTO as a Receiving Office
If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NUMBER	FILING or 371(c) DATE	GRP ART UNIT	FIL FEE REC'D	ATTY.DOCKET.NO	TOT CLAIMS	IND CLAIMS
10/606,729	06/26/2003	3688	2110	42327-501001US	108	5

CONFIRMATION NO. 5831

CORRECTED FILING RECEIPT

64046
Mintz Levin/San Diego Office
One Financial Center
Boston, MA 02111

OC000000124262316

Date Mailed: 03/23/2021

Receipt is acknowledged of this non-provisional utility patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF FIRST INVENTOR, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection.

Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please submit a written request for a corrected Filing Receipt, including a properly marked-up ADS showing the changes with strike-through for deletions and underlining for additions. If you received a "Notice to File Missing Parts" or other Notice requiring a response for this application, please submit any request for correction to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections provided that the request is grantable.

Inventor(s)

Philip M. Donian, San Francisco, CA;
Larry E. Henneman JR., Three Rivers, MI;
Michael M. Malione, Oakland, CA;

Applicant(s)

Philip M. Donian, San Francisco, CA;
Larry E. Henneman JR., Three Rivers, MI;
Michael M. Malione, Oakland, CA;

Power of Attorney: The patent practitioners associated with Customer Number 64046

Domestic Priority data as claimed by applicant

This appln claims benefit of 60/393,193 06/27/2002
and claims benefit of 60/392,232 06/27/2002

Foreign Applications for which priority is claimed (You may be eligible to benefit from the **Patent Prosecution Highway** program at the USPTO. Please see http://www.uspto.gov for more information.) - None.
Foreign application information must be provided in an Application Data Sheet in order to constitute a claim to foreign priority. See 37 CFR 1.55 and 1.76.

Permission to Access Application via Priority Document Exchange: No

Permission to Access Search Results: No

Applicant may provide or rescind an authorization for access using Form PTO/SB/39 or Form PTO/SB/69 as appropriate.

If Required, Foreign Filing License Granted: 09/17/2003

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 10/606,729**

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No
**** MICRO ENTITY ****
Title

INTERACTIVE DIGITAL MEDIA AND ADVERTISING PRESENTATION PLATFORM

Preliminary Class

014

Statement under 37 CFR 1.55 or 1.78 for AIA (First Inventor to File) Transition Applications: No

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific

countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4258).

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Title 35, United States Code, Section 184

Title 37, Code of Federal Regulations, 5.11 & 5.15

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Application	Document	Mailroom Date	Attorney Docket No.
10606729	APP.FILE.REC	03/23/2021	42327-501001US

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PATENT APPLICATION INFORMATION RETRIEVAL SYSTEM

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Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	ISSUE DATE	PATENT NO.	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,729	04/20/2021	10986403	42327-501001US	5831

64046 7590 03/31/2021

Mintz Levin/San Diego Office
One Financial Center
Boston, MA 02111

ISSUE NOTIFICATION

The projected patent number and issue date are specified above.

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)
(application filed on or after May 29, 2000)

The Patent Term Adjustment is 958 day(s). Any patent to issue from the above-identified application will include an indication of the adjustment on the front page.

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (http://pair.uspto.gov).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Application Assistance Unit (AAU) of the Office of Data Management (ODM) at (571)-272-4200.

APPLICANT(s) (Please see PAIR WEB site http://pair.uspto.gov for additional applicants):

Philip M. Donian, San Francisco, CA;
Larry E. Henneman JR., Three Rivers, MI;
Michael M. Malione, Oakland, CA;

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Subject: Private PAIR Correspondence Notification for Customer Number 64046

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Application	Document	Mailroom Date	Attorney Docket No.
10606729	ISSUE.NTF	03/31/2021	42327-501001US

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UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION INFORMATION RETRIEVAL SYSTEM

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:
Philip M. Donian, *et al.*

Application No.: 10/606,729

Filed: June 26, 2003

Patent No.: 10,986,403

Issue Date: April 20, 2021

For: METHOD AND APPARATUS FOR THE FREE LICENSING OF DIGITAL MEDIA CONTENT

Confirmation No.: 5831

Art Unit: 3688

Examiner: Yehdega Retta

FILED VIA EFS

Mail Stop: Office of Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR § 1.705

On behalf of the Applicant, the undersigned requests reconsideration of patent term adjustment under 37 C.F.R. § 1.705 indicated on the front page of the above-issued patent (issue date of April 20, 2021) *(see Exhibit A)* and on the Issue Notification *(see Exhibit B)*.

Summary

Applicant disagrees with the Office regarding the calculation of "A-delay" of 2272 days appearing in the upper section of the tab entitled "Patent Term Adjustments" of the Patent Application Information Retrieval ("PAIR"). S*ee Exhibit C*. Additionally, Applicant disagrees with the Office regarding the calculation of "Applicant Delays" of 1761 days appearing in the upper section of the tab entitled "Patent Term Adjustments" of the Patent Application Information Retrieval ("PAIR"). S*ee Exhibit C*.

Applicant does not dispute the Office's calculation of "B and C delays."

Applicant does not dispute the Office's calculation of "Overlapping Days."

Applicant does dispute the Office's calculation of "A delays". The total "A Delays" should be **2513 days** rather than 2272 days.

Applicant does dispute the Office's calculation of "Applicant Delays." The total "Applicant Delays" should be **1138 days** rather than 1761 days.

Applicant calculates the total Patent Term Adjustment to be 1822 days and not 958 days. The formula for the calculation of the PTA is as follows:

A Delay (2513 days) + B Delay (1277 days) – C Delay (0 day) – A/B Delay (830 day) – Applicant's Delay (1138 day) = 1822 days.

Statement of Facts Regarding the A delay

I. Undisputed Facts:

1. A Final Office Action was mailed on October 12, 2016.
2. A Notice of Appeal was timely filed by Applicant on April 4, 2017 along with a Pre-Brief Conference Request and fees for a three-month extension of time.
3. The Office incorrectly mailed a Notice of Abandonment on December 11, 2017.
4. A "Notice of Rescinded Abandonment" mailed on January 29, 2018.
5. A Pre-Brief Appeal Conference Decision mailed on April 2, 2018.

Hulu, LLC - Ex. 1006, Page 001106

II. Disputed Facts:

1. Applicant asserts that 241 days should be added to the Office calculation of "A Delay" of 2272 days under 35 U.S.C. § 154(b)(1)(A) for the reason stated below.

Statement of Facts Regarding the Applicant's Delay

I. Undisputed Facts:

1. A Notice of Appeal was filed on July 2, 2014.
2. A corresponding Appeal Brief was filed on February 13, 2015.
3. A separate Notice of Appeal was filed on April 4, 2017.
4. A corresponding Appeal Brief was filed July 19, 2018.

II. Disputed Facts:

1. Applicant disagrees with the Office about the calculation of Applicant Delay" of 1761 days and, more specifically, the "Applicant Delay" of 1386 days associated with the Appeal Brief filed on July 19, 2018 under 37 C.F.R. § 1.704(b) for the reason stated below.

Argument

"A Delays" Calculation

The total "A Delay" calculation is **2513 days** rather than the 2272 days calculated by the Office. Applicant should be credited with 241 days due to 1) the Office's improper abandonment of the application and 2) failure to timely issue a Pre-Brief Conference Request Decision.

The Office incorrectly mailed a Notice of Abandonment despite Applicant's timely filings. Applicant timely responded to a Final Office Action mailed on October 12, 2016 by filing a Notice of Appeal on April 4, 2017 along with a Pre-Brief Conference Request and fees for a three-month extension of time. Applicant did not receive a response from the Office until the Office incorrectly mailed a Notice of Abandonment on December 11, 2017. The Office then noted the error and mailed a Notice of Rescinded Abandonment on January 29, 2018 that vacated the holding of abandonment. The Notice of Rescinded Abandonment noted that the April 4, 2017 filing was timely and that the Office had not yet responded to the Pre-Brief Conference request. As such, the Office observed its failure in responding to the Pre-Brief Conference Request and the delay caused by the holding of abandonment was without merit.

Additionally, the Pre-Brief Conference Request Decision should have been issued by no later than August 4, 2017, which is four months from the filing of the Pre-Brief Conference Request. But the Office did not issue the Pre-Brief Conference Request Decision until April 2, 2018 – almost a year after the Notice of Appeal and the Pre-Brief Conference Request was filed with the USTPO.

When an Applicant files a Notice of Appeal and a Pre-Brief Conference Request, the Office applies 37 C.F.R. § 154(b)(1)(A) in order to calculate the "A Delay" to "guarantee prompt patent and trademark office responses."

37 C.F.R. § 154(b)(1)(A) provides:

> Subject to the limitations under paragraph (2), **if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to—**
>
> (i) provide at least one of the notifications under section 132 or a notice of allowance under section 151 not later than 14 months after—
>
> (I) the date on which an application was filed under section 111(a); or
>
> (II) the date of commencement of the national stage under section 371 in an international application;

> (ii) **respond to a reply under section 132, or to an appeal taken under section 134, within 4 months after the date on which the reply was filed or the appeal was taken**;
>
> (iii) act on an application within 4 months after the date of a decision by the Patent Trial and Appeal Board under section 134 or 135 or a decision by a Federal court under section 141, 145, or 146 in a case in which allowable claims remain in the application; or
>
> (iv) issue a patent within 4 months after the date on which the issue fee was paid under section 151 and all outstanding requirements were satisfied,
>
> **the term of the patent shall be extended 1 day for each day after the end of the period specified in clause (i), (ii), (iii), or (iv), as the case may be, until the action described in such clause is taken** (emphasis added).

Here, the Office had four months to respond to the Pre-Brief Conference Request filed on April 4, 2017 before incurring A delay. However, there was no communication or response in regards to the Pre-Brief Conference Request by the Office until almost a year later on April 2, 2018. This delayed response was at least partially caused by the incorrectly mailed Notice of Abandonment on December 11, 2017, which was subsequently rescinded on January 29, 2018. Accordingly, the patent term is to be extended one day for each day after August 4, 2017 until the mailing of the Pre-Brief Conference Request Decision.

It is noteworthy that the Applicant was unable to take any action to advance prosecution prior to receiving a response from the Office regarding the Pre-Brief Conference Request all due to the Office's negligence in improperly and unduly abandoning the Application. Accordingly, Applicant should be credited with 241 days for the improper abandonment of the Application and for failing to respond to the Pre-Brief Conference Request filed on April 4, 2017, until its Pre-Brief Conference Request Decision mailed on April 2, 2018. Thus, a calculation of 241 days should be added to the "A delays" of 2272, resulting in 2513 days under 35 U.S.C. § 154(b)(1)(A).

"Applicant Delays" Calculation

The Office's calculation of 1761 days "Applicant Delays" is incorrect. More specifically, the Office incorrectly calculated 1386 days of Applicant Delay for assuming a *second* Appeal Brief filed on July 19, 2018 was responsive to the *first* Notice Of Appeal filed July 2, 2014.

The Office applies 37 C.F.R. § 1.704 in order to calculate Applicant's delay "to engage in reasonable efforts to conclude prosecution (processing or examination)".

37 C.F.R. § 1.704(b) provides:

> With respect to the grounds for adjustment set forth in §§ 1.702(a) through (e), and in particular the ground of adjustment set forth in § 1.702(b), **an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed** (emphasis added).

Here, Applicant engaged in reasonable efforts and the Office miscalculated the time between the first Notice of Appeal and its corresponding Appeal Brief. The Office's calculation is incorrect because the Appeal Brief filed on July 19, 2018 was responsive to the *second* Notice of Appeal filed on April 4, 2017, not the *first* Notice of Appeal filed on July 2, 2014.

Applicant properly filed an Appeal Brief on February 13, 2015, that was responsive to the Notice of Appeal of July 2, 2014. Applicant should not be penalized for the 1386 days (*see Entry Number 104 of Exhibit C)* because the Office apparently overlooked the Appeal Brief filed on February 13, 2015, and mistakenly assumed the Appeal Brief of July 19, 2018 was responsive to the *First* Notice of Appeal on July 2, 2014.

Furthermore, Applicant should not be penalized with 1386 days of Applicant Delay because there was no failure on the part of the Applicant to engage in reasonable efforts to move prosecution forward. Thus, the calculation of 1386 days should be removed from the Office calculation of 1761 days of "Applicant delays" under 35 U.S.C. § 154(b)(2)(C).

With the removal of the 1386 days of Applicant Delay and the addition of some Applicant Delays discussed in the Additional Remarks, the total Applicant Delay will be **1138 days** rather than 1761 days.

Additional Remarks

Applicant agrees with the Office about the calculation of "B Delays" of 1277 days under 35 U.S.C. § 154(b)(1)(B). Applicant agrees with the Office about the calculation of "C Delays" of 0 days under 35 U.S.C. § 154(b)(1)(C).

The Office missed four Applicant Delays due to the miscalculation of 1386 days of the Applicant Delay by assuming the Appeal Brief filed on July 19, 2018 was responsive to the Notice of Appeal filed on April 2, 2014. First, an Applicant Delay of 91 days resulted from responding to a Non-Final Rejection mailed on February 2, 2016 on August 1, 2016. Second, an Applicant Delay of 82 days resulted from responding to a Final Rejection mailed October 12, 2016 on April 3, 2017. Third, an Applicant Delay of 203 days resulted from filing an Appeal Brief on April 23, 2015 after the Notice of Appeal was filed July 2, 2014. *See* 37 CFR 1.704(c)(11). Additionally, an Applicant Delay of 387 days is attributable to filing the Appeal Brief on July 26, 2018 following the Notice of Appeal filed April 4, 2017 (partially due to the improper abandonment by the Office). *See* 37 CFR 1.704(c)(11). Accordingly, the total "Applicant Delays" should be 1138 days rather than 1761 days.

The Patent is not subject to a terminal disclaimer. There were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the application that resulted in the Patent as set forth in 37 C.F.R. § 1.704, other than the circumstances of record.

Conclusion

This request is timely filed within two months after issuance pursuant to 37 C.F.R. § 1.705(d), that is, prior to June 20, 2021. The requisite **micro entity** fee required under 37 C.F.R. §§ 1.705(b)(1) and 1.705(d) as set forth in 37 C.F.R. §1.18(e) of $210.00 is enclosed with the present request. Applicant believes no additional fees are due with the filing of this Request. However, if any fees are required, Applicant hereby authorizes the Commissioner to charge such fee, or credit any overpayment in fees, to Deposit Account No. 50-0311; Reference Number: 42327-501001US.

In conclusion, Applicant calculates the total Patent Term Adjustment to be 1822 days and not 958 days. The formula for the calculation of the PTA is as follows:

A Delay (2513 days) + B Delay (1277 days) – C Delay (0 day) – A/B Delay (830 day) – Applicant's Delay (1138 day) = 1822 days.

Applicant thereby petitions the U.S. Patent and Trademark Office for reconsideration of the patent term adjustment calculation based on the facts provided herein.

Respectfully submitted,

Dated: May 20, 2021

Electronic signature: /Mark Hammond/
Mark Hammond
Registration No.: 75,822

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EXHIBIT A



(12) **United States Patent**
Donian et al.

(10) **Patent No.: US 10,986,403 B2**
(45) **Date of Patent: Apr. 20, 2021**

(54) **INTERACTIVE DIGITAL MEDIA AND ADVERTISING PRESENTATION PLATFORM**

(75) Inventors: **Philip M. Donian**, San Francisco, CA (US); **Larry E. Henneman, Jr.**, Three Rivers, MI (US); **Michael M. Malione**, Oakland, CA (US)

(73) Assignee: **Piranha Media Distribution, Inc.**, San Francisco, CA (US)

(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 958 days.

(21) Appl. No.: **10/606,729**

(22) Filed: **Jun. 26, 2003**

(65) **Prior Publication Data**

US 2004/0003398 A1 Jan. 1, 2004

Related U.S. Application Data

(60) Provisional application No. 60/393,193, filed on Jun. 27, 2002, provisional application No. 60/392,232, filed on Jun. 27, 2002.

(51) **Int. Cl.**
G06Q 30/00 (2012.01)
H04N 21/442 (2011.01)
(Continued)

(52) **U.S. Cl.**
CPC ***H04N 21/44204*** (2013.01); ***G06F 21/10*** (2013.01); ***G06Q 30/02*** (2013.01); ***H04N 7/17318*** (2013.01); ***H04N 21/23424*** (2013.01); ***H04N 21/2541*** (2013.01); ***H04N 21/25891*** (2013.01); ***H04N 21/4147*** (2013.01); ***H04N 21/4312*** (2013.01); ***H04N 21/4314*** (2013.01); ***H04N 21/44016*** (2013.01); ***H04N 21/454*** (2013.01); ***H04N 21/458*** (2013.01); ***H04N 21/4532*** (2013.01); ***H04N 21/4627*** (2013.01); ***H04N 21/4667*** (2013.01); ***H04N 21/4788*** (2013.01); ***H04N 21/47202*** (2013.01); ***H04N 21/482*** (2013.01); ***H04N 21/4825*** (2013.01);
(Continued)

(58) **Field of Classification Search**
None
See application file for complete search history.

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(Continued)

Primary Examiner — Yehdega Retta
(74) *Attorney, Agent, or Firm* — Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.

(57) **ABSTRACT**

A system and method for displaying digital media files with compulsory advertisement files is disclosed. In one embodiment, the system includes a user interface, a media file decryptor, an ad manager, an intersplicer, and a media player. The user interface receives input from a user indicating the selection of media files to be presented. The media file decryptor receives and decrypts the selected media files. The ad manager receives and manages ad files from an ad file source. The intersplicer combines the media files with the ad files by providing control signals to the media player, causing the media player to present the ad files with the selected media files. Various embodiments of the invention facilitate the wide distribution of media content in a way that allows the free use of media properties, on demand, with direct consumer exchange capabilities, while at the same time enabling compensation to copyright holders.

23 Claims, 18 Drawing Sheets

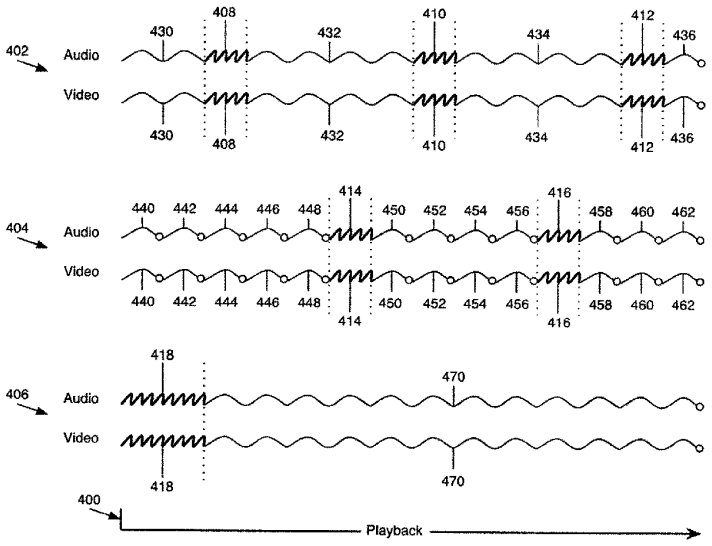


EXHIBIT A

(51) **Int. Cl.**

H04N 21/45	(2011.01)
H04N 21/4627	(2011.01)
G06F 21/10	(2013.01)
H04N 21/44	(2011.01)
H04N 21/482	(2011.01)
H04N 21/258	(2011.01)
H04N 21/254	(2011.01)
H04N 21/4147	(2011.01)
H04N 21/458	(2011.01)
H04N 21/4788	(2011.01)
H04N 21/234	(2011.01)
H04N 21/81	(2011.01)
H04N 21/845	(2011.01)
H04N 21/472	(2011.01)
H04N 21/8355	(2011.01)
G06Q 30/02	(2012.01)
H04N 21/431	(2011.01)
H04N 7/173	(2011.01)
H04N 21/658	(2011.01)
H04N 21/466	(2011.01)
H04N 21/454	(2011.01)

(52) **U.S. Cl.**

CPC ***H04N 21/6582*** (2013.01); ***H04N 21/812*** (2013.01); ***H04N 21/8173*** (2013.01); ***H04N 21/8193*** (2013.01); ***H04N 21/8355*** (2013.01); ***H04N 21/8456*** (2013.01)

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6,687,737	B2 *	2/2004	Landsman et al.	709/203
6,950,804	B2 *	9/2005	Strietzel	705/26
7,263,497	B1 *	8/2007	Wiser et al.	705/26
7,400,729	B2 *	7/2008	Dunstan et al.	380/239
7,761,327	B1 *	7/2010	Hannah	G06Q 20/206 382/100
2001/0042249	A1 *	11/2001	Knepper et al.	725/42
2002/0120564	A1 *	8/2002	Strietzel	705/40
2002/0138593	A1 *	9/2002	Novak et al.	709/219
2002/0161739	A1 *	10/2002	Oh	G06Q 30/02
2002/0191950	A1 *	12/2002	Wang	H04N 5/783 386/218
2003/0023973	A1	1/2003	Monson et al.	725/34
2003/0120541	A1 *	6/2003	Siann et al.	705/14
2004/0215741	A1 *	10/2004	Watson	709/217

* cited by examiner

EXHIBIT A

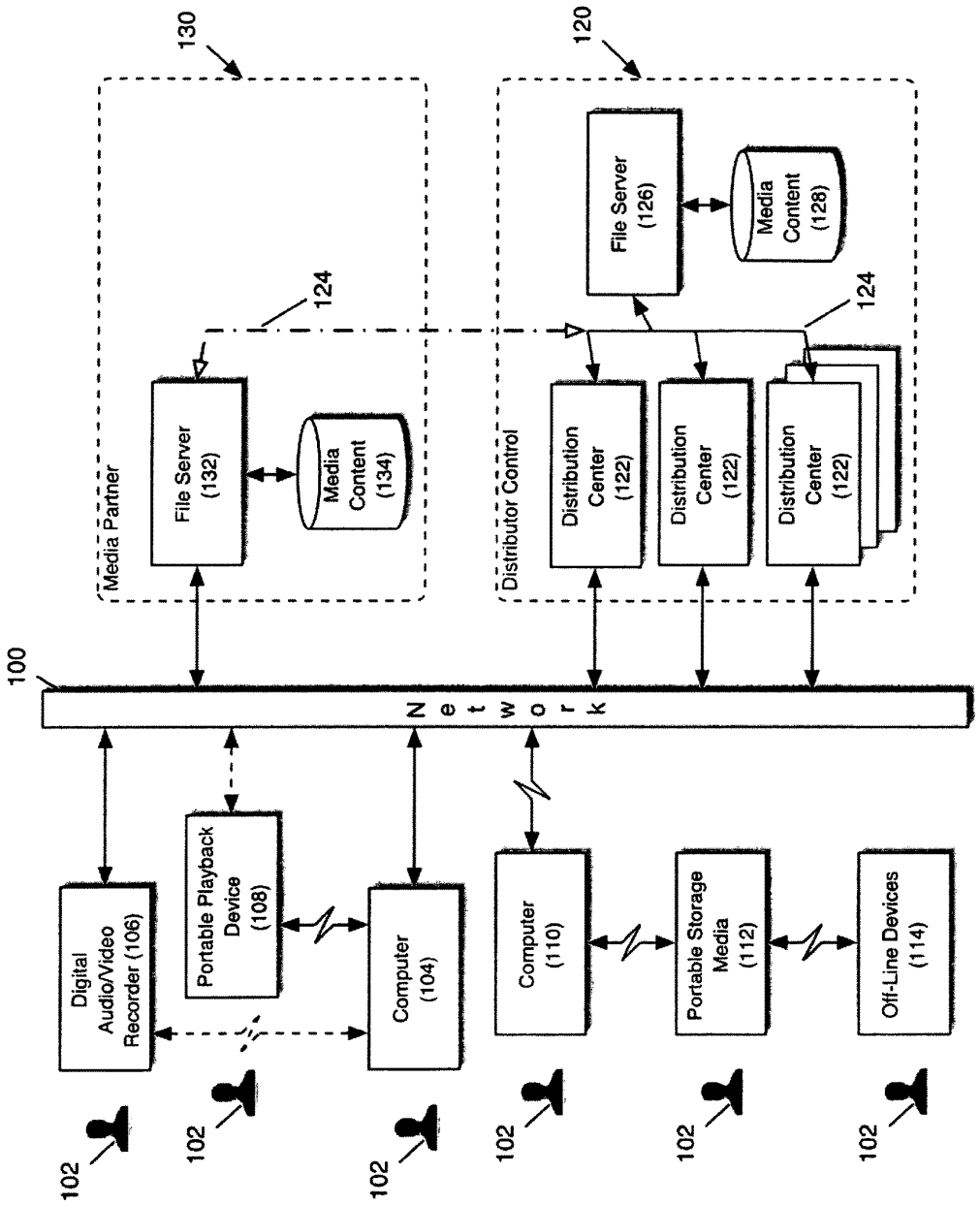


Figure 1

EXHIBIT A

Figure 2

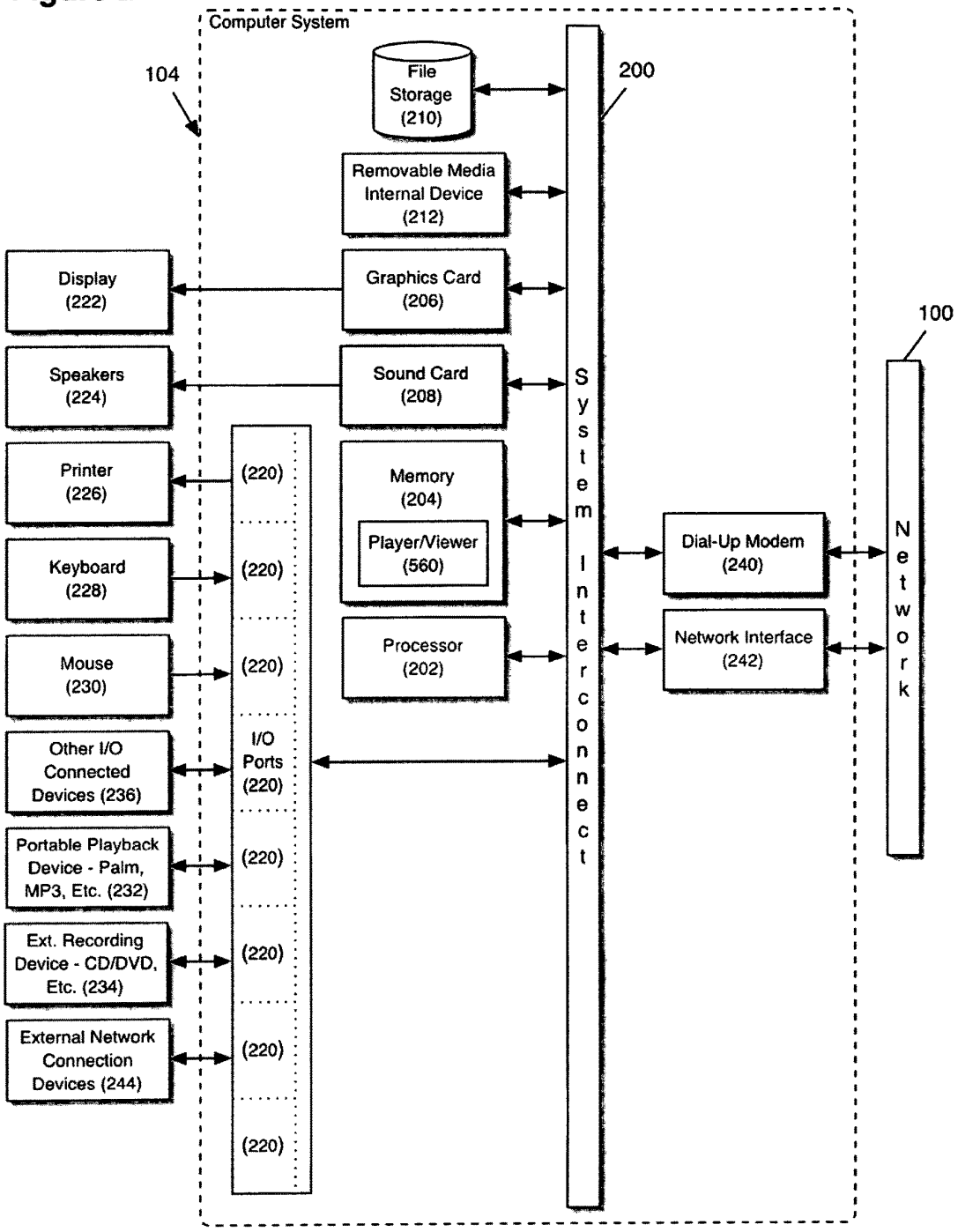


EXHIBIT A

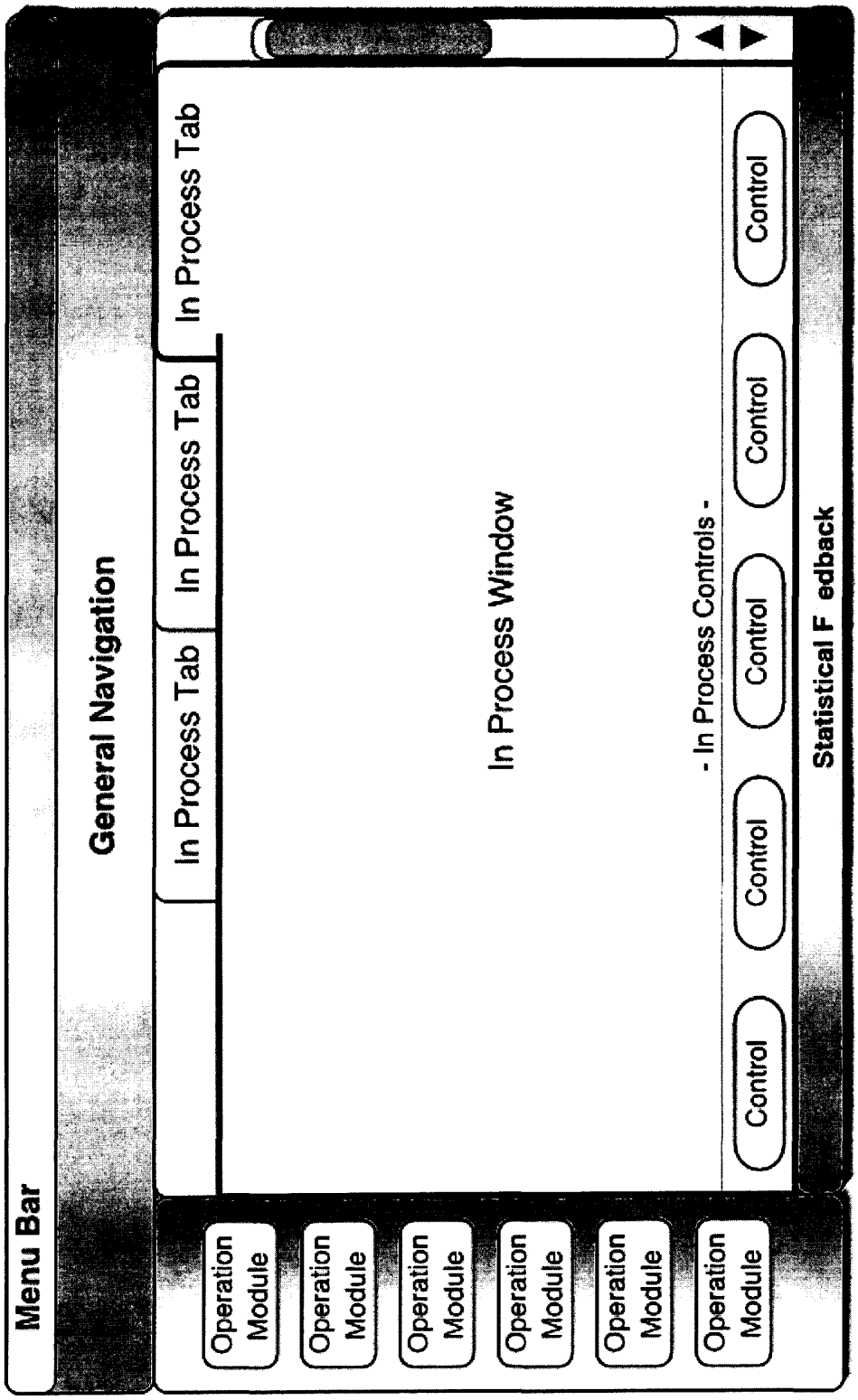


Figure 3A

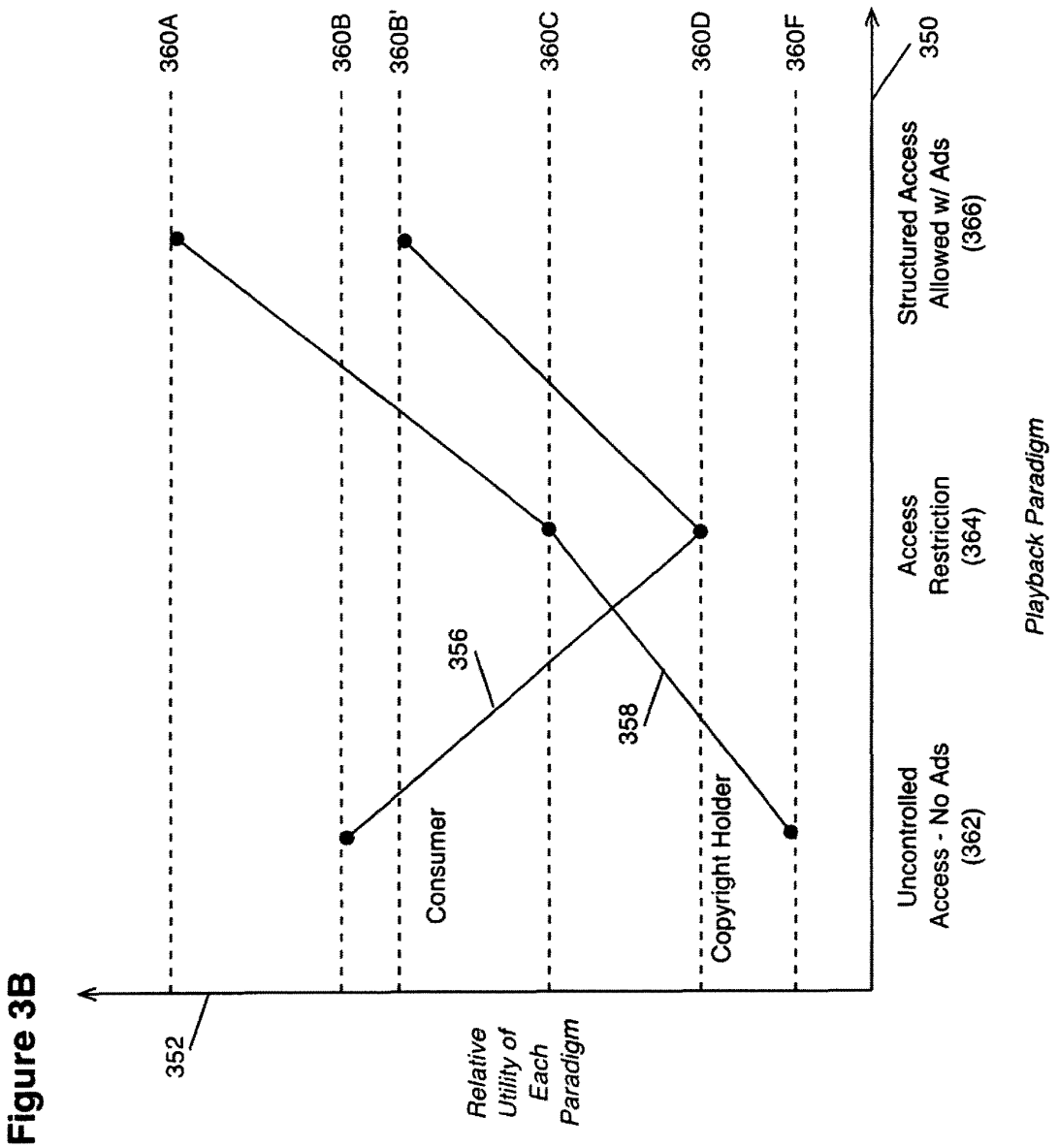

360A
360B
360B'
360C
360D
360F
350
Structured Access Allowed w/ Ads (366)
Access Restriction (364)
Uncontrolled Access - No Ads (362)
Playback Paradigm
356
358
Consumer
Copyright Holder
352
Relative Utility of Each Paradigm

Figure 3B

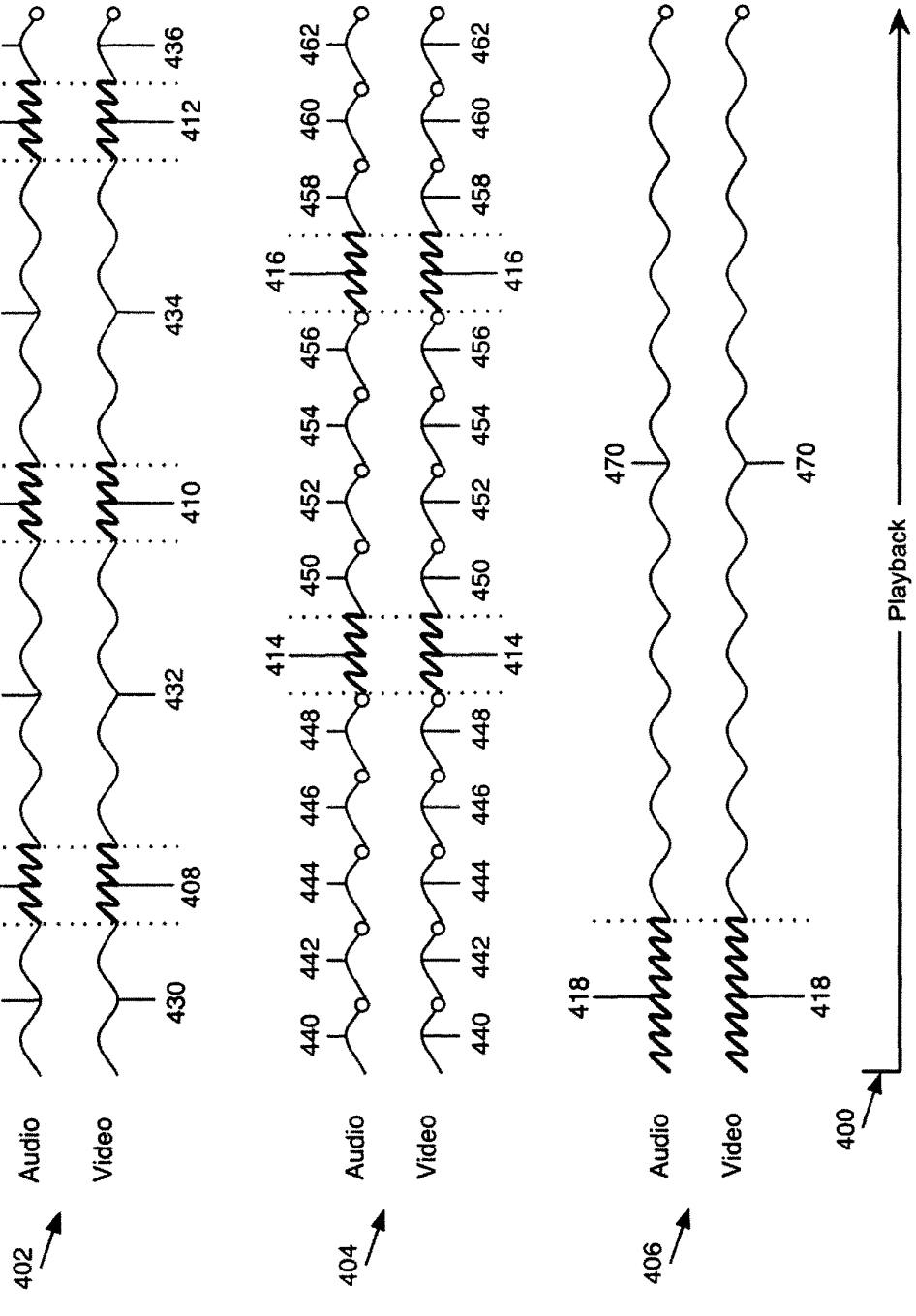

Audio
Video
Audio
Video
Audio
Video
Playback
400
402
404
406
408
410
412
414
416
418
430
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436
440
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Figure 4A

EXHIBIT A

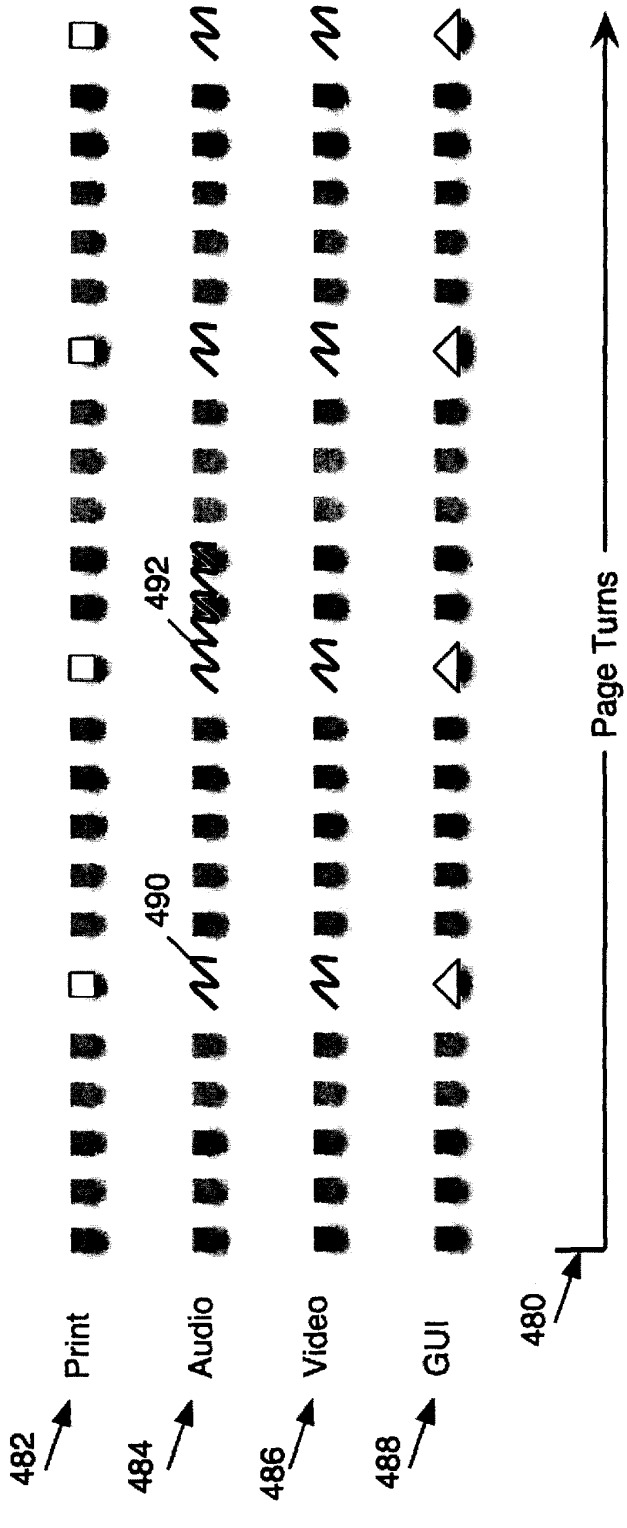
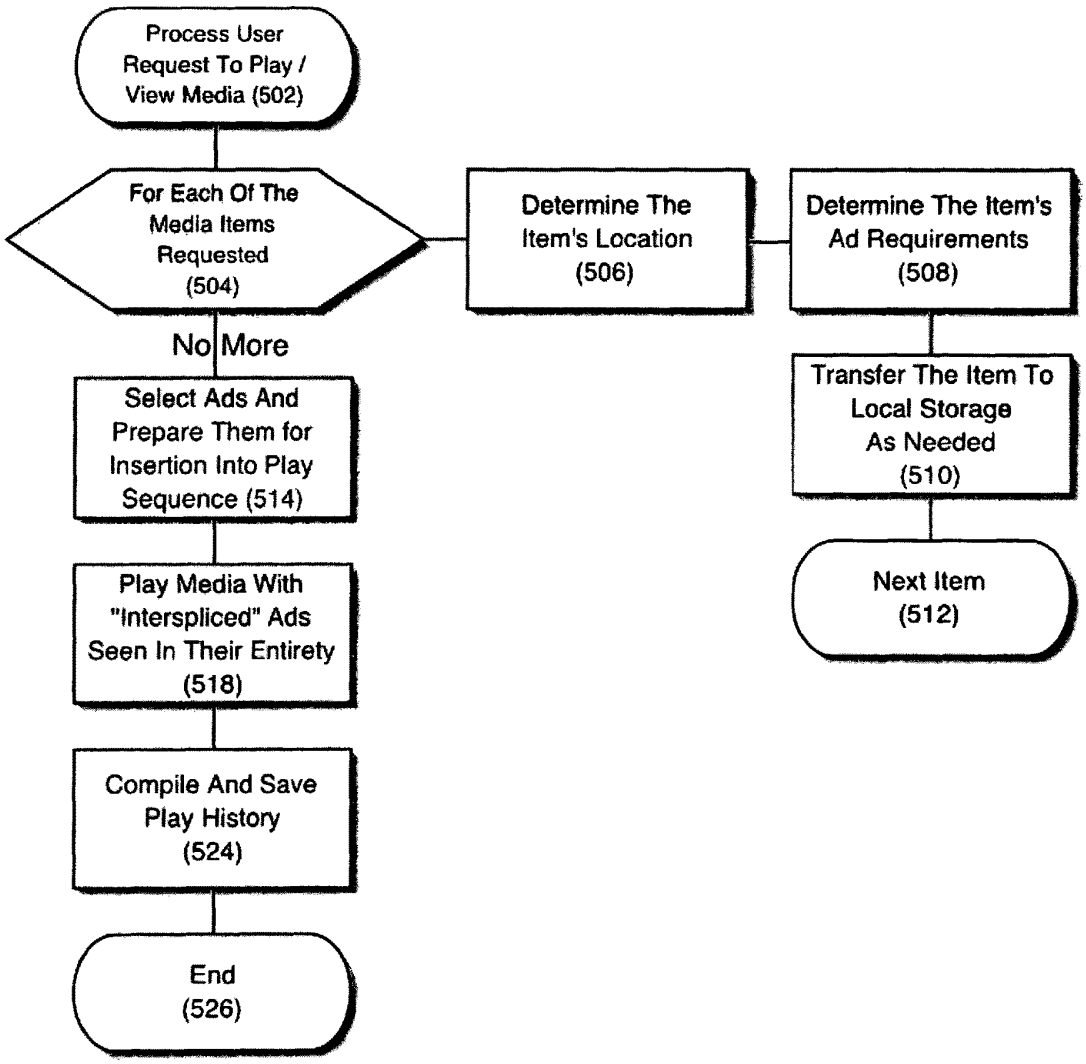


Figure 4B

Figure 5A


Process User Request To Play / View Media (502)
For Each Of The Media Items Requested (504)
Determine The Item's Location (506)
Determine The Item's Ad Requirements (508)
Transfer The Item To Local Storage As Needed (510)
Next Item (512)
No More
Select Ads And Prepare Them for Insertion Into Play Sequence (514)
Play Media With "Interspliced" Ads Seen In Their Entirety (518)
Compile And Save Play History (524)
End (526)

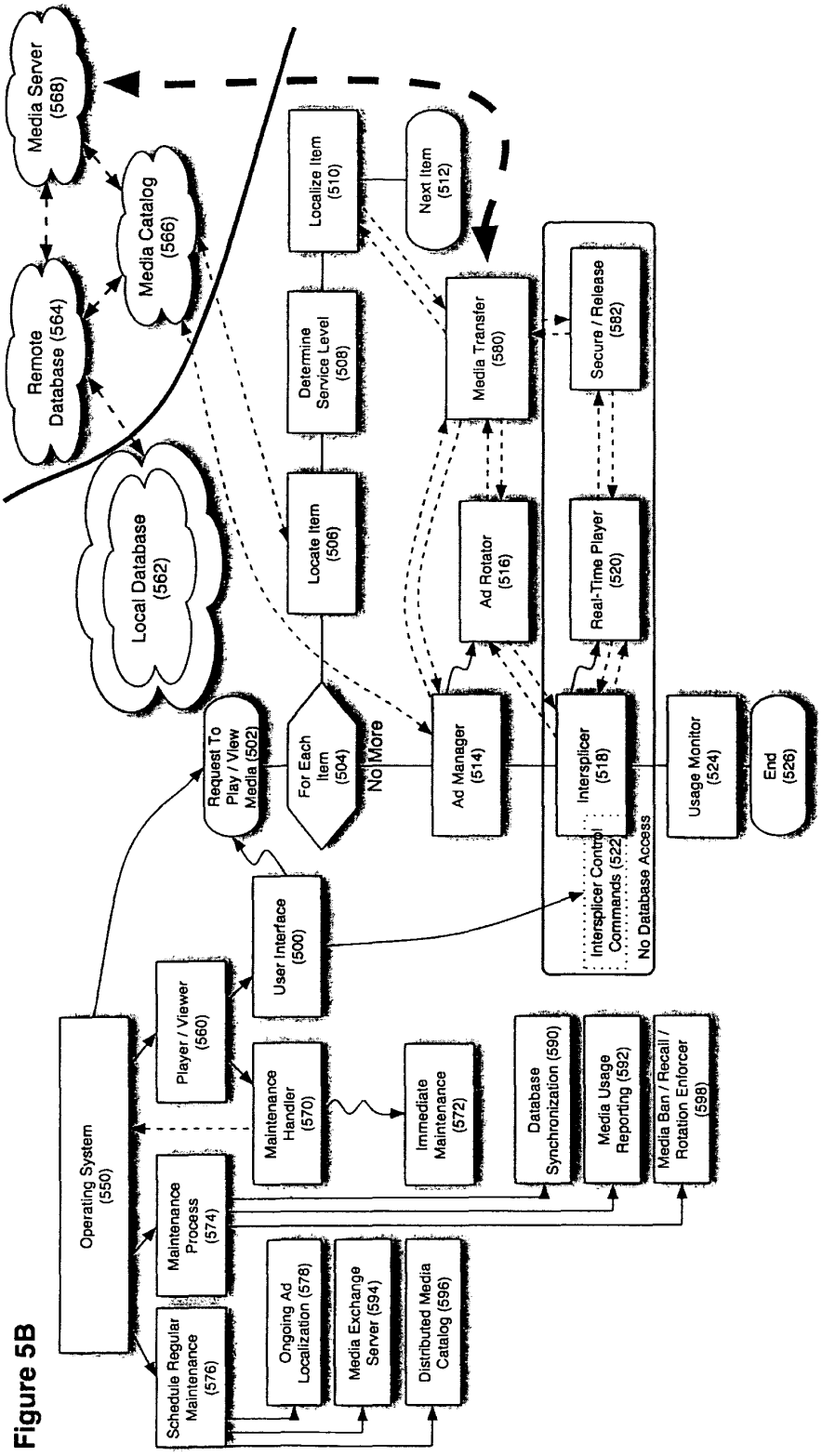

Media Server (568)
Media Catalog (566)
Remote Database (564)
Local Database (562)
Localize Item (510)
Next Item (512)
Determine Service Level (508)
Locate Item (506)
Media Transfer (580)
Secure / Release (582)
Ad Rotator (516)
Real-Time Player (520)
Request To Play / View Media (502)
For Each Item (504)
No More
Ad Manager (514)
Intersplicer (518)
Usage Monitor (524)
End (526)
Intersplicer Control Commands (522)
No Database Access
User Interface (500)
Player / Viewer (560)
Maintenance Handler (570)
Immediate Maintenance (572)
Database Synchronization (590)
Media Usage Reporting (592)
Media Ban / Recall / Rotation Enforcer (598)
Operating System (550)
Maintenance Process (574)
Schedule Regular Maintenance (576)
Ongoing Ad Localization (578)
Media Exchange Server (594)
Distributed Media Catalog (596)

Figure 5B

EXHIBIT A

Figure 6B

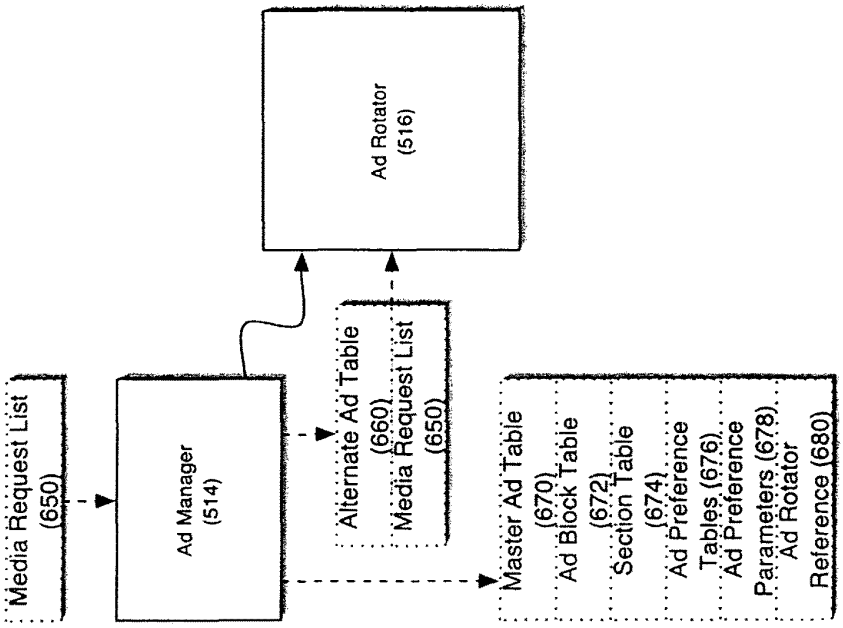


Figure 6A

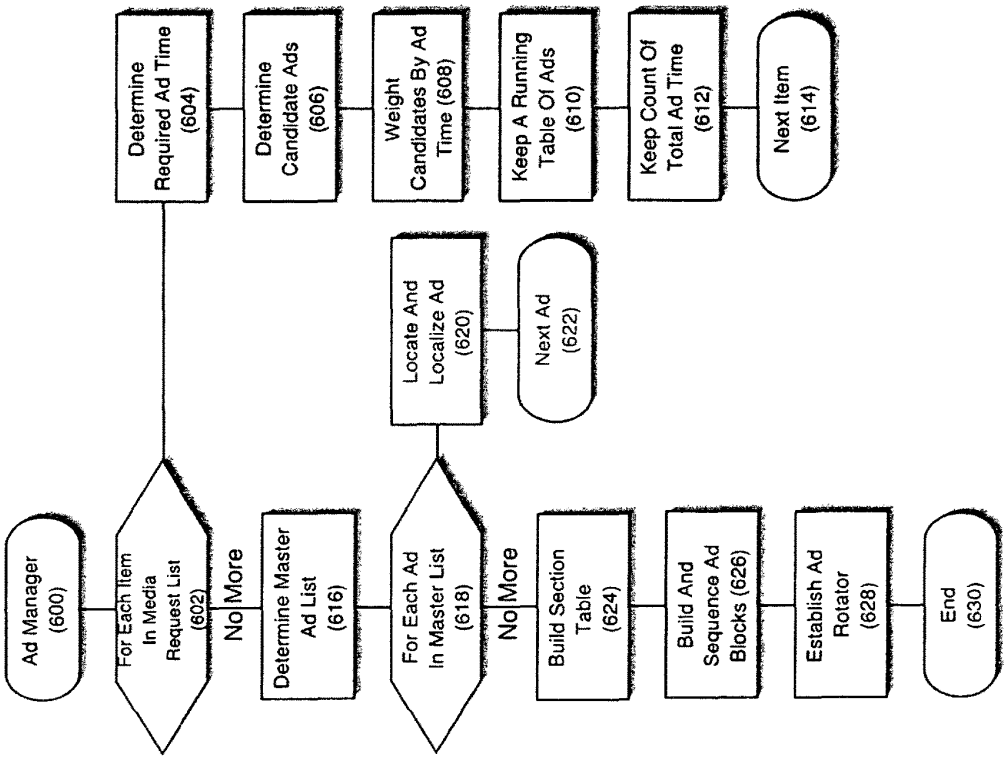


Figure 7B

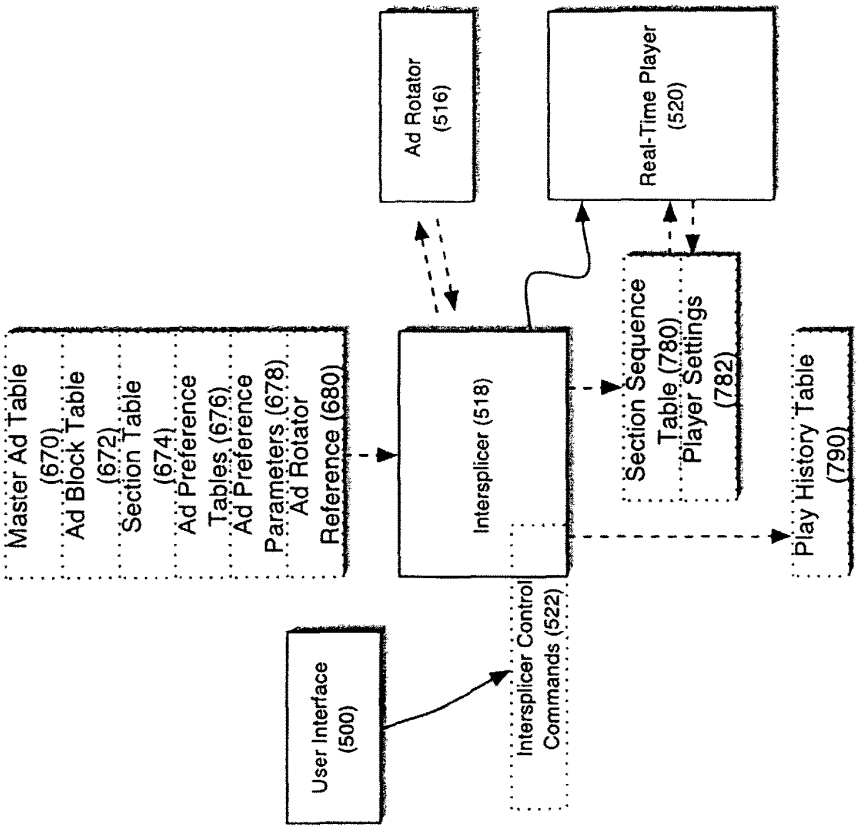
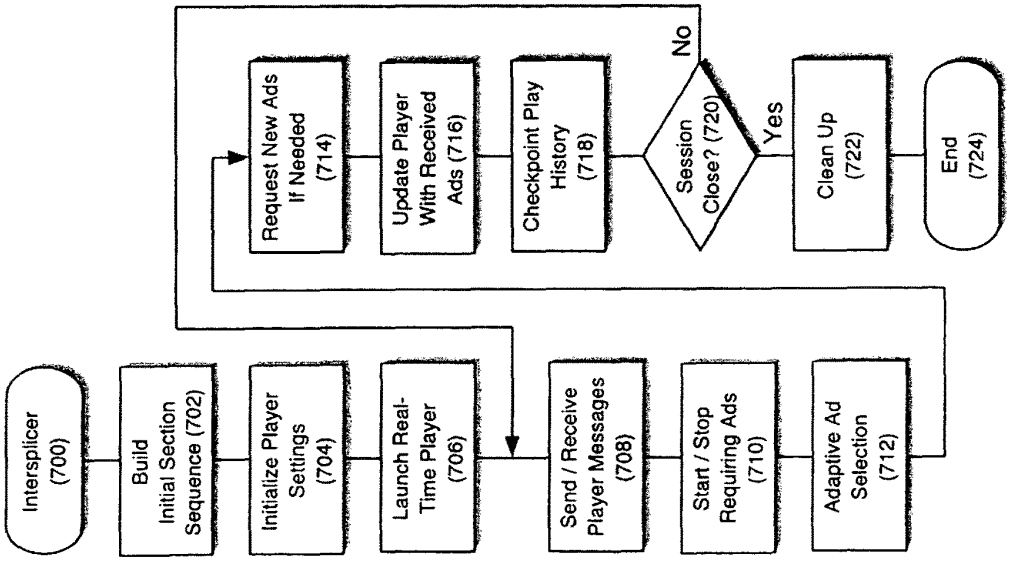


Figure 7A



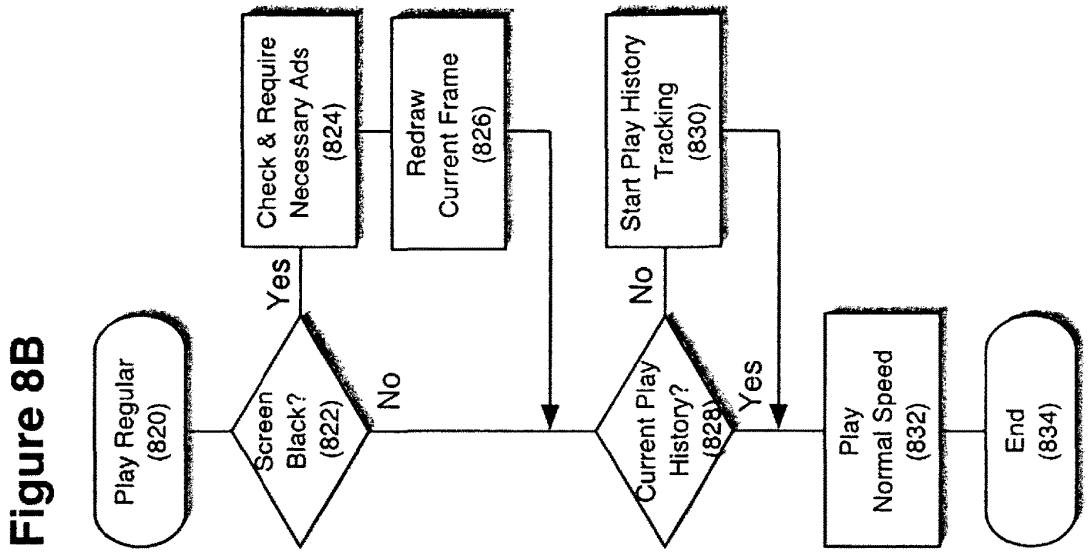


Figure 8B

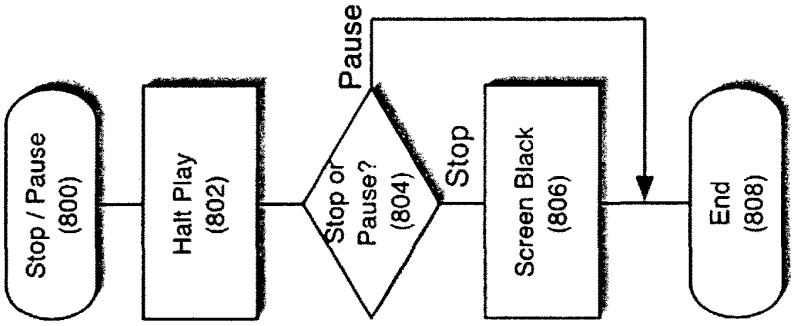


Figure 8A

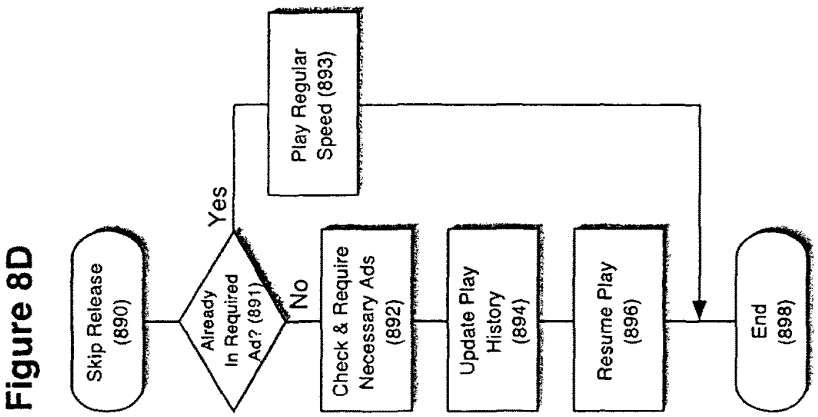


Figure 8D

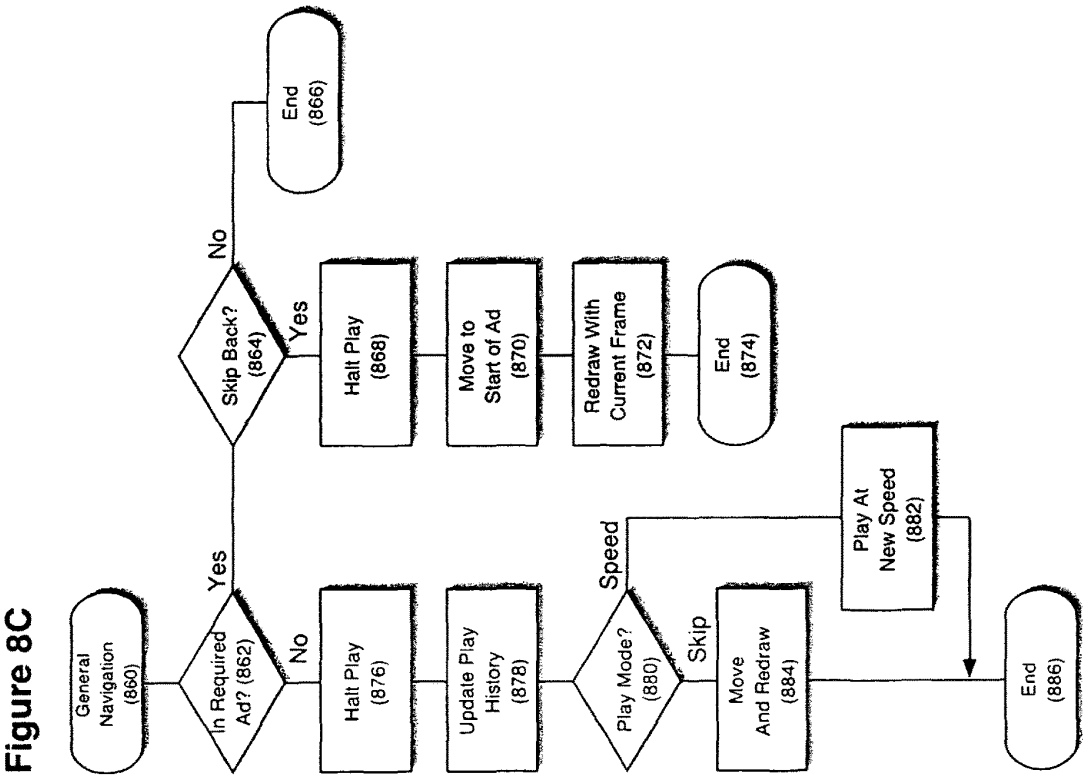


Figure 8C

EXHIBIT A

Figure 9C

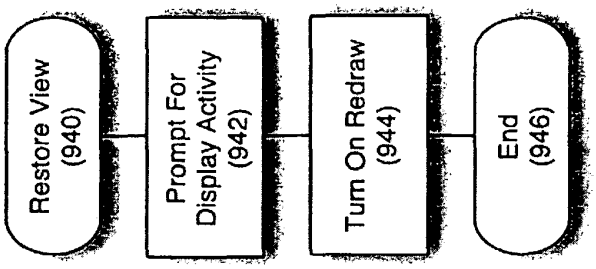


Figure 9B

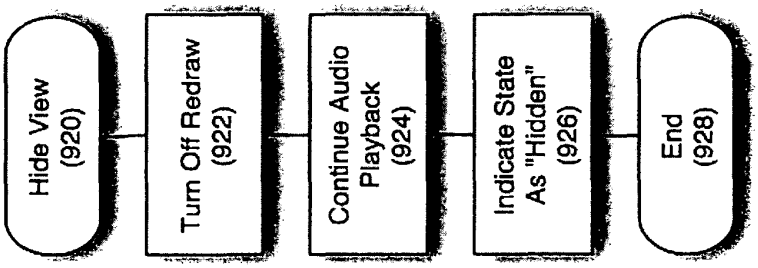


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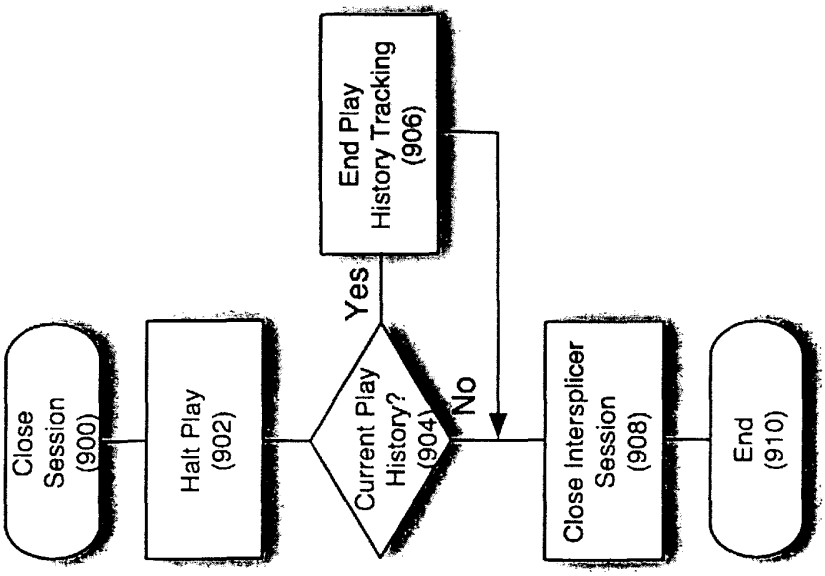


Figure 10A

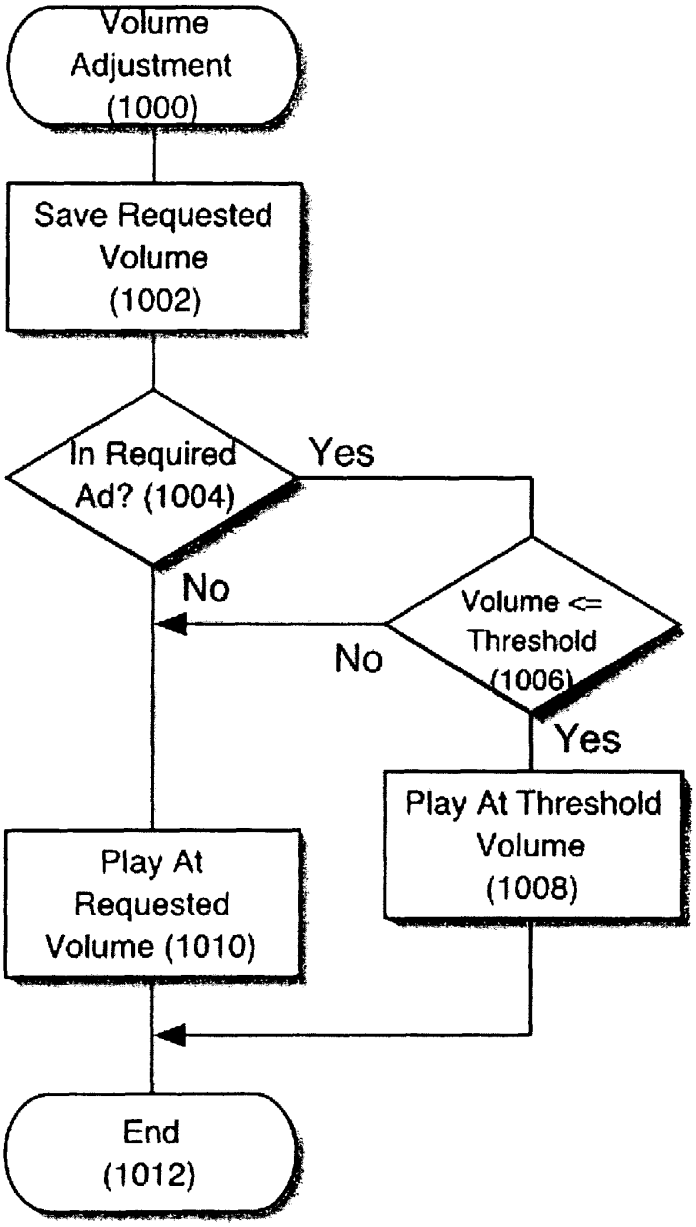
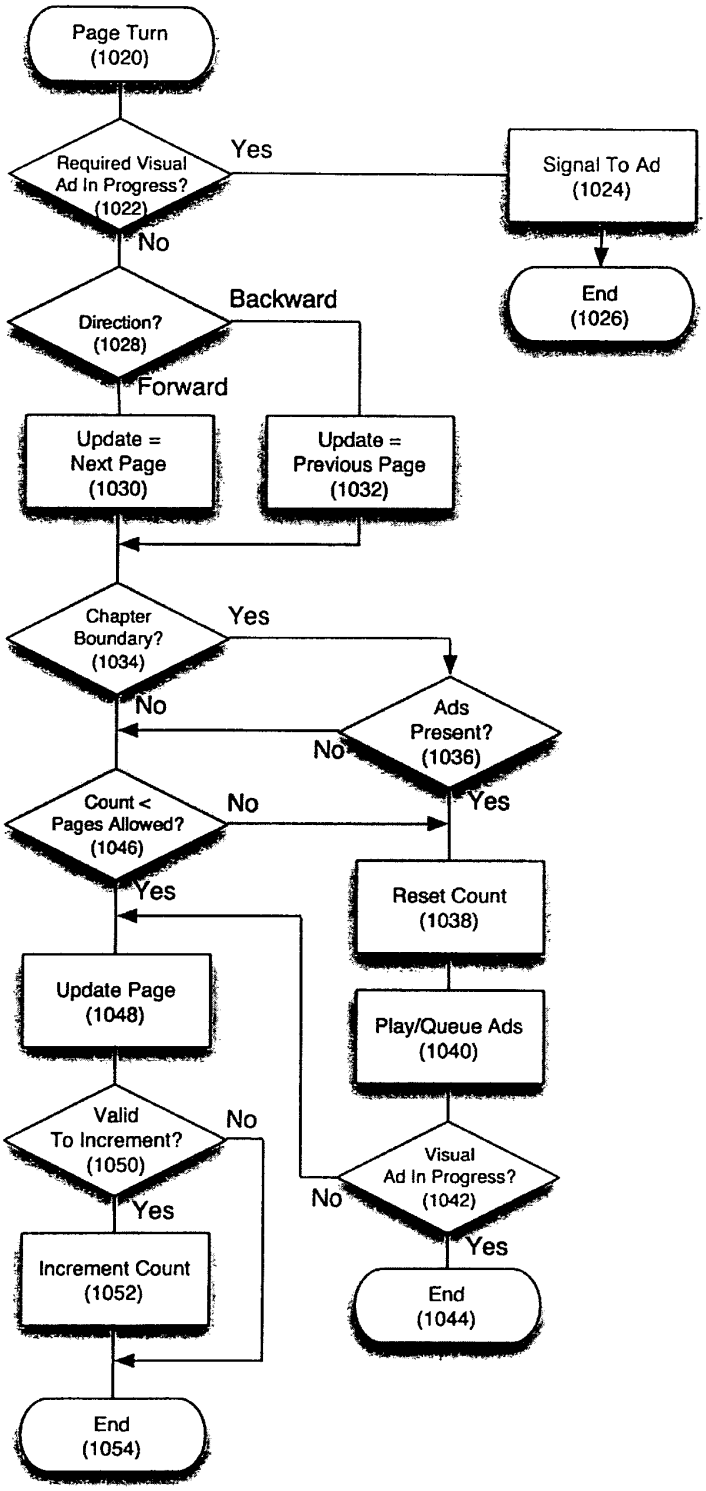

Volume Adjustment (1000)
Save Requested Volume (1002)
In Required Ad? (1004)
Yes
No
Volume <= Threshold (1006)
No
Yes
Play At Threshold Volume (1008)
Play At Requested Volume (1010)
End (1012)

Figure 10B


Page Turn (1020)
Required Visual Ad In Progress? (1022)
Yes
Signal To Ad (1024)
End (1026)
No
Direction? (1028)
Backward
Forward
Update = Next Page (1030)
Update = Previous Page (1032)
Chapter Boundary? (1034)
Yes
No
Ads Present? (1036)
No
Yes
Count < Pages Allowed? (1046)
No
Yes
Reset Count (1038)
Update Page (1048)
Play/Queue Ads (1040)
Valid To Increment? (1050)
No
Visual Ad In Progress? (1042)
No
Yes
Yes
Increment Count (1052)
End (1044)
End (1054)

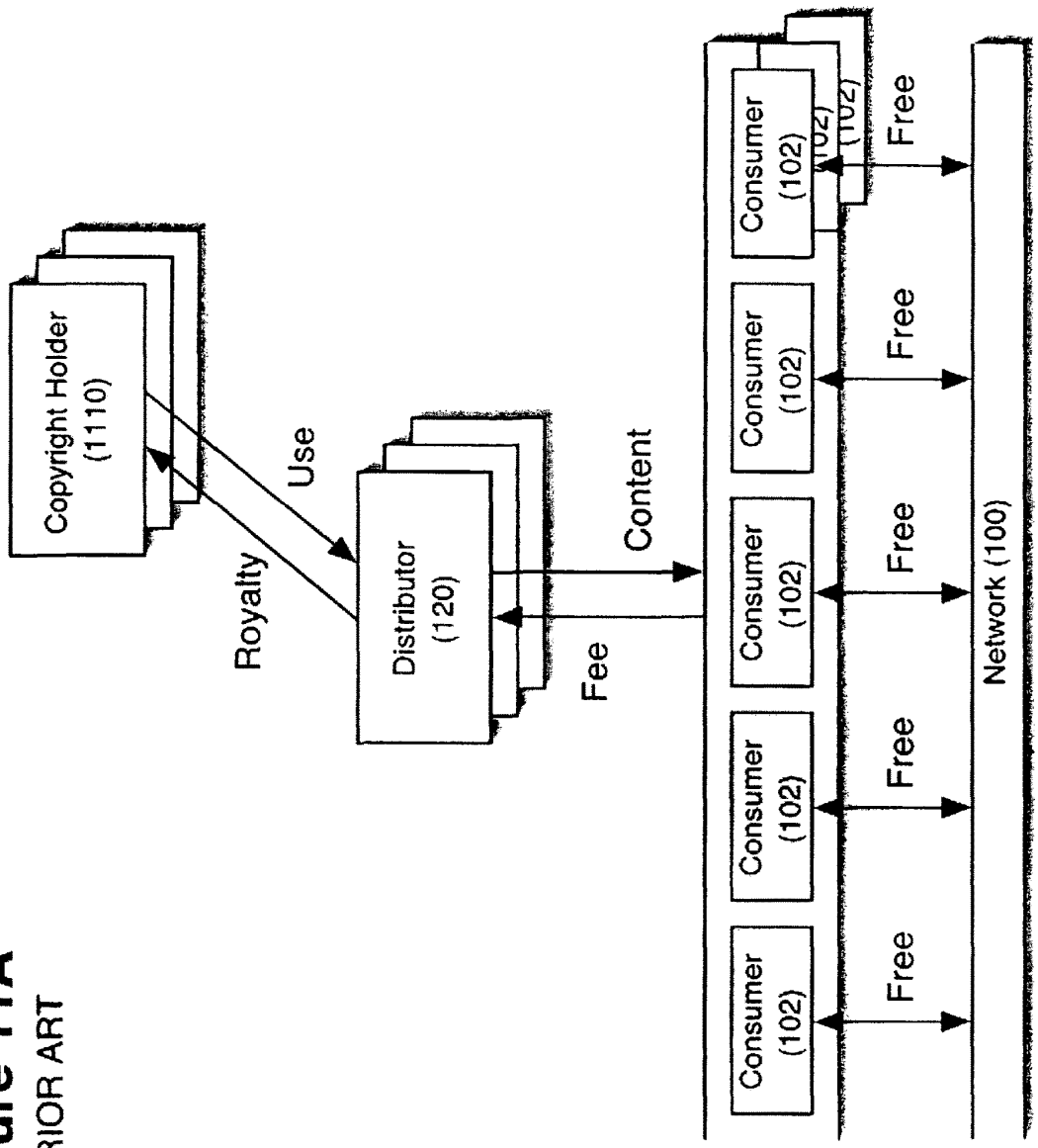


Figure 11A
PRIOR ART

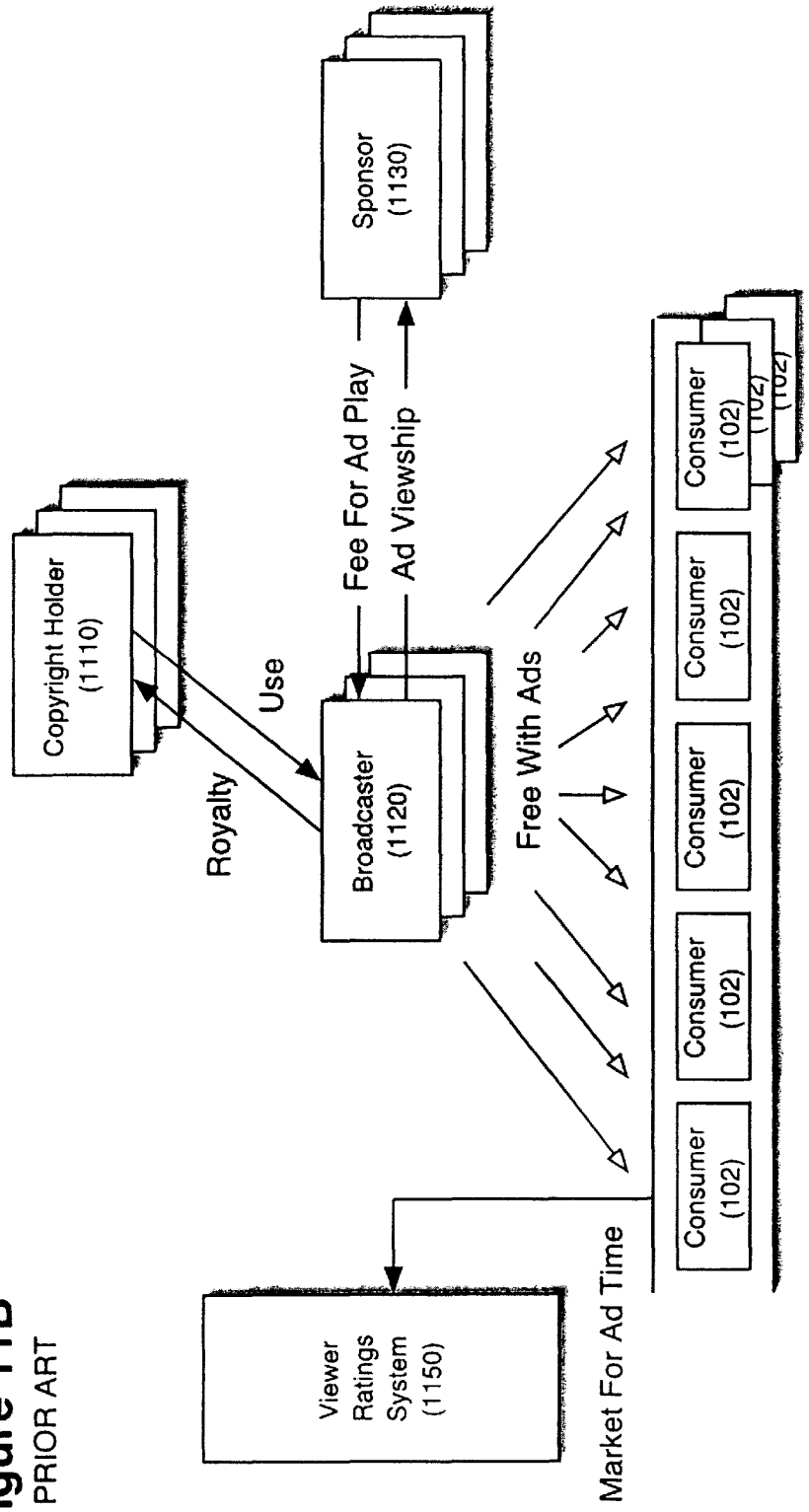


Figure 11B
PRIOR ART

EXHIBIT A

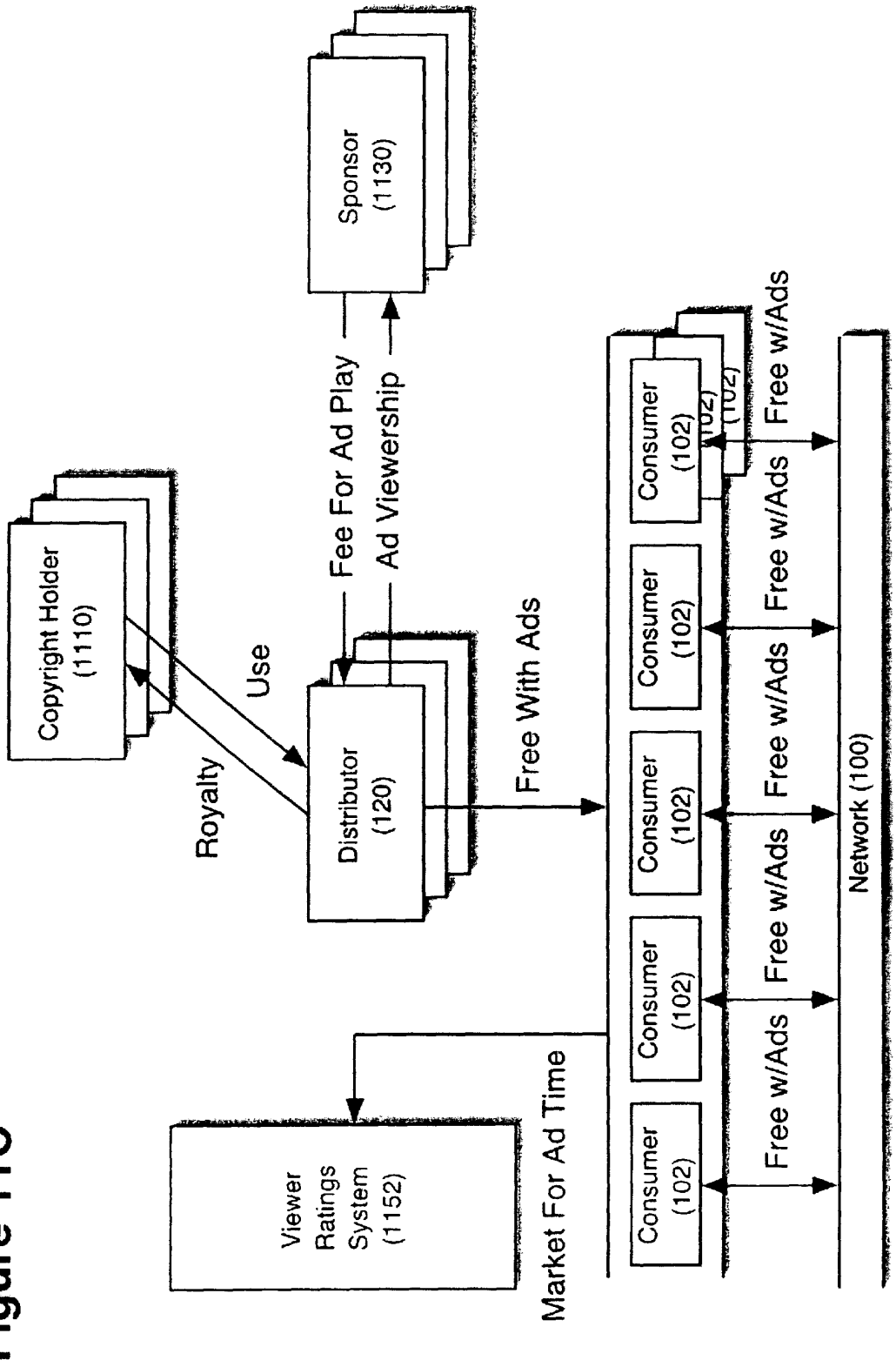


Figure 11C

EXHIBIT A

INTERACTIVE DIGITAL MEDIA AND ADVERTISING PRESENTATION PLATFORM

RELATED APPLICATIONS

This application claims the right of priority to U.S. Provisional Application Ser. No. 60/393,193 filed Jun. 27, 2002, and to U.S. Provisional Application Ser. No. 60/392,232 filed Jun. 27, 2002, each having at least one inventor in common herewith, both of which are incorporated herein by reference in their entirety.

BACKGROUND

Field of the Invention

This invention relates generally to the distribution of audio, video, and print media content, copyrighted or otherwise, via digital replication and delivery channels. More particularly, the invention relates to an apparatus and method for the wide digital distribution of media content in a way that allows the free use of media properties, on demand, with direct consumer exchange capabilities, while at the same time offering equitable return to the copyright holder, and providing for a strict level of control over the enforcement of license agreements on the part of the distributor.

Description of Background Art

The problem of widespread consumer-directed copying and redistribution of licensed material has in recent years become a critical concern for the motion picture, television, and recording industries. In light of this issue, publishing and other print media content providers have also had good reason to be apprehensive about digital delivery of their products.

As it stands now, there is much acrimony between the media copyright holders, distributors, and consumers over how to provide the convenience of digital delivery and replication of licensed material, while maintaining adequate control over its use and redistribution. New technologies to restrict consumer copying and unencumbered use of content have met with opposition and a determination on the part of some consumers to defeat them.

The distributor provides digital audio, video, and/or print media content to consumers, while maintaining the rights of copyright holders under a distribution agreement. Consumers desire to have free selection on demand from a wide range of content, and have grown accustomed to exchanging the media content in their possession in order to defeat the pay-for-use policy of the distributor. Given the nature of modern networked digital devices, the consumers' power to redistribute media files illicitly is formidable.

A number of methods for media distribution and licensing have been put into practice throughout the history of mass media. However, as discussed below the conventional methods and apparatus have inherent drawbacks that make it difficult for them to maintain their limitations to consumer access in the presence of modern digital technology and a consumer culture driven to defeat them in open defiance of the rights of copyright holders.

Broadcast Television, Broadcast Radio

Wide distribution of copyrighted material via broadcast television and radio, provided for free to the consumer population, uses the value of advertising promotion to generate revenue for the content creation and delivery system. Media broadcasting employs the practice of mixing licensed content with advertisements and other paid announcements in a pre-configured time sequence, then transmitting this sequence asymmetrically over the airwaves

to a large number of consumer receivers capable of showing the content in real-time as it is comes in. By virtue of the advertising sponsorship, broadcasters need not be concerned about the large number of consumers who view the content for free, and in fact, they seek the widest audience they can obtain, knowing that greater viewership leads to greater advertising revenue. Broadcasters benefit when their content is played with the commercials in tact, and they rely on the real-time nature of this distribution method to uphold this condition.

Cable Television, Cable Radio

Wide distribution of copyrighted material to the consuming population via cable television and cable radio is based on the concept of charging a recurring subscription fee, with select services available for a premium, to generate revenue for the content creation and delivery system. Pre-configured analog or digital media content, with or without commercial advertisement, is conveyed asymmetrically to the consuming population via coaxial cable. Cable is run to every home and other cable ready institution, without concern over the large and increasing size of this viewership, provided that all consumer receivers that get their signal from the cable are valid subscription users, and that select services are provided only to those subscribers who have purchased them.

To avert theft of service, cable delivery systems have employed a variety of signal scrambling methods to act as a form of encryption, providing means to decode the signal only to those subscribers who have paid for a particular premium service. Other technologies support the limited use of two-way signals on the coaxial cable, allowing subscriber verification on a receiver by receiver basis.

Satellite TV, Satellite Radio

Wide distribution of copyrighted material to the consuming population via satellite television and satellite radio is based on the same concept as those employed with cable television and radio, replacing the coaxial cable delivery apparatus with a system of orbital satellites and terrestrial receivers. Many of the subscriber verification and service level determination methods from cable have been facilitated in these systems via smart cards and other certification technologies incorporated into the satellite receiving equipment.

Pay-Per-View

Video On Demand (VOD) services based on user at-will consumption of asymmetrical content delivery is in use by cable, satellite, and internet based media delivery systems. Apparatuses to establish two-way communication enable the consuming population to request that content be delivered for a single use or limited time period, at any time upon request, rather than on an infrequent programming schedule of the delivery system. Pay-Per-View VOD allows for the immediate wide area distribution of live or prerecorded individual content without the delays associated with any physical circulation through retail locations.

Transmission Recording Technologies

All of the distribution methods described so far share a common shortcoming, which is that none of them can prevent the consumer from replicating and redistributing copyrighted material to others. Instead, they rely on the inherent limitations of consumer equipment to provide this control.

As consumer audio and video recording and editing equipment has become more commonplace, this lack of direct control has become a serious problem. New advances in technology reduce the time and labor associated with reconstituting broadcast material into a form that is otherwise available only for a fee, and the rise of digital tech-

nology has brought near perfect levels of fidelity and ease of reproduction to this equipment. When such devices are networked, the consumer gains the power to reproduce and disseminate copyrighted material at will, and there is little the copyright holders can do to stop or hold people responsible for this practice if it is widespread.

Retail Purchase of Licensed Media

Consumer retail purchase of copyrighted media is enabled by the availability of portable media storage receptacles, ever increasing in quality and capacity. Copyright holders have their content transferred to this portable media for sale in retail locations, through mail order, over the internet, and elsewhere. This method of distribution provides for high revenue generation while limiting explicit theft, however, once the media is removed from the retail environment, the consuming population has at its disposal multiple apparatus—including tape recorders, video cassette recorders, compact disk burners, digital video disk burners, and computer systems capable of reading the media directly, among others—available for the illicit manipulation, replication, and redistribution of purchased media.

Short Term Rental

Limited use of video cassette and digital video disc portable media is based on the ability of the consuming population to enter into rental agreements with licensed distributors through retail, mail order, internet, and other means. A small rental fee is relinquished in exchange for use of the media for a certain predefined time period. If, on expiration of this time allotment, the rented material is not surrendered to the licensed rental distributor, or is never surrendered, late fees may be accessed in an amount equal to or greater than the actual value of the media, in accordance with the terms of the rental agreement. While less costly than purchase of the media at retail locations, if the consuming population desires to re-use any media title, they must re-rent it, incurring additional rental cost and the added inconvenience of another trip to the rental location (or mail order or internet process).

Print Media (Books, Magazines, Newspapers, Other Periodicals)

eBooks and internet based periodicals have extended the physical print medium into the realm of the digital age by enabling the distribution channel to pare down the prerequisite paper volume and inherent bulk of traditional print media, while providing an efficient means of distribution and consumption. Electronic forms of print media require a computer or other digital device to navigate the representation of their print based content.

As it stands today, most newspapers and magazines in digital format bear little resemblance to their physical counterparts. They are commonly conveyed in a live website design which archives old content while sporadically presenting new subject matter. Given the ease with which audio and video media (which generally have much larger data file sizes) may be redistributed once they reach the consumer, publishers have been hesitant to release their content in a more familiar format, through digital means, for fear of widespread redistribution made possible by their diminutive file sizes.

Digital Video Recorder (TiVo, Replay TV, Ultimate TV)

Advances in home entertainment technology have given rise to a new breed of video recording systems based on the commoditization of components usually reserved for computer and other digital media manipulation devices. Digital Video Recorders (DVRs) record broadcast, cable, or satellite transmissions digitally to internal hard drive storage devices. Refinements to the first DVRs include the ability to eliminate commercial advertisements saved during the recording process and to redistribute recorded media from one DVR to another via an open network, such as the internet.

DVRs emulating this peer-to-peer technology provide an efficient means for consumers to redistribute digital media, but without central administration, they lack the necessary controls to prevent widespread redistribution of licensed media content beyond the level of personal use, to DVR users who don't maintain a license to consume the media.

Media Transfer (Burn CD/DVD, Transfer to Mobile Device)

Portability of media has been a hallmark of the technology revolution since the invention of the record album, and is based on the now usual and customary assignment of rights, allowing a consumer to play back, transfer, copy, and otherwise manipulate licensed media for personal use. Significant improvements in portable storage media over the decades have enabled the near perfect reproduction of media content in larger quantity to smaller storage media and other digital devices.

At present, to facilitate the highest possible reproduction standards, analog or digital content may either be 'burned' to Compact Disc or Digital Video Disc storage media, or transferred to digital devices which store the media on physical hard drives or other non-volatile storage apparatus. Once digital media has been transferred to these storage devices, it can be redistributed at will to others with the same ability to manipulate the media, including those who don't possess a license to do so.

Media Sampling

Pre-sales and pre-broadcast content delivery is based on the marketing principle of using promotion to generate sales and/or viewership. Media sampling turns a small section of a copyrighted content property into a revenue-generating advertisement, and redistribution of the sample adds value for the copyright holder. Sampling takes on many forms depending on the nature of the media, and these forms include listening stations in record stores, movie trailers shown prior to the feature presentation or through broadcast means, and television promos for upcoming shows. Given that media sampling in its current form is little more than promotional advertising, it does little to stem the tide of outlaw distribution.

The Internet (Web Sites, Pop-Up Ads, Redirects, Downloads, Subscription)

The rapid spread of networked computing devices has given rise to the Internet, a system for communication based on its ability to facilitate digital communication of thoughts, ideas, tools, art, and other valuable things, in a new and efficient digital manner. To connect, the consuming population generally enters into service agreements with Internet Service Providers who offer the means to get 'on-line' through computer modem dial-up, always-on cable, and other fixed access lines, as well as other wireless means of connection.

With the explosion of the World Wide Web and Email over the last several years, internet savvy consumers have become accustomed to receiving information on-line, much of it for free, as the world community wrestles with how to mature the Web into a tool for business and economy, rather than just for information distribution and collaboration. Efforts to defray the costs associated with keeping free content available on the Internet have included the use of banner advertisements on websites, pop-up advertisements, unwanted redirects to partner websites, voyeuristic monitoring of consumer habits for marketing and other data

mining purposes, and the creation of stealth networks which invisibly hijack the computing resources of unsuspecting users.

The prevailing free atmosphere surrounding the internet has encouraged many consumers to redistribute licensed intellectual property, including copyrighted print media, picture content, audio media, video media, and software, with open disregard for the use agreements binding upon them. Subscription services have arisen to offer consumers an alternative to the pervasive means by which free websites maintain their support, but they have done little to alter the consumer sentiment that the power to disregard copyright agreements with impunity gives one the right to do so.

Streaming Media (RealPlayer®, QuickTime®, Microsoft Media Player®)

Analogous to the old style nickelodeon movie projectors, streaming media content over open networked systems (i.e. the internet) provides an asymmetrical means by which media content may be delivered to consumers in a manner that strictly controls its use. A user makes a request for media via client software running on a computer or other networked digital device, and distribution occurs through a local software client that receives and presents said streamed media in its intended form only for as long as the streaming session is active. Though it provides significant copyright holder protection benefits, streaming media does not reside locally with the consumer, impeding the usual and customary right of the consumer to personal use applications such as making copies or recording for review at a later date or time.

Peer to Peer Networks (Napster®, Gnutella®, Morpheus®, Kazaa®, LimeWire®, Etc.)

Present peer to peer file distribution systems are based on advances in networking technologies and concepts which allow for the delivery of digital files directly from one member of the peer community to another without the need for central administration. Individual peer members make a request by way of entering search criteria into a local peer client software application, which then contacts other peers on the network as it searches for files matching the request criteria. Once located, such files are transferred directly from peer to peer. Peer to peer networks provide an efficient apparatus for the distribution of digital media, but without central administration, they lack the necessary controls to prevent the widespread redistribution of licensed media content to unlicensed members of the peer community. Several such systems appear to have been designed with this purpose specifically in mind.

Digital Rights Management

Digital Rights Management, or DRM, is a concept rooted in the notion that content owners may wish to maintain control over the digital distribution of their media. While DRM systems tend to vary in their technology and implementation, in general, they allow owners the ability to grant access to particular encrypted content, allow for authorized redistribution, and provide for transfer to portable media storage receptacles (amongst other assignable privileges) on an item-by-item, user-by-user, or some other basis. While DRM may provide a secure means for content owners to control distribution of their media with approval or denial of access to potential users, it has yet to be implemented in a manner consistent with offering a general license option for free use and redistribution.

Portable Media Access Management

Current "copy-lock" technologies are employed to control the method by which certain portable media storage receptacles such as CD's and DVD's can be used. Through methods which may include placing invisible directories or indiscriminant information at the beginning of the storage receptacles, copy-lock seeks to grant access to the media through some devices while restricting access on others which the copyright holder feels may be used to violate its rights. These methods generally allow for the playback of media content through traditional home entertainment devices while limiting their use in digital reproduction devices such as desktop computer systems. While copy-lock technologies may prove an effective means to curb the ease with which consumers at present may redistribute media through a digital network or media transfer process as outlined above, in their current embodiment they seriously limit the usual and customary rights to personal use and can generally be worked around with the aid of fairly ubiquitous analog technology—commonly referred to as the "analog hole."

To the inventor's knowledge, there is currently no conventional digital media distribution method in practice that incorporates the free consumer-directed access and exchange of content with the distributor-directed control of media sequencing after all such exchanges.

SUMMARY

It is an object of the present invention to provide a revenue generating market for the free consumer redistribution of media content, sponsored through paid advertising that a consumer may be required to experience during the course of media playback, provided by means of a system and/or method that offers the benefits of content restriction and controlled playback, working in conjunction with customized, addressable advertising on an individual consumer basis, with monitoring of content use and ad penetration to track audience viewership.

In accordance with the above objects and those that will be mentioned and will become apparent below, one particular embodiment of the digital media distribution method and apparatus in accordance with this invention comprises an interconnected network of computer systems and other digital devices, for use by a multitude of human consumers who access and use media content by way of these networked devices, a distributor who releases media content to consumers over the network, and a software application that imposes limitations on the consumer's use of media content.

The application software functions primarily as a media presentation "player/viewer", capable of running audio, video, and print media content. There is the provision for compatible versions of the player/viewer software to run on most consumer digital device and computer systems. The player/viewer software applies digital rights management techniques to control consumer use of media in a novel way. The player/viewer allows for a "general license", whereby a consumer can obtain free use of a media property, with strict controls enforced during media playback.

These enforced controls amount to the intermittent insertion of paid commercial advertisements and other promotional material into the time sequence of the media content during its course of presentation, along with the temporary disabling of certain user controls to ensure that this material is presented in its entirety. The consumer gains free use of content in exchange for exposure to these paid advertisements.

Some of the forms these advertisements may take are novel in the realm of digital advertising over open networks. Advertisements may occur in the same media style as the content. That is, in addition to any software-controlled

advertising methods in ordinary practice on consumer digital devices, audio ads are inserted into audio content as they have traditionally been heard in radio broadcasts, video ads are spliced into video content as they have traditionally been seen in television broadcasts, and print ads are interspersed with print content as they have traditionally appeared in newspapers and magazines. In addition, for book and other print content, there may be, according to the invention, audio ads played at certain intervals, similar to those traditionally heard over the radio.

Rather than strictly granting or denying access to secured content, one particular method of the invention provides for unlimited redistribution and free use under general license, enforced by the player/viewer software. This is a new use of digital rights management practices, and it provides improved security by diminishing incentive on the part of the consumer to breach the system, since the desired content is already available free-of-charge from within it.

The player/viewer software has the means to assemble a new, customized sequence of requested content, interspliced with promotional material every time it runs, selecting appropriate ads on demand from a greater repository. Ads are selected on the basis of requested content and other specific information that the system maintains about consumers and their media/ad play histories, and new ads may be chosen even when reusing the same content.

Where demographic, geographic, or other relevant user and/or system information is available, the player/viewer software can apply targeted marketing in the ad selection process. Targeted marketing takes the form of addressable advertising, which not only identifies a select advertising candidate list, but additionally verifies that individual ads were received and consumed by the intended recipient. This custom-selection of advertisements, addressable to unique users, conducted by software running on the consumer's device, is a novel use of new and existing technologies.

In the course of playing or viewing media content, the application software automatically edits the selected advertisements into the presentation stream. The novel "intersplicer" module providing this functionality enforces the conveyance of required ads in their entirety at least once, by disabling certain user playback controls while the ads are running. This module also has the power to adaptively select and re-sequence the ads to be shown in response to the user's navigational actions throughout the content, and keeps a history of all the content and advertising material that is presented.

After monitoring content use and ad penetration in the course of running media, the software provides a usage monitor that compiles this data after a play/view session is finished, possibly reporting it back to the distributor. Where such reporting occurs, this functionality gives the distributor the power to measure audience viewership of media content and advertisement penetration, provide for ad rotation, and generate valuable ad usage statistics. For media, the data records provide a detailed profile indicating the number of repeated times that each part of the content is consumed. This novel improvement allows the distribution system to derive greater value from media that is redistributed to a wide audience, through better knowledge of viewership patterns on an item by item basis.

The player/viewer software may employ a distributor-controlled licensing database, allowing the system to track a variety of service types by which a particular user could license a particular media property. Such a database also gives the distributor complete control over the system, providing the player/viewer the ability to grant or deny service altogether, depending on the property and/or the user. In this way, the present invention endows the distributor with the complete power to limit consumer use as directed by the copyright holder, on a property by property basis, and to adjust the amount of required advertising as needed. Local mirrors of this database on consumer-accessible devices are secured via digital rights management, so that the consumer cannot access them outside the running player/viewer software.

The software may also make use of a distributed media catalog for the purpose of locating particular media content throughout the distributor's system, and a hybrid central server and peer-to-peer media transfer system, by which secured media files are delivered to a consumer system upon request. When a centrally administered database for digital rights management is employed in conjunction with peer-to-peer file exchange of secured media content, in a distribution system that provides multiple service levels and types, including a general license to allow free viewing with ads, carried out by player/viewer application software running on the consumer device, there is a new and improved use of these technologies.

Through this software apparatus running on individual consumer systems, the present invention functions as a new use of the traditional broadcasting business model, which acts as an improvement by adding value to freely exchanged copies of media, distributed over a digital network. By coupling the long-standing broadcast media practice of commercial advertisement sponsorship with the appeal of select, on-demand, consumer-level redistribution over a digital network, the consumer gets the conveniences of virtually unlimited free media selection, instant access, and unrestricted sharing, while the copyright holder gains a tangible value from the increased viewership that results, through an apparatus that makes it possible to maintain explicit control over media use throughout.

The consumer is free to select and program any desired sequence of content, and the player/viewer software has the ability to present this material with ads inserted, while it monitors and measures all use of media and ad content, including repeated use of the same material. Through its use of paid advertising and sophisticated audience monitoring, the invention improves on current digital media distribution practices by creating an advertising-based market for unlimited free consumer use and exchange of media content over a digital network. The content use restrictions resulting from this distribution method and apparatus are an improvement over currently practiced methods, in that they benefit both consumers and copyright holders.

BRIEF DESCRIPTION OF THE DRAWINGS

Further features and advantages will become apparent from the following and more particular description of particular embodiments of the invention, as illustrated in the accompanying drawings, wherein like referenced characters generally refer to the same or similar parts or elements throughout the views, and in which:

FIG. **1** illustrates a networked computer system for the wide distribution of digital media content, according to one embodiment of the invention;

FIG. **2** illustrates a consumer computer system, according to one embodiment of the invention;

FIG. **3**A illustrates the player/viewer software graphical user interface, according to one embodiment of the invention;

FIG. **3**B illustrates an economic value comparison of existing digital media distribution practices against one particular method and apparatus of the invention;

FIG. **4**A is a schematic diagram illustrating the sequence of play for common audio/video media use sessions, according to one embodiment of the invention;

FIG. **4**B is a schematic diagram illustrating the sequence of viewing for a typical print media use session, according to one embodiment of the invention;

FIG. **5**A is a flowchart illustration of software operation in response to a user request to run media content, according to one embodiment of the invention;

FIG. **5**B is a block diagram illustrating certain software components that operate together to carry out the method of FIG. **5**A, according to one embodiment of the invention;

FIG. **6**A is a flowchart illustrating one particular method for performing the ad selection operation of FIG. **5**A, according to one embodiment of the invention;

FIG. **6**B is a block diagram illustrating in more detail the flow of data between certain software components operating in FIG. **6**A, according to one embodiment of the invention;

FIG. **7**A is a flowchart illustrating one particular method for performing the intersplicing operation of FIG. **5**A, according to one embodiment of the invention;

FIG. **7**B is a block diagram illustrating in more detail the flow of data between certain software components operating in FIG. **7**A, according to one embodiment of the invention;

FIGS. **8**A-**8**D are flowchart illustrations of software operation in response to user-generated playback control events, according to one embodiment of the invention;

FIGS. **9**A-**9**C are flowchart illustrations of software operation in response to user-generated display control events during playback, according to one embodiment of the invention;

FIG. **10**A is a flowchart illustration of software operation in response to user-generated audio-level control events during playback, according to one embodiment of the invention;

FIG. **10**B is a flowchart illustration of software operation in response to user-generated print media viewing control events, according to one embodiment of the invention;

FIGS. **11**A-**11**B are schematic illustrations of prior art business models employed for the purpose of media content distribution; and

FIG. **11**C is a schematic illustration of one particular business model capable of implementation with various methods and apparatus of the invention.

DETAILED DESCRIPTION

Referring now to FIG. **1**, there is shown a diagram of a networked computer system for the wide distribution of digital media content over at least one public or private telecommunications network **100**, such as the Internet. The system supports both client-server and peer-to-peer network communication architecture models, as well as any other networking methodology that can operate according to the invention.

A multitude of consumers **102** use their individual computer systems **104** and **110** or other digital device systems **106**, **108**, and **114** to play and view a variety of media content. Any consumer-used computer device **110**, digital device **114**, or storage medium device **112** that is capable of a temporary or ongoing digital transfer connection to any of the networked systems **104**, **106**, **108**, and **110**, either directly or indirectly, is also to be considered as part of network **100** if the device ever stores or runs any media that is an original or copy of content distributed by way of the present invention.

For instance, at a time when computer **110** is connected to network **100**, consumer **102** may via the method of the invention obtain media that is then stored on the hard drive of computer **110**, in order to use it at a later time when the connection is not available. If this media data is copied to or used with device **114** via removable storage medium **112**, then device **114** is to be considered as part of network **100** according to the invention.

A distributor **120**, shown in the figure as a box, is a person or business entity employing or participating in the method of the invention to release digital media content titles and tracks to consumers **102**. A "title" refers to an individual stock keeping unit, as managed by the distributor. A "track" is a self-contained portion of a title that a consumer may specifically order separately.

Titles and tracks are media content, occurring in any combination of video, audio, and print forms, or any other media format now known or later developed. Video refers to any media that consists of moving pictures, with or without sound, in a page-free context, including, without limitation, a film, television show, documentary, short subject, or music video. When audio accompanies video, the content is still classified as video. Audio refers to any media that contains audio only, in a page-free context, including, without limitation, a short musical track, such as a rock or popular song, a long musical piece such as a symphony or rave music track, or an audio program, such as a lecture, speech, radio drama, or book on tape.

Print media forms include any static or software-driven content that employs text and/or images laid out into pages, including, without limitation, a newspaper, magazine, book, reference material, or user-interactive hypermedia document. Print media may contain audio and/or video material, but if the primary value of the content involves page layout, it is classified as print media. However, when page-based operations take place within a single video area, and are subsidiary in value to accompanying video content, the media is video. For instance, the page-based menus on a DVD count as part of video media content, even though they involve text, menus, and pages.

Any audio, video, or print media content may also include extra application software code and/or document data as a part of it. Such code/data provides the player/viewer with specific logic functionality to accompany the content. The menus and text that accompany DVD format movies are a prime example of this kind of code/data.

Distributor systems **122**, **126** are those computers and devices on network **100** that are secured under strict control of the distributor **120**. Apart from these distributor systems, there may be a very large number of "consumer systems"—a term to denote any computer or other digital device under unrestricted consumer control and having either direct or indirect access to the network **100**. Such a consumer system may be, among other things, a computer system, a digital audio/video recorder, a portable playback device such as a palm-top computer or MP3 player, or a removable storage media device such as a computer with a read/write CD/DVD drive or a standalone CD/DVD player.

Distributor systems **122** act as media distribution centers, using a software firewall or other means to secure them from unauthorized consumer access, and allowing consumer systems to interact with them for the purpose of exchanging media and/or data according to the invention. Distributor systems **122** may be interconnected on an isolated or oth-

erwise secure extended network **124**, or possibly through a software-secured layer on open network **100**. The media distribution centers **122** coordinate their activities and maintain consistent databases via network **124**.

Also on the distributor's network **124** is a file server **126**, which handles the transfer of media content **128** to the media distribution centers **122** as needed. Though not shown, different distribution centers **122** may be connected to different open distribution networks, to facilitate distribution over multiple networks. Also, a number of media provider organizations **130** doing business with the distributor may facilitate the transfer of media content **134** to either consumer systems **104**, **110** or distribution centers **122** via one or more of their file servers **132**, which may either act through the open network **100**, or be connected to the distributor's network **124**.

The distributor is free to employ any database and file server design to suit the needs of the distribution network, provided it operates in compliance with the invention. For instance, the design might involve a secured, distributed database, administered to maintain a catalog of all media titles, the service types offered for each title, user profile and billing information, user demographic information, user/software registration data, user/title licensing data, security keys, a catalog of advertisements, user/ad viewership history, title/audience viewership history, and other statistics. Alternatively, a minimal database might maintain nothing more than a catalog of titles and advertisements, providing distributor **120** with a much lower amount of control over the system.

Acting as a server, each distribution center **122** may operate with any number of consumer-use computer systems **104**, **110** or web-enabled devices **106**, **108** over the network **100**. It is also possible, according to the invention, for consumer systems **104**, **110** and devices **106**, **108** to exchange media over shared network **100** on a peer-to-peer basis. For instance, when it has network access, consumer system **110** may direct another consumer system **104** to deliver particular media content to it. Media files exchanged in this way are secured from the consumer through digital rights management practices.

In the peer-to-peer context, a consumer system may act as either a client or a server. In the previous example, computer **110** acts as a client when requesting the media from computer **104**, which acts as a server to handle the request. If peer-to-peer functionality is indicated, the player/viewer software described below includes peer-to-peer server control logic, which it may run or launch as a background maintenance task or process, or alternatively have the system launch automatically from time to time by modifying the system's startup or operating environment.

In one embodiment, the invention employs a distributed database, operating as a centrally administered digital rights management server on one or more media distribution centers **122**, working in conjunction with an open peer-to-peer distribution system of secured media content, in a manner that offers the licensing of possibly multiple service types, while including at least one service type intended to allow widespread free viewing of distributed content on the part of the consumer, while still upholding value of use for the media copyright-holder. Under this scenario, the peer-to-peer functionality may be transparent to the consumer. In particular, when computer **110** requests media from distributor systems **122**, distributor **120** may instruct computer **104** to act as a server to handle some part, or all of the delivery of the media request in place of distributor systems **122**, giving the appearance that the media request is being fulfilled by the distributor. When database management, file exchange, and digital rights management technologies are used together in this novel way, in conjunction with the application software described below, there is a new and improved use of these technologies.

To achieve this improvement, the apparatus and method of the invention employ a new use of a traditional business model on a client-by-client basis over a digital network, through the use of novel media player/viewer software running on individual consumer systems to act as an apparatus for carrying out this model, as embodied in the parts of the software described in detail herein.

Referring now to FIG. **2**, there is shown a more detailed diagram view of a representative consumer computer system **104** (FIG. **1**), to illustrate some of the hardware components which, when controlled by the method implemented in the novel player/viewer application software, comprise one aspect of the invention. The distribution network and method described in FIG. **1** work in conjunction with the software application described below, which operates on ordinary consumer computer and other digital device systems, such as the one described here.

Computer system **104** has a conventional architecture, which includes a processor **202** and volatile RAM memory **204** coupled to processor **202** through an interconnect **200**. Memory block **204** includes an ad-intersplicing player/viewer **560**. While player/viewer **560** is shown as a complete functional block within memory **204**, it should be understood that player/viewer **560** includes stored code (e.g., on file storage **210**), portions of which may be transferred into and out of RAM memory **204** as needed. Interconnect **200** may be a system bus or any other apparatus that is employed to connect components such as these in a consumer-grade computer system.

Also coupled to interconnect **200** are internal peripheral hardware devices, such as file storage **210**, which may be a hard drive or other persistent storage peripheral, and removable media internal device **212**, which may be a floppy drive, ZIP drive, CD-ROM or DVD drive, CD/DVD read/write drive, or any other removable media drive.

Internal peripheral devices connected to interconnect **200** also include those for the generation of physical sounds, such as sound card **208** and speakers **224**, those for the real-time display of graphics, such as graphics card **206** and computer display **222**, and those to communicate over networks, such as network interface adapter **242** and dial-up modem **240**.

Interconnect **200** also serves a number of common I/O ports **220**, including those for keyboard **228**, mouse **230**, other connected I/O devices **236**, printer **226** for persistent output, and any external I/O ports **220** that are available to connect system **104** to other, external peripheral devices, such as portable playback device **232**, external recording device **234**, or external network connection device **244**. External recording device **234** may be, among other things, a CD player/burner or a DVD player/burner.

Computer display **222** is any type of volatile computer display device including without limitation a cathode ray tube (CRT), a light-emitting diode (LED) display, or a liquid crystal display (LCD). The other connected user I/O devices **236** may include any type of user input or output devices including, without limitation, a numeric keypad, a pointing device such as a trackball, light-pen, touch-sensitive pad, digitizing tablet, thumb wheels, or joystick, or a nonstandard display device or printer.

Network interface circuitry **242** couples computer system **104** to open computer network **100** (FIG. **1**). Where high-

bandwidth network service is absent, modem circuitry **240** allows the system to connect to network **100** by dial-up over ordinary telephone lines. It is also possible to connect to network **100** through alternative means by way of an external network connection device **244**, which connects to network **100** directly and transfers network data to system **104** by way of an I/O port **220**.

The invention applies to these and any other hardware components that may be employed in a consumer-grade computer system or other digital device to carry out the ends of the media player/viewer software described herein, whether or not they resemble or perform the same specific functions as those components shown in FIG. **2**.

The Player/Viewer Application Software

Media titles and tracks that the distributor **120** (FIG. **1**) releases, either by streaming broadcast delivery or by copy on demand, over digital network **100** (FIG. **1**) are to be seen and heard primarily through the use of program software applying the method set forth herein, on consumer media device systems supporting the use of such software. Different device/computer hardware platforms and operating systems, including embedded devices, may require custom versions of the software, and each such version is to carry out the method of this invention to the best of all practical ability within the constraints of its operating environment.

This software generally provides the functionality to run audio, video, and print media, as defined above, to the extent that the specific device on which it is running supports each of these media forms. On platforms that support graphical user interfaces and multitasking or multithreading, the software is implemented as a full-fledged "media player/viewer", offering multiple panels and/or windows to switch between any number of user-initiated media presentations.

Referring now to FIG. **3**A, there is shown a diagram of the player/viewer software's graphical user interface, as it might appear on computer system **104** (FIGS. **1** & **2**). It provides the ordinary functionality commonly found in typical media player software applications, and the software design methodology behind its implementation, delivery, and installation may be ordinary or new, as long as they result in software that behaves as specified in this description. For sake of further discussion, the term "user" will be taken to be synonymous with consumer **102**, from this point forward.

Installation of the software on computer system **104** (FIG. **2**) or any other consumer device system stores the player/viewer program code appropriate to the specific system somewhere on its persistent file storage **210**, or possibly in read-only memory (ROM) depending on the device. Installation may also modify the operating system to launch maintenance and server programs as background processes, either at startup or at some other specified time interval. Consumers **102** may carry out the installation process on their own systems, while other systems may ship with the software pre-installed as they are manufactured.

The player/viewer's user interface (FIG. **3**A) takes direction from a consumer by appearing on the consumer's display device **222** and giving audio and/or visual feedback to the input actions of its user. The functional style in which this player/viewer appears to the user may follow ordinary practice in the design of such interfaces, or it may involve a different and possibly new look and feel, as shown in the figure.

Such a player/viewer may also offer functionality through panels and/or windows for any of a wide variety of other conventional services, including without limitation internet browsing, internet chat, networked video gaming and tournaments, video conferencing, content aggregation, office productivity, email, secure business document distribution, and special interfaces for online auctions, event schedules, and ticket purchasing for movies, concerts, operas, ballets, sporting, and other events. Additionally, the player/viewer may provide integrated control over other ordinary network procedures, such as exchanging media content between users, ordering media and services from the distributor, and viewing system broadcast messages.

As it runs, the player/viewer software conveys video, visual effects to accompany audio, and print-based media content in an operating area of display **222**. There also are one or more control areas through which a consumer **102** may take specific actions pertinent to the associated media presentation. The consumer hears audio media content as sound emanating from the system speakers **224**, and sees video and print media content on the computer display **222**, either in conjunction with audio or not.

According to the invention, to prevent unlicensed consumer use of media content, persistent copies of media titles and tracks are retained as encrypted data on consumer devices. The player/viewer software uses a digital rights management approach to conceal the algorithm or key for removal of this encryption from the consumer. By way of this approach, the information for encryption removal is granted only to media player/viewer software that complies with the present invention in maintaining restriction and control over media use, while enforcing digital rights management on its secured data.

Novelty arises in the player/viewer software's particular ability to control use of media content while providing the means for unlimited free viewing of requested media, through a general licensing process that is transparent to the user. Unlike conventional digital rights management enforcing software, which primarily offer the choices of either granting or refusing access to particular material, the player/viewer software of the present invention can allow for unlimited free viewing of content, while still preserving the value of such use, by implementing the methods of traditional broadcast media business practices as a new use with digital media distribution, carried out by a software apparatus, the player/viewer present on each consumer system.

Along these lines, according to the invention, the player/viewer has logic to allow consumer **102** the free and unlimited use of secured media content, by offering a free general license for use of the content with paid commercial advertisements and other promotional material inserted into the content stream at certain intervals. The player/viewer may also have the power to select which ads are best suited for a particular consumer **102** given information the distributor **120** maintains in its central database about each consumer, applied in conjunction with each specific media title or track request.

No matter how it selects the ads, the invention provides a means to sequence these ads into appropriate blocks that are initially chosen and scheduled into the content stream by a novel "advertisement manager" module of the player/viewer software. There is a novel "intersplicer" module in the player viewer software that launches, communicates with, and strictly controls a digital rights management enabled real-time player module, while the player module handles the actual playback and viewing of the media content through the player/viewer software.

In this way, the invention has the ability to strictly enforce the insertion of advertisements into the content stream. Furthermore, whenever the player/viewer is running any ads, it has the power to ensure that the consumer **102** using it will experience the advertisements in their entirety. In this

particular embodiment of the invention, the player/viewer accomplishes this end by disabling any user interface command that the consumer could possibly use to skip, back out of, or speed through the promotional material, including the ability to lower the sound volume beneath a pre-determined threshold level. The intersplicer also has the ability to adaptively regroup and re-sequence the insertion of ad blocks extemporaneously (i.e. "on the fly"), in response to the consumer's arbitrary direction of the playback within the requested content, by means of playback controls.

By enforcing the insertion and conveyance of promotional material into media titles and tracks that the distributor **120** releases openly and freely, without charging the consumer **102** a fee to run it in this manner, the invention preserves the value of content use to the copyright holder while making it widely available on demand to the consuming public.

Essential to safeguarding the digital rights management measures that the player/viewer employs is the lack of a ready means to save media content to persistent storage in a format ordinary media player software can directly use. However, in certain instances the invention does allow for the use of such media content outside of the player/viewer.

Distributor **120** is free to permit this kind of use on a case by case basis. In this event, the distributor ensures that some mechanism exists to satisfactorily prevent unlimited copying and redistribution of the media outside of the player/viewer, unless the content in question is available for free release. Other software applications may also be permitted such use if they strictly adhere to solid digital rights management practices in securing the same data and content as the player/viewer of this invention, and provided the distributor deems acceptable their use of the media content.

Additionally, the player/viewer may provide for outside use of content by supporting its export onto removable media intended for hardware devices that have little capacity to generate reproductions, such as standalone CD and DVD players found in home entertainment systems. Through such a provision, a consumer **102** using the player/viewer has the power to use network distributed content on ordinary audio/video equipment, for instance, by burning a CD or DVD for use with such a device.

However, in this event the player/viewer typically employs some form of "digital copy-lock" technology on the removable media, to prevent any widespread redistribution outside the method of the present invention. This copy-lock technology flags the physical storage medium in such a way that a consumer may use it on a standalone device, but when inserted into a computer or other digital reproduction ready device, it will not function except through a running instance of the player/viewer software of the invention, if at all.

Direct export may also occur by transfer to other digital devices, such as mobile audio MP3 players. Ideally, such devices would employ digital rights management and other measures similar to those just described, to prevent redistribution of content exported in this way.

The player/viewer may also provide for the direct import of content from a number of conventional media formats, if the distributor **120** chooses to accommodate such a service. With direct import, any consumer **102** may transfer raw content already in their possession to player/viewer media for local storage, or may choose to circulate this content through the distribution system. The process begins with the player/viewer requesting information necessary for initial screening from the user. It then adds a player/viewer format encrypted copy to the user's system, prompts the user to keep or delete the original media file (if the option exists to do so), and optionally takes action to identify media titles and tracks through an automated process, making the results available to the user for application to the imported media. Initially, the new local copy is tagged as banned for redistribution, granting access only to the user who imported it. If the content is to be circulated through the system, the player/viewer may send a copy of the content to a media distribution center **122** for more detailed scanning and review necessary to prepare it for distribution.

If imported content matches an already-existing title or track, the player/viewer gives the user a choice to replace the import with an official copy, bring it into the system for distribution as a new title or track in the event that it differs from the original in some artistic or other valid way, or use it as is without replacement. If the user elects to use it as is, the copy maintains its status as banned for redistribution. If the user elects to replace it, the local copy is replaced with an official distribution copy of the title or track. In the event that the user chooses to distribute the content as a new title or track, or if the initial processing found it to be new material, the media distribution center finishes processing the content for distribution, possibly requesting more information from the user via the player/viewer over a period of time as it validates the content for general release. Once the title has released, the player/viewer automatically upgrades the user's banned copy to an official copy appropriate for redistribution.

In this way, the distribution system of the invention may allow individual consumers **102** to provide new titles and tracks for distribution. To the extent that this feature serves the role of a public access forum for media distribution, the player/viewer user interface may include logic for any additional functionality that is signaled whenever it detects that it is running this class of media. For instance, it can have a control button that reads "Click here to support this . . . " appear automatically at some point during the content's use session. When a user presses this button, a dialog or other interface appears, providing a direct way for the user to enter a donation amount and have it charged to a credit card or other type of billing account, perhaps one that is already on file for the particular user in the distributor's central database, all at the click of a button. At the discretion of the distributor, part or all of this donation amount may be credited to the user account of the individual consumer **102** who imported the new title or track for distribution.

When media is imported from a consumer, there is the possibility that invalid content may make it past the initial review process. If user-contributed content is distributed through the system, then later found to be equivalent to a copyright-holder provided title, the distributor can provide for the automatic replacement of such secondary content with the version approved for distribution. This process is known as "media rotation". Similarly, if a copyright-holder identifies invalid content and does not wish to have it further distributed, the content may be either banned for redistribution or recalled entirely, having all existing copies removed from the system.

Referring now to FIG. **3**B, there is shown a diagram depicting the economic aspects of the distribution method that this player/viewer software enables according to the invention, to better illustrate the nature of its improvement. Three different playback control paradigms are considered along a horizontal axis **350**, and a vertical axis **352** measures the relative utility of each paradigm to either an average consumer **102** or an average copyright-holder. Plot **356** is the utility to the consumer for each playback paradigm, and plot **358** is the utility to the copyright-holder for each playback paradigm.

In playback paradigm **362**, consumers freely redistribute copyrighted content amongst themselves, and a consumer who obtains such a copy has complete control over the use of it. This situation has high utility level **360**B for the consumer, who is getting something of value without paying for it, and it has the lowest indicated utility **360**F for the rights-holder, who loses large amounts of revenue and control as the consumers freely redistribute the copyrighted content in droves for unlimited use, with many of them never paying the rights-holder. This scenario has arisen in recent times as a result of the technological developments described in the background.

With an ordinary digital rights management (DRM) or copy-lock system in force, playback paradigm **364** applies. In this case the distribution system strictly denies all consumers who have not licensed a particular media content title from access to it. The paradigm enforces a strict control of use policy on the part of the distributor, without a facility for a free general use allowance, and in the process, maintains a price for use status quo, where digital media content is licensed to consumers for a fee.

With paradigm **364**, the utility for the rights-holder has moved up to level **360**C, and the utility for the consumer has dropped to level **360**D. Following the paradigm, the rights-holder can enforce a strict grant of use policy on all consumers who use media content under such a paradigm. However, relative to paradigm **362**, the consumer loses the ability to request media content on demand and use it for free, which is a considerable drop from level **360**B. Also lost to paradigm **364** is the right to make unlimited copies for personal use. Given the extent of this drop, some consumers are strongly motivated to use any means at their disposal to obtain free access to content, and there is a large economic force driving these consumers to break such DRM-based distribution systems, producing a constant effort on the part of consumers to establish and maintain paradigm **362**.

Furthermore, it is believed that media content has a very large potential market and a high price elasticity of demand. That is, the viewership of a particular media property increases dramatically as the price for use drops, even in the presence of advertisements. As a result, the potential for revenue from ad sponsorship is all the higher.

Playback paradigm **366** is facilitated by the method of the present invention, and enforced by the player/viewer software as described above. Media content is distributed to consumers freely and on-demand, however, through its use of a highly controlled playback apparatus, the method of the present invention has the power to require and enforce the presentation of paid advertisements inserted at regular intervals within the requested media content, whenever a consumer uses any media for free under the general license.

In this system, the consumers utility level has now risen to **360**B', which is much closer to level **360**B than to level **360**D, by the reason that a consumer would much rather bear commercials in exchange for free use of media content than not have free use of any sort. Meanwhile, the copyright-holder's utility has also increased greatly to level **360**A, because more viewing of paid ads by a much wider audience produces a greater source of revenue than a considerably smaller number of direct sales.

The system is an improvement over conventional digital rights management systems because it offers benefits to both the copyright holders and the consumers. From the consumer's standpoint, the drop from utility levels **360**B to **360**B' is much smaller than that from levels **360**B to **360**D, so there is much less incentive on the part of the consumer to engage in piracy and other attempts to circumvent the digital rights security put in place according to the invention.

Advertisement Sequencing Styles

Referring now to FIGS. **4**A and **4**B, there is shown a schematic diagram depicting some representative player/viewer media use sessions as they run over time. FIG. **4**A illustrates three primary styles of advertisement sequencing that may occur in combination over a playback sequence of requested audio or video media content, as defined previously above. FIG. **4**B illustrates the general style of ad sequencing that occurs in the process of viewing and browsing print media content, as defined previously above.

Media content exists in the form of titles and tracks, as defined previously above, and the user can have the player/viewer run any combination of available titles and tracks in any possible order. If a long-playing title has no tracks, or if a single track runs excessively long, the distributor may specify the division of the title or track into a series of contiguous segments. A title or track that contains more than one segment is a segmented title/track, in contrast with an unsegmented title/track consisting of one single segment. The distributor **120** assigns segment divisions on an item-by-item basis, and throughout distribution, these division locations accompany their associated title/track, in a fashion similar to the way the locations of all tracks on a title accompany the title when it is delivered as a single unit.

Segments would not ordinarily be ordered separately from the distributor, but the player/viewer's saved play-lists may contain individual segments. One purpose of segment divisions in a track or title is to indicate appropriate points within the material for the player/viewer to intersplice ads in the course of presenting the content. By this definition, a title may contain segments, or tracks, or possibly segments within tracks, but not tracks within a segment.

In FIG. **4**A, the passage of time over the course of playback is represented as a horizontal timeline **400**. There are shown three example sequences of audio or video media playback **402**, **404**, and **406**, each of them conveying content interspliced with advertisement blocks. These sequences are shown as video with audio, but the following discussion applies just as well to silent video or audio-only media. Using ordinary methods, the player/viewer can convey either of these styles just as well by leaving the video blank or the audio silent, or it may alternatively employ some other logic to fill in for blank video or silent audio with its own images or sounds.

As described above, the player/viewer has the power to intersplice paid commercial ads into the presentation stream intermittently over time throughout the course of playing an audio or video sequence. The media style of these ads may include some combination of audio, video, and/or print-based components, excluding the trivial case of no presentation at all. However, from these possibilities, there is typically only one such choice that strictly matches the media style of the content in play, and at most two in the event that different media component styles occur in the content immediately before and immediately after the interspliced break.

In the case where the media component style remains the same before and after the ad break, there is a unique choice of ad media style to match content media style. For instance, in the midst of audio-only content, it is an audio-only ad. In the midst of video with audio content, it is a video with audio ad, and so on. The player/viewer's advertisement manager has the power to call for this specific style of advertising to suit whatever content style is in progress, and this particular methodology of matching content media style with adver-

tisement style, for the purpose of programmatically interrupting the same media stream conveying the content with ads taking the same form, is novel in the realm of digital media players.

Applied to video and audio, this advertising methodology is a new use of the advertising style familiar to audiences through ordinary television and radio broadcasts. However, in the present invention, these advertisements are sequenced together and inserted into the content stream extemporaneously (i.e. "on the fly") by software running independently on each consumer's device, in response to the consumer's particular media requests and interactions with the specific content session running on each device. In an alternate embodiment of the invention, which may be employed for example in satellite radio or digital cable television receivers, targeted advertisements may be interspliced into an original broadcast presentation in real-time, thereby providing broadcast programming with promotional material tailored to the preferences, demographics, or other relevant criteria of individual users, in addition to and/or in place of those ads specifically associated with the broadcast media.

These ads are not required to appear in the same media form as the user-selected content, though in many cases, they do. According to the invention, it is even possible for an advertisement or media content segment to contain special tags and program logic to signal the player/browser to produce specific software-controlled actions, such as special buttons in the interface, displays, or user interactions. For example, at some point in the playback of a video title, the player/viewer can display a pop-up dialog or flash a control in its user interface that reads "Click here to buy this . . . ", with logic to take appropriate action if the user responds. This same feature provides a mechanism to supply interactive user polling in the midst of the media stream, or in place of ads, by presenting hypertext data input forms and delivering the user responses back to the distributor **120**.

Referring back to the figure, play sequence **402** contains both segmented audio/video content, shown throughout FIG. **4**A as wavy lines, and blocks of audio/video commercials, which are shown throughout as saw-toothed lines. Content segments **430**, **432**, **434**, and **436** comprise the media title the user has requested for play, and each of advertisement blocks **408**, **410**, and **412** is a group of at least one or more ads and/or other promotional material that the player/viewer software has automatically assembled and inserted into the sequence.

In the course of direct play, without any user-directed skipping from one point to another or performing other navigation throughout the content, sequence **402** begins with content segment **430**. Segment **430** immediately proceeds into advertisement block **408**, which is followed by content segment **432**, ad block **410**, content segment **434**, ad block **412**, and content segment **436**.

Play sequence **402** is typical for a segmented title/track, by the definition of segmented media given above. With segmented media, the player/viewer holds a sense of particular ad blocks retaining their own sense of place in the sequence, with the ads chosen to go along with a predetermined portion of the content. If the consumer elects to skip around during the course of playing a segmented title, the same block of ads plays with a particular portion of the content as the user skips back and forth through different parts of the title, over a predetermined period of time and/or number of viewings. If the predetermined limit is exceeded, the player/viewer rotates in new ad blocks automatically.

Segmented titles are sequenced like television programs, in that ad breaks tend to occur at particular scheduled places in the content. The first time through viewing any particular segmented content with ads, each block is shown before or after its associated content, and the player/viewer requires the ads to be run in their entirety. After that, when ad blocks that have been seen already are encountered again through a user-directed repeat of a sequence in a single request session, the player/viewer may allow the user to navigate out of the ad, or possibly omit it altogether.

For example, if the user of sequence **402** jumps right into segment **434** as segment **430** is just starting, the player/viewer will begin segment **434** at its point of entry, followed at its end by ad block **412**. Wherever possible, the ad block chosen for play at the end of a segment will be the one most appropriate to the actual part of the content that has played since the latest preceding ad block.

In some cases, there may be a need to insert an ad block just before resuming play after a user-directed skip. For instance, if the user has watched 80% of segment **432**, and then jumps into the middle of segment **434**, ad block **410** plays immediately, and when it is finished, content play resumes at the point selected in segment **434**.

Generally, the ad blocks presented during segment play occur either at the start of a segment, immediately following the end of a segment, or if necessary, just before resuming play after a user-directed skip. Logic in the player/viewer determines which of these are necessary as a result of the consumer's most recent viewing, and selects the most appropriate of the predefined blocks to insert at that point. If the same block is repeated excessively, the player/viewer has the power to rotate new ads into play at some point.

Play sequence **404** results when the user chooses a series of individual tracks for play. Common tracks include short songs and music videos, where each item is an individually-named short work. In this particular case, the consumer has selected to a play list of content tracks, **440**-**462**, and the player/viewer automatically inserts advertisement blocks **414** and **416** into the play sequence. These individual tracks were selected haphazardly from among several different titles.

With tracks, the location of advertising blocks is determined by the player/viewer's program logic, which upholds an average content play time, an allowance based on the number of tracks, or possibly some combination of these or other approaches on a case-by-case basis, to determine where it inserts the ad blocks. Whatever method it uses, it places the ad blocks between individual tracks, or runs them just before resuming play upon a user-directed skip into the middle of a track.

During the course of regular play without skipping around or other navigation, sequence **404** begins by playing tracks **440**, **442**, **444**, **446**, and **448** in series, followed by ad block **414**, and then tracks **450**, **452**, **454**, and **456**. After track **456** comes commercial ad block **416**, followed by tracks **458**, **460**, and **462**.

Tracked titles are sequenced like radio programming, in that the ad breaks tend to occur after a certain number of songs are played, after a certain amount of playback time has elapsed, or at song breaks nearest to particular times of the hour. In the case of the player/viewer, the user can sequence any combination of tracks together, and the ads chosen may in part reflect the specific tracks used. This has a direct implication when the consumer jumps around haphazardly in a requested play-list, or chooses to repeat a small subset of the tracks in the requested sequence.

For example, in sequence **404**, consider a case where the program is using a track allowance method for ad placement, with an initial allowance of 5 tracks per ad block. If the user

decides to play track **446** and then track **456**, the program does not insert ad block **416** immediately after track **456**. Instead, play goes directly into track **458**, because the allowance is 5 tracks. If the user plays through most of track **458**, then jumps to the beginning of track **442** and plays it, there is still allowance for one more track after that, since only four tracks (**446**, **456**, **458**, and **442**) have played so far. If the user then jumps to track **452**, an ad block will play immediately after track **452** completes, or if the user attempts to leave track **452** after hearing most of it but before it completes, because it is the fifth track. This ad block will be assembled extemporaneously to go with the five tracks that were played, and there is no retained sense of recurring blocks falling at specific points when the user skips around between tracks in a play-list. Typically, ad blocks inter-spliced in this way require full play with each occurrence, and the player/viewer manages its adaptive ad selection to present new ads every time, to a certain extent.

It is also possible for long-playing material to be completely unsegmented, as is the case in sequence **406**. With unsegmented content, a large ad block **418** is inserted at the very beginning of the program. The ads play in sequence, and when they are finished, the content **470** plays in an uninterrupted fashion. Even when a title or a lengthy track has segments, the player/viewer may elect to run it in this unsegmented fashion in response to instructions from the distributor **120**.

Referring now to FIG. **4**B, there is shown a schematic diagram of an ad-sponsored print media session. The consumer views the print media one page at a time by issuing page turn commands. Under a page allowance ad placement mechanism, an ad or block of ads is run after a set number of page turns (**5** in this case). When paging through print media in this fashion, moving either forward or backward in the material may be counted against the page allowance, or the mechanism may count only turns to pages that haven't been viewed within a limited time period, such as in the last five minutes, for instance. In addition to page allowance triggered ads, ad blocks may also be inserted at the end of each "chapter" or other appropriate section division in the print media. Chapters in print media are equivalent to audio/video segments, and the software handles them both in the same manner.

As noted in FIG. **4**A above, these ads are not required to appear in the same media form as the user-selected content, though in many cases they do, and the same possibility for an advertisement or media content segment to contain special tags and program logic to signal the player/browser to produce specific software-controlled actions exists. In general, page allowance triggered ads will be print based ads, such that the user may briefly be exposed to an advertisement, then can quickly page out of the ad or ad block, and return to the print content so as not to loose their train of thought while reading.

The timeline measure for print media is the number of user-activated page turns **480**, and ads are sequenced according to a page-turn allowance, as described above. Ads may also occur at the boundaries of chapters, which are the print media equivalent to segments, discussed above. Print based media involves any combination of print **482**, which encompasses many forms of page-based text and image layout, audio **484**, video **486**, and user-software interaction **488**, in the fashion of hypertext applications. When the player/viewer inserts an ad block into print media, the ads may also employ any combination of these means (**482**, **484**, **486**, and **488**) to convey their message, though as noted they tend to be in the same style as print advertising where print ads are interspersed with print content as they have traditionally appeared in newspapers and magazines.

For the print ad containing audio **490**, the audio and any associated visual advertising content complete at the same time. When a visual aspect of a print ad is in progress, user-activated page turns are disabled, unless the ad itself includes specific logic to handle them. When all in process visual aspects of the ad have finished, or when none are present to begin with, the user may resume paging. In the case of a print ad **492**, with an audio message continuing beyond all of the ad's visual aspects, the user may turn pages while the audio is still in progress. Below, FIG. **10**B explains in detail the player/viewer's logic to convey ads with print media.

Referring now to FIG. **5**A, there is shown a flowchart to illustrate the logic by which the player/viewer software processes a user request **502** to play or view some media, according to the invention. Request **502** may arise from, among other things, a direct file open operation, a selection from a remote media catalog or local media database, a selection of a user-defined play-list, a result of a media search engine or other web-based service, or some other user-driven command in the player/viewer. For example, in order to compile a user defined play-list from which a request **502** can be initiated, a user might acquire media files through any means available, including, but not limited to, browsing for a selection from a media repository, catalog, or library (e.g., as a part of, or in conjunction with, media catalog **566** described below), or via a peer-to-peer transfer.

Generally, the operation will begin with a list of one or more requested content items, the "media request list", which has an entry for each track, title, or in some cases, individual segment of a local track or title, chosen for play in the user-requested order. Segments are generally not released individually, but once a title is local, a play-list may have the option to sequence individual segments into a play session.

Once the media request list is established, the list is then populated in a process loop **504**. First, in step **506**, the program identifies the item and determines the location of the most conveniently accessible stored copy of it, either locally or over the network, relative to the processor **202** (FIG. **2**) running the program. The program accesses the item to verify its location and to extract any relevant internal data tags stored within or alongside it. As this step finishes, the program expands the item's entry in the media request list to include fields for its identification, verified location, and certain data tags containing information or access keys. This has the effect of turning the media request list into a table of data records, which for sake of continuity, retains the name "media request list" in the ongoing description.

In step **508**, the program determines the ad requirements called for by the item, by checking if any specially granted or restricted service levels apply on the content's use. If the distribution system does not provide for this determination, the player/browser may apply a "general license" that allows for free use of the item with the enforced intermittent insertion of paid ads into the content stream. Otherwise, the player/browser employs these means to retrieve or compute any specifically applicable service level and access key parameters, which are then added to the item's entry in the media request list. Without loss of generality, this determination may occur through direct use of any tags obtained as described in step **506**, possibly in conjunction with a local, distributed, central, or other database.

To enforce security, a database that functions in this capacity employs data encryption and other digital rights

management practices, to bar the consumer from any direct access to this information. When such a database is used, the running player/viewer is typically the only component of the consumer's system with the power to access it, thereby maintaining it under the distributor's exclusive control on all such systems.

In step **510**, the media item is transferred into local storage in accordance with a preset or predetermined localization policy. That is, if the item's verified location is too remote for direct playback, the program transfers the item to a more local destination and updates any pertinent data, such as the verified location, in the item's media request list entry. The media transfer logic has the option to re-register the item during the course of this transfer, which may further affect the item's media request list entry.

This finishes the processing of the item in loop **504**. In step **512**, the program returns to step **504** to process the next item through the loop. When the program has finished processing all the requested items, the loop exits, passing control to step **514**.

In step **514**, the program selects appropriate ads to go with the media request list and prepares them for insertion into the content play/view sequence. It selects which ads, if any, are to interrupt the requested content during the course of play, and then it localizes them. It groups the content into play sections, and it groups individual ads into blocks for insertion into the content. It also determines the rules and parameters by which step **518** adaptively selects and groups ads extemporaneously in response to user actions during playback, and provides an ongoing maintenance service to rotate ads into and out of play as needed during the course of the session. Given the nature of its operation, step **514**, and the logic it comprises, is referred to herein as the "ad manager".

In step **518**, the program plays (or for print content, displays) the requested media with ads, each of which can be forced to run in its entirety, interspliced into the content play sequence. Adhering to the selections of ad manager **514**, the program sets up a play sequence of individual content segments interspliced with blocks of ads, and it coordinates the real-time conveyance of the interspliced content/ad play sequence to the user in real-time, by way of the system's video display **206**, **222** (FIG. **2**) and audio output **208**, **224** (FIG. **2**) hardware. Given the nature of its operation, step **514**, and the logic it comprises, is referred to herein as the "intersplicer".

The program's behavior in step **518** is directly influenced by certain user interface commands that enable the user to make arbitrary navigational choices through the requested content's playback. The main job of the program in step **518** is to adaptively select and re-sequence ads extemporaneously in response to these user choices. In this process, the program maintains a history of the playback it has performed, which is a direct record of the user's navigational actions through the content and the program's own ad choice and sequencing decisions. While in step **518**, the program occasionally saves a persistent checkpoint of this play history, which it can recover later in the event of, for example, a system failure.

According to this particular embodiment of the invention, the program disallows user actions that alter the course of playback while a required advertisement is running. The logic for this behavior lies in step **518**, which keeps settings in memory to indicate the current state of play, including a value to indicate whether or not a required ad or ad block is in progress. Commands to alter play from the user interface are influenced by these settings, and in turn update them to modify playback (FIGS. **8**A-**8**D, **9**A-**9**C, **10**A, and **10**B). The program remains in step **518** until an appropriate user command or system maintenance action signals it to end.

In step **524**, the program compiles and saves the play history retained from step **518** into records on media usage and ad penetration, for each particular title and advertisement that ran during the course of the session. Media title usage records retain a detailed profile of the user's navigation throughout the content. Ad penetration records retain the number of times the ad was run, the track or segment associated with each run, the ad selection criteria behind each run, and other parameters. These records are saved to persistent storage, where they influence future ad management decisions and may eventually be sent back to the distributor to determine viewership ratings and for additional analysis/review.

Program control proceeds from step **524** to step **526**. In step **526**, processing of the user's request to play/view media ends, and the session is done.

Referring now to FIG. **5**B, there is shown a block diagram to illustrate how the logical components of the player/viewer operate together in carrying out the logic described with reference to FIG. **5**A. Where numbers coincide between FIG. **5**A and FIG. **5**B, the numbered component in FIG. **5**B carries out the corresponding logical step in FIG. **5**A.

The operation begins from operating system **550**, running on the consumer's computer **104** or other device. To use the player/viewer application **560**, the user interacts with the operating system **550** to either launch player/viewer **560** directly or to open a media file that brings about its launch with an immediate request to play media **502**.

As player/viewer **560** begins, it starts its user interface **500**, which either waits for the user to make a request **502** through it, or starts with request **502** initiated by operating system **550** to launch request **502** as soon as it brings up user interface **500**. Player/viewer **560** also launches a maintenance handler **570**, running concurrently with user interface **500**, to handle any internal maintenance that player/viewer **560** ordinarily runs during its course of operation.

The player/viewer **560** uses concurrent software design practices, and this description of the invention generally applies the term thread to indicate each conceptual program step or process operating in parallel by way of a software design practice that implements concurrency, even if the practice does not employ threads specifically. By way of concurrency, player/viewer **560** may have a number of requests **502** to play/view media running simultaneously, though as a rule only one of them has user focus at a time, and typically only one is visible at a time as well.

Maintenance handler **570** serves a variety of maintenance purposes. Aside from performing program maintenance itself, it may directly launch other immediate maintenance **572**, direct the operating system to run another program as a background maintenance process **574** that persists after the player/viewer **560** program has exited, or possibly direct the operating system to persistently schedule a regular maintenance job **576**, a job which then starts automatically either at system startup or at some regular time, even when there is no running player/viewer. Maintenance handler **570** may also provide coordination services to other operations establishing maintenance tasks of their own, such as ad manager **514**.

One service that the player/viewer maintains is local database interface **562**. This database serves as the program's store of user information and preferences, which may include without limitation, local media locations and registration data, content and advertisement viewing history,

security keys, availability and locations of local ads, and other system maintenance data. Most logical operations in the program access the local database **562** in some way. Specific connections to database **562** are not all shown explicitly, so as not to unnecessarily obscure the drawing. If it is designed to contain sensitive information, this database is maintained under strict distributor control, using digital rights management practices.

Local database **562** may be self-contained in persistent files on the consumer's device, or it may extend over network **100** to a remote central or distributed database **564**, which is controlled by the distributor **120** (FIG. **1**). Another remote service that the program may use is a central or distributed media catalog **566**, by which the player/viewer **560** may acquire information about any existing media titles or tracks, including but not limited to location, description, reviews, and available licensing options, among other things. The program may also use a service which employs a central or distributed protocol for media delivery, conceptually acting as a single media server **568**. Where present, services **564**, **566**, and **568** communicate with one another, and each one may consult either of the other services to handle a particular request.

The Network Administered Services Embodiment

According to the invention, there is a particular embodiment with additional features and different advantages, as supported through the apparatus and method of this invention as discussed up to now. The following discussion expands on the earlier discussion of these same steps in reference to FIG. **5**A, specifically in the context of this particular embodiment, which is called the "network administered services embodiment".

The network administered services embodiment uses local database **562**, working in part as a locally relevant mirror of central/distributed remote database **564**, which is administered centrally by one or more of the distributor's media distribution centers **122**, and secured under strict control of distributor **102**, in all consumer-accessible places, by means of digital rights management methods, according to the invention. Such data is also secured while in transit over network **100**, via a software-secured layer or other security mechanism.

The network administered services embodiment also provides a media catalog **566**, which may involve one or more media distribution centers **122** (FIG. **1**) acting as central servers, a peer to peer network of distributed media catalog servers **596** running on consumer systems, or some other configuration.

To deliver media to consumers, the network administered services embodiment provides both a centrally administered system with media distribution centers **122** (FIG. **1**) serving transfer requests from consumer client systems, and a peer-to-peer network of media exchange servers **594** running on consumer systems to provide a means for these systems to negotiate and conduct media transfer directly from one to another. This embodiment employs ordinary and new practices to optimize bandwidth utilization throughout its media delivery system, which is the apparatus providing media service **568** to player/viewer **560**.

Bearing these services in mind, there is shown an indication of the inter-operational communications that take place in the course of the logic discussed in FIG. **5**A. The beginning of a request to play media occurs at step **502**, and step **504** is a loop over each item in the media request list.

In step **506**, the program identifies a media content item on the basis of a unique universal identifier stored in any number of locations, including, but not limited to, local database **562** and/or the media file itself. The program then uses the identifier to locate the item by first going to local database **562**, and if not found, to media catalog **566**. It verifies that a requested content item is available, either locally or via the distribution network, through a test access in which data tags that may be present in local database **562** and/or the media file are extracted. If the user selected the item as a local file or archive, the program may get some or all of the information it needs directly from the file, as opposed to checking local database **562**, to determine the item's location. In any case, it makes sure the content is available at the specified location, and if it finds a problem, it may seek assistance from the user, perform an additional local search, or if possible, go directly to remote sources to locate a copy of the item.

In step **508**, service level determination goes first to data held in memory in the media request list, from step **506**, and then to local database **562**, which consults remote database **564** as needed. The distribution network maintains a full-fledged extranet for the purpose of media licensing, and the step of service level determination **508** becomes one of license verification in this embodiment. Each individual consumer gets a password-protected user account, and zero or more specific installations of the player/viewer software are registered to each user.

This embodiment provides for many user services administered via network **100**, including but not limited to those noted here. There may be user profile sharing, by which a user can access on a temporary basis, from a system or device other than their own, media that has previously been licensed to them. There may be multiple ratings systems provided, by which the consumer may choose to evaluate the quality and appropriateness of particular media based on any number of different criteria, including content ratings and critic and user reviews. There may be child accounts and media restriction controls, by which a primary account-holder can set up dependent accounts and limit the content viewable by dependent account-holders. In this instance, media may be restricted or allowed on any number of different criteria, including its level in any of the provided ratings systems, or by specific title or track.

Through user registration, this embodiment also provides for targeted advertising choices, conducted by the ad manager in the course of selecting ads, on the basis of user demographics, preferences, and other consumer specific criteria, on a session by session basis. This also applies to streaming audio and video, for which the intersplicer mechanism described below can allow for the user-targeted adaptive insertion of specific ads into a digital broadcast media stream at times signaled from the media stream. In this case the player/viewer software will run maintenance to localize appropriate ads for each streaming broadcast. In the absence of localized ads for a broadcast stream, the player/viewer may run a general ad that is broadcast with the stream.

The licensing/registration database is maintained centrally on the media distribution centers **122**, with local mirrors on each consumer system providing immediate and constant access to all of a specific user's licensing data. Individual media titles and tracks are licensed on a user-by-user basis, and digital rights management methods are employed to maintain the integrity of this system. When a consumer device is not connected to the network, the local database mirror contains enough information to run any content that the user has expressly licensed.

This license verification system offers and keeps track of a wide variety of service types, which ultimately affect the service level determination result. For instance, on a user-

by-user basis, each title may be offered and licensed as free for use with commercial interruptions, free for use without commercial interruptions but with requested user support, included (with or without ads) as part of a specific subscription package, specifically purchased for uninterrupted use on a short-term basis (fixed time period or total number of uses), and/or purchased outright for permanent uninterrupted use. With such a system, the distributor maintains absolute control over what services are offered with each piece of media, and through it, the copyright-holder can choose to offer or withhold any of these service types on a title-by-title basis.

There are several other functions through which this license verification system offers the distributor **120** even more control. For instance, a media file can be tagged as "banned for redistribution," and the system will prohibit any user except the one to whom it is registered from being able to use it. In extreme cases, the system can enforce a "full recall" of any content that a copyright-holder has deemed to be on the system without their proper consent, and the system will automatically remove all copies of it from circulation.

Once an item's service level is determined, whether it be through full-fledged license verification or any simpler process, the player/viewer attaches the result to the item's entry in the media request list. In the event that the item has a service level that prohibits any use of it whatsoever, which occurs for example in the situation where a particular user has not made a special licensing arrangement and a free general license service type is not available for the item, the player/viewer will warn the user and possibly suggest any other options that may exist to enable its use. If none of these are offered or taken, then the item is removed from the request list.

Aside from either calling for ads or not, the service level may include one or more advertising requirement parameters, such as the relative ratio of content material to promotional material, the frequency of interruptions, or some other metric. It may also specify the removal of particular segments of the content from the play stream through one or more content-filtering parameters. The nature and count of these service level parameters is determined by the distinctions that the distributor chooses to provide. This completes step **508**.

In step **510**, the media item, if determined as valid from step **508**, is localized. Localization of media takes place through the operational logic of media transfer **580**. Player/viewer program operations that transfer media content to or from a consumer device's local storage go through this logic. The player/viewer transfers the content from the valid location determined in step **506**, by means of media transfer **580**, which acts through media server **568** to localize the media, using the most appropriate central server, peer-to-peer, or other network configuration provided by the distribution system.

In step **580**, during the course of media transfer, the player/browser **560** may elect to release the media from its secured form and then secure it again according to a new key, as it stores the item to a persistent local destination. This operation involves the secure/release logic component **582**, and it has the effect of re-registering the media to its new owner. The media transfer process also updates any tags that are stored with the content to reflect any registration aspects that may be maintained there, and changes to any security keying data are saved in the media request list, for eventual inclusion into local database **562**.

Step **512** goes to the next item in the request list until all of them have been processed, and control passes to the ad manager **514**.

Ad manager **514** first consults the information available to it in program memory in the media request list. Then, it goes to local database **562**, operating consistently with remote database **564**, when available, to apply its data on the specific user's demographic information, advertising preferences, system location, media usage, ad viewership history, and other criteria, in conjunction with general data on the title/track requested and the preferences of sponsors regarding the use of their ads, to determine a list of candidate ads.

Once the ad manager **514** has determined which ads it will select to go with the request, it goes through a locate and localize step for each ad, similar to those in steps **506** and **510**. The locate step first uses the media request list in memory and local database **562** in conjunction with other local resources, and then it may go to media catalog **566** to locate specific advertisements on the network. The localize step goes through media transfer **580**, to bring the ads onto the device.

Ad manager **514** also establishes a concurrent ad rotator **516**. The ad manager may start a new thread for this purpose, or it may communicate with maintenance **570** to assign it a new or already-existing ad rotator thread **516**. Either way, the ad rotator thread **516** gets associated with the thread of request **502**. As different request threads **502** are hidden or made visible via user interaction, maintenance **570** may re-assign an ad rotator **516** from one media request thread **502** to another, or different ad rotator threads may exist for multiple requests **502**.

Ad rotator **516** handles requests for new ads from an intersplicer **518** by selecting and localizing appropriate ads, grouping them into blocks if so requested, and sending the result back to requesting intersplicer **518**. The ad rotator **516** is equipped to handle requests to replace individual ads, entire ad blocks, or the entire set of ads and blocks associated with intersplicer **518**, without having to interrupt playback. Just like ad manager **514**, it may use the logic of the media transfer component **580** for this purpose. Ad rotator **516** may also need to consult media catalog **566** to locate new ads, but this step is typically avoided through the ad manager **514**, which pre-locates alternative ads and passes this information along to ad rotator **516**. Ad rotator **516** also synchronizes the final media request list with local database **562**.

Intersplicer **518** launches a new concurrent real-time player thread **520**, charged with the computationally demanding task of real-time play/view performance, and it directs real-time player **520** in the sequence and manner in which to run. Playback starts from an initial section sequence table indicating how content is to be interspliced with ads, and is modified in response to intersplicer control commands **522** that the user issues with actions from user interface **500**. The intersplicer maintains a history of all the playback it has instructed player **520** to perform, and it selects and re-sequences ads extemporaneously in response to the user's arbitrary navigational choices through the requested content playback.

Where intersplicer **518** sequences playback, real-time player **520** handles the playback of any arbitrary sequence of content sections and ad blocks that intersplicer **518** orders. In the process, step **520** maintains file descriptors, file pointers, and buffers. It secures its buffers, decodes compressed media, and releases for use any media content that has been secured through encryption, through the logic of

secure/release **582**. All of this happens extemporaneously in the course of real-time playback. Intersplicer **518** communicates often with its associated real-time player **520**, to direct playback and follow what's playing. Intersplicer **518** also communicates with ad rotator **516** to request and receive new ads for its own adaptive local ad selection.

Intersplicer **518** finishes when either a user action or a timeout after program completion instructs it to end. In response to this instruction, it signals an end to real-time player **520** and ad rotator **516**. Upon this signal, real-time player **520** ends itself and ad rotator **516** either ends or releases itself from intersplicer **518** and continues running to attach later to another media play/view request **502**. In the meantime, ad rotator **516** may involve itself with ad localization or some other maintenance activity. Once the real-time player and ad rotator have removed themselves, intersplicer **518** ends.

Since intersplicer **518**, real-time player **520**, and secure/restore **582** are more time-sensitive than other components, the design of the player/viewer software generally has play request **502** conduct any necessary access of local database **562**, which may invoke remote database **564**, through other threads, while intersplicer **518**, player **520**, and secure/restore **582** are running in the request thread **502**. This is a design choice, and the invention applies just as well to other software designs that function according to the invention.

The media and ad usage monitor **524** compiles the play history data from intersplicer **518** and incorporates it into local database **562**, which ultimately synchronizes back to remote database **564**, or otherwise communicates it back to media distribution center **122** (FIG. **1**). This data is important, as it provides the basis for a sophisticated viewership ratings system, which the network administered services distributor **120** maintains as a direct or statistically-based compilation of media usage data gathered from every consumer **102** on the system, as well as providing ad penetration statistics for tracking the viewership of each ad, and a basis for future ad selection choices, delegated from remote database **564** in step **514**, the ad manager.

In addition to the basic media use request operation that begins in step **502**, there are several common maintenance tasks that occur regularly in the course of running the player/viewer software **560**. Regular management of program resources may be handled by maintenance handler **570**, or as a separate immediate maintenance thread **572**.

There are also distribution-related maintenance tasks, which may be managed on an ongoing basis, either as an immediate maintenance **572**, a maintenance process **574**, or a scheduled regular maintenance **576**. These may without limitation include ongoing ad localization **578**, database synchronization **590** between local database **562** and remote database **564**, any special media usage reporting **592** that is not included as part of regular database synchronization **590**, the provision of a media exchange server **594** to handle peer-to-peer and other direct consumer-to-consumer media transfer aspects of general media server **568**, the provision of a distributed media catalog server **596** to act as a component of media catalog **566**, and the enforcement of distributor media recalls, bans, and rotations **598** as described above with license verification in step **508**.

DETAILED OPERATION OF THE INVENTION

Referring now to FIGS. **6**A and **6**B, there is shown in FIG. **6**A a more detailed flowchart of the operation of step **514**, the ad manager. In FIG. **6**B, there is a block diagram that indicates the data stored in memory and exchanged in association with the logic of steps **514** and **516**.

Referring now to FIG. **6**A, there is shown a flowchart illustrating in more detail the method by which the ad manager, step **514** (FIG. **5**A), operates according to this particular embodiment of the invention. The ad manager begins in step **600** with a media request list **650** already stored in memory. In step **602**, it enters a loop to process each item in media request list **650**, one at a time. This processing proceeds to step **604**, where the ad manager determines an optimum amount of advertising time required by the item, based on information saved earlier in the media request list **650**. The resulting ad requirement is an arbitrary function that can depend on, without limitation, one or more of the following: the item's running time; the number of segments it contains; and/or its advertising requirement parameters, determined with its service level in step **508**.

In step **606**, the ad manager produces a list of candidate ads specifically tailored to the media track/title in question. This candidate ad list may derive directly from data and/or advertisements embedded with the content in a file or archive, or it may be the result of a query to a local or remote distributor's database. Generally speaking, the resulting list will be a function of the specific media title, its parameters from media request list **650**, available data on the user's previous advertising and media usage history, recent ad localizer maintenance downloads, user preference settings that may be in effect on the player/viewer, user advertising preferences, and relevant user demographic information.

Except when the result of step **604** is zero by way of a privileged license, the resulting list contains at least one ad, and it will include enough advertising to cover some multiple of the item's optimum ad time determined above, with the multiple ranging from at least one to at most one hundred. Associated with each ad in the list are a number of attached parameters and weighting coefficients that specify each ad's relative appropriateness to the particular content item in question, with separate coefficients to cover multiple selection criteria, possibly including, but not limited to, the specific title/track of the item, the item's genre, demographic information about the user, and/or the geographic location of the system or device running the player/viewer. Other returned parameters may include ad running time, an overall ad preference rating, the type of product being advertised, some preferential ad block positioning, or other relevant usage rules associated with the ad. The ad manager uses these parameters in step **616**, described further below.

Block positioning and other rules may be quite specific. For instance, there may be rules instructing a particular ad to be played in the block associated with a specific segment of a title, at a specific position within a block, or tied to another ad, such as two ads linked either at the beginning and end of a block, or in separate blocks that run after successive segments in a title. In step **608**, the ad manager weights this candidate ad list by the ad time determined in step **604**, to scale its influence on the ultimate choice of ads by the amount of required ad play time it contributes to the entire session. In step **610**, this list is merged into the ad manager's internal ad table, which maintains each advertisement's parameters, preference ratings, and time weightings, on an item-by-item basis, as it combines ads that are common to multiple items. In step **612**, the result from step **604** is added to a count of total ad time for the entire media request, to serve later in choosing the size of the master ad table. The loop then returns in step **614** to process the next item in media request list **650**.

After loop **602** is finished, the ad manager goes to step **616**, in which it processes the internal ad table into a preliminary master ad table **670**. Using the total resulting length of required ad time from step **612**, it selects enough ads from the internal table to have a running time greater than or equal to this result, giving preference according to the weighted sum total, determined for each ad in the table, of the metrics determined above. Then, it processes its internal table to yield a set of ad preference tables **676**, which have been inverted to map ad selection criteria to a ranked list of candidate ads taken from those in the master ad table. This inversion allows the weighting coefficients and preference ratings, which are indexed by ad in the internal table, to be indexed by title, genre, demographic, or other selection criterion in each of the ad preference tables. The intersplicer uses these tables later to perform adaptive ad selection and sequencing in response to user actions.

After computing the preliminary master ad table **670**, step **616** removes all the ads so chosen from its internal table, and maintains the result as an alternate ad table **660**, which provides specific ad indications and selection criteria to make substitutions into the master ad table **670** as needed. When this is done, the ad manager proceeds to step **618**, which loops through the master ad table, one ad at a time. In the loop, step **620** locates and localizes each ad.

In step **620**, the ad manager determines the nearest location of the ad in question and verifies its presence there, potentially through the use of remote media catalog **566** (FIG. **5**B). Once it locates the necessary ad, it may elect to transfer the ad to local storage if such an operation will complete in a reasonable amount of time, or it may elect to replace this particular item in master ad table **670** with a more accessible one from alternate ad table **660**. Should this happen, it removes the replacement ad from alternate ad table **660** and merges the ad's selection criteria into ad preference tables **674**. Once the ad has been either localized or replaced, the loop returns for the next ad in step **622**.

Loop **618** terminates when every ad in the final master ad table **670**, after any replacements have occurred, is present in a nearby location, either on local storage, or somewhere else where the available speed of access is determined to be fast enough for real-time play. If there is no way to localize enough advertisements to fulfill the requirements of master ad table **670**, the player/viewer notifies the user of the situation and suggests connecting to the network or other appropriate alternative. If after this attempt, the estimated amount of time required to transfer the ads is prohibitive, the player/viewer notifies the user of the delay with a prompt to await transfer, continue now, or abort playback. If there is still no means available for transfer, or the user has chosen to continue now, and there aren't enough advertisements on the system to support the requested media, the player/viewer will offer to abort the request or play only a limited portion of it.

In step **624**, the ad manager checks for media titles that contain segments, and builds a section table **674** of all individual segments and tracks comprising the content of the request, in preparation for the insertion of ad blocks at arbitrary points in the list. In this step, data from the media request list, such as title identification, access keys, file location, endpoint times, and genre of title, may be included with each entry in the section table **674**. The main purpose of segments in a media track or title is to indicate appropriate points for commercial interruptions, and the ad manager has the power to decide which segments are run back-to-back, and which ones are to have ad blocks inserted after them. In many cases, every single segment in a track or title gets an ad block. In segmented items, the section groupings and ad insertion points set here are not altered by the intersplicer.

In step **626**, the ad manager builds and sequences ad blocks into the requested content, according to the rules it has from various content, database, and ad sources. To do this, it first estimates the desired average ad block running time, possibly through the application of ad requirement parameters from the media request list, and the total running time of the content. From these results, it computes a desired average time between interruptions. It then uses section table **674** in conjunction with any ad requirement parameters from the media request list **650**, which may call for the lengthening or shortening of ad block duration or interruption frequency associated with specific content segments, to build a preliminary list of ad blocks and sequence them into appropriate points in the section table, attempting to match the desired parameters as optimally as possible.

Next, it assembles ads from the master ad table into a set of blocks that optimally match the preliminary block times, possibly in consultation with a local or remote database to provide additional usage history and system data to aid in this process. For instance, when the user quits a request session during the play of a required ad, the system keeps track of this through the usage monitor **524** (FIG. **5**B), and it may at this point in the logic set up an ad or ad block to run at the very beginning of a session. With these complete, the section table **674** and ad block table **672** are finalized.

Step **626** concludes with a determination of ad preference parameters **678** for track media. These parameters are computed from the ad requirement and other parameters described above. They may include a track allowance, for adaptive ad scheduling on the basis of allowed tracks, and a preference weighting, to apply to track allowance scheduling against time allotment scheduling. Other ad preference parameters may include relative weightings for title based, genre based, demographic based, location based, and/or other bases for ad selection that are provided in the ad preference tables.

Next, in step **628**, the ad manager either launches a new thread or requests the maintenance handler to issue it an already existing maintenance thread. Either way, a concurrent ad rotator **516** is associated with the main request thread of ad manager **514**. In the course of establishing ad rotator **516**, ad manager **514** passes its alternate ad table **660** and media request list **650** to ad rotator **516**, which retains them to handle requests for new ads. The first action taken by ad rotator **516** is to synchronize local database **562** with any updated information found in media request list **650**, which may include file locations and security keys, among other things. After ad rotator **516** has modified local database **562**, it waits for new ad requests from the intersplicer **518**, handling them accordingly. Ad rotator **516** may also take it upon itself to act as an ongoing ad localizer, transferring new ad content to the local system to keep a steady supply of ads available for use. In this manner, future media play requests **502** can avoid the delays associated with ad transfer. Upon establishing ad rotator **516**, ad manager **514** receives an ad rotator reference through which the play/view request **502** thread can continue to communicate with it.

In step **630**, the ad manager ends, and the request that called it passes control on to intersplicer **518**. The ad manager passes its master ad table **670**, ad block table **672**, content play section table **674**, adaptive preference rules, which include ad preference tables **676** and ad preference parameters **678**, and the ad rotator reference **680**, to the intersplicer **518** (FIG. **5**A), which retains them for its own use.

Referring now to FIGS. **7**A and **7**B, there is shown in FIG. **7**A a more detailed flowchart of the operation of step **518**, the intersplicer. In FIG. **7**B, there is a block diagram that indicates the data stored in memory and exchanged in association with the logic of steps **518**, **520**, and **516**.

Referring now to FIG. **7**A, there is shown a flowchart illustrating in detail an example of one particular method of the operation of the intersplicer. The intersplicer begins in step **700**, where it receives in memory a master ad table **670**, an ad block table **672**, a content section table **674**, ad preference tables **676**, ad preference parameters **678**, and ad rotator reference **680**.

Master ad table **670** contains location and other data about every ad that has been selected to run with the session. Ad block table **672** contains a series of ad blocks, each of which is a series of references to individual ads in master ad table **670**. Section table **674** is a list of content sections with indications for any pre-programmed ad breaks, and information about the location of each media section, along with start and end time offsets. Ad preference tables **676** and parameters **678** are rules by which the intersplicer can perform adaptive ad selection and sequencing extemporaneously, determining and running new ad combinations in response to user navigation actions throughout the session. Ad rotator reference **680** is the point of communication for intersplicer **518** to contact ad rotator **516** to request ad rotation and other services from it.

In step **702**, the intersplicer uses the content section table, master ad table, and block list table to build a raw section sequence table **780** of ordered sections. These sections may possibly include indicator flags through which the running real-time player **520** may identify the boundaries between content and required ads, or the program may rely on the intersplicer to check the player settings on a regular basis and determine on its own when required ads are in progress. The section sequence serves as a map from a time point in the overall sequenced session to a time point in a particular content or ad item, along with the identity of that item.

Next, in step **704**, the intersplicer **518** initializes a set of player settings **782**, which directly control how playback proceeds. It initializes player settings **782** for standard play starting at the beginning of the sequence determined in step **702**, and it prepares all data pertaining to the play section sequence **780** and the player settings **782** for shared use with real-time player **520**. Without limitation, player settings **782** may include the media mode (audio, video, or print), direction of play, play rate, video frame rate, audio sampling rate, sound volume, current media frame/location, redraw mode (update, no update, or black), and next media switch. In step **706**, intersplicer **518** launches real-time player **520** as a concurrent thread, maintaining the means to exchange section sequencing **780** and player settings **782** back and forth between itself and real-time player **520**. After step **706**, the real-time media player **520** runs on its own and communicates back and forth with intersplicer **518**, either through a block of common memory, a system of message passing, or any other appropriate means. Real-time player **520** runs whatever media is in its section sequence **780**, according to its player settings **782**, and all alterations in playback arrive to the player as data exchanged from intersplicer **518**. Furthermore, real-time player **520** signals back to intersplicer **518** whenever it starts or finishes playing an advertisement block.

The real-time player is responsible for physically running the media content in context of the player/viewer, and running ads wherever the intersplicer has sequenced them into the material, as well as releasing for use any media content that has been secured through encryption, through the logic of secure/release **582**.

The real-time player **520**, monitors the section sequence table at regular intervals to adjust the way it buffers media content from local storage to memory, prepares to open and close files, and selects which specific timing and sequence of frames and/or audio samples to extract from storage and display/play. These operations occur in conjunction with a real-time clock or other interrupt signal that is employed to enhance communication with the audio and graphics hardware, to provide the smoothest and most pleasing display appearance and/or audio possible.

In step **708**, the intersplicer communicates with the real-time player for the purposes noted above. When the intersplicer detects the start of an ad block, it checks to see if the ad block is required. When an ad block is required, the player/viewer disables playback-altering functionality that the user could apply to circumvent the running of these advertisements in their entirety. That is, any user command to alter the rate of play or skip in the forward direction is disabled, along with muting or reducing the sound volume beneath a certain minimum threshold. Initially, each ad and ad block is required, but once an individual ad and its current ad block have played completely through, the logic of the player/viewer may indicate that enforced regular-speed play is no longer necessary for the particular ad or ad block in question. When an ad or ad block is not required, it may be handled in the same way as part of the content, or skipped entirely.

The player/viewer maintains a persistent memory of each ad block and ad in the master list. However, track allowance based ad blocks are assembled extemporaneously by the intersplicer in response to the number of tracks or pages that the user has received, possibly operating in conjunction with some sense of timing based on the clock. Typically, these blocks are new every time, and only certain ads within them may be skipped, if skipping in this instance is to be allowed all.

In step **710**, the intersplicer takes special actions if it detects that a required ad section is starting or ending. At the start of a required ad section, a copy of the current player settings is saved, and the parameters are set to regular speed play at a volume no less than a particular threshold level. Also, if user-interface functionality is to be disabled directly during required ad play, this takes place here. There is logic provided through intersplicer control commands **522** to handle the enforced viewing of ads according to the invention without resorting to disabling controls at the interface level, but the option exists to do so instead or in addition. If user interface controls are not disabled directly, they can check the current ad state of the intersplicer through a special intersplicer command and use this result in their own operations. If step **710** detects the finish of a required ad block, it will restore the player settings that were saved as the required ad block was entered, subject to any intersplicer control commands **522** that may have altered the saved settings.

In step **712**, the intersplicer performs any necessary adaptive ad selection. If an unsegmented title or track is currently in progress, the adaptive logic keeps track of the number of tracks played, and the time passed since the last ad ended. Depending on values in the ad selection parameters, the intersplicer will apply some combination of track count-based and elapsed time-based logic (or any other desirable criteria) to decide when to call for a commercial break. When it decides to insert a break, it uses the data in the ad preference parameters **678** and the ad preference

tables **676** to select individual ads from the master ad table **670** to put into the block, and orders them in the way that best fits the preference parameters of all the ads in the block.

In step **714**, the intersplicer consults the local data it is keeping in memory on ad usage, in conjunction with any special messages it may have received from the adaptive ad selector about having trouble finding ads. If it finds one or more ads and or blocks that have either shown too many times or been held in the list for too long a period of time, it makes a maintenance request for local ad rotation. The intersplicer contacts its ad rotator and sends it a list of ads and ad blocks in any combination, which are to be replaced, or it may request an entire new set of ads to replace all the current ones.

The ad rotator may choose to consult the alternate ad table or run the equivalent of a whole new ad manager session to replace the ads and/or ad blocks requested by the intersplicer. When it has finished it's task, it informs the intersplicer that new ads are ready, and the intersplicer **518** receives the result and swaps the new ads/ad blocks in place of the old ones when it finds an appropriate time, keeping usage data from the old ads to be used later to compute ad penetration.

As the user arbitrarily controls the playback, intersplicer **518** keeps an account of its entire user-directed play history, including which ad blocks have been seen, the number of times each individual ad has run, and the ad selection criteria behind each of these runs. In response to this history, the intersplicer dynamically selects ads from its available pool to group into new blocks and sequences them into the playback at appropriate points. In this way, the ads run are customized to the consumer's actual use of the content.

In step **718**, the intersplicer may elect to checkpoint any data it is maintaining about the media and ads that have played in order to compile usage records, and to maintain an in-process snapshot of this information to be recovered in the event of a system failure.

The ability of the player/viewer software to adaptively select, sequence, and re-sequence ads that are shown on the basis of user navigation through a self-selected series of media content is a novel feature for media players, and it is also novel in the field of media distribution, in that software running on a consumer system is presenting same-media style ads that are sequenced on the basis of the user's particular choices of content and playback. Also novel is the on-demand selection of appropriate ads from a greater repository, performed by software running centrally or on a consumer's machine, to custom-select and assemble the ads shown on the basis of the consumer's choice of content, as well as demographic and other consumer information on file.

In step **720**, the intersplicer checks to see if any user action or system timeout has requested to close the session, and if not, it loops back to step **708** to continue processing user, player, and ad rotator interactions. In the event a session close has been indicated, control passes to step **722**, which signals the playback session to end. This signal causes the real-time player **520** to stop and close itself out, a process in which it closes open files, cleans out its buffers, and ends. Once it has closed real-time player **520**, the intersplicer releases ad rotator **516** and cleans up after itself, finishing step **722** and moving on to its end, in step **724**.

In step **708**, the intersplicer communicates with the real-time player to maintain certain playback parameters, which affect the control of playback. The player/viewer maintains a sense of the currently active intersplicer in the course of managing its GUI frames and panels. When a user takes any action on a graphical object in the play control area of the interface, the user interface **500** calls one or more appropriate intersplicer control command methods **522** belonging to the focused intersplicer.

These intersplicer control methods **522** alter certain player settings in memory, causing the real-time player **520** to alter playback upon discovering the change.

User commands that communicate with the intersplicer in this manner include the common playback controls of play, stop, pause/continue, reverse, rewind, fast-forward, slow-motion, track advance, frame-by-frame advance, go direct to point or page in sequence, and shuttle knob. They also include any sound controls, such as volume and mute, and for print media, the display control operations of forward and backward page turns and chapter advances and returns.

According to the invention, the real-time player **520** deciphers media files as it runs through the logic of secure/release **582**, playing or showing content directly to the user through volatile sound and display devices, and managing any needed buffers in the process. Where non-volatile memory or other storage is used for buffering of copyrighted content during the course of playback, provisions available to the computer system to limit access to these areas from outside the program may be employed, and the intersplicer may include in its clean-up tasks the job of explicitly writing over any areas that contain unencrypted content. In addition, the intersplicer may use a rough encryption algorithm on these buffer areas to further hide them from the user.

The intersplicer handles user generated requests to alter the speed of playback or skip around throughout the requested material. It keeps track of all the particular segments of the content and advertisements that have run through its play history, including a count of the number of times for each of them. As any single ad or block of ads is presented multiple times throughout the course of the session, the intersplicer may call for new ads and/or ad blocks as it deems they are needed, and a maintenance process will see to it that the requested ads are replaced. When the user or the player/viewer application signals that the requested session is ready to close, the intersplicer closes out playback and passes its raw data on media use and ad penetration along to step **524**, the usage monitor.

Other than the controls to navigate through audio/video playback and print viewing, there are also intersplicer methods to handle user interface manipulation on the part of the user. As multiple requests to play/view **502** are running concurrently, there are actions that close a running request, those that hide an individual play/view presentation, and others that restore the view of a hidden presentation.

FIGS. **8**A-**8**D, **9**A-**9**C, **10**A, and **10**B are flowcharts to illustrate the operation of the primary intersplicer control commands **522** (FIGS. **5**A, **7**A). These operations are the essential elements of the user controls listed above, and one of many important novelties of the invention is its ability to ensure the viewing of promotional ad material when the service level calls for it, whether through these controls or by some other approach. As these commands alter the course of play, they are also responsible for gathering user play history data, effectively keeping track of the user's entire navigation history throughout the material, as shown in the following figures. The commands illustrated in these figures are those that pertain to the operation of the intersplicer. The user actions which invoke these commands may involve additional operations not shown, to manage other appearance and behavior aspects of the user interface.

Referring now to FIG. **8**A, there is shown a flowchart depicting an intersplicer control command to stop or pause

playback, beginning at step **800**. In step **802**, it issues an intersplicer player setting to signal the player to halt. In step **804**, it makes a decision based upon whether the initiating user action is a "stop" or a "pause". In the event of a "stop", step **806** issues a player setting to put up a black screen, rather than to display the current frame. In the event of a "pause", control skips past step **806**, directly to the end **808** of the command.

Referring now to FIB. **8**B, there is shown a flowchart illustrating the operation of an intersplicer control method to play forward at regular speed, beginning at step **820**. The player setting for "current frame" reflects the print page or video frame (for video content or audio content with corresponding visual feedback) at the point in the media sequence being presented, along with any audio sample corresponding to the start of the frame. The current frame changes in response to playback progression and user navigation through the content.

In step **822**, the method checks on the condition of the screen to see if it is black. If the screen is not black, control proceeds directly to step **828**. Otherwise, control proceeds to step **824**. In step **824**, the intersplicer checks to see if any ads are immediately necessary as a result of user navigation taken while the screen was black, and waits for the intersplicer to run any such ads in their entirety, before passing control to step **826**. In step **826**, the method redraws the current frame and passes control to step **828**.

In step **828**, the method checks if there is a current session play history for the content. If there is no existing play history, step **830** starts play history tracking by marking the current playback point as the start point, before passing control to step **832**. Otherwise, there is no need to start a new instance of play history, and control proceeds directly to step **832**, which signals the intersplicer to resume play at normal speed. The method ends at step **834**.

Referring now to FIG. **8**C, there is shown a flowchart illustrating the operation of an intersplicer control command method for general navigation throughout the requested content. This includes backing up at a regular, reduced, or accelerated speed, fast-forward play, skipping forward or backward to a fixed point, slow motion or frame advance, and general skipping around by dragging along a time bar.

In step **862**, the method checks to see if a required ad is currently in progress. If the answer is yes, step **864** checks to see if the requested operation is a backward skip, and exits the method immediately if it isn't. If it is a backward skip in a commercial segment, control passes to step **868**, which halts play, and then to **870**, which moves the current frame back to the beginning of the current ad or advertisement block. When a required ad is playing, no skipping prior to this point is permitted. Step **872** redraws the current frame at this point, using the method illustrated in FIG. **8**B, and once playback is resumed, the method ends in step **874**.

At step **862**, if no ad is in progress, or the ad and ad block in progress are already tagged as having been viewed at least once, control proceeds to step **876**, which halts playback. Next, step **878** updates the play history currently in progress with the initiated navigation and continues tracking. Step **880** is a decision based on whether the operation that called the method is one to alter the play speed, or to skip around. In the event of a speed alteration, control passes to step **882**, signaling the intersplicer to run the player at a new forward or backward speed. In the event of a skip, control passes to step **884**, which moves the current play position to a new point and signals the intersplicer to redraw the screen with the frame for the new position. After step **882** or **884**, the method ends in step **886**. If playback is to resume after a skip action, the action calls the method shown in FIG. **8**D at this point. In either case, if the user is dragging along a time bar, playback doesn't resume until the drag is released.

In FIG. **8**D, there is shown a flowchart to illustrate the operation of the intersplicer control command to resume play upon release of an interactive skip operation. The command begins in step **890**. In step **891**, the program checks to see if a required ad is already in progress. If the answer is yes, then control proceeds to step **893**, which resumes playback at regular speed, using the method depicted in FIG. **8**B. After resuming playback, the method ends in step **898**. If the answer is no, then control passes to step **892**, where the intersplicer checks to see if any ads are immediately necessary as a result of the user's jump to the new current position, and waits for the intersplicer to run any such ads in their entirety, before passing control to step **894**. In step **894**, the program updates the play history with the starting point of the new play location. Next, step **896** signals the intersplicer to resume play at the current speed setting, and the command ends in step **898**.

Referring now to FIG. **9**A, there is shown a flowchart illustrating the operation of an intersplicer control command to close out the media request session. The command begins in step **900**. In step **902**, it instructs the intersplicer to halt play if it is in progress. In step **904**, it checks to see if play history tracking is in progress. If it is, then the command goes to step **906**, which ends the current play history and passes control to step **908**. If not, control proceeds directly to step **908**. In step **908**, the command instructs the intersplicer to close out its session the next time it reaches its decision step **720** (FIG. **7**A).

Referring now to FIG. **9**B, there is shown a flowchart illustrating the operation of an intersplicer control command to hide the view of a running intersplicer's panel or window. The command begins in step **920**. In step **922**, it instructs the intersplicer to signal its associated real-time player to turn off the redrawing of running media, allowing the player to free up resources as it sees fit. Step **924** ensures that audio content will continue to play if the media is not halted, and it may involve signaling higher level audio control software to mix this audio with that of other active intersplicer sessions. Step **926** indicates to the intersplicer that the player is "hidden", for sake of tracking media use and ad penetration. That is, play history accounting of content or advertising that plays while the intersplicer is hidden will take into account the fact that any visual aspect of the content or ad was hidden at the time. This accounting applies to video and print content or ads, because their visuals are not seen, and to the audio portion of any content or ad in the special case where another session's audio is mixed into the stream while the content or ad is playing. In the case of hiding the panel or window of audio-only content to use some other silent visual media, hidden accounting of content or ad play history may not take effect. Step **928** is the end of the command.

Referring now to FIG. **9**C, there is shown a flowchart illustrating the operation of an intersplicer command to restore the view of a hidden intersplicer's panel or window. The command begins in step **940**. In step **942**, the command prompts the intersplicer to resume display activity through its associated real-time player, giving the player a chance to ready any buffers and other resources it needs to reestablish visible play. Once the player is prepared to proceed, control passes to step **944**, which signals the player to resume redraw of visual content. The command ends in step **946**.

Referring now to FIG. **10**A, there is shown a flowchart illustrating the operation of an intersplicer command to

change or mute the playback volume. According to the invention, volume and mute controls behave as they would in an ordinary media player, except during the presentation of required ads. In that circumstance, the player/viewer has a minimum threshold, and the sound volume is required to be at or above this level.

The method begins in step **1000**. In step **1002**, the method saves the new volume level value as the volume to be applied after completing required ads. In step **1004**, it checks to see if a required ad is currently in progress. If the answer is yes, step **1006** checks the new volume level against the minimum threshold volume for required ads. If the new volume level is at or beneath this level during required ad play, step **1008** signals the player to change the volume to the threshold level. If the requested volume is above the threshold, or if required ads aren't in progress, control proceeds to step **1010**, which changes the player volume to the new level. In either case, control proceeds after step **1008** or **1010** to step **1012**, the end of the method.

Referring now to FIG. **10**B, there is shown a flowchart illustrating the operation of an intersplicer command to turn the page. This command is used in the course of viewing print media, where the user is offered buttons to page forward or page backwards. Print media also offers controls to skip to the beginning or end of the current chapter (which may take any of the same form as book chapters, newspaper sections, magazine features, or other editorial divisions), or to any specific point in the content. For these operations, the method of FIG. **8**C is employed, where each page can be thought of as a "frame" in the viewer, and chapters are equivalent to segments for the purpose of determining ad requirements.

However, most user interaction with print media is on a page-by-page (frame-by-frame) basis, and individual page turns may signal the insertion of one or more required ads. The intersplicer command for turning the page begins with step **1020**. In step **1022**, the method checks to see if a required ad involving any visual content is already in progress. If the answer is yes, control proceeds to step **1024**, which signals the forward or backward page turn logic associated with the current ad, after which the method ends in step **1026**, thereby prohibiting the user from paging out of a required visual ad while it is in progress. If the particular ad logic is equipped for user-requested page turns within the ad, it will handle the signal from step **1024** accordingly.

If the answer to step **1022** is no, control proceeds to step **1028**, which tests whether the page turn is in the forward or backward direction. If the direction is forward, step **1030** sets the update page to be the page after the current page. If it's backward, step **1032** sets the update page to be the page before the current page. Either way, control after that proceeds to step **1034**.

Step **1034** is a test to see if the page turn request crosses a chapter boundary in the print media. If the answer is yes, control proceeds to step **1036**, which checks to see if any ads are to be shown at the specific chapter boundary in question. If the answer is yes, control proceeds to step **1038**, which resets the page counter before passing control to step **1040**. Step **1040** runs or queues the appropriate ad or block of ads, and, as with all ads, the intersplicer maintains the means to determine if such ads are required to run in their entirety, or if the user is allowed to skip through them.

Step **1040** typically starts running the new ads immediately. However, if a previous audio-only ad is still in progress at the time, step **1040** queues the new ad segment for play immediately following the completion of the playing ad. If the new ad segment is not required, step **1040** may elect to forego it for sake of user convenience, rather than putting it in the queue. If it queues up any visual advertising material, step **1040** may display a special purpose, single-page silent ad to accompany the audio-only ad that is still in progress, which may be generic in nature or tied to the current ad in some material way.

Once step **1040** has set into motion or queued the new advertising, step **1042** decides whether the currently playing ad has any visual content. If the answer is yes, the method ends at step **1044**. Otherwise, control proceeds to step **1048**, which updates the displayed page, and then to step **1050**, which tests to see if it is valid to increment the page counter. The purpose of this is to allow assorted rules of use to page allowance. One such use would be to increment in all cases, whether the page turn is forward or backward. Alternatively, only forward page turns may increment the counter, or the counter may increment only when turning to a page that hasn't been viewed within the last few minutes. Whichever method is chosen, a test for it is performed in step **1050**. If the test passes, control proceeds to step **1052**, in which the method increments the counter before ending in step **1054**. If it fails, the method goes directly to its end at step **1054**.

If the answer to either step **1034** or **1036** is no, control passes to step **1046**, which is a decision based on the value of the page counter. If the page count has reached or exceeded the allowance for page turns between ad segments, control goes back to step **1038** and then to **1040**, resetting the page counter and calling for ads. Allowance-based ads are typically required when they arise, as opposed to chapter break ads which are generally required just the first time around. It is also generally true that allowance based ads rotate more often than chapter break ads, which maintain some sense of "particular ads at a particular place" in the media time line. In step **1042**, the method will decide to end if the currently playing ad is visual in nature. If the ad is audio-only, control proceeds to step **1048**, updates the displayed content page, and then to step **1050**, which tests to see if the page counter is to be incremented. If the answer is yes, step **1052** increments this count before passing control to step **1054**. Otherwise, control passes directly to step **1054**, the end of the command.

Whenever a visual ad or block of ads finish, the update page is the page that is viewed next in the paging direction. It is also possible to have blocks of text content and visual ads interspersed on the same "page", much in the same way that content may appear interspersed with advertising on a traditional newspaper page. In this case, the intersplicer treats the assembly of content and advertising as a visual ad, and the ad provides logic to handle all of its associated parts, through the mechanism of step **1024** above, possibly operating in conjunction with user interface event handlers that work directly with the logic of such print ads.

Through the operation described above, the invention behaves as described, providing a novel apparatus that implements the method of a particular business model. That model is the sponsorship of media content, made available to the public for free, through the use of paid commercial interruptions. The use of this business model adds value to the distributor and copyright holder by creating a market for advertising time via the distribution system, and it adds value to the consumer, who gains the ability to request any available desired content on demand and use it for free. The wider the consumer audience that uses and redistributes content to be used in this fashion, the greater the benefit to the distributor and copyright holder.

By implementing this business model, the apparatus and method of the present invention are a new use of digital

rights management technologies, one that is a clear improvement over their ordinary practice of either granting or denying use of material altogether. The invention pertains to any digital media distribution or rights management system that employs application software, running on a multitude of consumer devices, to enforce the insertion of ads into the media content presentation stream at time of use as described above, where these ads are selected and their sequence determined by the software on the consumer device. In a particular embodiment with additional functionality, ad selection at the consumer device level is supplemented through ad selection from a central database, either as a means to determine candidate ads, or as a distributor-supplied fill-in for broadcast streams, to provide an option to consumer device level ad sequencing when user specific ads aren't available in time to go with the stream.

Referring now to FIG. **11**A, there is shown a schematic diagram indicating exchanges between individual consumers **102**, the media distributor **120**, and one or more copyright-holders **1110**, as they commonly occur on digital networks without the method and apparatus of the present invention.

Individual consumers **102** receive media content though direct purchase or ongoing subscription to an online service offered by a distributor **120**. Whether this happens by transfer over a digital network **100**, or physical conveyance of removable media, the content is transferred directly to a particular consumer in exchange for a one-time charge or regular periodic payment. The distributor **120** has an agreement with the copyright holders **1110** to pay them a certain royalty based on use of their material, and the distributor **120** pays this out of the money received from the consumers **102**.

Ordinarily, when individual consumers **102** have the ability to openly copy and redistribute media content over a network **100**, this arrangement breaks down. Under this circumstance, certain consumers can get content directly from one or more other consumers, thereby bypassing the legitimate distribution chain and using the media without paying for it.

The distributor **120** may employ existing digital rights management methods to curtail this type of exchange, but only to a certain extent. There is generally some way for an unscrupulous consumer to get around the system and redistribute the media property, even if it means having to go through an intermediate analog or other step. Furthermore, there is a strong market force to support such piracy, because of the economic nature of media content as a good. It is believed that the majority of consumers who refrain from purchasing media content do so more out of pricing concerns than out of lack of interest in the product. This implies that there is a huge market for pirated media content, given the vast number of consumers who would use more media if the price were lowered.

Referring now to FIG. **11**B, there is shown a traditional broadcast model for media distribution. A broadcaster **1120** pays to license the use of content material from the copyright holder **1110**, and sends it out for free over the airwaves, through cable lines, or through some other means to the widest possible audience of consumers **102**. The broadcaster **1120** profits from this practice by inserting paid advertisements into the content stream, which the consumers **102** are ordinarily exposed to along with the content because of the real-time nature of their receiving devices. One or more sponsors **1130** pay the broadcaster to run their ads, in exchange for the audience viewership that these ads receive. A sponsor **1130** makes money from an individual consumer **102** when the consumer purchases the sponsor's product as a result of seeing or hearing an ad for it.

Radio and television broadcasting have conventionally employed such a model, and as the system matured, the value of a viewership ratings system **1150** became apparent. Through statistically based estimates on programming viewership, broadcasters and sponsors get a better sense of the value of their ad time.

This system supports the free distribution of media content to the widest possible audience. The more consumers **102** who are exposed to content sequenced with ads, the greater the value sponsor **1130** and broadcaster **1120** derive from it. If a consumer **102** records broadcast material and redistributes it to other consumers digitally over a network, without removing the ads, there is still value to be had, if only the viewer rating system **1150** had a way of measuring such use and including it into its statistics. Ordinary methods of viewer ratings measurement are not equipped to handle this type of redistribution.

With conventional broadcasting systems, there is little to be gained even if this redistribution were measured, because of the ease with which consumer technology can edit out the paid advertisements from a recorded broadcast. That is, for a consumer who is going through the effort of redistributing broadcast material, it requires very little extra effort to remove the commercials from the content, thereby circumventing the system entirely.

Referring now to FIG. **11**C, there is shown a schematic diagram for media distribution according to the invention. In this case, we have a distributor **120** who distributes media to individual consumers **102** by the same direct transfer methods described with FIG. **11**A, one method of which is transfer over a digital network **100**.

However, by the apparatus of the invention, in particular the player/viewer software which individual consumers use to playback their content, a method is put in place to insert advertisements targeted by user demographic information, device location, user self-selected preferences, or some other criteria, into every media presentation that is produced for a consumer who chooses to use the content for free under a general license. By way of this novel apparatus, the invention creates a new use for the traditional broadcaster's business model, depicted in FIG. **11**B.

By virtue of this business model, the value to distributor **120** and copyright holder **1110** of unrestricted consumer redistribution of material is turned from a liability to an asset, and a clear improvement results. Consumer redistribution becomes in effect a means of broadcasting, and the revenue generation value of the distribution system is bolstered by it.

According to the invention, a distributor **120** makes arrangements for the use of content material from the copyright holder **1110**, and sends it out for free over a digital network **100** to the widest possible audience of consumers **102**. The distributor **120** profits from this practice by inserting paid advertisements into the media presentation, which the consumers **102** are forced to watch and/or listen to along with the content because of the player/viewer software apparatus of the invention. One or more sponsors **1130** pays the distributor **120** to run their ads, in exchange for the audience viewership that these ads receive. A sponsor **1130** makes money from an individual consumer **102** when the consumer purchases the sponsor's product as a result of seeing or hearing an ad for it.

To gauge the audience viewership that these media and ads receive, the player/viewer software includes a unique usage monitor which provides for a more sophisticated

viewer ratings system than the ordinary and conventional ratings systems in practice with traditional broadcasting. Principally, the usage monitor forwards media and ad penetration data gathered during media presentation, from every consumer (rather than just from a representative sample), to the viewer ratings system **1152**. Additionally, when used in conjunction with information gathered by virtue of the digital rights management practices employed for license verification, these data provide a complete media and ad consumption history for each user.

With usage monitoring, it also becomes feasible for the license verification process to provide "special offers" and other extra benefits in exchange for frequent use. For instance, the distributor might choose to bestow a full purchase license to a media title upon a consumer who has "earned" it by way of many repeated presentations of the same title under the general license with ads. Alternatively, the distributor might choose to grant "reward points" to a consumer, "earned" by way of many repeated presentations of various media under the general license with ads, good toward a full purchase license to a media title of the consumers choosing. A third alternative might involve rewarding a consumer with either a full purchase license to a media title or "reward points" good toward a full purchase license to a media title of the consumers choosing, in exchange for that consumer making other consumers on the system aware of new media, either directly or indirectly, which results in additional revenue which can be attributed to the efforts of the original consumer.

This method and apparatus result from the incorporation of well-established mass-media broadcasting practices, along with existing and new computer-controlled digital data management, manipulation, and encryption techniques, into a novel, software based digital media presentation apparatus. By coupling the long-standing broadcast media practice of commercial advertisement sponsorship with the appeal of select-on-demand, consumer-level redistribution, it is a great improvement over current digital media distribution practices. The consumer retains the conveniences of virtually unlimited free media selection, instant access, and unrestricted sharing, while gaining the legitimate right to have them. The copyright owner gains a tangible value from the increased viewership resulting from unlimited consumer-level redistribution of content onto digital devices, and explicit control over media use. The ability of media content consumers **102** and copyright owners **1130** to mutually benefit from digital distribution over a network **100** is vastly improved.

Without departing from the spirit and scope of this invention, one of ordinary skill in the art can make various changes and modifications to the invention to adapt it to various usages and conditions. For example, while in the embodiments described herein the invention is implemented primarily in software, it should be understood that the invention may be implemented with hardware, software, firmware, or any combination thereof. As another example, ad selection can be based on other useful criteria including, but not limited to, time of day, the format of the associated media file, and marketing preferences (e.g., user preferences, distributor preferences, advertiser preferences, content provider preferences, etc.). Further, the invention can be embodied in an electronically-readable medium having code embodied therein for causing an electronic device to perform the methods described herein.

We claim:

1. A digital media player device for controlling digital media presentations, the digital media player device comprising:

one or more processors for receiving data comprising digital media content and digital advertising content;

a user interface input for allowing a user to control a course of presentation of the digital media content received;

an intersplicer for controlling one or more insertion points of the digital advertising content into the digital media content thereby sequencing the digital media content and the digital advertising content,

the sequencing comprising ordering one or more data blocks of the digital media content and one or more data blocks of the digital advertising content into a content stream playable as audio or visual content perceivable by the user,

the content stream comprising one or more initially sequenced insertion points at which the digital advertising content is scheduled to be presented relative to the digital media content during play;

in response to user input updating a current play position in the content stream to a new play position in the content stream, the one or more processors using one or more adaptive preference rules to adaptively modify a presentation position of the digital advertising content from at least one of the one or more initially sequenced insertion points to one or more alternatively sequenced insertion points in the digital media content,

at least one of the one or more alternatively sequenced insertion points being different than the one or more initially sequenced insertion points relative to the digital media content within the content stream;

the one or more alternatively sequenced insertion points being adaptively selectable by the intersplicer according to selection criteria defined by the one or more adaptive preference rules taking into account the new play position and at least one of a length of time associated with playing the digital media content and a number of digital media data blocks of the digital media content to be played,

such that at least one of the alternatively sequenced insertion points is positioned at a play position in the digital media content that satisfies a condition selected from:

the play position being a predetermined length of time after the new play position,

the play position being a predetermined number of digital media data blocks after the new play position; and

a user interface output for causing presentation of the content stream during a play period associated with one or more states of play such that a part of the digital advertising content is adaptively played at the one or more alternatively sequenced insertion points, instead of at the one or more initially sequenced insertion points; and

at least a first memory for storing a setting to indicate a first state of play, the setting including a first value to indicate presentation of a required part of the digital advertising content is in progress during presentation of the content stream such that responsive to detecting the first value in the first memory, the user interface input is disabled to prevent commands comprising at least one of a user volume control or a user navigation control from altering a course of presentation of the

content stream while presentation of the required part of the digital advertising content is in progress.

2. The digital media player device as in claim **1**, wherein the user interface input comprises a graphical user interface that includes a time bar to allow the user to control the course of presentation of the digital media content received to a specific point in the presentation past at least one of the one or more initially sequenced insertion points.

3. The digital media player device as in claim **1**, wherein the sequencing is performed by at least one remote system differing from the digital media player device, the at least one remote system comprising a processor.

4. The digital media player device as in claim **1**, wherein the digital media content comprises at least one media file.

5. The digital media player device as in claim **1**, wherein the digital advertising content comprises at least one advertisement file.

6. The digital media player device as in claim **5**, wherein a sequence is generated by sub-dividing a media file into two or more segments, and wherein at least a part of the at least one of the advertising file is presented between two of the segments.

7. The digital media player device as in claim **4**, wherein the user input results in a change of a sequence of two or more media files by at least one of subtracting an existing media file and re-arranging the sequence of two or more media files in a change of sequence by adding a new media file.

8. The digital media player device as in claim **1**, wherein the user input further comprises one or more navigational choices for the content stream.

9. The digital media player device as in claim **8**, wherein the one or more navigational choices are selected from a group consisting of: play, stop, pause/continue, reverse, rewind, fast-forward, slow-motion, track advance, frame-by-frame advance, go direct to point or page in sequence, advance chapter, page turn, change track, change media selection, shuttle knob, and one or more sound controls.

10. The digital media player device as in claim **1**, further comprising: rotating, using an ad manager and an ad rotator, new advertising content into the content stream in response to the user input, the ad manager operative to receive ad files and select ad files for presentation from a database of ad files and the ad rotator configured to replace ad files with new ad files after the ad files have been presented.

11. The digital media player device as in claim **1**, wherein the adaptively modifying uses two or more of the adaptive preference rules for determining the one or more alternatively sequenced insertion points of at least a part of the digital advertising content.

12. The device as in claim **1**, wherein the intersplicer generates control signals configured to instruct the one or more processors to interrupt the presentation of the digital media content with the presentation of the one or more data blocks at the one or more alternatively sequenced insertion points on the digital media player device.

13. The device as in claim **1**, the digital media player device further comprising a media file decryptor configured to receive and decrypt the digital media content during play, the media file decryptor configured to limit access to a non-volatile memory following the decryption of the digital media content.

14. The device as in claim **1**, wherein the digital media player device is configured to read a data structure of the one or more data blocks of the digital media content, the data structure including a first field containing data identifying a media file associated with the digital media content, a second field containing data indicative of an ad requirement associated with the digital media content, and a third field containing data representing an ad file associated with the digital advertising content to be displayed with the media file.

15. The device as in claim **1**, wherein the user interface input includes a time bar configured to control the intersplicer to alter a course of presentation of the content stream in response to the user dragging the time bar, the dragging of the time bar enabling at least one of fast-forward play, skipping forward, backward skipping to a fixed point, slow motion play, and frame advance play.

16. The device as in claim **1**, wherein the user interface input includes a graphical user interface comprising a first tab indicative of a first media type and a second tab indicative of a second media type such that a user selection of the first tab causes the digital media player device to present a media file of the first media type in an active display window with a time bar, the time bar configured to control the intersplicer to alter a course of presentation of the content stream in response to the user dragging the time bar, and a user selection of the second tab causes the digital media player device to present another media file of the second media type in a background window.

17. A computer-implemented system for controlling digital media presentations, the system comprising:

one or more processors;

a user interface for allowing a user to control a course of presentation of digital media content;

an intersplicer for controlling one or more insertion points of digital advertising content into the digital media content thereby sequencing the digital media content and digital advertising content,

the sequencing comprising ordering one or more data blocks of the digital media content and one or more data blocks of the digital advertising content into a content stream playable as audio or visual content perceivable by the user,

the content stream comprising one or more initially sequenced insertion points at which the digital advertising content is scheduled to be presented relative to the digital media content during play;

in response to user input updating a current play position in the content stream to a new play position in the content stream, the one or more processors using one or more adaptive preference rules to adaptively modify, a presentation position of the digital advertising content from at least one of the one or more initially sequenced insertion points to one or more alternatively sequenced insertion points;

the one or more alternatively sequenced insertion points being adaptively selectable by the intersplicer according to selection criteria defined by the one or more adaptive preference rules taking into account the new play position and at least one of a length of time associated with playing the digital media content, a number of digital media data blocks of the digital media content to be played, and a point in time the digital media content is to be played, such that at least one of the alternatively sequenced insertion points is positioned at a play position in the digital media content that satisfies a condition selected from:

the play position being a predetermined length of time after the new play position,

the play position being a predetermined number of digital media data blocks after the new play position, and

the play position being at a predetermined time of the hour after the new play position;

a user interface output for causing presentation of the content stream during a play period associated with one or more states of play such that a part of the digital advertising content is adaptively played at the one or more alternatively sequenced insertion points, instead of the one or more initially sequenced insertion points; and

at least a first memory for storing a setting to indicate a first state of play, the setting including a first value to indicate presentation of a required part of the digital advertising content is in progress during presentation of the content stream such that responsive to detecting the first value in the first memory, the user interface is disabled to prevent commands comprising a user navigation control from altering a course of presentation of the content stream.

18. The system as in claim **17**, wherein the at least first memory is part of the computer-implemented system.

19. The system as in claim **17**, wherein the at least first memory is part of at least one remote system.

20. The system as in claim **17**, wherein the at least first memory is part of at least one remote system.

21. A computer-implemented method for controlling digital media presentations using an improved digital media player system, the method comprising:

receiving, on a digital media player system, data comprising digital media content and digital advertising content, the digital media player system having a user interface and an intersplicer, the user interface configured to allow a user to control a course of presentation of the digital media content received, and the intersplicer configured to control one or more initially sequenced insertion points of the digital advertising content into the digital media content;

sequencing the digital media content, using the intersplicer, the sequencing comprising ordering one or more data blocks of the digital media content into a content stream playable as audio or visual content perceivable by the user, the content stream comprising a media section that comprises at least some of the digital media content, the content stream further comprising an advertising block within which at least some of the digital advertising content is scheduled to be presented, the advertising block being arranged within the content stream at an initially defined insertion position relative to the media section during play;

adaptively re-sequencing the content stream into a modified content stream to reflect a user input comprising updating a current play position to a new play position in the digital media content detected at the digital media player system, the modified content stream comprising an alternate insertion position of the advertising block relative to the media section, the adaptively re-sequencing comprising determining the alternate insertion position using one or more adaptive preference placement rules associated with the digital media content;

the alternate insertion position being adaptively selectable by the intersplicer according to selection criteria defined by the one or more adaptive preference placement rules taking into account the new play position and at least one of a length of time associated with playing the digital media content, a number of digital media data blocks of the digital media content to be played, and a point in time the digital media content is to be played, such that the alternate insertion position is positioned at a play position in the digital media content that satisfies a condition selected from:

the play position being a predetermined length of time after the new play position,

the play position being a predetermined number of digital media data blocks after the new play position, and

the play position being at a predetermined time of the hour after the new play position;

causing presentation of the modified content stream at the digital media player system during a play period associated with one or more states of play;

causing adaptive presentation of a required part of the digital advertising content at the alternate insertion position, instead of at the one or more initially sequenced insertion points;

keeping a setting, in at least a first memory of the digital media player system, to indicate a first state of play, the setting including a first value to indicate presentation of the required part of the digital advertising content is in progress during presentation of the modified content stream; and

responsive to detecting the first value in the first memory, disabling user interface commands comprising a user navigation control that enables the user to alter a course of presentation of the modified content stream.

22. A computer-implemented method for controlling digital media presentations using an improved digital media player system, the method comprising:

transmitting, by at least one remote system to a digital media player system, data comprising digital media content and digital advertising content, the digital media player system having a user interface and an intersplicer, the user interface configured to allow a user to control a course of presentation of the digital media content received, and the intersplicer for controlling one or more insertion points of the digital advertising content into the digital media content;

sequencing the digital media content, using the intersplicer, the sequencing comprising ordering one or more data blocks of the digital media content into a content stream playable as audio or visual content perceivable by the user, the content stream comprising a media section that comprises at least some of the digital media content, the content stream further comprising an advertising block within which at least some of the digital advertising content is scheduled to be presented during play, the advertising block being arranged within the content stream at an initially defined insertion position relative to the media section;

adaptively re-sequencing the content stream into a modified content stream to reflect a user input comprising updating a current play position to a new play position in the digital media content detected at the digital media player system, the modified content stream comprising an alternate insertion position of the advertising block relative to the media section, the adaptively re-sequencing comprising determining the alternate insertion position using one or more adaptive preference placement rules associated with the digital media content during play;

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the alternate insertion position being adaptively selectable by the intersplicer according to selection criteria defined by the one or more adaptive preference placement rules taking into account the new play position and at least one of a length of time associated with playing the digital media content, a number of digital media data blocks of the digital media content to be played, and a point in time the digital media content is to be played

such that the alternate insertion position is positioned at a play position in the digital media content that satisfies a condition selected from:

the play position being a predetermined length of time after the new play position,

the play position being a predetermined number of digital media data blocks after the new play position, and

the play position being at a predetermined time of the hour after the new play position;

causing presentation of the modified content stream at the digital media player system during a play period associated with one or more states of play;

causing adaptive presentation of a required part of the digital advertising content at the alternate insertion point, instead of the initially defined insertion position;

keeping a setting, in at least a first memory of the digital media player system, to indicate a first state of play, the setting including a first value to indicate presentation of the required part of the digital advertising content is in progress during presentation of the modified content stream; and

responsive to detecting the first value in the first memory, disabling user interface commands comprising a user navigation control that enables the user to alter a course of presentation of the content stream.

23. The method as in claim **22**, wherein presentation data comprising an indication of the digital advertising content that has been presented is stored in a second memory of the digital media player system.

* * * * *

EXHIBIT B

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	ISSUE DATE	PATENT NO.	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,729	04/20/2021	10986403	42327-501001US	5831

64046 7590 03/31/2021

Mintz Levin/San Diego Office
One Financial Center
Boston, MA 02111

ISSUE NOTIFICATION

The projected patent number and issue date are specified above.

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)
(application filed on or after May 29, 2000)

The Patent Term Adjustment is 958 day(s). Any patent to issue from the above-identified application will include an indication of the adjustment on the front page.

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (http://pair.uspto.gov).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Application Assistance Unit (AAU) of the Office of Data Management (ODM) at (571)-272-4200.

APPLICANT(s) (Please see PAIR WEB site http://pair.uspto.gov for additional applicants):

Philip M. Donian, San Francisco, CA;
Larry E. Henneman JR., Three Rivers, MI;
Michael M. Malione, Oakland, CA;

The United States represents the largest, most dynamic marketplace in the world and is an unparalleled location for business investment, innovation, and commercialization of new technologies. The USA offers tremendous resources and advantages for those who invest and manufacture goods here. Through SelectUSA, our nation works to encourage and facilitate business investment. To learn more about why the USA is the best country in the world to develop technology, manufacture products, and grow your business, visit SelectUSA.gov.

10/606,729	INTERACTIVE DIGITAL MEDIA AND ADVERTISING PRESENTATION PLATFORM	42327-501001US	04-22-2021::19:57:06

Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/606,729

Filing or 371(c) Date:	06-26-2003	Overlapping Days Between {A and B} or {A and C}:	830
Issue Date of Patent:	04-20-2021	Non-Overlapping USPTO Delays:	2719
A Delays:	2272	PTO Manual Adjustments:	0
B Delays:	1277	Applicant Delays:	1761
C Delays:	0	Total PTA Adjustments:	958

Patent Term Adjustment History Explanation Of Calculations

Number	Date	Contents Description	PTO(Days)	APPL(Days)	Start
236.5	04-20-2021	PTA 36 Months	1277		0.5
236	04-20-2021	Patent Issue Date Used in PTA Calculation			0
235	03-26-2021	Export to Final Data Capture			0
234	03-24-2021	Finished Initial Data Capture			0
233	03-25-2021	Dispatch to FDC			0
232	03-19-2021	Response to Reasons for Allowance			0
231	03-23-2021	Email Notification			0
230	03-22-2021	Application Is Considered Ready for Issue			0
229	03-23-2021	Filing Receipt - Corrected			0
228	03-19-2021	Issue Fee Payment Verified			0
227	03-19-2021	Issue Fee Payment Received			0
226	03-18-2021	Mail Post Card			0
225	03-09-2021	Export to Initial Data Capture			0
224	03-10-2021	Email Notification			0
223	03-10-2021	Mail Notice of Allowance			0
222	03-06-2021	Office Action Review			0
221	03-06-2021	Office Action Review			0
220	03-06-2021	Issue Revision Completed			0
219	03-06-2021	Document Verification			0
218	03-06-2021	Notice of Allowance Data Verification Completed			0

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217	03-06-2021	Case Docketed to Examiner in GAU	0
216	02-26-2021	Reasons for Allowance	0
215	02-26-2021	Allowability Notice	0
212	02-17-2021	Applicant Has Filed a Verified Statement of Micro Entity Status in Compliance with 37 CFR 1.29	0
211	02-17-2021	Date Forwarded to Examiner	0
210	02-16-2021	Response after Non-Final Action	0
209	02-16-2021	Request for Extension of Time - Granted	0
208	01-27-2021	Email Notification	0
207	01-27-2021	Mail Examiner Interview Summary (PTOL - 413)	0
206	01-21-2021	Interview Summary - Applicant Initiated - Telephonic	0
205	01-21-2021	Interview Summary Record	0
204	12-30-2020	Interview Request Correction	0
203	11-13-2020	Electronic Review	0
202	11-13-2020	Electronic request for Examiner Interview	0
201	11-13-2020	Email Notification	0
200	11-13-2020	Mail Non-Final Rejection	0
199	11-10-2020	Email Notification	0
198	11-09-2020	Non-Final Rejection	0
197	11-10-2020	Mail Examiner Interview Summary (PTOL - 413)	0
196	10-29-2020	Interview Summary - Applicant Initiated - Telephonic	0
195	11-05-2020	Interview Summary Record	0
194	10-22-2020	Electronic request for Examiner Interview	0
193	10-22-2020	Email Notification	0
192	10-22-2020	Email Notification	0
191	10-21-2020	Mail Pet Dec Track 1 Grant	0
190	10-20-2020	Office Action Review	0
189	10-21-	Track 1 Request Granted	0

	2020		
188	10-21-2020	Mail-Record Petition Decision of Granted to Make Special	0
187	10-20-2020	Record Petition Decision of Granted to Make Special	0
186	10-20-2020	Pet Dec Track 1 Grant	0
185	10-13-2020	Applicant Has Filed a Verified Statement of Micro Entity Status in Compliance with 37 CFR 1.29	0
184	10-13-2020	Applicant Has Filed a Verified Statement of Micro Entity Status in Compliance with 37 CFR 1.29	0
183	10-15-2020	Date Forwarded to Examiner	0
182	10-13-2020	Amendment Submitted/Entered with Filing of CPA/RCE	0
181	10-13-2020	Request for Continued Examination (RCE)	0
180	10-15-2020	Disposal for a RCE / CPA / R129	0
179	10-13-2020	Track 1 Request	0
178	10-13-2020	Petition Entered	0
177	10-13-2020	Workflow - Request for RCE - Begin	0
176	08-12-2020	Electronic Review	0
175	08-12-2020	Email Notification	0
174	08-12-2020	Mail PTAB Decision on Appeal - Affirmed	0
173	08-10-2020	PTAB Decision - Examiner Affirmed	0
169	12-18-2018	Request for Refund	0
168	12-28-2018	Email Notification	0
167	12-28-2018	Docketing Notice Mailed to Appellant	0
166	12-26-2018	Assignment of Appeal Number	0
165	12-21-2018	Appeal Awaiting PTAB Docketing	0
164	12-19-2018	Appeal ready for PAC review	0
163	12-18-2018	Reply Brief Filed	0
162	10-18-2018	Electronic Review	0
161	10-18-2018	Email Notification	0
160	10-17-2018	Exam. Ans. Review Complete	0

159	10-18-2018	Mail Examiner's Answer	0
158	10-10-2018	Examiner's Answer to Appeal Brief	0
157	08-07-2018	Appeal Brief Review Complete	0
156	08-07-2018	Date Forwarded to Examiner	0
155	07-19-2018	track 1 OFF	0
154	07-19-2018	Appeal Brief Filed	0
153	07-19-2018	Request for Extension of Time - Granted	0
152	04-02-2018	Email Notification	0
151	04-02-2018	Mail Appeals conf. Proceed to PTAB	0
150	03-28-2018	Office Action Review	0
149	03-27-2018	Pre-Appeal Conference Decision - Proceed to PTAB	0
148	04-04-2017	Request for Pre-Appeal Conference Filed	0
146	01-31-2018	Mail Notice of Rescinded Abandonment	0
145	01-29-2018	Notice of Rescinded Abandonment in TCs	0
144	12-11-2017	Email Notification	0
143	12-11-2017	Mail Abandonment for Failure to Respond to Office Action	0
142	12-06-2017	Aband. for Failure to Respond to O. A.	0
140	04-04-2017	Notice of Appeal Filed	0
139	04-04-2017	Request for Extension of Time - Granted	0
138	04-04-2017	Applicant Has Filed a Verified Statement of Micro Entity Status in Compliance with 37 CFR 1.29	0
137	10-12-2016	Electronic Review	0
136	10-12-2016	Email Notification	0
135	10-12-2016	Mail Final Rejection (PTOL - 326)	0
134	10-05-2016	Office Action Review	0
133	10-05-2016	Final Rejection	0
132	08-03-2016	Date Forwarded to Examiner	0

131	08-01-2016	Response after Non-Final Action		0
130	08-01-2016	Request for Extension of Time - Granted		0
128	08-01-2016	Applicant Has Filed a Verified Statement of Micro Entity Status in Compliance with 37 CFR 1.29		0
127	02-01-2016	Electronic Review		0
126	02-01-2016	Email Notification		0
125	02-01-2016	Mail Non-Final Rejection		0
124	01-24-2016	Office Action Review		0
123	01-22-2016	Non-Final Rejection		0
122	01-22-2016	Subtract Disposal Count		0
121	01-22-2016	Subtract 0.50 Disposal Count		0
120	11-19-2015	Date Forwarded to Examiner		0
119	10-28-2015	Amendment After Brief		0
118	08-31-2015	Exam. Ans. Review Complete		0
117	08-28-2015	Electronic Review		0
116	08-28-2015	Email Notification		0
115	08-28-2015	Mail Examiner's Answer	5	110
114	08-24-2015	Office Action Review		0
113	08-18-2015	Examiner's Answer to Appeal Brief		0
112	06-19-2015	Date Forwarded to Examiner		0
111	04-23-2015	track 1 OFF		0
110	04-23-2015	Appeal Brief Filed		0
109	04-28-2015	Appeal Brief Review Complete		0
108	04-11-2015	Email Notification		0
107	04-09-2015	Notice -- Defective Appeal Brief		0
106	04-07-2015	Date Forwarded to Examiner		0
105	08-14-2014	track 1 OFF		0
104.3	02-13-	Defective / Incomplete Appeal Brief Filed		0

	2015			
104	07-19-2018	Appeal Brief Filed	1386	92
103	03-18-2015	Appeal Brief Review Complete		0
102	03-11-2015	Email Notification		0
101	03-11-2015	Mail Advisory Action (PTOL - 303)		0
100	03-05-2015	Office Action Review		0
99	03-05-2015	Advisory Action (PTOL-303)		0
98	02-23-2015	Date Forwarded to Examiner		0
97	02-13-2015	Amendment/Argument after Notice of Appeal		0
96	08-14-2014	Mail Appeals conf. Proceed to PTAB		0
95	08-13-2014	Office Action Review		0
94	08-12-2014	Pre-Appeal Conference Decision - Proceed to PTAB		0
93	07-02-2014	Request for Pre-Appeal Conference Filed		0
92	07-02-2014	Notice of Appeal Filed		0
91	05-01-2014	Electronic Review		0
90	05-01-2014	Email Notification		0
89	05-01-2014	Mail Final Rejection (PTOL - 326)		0
88	04-28-2014	Office Action Review		0
87	04-28-2014	Final Rejection		0
86	02-21-2014	Date Forwarded to Examiner		0
85	02-14-2014	Response after Non-Final Action	86	74
84	02-14-2014	Request for Extension of Time - Granted		0
83	02-14-2014	Applicant Has Filed a Verified Statement of Micro Entity Status in Compliance with 37 CFR 1.29		0
82	12-30-2013	Mail Interview Summary - Applicant Initiated - Telephonic		0
81	12-24-2013	Office Action Review		0
80	12-24-2013	Office Action Review		0
79	12-24-2013	Office Action Review		0

78	12-23-2013	Interview Summary- Applicant Initiated			0
77	12-23-2013	Interview Summary - Applicant Initiated - Telephonic			0
76	08-20-2013	Electronic Review			0
75	08-20-2013	Email Notification			0
74	08-20-2013	Mail Non-Final Rejection	768		59
73	08-13-2013	Office Action Review			0
72	08-13-2013	Non-Final Rejection			0
71	03-29-2013	Email Notification			0
70	03-26-2013	Mail Miscellaneous Communication to Applicant			0
69	03-22-2013	Miscellaneous Communication to Applicant - No Action Count			0
68	03-19-2013	Miscellaneous Incoming Letter			0
65	07-23-2012	Mail Miscellaneous Communication to Applicant			0
64	07-21-2012	Miscellaneous Communication to Applicant - No Action Count			0
63	07-17-2012	Miscellaneous Incoming Letter			0
62	01-18-2012	Miscellaneous Incoming Letter			0
61	03-18-2011	Date Forwarded to Examiner			0
60	03-14-2011	Amendment Submitted/Entered with Filing of CPA/RCE			0
59	03-14-2011	Request for Continued Examination (RCE)		59	51
58	03-18-2011	Disposal for a RCE / CPA / R129			0
57	03-14-2011	Request for Extension of Time - Granted			0
56	03-14-2011	Workflow - Request for RCE - Begin			0
55	02-09-2011	Change in Power of Attorney (May Include Associate POA)			0
54	02-04-2011	Correspondence Address Change			0
53	10-14-2010	Electronic Review			0
52	10-14-2010	Email Notification			0
51	10-14-2010	Mail Final Rejection (PTOL - 326)			0

50	10-08-2010	Final Rejection			0
49	08-11-2010	Date Forwarded to Examiner			0
48	08-02-2010	Response after Non-Final Action		91	43
47	08-02-2010	Request for Extension of Time - Granted			0
46	05-13-2010	Email Notification			0
45	05-13-2010	Change in Power of Attorney (May Include Associate POA)			0
44	05-11-2010	Correspondence Address Change			0
43	02-01-2010	Mail Non-Final Rejection			0
42	01-29-2010	Non-Final Rejection			0
41	11-19-2009	Date Forwarded to Examiner			0
40	11-14-2009	RCE- AF Processed			0
39	11-19-2009	Date Forwarded to Examiner			0
38	11-14-2009	Request for Continued Examination (RCE)		86	34
37	11-19-2009	Disposal for a RCE / CPA / R129			0
36	11-14-2009	Request for Extension of Time - Granted			0
35	11-14-2009	Workflow - Request for RCE - Begin			0
34	05-20-2009	Mail Final Rejection (PTOL - 326)			0
33	05-19-2009	Final Rejection			0
32	03-10-2009	Date Forwarded to Examiner			0
31	02-27-2009	Response after Non-Final Action		53	29
30	02-27-2009	Request for Extension of Time - Granted			0
29	10-03-2008	Mail Non-Final Rejection	1499		0.5
28	09-30-2008	Non-Final Rejection			0
24	07-19-2004	Information Disclosure Statement considered			0
23	09-29-2003	Information Disclosure Statement considered			0
22	07-22-2008	Case Docketed to Examiner in GAU			0
21	06-17-	Transfer Inquiry to GAU			0

	2008		
20	10-17-2007	Withdraw Flagged for 5/25	0
19	10-15-2007	Flagged for 5/25	0
18	06-28-2007	Case Docketed to Examiner in GAU	0
17	03-21-2006	Case Docketed to Examiner in GAU	0
16	03-04-2005	IFW TSS Processing by Tech Center Complete	0
15	03-04-2005	Case Docketed to Examiner in GAU	0
14	08-02-2004	Reference capture on IDS	0
13.7	07-19-2004	Information Disclosure Statement (IDS) Filed	0
13	07-19-2004	Information Disclosure Statement (IDS) Filed	0
12	06-29-2004	Correspondence Address Change	0
11	09-29-2003	Reference capture on IDS	0
10.7	09-29-2003	Information Disclosure Statement (IDS) Filed	0
10	09-29-2003	Information Disclosure Statement (IDS) Filed	0
9	09-22-2003	Application Return from OIPE	0
8	09-22-2003	Application Is Now Complete	0
7	09-22-2003	Application Return TO OIPE	0
6	09-17-2003	Application Dispatched from OIPE	0
5	09-18-2003	Application Is Now Complete	0
4	09-05-2003	CASE CLASSIFIED BY OIPE	0
3	09-05-2003	Cleared by OIPE CSR	0
2	08-15-2003	IFW Scan & PACR Auto Security Review	0
1	06-26-2003	Initial Exam Team nn	0
0.5	06-26-2003	Filing date	0

Close Window

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Electronic Patent Application Fee Transmittal

Application Number:	10606729
Filing Date:	26-Jun-2003
Title of Invention:	INTERACTIVE DIGITAL MEDIA AND ADVERTISING PRESENTATION PLATFORM
First Named Inventor/Applicant Name:	Philip M. Donian
Filer:	Mark D. Hammond/Matthew Tupper
Attorney Docket Number:	42327-501001US

Filed as Micro Entity

Filing Fees for Utility under 35 USC 111(a)

Description	Fee Code	Quantity	Amount	Sub-Total in USD($)
Basic Filing:				
Pages:				
Claims:				
Miscellaneous-Filing:				
Petition:				
APPLICATION FOR PATENT TERM ADJUSTMENT	3455	1	210	210
Patent-Appeals-and-Interference:				
Post-Allowance-and-Post-Issuance:				

Description	Fee Code	Quantity	Amount	Sub-Total in USD($)
Extension-of-Time:				
Miscellaneous:				
		Total in USD ($)		**210**

Electronic Acknowledgement Receipt	
EFS ID:	42781004
Application Number:	10606729
International Application Number:	
Confirmation Number:	5831
Title of Invention:	INTERACTIVE DIGITAL MEDIA AND ADVERTISING PRESENTATION PLATFORM
First Named Inventor/Applicant Name:	Philip M. Donian
Customer Number:	64046
Filer:	Mark D. Hammond/Matthew Tupper
Filer Authorized By:	Mark D. Hammond
Attorney Docket Number:	42327-501001US
Receipt Date:	20-MAY-2021
Filing Date:	26-JUN-2003
Time Stamp:	20:41:26
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	yes
Payment Type	DA
Payment was successfully received in RAM	$210
RAM confirmation Number	E20215JK41470899
Deposit Account	500311
Authorized User	Matthew Tupper
The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows: 37 CFR 1.21 (Miscellaneous fees and charges)	

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Patent Term Adjustment Petition	042327-501001US_PTAPetition.pdf	22877294 c76b204f7b494a937aad20b5187489991ed6637f	no	63
Warnings:					
Information:					
2	Fee Worksheet (SB06)	fee-info.pdf	30427 6f91dc455aeffee818266641fce41f8d2d10f205c	no	2
Warnings:					
Information:					
		Total Files Size (in bytes):	22907721		

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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P.O. Box 1450
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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,729	06/26/2003	Philip M. Donian	42327-501001US	5831

64046 7590 07/21/2021

Mintz Levin/San Diego Office
One Financial Center
Boston, MA 02111

EXAMINER	
RETTA, YEHDEGA	

ART UNIT	PAPER NUMBER
3688	

NOTIFICATION DATE	DELIVERY MODE
07/21/2021	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPDocketingBOS@mintz.com
IPFileroombos@mintz.com
mintzdocketing@cpaglobal.com

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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In re Patent No. 10,986,403	:	
Issue Date: 20 Apr 2021	:	
Application No. 10/606,729	:	DECISION ON PETITION
Filing or 371(c) Date: 26 Jun 2003	:	
Attorney Docket No. 042327-501001US	:	

This is a response to Patentee's petition pursuant to 37 C.F.R. § 1.705(b) filed May 20, 2021, requesting that the Office adjust the patent term adjustment from 958 days to 1299 days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by 1299 days is **GRANTED**.

The Office acknowledges the receipt of the $210.00 fee set forth in 37 C.F.R. § 1.18(e). No additional fees are required. A review of the record indicates that this patent is not subject to a terminal disclaimer.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **1299 days.**

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3225.

/Paul Shanoski/
Paul Shanoski
Attorney Advisor
Office of Petitions

Encl: Adjusted PTA calculation
DRAFT Certificate of Correction

DRAFT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 10,986,403 B2

DATED : **Apr. 20, 2021** **DRAFT**

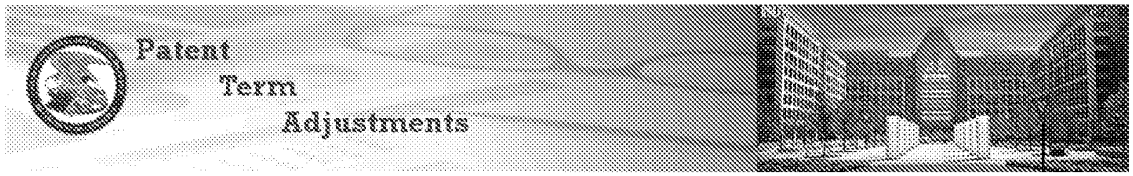
INVENTOR(S) : **Donian et al.**

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 958 days

Delete the phrase "by 958 days" and insert – by 1299 days --



PTA/PTE Information | Patent Term Adjustment | Patent Term Extension | Calculation Explanation

Application Number*: 10606729 Open Explanation of PTA Calculation Explanation of PTE Calculation

Print

PTA Calculations for Application: 10606729

Application Filing Date	06/26/2003	OverLapping Days Between (A and B) or (A and C)	830
Issue Date of Patent	04/20/2021	Non-Overlapping USPTO Delays:	2719
A Delays	2272	PTO Manual Adjustment	341
B Delays	1277	Applicant Delay (APPL)	1761
C Delays	0	Total PTA (days)	1299

* - Sorted Column

File Contents History

Action Number	Action Recorded Date	Action Due Date	Action Code	Action Description	Duration PTO	Duration APPL	Parent Action Number
245	07/20/2021		P028	Adjustment of PTA Calculation by PTO		669	0
244	07/20/2021		P028	Adjustment of PTA Calculation by PTO		268	0
243	07/20/2021		P028	Adjustment of PTA Calculation by PTO	1386		0
242	07/20/2021		P028	Adjustment of PTA Calculation by PTO		82	0
241	07/20/2021		P028	Adjustment of PTA Calculation by PTO		91	0
236.5	04/20/2021	06/26/2006	PTA36M	PTA 36 Months	1277		0.5
236	04/20/2021		PTAC	Patent Issue Date Used in PTA Calculation			0
235	03/26/2021		EFDC	Export to Final Data Capture			0
233	03/25/2021		D1935	Dispatch to FDC			0
234	03/24/2021		FIDC	Finished Initial Data Capture			0
231	03/23/2021		EML_NTR	Email Notification			0
229	03/23/2021		FLRCPT.C	Filing Receipt - Corrected			0
230	03/22/2021		PILS	Application Is Considered Ready for Issue			0
232	03/19/2021		REAS	Response to Reasons for Allowance			0
228	03/19/2021		N084	Issue Fee Payment Verified			0
227	03/19/2021		IFEE	Issue Fee Payment Received			0
226	03/18/2021		PST_CRD	Mail Post Card			0
224	03/10/2021		EML_NTF	Email Notification			0
223	03/10/2021		MN/=.	Mail Notice of Allowance			0
225	03/09/2021		EIDC	Export to Initial Data Capture			0
222	03/06/2021		OAR	Office Action Review			0
221	03/06/2021		OAR	Office Action Review			0
220	03/06/2021		IREV	Issue Revision Completed			0
219	03/06/2021		DVER	Document Verification			0
218	03/06/2021		N/=.	Notice of Allowance Data Verification Completed			0
217	03/06/2021		DOCK	Case Docketed to Examiner in GAU			0
216	02/26/2021		EX.R	Reasons for Allowance			0
215	02/26/2021		CNTA	Allowability Notice			0
212	02/17/2021		MICR	Applicant Has Filed a Verified Statement of Micro Entity Status in Compliance with 37 CFR 1.29			0
211	02/17/2021		FWDX	Date Forwarded to Examiner			0
210	02/16/2021		A...	Response after Non-Final Action			0
209	02/16/2021		XT/G	Request for Extension of Time - Granted			0
208	01/27/2021		EML_NTR	Email Notification			0
207	01/27/2021		MEXIN	Mail Examiner Interview Summary (PTOL - 413)			0
206	01/21/2021		EXAT	Interview Summary - Applicant Initiated - Telephonic			0
205	01/21/2021		EXIN	Interview Summary Record			0
204	12/30/2020		INCOR	Interview Request Correction			0
203	11/13/2020		ELC_RVW	Electronic Review			0
202	11/13/2020		M865E	Electronic request for Examiner Interview			0
201	11/13/2020		EML_NTF	Email Notification			0

200	11/13/2020		MCTNF	Mail Non-Final Rejection			0
199	11/10/2020		EML_NTR	Email Notification			0
197	11/10/2020		MEXIN	Mail Examiner Interview Summary (PTOL - 413)			0
198	11/09/2020		CTNF	Non-Final Rejection			0
195	11/05/2020		EXIN	Interview Summary Record			0
196	10/29/2020		EXAT	Interview Summary - Applicant Initiated - Telephonic			0
194	10/22/2020		M865E	Electronic request for Examiner Interview			0
193	10/22/2020		EML_NTR	Email Notification			0
192	10/22/2020		EML_NTR	Email Notification			0
191	10/21/2020		MPDTG	Mail Pet Dec Track 1 Grant			0
189	10/21/2020		T1GR	Track 1 Request Granted			0
188	10/21/2020		MP003	Mail-Record Petition Decision of Granted to Make Special			0
190	10/20/2020		OAR	Office Action Review			0
187	10/20/2020		P003	Record Petition Decision of Granted to Make Special			0
186	10/20/2020		PDTG	Pet Dec Track 1 Grant			0
183	10/15/2020		FWDX	Date Forwarded to Examiner			0
180	10/15/2020		ABN9	Disposal for a RCE / CPA / R129			0
185	10/13/2020		MICR	Applicant Has Filed a Verified Statement of Micro Entity Status in Compliance with 37 CFR 1.29			0
184	10/13/2020		MICR	Applicant Has Filed a Verified Statement of Micro Entity Status in Compliance with 37 CFR 1.29			0
182	10/13/2020		AMSB	Amendment Submitted/Entered with Filing of CPA/RCE			0
181	10/13/2020		RCEX	Request for Continued Examination (RCE)			0
179	10/13/2020		TK1R	Track 1 Request			0
178	10/13/2020		PET.	Petition Entered			0
177	10/13/2020		BRCE	Workflow - Request for RCE - Begin			0
176	08/12/2020		ELC_RVW	Electronic Review			0
175	08/12/2020		EML_NTF	Email Notification			0
174	08/12/2020		MAPDA	Mail PTAB Decision on Appeal - Affirmed			0
173	08/10/2020		APDA	PTAB Decision - Examiner Affirmed			0
168	12/28/2018		EML_NTR	Email Notification			0
167	12/28/2018		AP_DK_M	Docketing Notice Mailed to Appellant			0
166	12/26/2018		APAS	Assignment of Appeal Number			0
165	12/21/2018		APWD	Appeal Awaiting PTAB Docketing			0
164	12/19/2018		ARBP	Appeal ready for PAC review			0
169	12/18/2018		IRFND	Request for Refund			0
163	12/18/2018		APRB	Reply Brief Filed			0
162	10/18/2018		ELC_RVW	Electronic Review			0
161	10/18/2018		EML_NTF	Email Notification			0
159	10/18/2018		MAPEA	Mail Examiner's Answer			0
160	10/17/2018		PACC	Exam. Ans. Review Complete			0
158	10/10/2018		APEA	Examiner's Answer to Appeal Brief			0
157	08/07/2018		APBR	Appeal Brief Review Complete			0
156	08/07/2018		FWDX	Date Forwarded to Examiner			0
155	07/19/2018		T1OFF	track 1 OFF			0
154	07/19/2018		AP.B	Appeal Brief Filed			0
153	07/19/2018		XT/G	Request for Extension of Time - Granted			0
104	07/19/2018	10/02/2014	AP.B	Appeal Brief Filed		1 366	92
152	04/02/2018		EML_NTR	Email Notification			0
151	04/02/2018		MAPCP	Mail Appeals conf. Proceed to PTAB			0
150	03/28/2018		OAR	Office Action Review			0
149	03/27/2018		APCP	Pre-Appeal Conference Decision - Proceed to PTAB			0
146	01/31/2018		MNRAB	Mail Notice of Rescinded Abandonment			0
145	01/29/2018		NRAB	Notice of Rescinded Abandonment in TCs			0
144	12/11/2017		EML_NTR	Email Notification			0
143	12/11/2017		MABN2	Mail Abandonment for Failure to Respond to Office Action			0
142	12/06/2017		ABN2	Aband. for Failure to Respond to O. A.			0
148	04/04/2017		AP.C	Request for Pre-Appeal Conference Filed			0
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139	04/04/2017		XT/G	Request for Extension of Time - Granted			0
138	04/04/2017		MICR	Applicant Has Filed a Verified Statement of Micro Entity Status in Compliance with 37 CFR 1.29			0
137	10/12/2016		ELC_RVW	Electronic Review			0
136	10/12/2016		EML_NTF	Email Notification			0
135	10/12/2016		MCTFR	Mail Final Rejection (PTOL - 326)			0
134	10/05/2016		OAR	Office Action Review			0
133	10/05/2016		CTFR	Final Rejection			0
132	08/03/2016		FWDX	Date Forwarded to Examiner			0
131	08/01/2016		A...	Response after Non-Final Action			0
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127	02/01/2016		ELC_RVW	Electronic Review			0

126	02/01/2016		EML_NTF	Email Notification			0
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123	01/22/2016		CTNF	Non-Final Rejection			0
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120	11/19/2015		FWDX	Date Forwarded to Examiner			0
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118	08/31/2015		PACC	Exam. Ans. Review Complete			0
117	08/28/2015		ELC_RVW	Electronic Review			0
116	08/28/2015		EML_NTF	Email Notification			0
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113	08/18/2015		APEA	Examiner's Answer to Appeal Brief			0
112	06/19/2015		FWDX	Date Forwarded to Examiner			0
109	04/28/2015		APBR	Appeal Brief Review Complete			0
111	04/23/2015		T1OFF	track 1 OFF			0
110	04/23/2015		AP.B	Appeal Brief Filed			0
108	04/11/2015		EML_NTR	Email Notification			0
107	04/09/2015		APBD	Notice -- Defective Appeal Brief			0
106	04/07/2015		FWDX	Date Forwarded to Examiner			0
103	03/18/2015		APBR	Appeal Brief Review Complete			0
102	03/11/2015		EML_NTR	Email Notification			0
101	03/11/2015		MCTAV	Mail Advisory Action (PTOL - 303)			0
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99	03/05/2015		CTAV	Advisory Action (PTOL-303)			0
98	02/23/2015		FWDX	Date Forwarded to Examiner			0
104.3	02/13/2015		APBI	Defective / Incomplete Appeal Brief Filed			0
97	02/13/2015		AP/A	Amendment/Argument after Notice of Appeal			0
105	08/14/2014		T1OFF	track 1 OFF			0
96	08/14/2014		MAPCP	Mail Appeals conf. Proceed to PTAB			0
95	08/13/2014		OAR	Office Action Review			0
94	08/12/2014		APCP	Pre-Appeal Conference Decision - Proceed to PTAB			0
93	07/02/2014		AP.C	Request for Pre-Appeal Conference Filed			0
92	07/02/2014		N/AP	Notice of Appeal Filed			0
91	05/01/2014		ELC_RVW	Electronic Review			0
90	05/01/2014		EML_NTF	Email Notification			0
89	05/01/2014		MCTFR	Mail Final Rejection (PTOL - 326)			0
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87	04/28/2014		CTFR	Final Rejection			0
86	02/21/2014		FWDX	Date Forwarded to Examiner			0
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82	12/30/2013		MEXAT	Mail Interview Summary - Applicant Initiated - Telephonic			0
81	12/24/2013		OAR	Office Action Review			0
80	12/24/2013		OAR	Office Action Review			0
79	12/24/2013		OAR	Office Action Review			0
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77	12/23/2013		EXAT	Interview Summary - Applicant Initiated - Telephonic			0
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75	08/20/2013		EML_NTF	Email Notification			0
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72	08/13/2013		CTNF	Non-Final Rejection			0
71	03/29/2013		EML_NTR	Email Notification			0
70	03/26/2013		MM327	Mail Miscellaneous Communication to Applicant			0
69	03/22/2013		M327	Miscellaneous Communication to Applicant - No Action Count			0
68	03/19/2013		LET.	Miscellaneous Incoming Letter			0
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64	07/21/2012		M327	Miscellaneous Communication to Applicant - No Action Count			0
63	07/17/2012		LET.	Miscellaneous Incoming Letter			0
62	01/18/2012		LET.	Miscellaneous Incoming Letter			0
61	03/18/2011		FWDX	Date Forwarded to Examiner			0
58	03/18/2011		ABN9	Disposal for a RCE / CPA / R129			0
60	03/14/2011		AMSB	Amendment Submitted/Entered with Filing of CPA/RCE			0
59	03/14/2011	01/14/2011	RCEX	Request for Continued Examination (RCE)			51
57	03/14/2011		XT/G	Request for Extension of Time - Granted			0
56	03/14/2011		BRCE	Workflow - Request for RCE - Begin			0
55	02/09/2011		PA..	Change in Power of Attorney (May Include Associate POA)			0
54	02/04/2011		C.AD	Correspondence Address Change			0
53	10/14/2010		ELC_RVW	Electronic Review			0

52	10/14/2010		EML_NTF	Email Notification			0
51	10/14/2010		MCTFR	Mail Final Rejection (PTOL - 326)			0
50	10/08/2010		CTFR	Final Rejection			0
49	08/11/2010		FWDX	Date Forwarded to Examiner			0
48	08/02/2010	05/03/2010	A...	Response after Non-Final Action		91	43
47	08/02/2010		XT/G	Request for Extension of Time - Granted			0
46	05/13/2010		EML_NTR	Email Notification			0
45	05/13/2010		PA..	Change in Power of Attorney (May Include Associate POA)			0
44	05/11/2010		C.AD	Correspondence Address Change			0
43	02/01/2010		MCTNF	Mail Non-Final Rejection			0
42	01/29/2010		CTNF	Non-Final Rejection			0
41	11/19/2009		FWDX	Date Forwarded to Examiner			0
39	11/19/2009		FWDX	Date Forwarded to Examiner			0
37	11/19/2009		ABN9	Disposal for a RCE / CPA / R129			0
40	11/14/2009		AMPR	RCE- AF Processed			0
38	11/14/2009	08/20/2009	RCEX	Request for Continued Examination (RCE)		86	34
36	11/14/2009		XT/G	Request for Extension of Time - Granted			0
35	11/14/2009		BRCE	Workflow - Request for RCE - Begin			0
34	05/20/2009		MCTFR	Mail Final Rejection (PTOL - 326)			0
33	05/19/2009		CTFR	Final Rejection			0
32	03/10/2009		FWDX	Date Forwarded to Examiner			0
31	02/27/2009	01/05/2009	A...	Response after Non-Final Action		53	29
30	02/27/2009		XT/G	Request for Extension of Time - Granted			0
29	10/03/2008	08/26/2004	MCTNF	Mail Non-Final Rejection	1439		0.5
28	09/30/2008		CTNF	Non-Final Rejection			0
22	07/22/2008		DOCK	Case Docketed to Examiner in GAU			0
21	06/17/2008		TI1050	Transfer Inquiry to GAU			0
20	10/17/2007		W525	Withdraw Flagged for 5/25			0
19	10/15/2007		F525	Flagged for 5/25			0
18	06/28/2007		DOCK	Case Docketed to Examiner in GAU			0
17	03/21/2006		DOCK	Case Docketed to Examiner in GAU			0
16	03/04/2005		TSSCOMP	IFW TSS Processing by Tech Center Complete			0
15	03/04/2005		DOCK	Case Docketed to Examiner in GAU			0
14	08/02/2004		RCAP	Reference capture on IDS			0
24	07/19/2004		IDSC	Information Disclosure Statement considered			0
13.7	07/19/2004		M844	Information Disclosure Statement (IDS) Filed			0
13	07/19/2004		WIDS	Information Disclosure Statement (IDS) Filed			0
12	06/29/2004		C.ADB	Correspondence Address Change			0
23	09/29/2003		IDSC	Information Disclosure Statement considered			0
11	09/29/2003		RCAP	Reference capture on IDS			0
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9	09/22/2003		WROIPE	Application Return from OIPE			0
8	09/22/2003		COMP	Application Is Now Complete			0
7	09/22/2003		ROIPE	Application Return TO OIPE			0
5	09/18/2003		COMP	Application Is Now Complete			0
6	09/17/2003		OIPE	Application Dispatched from OIPE			0
4	09/05/2003		CLSS	CASE CLASSIFIED BY OIPE			0
3	09/05/2003		L194	Cleared by OIPE CSR			0
2	08/15/2003		SCAN	IFW Scan & PACR Auto Security Review			0
1	06/26/2003		IEXX	Initial Exam Team nn			0
0.5	06/26/2003		EFILE	Filing date			0

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From: PAIR_eOfficeAction@uspto.gov
Cc: PAIR_eOfficeAction@uspto.gov
Subject: Private PAIR Correspondence Notification for Customer Number 64046

Jul 22, 2021 03:49:29 AM

Dear PAIR Customer:

Mintz Levin/San Diego Office
One Financial Center
Boston, MA 02111
UNITED STATES

The following USPTO patent application(s) associated with your Customer Number, 64046 , have new outgoing correspondence. This correspondence is now available for viewing in Private PAIR.

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Application	Document	Mailroom Date	Attorney Docket No.
10606729	PET.DEC.COCI	07/21/2021	42327-501001US
	OA.APPENDIX	07/21/2021	42327-501001US

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Thank you for prompt attention to this notice,

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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,729	06/26/2003	Philip M. Donian	42327-501001US	5831

64046 7590 07/28/2021

Mintz Levin/San Diego Office
One Financial Center
Boston, MA 02111

EXAMINER	
RETTA, YEHDEGA	

ART UNIT	PAPER NUMBER
3688	

NOTIFICATION DATE	DELIVERY MODE
07/28/2021	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPDocketingBOS@mintz.com
IPFileroombos@mintz.com
mintzdocketing@cpaglobal.com

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 10,986,403
Issue Date: 20 Apr 2021
Application No. 10/606,729
Filing or 371(c) Date: 26 Jun 2003
Attorney Docket No. 042327-501001US

DECISION ON PETITION

This is a corrected decision in response to Patentee's petition pursuant to 37 C.F.R. § 1.705(b) filed May 20, 2021, requesting that the Office adjust the patent term adjustment from 958 days to 1822 days.

The Office acknowledges the submission of the $210.00 fee set forth in 37 C.F.R. § 1.18(e). No additional fees are required. A review of the electronic file indicates that this patent is not subject to a terminal disclaimer.

This redetermination of patent term adjustment is NOT the Director's decision on the applicant's request for reconsideration for purposes of seeking judicial review under 35 U.S.C. § 154(b)(4).

Relevant Procedural History

On April 20, 2021, the Office determined that applicant was entitled to 958 days of PTA.

On May 20, 2021, Patentee filed a request for redetermination of patent term adjustment requesting a PTA of 1822 days, pursuant to 37 C.F.R. § 1.705(b).

On July 21, 2021, the USPTO mailed a decision in response to Patentee's request for redetermination of patent term adjustment, which indicated applicant was entitled to 1299 days of PTA.

Decision

Upon review, the USPTO finds that Patentee is entitled to 1881 days of PTA.

One period of adjustment and one period of reduction are in dispute.

"A" Delay

One period of adjustment under 35 U.S.C. § 154(b)(1)(A) is in dispute.

The patentee filed a notice of appeal on April 4, 2017, along with a Pre-Appeal Brief Request for Review. The USPTO mailed a notice of abandonment on December 11, 2017. The USPTO mailed a *Sua Sponte* Exercise of Supervisory Review on January 29, 2018, which vacated the holding of abandonment. The USPTO mailed a Notice of Panel Decision from Pre-Appeal Brief Review on April 2, 2018, which indicated that a pre-appeal brief conference was held and the application remained under appeal. The Patentee filed an Appeal Brief on July 19, 2018.

On the fourth and fifth pages of this petition, Patentee argues an adjustment of 241 days is warranted for the Office's failure to issue a Notice of Panel Decision from Pre-Appeal Brief Review within four months of the filing of the Pre-Appeal Brief Request for Review, and this delay begins on August 5, 2017 and ends on April 2, 2018.

Patentee cites to no portion of the C.F.R. to support this argument, and instead cites to 35 U.S.C. § 154(b)(1)(A)(ii) which states, *in pertinent part*:

> Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to ... respond to a reply under section 132, or to an appeal taken under section 134, within 4 months after the date on which the reply was filed or the **appeal was taken** (emphasis added)... the term of the patent shall be extended 1 day for each day after the end of the period specified in clause (i), (ii), (iii), or (iv), as the case may be, until the action described in such clause is taken.

Patentee's argument has been given careful consideration, and has been deemed to be unpersuasive. The USPTO finds that the "appeal was taken" with Patentee's filing of the appeal brief on July 19, 2018, and not the filing of a Pre-Appeal Brief Request for Review on April 4, 2017. As set forth in the response to Comment 38 in *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final rule*, 65 Fed. Reg. 56366, 56386 (Sept 18, 2000):

> [t]he Office is interpreting the phrase "the date on which" an "appeal was taken" in 35 U.S.C. 154(b)(1)(A)(ii) as the date an appeal brief in compliance with § 1.192 was filed. The Office originally interpreted the phrase "the date on which" an "appeal was taken" in 35 U.S.C. 154(b)(1)(A)(ii) to mean the date a notice of appeal to the Board of Patent Appeals and Interferences under 35 U.S.C. 134 and § 1.191 was filed. See Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term, 65 FR at 17217, 1233 Off. Gaz. Pat. Office at 111. The Office has reconsidered this interpretation of the phrase ''the date on which'' an "appeal was taken" in 35 U.S.C. 154(b)(1)(A)(ii).

Further discussion can be found on pages 56386-56387 of *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final rule*.

See also 37 C.F.R. § 1.703(a)(4), which begins the four-month clock with the filing of "an appeal brief in compliance with §41.37 of this title," and not the filing of a Pre-Appeal Brief Request for Review. *See also* the portion of M.P.E.P. § 2731 which discusses 37 C.F.R. § 1.703(a)(4).

It follows that the USPTO finds the issuance of a Notice of Panel Decision from Pre-Appeal Brief Review on April 2, 2018 does not warrant an adjustment of 241 days.

"B" Delay

The Patentee and Office agree there are 1277 days of "B" delay.

"C" Delay

The Patentee and Office agree there are zero days of "C" delay.

Overlap

The Patentee and Office agree there are 830 overlapping days of Office delay.

In *Wyeth v. Kappos*, 591 F.3d 1364 (Fed. Cir. 2010), the Court of Appeals for the Federal Circuit determined that overlap occurs when the calendar days overlap between the "A" and "B" delays. Under this interpretation, the Office finds that the overlapping period of "A" delay and "B" delay is 830 days.

The Office finds that the periods of "B" delay are:

(1) beginning on June 27, 2006 (date that is the day after the three year anniversary of the filing date of the application) and ending on November 13, 2009 (date that is the day before the first RCE was filed) for a period 1236 days; and

(2) beginning on March 11, 2021 (date that is the day after the notice of allowance was mailed) and ending on April 20, 2021 (date of patent issuance) for a period of 41 days.

The Office finds that the overlapping period of "A" delay is a 1499-day adjustment pursuant to 37 C.F.R. § 1.703(a)(1) which began on August 27, 2004 (the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a)) and ended on October 3, 2008 (the date on which a non-final Office action was mailed) constitutes 830 days. The 830-day portion of the 1499-day period that begins on June 27, 2006 and ends on October 3, 2008 overlaps with the period of "B" delay.

The total number of overlapping days of Office delay is 830 days.

Reduction under 35 U.S.C. § 154(b)(2)(C)(iii) & 37 CFR 1.704 [Applicant Delay]

As a preliminary matter, the USPTO agrees that several additional reductions are warranted:

- A 203-day period pursuant to 37 C.F.R. § 1.704(c)(11) from October 3, 2014 until April 23, 2015, because Patentee filed a Notice of Appeal on July 2, 2014 and Patentee did not file an Appeal Brief on April 23, 2015. A reduction of 203 days has been entered.

- A 91-day period pursuant to 37 C.F.R. § 1.704(b) from May 2, 2016 until August 1, 2016 because the Office mailed a non-final Office action on February 1, 2016, however Patentee did not file its amendment to the claims and remarks until August 1, 2016. A reduction of 91 days has been entered.

- An 82-day period pursuant to 37 C.F.R. § 1.704(b) from January 13, 2017 until April 4, 2017 because the Office mailed a non-final Office action on October 12, 2016, however Patentee did not file its notice of appeal until April 4, 2017. A reduction of 82 days has been entered.

There is one period of reduction in dispute.

The Office entered a reduction of 1386 days associated with the filing of the aforementioned Appeal Brief on July 19, 2018, and the Office agrees this reduction is not warranted. With this petition, Patentee argues a reduction of 387 days is warranted, since Patentee filed a Notice of Appeal on April 4, 2017 and an Appeal Brief was not filed until July 26, 2018, which is three months and 387 days after the filing of the Notice of Appeal. *See* 37 C.F.R. § 1.704(c)(11).

However, a portion of the period beginning on July 5, 2017 and ending on July 26, 2018 spans the period during which this application was improperly found to be abandoned. As such, the Office is interpreting the 37 C.F.R. § 1.704(c)(11) period to begin on the day after the three-month anniversary of the date on which the *Sua Sponte* Exercise of Supervisory Review of January 29, 2018 was mailed (Tuesday, May 1, 2018, since April 29, 2018 fell on a Sunday). The period beginning on May 1, 2018 and ending on July 26, 2018 totals 87 days.

Overall PTA Calculation

Formula:

"A" delay + "B" delay + "C" delay - overlap - applicant delay = X.

USPTO's Calculation:

2272 (1499 + 768 + 5) + 1277 (6509 – 4135 – 1097) + 0 – 830 – 838 (53 + 86 + 91 + 59 + 86 + 203 + 91 + 82 + 87) = 1881

Patentee's Calculation:

2513 (1499 + 768 + 5+ 241) + 1277 (6509 – 4135 – 1097) + 0 – 830 – 1138 (53 + 86 + 91 + 59 + 86 + 203 + 91 + 82 + 387) = 1822

Conclusion

Patentee is entitled to PTA of 1881 days. Using the formula "A" delay + "B" delay + "C" delay - overlap - applicant delay = X, the amount of PTA is calculated as following: 2272 + 1277 + 0 – 830 – 838 = 1881 days.

If Patentee seeks a review of this decision, Patentee must request reconsideration within **TWO (2) months** from the mail date of this decision. Extensions of time pursuant to 37 C.F.R. § 1.136(a) are **not** available. If applicant does not reply, then the Office will *sua sponte* issue a certificate of correction in the amount of 1881 days.

Telephone inquiries regarding this decision may be directed to Attorney Advisor Paul Shanoski at (571) 272-3225.[1]

/Paul Shanoski/
Paul Shanoski
Attorney Advisor
Office of Petitions

Encl: Adjusted PTA calculation
DRAFT Certificate of Correction

[1] Patentee will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. *See* 37 C.F.R. § 1.2. As such, Patentee is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Patentee.

DRAFT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 10,986,403 B2

DATED : **Apr. 20, 2021** **DRAFT**

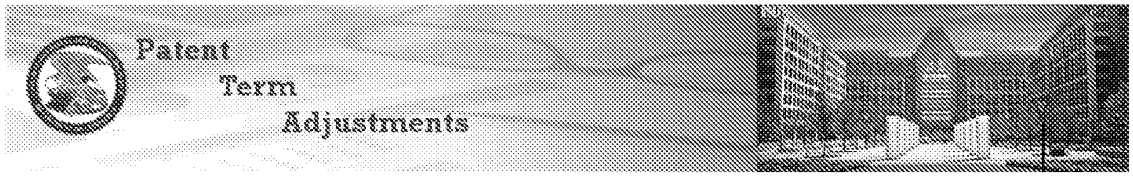
INVENTOR(S) : **Donian et al.**

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 1299 days

Delete the phrase "by 1299 days" and insert – by 1881 days --



PTA/PTE Information | Patent Term Adjustment | Patent Term Extension | Calculation Explanation

Application Number*: 10606729 Open Explanation of PTA Calculation Explanation of PTE Calculation

Print

PTA Calculations for Application: 10606729

Application Filing Date	06/26/2003	OverLapping Days Between (A and B) or (A and C)	830
Issue Date of Patent	04/20/2021	Non-Overlapping USPTO Delays:	2719
A Delays	2272	PTO Manual Adjustment	923
B Delays	1277	Applicant Delay (APPL)	1761
C Delays	0	Total PTA (days)	1881

* - Sorted Column

File Contents History

Action Number	Action Recorded Date	Action Due Date	Action Code	Action Description	Duration PTO	Duration APPL	Parent Action Number
255	07/27/2021		P028	Adjustment of PTA Calculation by PTO	663		0
254	07/27/2021		P028	Adjustment of PTA Calculation by PTO		87	0
248	07/20/2021		P026	Record a Petition Decision of Granted for Patent Term Adjustment after Issue			0
245	07/20/2021		P028	Adjustment of PTA Calculation by PTO		669	0
244	07/20/2021		P028	Adjustment of PTA Calculation by PTO		203	0
243	07/20/2021		P028	Adjustment of PTA Calculation by PTO	1386		0
242	07/20/2021		P028	Adjustment of PTA Calculation by PTO		92	0
241	07/20/2021		P028	Adjustment of PTA Calculation by PTO		91	0
236.5	04/20/2021	06/26/2006	PTA36M	PTA 36 Months	1277		0.5
236	04/20/2021		PTAC	Patent Issue Date Used in PTA Calculation			0
235	03/26/2021		EFDC	Export to Final Data Capture			0
233	03/25/2021		D1935	Dispatch to FDC			0
234	03/24/2021		FIDC	Finished Initial Data Capture			0
231	03/23/2021		EML_NTR	Email Notification			0
229	03/23/2021		FLRCPT.C	Filing Receipt - Corrected			0
230	03/22/2021		PILS	Application Is Considered Ready for Issue			0
232	03/19/2021		REAS	Response to Reasons for Allowance			0
228	03/19/2021		N084	Issue Fee Payment Verified			0
227	03/19/2021		IFEE	Issue Fee Payment Received			0
226	03/18/2021		PST_CRD	Mail Post Card			0
224	03/10/2021		EML_NTF	Email Notification			0
223	03/10/2021		MN/=.	Mail Notice of Allowance			0
225	03/09/2021		EIDC	Export to Initial Data Capture			0
222	03/06/2021		OAR	Office Action Review			0
221	03/06/2021		OAR	Office Action Review			0
220	03/06/2021		IREV	Issue Revision Completed			0
219	03/06/2021		DVER	Document Verification			0
218	03/06/2021		N/=.	Notice of Allowance Data Verification Completed			0
217	03/06/2021		DOCK	Case Docketed to Examiner in GAU			0
216	02/26/2021		EX.R	Reasons for Allowance			0
215	02/26/2021		CNTA	Allowability Notice			0
212	02/17/2021		MICR	Applicant Has Filed a Verified Statement of Micro Entity Status in Compliance with 37 CFR 1.29			0
211	02/17/2021		FWDX	Date Forwarded to Examiner			0
210	02/16/2021		A...	Response after Non-Final Action			0
209	02/16/2021		XT/G	Request for Extension of Time - Granted			0
208	01/27/2021		EML_NTR	Email Notification			0
207	01/27/2021		MEXIN	Mail Examiner Interview Summary (PTOL - 413)			0
206	01/21/2021		EXAT	Interview Summary - Applicant Initiated - Telephonic			0
205	01/21/2021		EXIN	Interview Summary Record			0
204	12/30/2020		INCOR	Interview Request Correction			0

203	11/13/2020		ELC_RVW	Electronic Review			0
202	11/13/2020		M865E	Electronic request for Examiner Interview			0
201	11/13/2020		EML_NTF	Email Notification			0
200	11/13/2020		MCTNF	Mail Non-Final Rejection			0
199	11/10/2020		EML_NTR	Email Notification			0
197	11/10/2020		MEXIN	Mail Examiner Interview Summary (PTOL - 413)			0
198	11/09/2020		CTNF	Non-Final Rejection			0
195	11/05/2020		EXIN	Interview Summary Record			0
196	10/29/2020		EXAT	Interview Summary - Applicant Initiated - Telephonic			0
194	10/22/2020		M865E	Electronic request for Examiner Interview			0
193	10/22/2020		EML_NTR	Email Notification			0
192	10/22/2020		EML_NTR	Email Notification			0
191	10/21/2020		MPDTG	Mail Pet Dec Track 1 Grant			0
189	10/21/2020		T1GR	Track 1 Request Granted			0
188	10/21/2020		MP003	Mail-Record Petition Decision of Granted to Make Special			0
190	10/20/2020		OAR	Office Action Review			0
187	10/20/2020		P003	Record Petition Decision of Granted to Make Special			0
186	10/20/2020		PDTG	Pet Dec Track 1 Grant			0
183	10/15/2020		FWDX	Date Forwarded to Examiner			0
180	10/15/2020		ABN9	Disposal for a RCE / CPA / R129			0
185	10/13/2020		MICR	Applicant Has Filed a Verified Statement of Micro Entity Status in Compliance with 37 CFR 1.29			0
184	10/13/2020		MICR	Applicant Has Filed a Verified Statement of Micro Entity Status in Compliance with 37 CFR 1.29			0
182	10/13/2020		AMSB	Amendment Submitted/Entered with Filing of CPA/RCE			0
181	10/13/2020		RCEX	Request for Continued Examination (RCE)			0
179	10/13/2020		TK1R	Track 1 Request			0
178	10/13/2020		PET.	Petition Entered			0
177	10/13/2020		BRCE	Workflow - Request for RCE - Begin			0
176	08/12/2020		ELC_RVW	Electronic Review			0
175	08/12/2020		EML_NTF	Email Notification			0
174	08/12/2020		MAPDA	Mail PTAB Decision on Appeal - Affirmed			0
173	08/10/2020		APDA	PTAB Decision - Examiner Affirmed			0
168	12/28/2018		EML_NTR	Email Notification			0
167	12/28/2018		AP_DK_M	Docketing Notice Mailed to Appellant			0
166	12/26/2018		APAS	Assignment of Appeal Number			0
165	12/21/2018		APWD	Appeal Awaiting PTAB Docketing			0
164	12/19/2018		ARBP	Appeal ready for PAC review			0
169	12/18/2018		IRFND	Request for Refund			0
163	12/18/2018		APRB	Reply Brief Filed			0
162	10/18/2018		ELC_RVW	Electronic Review			0
161	10/18/2018		EML_NTF	Email Notification			0
159	10/18/2018		MAPEA	Mail Examiner's Answer			0
160	10/17/2018		PACC	Exam. Ans. Review Complete			0
158	10/10/2018		APEA	Examiner's Answer to Appeal Brief			0
157	08/07/2018		APBR	Appeal Brief Review Complete			0
156	08/07/2018		FWDX	Date Forwarded to Examiner			0
155	07/19/2018		T1OFF	track 1 OFF			0
154	07/19/2018		AP.B	Appeal Brief Filed			0
153	07/19/2018		XT/G	Request for Extension of Time - Granted			0
104	07/19/2018	10/02/2014	AP.B	Appeal Brief Filed		1386	92
152	04/02/2018		EML_NTR	Email Notification			0
151	04/02/2018		MAPCP	Mail Appeals conf. Proceed to PTAB			0
150	03/28/2018		OAR	Office Action Review			0
149	03/27/2018		APCP	Pre-Appeal Conference Decision - Proceed to PTAB			0
146	01/31/2018		MNRAB	Mail Notice of Rescinded Abandonment			0
145	01/29/2018		NRAB	Notice of Rescinded Abandonment in TCs			0
144	12/11/2017		EML_NTR	Email Notification			0
143	12/11/2017		MABN2	Mail Abandonment for Failure to Respond to Office Action			0
142	12/06/2017		ABN2	Aband. for Failure to Respond to O. A.			0
148	04/04/2017		AP.C	Request for Pre-Appeal Conference Filed			0
140	04/04/2017		N/AP	Notice of Appeal Filed			0
139	04/04/2017		XT/G	Request for Extension of Time - Granted			0
138	04/04/2017		MICR	Applicant Has Filed a Verified Statement of Micro Entity Status in Compliance with 37 CFR 1.29			0
137	10/12/2016		ELC_RVW	Electronic Review			0
136	10/12/2016		EML_NTF	Email Notification			0
135	10/12/2016		MCTFR	Mail Final Rejection (PTOL - 326)			0
134	10/05/2016		OAR	Office Action Review			0
133	10/05/2016		CTFR	Final Rejection			0
132	08/03/2016		FWDX	Date Forwarded to Examiner			0
131	08/01/2016		A...	Response after Non-Final Action			0
130	08/01/2016		XT/G	Request for Extension of Time - Granted			0

128	08/01/2016		MICR	Applicant Has Filed a Verified Statement of Micro Entity Status in Compliance with 37 CFR 1.29			0
127	02/01/2016		ELC_RVW	Electronic Review			0
126	02/01/2016		EML_NTF	Email Notification			0
125	02/01/2016		MCTNF	Mail Non-Final Rejection			0
124	01/24/2016		OAR	Office Action Review			0
123	01/22/2016		CTNF	Non-Final Rejection			0
122	01/22/2016		SDSPL	Subtract Disposal Count			0
121	01/22/2016		NSDSP050	Subtract 0.50 Disposal Count			0
120	11/19/2015		FWDX	Date Forwarded to Examiner			0
119	10/28/2015		AABR	Amendment After Brief			0
118	08/31/2015		PACC	Exam. Ans. Review Complete			0
117	08/28/2015		ELC_RVW	Electronic Review			0
116	08/28/2015		EML_NTF	Email Notification			0
115	08/28/2015	08/23/2015	MAPEA	Mail Examiner's Answer			110
114	08/24/2015		OAR	Office Action Review			0
113	08/18/2015		APEA	Examiner's Answer to Appeal Brief			0
112	06/19/2015		FWDX	Date Forwarded to Examiner			0
109	04/28/2015		APBR	Appeal Brief Review Complete			0
111	04/23/2015		T1OFF	track 1 OFF			0
110	04/23/2015		AP.B	Appeal Brief Filed			0
108	04/11/2015		EML_NTR	Email Notification			0
107	04/09/2015		APBD	Notice -- Defective Appeal Brief			0
106	04/07/2015		FWDX	Date Forwarded to Examiner			0
103	03/18/2015		APBR	Appeal Brief Review Complete			0
102	03/11/2015		EML_NTR	Email Notification			0
101	03/11/2015		MCTAV	Mail Advisory Action (PTOL - 303)			0
100	03/05/2015		OAR	Office Action Review			0
99	03/05/2015		CTAV	Advisory Action (PTOL-303)			0
98	02/23/2015		FWDX	Date Forwarded to Examiner			0
104.3	02/13/2015		APBI	Defective / Incomplete Appeal Brief Filed			0
97	02/13/2015		AP/A	Amendment/Argument after Notice of Appeal			0
105	08/14/2014		T1OFF	track 1 OFF			0
96	08/14/2014		MAPCP	Mail Appeals conf. Proceed to PTAB			0
95	08/13/2014		OAR	Office Action Review			0
94	08/12/2014		APCP	Pre-Appeal Conference Decision - Proceed to PTAB			0
93	07/02/2014		AP.C	Request for Pre-Appeal Conference Filed			0
92	07/02/2014		N/AP	Notice of Appeal Filed			0
91	05/01/2014		ELC_RVW	Electronic Review			0
90	05/01/2014		EML_NTF	Email Notification			0
89	05/01/2014		MCTFR	Mail Final Rejection (PTOL - 326)			0
88	04/28/2014		OAR	Office Action Review			0
87	04/28/2014		CTFR	Final Rejection			0
86	02/21/2014		FWDX	Date Forwarded to Examiner			0
85	02/14/2014	11/20/2013	A...	Response after Non-Final Action			74
84	02/14/2014		XT/G	Request for Extension of Time - Granted			0
83	02/14/2014		MICR	Applicant Has Filed a Verified Statement of Micro Entity Status in Compliance with 37 CFR 1.29			0
82	12/30/2013		MEXAT	Mail Interview Summary - Applicant Initiated - Telephonic			0
81	12/24/2013		OAR	Office Action Review			0
80	12/24/2013		OAR	Office Action Review			0
79	12/24/2013		OAR	Office Action Review			0
78	12/23/2013		EXIA	Interview Summary- Applicant Initiated			0
77	12/23/2013		EXAT	Interview Summary - Applicant Initiated - Telephonic			0
76	08/20/2013		ELC_RVW	Electronic Review			0
75	08/20/2013		EML_NTF	Email Notification			0
74	08/20/2013	07/14/2011	MCTNF	Mail Non-Final Rejection			59
73	08/13/2013		OAR	Office Action Review			0
72	08/13/2013		CTNF	Non-Final Rejection			0
71	03/29/2013		EML_NTR	Email Notification			0
70	03/26/2013		MM327	Mail Miscellaneous Communication to Applicant			0
69	03/22/2013		M327	Miscellaneous Communication to Applicant - No Action Count			0
68	03/19/2013		LET.	Miscellaneous Incoming Letter			0
65	07/23/2012		MM327	Mail Miscellaneous Communication to Applicant			0
64	07/21/2012		M327	Miscellaneous Communication to Applicant - No Action Count			0
63	07/17/2012		LET.	Miscellaneous Incoming Letter			0
62	01/18/2012		LET.	Miscellaneous Incoming Letter			0
61	03/18/2011		FWDX	Date Forwarded to Examiner			0
58	03/18/2011		ABN9	Disposal for a RCE / CPA / R129			0
60	03/14/2011		AMSB	Amendment Submitted/Entered with Filing of CPA/RCE			0
59	03/14/2011	01/14/2011	RCEX	Request for Continued Examination (RCE)			51
57	03/14/2011		XT/G	Request for Extension of Time - Granted			0
56	03/14/2011		BRCE	Workflow - Request for RCE - Begin			0

55	02/09/2011		PA..	Change in Power of Attorney (May Include Associate POA)			0
54	02/04/2011		C.AD	Correspondence Address Change			0
53	10/14/2010		ELC_RVW	Electronic Review			0
52	10/14/2010		EML_NTF	Email Notification			0
51	10/14/2010		MCTFR	Mail Final Rejection (PTOL - 326)			0
50	10/08/2010		CTFR	Final Rejection			0
49	08/11/2010		FWDX	Date Forwarded to Examiner			0
48	08/02/2010	05/03/2010	A...	Response after Non-Final Action		91	43
47	08/02/2010		XT/G	Request for Extension of Time - Granted			0
46	05/13/2010		EML_NTR	Email Notification			0
45	05/13/2010		PA..	Change in Power of Attorney (May Include Associate POA)			0
44	05/11/2010		C.AD	Correspondence Address Change			0
43	02/01/2010		MCTNF	Mail Non-Final Rejection			0
42	01/29/2010		CTNF	Non-Final Rejection			0
41	11/19/2009		FWDX	Date Forwarded to Examiner			0
39	11/19/2009		FWDX	Date Forwarded to Examiner			0
37	11/19/2009		ABN9	Disposal for a RCE / CPA / R129			0
40	11/14/2009		AMPR	RCE- AF Processed			0
38	11/14/2009	08/20/2009	RCEX	Request for Continued Examination (RCE)		88	34
36	11/14/2009		XT/G	Request for Extension of Time - Granted			0
35	11/14/2009		BRCE	Workflow - Request for RCE - Begin			0
34	05/20/2009		MCTFR	Mail Final Rejection (PTOL - 326)			0
33	05/19/2009		CTFR	Final Rejection			0
32	03/10/2009		FWDX	Date Forwarded to Examiner			0
31	02/27/2009	01/05/2009	A...	Response after Non-Final Action		53	29
30	02/27/2009		XT/G	Request for Extension of Time - Granted			0
29	10/03/2008	08/26/2004	MCTNF	Mail Non-Final Rejection	1489		0.5
28	09/30/2008		CTNF	Non-Final Rejection			0
22	07/22/2008		DOCK	Case Docketed to Examiner in GAU			0
21	06/17/2008		TI1050	Transfer Inquiry to GAU			0
20	10/17/2007		W525	Withdraw Flagged for 5/25			0
19	10/15/2007		F525	Flagged for 5/25			0
18	06/28/2007		DOCK	Case Docketed to Examiner in GAU			0
17	03/21/2006		DOCK	Case Docketed to Examiner in GAU			0
16	03/04/2005		TSSCOMP	IFW TSS Processing by Tech Center Complete			0
15	03/04/2005		DOCK	Case Docketed to Examiner in GAU			0
14	08/02/2004		RCAP	Reference capture on IDS			0
24	07/19/2004		IDSC	Information Disclosure Statement considered			0
13.7	07/19/2004		M844	Information Disclosure Statement (IDS) Filed			0
13	07/19/2004		WIDS	Information Disclosure Statement (IDS) Filed			0
12	06/29/2004		C.ADB	Correspondence Address Change			0
23	09/29/2003		IDSC	Information Disclosure Statement considered			0
11	09/29/2003		RCAP	Reference capture on IDS			0
10.7	09/29/2003		M844	Information Disclosure Statement (IDS) Filed			0
10	09/29/2003		WIDS	Information Disclosure Statement (IDS) Filed			0
9	09/22/2003		WROIPE	Application Return from OIPE			0
8	09/22/2003		COMP	Application Is Now Complete			0
7	09/22/2003		ROIPE	Application Return TO OIPE			0
5	09/18/2003		COMP	Application Is Now Complete			0
6	09/17/2003		OIPE	Application Dispatched from OIPE			0
4	09/05/2003		CLSS	CASE CLASSIFIED BY OIPE			0
3	09/05/2003		L194	Cleared by OIPE CSR			0
2	08/15/2003		SCAN	IFW Scan & PACR Auto Security Review			0
1	06/26/2003		IEXX	Initial Exam Team nn			0
0.5	06/26/2003		EFILE	Filing date			0

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Application	Document	Mailroom Date	Attorney Docket No.
10606729	PET.DEC.COCI	07/28/2021	42327-501001US
	OA.APPENDIX	07/28/2021	42327-501001US

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CERTIFICATE OF CORRECTION

PATENT NO.	: 10,986,403 B2
APPLICATION NO.	: 10/606729
DATED	: April 20, 2021
INVENTOR(S)	: Donian et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the Title Page:

The first or sole Notice should read --

Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 1881 days.

Signed and Sealed this
Twenty-third Day of November, 2021

Drew Hirshfeld
Performing the Functions and Duties of the
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